**Syllabus**

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


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**In re Moore (Fed. Cir. 1987)**

**Background**

- Moore invented a chemical compound and filed a patent for it in November 1964
- Moore’s patent was rejected based on an article in a British chemistry journal published in December 1963
- To overcome the 102(a) rejection, Moore demonstrated that he had prepared the compound prior to the effective date of the British article, but had not established a use for it

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**Pre-AIA §102(f): the F is for Fraud**

“A person shall be entitled to a patent unless –

(f) He did not *himself* invent the subject matter sought to be patented
Two Main §102(f) Scenarios

(1) “Derivation” (invention theft)
   • Requirements:
     (1) Conception by Person A;
     (2) Communication (enabling) of full inventive idea to Person B

(2) Inventorship rejections and disputes – USPTO and litigation
   • Related to 35 USC § 256 (“correction of named inventor”)
   • Misjoinder (adding non-inventor to patent)
   • Non-joinder (omitting inventor from patent)

Campbell v. Spectrum Automation Co. (6th Cir. 1975)

Background

• Campbell testified that he invented the “Open-Flex” feed track (US Pat. No. 3,002,600), and reportedly gave Zimmerman (his employee at the time) full directions as to how to manufacture it
  • The trial judge did not believe Campbell’s testimony

• Zimmerman testified that he conceived of his own flexible feed track (the “Maxi-Flex”), inspired by his father’s spring tension belt buckle, and later showed it to Campbell
  • The trial judge believed Zimmerman’s testimony

• §102(f): a “person shall be entitled to a patent unless … he did not himself invent the subject matter sought to be patented”

C.J. Phillips’ opinion for the Court

• §282: “A patent shall be presumed valid. The burden of establishing invalidity of a patent shall rest on a party asserting it.”

• “In The Barbed Wire Patent, the court held that when an unpatented device, the existence and use of which are sought to be established by oral testimony, is set up as a complete anticipation of a patent the proof sustaining it must be ‘clear, satisfactory, and beyond a reasonable doubt’.”

• “The circumstantial evidence … including the father’s belt buckle, substantiates Zimmerman’s testimony.”

Campbell v. Spectrum Automation Co. (6th Cir. 1975)

- What was the corroborating evidence here?
- Was it sufficient?
- Why didn’t the court discuss one very important piece of circumstantial evidence – that Campbell applied for a patent and Zimmerman didn’t?
Q 1: Rodrigo filed a Spanish patent application on February 27, 2005, and filed a corresponding U.S. application on January 22, 2006, claiming the benefit of the Spanish application. Rodrigo’s default priority (invention) date in the U.S. is:

1. Jan. 22, 2005
2. Feb. 27, 2005
4. Feb. 27, 2006

Q 2: Rodrigo filed a Spanish patent application on February 27, 2005, and filed a corresponding U.S. application on January 22, 2006, claiming the benefit of the Spanish application. Rodrigo’s §102(b) critical date is:

1. Feb. 27, 2004
2. Jan. 22, 2005
3. Feb. 27, 2005
More practice…

Q 3: Rodrigo filed a Spanish patent application on February 27, 2005, and filed a corresponding U.S. application on January 22, 2006, claiming the benefit of the Spanish application. Rodrigo can prove conception in Spain on December 8, 2004, and reasonable diligence in Spain extending from January 3, 2005, to the filing of the Spanish application. Rodrigo’s §102(a) critical date is:

1. Feb. 27, 2004
2. Dec. 8, 2004
3. Jan. 3, 2005
4. Jan. 22, 2005
5. Feb. 27, 2005

More practice…

Q 4: Theodora sold any future patent rights in her invention to Big Corp. on March 5, 2008. She submitted an article describing the invention to Printed Publication on May 8, 2008. The article was published in Printed Publication on July 28, 2008. Based on the preceding, the earliest effective date for §102(b) prior art is:


Post-AIA Question 1A

Alyssa, an entrepreneur in Palo Alto, invents a novel diaper in April 2012 and files a U.S. patent application in September 2013. Consider each of the following additional sets of facts. In each scenario, is Alyssa entitled to receive a patent based on the facts presented? In your explanation, please note the relevant statutory section (e.g., "post-AIA § 102(a)(2)").

In May 2013, Alyssa publishes an article describing the diaper in Parenting magazine.

Pre-AIA Question 1B

Alyssa, an entrepreneur in Palo Alto, invents a novel diaper in April 2011 and files a U.S. patent application in September 2012. Consider each of the following additional sets of facts. In each scenario, is Alyssa entitled to receive a patent based on the facts presented? In your explanation, please note the relevant statutory section (e.g., "post-AIA § 102(a)(2)").

In May 2012, Alyssa publishes an article describing the diaper in Parenting magazine.

Post-AIA Question 2A

Alyssa, an entrepreneur in Palo Alto, invents a novel diaper in April 2012 and files a U.S. patent application in September 2013. Consider each of the following additional sets of facts. In each scenario, is Alyssa entitled to receive a patent based on the facts presented? In your explanation, please note the relevant statutory section (e.g., "post-AIA § 102(a)(2)").

In June 2013, Luis independently invents the same diaper in Mexico and immediately puts the diapers into public use in his publicly accessible childcare facility in Mexico City.

Pre-AIA Question 2B

Alyssa, an entrepreneur in Palo Alto, invents a novel diaper in April 2011 and files a U.S. patent application in September 2012. Consider each of the following additional sets of facts. In each scenario, is Alyssa entitled to receive a patent based on the facts presented? In your explanation, please note the relevant statutory section (e.g., "post-AIA § 102(a)(2)").

In June 2012, Luis independently invents the same diaper in Mexico and immediately puts the diapers into public use in his publicly accessible childcare facility in Mexico City.
Post-AIA Question 3A

Alyssa, an entrepreneur in Palo Alto, invents a novel diaper in April 2012 and files a U.S. patent application in September 2013. Consider each of the following additional sets of facts. In each scenario, is Alyssa entitled to receive a patent based on the facts presented? In your explanation, please note the relevant statutory section (e.g., “post-AIA § 102(a)(2)”).

In June 2013, Luis independently invents the same diaper, and in July 2013, he publishes a Spanish-language article describing it in Mi Bebé.

Pre-AIA Question 3B

Alyssa, an entrepreneur in Palo Alto, invents a novel diaper in April 2011 and files a U.S. patent application in September 2012. Consider each of the following additional sets of facts. In each scenario, is Alyssa entitled to receive a patent based on the facts presented? In your explanation, please note the relevant statutory section (e.g., “post-AIA § 102(a)(2)”).

In June 2012, Luis independently invents the same diaper, and in July 2012, he publishes a Spanish-language article describing it in Mi Bebé.

Post-AIA Question 4A

Alyssa, an entrepreneur in Palo Alto, invents a novel diaper in April 2012 and files a U.S. patent application in September 2013. Consider each of the following additional sets of facts. In each scenario, is Alyssa entitled to receive a patent based on the facts presented? In your explanation, please note the relevant statutory section (e.g., “post-AIA § 102(a)(2)”).

In May 2013, Alyssa publishes an article describing the diaper in Parenting magazine. In June 2013, Luis independently invents the same diaper. And then in July 2013, Luis publishes a Spanish-language article describing it in Mi Bebé.

Pre-AIA Question 4B

Alyssa, an entrepreneur in Palo Alto, invents a novel diaper in April 2011 and files a U.S. patent application in September 2012. Consider each of the following additional sets of facts. In each scenario, is Alyssa entitled to receive a patent based on the facts presented? In your explanation, please note the relevant statutory section (e.g., “post-AIA § 102(a)(2)”).

In May 2012, Alyssa publishes an article describing the diaper in Parenting magazine. In June 2012, Luis independently invents the same diaper. And then in July 2012, Luis publishes a Spanish-language article describing it in Mi Bebé.

Post-AIA Question 5A

Alyssa, an entrepreneur in Palo Alto, invents a novel diaper in April 2012 and files a U.S. patent application in September 2013. Consider each of the following additional sets of facts. In each scenario, is Alyssa entitled to receive a patent based on the facts presented? In your explanation, please note the relevant statutory section (e.g., “post-AIA § 102(a)(2)”).

In June 2013, Luis independently invents the same diaper, and in July 2013, he files a U.S. patent application claiming the diaper. His patent application is published 18 months after filing.

Pre-AIA Question 5B

Alyssa, an entrepreneur in Palo Alto, invents a novel diaper in April 2011 and files a U.S. patent application in September 2012. Consider each of the following additional sets of facts. In each scenario, is Alyssa entitled to receive a patent based on the facts presented? In your explanation, please note the relevant statutory section (e.g., “post-AIA § 102(a)(2)”).

In June 2012, Luis independently invents the same diaper, and in July 2012, he files a U.S. patent application claiming the diaper. His patent application is published 18 months after filing.
Post-AIA Question 6A

Alyssa, an entrepreneur in Palo Alto, invents a novel diaper in April 2012 and files a U.S. patent application in September 2013. Consider each of the following additional sets of facts. In each scenario, is Alyssa entitled to receive a patent based on the facts presented? In your explanation, please note the relevant statutory section (e.g., “post-AIA § 102(a)(2)”).

In May 2013, Alyssa publishes an article describing the diaper in Parenting magazine. In June 2013, Luis independently invents the same diaper. In July 2013, Luis files a U.S. patent application claiming the diaper.

Pre-AIA Question 6B

Alyssa, an entrepreneur in Palo Alto, invents a novel diaper in April 2011 and files a U.S. patent application in September 2012. Consider each of the following additional sets of facts. In each scenario, is Alyssa entitled to receive a patent based on the facts presented? In your explanation, please note the relevant statutory section (e.g., “post-AIA § 102(a)(2)”).

In May 2012, Alyssa publishes an article describing the diaper in Parenting magazine. In June 2012, Luis independently invents the same diaper. In July 2012, Luis files a U.S. patent application claiming the diaper.

Post-AIA Question 7A

Alyssa, an entrepreneur in Palo Alto, invents a novel diaper in April 2012 and files a U.S. patent application in September 2013. Consider each of the following additional sets of facts. In each scenario, is Alyssa entitled to receive a patent based on the facts presented? In your explanation, please note the relevant statutory section (e.g., “post-AIA § 102(a)(2)”).

In August 2012, Alyssa places her diaper on sale by offering to sell it to Strawberry Baby, a boutique in Menlo Park. The boutique declines.

Pre-AIA Question 7B

Alyssa, an entrepreneur in Palo Alto, invents a novel diaper in April 2011 and files a U.S. patent application in September 2012. Consider each of the following additional sets of facts. In each scenario, is Alyssa entitled to receive a patent based on the facts presented? In your explanation, please note the relevant statutory section (e.g., “post-AIA § 102(a)(2)”).

In August 2011, Alyssa places her diaper on sale by offering to sell it to Strawberry Baby, a boutique in Menlo Park. The boutique declines.