Utility Patents
Novelty

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Five requirements for a valid patent:

- Patentable subject matter
- Novelty
- Utility
- Nonobviousness
- Enablement

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- **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).

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- **Derivation** – The applicant must be the true inventor – she or he cannot have derived it from someone else. Pre-AIA § 102(f).

Pre-AIA, these different senses of novelty resided in different sections of § 102.

But post-AIA, things have changed …

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

The <u>derivation</u> concept is no longer expressly addressed in the AIA version of § 102, but it <u>can be implied</u> 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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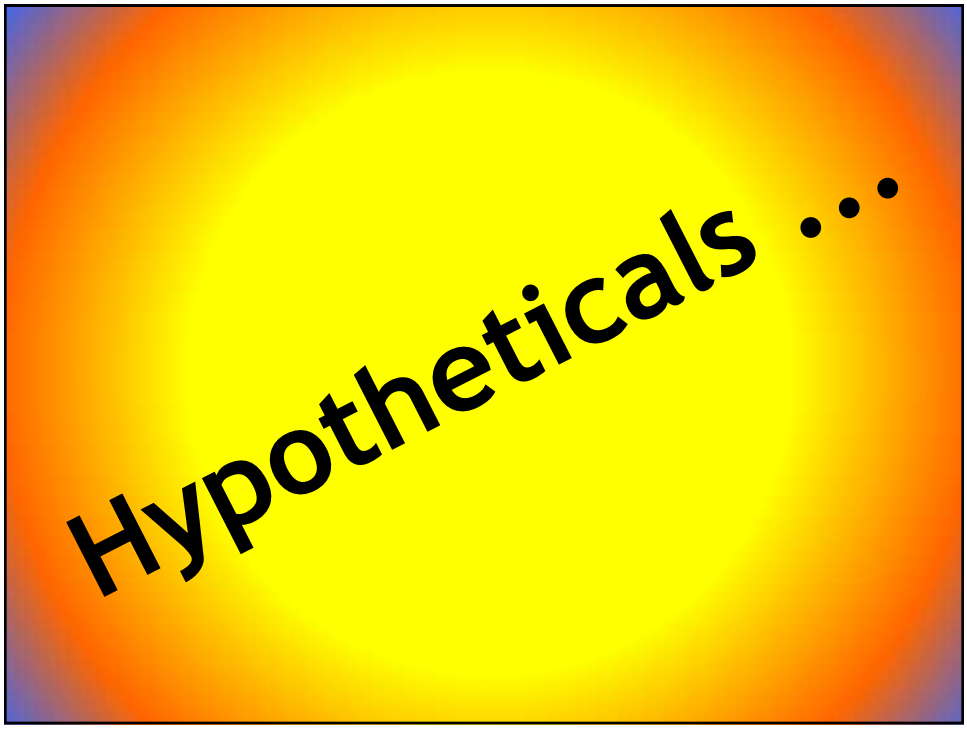
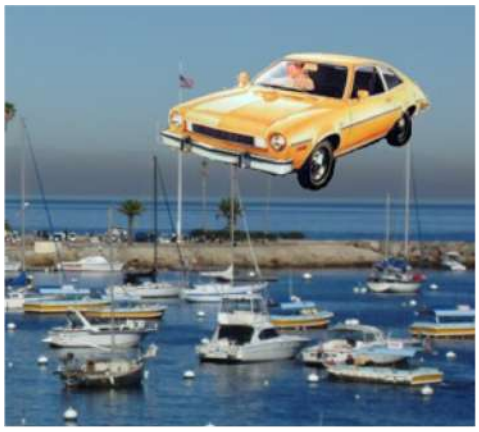


Gravity Shield!



NOVELTY PROBLEM

Martha and Darius

Martha invented the gravity shield in Mississippi in January 2019 and made no disclosures except to file a patent application with the USPTO later that same month. On February 2019, Darius invents the gravity shield in Delaware and files a patent application with the USPTO that same month. In March 2019, Martha abandons her patent application, and the application is never published. Darius has disclosed nothing.

Can Darius get a patent?

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Can Darius get a patent?

YES. → Darius can get the patent. Unpublished, abandoned applications aren't within AIA § 102, and thus don't count as invalidating prior art. (Cf. AIA 102(a)(2).

NOVELTY PROBLEM

Pilar and Gareth

Pilar invented the gravity shield in Peru in January 2020 and publicly used it there. Pilar never files a patent application anywhere.

In February 2020, 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 and Gareth – *2012 variation*

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Can Gareth get the patent?

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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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 and Theresa

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

NOVELTY PROBLEM

Rafiq and Theresa

Rafiq invented the gravity shield in Arizona in June 2017 and made no disclosures. In August 2017, Theresa independently invented the gravity shield also in Arizona. She disclosed it in September 2017. Rafiq files a patent application in February 2018. Theresa files her application in March 2018. 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.

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

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NOVELTY PROBLEM

Beatrice and Charlotte

Last month Beatrice was at a party when Charlotte told her about her invention of a new pen nib that works well for delivering ink to paper but manages to protect the ink from drying out. After fully explaining how it works so that Beatrice could make one for herself, Beatrice exclaimed, “That’s so clever! You should patent that!”

“Naw,” Charlotte said, “but if you want to patent it, go ahead. That’s fine by me.” Beatrice immediately filed a patent application. Can Beatrice get the patent?

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"Naw," Charlotte said, "but if you want to patent it, go ahead. That's fine by me." Beatrice immediately filed a patent application. Can Beatrice get the patent?

NO. → Beatrice is barred because of ***derivation***. Only the inventor can file for a patent. This isn't explicitly found under AIA § 102, but the concept still stands.

NOVELTY PROBLEM

Beatrice and Charlotte – *2010 version*

Back in 2010, Beatrice was at a party when Charlotte told her about her invention of a new pen nib that works well for delivering ink to paper but manages to protect the ink from drying out. After fully explaining how it works so that Beatrice could make one for herself, Beatrice exclaimed, "That's so clever! You should patent that!"

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NO. → Beatrice is barred because of ***derivation*** under pre-AIA § 102(f). Only the inventor can file for a patent.