Patent Law

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March 7, 2016
Class 9 – Novelty: priority of invention and prior invention

Recap

Recap

- → "Patented"
- → Disclosure in patent documents
- → Derivation

Today's agenda

Today's agenda

- → priority of invention and § 102(g)
- → abandoned, suppressed, or concealed inventions
- → § 102(g) as prior art
- → Taking stock of where we are

Priority of invention

Priority of invention

→ The goal: figure out who invented first

→ No longer really relevant under the post-AIA first-to-file system

(pre-AIA) 35 U.S.C. § 102 — Conditions for patentability; novelty and loss of right to patent

A person shall be entitled to a patent unless —

* * *

(g)

(1) during the course of an interference conducted under section 135 or section 291, another inventor involved therein establishes, to the extent permitted in section 104, that before such person's invention thereof the invention was made by such other inventor and not abandoned, suppressed, or concealed, or

(2) before such person's invention thereof, the invention was made in this country by another inventor who had not abandoned, suppressed, or concealed it.

In determining priority of invention under this subsection, there shall be considered not only the respective dates of **conception** and **reduction to practice** of the invention, but also the **reasonable diligence** of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

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Priority of invention

→ § 102(g)(1):

- Two inventors in an interference
- First inventor in interference (and WTO country), who doesn't abandon/conceal/suppress, wins

→ § 102(g)(2):

- No interference
- First inventor in USA, who doesn't abandon/conceal/suppress, wins

Priority of invention

→ § 102(g) trailing sentence:

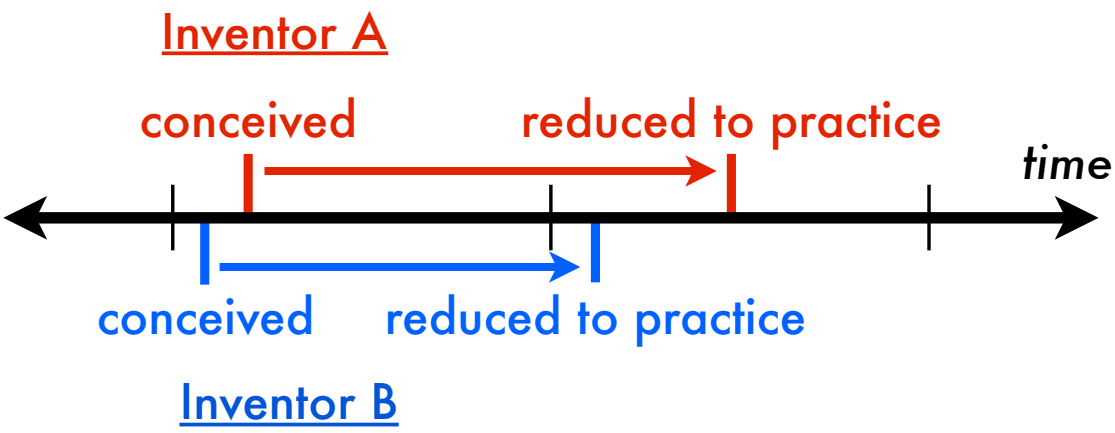
- Invention has two steps: conception and reduction to practice
- We consider both, plus reasonable diligence

Priority of invention

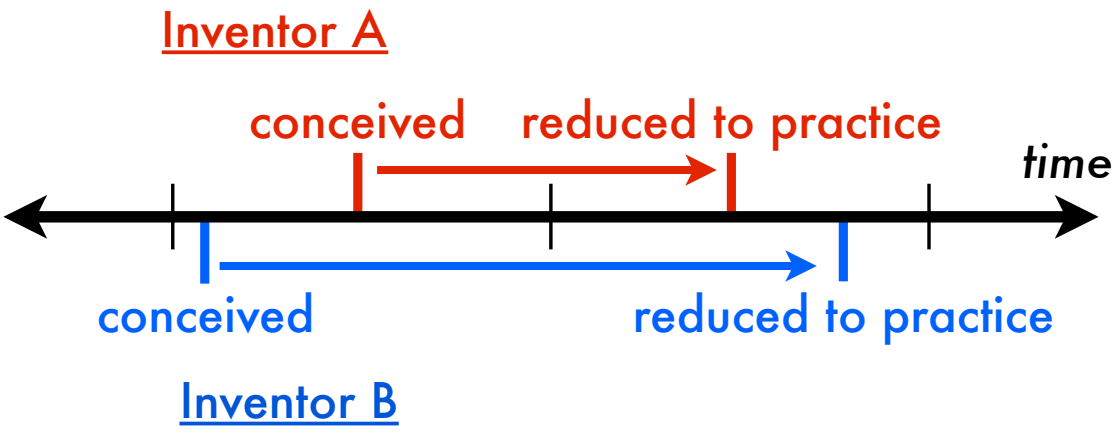
→ A four-part summary of this law:

- 1. The first to reduce the invention to practice usually has priority.
- 2. Filing a valid application counts as constructive reduction to practice.
- 3. The first to conceive may prevail over the first to reduce to practice if the first to conceive was diligent from a time prior to the second conceiver's conception.
- 4. Any reduction to practice that is abandoned, suppressed, or concealed doesn't count.

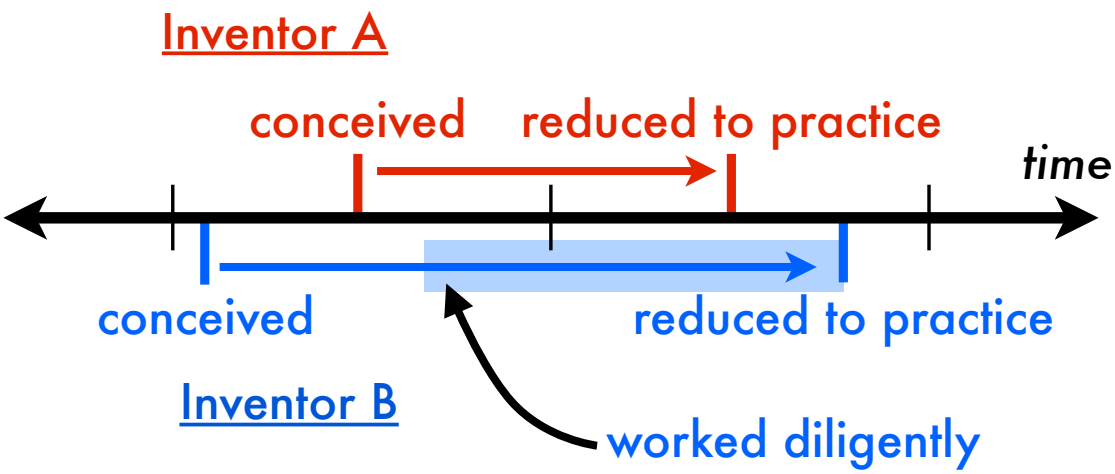
Priority of invention



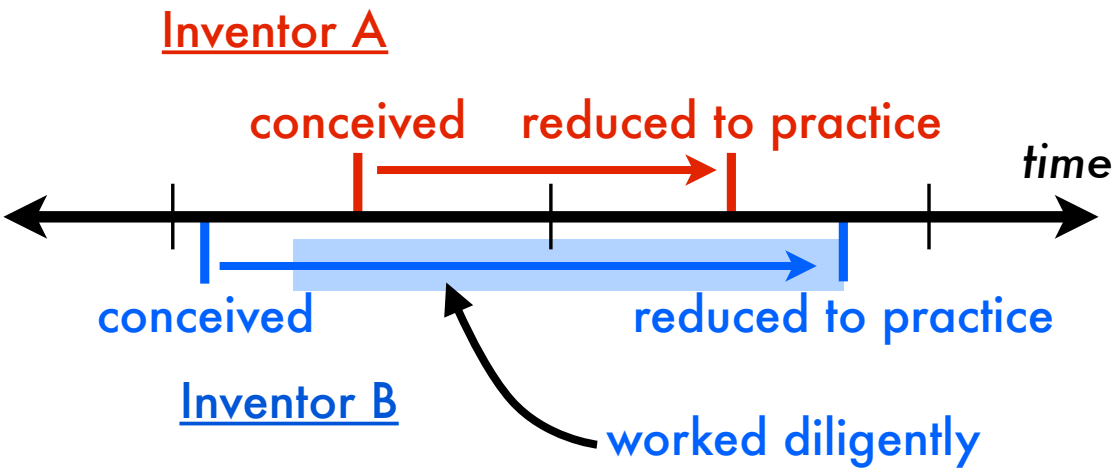
Priority of invention



Priority of invention



Priority of invention



Brown v. Barbacid

→ So what counts as conception and reduction to practice?

- Barbacid reduction to practice: March 6, 1990
- Brown experiment #1: Sept. 20, 1989
- Brown experiment #2: Sept. 25, 1989

Brown v. Barbacid

→ What was wrong with Brown experiment #1?

Brown v. Barbacid

→ What was wrong with Brown experiment #1?

- Didn't include every limitation of the claim
- September 25: added peptide inhibitor

Brown v. Barbacid

→ What was wrong with Brown experiment #2?

Brown v. Barbacid

→ What was wrong with Brown experiment #2?

- No (corroborated!) evidence that Dr. Reiss immediately understood what was going on
- Need both (1) an embodiment that encompasses all elements of the invention, and (2) appreciating that the embodiment works for the intended purpose

Brown v. Barbacid

→ Working embodiment: Sept. 25, 1989

→ Appreciation: by at least Nov. 1989

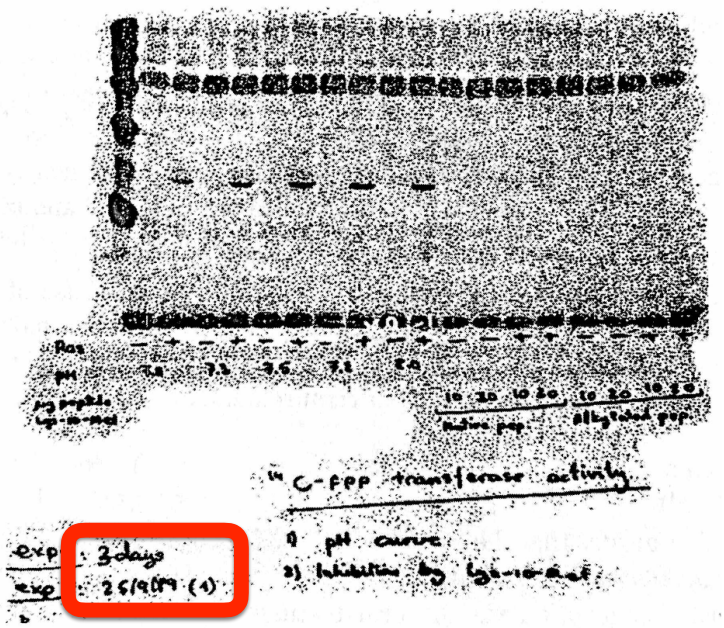
- Testimony of Dr. Casey

→ November 1989 is before March 6, 1990, so Brown wins

Brown v. Barbacid

- → Brown experiment #2: September 25, 1989
- → Brown understanding: November 1989
- → Barbacid reduction to practice: March 6, 1990
- → Barbacid application: May 8, 1990
- → Brown application: December 22, 1992

Brown v. Barbacid



Priority of invention

→ Conception:

- A definite and permanent idea of the complete and operative invention
- Enough to enable
- But uncertainty about whether it will work is okay

Priority of invention

→ Reduction to practice:

- Practicing an embodiment of the invention encompassing all elements (or an enabling patent application), AND
- Appreciating that the invention worked for its intended purpose

Priority of invention

→ Diligence

- Small gaps are okay
- Larger gaps need a good excuse: maybe poverty, regular employment, or vacations
- Bad excuses: attempts to commercialize, work on other projects, doubts about the invention

Priority of invention

→ Benefits of a first-to-invent system?

→ Downsides?

Priority of invention

→ Benefits of a first-to-invent system?

- Incentive to invent earlier

→ Downsides?

- Expensive to administer, especially when there are close calls
- Doesn't incentivize filing earlier

Priority of invention

→ Constructive reduction to practice: Why does a patent application count?

Priority of invention

→ Constructive reduction to practice: Why does a patent application count?

- In theory, it is fully enabling, just like an actual reduction to practice
- Also, encourages early filing

Priority of invention

→ After the AIA:

- Conception and reduction to practice no longer determine priority – filing date does
- Possibly still relevant to inventorship, when an invention is on sale, and other issues

Abandoned/ suppressed/concealed

Abandoned/ suppressed/concealed

→ Suppressed/concealed: trade secrets are the classic example

→ Abandoned: filing delays

- Much harder

Peeler v. Miller

→ Peeler application: Jan. 4, 1968
- (Didn't prove any earlier invention date)

→ Miller invention: April 18, 1966

→ Miller app. work begins: Oct. 1968

→ Miller application: April 27, 1970

Peeler v. Miller

→ Was the invention abandoned?

Peeler v. Miller

→ Was the invention abandoned?

- Yup. Four-year delay in filing patent application was too long.
- No specific proof of intent to abandon
- "Mere delay" is not enough to abandon
- But here, timing was "unreasonable"

Peeler v. Miller

→ Delays

- In general: months are fine; years are not
- But it's a fact-specific inquiry
- If you have a good excuse to delay, that's okay
- Best excuse: to improve the patent application (through testing, &c)

Peeler v. Miller

→ Who gets the patent?

Peeler v. Miller

→ Who gets the patent?

- Peeler!
- Even though he wasn't the first inventor!
- Is that reasonable?

§ 102(g) as prior art

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§ 102(g) as prior art

→ Why doesn't § 102(g)(2) cover all other kinds of prior art?

- § 102(g)(2) requires conception and reduction to practice — more limited than printed publications, &c
- § 102(g)(2) is limited to invention in the United States

§ 102(g) as prior art

→ Bottom line: § 102(g)(2) is another way of back-dating prior art that later becomes public

- Not abandoned/suppressed/concealed

Dow Chemical v. Astro-Valcour

→ 3/84: AVI makes foam with isobutane

→ 8/84: AVI makes foam with isobutane (again)

→ 8/84: Dow conceives of invention

→ 9/84: Dow reduces invention to practice

→ 12/85: Dow files patent application

Dow Chemical v. Astro-Valcour

→ So AVI made the invention first. What's Dow's argument?

Dow Chemical v. Astro-Valcour

→ So AVI made the invention first. What's Dow's argument?

- AVI hadn't actually invented it — no one thought they had invented anything new
- Sort of like *Seaborg* and *Schering-Plough*

Dow Chemical v. Astro-Valcour

→ Why isn't this a good argument? Invention requires conception and reduction to practice….

Dow Chemical v. Astro-Valcour

→ Why isn't this a good argument? Invention requires conception and reduction to practice....

- You have to understand what you did – and they did
- You don't have to understand <u>that it may be patentable</u>

Dow Chemical v. Astro-Valcour

→ Does this rule make sense?

Dow Chemical v. Astro-Valcour

→ Does this rule make sense?

- Yes, if we're concerned about the benefit the public gets from the product
- No, if we're concerned about the benefit the public gets from disclosure in the patent

Dow Chemical v. Astro-Valcour

→ Was this abandoned/suppressed/ concealed?

Dow Chemical v. Astro-Valcour

→ Was this abandoned/suppressed/concealed?

- Two ways: deliberate or implied
- Here: 2.5 years – commercializing the product, not waiting to file a patent application
- Would 2.5 years before filing a patent application have been okay?

Taking stock of where we are

Taking stock of where we are

→ Novelty and statutory bars: § 102

→ First question: effective filing date on or after March 16, 2013

- If so: post-AIA statute/rules
- If not: pre-AIA statute/rules

Taking stock of where we are

→ Pre-AIA § 102:

- § 102(a): novelty
- § 102(b): statutory bar
- § 102(c): statutory bar
- § 102(d): statutory bar
- § 102(e): novelty
- § 102(f): derivation
- § 102(g): novelty

Taking stock of where we are

→ Pre-AIA § 102(a): novelty

- known by others (in this country)
- used by others (in this country)
- patented (anywhere)
- described in a printed publication (anywhere)
- before the invention

Taking stock of where we are

→ Pre-AIA § 102(e): novelty

- described in a published patent application (in this country)
- described in a patent (in this country)
- filed before the invention, even if published later (backdated prior art)

Taking stock of where we are

→ Pre-AIA § 102(f): derivation

- stolen from someone else

Taking stock of where we are

→ Pre-AIA § 102(g): novelty

- invented first by someone else (anywhere); not abandoned, suppressed, or concealed; and established in an interference
- invented first by someone else (in this country); and not abandoned, suppressed, or concealed

Taking stock of where we are

→ Post-AIA § 102:

- § 102(a): novelty
- § 102(b): grace period

Taking stock of where we are

→ Post-AIA § 102(a)(1): novelty

- patented
- described in a printed publication
- in public use
- on sale
- otherwise available to the public
- anywhere
- before the effective filing date

Taking stock of where we are

→ Post-AIA § 102(a)(2): novelty

- described in a published patent application, or
- described in a patent
- anywhere
- with an effective filing date before the effective filing date (not the invention!)

Next time

Next time

→ Statutory bars: introduction and public use