Pre-AIA Novelty, Part 2

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Scenario #1—Are Iris & Caliban Applications Both Prior Art?


Iris filed a US patent application on September 21, 2009 and cannot prove an earlier invention date. USPTO published Iris’ application on March 21, 2011, but Iris then abandoned the application.

Caliban filed an Australian patent application on January 5, 2009, did not file a US patent application, and otherwise kept information relating to his claimed invention secret. The Australian patent office published Caliban’s application on July 9, 2010 and issued a patent to Caliban on February 15, 2011.

Scenario #2—Are Figures in “Laid Open” Foreign Application Prior Art?

In 1982, Young filed Canadian application with “Figures 3 and 4.” In 1983, the Canadian patent issued, but without “Figures 3 and 4,” which “were cancelled during prosecution.” The original “application was not formally indexed,” but “was in the file of the [issued] patent,” which “was indexed and catalogued according to its subject matter.”

In 1995, Bruckelmyer filed US application. The question is whether Young’s “Figures 3 and 4” are prior art.

“Bruckelmyer contend[ed] that a patent application located in a foreign patent office … is not ‘publicly accessible’ just because it is laid open for inspection.”

Scenario #3—Is “Laid Open” Foreign Application Reasonably Accessible on Saturday?

Effective filing date of US application was April 7, 1992. Canadian patent application (presumably by same inventor) was “made available for public inspection” on Saturday, April 6, 1991.

Canadian Patent Office (CPO) was closed on Saturdays and Sundays, and “the only way the public could gain access … was by physical inspection.”

Defendant contended “that ‘[m]embers of the public accompanied by an authorized CPO employee could have inspected the Application on Saturday.’”

Scenario #4—Is Video Shown Abroad Potential Prior Art?

Dr. Puglisi (not one of the claimed inventors) “showed [5-minute] video at conferences in Austria, Belgium, France and Italy, and … made oral presentations in accompaniment therewith, speaking in French or Italian.”
Scenario #5—Are Napkins/Mats in Restaurant Potential Prior Art?

“Defendants claim Parkes and Boxall violated 35 USC §102(b) by publicly disclosing the invention more than a year before the effective date of the patent because they drew diagrams of it on restaurant napkins and placemats while dining at restaurants.”

Scenario #6—Is Document Available on Internet Potential Prior Art?

“Paper in file named “ndss98.ps” (reflecting acronym for a 1998 conference) was made available, as “backup” for pre-publication peer review, for 7 days on “open FTP server” in subdirectory bearing name of project known to those skilled in art.

Author had submitted paper in e-mail, which also “included the specific address, ftp://ftp.csl.sri.com/pub/emerald/ndss98.ps” of the FTP file. “[R]ecord [did] not show that anyone accessed … paper via the FTP server.”

Scenario #7—Is Post to Internet Newsgroup Potential Prior Art?

“On June 29, 1995—nine months before the priority date claimed for the ‘835 patent—Yount posted to the comp.infosystems.www.authoring.cgi newsgroup a message entitled ‘How to tell which page called the script?’” Yount explained he was “a newbie at this CGI [common gateway interface] stuff.”

“A college student named Shishir Gundavaram replied with the following post (the ‘Post’) in 1995.

At that time, posts to the newsgroup were not indexed and, generally speaking, were not electronically searchable.

Real Cases Behind Scenarios #2-7

(2) Bruckelmyer v. Ground Heaters, Inc., 445 F.3d 1374 (Fed. Cir. 2006)
(7) Suffolk Techs., LLC v. AOL Inc., 752 F.3d 1358 (Fed. Cir. 2014)

Additional Questions

Q: In the late 1980s, Priori Co. developed and used in the U.S. a process for dying fabric for commercial clothing manufacturers without making affirmative efforts to keep it secret. Indeed, in 1989, representatives of Priori described their process in detail in nonconfidential oral disclosures to representatives of at least six different major U.S. clothing manufacturers. Did Priori’s actions generate potential prior art for a patent application filed in 1991?

1. Yes
2. No

Additional Questions

Q: Hal conceived his invention in Oklahoma on August 1, 2005, and was reasonably diligent in seeking to reduce it to practice from September 7, 2005, until his reduction to practice in Oklahoma on February 12, 2006. Hal filed a US patent application for his invention on January 31, 2007. An article in French that disclosed the exact same invention was published in Paris on February 1, 2006. Is the article §102 prior art for Hal’s invention?

1. Yes
2. No
Additional Questions

Review Q: Earl conceived his invention on March 5, 2008, and was reasonably diligent from then, until his reduction to practice on July 9, 2008. Marta conceived the same invention on March 8, 2008, and was reasonably diligent from March 8 until her reduction to practice on June 27, 2008. Under §102, who is the first inventor?

1. Earl
2. Marta
3. Neither: it’s a tie.

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”

Peeler v. Miller (C.C.P.A. 1976)

Background

• March 1966: Miller determined experimentally that “FREON 11” worked as anti-cavitation additive
• April 1966: Miller provided internal “invention disclosure”
• April 1966: Monsanto Research Dep’t characterized Miller’s disclosure as “‘Ready (to file)’”
• January 1968: Peeler application was filed
• October 1968: Black began work “in Monsanto’s patent department”
• April 1970: Miller application was filed

J. Rich’s opinion for the Court

• RTP Must Precede ASC
  • No Abandonment by Miller Personally
  • Miller’s post-1966 “lack of activity” was “understandable” given corporate “realities”
• Suppression by Monsanto
  • “[P]roof of specific intent to suppress is not necessary where the time between actual [RTP] and filing is unreasonable.”
  • “[F]our-year delay” in filing “is, prima facie, unreasonably long ….”

Abandoned, Suppressed or Concealed: Refinements

• Paulik (Fed. Cir. 1985)
  • Potential cure of ASC by resumption of work before another’s priority date
• Gillman (2d Cir. 1940) (L. Hand, J.)
  • ASC where device used to make “public” products was held as “secret as possible”
• Astro-Valcour (Fed. Cir. 2001)
  • “[I]n cases in which an invention is disclosed to the public by commercialization [without application for a patent], courts have excused delay upon proof that the first inventor engaged in reasonable efforts to bring the invention to the market.”