

CLASS 6

THE NOVELTY REQUIREMENT II

PATENT LAW & POLICY
PROFESSOR WAGNER



Today's Agenda

First to Invent: Overview

First to File (New Law)

Exceptions and Exclusions

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First to Invent Overview

Current 35 USC 102(g) | Until March 2013

§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 ... another inventor involved therein establishes ... 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.

§102(g) (continued) ...

.... 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.

First to Invent

The Rules of Priority

Rule: First to reduce to practice = priority

Exception A: Prior conception + diligence until reduction to practice.

Exception B: The original inventor abandons, suppresses, or conceals her invention.

The Rules of Priority

	Inventor A	Inventor B
Conception	Jan. 1, 2001	Jan. 4, 2001
Reduction to Practice	Jan. 2, 2001	Jan. 5, 2001
Filing Date	Jan. 3, 2001	Jan. 6, 2001

The Rules of Priority

	Inventor A	Inventor B
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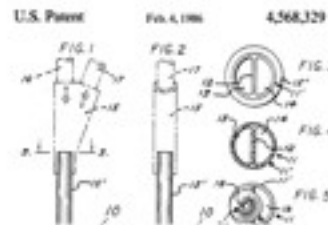
The Rules of Priority

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The Rules of Priority

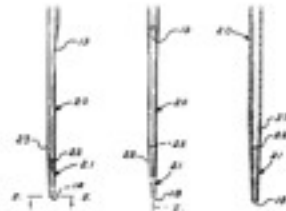
	Inventor A	Inventor B
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United States Patent 4,568,329
 Mahurkar
 Filed: 1983-01-11
 Date of Patent: 1983-01-11

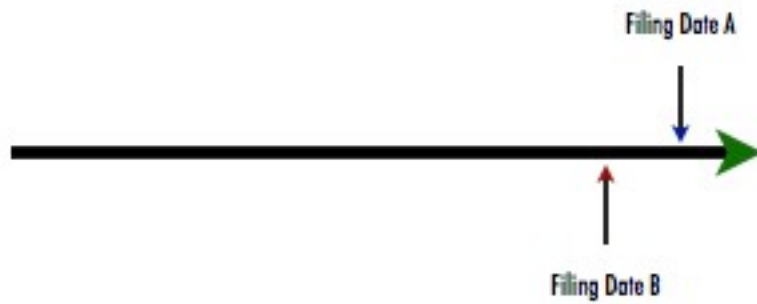


Mahurkar v. CR Bard (1996)

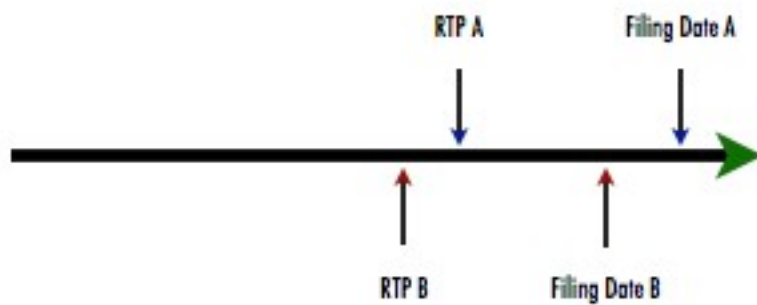
U.S. Patent 4,568,329
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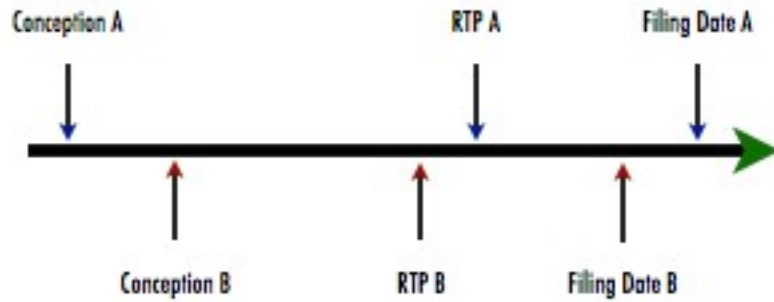
A Priority Timeline



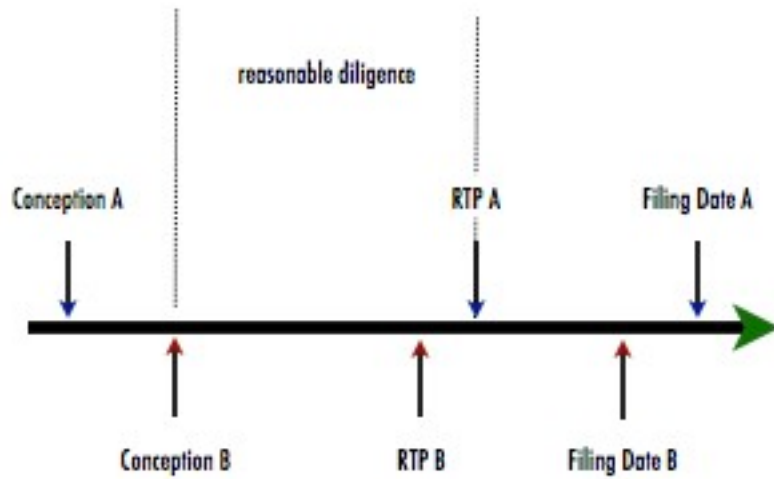
A Priority Timeline



A Priority Timeline



A Priority Timeline



Note the corroboration requirement.
Why?

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First to File

New 35 USC 102 | After March 2013

§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.

New 35 USC 102 | After March 2013

§102. Conditions for patentability; novelty

(a) NOVELTY; PRIOR ART.—A person shall be entitled to a patent unless—

No more 102(g) "rules of priority"
(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.

New 35 USC 102 | After March 2013

§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 or after **Filing Date A** in a country or territory in which the invention was known 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.

Filing Date B

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First to File

New 35 USC 102 | After March 2013

§102. Conditions for patentability; novelty

(b) EXCEPTIONS.—

(1) DISCLOSURES MADE 1 YEAR OR LESS BEFORE THE EFFECTIVE FILING DATE OF THE CLAIMED INVENTION.—A disclosure made 1 year or less before the effective filing date of a claimed invention shall not be prior art to the claimed invention under subsection (a)(1) if—

(A) the disclosure was made by the inventor or joint inventor or by another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor; or

(B) the subject matter disclosed had, before such disclosure, been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor.

New 35 USC 102 | After March 2013

§102. Conditions for patentability; novelty

(b) EXCEPTIONS.—

(1) DISCLOSURES MADE 1 YEAR OR LESS BEFORE THE EFFECTIVE FILING DATE OF THE CLAIMED INVENTION.—A disclosure made 1 year or less before the effective filing date of a claimed invention shall not be prior art to the claimed invention under subsection (a)(1) if—

Filing Date

(A) the disclosure was made by the inventor or joint inventor or by another who obtained the subject matter disclosed directly or indirectly from the inventor or a

(B) the subject matter disclosed had, before such disclosure, been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor.

(A) Disclosures by the inventor [from inventor]

(B) Disclosures by others [from inventor, published first]

New 35 USC 102 | After March 2013

§102. Conditions for patentability; novelty

(b) EXCEPTIONS.—

(2) DISCLOSURES APPEARING IN APPLICATIONS AND PATENTS.—A disclosure shall not be prior art to a claimed invention under subsection (a) (2) if—

(A) the subject matter disclosed was obtained directly or indirectly from the inventor or a joint inventor;

(B) the subject matter disclosed had, before such subject matter was effectively filed under subsection (a) (2), been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor; or

(C) the subject matter disclosed and the claimed invention, not later than the effective filing date of the claimed invention, were owned by the same person or subject to an obligation of assignment to the same person.

New 35 USC 102 | After March 2013

§102. Conditions for patentability; novelty

(b) EXCEPTIONS.—

(2) DISCLOSURES APPEARING IN APPLICATIONS AND PATENTS.—A disclosure shall not be prior art to a claimed invention under subsection (a) (2) if—

(A) the subject matter disclosed was obtained directly or indirectly from the inventor or a joint inventor;

(B) the subject matter disclosed had, before such subject matter was effectively filed under subsection (a) (2), been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor; or

(C) the subject matter disclosed and the claimed invention, not later than the effective filing date of the claimed invention, were owned by the same person or subject to an obligation of assignment to the same person.

a 'derivation' defense of prior art

New 35 USC 102 | After March 2013

§102. Conditions for patentability; novelty

(b) EXCEPTIONS.—

(2) DISCLOSURES APPEARING IN APPLICATIONS AND PATENTS.—A disclosure shall not be prior art to a claimed invention under subsection (a) (2) if—

(A) the subject matter disclosed was obtained directly or indirectly from the inventor or a joint inventor; or
[similar to earlier exception: prior disclosure by inventor]

(B) the subject matter disclosed had, before such subject matter was effectively filed under subsection (a) (2), been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor; or

(C) the subject matter disclosed and the claimed invention, not later than the effective filing date of the claimed invention, were owned by the same person or subject to an obligation of assignment to the same person.

New 35 USC 102 | After March 2013

§102. Conditions for patentability; novelty

(b) EXCEPTIONS.—

(2) DISCLOSURES APPEARING IN APPLICATIONS AND PATENTS.—A disclosure shall not be prior art to a claimed invention under subsection (a) (2) if—

(A) the subject matter disclosed was obtained directly or indirectly from the inventor or a joint inventor;

(B) the subject matter disclosed had, before such subject matter was effectively filed under subsection (a) (2), been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor; or
[common ownership exception]

(C) the subject matter disclosed and the claimed invention, not later than the effective filing date of the claimed invention, were owned by the same person or subject to an obligation of assignment to the same person.

NEXT CLASS

NONOBVIOUSNESS I

PATENT LAW & POLICY
PROFESSOR WAGNER

