AIA and Novelty, Part 2.5

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Syllabus

• Updated syllabus will be available online
  • SUBJECT TO CHANGE! Always consult the online syllabus!


Merges & Duffy, p.383

<table>
<thead>
<tr>
<th>Paragraph (1)</th>
<th>Paragraph (2)</th>
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<tr>
<td>(&quot;One-Time-Period&quot; Prior Art)</td>
<td>(&quot;Two-Time-Period&quot; Prior Art)</td>
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<td>§ 102(a)(1)</td>
<td>§ 102(a)(2)</td>
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<td>Rules for including prior art that is:</td>
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<td>patented,</td>
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<td>§ 102(b)(1)</td>
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<td>Exceptions to (a)(1)</td>
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Patent Drafting Assignment

AIA §102: Exceptions/Grace Period

Subparagraphs (A) and (B) are similar:

• The (A) subparagraphs each allow exclusion of information that came directly or indirectly from the applicant, including even an earlier filed application that was derived from the applicant (“A” Grace Period Events)

• The (B) subparagraphs allow exclusion of independently discovered material if the applicant was first to publicly disclose it (“B” Grace Period Events)

“A” Grace Period Hypotheticals

Anne Able files an application on June 1, 2020.

1) In May 2020, Anne published her own article disclosing the invention. Removed from prior art under (b)(1)(A).

2) In April 2020, Evil Eric stole Anne’s notes and placed the invention on sale. Removed from prior art under (b)(1)(A).

3) Also in April 2020, Evil Eric filed a U.S. patent application using Anne’s notes. Removed from prior art under (b)(2)(A).

In each case, the art gets removed by subparagraph (A) in either (b)(1) or (2) because the disclosure came from/ was derived from Anne’s own work.
**“B” Grace Period Hypotheticals**

Bob Baker publicly discloses his invention in an article on January 1, 2020, and eventually files a patent application on December 31, 2020.

1. On February 1, 2020, Irene Independent publishes her own article based on her own research on the same subject.
   - Removed from prior art under (b)(1)(B).
2. On March 1, 2020, Irene files a patent application based on her own research.
   - Removed from prior art under (b)(2)(B).

   First filer (Irene) loses patent to second filer (Bob).

   - In both cases, Irene’s independent work gets excluded from the prior art because Bob made an earlier “public” disclosure. Bob can prove he was the “first inventor” – and so we call this a **“first inventor to file” system**

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**In re Hafner (C.C.P.A. 1969)**

**Background**

- Hafner’s chemical composition patents were first filed in Germany (1959) and then in the US (1960)
- German patents issued, but US patents were rejected because he did not disclose any use for his compositions (§ 112)
- Hafner argues that the prior art (his German patent application and a publication) “do not qualify as ‘enabling’ disclosures because they allegedly do not ‘teach the public ‘how to use’ the invention…’”

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**Seymour and Hafner: Anticipatory Enablement**

- **General Rule**
  - Only prior art that enables “mak[ing], construct[ing] and practic[ing] the invention” can anticipate. *Seymour v. Osborne* (1870).
- **Limitation**
  - Prior art can anticipate if it enables making substance, even if it does not identify “specific, substantial utility.” *In re Hafner* (C.C.P.A. 1969)

  “[t]he standard for what constitutes proper enablement of a prior art reference for purposes of anticipation… differs from the enablement standard under section 112.” *Rasmussen v. Smithkline Beecham Corp.* (Fed. Cir. 2005)

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**Prima Tek v. Polypap (Fed. Cir. 2005)**

**Background**

- **Limitations of Prima Tek patents**
  - No “pot means” (negative limitation)
  - “[F]loral holding material”
  - “[C]rimping” and “at least one overlapping fold”
  - Charrin’s French patent application was published in 1989.
  - Prima Tek’s patent applications have effective filing dates of 1992 at latest and trace back through CIPs to application filed in 1988.
J. Dyk’s opinion for the Court

Claim Construction for Validity Analysis

- “pot” = “‘rounded metal or earthen container …’” (Webster’s dictionary definition)
  - Result: “without a pot means” satisfied by lack of such container in Charrin prior art
- “floral holding material” not needing to “be capable of holding its predetermined shape”
  - Result: “floral holding material” satisfied by “mass of wetted moss” in Charrin prior art

J. Dyk’s opinion for the Court

• “[A] prior art reference may anticipate when the claim limitation or limitations not expressly found in that reference are nonetheless inherent in it.”
• “Inherent anticipation does not require an appreciation of the inherent limitation by those of skill … before the critical date ….”

Allergan, Inc. v. Apotex, Inc.

Background

- Claim language required “treating hair loss.”
- Specification said, “‘Treating hair loss’ includes arresting hair loss or reversing hair loss, or both, and promoting hair growth.”
- “Appellants argue[d] … that the use of the conjunctive ‘and’ in the inventor’s own lexicography expressly provides that the method for treating hair loss must both arrest or reverse hair loss, as well as also promote hair growth.”

Allergan v. Apotex (Fed. Cir. 2014)

Background

- Ocular prostaglandin drops initially approved for elevated intraocular pressure due to glaucoma or other eye conditions
- Incidental finding of a very common side effect: increased eyelash growth (length, thickness, number of lashes)
- Interest in establishing new use as cosmetic therapy for eyelash thinning/alopecia emerged
Allergan v. Apotex (Fed. Cir. 2014)

C.J. Prost’s opinion for the Court

• “Reading the patentee’s own lexicography in light of the whole specification, we conclude that a method of ‘treating hair loss’ may include a method of promoting hair growth without also arresting or reversing hair loss.”
  - Plain Meaning
  - Claim to Cover Disclosed Embodiments
  - “There is nothing … suggesting that the patentee would have excluded these examples from the [claims’] scope ….”

Allergan v. Apotex (Fed. Cir. 2014)

C.J. Prost’s opinion for the Court

• “A patent is invalid for anticipation … if a single prior art reference discloses each and every limitation of the claimed invention.”
  - Johnstone Patent Cooperation Treaty (PCT, WIPO) application as example of prior art for which content might be contested.
  - Inherency involves whether limitation “is necessarily present,” but this may be established by showing that limitation is “‘natural result flowing from … prior art.’”
  - Question of whether promoting eyelash growth is inherent

Pre-AIA Novelty, Part 1

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AIA Statutory Framework

35 U.S.C. 102(a) & (b): Shorthand

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<tr>
<td>102(a)(2)</td>
<td>Gives 3 exceptions prior art</td>
<td>Non-Inventor Disclosures</td>
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<td>102(b)(3)</td>
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Public Disclosures
Grace Period Interfering Disclosures
Non-Inventor Disclosures
Community-Owned Disclosures
Novelty

• Pre-AIA §102
  • §102(a): before invention, public use or knowledge in US, or patent or “printed publication” anywhere
  • §102(b): >1 yr before US filing, public use or “on sale” in US, or patent or “printed publication” anywhere
  • §102(c): before invention, US patent application leading to issued US patent or published application
  • §102(g)(1): interference ⇒ made by another US pat. applicant in WTO country, and not ASC
  • §102(g)(2): no interference ⇒ made in US by another, and not abandoned/suppressed/concealed

• AIA §102
  • Art Under AIA §102(a)(1): patent, printed publication, public use, matter on sale, or matter otherwise publicly available
  • Art Under AIA §102(a)(2): US patent or published application
  • Effective date = “effective filing date”
  • Exclusions: derivation, pre-filing inventor-connected disclosure, common ownership (New §102(b)(2))
  • Grace Period Under AIA §102(b)(1)
  • Year preceding effective filing date
  • Disclosure made by inventor, made by “derivant,” or preceded by inventor-connected public disclosure

Effective filing date before March 16, 2013: pre-AIA law applies

Novelty Under Pre-AIA §102

Pre-AIA §102. CONDITIONS FOR PATENTABILITY; NOVELTY AND LOSS OF RIGHT TO PATENT

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

Novelty: Loss of Right to Patent

Pre-AIA §102. CONDITIONS FOR PATENTABILITY; NOVELTY AND LOSS OF RIGHT TO PATENT

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Novelty (Anticipation) vs. Statutory Bars

• Novelty/Anticipation [102(a)] is concerned with NEWNESS – is it original to the patent applicant/patentee?

• Statutory Bars [102(b)] are concerned with TIMELINESS – did the inventor file soon enough?

Rare Statutory Bars: §102(c)

• Under §102(c), art can be abandoned if (1) the inventor dedicates the invention to the public or (2) take actions that are inconsistent with patenting

• Classic case on abandonment is Macbeth-Evans Glass Co. v. General Electric Co. (6th Cir. 1917) (The inventor exploited the invention as a trade secret “for almost ten years before the patent in suit was applied for”)

• Modern cases apply the holding of Metallizing Engineering (2d Cir. 1946), which held that secret commercial use was a “public use” under §102(b) (not under §102(c))

• Secret commercial use is not abandoned if patent filed within 1 year of the secret use. See Mendenhall v. Astec Indus. (E.D. Tenn. 1988)

Rare Statutory Bars: §102(d)

• §102(d) requires the confluence of two highly unusual circumstances:
  • An inventor who first files a patent application in a foreign jurisdiction “mistakenly” waits for than a year after the foreign filing to file in the US
  • The foreign jurisdiction must issue the patent before the US patent is filed

• Merges: “the 102(d) bar can only arise where an inventor is doubly cursed by both negligence (professional malpractice in filing the US application late) and bad luck (having a foreign patent bureaucracy move swiftly at just the wrong time).”

• Applications in Europe, Japan, and other common jurisdictions often remain pending for much longer than a year.
Four Prior Art Categories of pre-AIA § 102

(i) § 102(a): Prior publicly available art
- This category includes the publicly available art (e.g., printed publications) generated by others (not the applicant herself) that became publicly available prior to the applicant’s date of invention.

(ii) § 102(e): Prior art disclosed in US applications
- This category includes anything disclosed in a US patent application that was filed by another (not the applicant herself) in the US prior to the applicant’s date of invention and that was eventually published or issued as a patent.

(iii) § 102(g)(1): Prior inventions claimed in US applications
- Any invention claimed in a US patent application filed by another inventor where the other inventor’s date of invention is prior to the applicant’s date of invention.

(iv) § 102(g)(2): Prior inventions made in the US
- Any invention made in US by another inventor where the other inventor’s date of invention is prior to the applicant’s date of invention.
35 U.S.C. § 102(g)(1)

- during the course of an interference conducted under section 135 or section 291...
- another inventor involved therein establishes, to the extent permitted in section 104...
- that before such person's invention thereof...
- the invention was made by such other inventor...
- and not abandoned, suppressed, or concealed

35 U.S.C. § 102(g)(2)

- before such person's invention thereof
- the invention was made in this country...
- by another inventor...
- who had not abandoned, suppressed, or concealed it...

Common Priority Rule: § 102(g)(2)

- ... 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

Priority and Prior Art: §102(g)

- §102(g)(1): Interference
  - Made by another US patent applicant in WTO country
  - “[N]ot abandoned, suppressed or concealed”
- §102(g)(2): No Interference
  - Made in US by another
  - “[N]ot abandoned, suppressed or concealed”
- Factors in Priority
  - “dates of conception and reduction to practice”
  - “reasonable diligence” of “first to conceive”

Priority and Prior Art: §102(g)

- Basic Rule: First to RTP wins.
  - Exception #1: First to Conceive but Second to RTP is “reasonabl[y] diligent[t]” from before Other’s Conception up to Own RTP.
  - Exception #2: First to RTP “abandoned, suppressed, or concealed.”
- Patent Application = Constructive RTP
- Rule 131 as Means to Establish Priority

Date of Invention for §102(a), §102(e) & §102(g)(2)

- Default: Effective Filing Date
- Back of Effective Filing Date?
  - Actual Reduction to Practice without ASC
  - Start of Reasonable Diligence Extending from Time After Conception to RTP without ASC
Conception & RTP Defined

- **Conception**: “complete performance of the mental part of the inventive art”; “formation in the mind of the inventor of a definite and permanent idea of the complete and operative invention” Townsend (C.C.P.A. 1929)
- **(Actual) RTP**: (1) developing embodiment having all claim limitations, plus (2) knowledge “that the invention would work for its intended purpose” Cooper (Fed. Cir. 2001)

35 USC §135(a): BPAI Proceedings

(a) Whenever an application is made for a patent which, in the opinion of the Director, would interfere with any pending application, or with any unexpired patent, an interference may be declared … The Board of Patent Appeals and Interferences shall determine questions of priority of the inventions and may determine questions of patentability …

35 USC §135(b): Time Limits

1. A claim which is the same as, or for the same or substantially the same subject matter as, a claim of an issued patent may not be made in any application unless such a claim is made prior to one year from the date on which the patent was granted.
2. [Published apps: claim] may be made in an application filed after the application is published only if the claim is made before one year after the date on which the application is published.

35 U.S.C. 291: Interfering Patents

The owner of an interfering patent may have relief against the owner of another by civil action, and the court may adjudge the question of validity of any of the interfering patents, in whole or in part. The provisions of the second paragraph of section 146 of this title shall apply to actions brought under this section.

Brown v. Barbacid (Fed. Cir. 2002)

**Background**
- September 1989: Dr. Reiss (for Brown) performed experiments alleged to establish RTP
- November 1989: Dr. Casey allegedly knew that Dr. Reiss had performed experiment with an FT inhibitor
- March 1990: Barbacid reduced to practice
- April 1990: Brown filed application
- May 1990: Barbacid filed patent application
- February 1993: Barbacid patent issued
• Winners of the 1985 Nobel Prize in Physiology or Medicine "for their discoveries concerning the regulation of cholesterol metabolism"

Michael S. Brown  Joseph L. Goldstein

Brown v. Barbacid (Fed. Cir. 2002)

Invention: Milestone Events/Dates

Conception  RTP  Filing  Issuance

Board Decision

Brown

Filed: 4/18/1990


Barbacid

Brown’s Argument on Appeal

Brown


Barbacid

**Brown v. Barbacid (Fed. Cir. 2002)**

**J. Rader’s opinion for the Court**

- The Barbacid patent application was filed on May 8, 1990 and issued on February 9, 1993. The Brown application was filed on December 22, 1992 but was accorded the benefit of an earlier related application filed on April 18, 1990. Thus, Brown was the senior party.
- Barbacid, as the junior party, had the burden to prove priority by a preponderance of the evidence.
- “Brown’s physical evidence [notebooks from September 1989] do not require corroboration to demonstrate the content of the physical evidence ...”
- “[A]n inventor’s testimonial assertions of inventive facts require corroboration by independent evidence.”

**In re Lister (Fed. Cir. 2009)**

**Background**

- Lister developed an improvement/handicap for golf
- Manuscript “Advanced Handicap Alternatives for Golf” submitted to Copyright Office on July 4, 1994, which issued a certificate of registration on July 18, 1994
- Patent filed with USPTO on August 5, 1996
- Lengthy prosecution history: 13 years of rejections/amendments
- Most recent: rejected claims anticipated by Lister manuscripts as prior art (under §102(a) and §102(b))
- BPAI overturned §102(a) rejection, affirmed §102(b) rejection

**In re Lister (Fed. Cir. 2009)**

**J. Prost’s opinion for the Court**

- Section 102(b) is a bar to patentability if “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.”
- “The bar is grounded on the principle that once an invention is in the public domain, it is no longer patentable by anyone.” In re Hall (Fed. Cir. 1986)
- Whether a reference is publicly accessible is determined on a case-by-case basis based on the “facts and circumstances surrounding the reference’s disclosure to members of the public.” In re Klopfenstein (Fed. Cir. 2004)
- A reference is considered publicly accessible if it was “disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art exercising reasonable diligence, can locate it.” Avocera Wireless Corp. v. International Trade Commission (Fed. Cir. 2008)
In re Lister (Fed. Cir. 2009)

J. Prost’s opinion for the Court

• “any member of the public … is capable of gaining access to the manuscript without any need for special authorization”
• “a reference can be considered publicly accessible even if gaining access to it might require a significant amount of travel” (Court cites In re Hall, which held that a copy of a dissertation shelved in a library in Germany was a printed publication)
• “… could hire someone local to inspect the manuscript on their behalf”
• “it is unnecessary to show that anyone actually inspected the reference”
• “the evidence contained in the IDS neither provides substantial evidence that the Lister manuscript was publicly accessible as of the critical date nor suffices to prove a prima facie case of accessibility that would shift the burden to Dr. Lister to show inaccessibility

EFF v. Personal Audio (PTAB 2014)

Background

• EFF requested IPR of Claims 31-35 based on the existence of two pieces of “prior art” dated April 22, 1993
  • NCSA Geek of the Week
  • SurfPunk “Technical Journal”

What does PTAB say about each of these?

Electronic Frontier Foundation v. Personal Audio, LLC

15 Minute Break