# Patent Law

Prof. Roger Ford
Class 8 · September 25, 2017
Novelty and statutory bars:
pre-AIA § 102(b) prior art

# Recap

→ Novelty: introduction

→ Anticipation: the basics

→ 'known or used by others'

# Today's agenda

# Today's agenda

→ 'printed publication'

→ 'patented'

→ (pre-AIA) § 102(b) introduction

→ 'on sale'

→ ~~'in public use'~~

# 'printed publication'

**(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 —

(a) the invention was known or used by others in this country, or patented or **described in a printed publication in this or a foreign country, before the invention thereof** by the applicant for patent, or

(b) the invention was patented or **described in a printed publication in this or a foreign country** or in public use or on sale in this country, **more than one year prior to the date of the application** for patent in the United States, or

* * *

**(post-AIA) 35 U.S.C. § 102 — Conditions for patentability; novelty**

(a) Novelty; Prior Art.— A person shall be entitled to a patent unless—

(1) the claimed invention was patented, **described in a printed publication**, or in public use, on sale, or otherwise available to the public **before the effective filing date** of the claimed invention; or

(2) the claimed invention was described in a patent issued under section 151, or in an application for patent published or deemed published under section 122(b), in which the patent or application, as the case may be, names another inventor and was effectively filed before the effective filing date of the claimed invention.

(b) Exceptions.—

* * *

# *In re Klopfenstein*

→ Patent: extruded soy cotyledon fiber (yum!)

→ § 102(a) or (b)?

→ What was the prior disclosure?

# *In re Klopfenstein*

→ Patent: extruded soy cotyledon fiber (yum!)

→ § 102(a) or (b)?

→ What was the prior disclosure?

- Presentations by the inventors – therefore § 102(b) prior art
- But post-AIA, difference no longer matters

# *In re Klopfenstein*

→ So what was the publication?

- Never published in a book or journal
- No copies distributed
- Never indexed in a library

# *In re Klopfenstein*

→ Court: the test is whether the reference was sufficiently available to the public interested in the art

- Billboard? Yes.
- Indexed Ph.D. thesis? Yes.
- Non-indexed B.A. thesis? Nope.
- Talk with six copies of paper? Yes.
- Talk with no paper or slides? No.
- Document in Australian patent office? Yes.

# *In re Klopfenstein*

→ Another multi-factor test!

- Length of time it was displayed
- Expertise of viewing audience
- Expectation of privacy or non-copying
- Ease of copying

# *In re Klopfenstein*

→ Websites?

→ Podcasts?

→ Class lecture?

→ Class lecture with slides?

→ Conference lecture to experts?

→ Conference lecture to experts with slides?

→ Conference lecture to experts with slides posted on the internet?

# *In re Klopfenstein*

→ So are these tests consistent?

- "known or used by others" – must be public knowledge or use (*Rosaire*)
- "described in a printed publication" – need not be published (*Klopfenstein*)

# *In re Klopfenstein*

→ So are these tests consistent?

- "known or used by others" – must be public knowledge or use (*Rosaire*)
- "described in a printed publication" – need not be published (*Klopfenstein*)

→ They both prevent ideas from being withdrawn from the public domain

# ‘patented’

**(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 —

(a) the invention was **known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof** by the applicant for patent, or

(b) the invention was **patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application** for patent in the United States, or

* * *

**(post-AIA) 35 U.S.C. § 102 — Conditions for patentability; novelty**

(a) Novelty; Prior Art.— A person shall be entitled to a patent unless—

(1) the claimed invention was **patented, described in a printed publication, or in public use, on sale, or otherwise available to the public before the effective filing date** of the claimed invention; or

(2) the claimed invention was described in a patent issued under section 151, or in an application for patent published or deemed published under section 122(b), in which the patent or application, as the case may be, names another inventor and was effectively filed before the effective filing date of the claimed invention.

(b) Exceptions.—

* * *

# Patented

→ Most patents are also printed publications

→ Note distinction: "described in a printed publication" versus "patented" (not "described in a patent")

→ What does it mean for something to be "patented"?

# Patented

→ Most patents are also printed publications

→ Note distinction: "described in a printed publication" versus "patented" (not "described in a patent")

→ What does it mean for something to be "patented"?

- Covered by a patent claim

# Patented

→ So, in practice:

- Usually patents are treated as printed publications (if indexed and classified)
- Broader: what is "described in" the patents (claims plus specification) versus "patented" (claims only)
- "Patented" rarely matters

# Patented

→ The exception: Weird foreign patents that aren't printed publications

- E.g., German Gebrauchsmuster (utility model) — available to the public but not examined or indexed
- But: Secret patents are not prior art (despite statutory language) because they don't satisfy the patent bargain

# (pre-AIA) § 102(b) introduction

**(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 —

(a) the invention was **known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof** by the applicant for patent, or

(b) the invention was **patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application** for patent in the United States, or

* * *

# (pre-AIA) § 102(b)

→ Many of the same kinds of prior art as § 102(a)

→ Imposes a one-year filing deadline

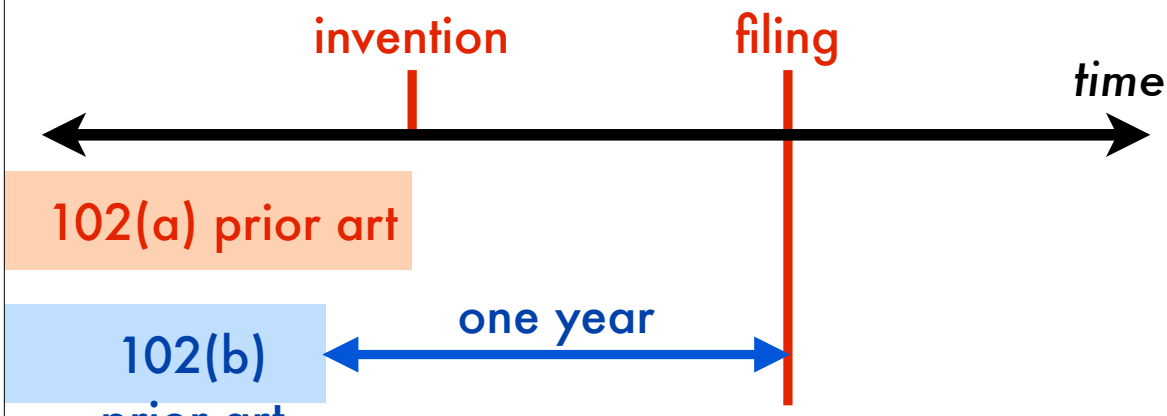
| Pre-AIA § 102(a) (novelty) | Pre-AIA § 102(b) (statutory bars) |
|---|---|
| known by others (in U.S.) | on sale (in U.S.) |
| used by others (in U.S.) | in public use (in U.S.) |
| patented (anywhere) | patented (anywhere) |
| described in a printed publication (anywhere) | described in a printed publication (anywhere) |
| before the invention | more than one year prior to the application date |

# (pre-AIA) § 102(b)

# (pre-AIA) § 102(b)


102(a) prior art

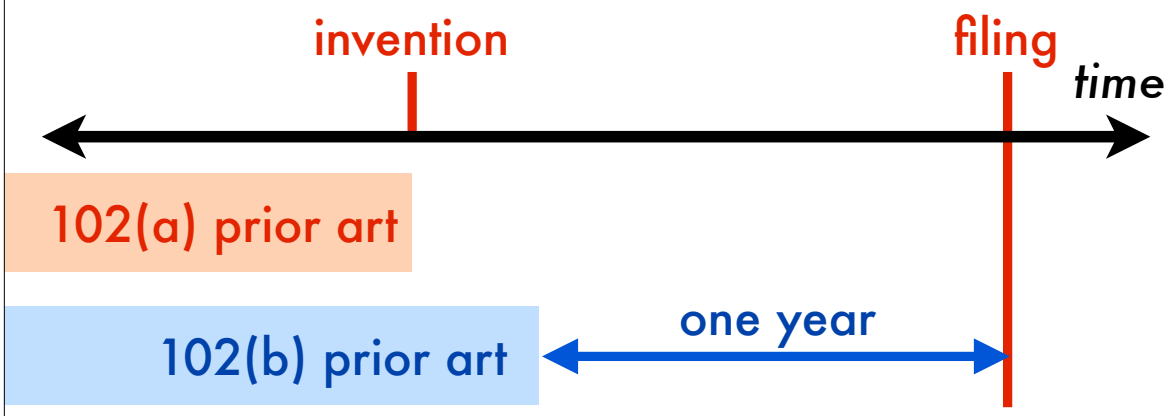
# (pre-AIA) § 102(b)



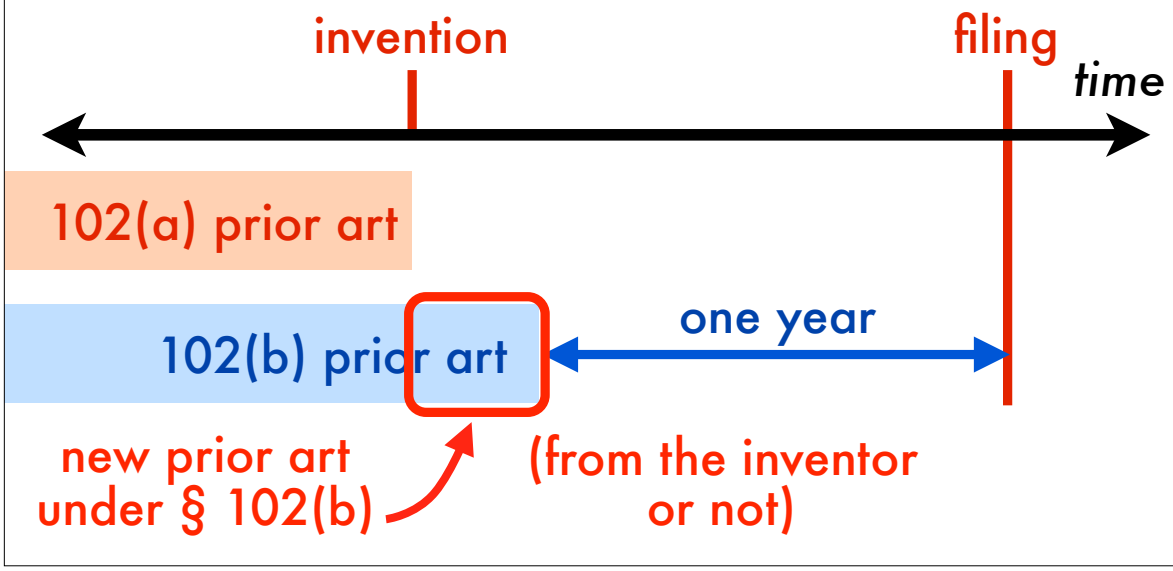

102(a) prior art

102(b) prior art

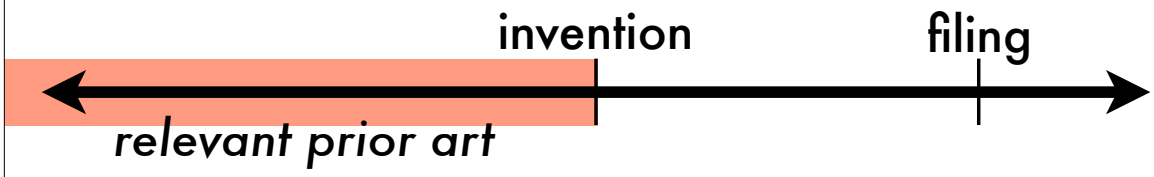
# (pre-AIA) § 102(b)



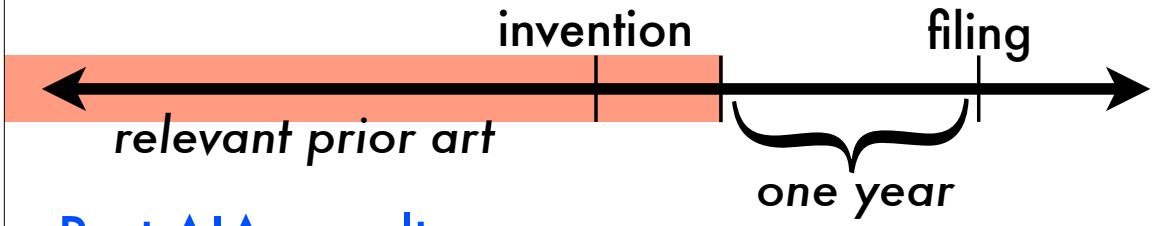

# (pre-AIA) § 102(b)



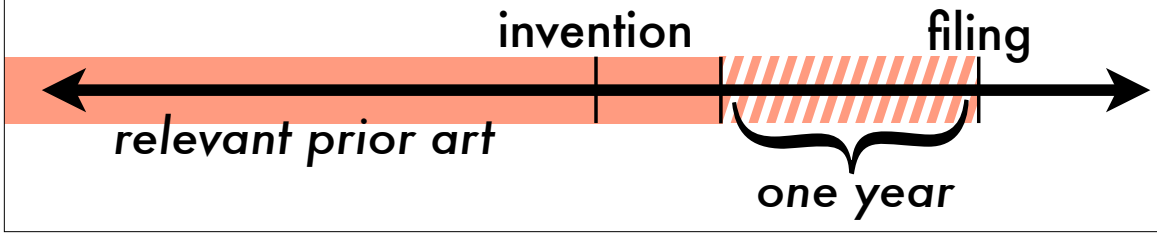
## Pre-AIA § 102(a) (novelty):




## Pre-AIA § 102(b) (statutory bars):




## Post-AIA novelty:




# 'on sale'

**(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 —

(a) the invention was **known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof** by the applicant for patent, or

(b) the invention was **patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application** for patent in the United States, or

* * *

**(post-AIA) 35 U.S.C. § 102 — Conditions for patentability; novelty**

(a) Novelty; Prior Art.— A person shall be entitled to a patent unless—

(1) the claimed invention was **patented, described in a printed publication, or in public use, on sale, or otherwise available to the public before the effective filing date** of the claimed invention; or

(2) the claimed invention was described in a patent issued under section 151, or in an application for patent published or deemed published under section 122(b), in which the patent or application, as the case may be, names another inventor and was effectively filed before the effective filing date of the claimed invention.

(b) Exceptions.—

* * *

# *Pfaff v. Wells Electronics*

- → Nov. 1980: TI contacts Pfaff to design socket
- → Feb./Mar. 1981: Pfaff sends detailed drawings to manufacturer
- → Apr. 8, 1981: TI confirms in writing previously placed oral order for 30,100 sockets
- → Apr. 19, 1981: § 102(b) critical date
- → July, 1981: Pfaff fulfills TI order
- → Apr. 19, 1982: Pfaff files patent application

# *Pfaff v. Wells Electronics*

- → So the key question: when was the invention "on sale" for purposes of § 102?

# *Pfaff v. Wells Electronics*

→ So the key question: when was the invention "on sale" for purposes of § 102?

→ Court: two requirements

- Commercial offer for sale
- Invention must be "ready for patenting"

# *Pfaff v. Wells Electronics*

commercial offer for sale?

→ Nov. 1980: TI cont[illegible]et

→ Feb./Mar. 1981: Pfaff sends detailed drawings to manufacturer

→ Apr. 8, 1981: TI confirms in writing previously placed oral order for 30,100 sockets

→ Apr. 19, 1981: § 102(b) critical date

→ July, 1981: Pfaff fulfills TI order

→ Apr. 19, 1982: Pfaff files patent application

# *Pfaff v. Wells Electronics*

commercial offer for

ready for patenting?

→ Nov. 1980: TI cont

→ Feb./Mar. 1981: Pfaff send drawings to manufacturer

→ Apr. 8, 1981: TI confirms in writing previously placed oral order for 30,100 sockets

→ Apr. 19, 1981: § 102(b) critical date

→ July, 1981: Pfaff fulfills TI order

→ Apr. 19, 1982: Pfaff files patent application

# *Pfaff v. Wells Electronics*

→ What does "ready for patenting" mean?

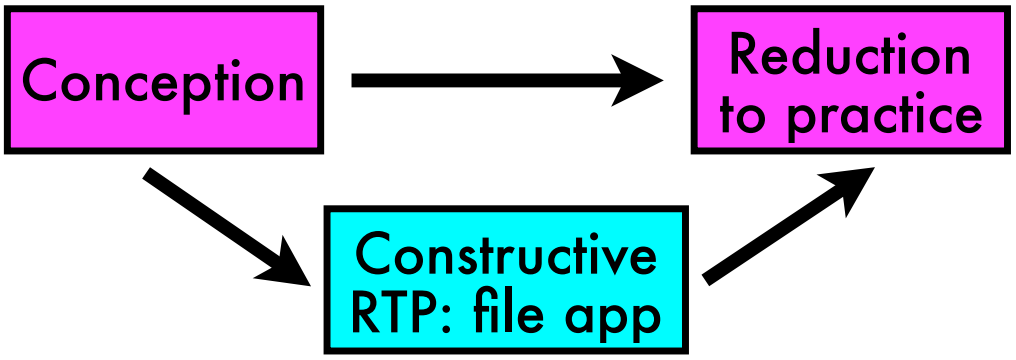
# *Pfaff v. Wells Electronics*

→ What does "ready for patenting" mean?

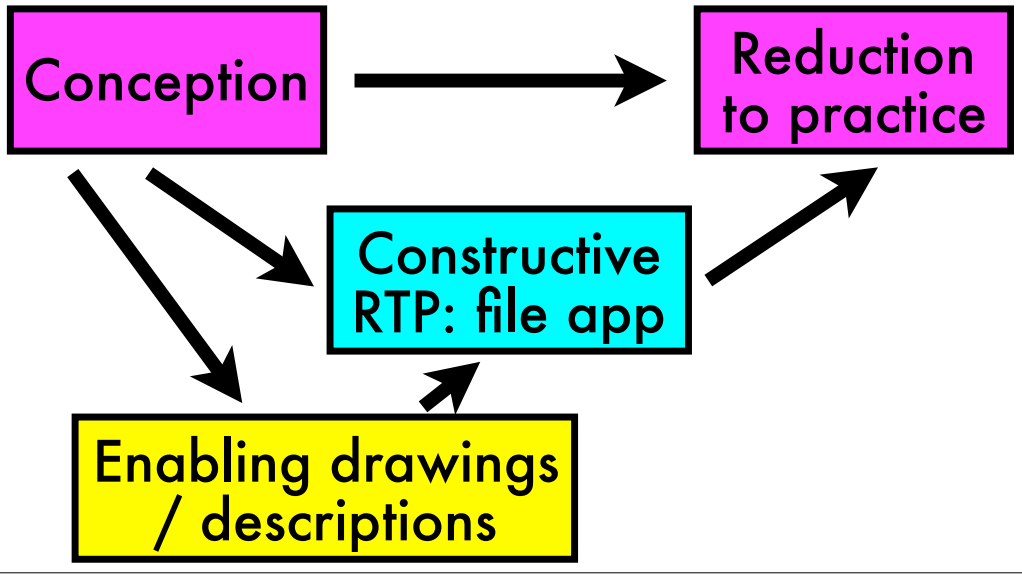
- Court: EITHER (a) reduction to practice or (b) drawings or descriptions sufficient to enable someone to practice the invention

# *Pfaff v. Wells Electronics*

# *Pfaff v. Wells Electronics*




# *Pfaff v. Wells Electronics*



"[I]t is evident that Pfaff could have obtained a patent on his novel socket when he accepted the purchase order from Texas Instruments for 30,100 units. At that time he provided the manufacturer with a **description and drawings that had 'sufficient clearness and precision to enable those skilled in the matter' to produce the device**."

*Pfaff v. Wells Electronics*

# *Pfaff v. Wells Electronics*

→ Who knew of TI's purchase of the sockets? How "public" was the sale?

# *Pfaff v. Wells Electronics*

→ Who knew of TI's purchase of the sockets? How "public" was the sale?

- No one, as far as we know
- Not at all public

# *Pfaff v. Wells Electronics*

→ Two anomalies of the on-sale bar:

- It can apply even before the inventor has invented the invention, for purposes of priority
- It can apply to purely "private" sales – a truly secret form of prior art

→ Do these make sense?

# *Pfaff v. Wells Electronics*

→ Why apply the on-sale bar before the invention has been reduced to practice?

# *Pfaff v. Wells Electronics*

→ Why apply the on-sale bar before the invention has been reduced to practice?

- Otherwise, inventors would have an incentive to wait and not file for patents earlier – we want people to file quickly
- Inventor has everything needed to reduce to practice – has an enabling disclosure

# *Pfaff v. Wells Electronics*

→ Okay, why not go further and just say that the commercial offer for sale is enough to trigger the one-year bar?

# *Pfaff v. Wells Electronics*

→ Okay, why not go further and just say that the commercial offer for sale is enough to trigger the one-year bar?

- If the invention hasn't been fully developed at that point, you could make it impossible to rely on the patent system

# *Pfaff v. Wells Electronics*

→ Why not require sales to be "public" to count?

# *Pfaff v. Wells Electronics*

→ Why not require sales to be "public" to count?

- Otherwise, inventors would have an incentive to make private sales and delay filing – we want people to file quickly
- Worst-case scenario: an inventor extends his or her monopoly indefinitely

# *Pfaff v. Wells Electronics*

→ Note: It's not clear if secret sales are still prior art after the AIA

- Pending now before the Federal Circuit en banc
- We'll discuss the statutory argument in a few classes

# *Space Systems*

→ In both *Pfaff* and *Space Systems:*

- The inventor had contracted to sell the invention
- The inventor sent the customer a document with a description and drawings of the invention

# *Space Systems*

→ But the on-sale bar wasn't triggered in *Space Systems*. Why?

# *Space Systems*

→ But the on-sale bar wasn't triggered in *Space Systems*. Why?

- The disclosures were much less specific
- *Pfaff:* manufacturer-ready drawings for production
- *Space Systems:* there was still uncertainty about whether it would work

# *Plumtree Software*

→ Question: What counts as a commercial offer for sale?

- (1) It must be a commercial offer for sale under general UCC contract-law principles: "A commercial offer is 'one which the other party could make into a binding contract by simple acceptance.'"
- (2) The offer must be <u>of the invention</u>

# *Plumtree Software*

→ So why wasn't the sale here sufficient?

# *Plumtree Software*

→ So why wasn't the sale here sufficient?

- It isn't clear that the inventor (1) was required to use the patented method, or (2) actually used (before the critical date) the patented method
- So remand for fact finding

# *Plumtree Software*

→ What does it mean to offer to sell the invention?

# *Plumtree Software*

→ What does it mean to offer to sell the invention?

- The invention can be described expressly to the buyer, à la *Pfaff*
- The seller can be required to sell the invention
  - Some cases: intent to sell the invention is enough
- The seller can actually sell the invention

# *Plumtree Software*

→ What does it mean to offer to sell the invention?

- Note: not a patent license or sale, a sale of the product

→ This is a good example of the nested nature of legal rules
→ Was the invention:
- On sale
  - commercial offer for sale
    - (according to contract-law principles…)
  - of the invention itself
    - for product inventions:
      - offeror is required (where that requirement exists before the critical date) to provide the patented invention, or
      - maybe, offeror intends (where that intent exists before the critical date) to provide the patented invention, or
      - offeror actually provides the patented invention
    - for process inventions:
      - offeror is required (where that requirement exists before the critical date) to use the patented invention, or
      - maybe, offeror intends (where that intent exists before the critical date), or
      - offeror actually uses the patented invention
  - where the invention is ready for patenting
    - complete conception
    - ready for patenting
      - embodiment of the invention, or
      - enabling description and drawings
- more than one year before the effective filing date

# On-sale bar: Examples

→ Pfaff comes up with the general idea for the socket, and contracts with TI to make and sell it, but hasn't worked out all the details

→ Is the invention "on sale" yet?

# On-sale bar: Examples

→ Pfaff comes up with the general idea for the socket, and contracts with TI to make and sell it, but hasn't worked out all the details

→ Is the invention "on sale" yet?

- No – not ready for patenting since there is no enabling description yet

# On-sale bar: Examples

→ Pfaff comes up with the idea for the socket, makes detailed drawings, and offers it for sale, but no one buys it

→ Is the invention "on sale" yet?

# On-sale bar: Examples

→ Pfaff comes up with the idea for the socket, makes detailed drawings, and offers it for sale, but no one buys it

→ Is the invention "on sale" yet?

- Yes – an offer for sale does not require acceptance

# On-sale bar: Examples

→ Pfaff comes up with the idea for the socket, makes detailed drawings, and advertises it in a magazine, but never formally offers it for sale

→ Is the invention "on sale" yet?

# On-sale bar: Examples

→ Pfaff comes up with the idea for the socket, makes detailed drawings, and advertises it in a magazine, but never formally offers it for sale

→ Is the invention "on sale" yet?

- No – advertising is not an offer for sale under contract-law principals

# On-sale bar: Examples

→ Pfaff comes up with the idea for the socket, makes detailed drawings, and offers an "improved socket" for sale

→ Is the invention "on sale" yet?

# On-sale bar: Examples

→ Pfaff comes up with the idea for the socket, makes detailed drawings, and offers an "improved socket" for sale

→ Is the invention "on sale" yet?

- Yes – buyers do not have to <u>understand</u> what makes the invention interesting

# On-sale bar: Examples

→ Pfaff comes up with the idea for a cheaper socket, makes detailed drawings, and offers a "socket" for sale

→ Is the invention "on sale" yet?

# On-sale bar: Examples

→ Pfaff comes up with the idea for a cheaper socket, makes detailed drawings, and offers a "socket" for sale

→ Is the invention "on sale" yet?

- Maybe – depends on whether the fact finder thinks he intended to exploit the better socket when he made the offer (*Tec Air, Inc. v. Denso Mfg. Mich. Inc.*)

# Next time

# Next time

→ Yet more novelty and statutory bars