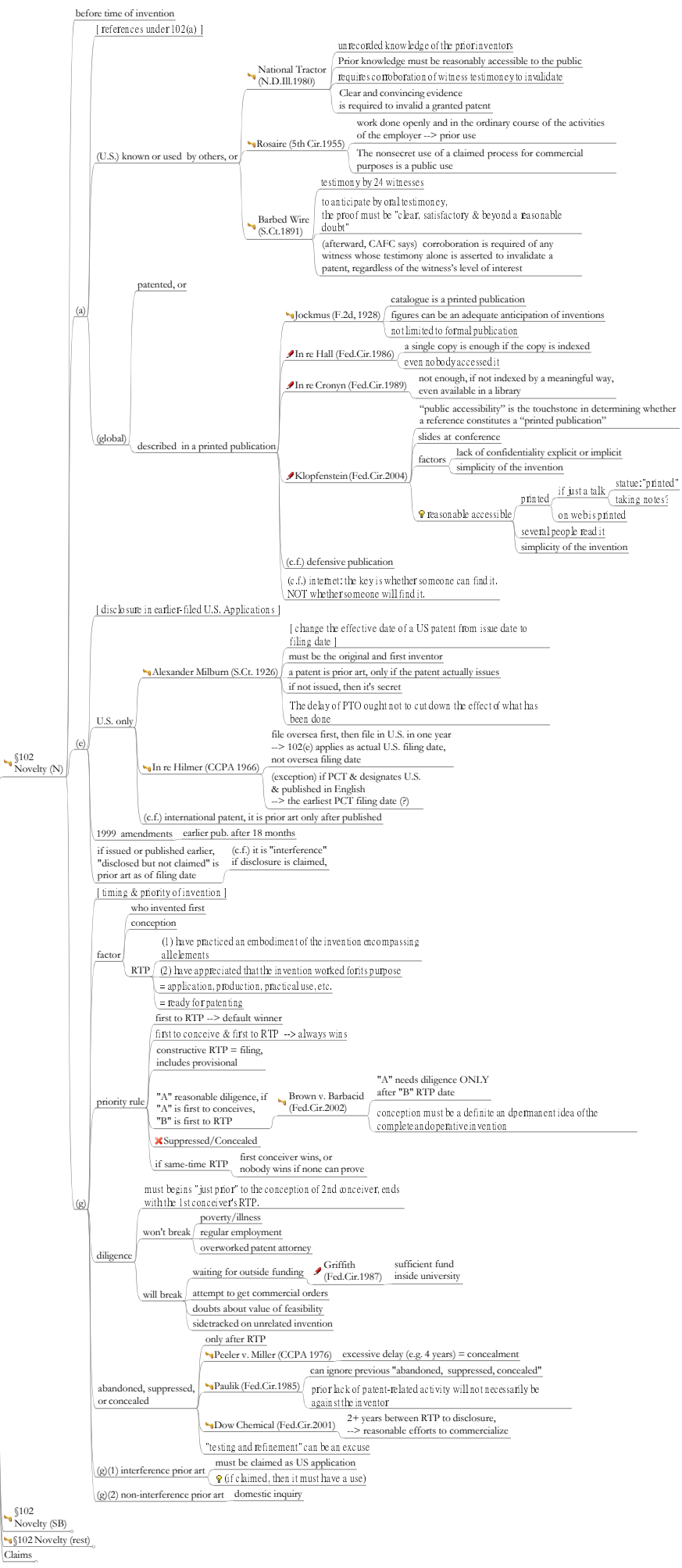
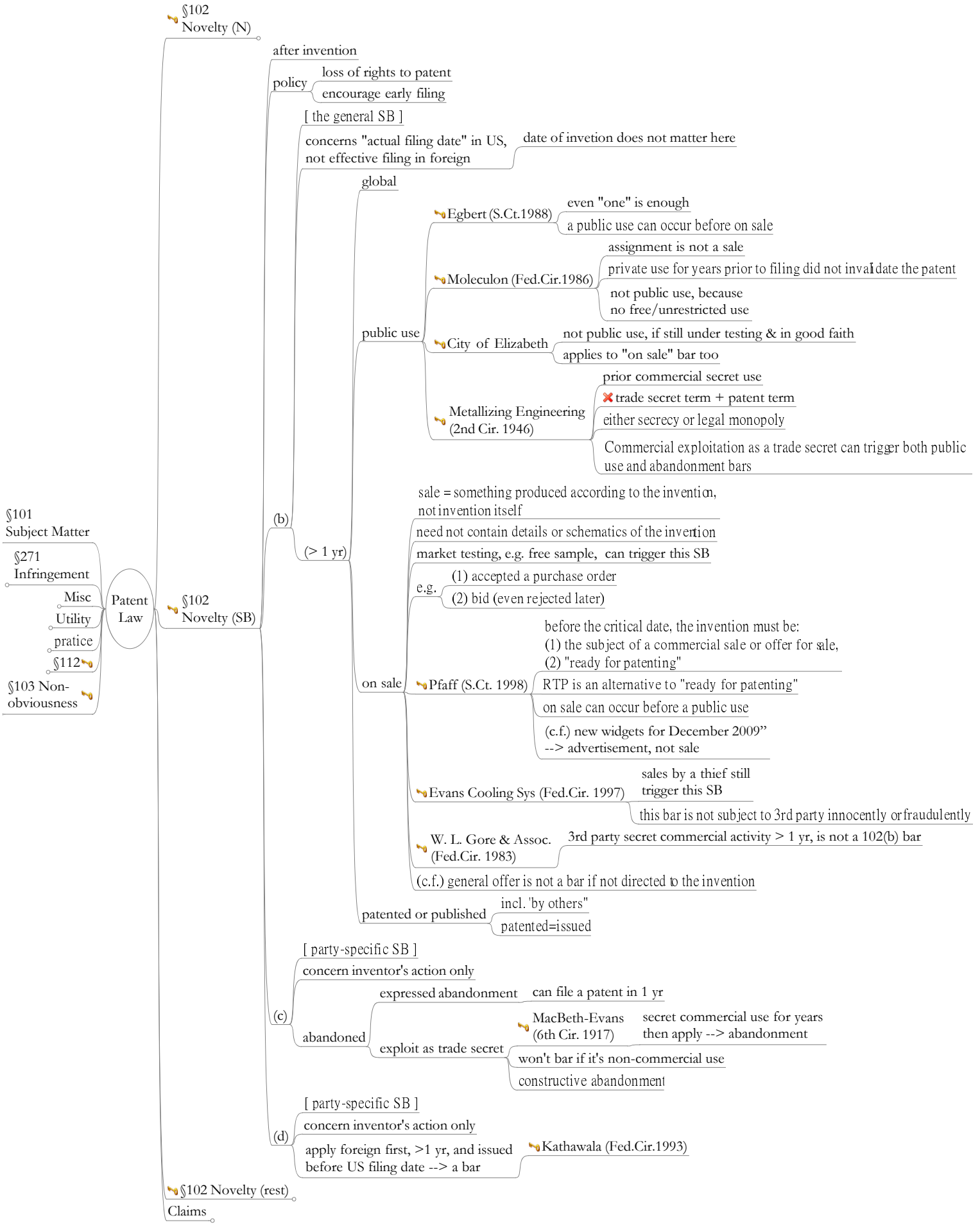


§101 Subject Matter
 §271 Infringement
 Misc Utility
 Patrice §112
 §103 Non-obviousness

Patent Law





§102 Novelty (N)

after invention

policy
loss of rights to patent
encourage early filing

[the general SB]

concerns "actual filing date" in US,
not effective filing in foreign

date of invention does not matter here

global

public use

- Egbert (S.Ct.1988)
 - even "one" is enough
 - a public use can occur before on sale
- Moleculon (Fed.Cir.1986)
 - assignment is not a sale
 - private use for years prior to filing did not invalidate the patent
 - not public use, because no free/unrestricted use
- City of Elizabeth
 - not public use, if still under testing & in good faith
 - applies to "on sale" bar too
- Metallizing Engineering (2nd Cir. 1946)
 - prior commercial secret use
 - trade secret term + patent term
 - either secrecy or legal monopoly
 - Commercial exploitation as a trade secret can trigger both public use and abandonment bars

(b)

(> 1 yr)

sale = something produced according to the invention,
not invention itself

need not contain details or schematics of the invention

market testing, e.g. free sample, can trigger this SB

- e.g.
- (1) accepted a purchase order
 - (2) bid (even rejected later)

on sale

- Pfaff (S.Ct. 1998)
 - before the critical date, the invention must be:
 - the subject of a commercial sale or offer for sale,
 - "ready for patenting"
 - RTP is an alternative to "ready for patenting"
 - on sale can occur before a public use
 - (c.f.) new widgets for December 2009" --> advertisement, not sale
- Evans Cooling Sys (Fed.Cir. 1997)
 - sales by a thief still trigger this SB
- W. L. Gore & Assoc. (Fed.Cir. 1983)
 - 3rd party secret commercial activity > 1 yr, is not a 102(b) bar
- (c.f.) general offer is not a bar if not directed to the invention

patented or published

incl. "by others"
patented=issued

[party-specific SB]

concern inventor's action only

abandoned

- expressed abandonment can file a patent in 1 yr
- exploit as trade secret
 - MacBeth-Evans (6th Cir. 1917)
 - secret commercial use for years then apply --> abandonment
 - won't bar if it's non-commercial use
 - constructive abandonment

[party-specific SB]

concern inventor's action only

- apply foreign first, >1 yr, and issued before US filing date --> a bar
- Kathawala (Fed.Cir.1993)

§102 Novelty (rest)

Claims

- §101 Subject Matter
- §271 Infringement
- Misc
- Utility
- practice
- §112
- §103 Non-obviousness

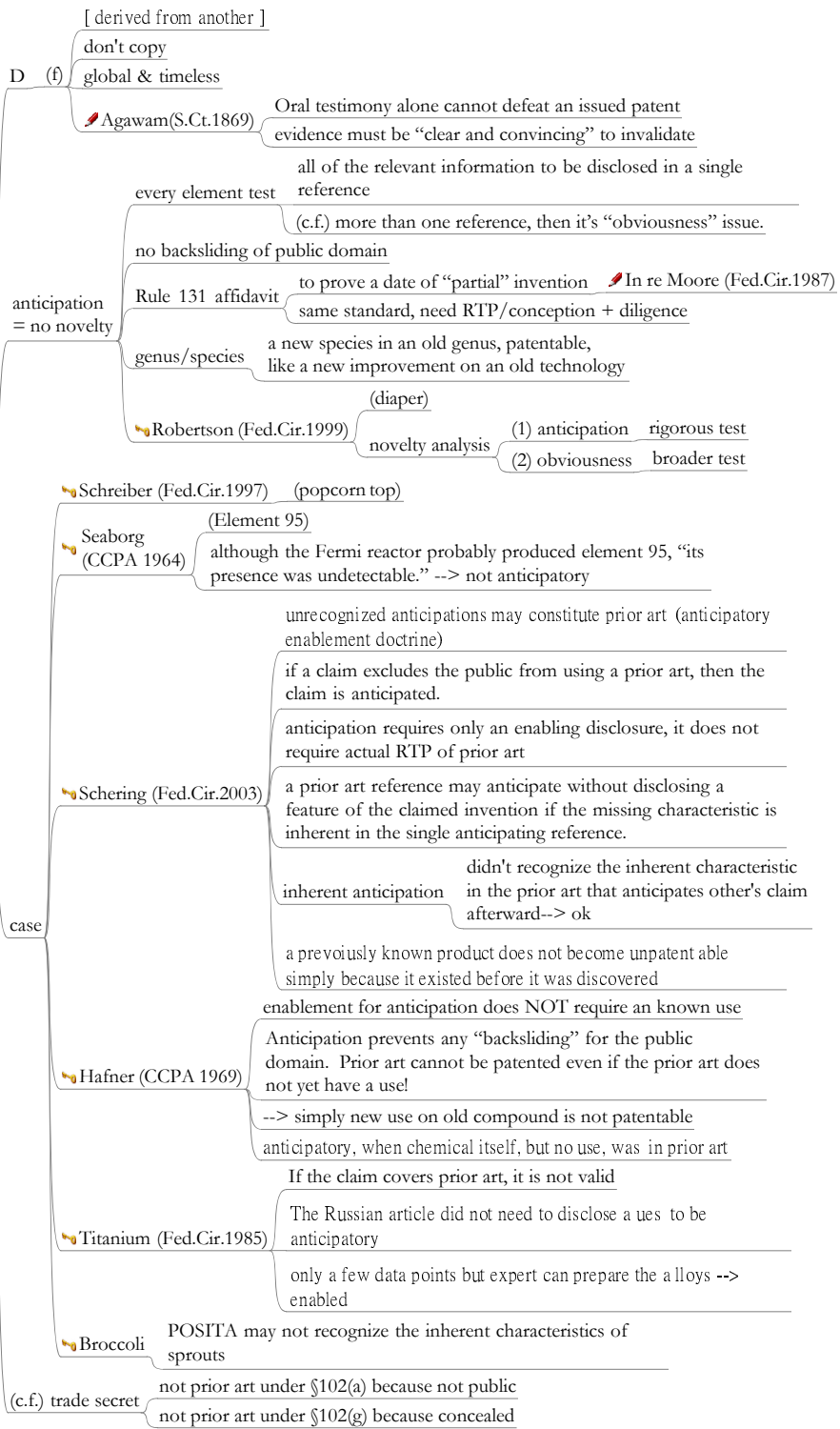
Patent Law

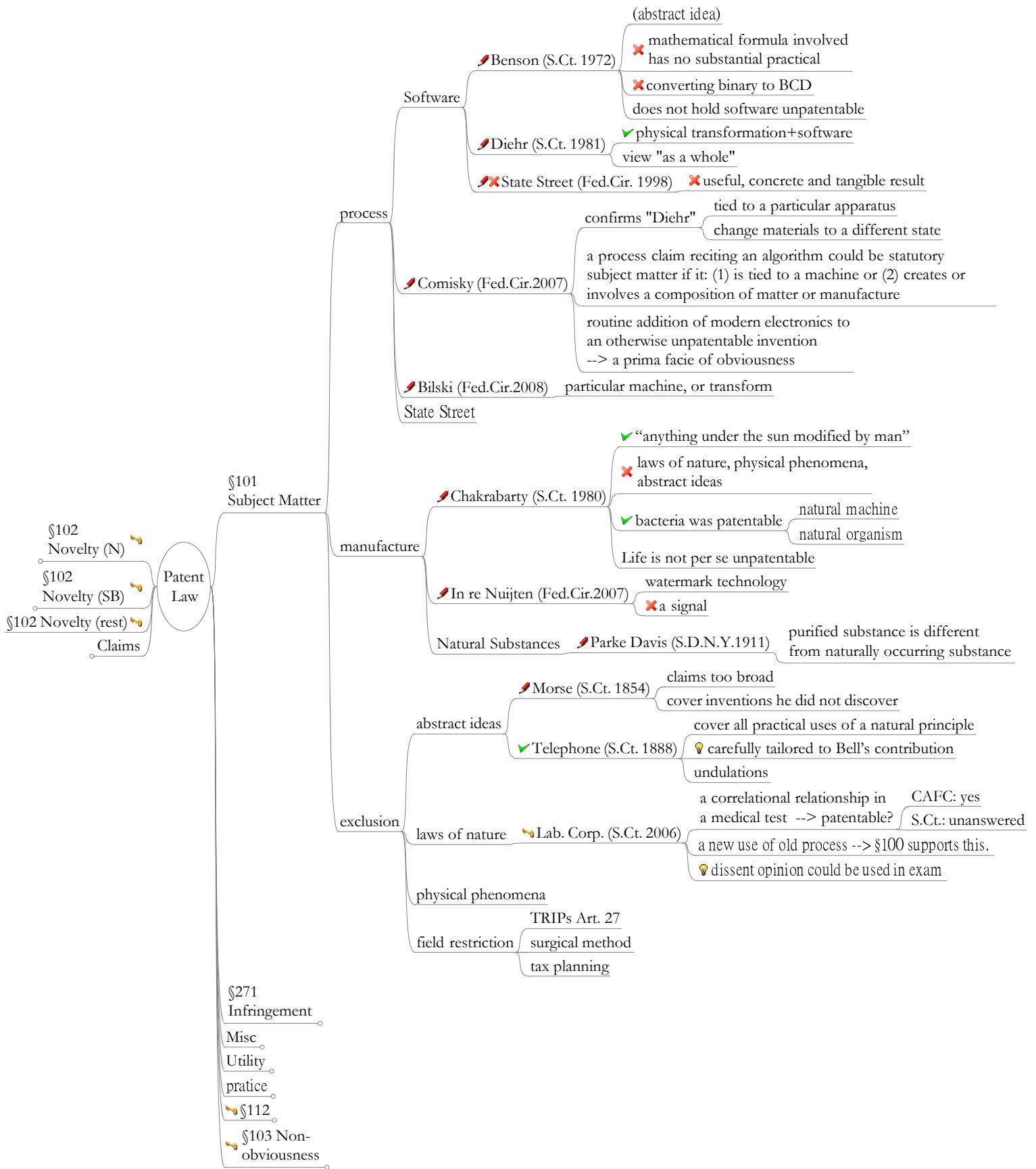
§102 Novelty (SB)

- §101 Subject Matter
- §271 Infringement
 - Misc
 - Utility
 - practice
 - §112
- §103 Non-obviousness

Patent Law

- §102 Novelty (N)
- §102 Novelty (SB)
- §102 Novelty (rest)
- Claims
 - Preamble
 - Transition
 - Body
 - claims do NOT have to enable
 - Markman (S.Ct. 1996) claim construction is an issue of law, by judge
 - application of claim is an issue of fact, by jury
 - Warner-Jenkinson (S.Ct. 1997) reaffirmed D.O.E. for claim elements
 - Festo (S.Ct. 2002) limiting D.O.E. by prosecution history estoppel issue of law
 - Phillips v. AWH (Fed.Cir. 2005) intrinsic > extrinsic
 - patentee, lexicographer
 - claim difference





§101
Subject Matter

Undue Experimentation **Amgen (Fed.Cir. 1991)**
amount of experiment cannot be unduly extensive
lack of enablement
no conception of chemical compound based solely on its biological activity
labor alone is not unreasonable experiment, if the technique is routine

purely objective

In re Fisher (CCPA 1970)
✗ open-ended claim without upper bound
It's about a degree of concentration
enabled only "1 to 2.3" but claimed "1 to infinity"
scope of enablement must at least roughly "commensurate with the scope of the claims"

Incandescent Lamp (S.Ct. 1895)
claim a broad scope and many embodiments don't work
can still need to license others' patent if it's an improvement patent

In re Wands (Fed.Cir. 1988) lack of starting materials

In re Strahilevitz (CCPA, 1982)
✓ prophetic example
only a "conceptual invention"
no working example is ok, as long as it enables POSITA to make use of invention without undue experiment

POSITA must believe that prophesy is accurate and the degree of failures must be tolerable for that art

Purdue v. Endo (Fed.Cir. 2006)
✗ prophesies misrepresented as actual results
if no enabled --> invalid

Enablement

§132 (no new matter) **Gentry Gallery (Fed.Cir. 1998)**
(fact) sectional sofa
claims may be no broader than the supporting disclosure, and therefore that a narrow disclosure will limit claim breadth

§120 earlier filing date in US continuation

standard test: "in possession" of invention
the specification must demonstrate to a person of ordinary skill that the patentee possessed what it claimed

sometimes, "enablement" applies too

Written Description

Eli Lilly (Fed. Cir. 1997)
genus/species
no need to disclose if not claimed subject matter
Every species in a genus need not be described in order that a genus meet the written description

University of Rochester (Fed.Cir. 2003)
required "enablement"
✗ function is known but what it is unknown

Lizardtech (Fed.Cir. 2005)
a claim scope in excess of the specification's embodiments invalidates the claim

Definiteness

Safety Travel Chairs (Fed.Cir. 1986)
It claims the goal instead of the trick.
does not necessarily require incredible detail
but supported by specification

§112 ¶ 2

"so dimensioned" is accurate as long as POSITHA can realize easily

Standard Oil (Fed.Cir. 1985)
the specification is the primary basis for construing the claim
claims must find clear support in the description so that the meaning may be ascertainable
issue: "partially soluble"

highly depends on POOSIA & specification

Best Mode

Randomex (Fed.Cir. 1988)
✗ trade name if no substitute
✓ trade name, having substitute
deliberate concealment of best fluid formula in a list, if not claiming prior art regarding the fluid
a laundry list is ok

best mode is "subjective" at time of filing
Chemcast (Fed.Cir. 1990)
two-step test
(1) at filing, whether patentee knew a mode considered better than others
(2) compare what he knew and what he disclosed --> is disclosure adequate to enable POSITA to practice?

Transco (Fed. Cir. 1994) "no updating" to continuation or divisional

EU doesn't need this but, better to have it, for §119 priority in later U.S. filing

inventor's knowledge only assignee does not matter

"claimed" subject matter only

¶ 6, Means-Plus-Function **Wright (S.D.N.Y.1910)** a pioneer patent, entitled to a broader construction

§103 Non-obviousness

§271 Infringement

Misc

Utility

practice

§102 Novelty (N)
§102 Novelty (SB)
§102 Novelty (rest)
Claims
Patent Law

§101
Subject Matter

§112

§102(a),(e),(g) prior art *Hazeltine(S.Ct.1965)* §102(e)
a patent is a reference as of its filing date
a secret prior art

(i) §102(f) also qualifies *Oddzon (Fed.Cir.1997)*
§102(b) *Oddzon (Fed.Cir.1997)*
§102(c)(d) *Foster (CCPA 1965)*

(ii) (?) any particular reference?
(iii) the reference is pertinent?

key: the capabilities of POSITA

(2) difference between prior art & claims *Clay (Fed.Cir.1992)* from same field?
Calmer (S.Ct. 1966) is the reference pertinent?
closure problem, not insecticide

Graham (S.Ct. 1966)

(3) level of ordinary skill in the art *Winslow (CCPA 1966)* POSITA knows all prior art, but merely ordinary creativity
patentable if (1) some pieces of technology were nonanalogous, or (2) combination was not obvious

(4) determine obvious / nonobvious *Graham* quality not disclosed in spec. is disfavored
KSR (in KSR?) predictable combinations

(5) secondary considerations
commercial success
long felt but unsolved needs
failure of others, etc.
Adams
KSR
Arkie Lures (Fed.Cir. 1997)

§102 Novelty (N)
§102 Novelty (SB)
§102 Novelty (rest)
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§103 Non-obviousness

Selden patent

KSR (S.Ct. 2007) ~~CAFC: TSM as mandatory~~
obvious to try
Obviousness is a "legal determination"
Predictability is the key

Arkie Lures (Fed.Cir.1997) skepticism of others, in favor of nonobviousness
teach away --> nonobvious

Sakraida (S.Ct. 1976) combination rule, simply arrange old elements that play known functions and yield no more than expected --> obvious

Anderson's-Black Rock (S.Ct. 1969) combination of old elements...useful...but added nothing to the nature and quality of... --> obvious

need to be greater than the sum of ...seperately

Calmer (S.Ct. 1966) test=POSITA+more knowleges

Adams (S.Ct. 1966) (fact) a wet battery
have been unexpected
known disadvantages in old devices that discourage the search for new inventions

Eibel (S.Ct. 1923) a court should "first look into the art to find what the real merit of the alleged discovery or invention is and whether it has advanced the art substantially

Hotchkiss (S.Ct. 1853) needs more ingenuity and skill
the origin of obviousness concern

103(a) Patentability shall not be negatived by the manner in which the invention was made.

concerns technical triviality, NOT economic triviality

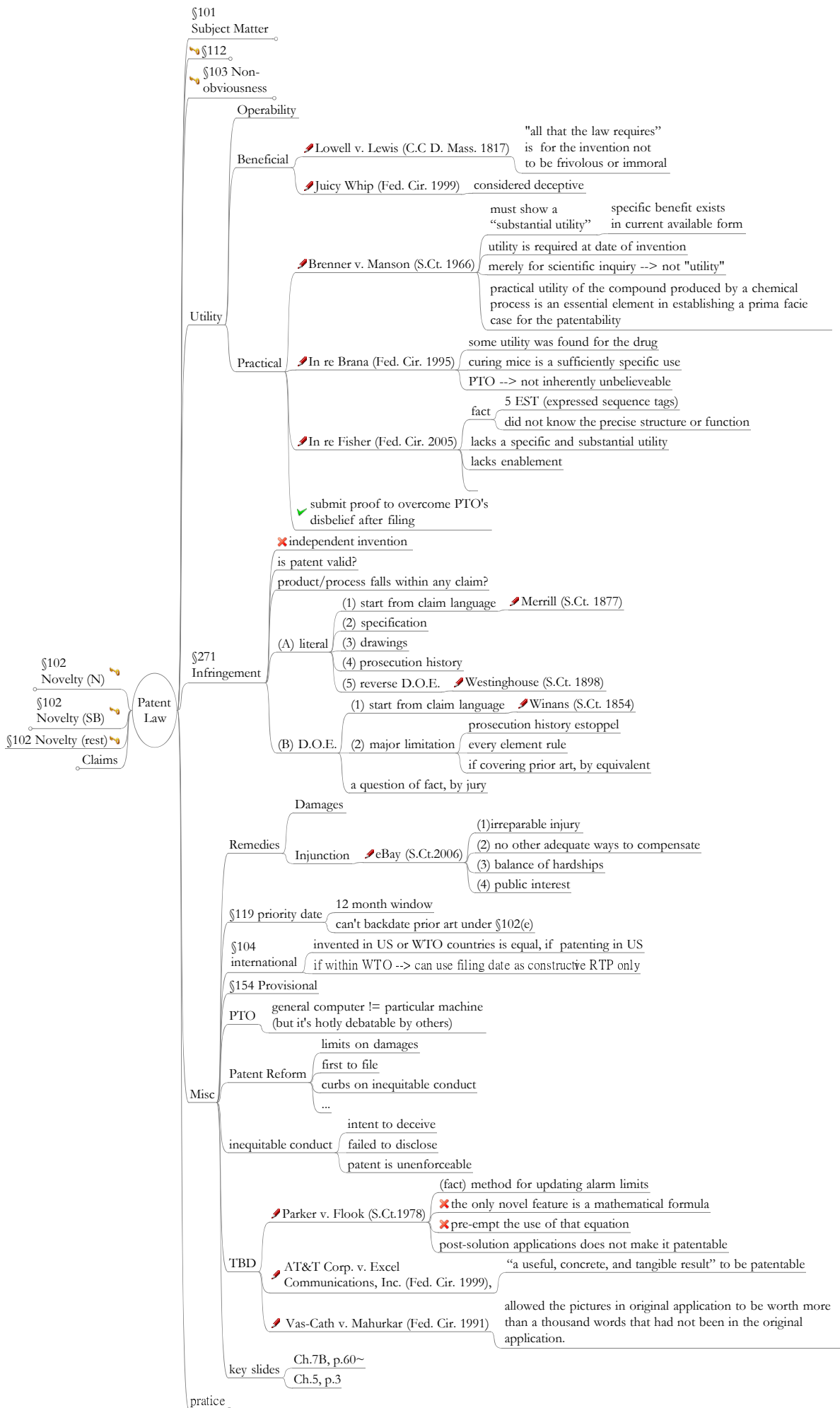
misc defense to "why not invented before" no need
timing is just right?

§271
Infringement

Misc

Utility

praticce



- §102 Novelty (N)
- §102 Novelty (SB)
- §102 Novelty (rest)
- Claims

To get the FreeMind software, you may go to
<http://freemind.sourceforge.net>



If you need the original mindmap file, please write to:

leejason@gwu.edu