Invention & Industry
Patent

Patent Novelty

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Novelty: Key Points

- Understand that there are different kinds of novelty.
- Judge novelty by comparing patentee/ applicant's claims to prior art.
- Be able to apply §102(a) & (b) from the America Invents Act of 2011 (AIA).
- Understand that the old §102 applies to most current patents, and it can have surprising differences.

Different senses of "novelty" or "newness"

- Anticipation – The invention was already known to the public (i.e., it is in the prior art). Pre-AIA §102(a)&(e).
- Priority – Where there are two applicants, only one has priority and will get the patent. Pre-AIA §102(g).
- Statutory Bars – Patentees can lose their right to a patent by waiting too long after a public disclosure. Pre-AIA §102(b).
- Derivation – The applicant must be the true inventor – she or he cannot have derived it from someone else. Pre-AIA §102(f).

Different senses of "novelty" or "newness"

- A
- P
- S
- D

But things have changed …

In AIA version of §102, the concepts of *anticipation*, *priority*, and *statutory bars* are all collapsed into a unitary framework, which you just have to work through. It combines all those senses of newness into a one algorithm.

The derivation concept is no longer expressly addressed in the AIA version, but it can be implied from other provisions and is considered fundamental to the whole patent scheme.

35 U.S.C. §102 Conditions for patentability; novelty.
As amended by the America Invents Act of 2011
Effective for applications filed on or after March 16, 2013

(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.

(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. …

Gravity Shield

NOVELTY PROBLEM

Pilar in Peru

Pilar invented the gravity shield in Peru in January 2014 and publicly used it there. Pilar never files a patent application anywhere.

In February 2014, without knowledge of Pilar's invention, Gareth invents the gravity shield and files for a patent.

Can Gareth get the patent?

NO → The public use in Peru bars Gareth from getting a patent.

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

Under the 1952 Patent Act

Effective for applications filed on or before March 15, 2013

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 …

NOVELTY PROBLEM

Pilar in Peru – *2012 variation*

Pilar invented the gravity shield in Peru in January 2012 and publicly used it there. Pilar never files a patent application anywhere.

In February 2012, without knowledge of Pilar's invention, Gareth invents the gravity shield and files for a patent.

Can Gareth get the patent?

YES → There is no bar caused by public use in in a foreign country.

NOVELTY PROBLEM

Rafiq in Arizona

Rafiq invented the gravity shield in Arizona in June 2014 and made no disclosures. In August 2014, Theresa independently invented the gravity shield in Vermont. She disclosed it in September 2014. Rafiq files a patent application in February 2015. Theresa files her application in March 2015. What result?

Rafiq does not get a patent. **Theresa does get a patent.** → Rafiq is barred under §102(a)(1) and no exception applies. Theresa would be barred under §102(a)(1), but the exception of §102(b)(1)(A) applies to her.

Problems adapted from "PRIOR ART PROBLEMS UNDER AIA AND PROPOSED SOLUTIONS" by Prof. Paul M. Janicke and Prof. Lisa A. Dolak.

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