Patent Law

Prof. Roger Ford
September 28, 2016
Class 7 – Novelty:
(AIA) § 102(a)(1) prior art

Recap

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- → Novelty: introduction
- → Anticipation: the basics
- → Accidental anticipation

Today's agenda

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→ Novelty framework

→ (AIA) § 102(a)(1) prior art:

- "printed publication"
- "patented"
- "in public use"
- ~~"on sale"~~
- ~~"otherwise available to the public"~~

Novelty framework

Novelty: introduction

→ Novelty as a four-step process:

- Which law applies? (Pre-AIA or post-AIA)
- Does a reference qualify as prior art under a subsection of § 102?
- What are the effective date of the prior-art reference and the critical date of the patent?
- Does the information disclosed in the prior-art reference anticipate the patent claim(s)?

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(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

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(b) Exceptions.—

* * *

Novelty framework

→ Relevant prior-art references (post-AIA):

- § 102(a)(1): things "patented"
- § 102(a)(1): things "described in a printed publication"
- § 102(a)(1): things "in public use, on sale, or otherwise available to the public"
- …

(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

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Novelty framework

→ Today:

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(AIA) § 102(a) prior art

‘printed publication’

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In re Klopfenstein

→ Patent: extruded soy cotyledon fiber (yum!)

→ What is the prior art at issue?

In re Klopfenstein

→ Patent: extruded soy cotyledon fiber (yum!)

→ What is the prior art at issue?

- Presentation at academic conference
- 14 slides on a poster
- Shown continually for 2.5 days (at AACC) and less than a day (at KSU)

In re Klopfenstein

→ Complications / caveats:

- Pre-AIA rule – but "printed publication" is presumed to mean the same thing today
- Presentation by inventors – so a § 102(b) statutory-bar case, not a novelty case

In re Klopfenstein

→ So how on earth is this a publication?

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

Oxford English Dictionary meanings for "publication":

1. a. The action of making something publicly known; public notification or announcement; an instance of this.

b. *Law.* **Notification or communication to a third party or to a limited number of people regarded as representative of the public**; an instance of this; spec. (*a*) execution of a will before witnesses; (*b*) communication of defamatory words to a person or persons other than the person or organization defamed.

2. a. The issuing of a book, newspaper, magazine, or other printed matter for public sale or distribution; **the action of making material publicly accessible or available in electronic form**; an instance of this.

b. **A published work; a book, newspaper, etc., produced and issued for public sale or distribution; a text made publicly accessible or available in electronic form**.

3. The action or fact of making a thing public or common property.

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

→ 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

→ Why interpret "printed publication" so broadly?

In re Klopfenstein

→ Why interpret "printed publication" so broadly?

- "the entire purpose of the 'printed publication' bar was to 'prevent withdrawal' of disclosures 'already in the possession of the public' by the issuance of the patent"
- Catch-all provision: "otherwise available to the public"
- Maybe publications are more reliable sources of evidence than other kinds that might be used more often absent a broad "publication" rule

'patented'

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(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

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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

Reeves Bros. v. US Laminating Corp.

→ Prior art: German Gebrauchsmuster (utility model)

- Limited rights upon registration
- Registered, not examined
- Available to the public

Reeves Bros. v. US Laminating Corp.

→ "The GM was not a printed publication at any time"

- But, some have been treated as printed publications

→ Secret patents (!) – not prior art

- Under the stature, no reason to disregard
- But we do, because they don't satisfy the patent bargain

"in public use"

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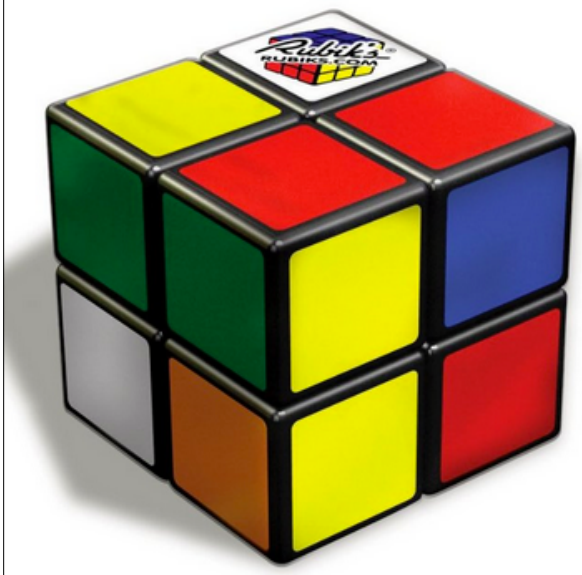
Moleculon Research



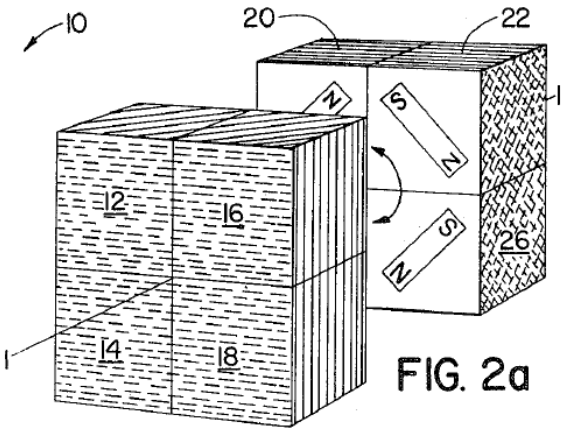


FIG. 2a

Moleculon Research

→ 1957: Nichols conceives of toy

→ 1957–62: Nichols constructs paper models

→ 1968: Nichols constructs wooden model

→ January 1969: Nichols agrees to assign rights to Moleculon

→ March 7, 1969: Nichols sends model to Parker Brothers

→ March 3, 1970: Nichols files patent application

Moleculon Research

→ Possible prior-art disclosures:

- Nichols showing model to coworkers
- Nichols assigning rights to Moleculon
- Nichols offering license to Parker Bros.

→ Nichols "retained control over the puzzle's use and the distribution of information concerning it"

→ Are any of these "public use"?

Moleculon Research

→ Consistent with *Beachcombers?*

Moleculon Research

→ What if I rent a booth at a trade show and demo my invention to everyone, but the trade show has a no-photos rule?

→ What if I put my booth behind a curtain and make visitors sign non-disclosure agreements?

→ What if I give a lecture?

Moleculon Research

→ On sale:

- Nichols contacting game manufacturers
- Nichols assigning rights to Moleculon

→ Transferring rights is not the same thing as selling the individual invention

Moleculon Research

→ But what if he had transferred the prototype to Moleculon?

Moleculon Research

→ But what if he had transferred the prototype to Moleculon?

- Maybe we care about how long consumers have to pay monopoly prices
- Maybe we want a rule, not a standard
- Maybe a limited sale to one person doesn't count

Metallizing Eng'g Co. v. Kenyon Bearing

→ Possible public use?

- Use to make products that are sold to the public
- Even though the public can't figure out the patented process

Metallizing Eng'g Co. v. Kenyon Bearing

→ Complication / caveat:

- Use by inventors – so a § 102(b) statutory-bar case, not a novelty case

Metallizing Eng'g Co. v. Kenyon Bearing

→ What's the problem for society with what Meduna did?

Metallizing Eng'g Co. v. Kenyon Bearing

→ What's the problem for society with what Meduna did?

- Letting someone use a process and later patent it extends the monopoly

Metallizing Eng'g Co. v. Kenyon Bearing

→ Court: this is a "public use" even though it was secret

- Trade-secret uses can be public uses, if they're used to manufacture products for sale to the public

→ How is this public?

Metallizing Eng'g Co. v. Kenyon Bearing

→ So: We have two different rules for trade secrets!

- Trade-secret use by the inventor can be a public use
- Trade-secret use by others is not a public use

→ Why the difference?

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* * *

Next time

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→ More novelty!