Patent 4

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

Requirements for a Valid Patent

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

§ 103: Non-obviousness

- 103. (a) A patent may not be obtained *though the invention is not identically disclosed or described as set forth in section 102 of this title,* 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 negatived by the manner in which the invention was made.

How does non-obviousness differ from novelty?

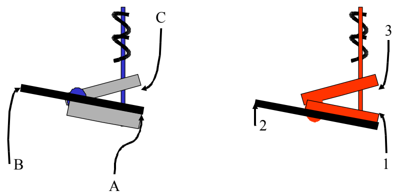
- Obvious at the time the invention was made to a "person having ordinary skill in the art" (PHOSITA)
- Obviousness can come from incremental improvements, or combining prior art references, if it would occur to the PHOSITA to do so
- Question of law, based on fact

Nonobviousness

- *Graham v. John Deere Co.*
  - 1950: Graham patents one version of plowshank, '811
  - 1953: Graham modifies '811 shank and applies for new patent, '798

Graham's new design was unquestionably not the same as the prior patent. Why wasn't the new patent valid?

Is it obvious to move the hinge plate from position A under the shank to position 1 above the shank?



Graham v. John Deere Co.

- "..to develop some means of weeding out those inventions which would not be disclosed or devised but for the inducement of a patent."
- Distinguish the "skilful mechanic" from the inventor

- Patent gives exclusive rights to
  - Invention
    - All the elements of a given claim
  - equivalents

Obviousness: Graham

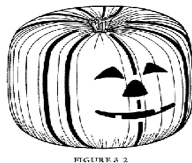
- Scope and content of the prior art
  - Patent, non-patent – for obviousness, places the PHOSITA would be expected to look
- Difference between prior art and claims
- Level of ordinary skill in the prior art
- *Secondary factors*
  - Commercial success
  - Long-felt but unsolved needs
  - Failure of others

Combining References

- *What if two different pieces of prior art together suggest invention?*
- *In re Vacek*
  - Dzelakalns teaches chimeric gene in cyanobacteria
  - Sekar I and II and Ganesan teach Bacillus insecticide
  - *is Bacillus insecticide* ***in cyanobacteria*** *obvious?*
- Combination of prior art references is obvious *if*
  - prior art would have suggested to PHOSITA
  - prior art would have shown reasonable expectation of success (motivation)

In re Dembiczak

- Solving "the long-standing problem of unsightly trash bags placed on the curbs of America"
- Avoiding the "tempting but forbidden zone of hindsight"



Non-obviousness

- invention v. ordinary skill and common sense
- Teaching, suggestion, or motivation to combine references?
- Avoid hindsight bias

Patent rights

- § 271. (a) Except as otherwise provided in this title, whoever without authority makes, uses, offers to sell, or sells any patented invention, within the United States or imports into the United States any patented invention during the term of the patent therefor, infringes the patent.

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Infringement varies by patent type

- Machine or device: similarity of means, mode, and results of operation
- Composition of matter: replication of ingredients in approximately the same proportions
- Process patents: replication of each step of the patent in approximately the same order

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Infringement

- Literal
  - Patent claims A, B, C; accused does A, B, C
  - Unless reverse equivalents (rare)
- By Equivalents
  - Patent claims A, B, C; accused does A, B, X
  - X is only insignificant variation on C
    - Same function, way, result
    - Even later-developed technology
  - Equivalents limited by prior art, prosecution history estoppel
  - Range of equivalents larger for breakthrough patents

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Literal infringement

- Accused product or process contains every element of a patent claim
  - Does it have to infringe all patent claims?
- What do the claims mean?
  - Claim construction is a matter of law
  - “Markman hearings”

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Phillips v. AWH Corp.

- Baffled by “baffles”?

What is claimed is:

1. Building modules adapted to fit together for construction of fire, sound and impact resistant security barriers and rooms for use in securing records and persons, comprising in combination, an outer shell of substantially parallelepiped shaped with two outer steel plate panel sections of greater surface area serving as inner and outer walls for a structure when a plurality of the modules are fitted together, sealant means spacing the two panel sections from steel to steel contact with each other by a thermal-acoustical barrier material, and further means disposed inside the shell for increasing its load bearing capacity comprising internal steel baffles extending inwardly from the steel shell walls.

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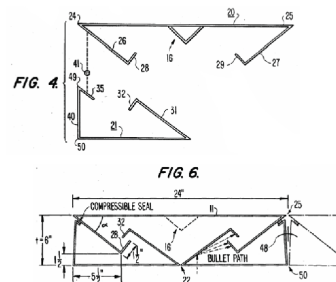

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Sources of claim construction

- Intrinsic evidence
  - Claims
  - Specification
  - Prosecution history
- [to be continued]

Phillips v. AWH Corp.

- **Steel shell modules for prisoner detention facilities,** Edward H. Phillips
- Patent 4,677,798
- http://www.google.com/patents?id=5k8rAAAAEBAJ&dq=4677798