The Novelty Requirement I

Class Notes: February 3, 2003

Law 677 | Patent Law | Spring 2003
Professor Wagner
Today’s Agenda

1. The Date of Invention

2. Anticipation

3. "Known or Used"

4. "Patented or Described in a Printed Publication"

5. Secret Prior Art
Date of Invention

Basic point: § 102 seeks to prevent patents on inventions that are not “new” or “novel” at the time of invention.

35 U.S.C. § 102
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 . . .
The Date of Invention

Mahurkar v CR Bard (Fed. Cir. 1996) (Rader)

• Who bears the burden of proof on:
  o The invalidity of the patent
  o The date of invention

• What is your date of invention if you cannot provide other evidence?

• Why require corroboration of dates of invention?

• Explain:
  o Conception
  o Reduction to practice
The Date of Invention

Hypothetical:

- **Conception:** August 1980
- **Reduction to Practice:** August 1981
- **Filing Date:** August 1982

Which of the following are “good” prior art:

- a) Publication date: July 1983
- b) Publication date: July 1982
- c) Publication date: July 1981
- d) Publication date: July 1980
Anticipation

“Anticipation” has two basic components:

1. Description of all elements of the claim
2. Description sufficient to enable the claim

Minnesota Mining & Mfg v Johnson & Johnson (Fed. Cir. 1992) (Rich)

Why is claim construction important to the analysis?
Anticipation

*In re Paulsen* (Fed. Cir. 1994) (Lourie)

Invention:
1. Portable computer / calculator
2. “clamshell” configuration

Yokoyama reference:
1. Box for calculator, with clamshell configuration

Why does the Yokoyama reference anticipate the invention? (Does it enable the invention?)

So the “single reference” requirement:

*Everything disclosed in a single reference + everything within the knowledge of POSITA*
"Known or Used"

**Gayler v Wilder (1850)**
- Why did the Connor safe not anticipate the invention?
- What is the policy here? Is this the right choice?

**Rosaire v Baroid Sales Division (5th Cir. 1955)**
- Why does the Teplitz process anticipate?
- How do you reconcile this with Gayler?

**Why do you think this is limited to the U.S.?**
“Patented or Described”

*In re Hall* (Fed. Cir. 1986)

Why is the (unpublished) doctoral thesis a “printed publication”?

What is the “touchstone” of a printed publication?

*In re Cronyn* (Fed. Cir. 1989)

Why are the (unpublished) theses not “printed publications”?
102(e) Prior Art

35 U.S.C. § 102. - Conditions for patentability; novelty and loss of right to patent

(e) the invention was described in —

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent ...
35 U.S.C. § 102(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.
Secret Prior Art [102(g)]

How can it be said that 102(g) “opens up” the possibilities for prior art?

*Thomson v Quixote Corp.* (Fed. Cir. 1999)

Why generally require corroboration?

Why is no corroboration required here?

Would *Gayler* still yield the same result under 102(g)?
Next Class

The Novelty Requirement II

Derivation

Priority