Patent Law

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October 10, 2016
Class 10 – Novelty scraps

Announcement

Announcement

- → Midterm exam distributed Monday, October 17 at 9:00 am
- → Midterm exam due Monday, October 24 at 9:00 am
- → Time limit: You may spend up to four hours completing the exam
- → Materials: Open anything
- → Previous midterms are on the website

Recap

Recap

→ Patent documents

→ Priority of invention

Today's agenda

Today's agenda

- → "abandoned, suppressed, or concealed" inventions
- → (pre-AIA) § 102(g) as prior art
- → (pre-AIA) statutory bars
  - § 102(b)
  - § 102(c)
  - § 102(d)
- → derivation

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

(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.

§ 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

→ Why isn't § 102(g)(2) redundant?

- Sometimes there isn't good evidence in a traditional reference
- Also, invention by another inventor may be earlier in time than the reference documenting that invention

§ 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*
- Does this make sense?

Dow Chemical v. Astro-Valcour

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

Dow Chemical v. Astro-Valcour

→ So 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?

Statutory bars

Statutory bars (pre-AIA)

- → § 102(b): one-year bar
- → § 102(c): abandonment
- → § 102(d): foreign filings

§ 102(b)

(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 —

* * *

(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

(c) he has **abandoned** the invention, or

(d) the invention was **first patented** or caused to be patented, or was the subject of an inventor's certificate, **by the applicant** or his legal representatives or assigns **in a foreign country** prior to the **date of the application for patent in this country** on an application for patent or inventor's certificate **filed more than twelve months before the filing of the application in the United States**, or

* * *

§ 102(b) (pre-AIA)

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

→ Imposes a one-year filing deadline

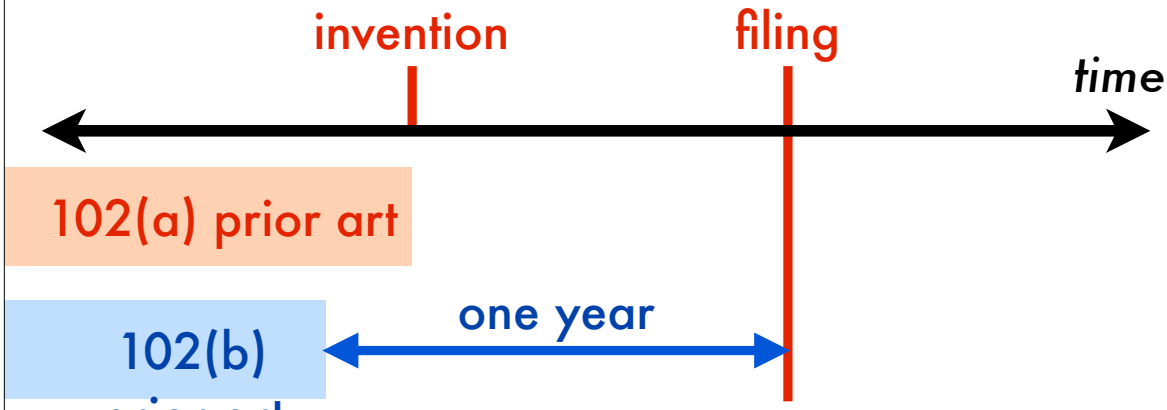
Pre-AIA § 102(a) (novelty)	Pre-AIA § 102(b) (statutory bars)
known by others (in U.S.)	on sale (in U.S.)
used by others (in U.S.)	in public use (in U.S.)
patented (anywhere)	patented (anywhere)
described in a printed publication (anywhere)	described in a printed publication (anywhere)
before the invention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

§ 102(b) (pre-AIA)

§ 102(b) (pre-AIA)

102(a) prior art

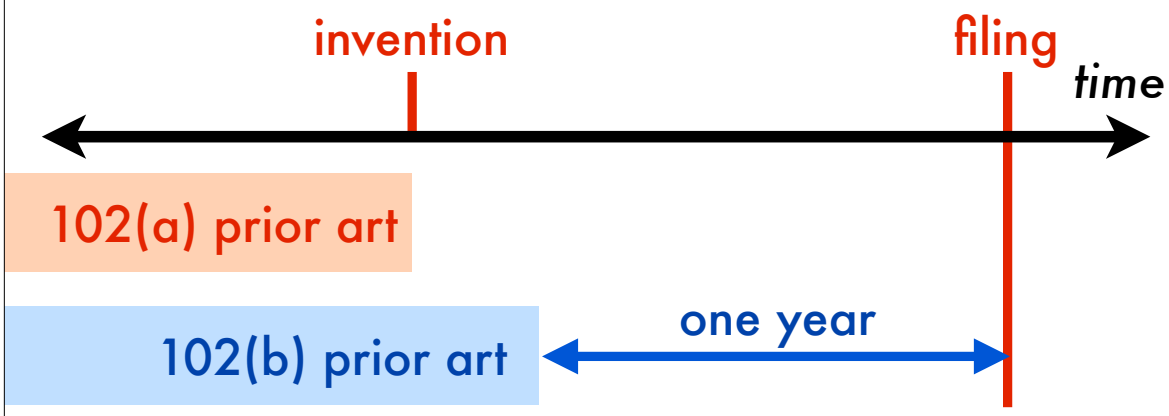
§ 102(b) (pre-AIA)



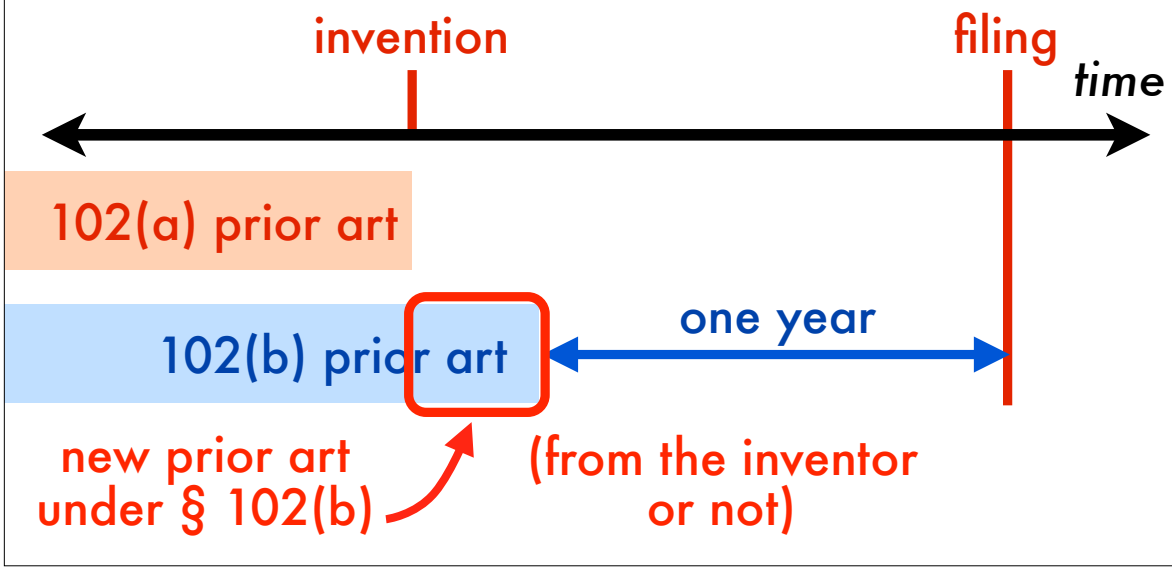
102(a) prior art

102(b) prior art

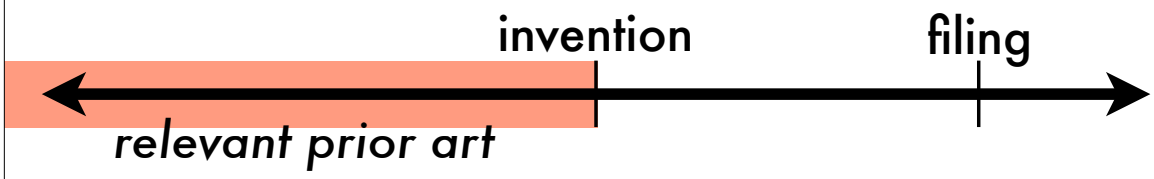
§ 102(b) (pre-AIA)



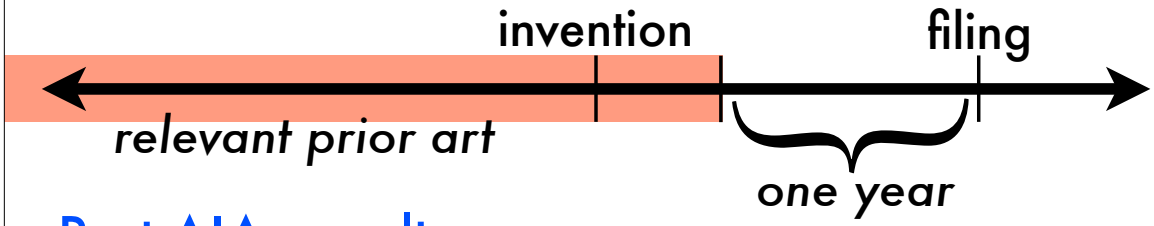
§ 102(b) (pre-AIA)



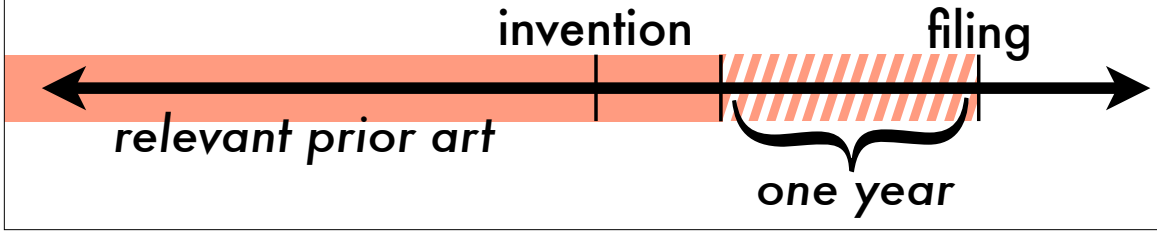
Pre-AIA novelty:



Pre-AIA statutory bars:



Post-AIA novelty:



§ 102(c)

(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 —

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(c) he has **abandoned** the invention, or

(d) the invention was **first patented** or caused to be patented, or was the subject of an inventor's certificate, **by the applicant** or his legal representatives or assigns **in a foreign country** prior to the **date of the application for patent in this country** on an application for patent or inventor's certificate **filed more than twelve months before the filing of the application in the United States**, or

* * *

Macbeth-Evans Glass

→ 1903: Macbeth begins using secret process to make glass products

→ May 1910: Macbeth employee leaves and takes secret process to Jefferson Glass Co.

→ Dec. 1910: Jefferson Glass Co. begins using secret process to make glass products

→ May 1913: Macbeth files patent application

Macbeth-Evans Glass

→ Today, would be barred as a public use under (pre-AIA) § 102(b):

- Under *Metallizing,* use of a trade secret – by the patent applicant only – to make a commercial product more than a year before the filing date counts as a public use

Macbeth-Evans Glass

→ What had the inventor abandoned?

Macbeth-Evans Glass

→ What had the inventor abandoned?

- Not the invention: Macbeth-Evans used it for many years as a trade secret
- Instead, the patent rights
- Otherwise, the patent holder could extend his or her monopoly beyond the 20-year limit

"This, however, inevitably concedes an intent either to **abandon the right to secure protection under the patent laws**, or to retain such right and if necessity should arise then to obtain through a patent a **practical extension of any previous exclusive use** (secured through secrecy) into a total period beyond the express limitation fixed by those laws."

Macbeth-Evans

§ 102(c) (pre-AIA)

→ Abandonment has little practical importance today

- § 102(b) public use has expanded to cover the usual case, commercial exploitation of a trade secret

§ 102(c) (pre-AIA)

→ Today, abandonment matters in two scenarios:

- Inventor expressly abandons her invention to the public, and then changes her mind
- Inventor commercially exploits the invention as a trade secret for less than a year

§ 102(c) (pre-AIA)

→ Today, abandonment is <u>not</u> a problem in two scenarios:

- Inventor keeps the invention secret and uses it for noncommercial purposes
- Inventor files patent application, "abandons" the application, then starts prosecution again

§ 102(d)

(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 —

* * *

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(c) he has **abandoned** the invention, or

(d) the invention was **first patented** or caused to be patented, or was the subject of an inventor's certificate, **by the applicant** or his legal representatives or assigns **in a foreign country** prior to the **date of the application for patent in this country** on an **application for patent or inventor's certificate filed more than twelve months before the filing of the application in the United States**, or

* * *

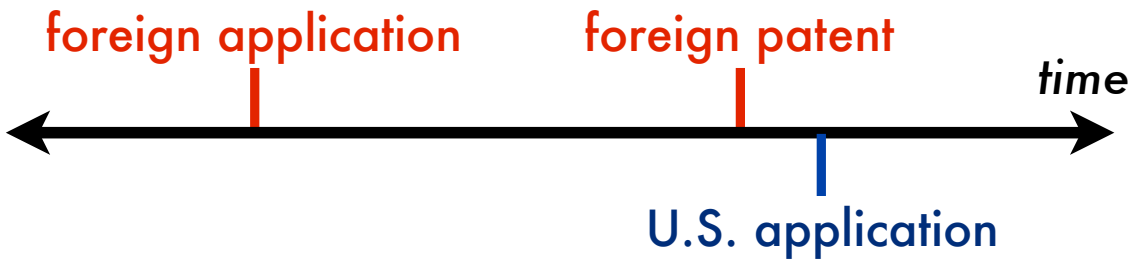
§ 102(d) (pre-AIA)

→ Same invention, same applicant

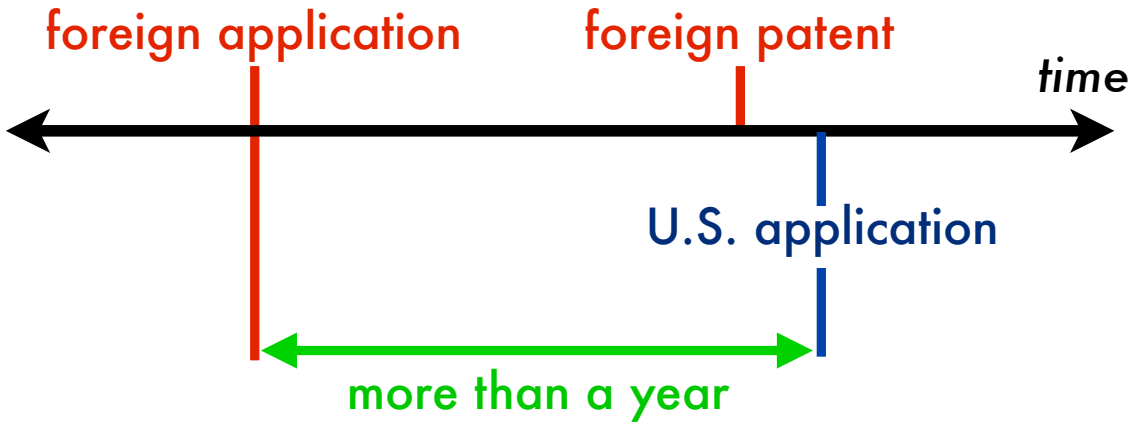
→ Foreign patent issued before U.S. application filed

→ Foreign application filed more than a year before U.S. application filed

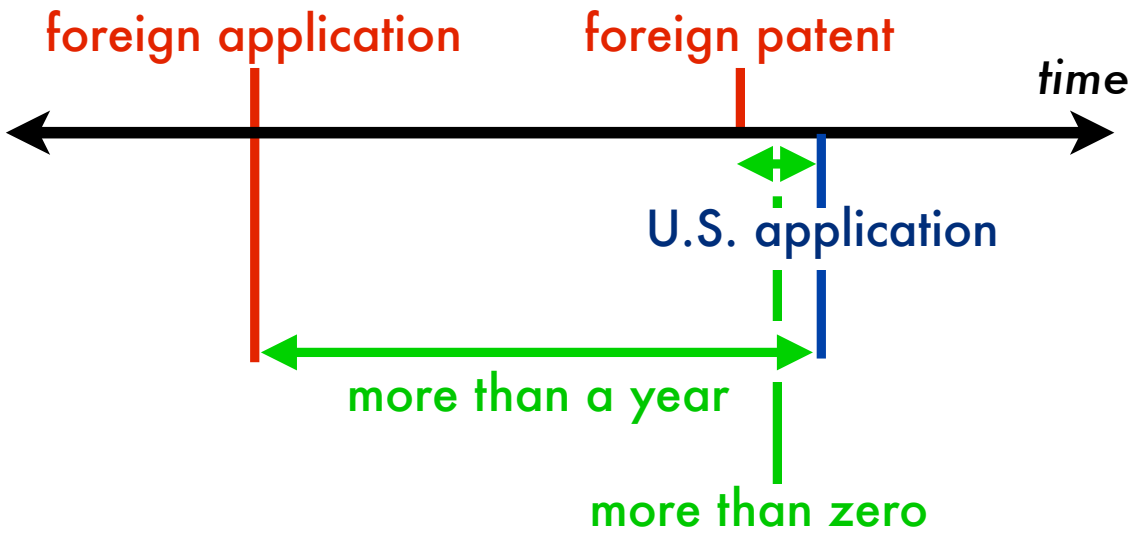
§ 102(d) (pre-AIA)



§ 102(d) (pre-AIA)



§ 102(d) (pre-AIA)



§ 102(d) problems

→ June 17, 2000: French application

→ July 8, 2001: U.S. application

→ October 15, 2002: French patent

→ Barred by § 102(d)?

§ 102(d) problems

→ June 17, 2000: French application

→ July 8, 2001: U.S. application

→ October 15, 2002: French patent

→ Barred by § 102(d)?

- No. U.S. application was filed more than a year after foreign application, but before foreign patent had issued

§ 102(d) problems

→ June 17, 2000: Estonian application

→ October 15, 2000: Estonian patent

→ May 14, 2001: U.S. application

→ Barred by § 102(d)?

§ 102(d) problems

→ June 17, 2000: Estonian application

→ October 15, 2000: Estonian patent

→ May 14, 2001: U.S. application

→ Barred by § 102(d)?

- No. U.S. application was filed within a year of the foreign application. So it doesn't matter that the foreign patent had already issued.

§ 102(d) problems

→ June 17, 2000: Japanese application

→ January 1, 2001: Japanese patent

→ June 18, 2001: U.S. application

→ Barred by § 102(d)?

§ 102(d) problems

→ June 17, 2000: Japanese application

→ January 1, 2001: Japanese patent

→ June 18, 2001: U.S. application

→ Barred by § 102(d)?

- Yes. U.S. application was more than a year after the Japanese application, and after Japanese patent had issued.

§ 102(d) (pre-AIA)

→ Remaining questions:

- What counts as "patented"?
- What counts as the same "invention"?

In re Kathawala

→ Nov. 22, 1982: Kathawala files U.S. application

→ Nov. 21, 1983: Kathawala files applications in Spain and Greece, including claims covering ester derivatives not included in U.S. application

→ Oct. 2, 1984: Greek patent issues

→ Jan. 21, 1985: Spanish patent issues

→ Apr. 11, 1985: Kathawala files U.S. continuation-in-part application adding ester derivatives

In re Kathawala

→ What counts as "patented"?

- Kathawala: The Spanish patent was not publicly available
- Court: Too bad. What matters is when you have exclusive rights.
- *Reeves*: "patented" for purposes of § 102(a)/(b) means what is covered by the claims

In re Kathawala

→ What counts as the same invention?

- Kathawala: The esters were not patented in Greece because the Greek patent was invalid
- Kathawala: The esters were not patented in Spain because that patent only covered the process, not the compounds as products
- Court: Nope.

In re Kathawala

→ Why is it irrelevant whether the Greek patent is valid?

→ Why is it irrelevant what the Spanish claims cover?

In re Kathawala

→ How could the applicant have avoided problems?

In re Kathawala

→ How could the applicant have avoided problems?

- Just file in the U.S. within a year of any foreign filings
- This is a really uncommon problem

Derivation

(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 —

* * *

(f) he did not himself invent the subject matter sought to be patented, or

* * *

Campbell v. Spectrum Automation

→ (pre-AIA) § 102(f): if you steal the invention, the patent is invalid

→ Clear-and-convincing evidence

→ Corroboration rule

Campbell v. Spectrum Automation

→ Why did the company not just file in Zimmerman's name, with the company as the assignee?

Two § 102(f) scenarios

→ Fraud (*Campbell*)

→ Inventorship disputes

Derivation

→ Post-AIA: no derivation provision in § 102

- But, it might be implicit: only an "inventor" can get a patent

→ Instead: administrative derivation proceeding (§ 291) or civil cause of action (§ 135)

(post-AIA) 35 U.S.C. § 135 — Derivation proceedings

(a) Institution of Proceeding.—

(1) In general.— An applicant for patent may file a petition with respect to an invention to institute a derivation proceeding in the Office. The petition shall set forth with particularity the **basis for finding that an individual named in an earlier application as the inventor or a joint inventor derived such invention from an individual named in the petitioner's application as the inventor or a joint inventor** and, without authorization, the earlier application claiming such invention was filed. * * *

(2) Time for filing.— A petition under this section with respect to an invention that is the same or substantially the same invention as a claim contained in a patent issued on an earlier application, or contained in an earlier application when published or deemed published under section 122(b), may not be filed unless such petition is filed **during the 1-year period following the date on which the patent containing such claim was granted or the earlier application containing such claim was published**, whichever is earlier. * * *

(post-AIA) 35 U.S.C. § 291 — Derived patents

(a) In General.— The owner of a patent may have relief by **civil action against the owner of another patent that claims the same invention and has an earlier effective filing date**, if the invention claimed in such other patent was **derived from the inventor** of the invention claimed in the patent owned by the person seeking relief under this section.

(b) Filing Limitation.— An action under this section may be filed only before the end of the **1-year period beginning on the date of the issuance of the first patent** containing a claim to the allegedly derived invention and naming an individual alleged to have derived such invention as the inventor or joint inventor.

Next time

Next time

→ Obviousness!