

Patent Law

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Class 13 – Nonobviousness:
Scope and Content of the Prior Art

Recap

Recap

- Obviousness after *KSR*
- Objective indicia of nonobviousness

Today's agenda

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- Evaluating obviousness
- Categories of prior art
- Timing of obviousness
- Analogous art

**Evaluating
obviousness**

(Post-AIA) 35 U.S.C. § 103 — Conditions for patentability; non-obvious subject matter

A patent for a claimed invention may not be obtained, notwithstanding that the claimed invention is not identically disclosed as set forth in section 102, **if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious** before the effective filing date of the claimed invention **to a person having ordinary skill in the art to which the claimed invention pertains**. Patentability shall not be negated by the manner in which the invention was made.

Evaluating obviousness

- The philosophical question: How do we know if the invention would have been obvious?
 - *Graham*: We just ask if it's obvious
 - Fed. Cir. pre-KSR: TSM test
 - *KSR*: Look for some reason to combine, or predictable results from a combination

Evaluating obviousness

- But that leaves a question: Why do we assume someone of ordinary skill in the art would know about all the prior art?

In re Winslow

- Technology: Machine for opening top bag in a stack of plastic bags
 - Gerbe: Bag-filling machine using air to open bags; bags held in place by friction
 - Hellman: Envelope-packing machine; envelopes hung vertically from rod
 - Rhoades: Bags hung from pin

In re Winslow

→ So a fairly simple mechanical invention, KSR-style:

- Gerbe + Hellman = Winslow
- But is there any reason to think Winslow would know about Gerbe or Hellman?

“We think the proper way to apply the 103 obviousness test to a case like this is to **first picture the inventor as working in his shop with the prior art references — which he is presumed to know — hanging on the walls around him**. One then notes that what applicant Winslow built here he admits is basically a Gerbe bag holder having air-blast bag opening to which he has added two bag retaining pins. If there were any bag holding problem in the Gerbe machine when plastic bags were used, their flaps being gripped only by spring pressure between the top and bottom plates, **Winslow would have said to himself, ‘Now what can I do to hold them more securely?’ Looking around the walls, he would see Hellman’s envelopes with holes in their flaps hung on a rod**. He would then say to himself, ‘Ha! I can punch holes in my bags and put a little rod (pin) through the holes. That will hold them! After filling the bags, I’ll pull them off the pins as does Hellman. Scoring the flap should make tearing easier.’”

In re Winslow, M&D at 713.

In re Winslow

- Is it fair to assume someone of ordinary skill in the art knows all the relevant prior art?

In re Winslow

- Is it fair to assume someone of ordinary skill in the art knows all the relevant prior art?
 - Researchers are presumed to do research to solve problems
 - It's impossible to know which prior art would be known and unknown
 - Risk of double patenting

Categories of prior art

(Post-AIA) 35 U.S.C. § 103 — Conditions for patentability; non-obvious subject matter

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Categories of prior art

- § 102: Specific categories of art
 - “patented”
 - “described in a printed publication”
 - “in public use”
 - “on sale”
 - &c
- § 103: just “the prior art”

Categories of prior art

- So what sorts of things count as prior art under § 103?
 - Possibly: Any § 102 art
 - Possibly: Only certain § 102 art
 - Possibly: Anything public
 - Other?

Categories of prior art

- So what sorts of things count as prior art under § 103?
 - Definitely anything covered by pre-AIA § 102(a)
 - Definitely anything covered by post-AIA § 102(a)(1)
 - Question: What about backdated patent art?

Hazeltine Research

- Mar. 1954: Wallace files application
- Dec. 1957: Regis files application
- Feb. 1958: Wallace patent issues
- June 1959: Examiner rejects Regis application as obvious in view of Wallace

Hazeltine Research

→ What does § 103 say about this?

(Pre-AIA) 35 U.S.C. § 103 — Conditions for patentability; non-obvious subject matter

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102, if **the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made** to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made. * * *

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Hazeltine Research

→ What does § 103 say about this?

- Can something be obvious to a person of ordinary skill in the art in view of secret prior art?

Hazeltine Research

- Despite the text of § 103, the Court applies *Milburn*
- How strong is the Court's policy argument?
 - If we care about incentives?
 - If we care about fairness?
 - If we care about double patenting?

Timing of
obviousness

Timing of obviousness

- The timing rules of § 103 seem fairly straightforward:
 - Pre-AIA: § 103 art must predate invention
 - Post-AIA: § 103 art must predate filing
- In practice, can be more complex

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Pre-AIA § 103 timing: *In re Foster*

- Dec. 1952: Foster invents
- Aug. 1954: Binder article
- Aug. 1956: Foster files application
- **Result under § 102 if Binder article anticipated?**

Pre-AIA § 103 timing: *In re Foster*

- Dec. 1952: Foster invents
- Aug. 1954: Binder article
- Aug. 1956: Foster files application
- Result under § 102 if Binder article anticipated?
 - Binder post-dates invention but comes more than a year before application, so prior art under § 102(b) statutory bar

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Pre-AIA § 103 timing: *In re Foster*

- Dec. 1952: Foster invents
- Aug. 1954: Binder article
- Aug. 1956: Foster files application
- Result under § 103 if Binder article renders the Foster invention obvious?
 - Under the text, it wasn't obvious as of the invention date, so Foster gets the patent
 - But, Foster: Foster doesn't get the patent

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Pre-AIA § 103 timing: *In re Foster*

- Maybe the statute implicitly reads
“at the time the invention was made
or one year before the filing date”
- Maybe § 102(b) has an implicit
built-in obviousness bar
- Maybe other?

Pre-AIA § 103 timing: *In re Foster*

- Is this a good policy outcome?

Pre-AIA § 103 timing: *In re Foster*

→ Is this a good policy outcome?

- It prevents double patenting
- It encourages prompt filing
- It seems to basically fix a bug in the law

Post-AIA § 103 timing

→ (This one hasn't been litigated yet)

→ Jan. 2014: I invent X and Y

→ July 2014: I publish an article describing X

→ Mar. 2015: I file a patent claiming X and Y

→ Can I get a patent on X under § 102?

Post-AIA § 103 timing

- (This one hasn't been litigated yet)
- Jan. 2014: I invent X and Y
- July 2014: I publish an article describing X
- Mar. 2015: I file a patent claiming X and Y
- Can I get a patent on X under § 102?
 - My disclosure in July 2014 is carved out, so I can get a patent on X

Post-AIA § 103 timing

- (This one hasn't been litigated yet)
- Jan. 2014: I invent X and Y
- July 2014: I publish an article describing X
- Mar. 2015: I file a patent claiming X and Y
- Can I get a patent on Y under § 103, if X renders Y obvious?

Post-AIA § 103 timing

- (This one hasn't been litigated yet)
- Jan. 2014: I invent X and Y
- July 2014: I publish an article describing X
- Mar. 2015: I file a patent claiming X and Y
- Can I get a patent on Y under § 103, if X renders Y obvious?
 - Text: It was obvious as of filing, so no
 - But: There must be an implicit exception in what counts as § 103 "prior art"

Analogous art

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Analogous art

- Novelty: all prior art is relevant
- Obviousness: prior art is relevant only if it's from the same field, or is related
 - **Why?**

Analogous art

- Two kinds of relevant prior art
 - Prior art that's from the same field of endeavor, regardless of the problem it exists to solve
 - Prior art that is reasonably pertinent to the specific problem the inventor is trying to solve, regardless of the field
- The problem: how broadly to define the "problem" the inventor is trying to solve

In re Clay

- Patent: method of filling empty space in an oil tank with a gel



In re Clay

- Prior art: method of filling empty space with air-filled bladders
- Prior art: method of filling underground cavities in oil-producing areas with a gel

In re Clay

- Court: underground gel is not analogous prior art
 - Different fields: exploration versus storage
 - Different problem: streamlining underground formations to cause oil to flow more easily, not filling empty space in storage

In re Clay

- The problem: At what level of generality do we consider the “field of endeavor” and “problem” the inventor is solving?

In re Clay

- *Wang Laboratories v. Toshiba*: Prior-art memory module used in large machinery was not analogous art for memory module for personal computers

In re Clay

- *George J. Meyer Mfg. Co. v. San Marino Electronic Corp.*: Circuit for tracking stars and missiles was analogous art for circuit designed to inspect bottles to detect foreign objects

Next time

Next time

→ Utility