Industry & Invention
Patent

Utility Patents
Novelty

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Novelty: Key Points

- Understand that there are different kinds of novelty.
- Judge novelty by comparing the patentee/applicant's claims to the prior art.
- Be able to apply § 102(a) & (b) from the America Invents Act of 2011 (AIA).
- Understand that the old § 102 applies to a large number of current patents (very roughly half of them), 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"

- Anticipation – The i…
- …
- …
- …

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 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. …

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Gravity Shield

NOVELTY PROBLEM

Pilar in Peru

Pilar invented the gravity shield in Peru in January 2019 and publicly used it there. Pilar never files a patent application anywhere.

In February 2019, without knowledge of Pilar's invention, Gareth invented the gravity shield and filed for a patent.

Can Gareth get the patent?

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Can Gareth get the patent?

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

NOVELTY PROBLEM

Pilar in Peru – *2012 variation*

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35 U.S.C. § 102 Conditions for patentability; novelty.
As 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 …

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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 invented the gravity shield and filed 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 2017 and made no disclosures. In August 2017, Theresa independently invented the gravity shield in Vermont. She disclosed it in September 2017. Rafiq files a patent application in February 2018. Theresa files her application in March 2018. What result?

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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.

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In other words, the AIA is not *completely* "first to file"

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Invention Priority in Patents Under Pre-AIA Rules

Basics of invention priority pre-AIA

- interference
  - procedure by which priority is determined
  - between two pending applications or a pending application and an issued patent
- "first to invent" wins priority
  - (vs. "first to file" under AIA)
- "invention" starts with "conception" and is completed upon "reduction to practice"
- determining "conception" and "reduction to practice" are questions of law

35 U.S.C. § 102(g) (pre-AIA)

(g)(1) during the course of an interference … another inventor … that before such person's invention thereof the invention was made by such other inventor and not abandoned, suppressed, or concealed … 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.

Conception

Conception is the "formation in the mind of the inventor, of a definite and permanent idea of the complete and operative invention, as it is hereafter to be applied in practice."

Hybritech Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367 (Fed. Cir. 1986)

Reduction to practice

- **actual** – by building and testing a physical embodiment demonstrating "that the claimed invention work for its intended purpose"
- **constructive** – by filing a patent application

Invention Priority Rules

1. First to RTP is generally the first to invent
2. Filing date is presumed invention date (RTP_c)
   - **But**, an inventor can use evidence to establish a pre-filing invention date as of RTP_a
3. Second to RTP may nonetheless prevail by proving:
   - conception prior to other's conception, **and**
   - diligent effort toward actual or constructive RTP from a time prior to the rival's conception

Invention Priority Rules

4. The first inventor by actual RTP date loses that date for priority purposes if they later abandon, suppress, or conceal the invention.
   - The inventor thereby having lost the benefit of the actual RTP date is entitled to the resumption date as the invention date
5. If an inventor's conception is derived from another person, that other person is entitled to priority, regardless of who reduced the invention to practice.

Limitations

- ✓ Activity outside the United States cannot be relied upon to establish conception or RTP dates.
- ✓ Evidence of conception and RTP dates must be corroborated. Testimony of the inventor's recollection alone is legally insufficient to establish conception or RTP dates.

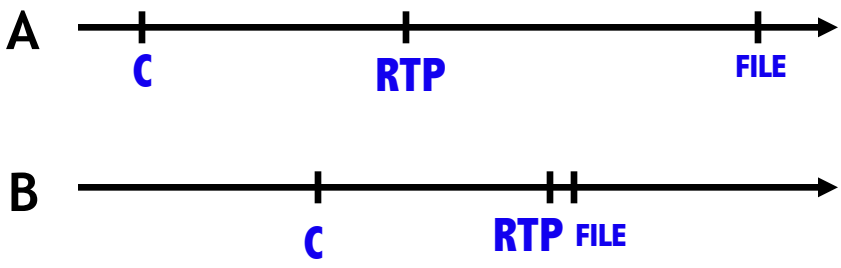
QUADRALITHIUM FLOCCULATOR

Who wins priority?

- Annabeth conceived of the quadralithium flocculator on January 10, 2010, reduced the flocculator to practice on June 5, 2010, and filed for a patent on October 13, 2010.
- Barry conceived of the quadralithium flocculator on February 28, 2010, reduced the flocculator to practice on August 8, 2010, and filed a patent application on August 9, 2010.

QUADRALITHIUM FLOCCULATOR

Who wins priority?



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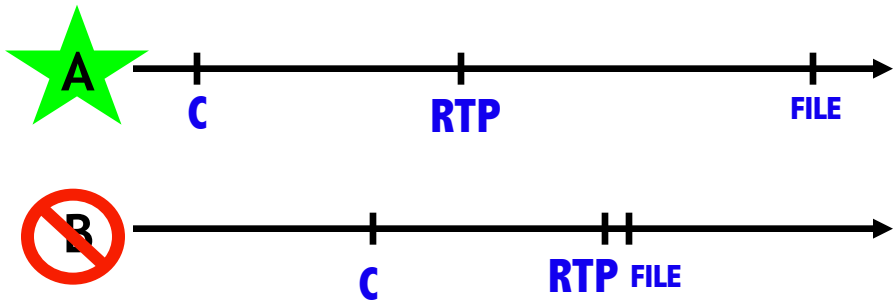

Annabeth wins.

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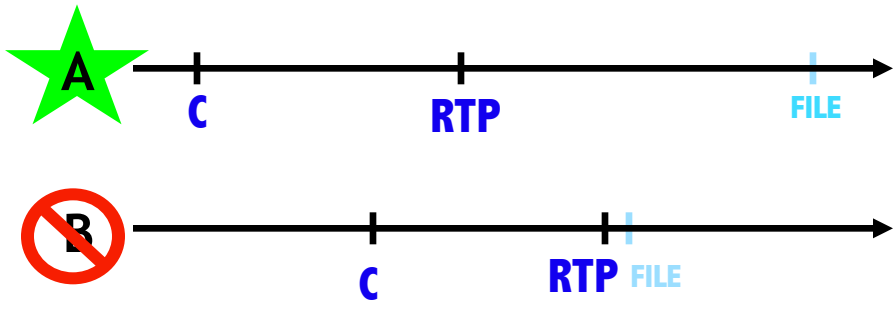


Annabeth wins.

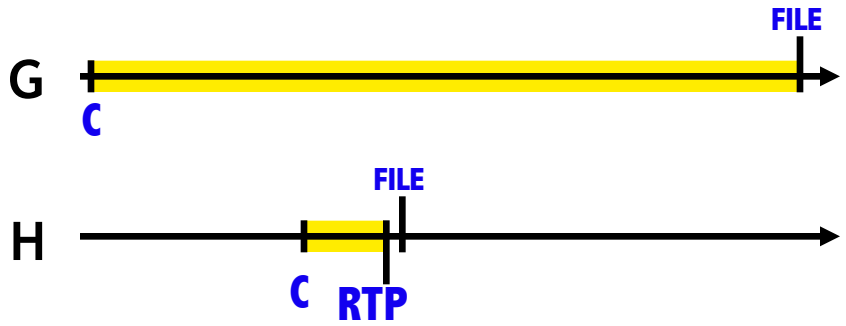
MAGNETRON

Who wins priority?

- Gretchen conceived of the magnetron on February 1, 1999. She worked diligently and continuously to reduce the magnetron to practice. Although she still hasn't completed a working prototype, she filed a patent application on October 10, 2010.
- Haila conceived of the magnetron on February 28, 2004 and worked diligently until she built a working model on March 15, 2004. She filed a patent application on April 13, 2004.

MAGNETRON

Who wins priority?



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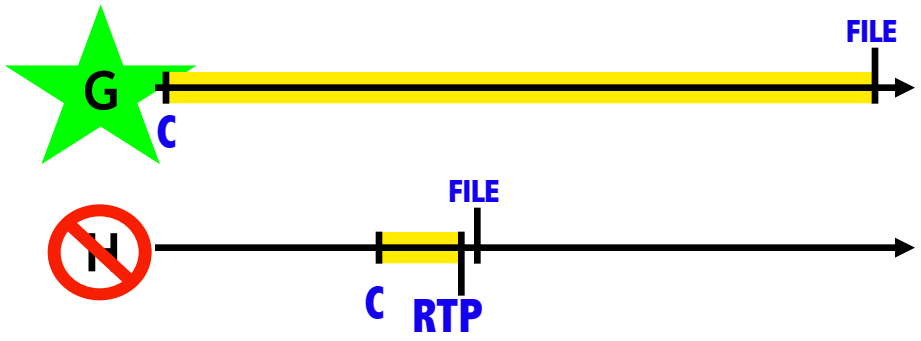
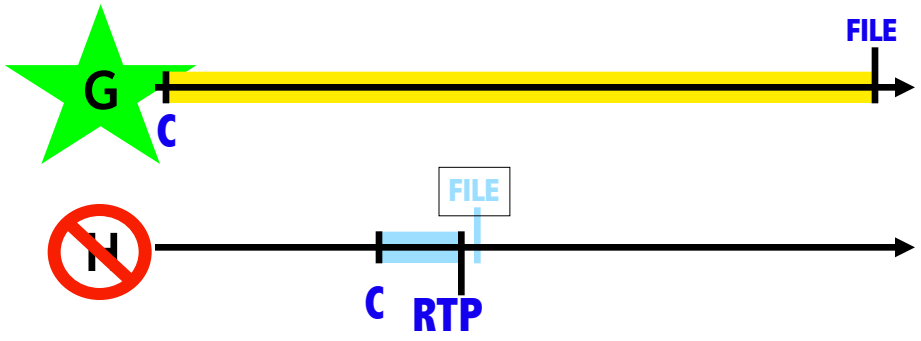


Gretchen wins.

MAGNETRON

Who wins priority?



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