

Invention Priority in Patents

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Basics

- 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)
- “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)

(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.

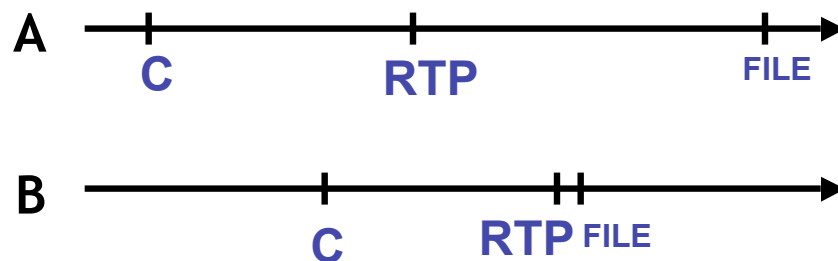
QUADRALITHIUM FLOCCULATOR

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 for a patent application on August 9, 2010.

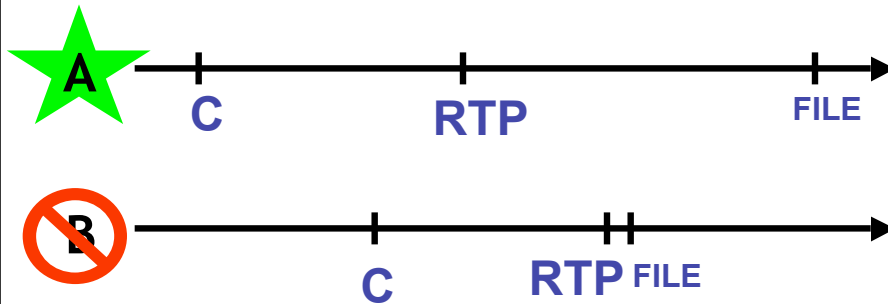
QUADRALITHIUM FLOCCULATOR

Who wins priority?



QUADRALITHIUM FLOCCULATOR

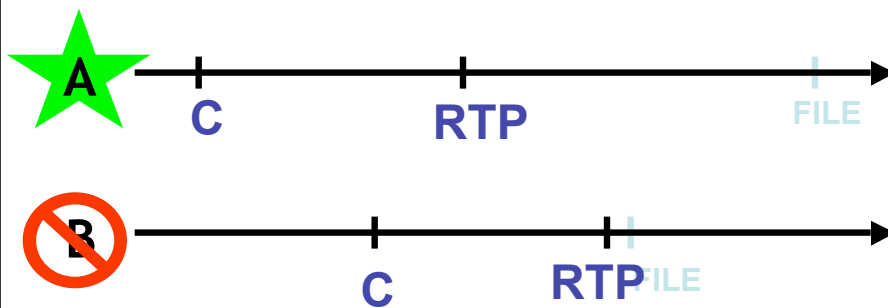
Who wins priority?



Annabeth wins.

QUADRALITHIUM FLOCCULATOR

Who wins priority?



Annabeth wins.

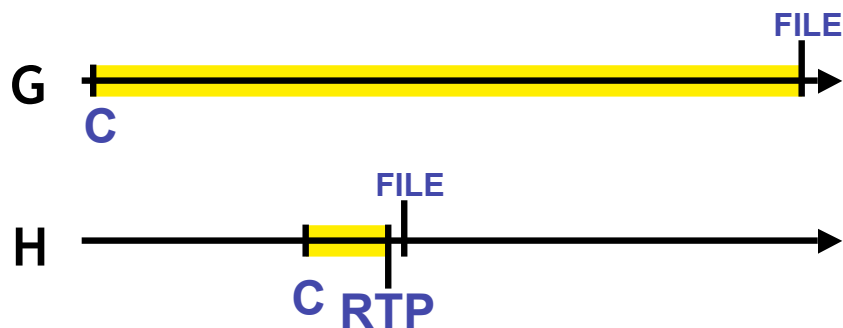
MAGNETRON

Who wins priority?

- Gretchen conceives of the magnetron on February 1, 1999. She works diligently and continuously to reduce the magnetron to practice. Although she hasn't yet completed a working prototype, she files a patent application on October 10, 2010.
- Haila conceives of the magnetron on February 28, 2002, works diligently until she builds a working model on March 15, 2002. She files a patent application on April 13, 2002.

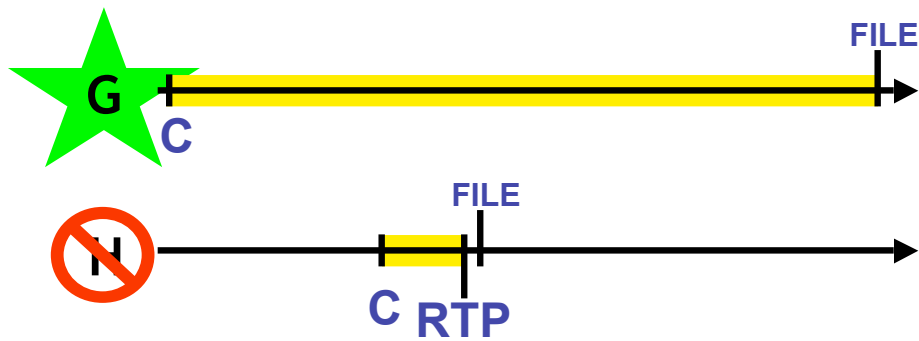
MAGNETRON

Who wins priority?



MAGNETRON

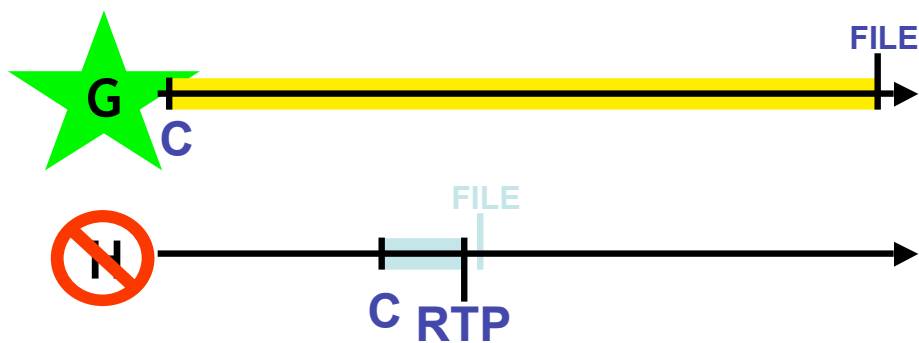
Who wins priority?



Gretchen wins.

MAGNETRON

Who wins priority?



Gretchen wins.

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