Patent 3

http://wendy.seltzer.org/neu/IP/

Patent litigation

- A defendant accused of patent infringement will typically argue both
  - Invalidity
    - The patent fails one of the statutory criteria, and therefore cannot be infringed.
  - Non-infringement
    - Even if the patent were valid, my activities do not infringe because my product/process does not contain all elements of any patent claim.
- Contrast with copyright:
  - Validity is a major issue in patent cases, minor in copyright suits

Requirements for a Valid Patent

- *Patentable subject matter*
- **Novelty**
- *Utility*
- Non-obviousness
- *Enablement*

Novelty

- "New" compared to prior art
  - Inventor got there first
  - Not "anticipated" in whole by prior art
- Not subject to statutory bar
  - Inventor got to the patent office in time

35 U.S.C. § 102(a): Novelty

- (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

35 U.S.C. § 102(b): Statutory Bar

- (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

Prior Use

- 102(a) "known or used by others in this country" before invention by the applicant?
  - *Rosaire v. National Lead Co.*
    - 1935-36: Teplitz used method
    - 1936: Rosaire and Horvitz claim invention, apply for patent
    - [1939 Gulf applies for patent on Teplitz work]
    - *Is Rosaire's patent good?*
      - *Not novel based on Teplitz's prior public use*

Prior Use

- Known or used by others
  - Prior art can be non-patent, need never have sought patent protection
  - Available to the public
  - PHOSITA could reduce to practice
  - To anticipate, single reference must disclose all elements of the claimed invention

Printed Publication

- 102(b) "the invention was … described in a printed publication … more than one year prior to the date of the application"
  - *In re Hall*
    - 1977: Foldi thesis put on library shelves, Freiburg University, Germany, describing Hall's invention
    - 1979: Hall applies for patent
    - *Is Hall's patent good?*

Printed Publication

- Publication "accessible to the public"

Public Use

- 102(b) "the invention was … in public use … more than one year prior to the date of the application"
  - *Egbert v. Lippmann*
    - 1855: Inventor Barnes gave corset steels to fiancee
      - "Inventor slept on his rights"
    - 1866: Barnes seeks patent on corset steels
    - *Is Barnes's patent good?*

Public use

- Use of one embodiment is enough
- Use by one person other than inventor
- Not necessary that it be visible!
- But
  - Use under a promise of secrecy is not public
  - Use for experimental purposes may not be public

Experimental Use

- *City of Elizabeth v. Pavement Co.*
  - 1848: Pavement Co. builds "new and improved wooden pavement" in Boston
  - 1854: Pavement Co. files patent for pavement
  - *Is Pavement Co.'s patent good?*
    - *public use or sale?*

On Sale

- No patent if inventor commercializes more than a year before filing
- Definite sale or offer to sell
  - Either the invention or something that makes the invention obvious
- Sale for profit, not experimentation

Priority, 102(g)

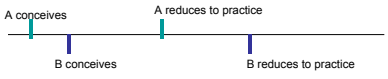
- Patent generally goes to the first inventor to reduce invention to practice
- But,
  - if rival was first to conceive and
  - that rival exercises "reasonable diligence" in reducing invention to practice

  Rival may be entitled to patent

35 U.S.C. § 102(g): Priority

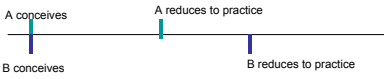
- (g) (1) during the course of an *interference* … another inventor involved therein establishes, to the extent permitted in section 104, that before such person's invention thereof the invention was made by such other inventor and not abandoned, suppressed, or concealed, or
- (2) before such person's 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.

Timeline 1



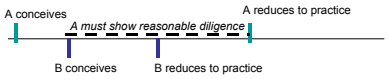
A was both first to conceive and reduce to practice

Timeline 2



A reduced to practice first

Timeline 3



A gets patent only if he shows reasonable diligence

Conception

- Question of law
- Formulating the complete solution to a problem
- With sufficient detail so a PHOSITA can reduce it to practice without further experimentation

PHOSITA=
Person Having Ordinary Skill In The Art

Reduction to Practice

- Actual:
  - Physical embodiment
  - Complete embodiment
  - Testing sufficient to demonstrate utility and success
- Constructive: Patent Application

Diligence

- Either actual activity or a legitimate excuse during the entire relevant period
- Inventor charged with his/her attorney's diligence or laxity in filing the patent application

Griffith v. Kanamaru