

Duderstand 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.

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

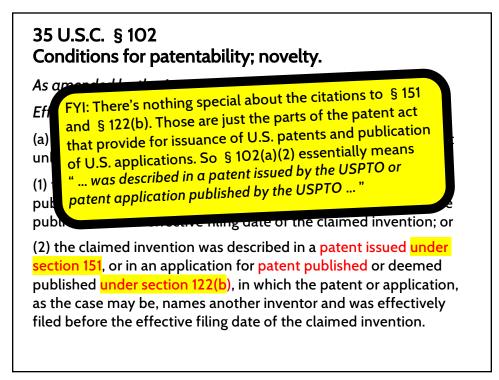
As amended by the America Invents Act of 2011

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. ... 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

As you can see the text of the old **§** 102 is a bit peculiar, *Un* treating some things differently if they happened in a *Eff* foreign country.

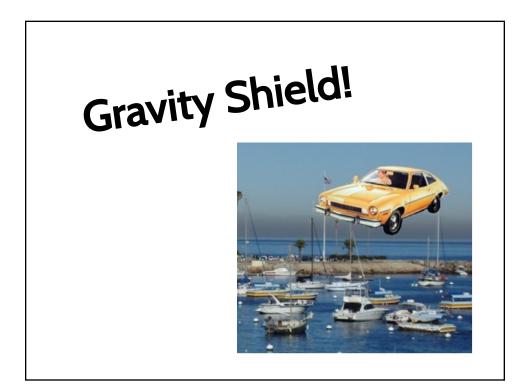
A person shall be entitled to a patent unless -

the United States, or ...

(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 ...

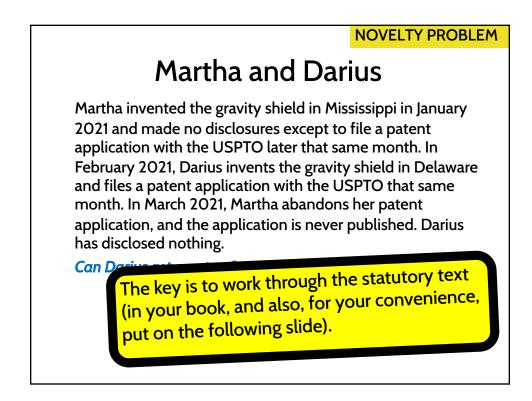




Martha and Darius

Martha invented the gravity shield in Mississippi in January 2021 and made no disclosures except to file a patent application with the USPTO later that same month. In February 2021, Darius invents the gravity shield in Delaware and files a patent application with the USPTO that same month. In March 2021, Martha abandons her patent application, and the application is never published. Darius has disclosed nothing.

Can Darius get a patent?



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

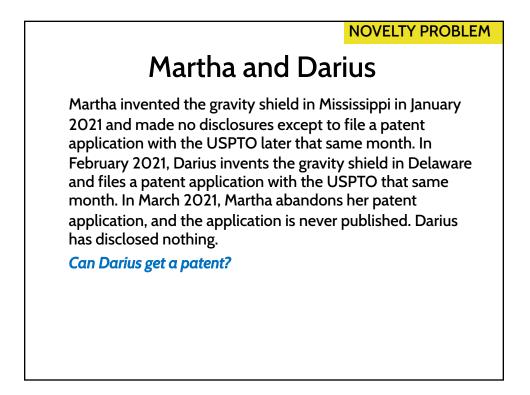
(2) the claimed invention was described in a patent issued under section 151, or in an application for patent published or deemed published under section 122(b), in which the patent or application, as the case may be, names another inventor and was effectively filed before the effective filing date of 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. ...

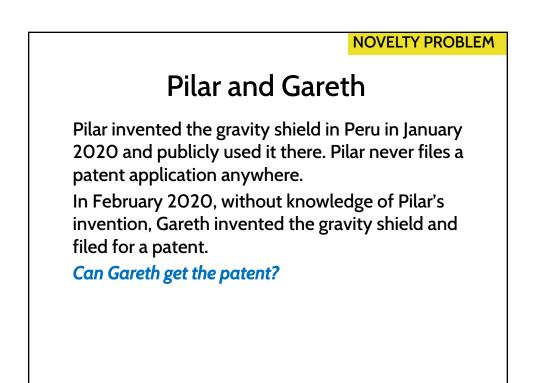


Martha and Darius

Martha invented the gravity shield in Mississippi in January 2021 and made no disclosures except to file a patent application with the USPTO later that same month. In February 2021, Darius invents the gravity shield in Delaware and files a patent application with the USPTO that same month. In March 2021, Martha abandons her patent application, and the application is never published. Darius has disclosed nothing.

Can Darius get a patent?

<u>YES</u> \rightarrow 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)).



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?

<u>NO</u> → The public use in Peru bars Gareth from getting a patent.

NOVELTY PROBLEM

Pilar and Gareth - 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.

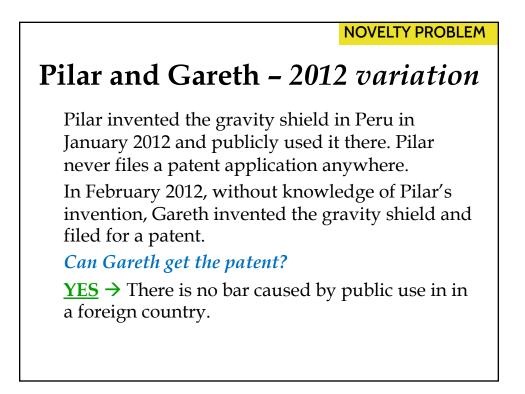
Can Gareth get the patent?

All the statutory text you need from the old version of § 102 is on the next slide

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 ...



NOVELTY PROBLEM

S and

Pilar and Gareth - 2012 variation

So, as you can see, the AIA made a Pi substantive difference in the law Ja

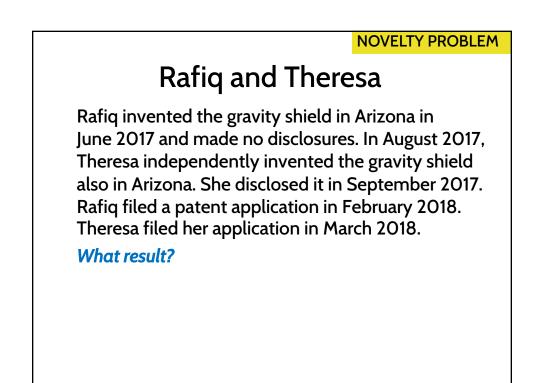
of novelty determinations. This n

Pilar and Gareth problem is just Iı

one example of that.

Can Gareth get the patents

<u>YES</u> \rightarrow 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 filed a patent application in February 2018. Theresa filed her application in March 2018.

What result?

<u>Rafiq does not get a patent.</u> Theresa does get a patent. \rightarrow 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.

