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Institution **Harvard Law School**
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Course / Session **F15 Okediji - Patents**
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Count(s)	Word(s)	Char(s)	Char(s) (WS)
Section 1	1128	5420	6543
Section 2	799	4005	4802
Section 3	880	4643	5519
Total	2807	14068	16864

Answer-to-Question-_1_

1.1

The AIA adopted a "first to file" system, as opposed to the "first to invent" system that had been in place under the 1952 Patent Act. Under the AIA, an inventor is entitled to a patent unless "the claimed invention was patented, described in a printed publication, in public use, or on sale, or otherwise available to the public before the effective filing date of the claimed invention." AIA §102(a)(1). It is assumed that the AIA has incorporated most, if not all, of the common law surrounding the 1952 Patent Act, including the "on-sale" bar of §102(b). However, "a disclosure made one year or less before the effective filing date of a claimed invention shall not be prior art . . . if the disclosure was made by the inventor" AIA §102(b)(1).

Because Margo is the first to file (on 6/4/14), she will be entitled to the patent, unless Mark's sale of ABC counts as a public disclosure under §102(b)(1). This will probably be the case, since Mark's public sale of 100 units of ABC unquestionably puts ABC in the public domain. *See, e.g., Pfaff; Abbott*. Because Mark also filed for a patent application less than a year after his initial "disclosure," he does not have a problem with the on-sale statutory bar, and will be entitled to the patent.

1.2

The analysis from above remains essentially unchanged, even though Mark's sale to

Natalie is now "secret." *Pfaff*, for example, did not mention the need for the public to be aware of the fact that his invention was "on sale" - the fact that the invention *was* the subject of a commercial offer for sale was sufficient to raise the statutory bar. Indeed, in *Abbott*, the court found that the *parties to the transaction themselves* did not need to be aware of the fact that the subject of their transaction was patentable material. Margo thus cannot obtain a patent on ABC under AIA §102(a)(1) because ABC had been publicly disclosed by Mark prior to her filing. Since Mark filed his application before the 1-year grace period expired, he is entitled to a patent.

1.3

Under the 1952 Patent Act, §102(a) precludes issuance of a patent on an invention if the invention was patented . . . in this or a foreign country before the invention thereof by the applicant.

As an initial matter, Tope cannot receive a patent on A-B-C because his application does not describe a use for the invention, and therefore fails the utility requirement of §§ 101 and 112. *See also Brenner*.

The question now becomes whether Grace is entitled to a patent. This turns on whether Tope's patent application can serve as prior art to Grace's invention. Under §102(e), this can happen either if Tope's application is (incorrectly) granted, or if it is published pursuant to §122(b) of the Patent Act. However, one of these two things must occur before Tope's application will be able to anticipate Grace's under §102(e).

However, Grace may still have a problem under §102(g), since Tope can demonstrate that he both conceived and reduced A-B-C to practice before Grace's invention. Two important questions will need to be resolved at this point: 1) Whether Tope can be considered to have "invented" A-B-C for purposes of §102(g)(2) since he has not yet found a utility for A-B-C, and 2) Whether Tope had "abandoned, concealed or suppressed" A-B-C. The latter question will probably turn on how long Tope waited after conceiving and making A-B-C to file his patent application on 11/1/08, a fact that is not given. However, assuming Tope did not abandon, conceal or suppress his invention, I think it probable that a court will answer the former question affirmatively, and find that Tope did invent A-B-C for purposes of §102(g)(2), in line with cases such as *Hafner*. (It is important to note that this case is not identical to cases such as *Hafner* and *Lockwood*, since §102(a) requires a device to be *publicly* "known or used by others," a fact that we are unable to infer from the facts as presented.)

The outcome under the AIA is likely to be the same. AIA §102(a)(2) uses language similar to the 1952 Patent Act's §102(e), in that an application must be granted under published under §122 to be considered prior art. If either of these happens, then Tope's application will become prior art, precluding Grace's application to patent A-B-C. *See Hafner*.

1.4

The AIA created a "first-to-file" regime in the United States. However, the AIA also

created an exception to the first-to-file rule; a disclosure made 1 year or less before the effective filing date of a claimed invention is not prior art if the subject matter disclosed had, before such disclosure, been publicly disclosed. AIA §102(b)(1)(B).

Because Fred was the first to publicly disclose the invention, he is entitled to a patent as long as he files his patent application within one year of his public disclosure - the AIA allows an inventor to preserve his priority by publicly disclosing an invention and filing for a patent within one year. Since that is the case here, Fred will be entitled to the patent.

1.5

Since the fact pattern occurs in 2014, the AIA will apply. Since Ella's first public disclosure of the invented process (5/10/14) was not made until after Ben's patent application was filed on (5/5/14), and Ben is unquestionably the first to file, Ella cannot be entitled to the patent. Ben may be entitled to the patent as the first-to-file, as long as Ella's previous activities do not qualify as prior art references under AIA §102(a)(1).

Whether Ben is entitled to a patent thus turns on two questions: 1) Whether Ella's use of the machine was a "secret" or "public" use, and 2) Whether Ella's sale of the widgets precluded Ben's patent on the widget-making process.

Ella's use of the machine will probably be considered a secret use - although the video recordings of Ella's process were stored online, only family members and invited guests could access the recordings. There is no indication that anyone other than Connor saw the

recordings, and Connor only saw the recordings after Ben had filed his patent application. Therefore, Ella's non-informing public use of the widget-making process is likely a secret, and therefore the proper subject of a patent to anyone but Ella. *See Metallizing Engineering.*

Nor is Ella's sale of the widgets likely to be held as a bar to Ben's patenting of the widget-making process, since the widgets could not easily be reverse-engineered. This puts this case in the third-party's "secret use" area, similar to cases such as *Gore*, and Ben will be able to receive a patent. *See also Dunlop.*

Answer-to-Question-2

(I assume this question is governed entirely by the 1952 Patent Act.)

The first question that must be answered is whether the '888 patent and the '000 patent are valid - if they are not, Paynt cannot have infringed.

The '000 (product) patent faces several substantial hurdles. In the first instance, we are unsure of how long Paynt has been selling containers of paint that are identical to that disclosed in the '000 patent. If this paint had been sold prior to Matt's application on April 20, 2009, then the public use provision of §102(a) will apply, and the '000 patent will be invalid, since that which infringes, if later, anticipates, if earlier.

Even if this is not the case, however, the '000 will probably still be invalidated under §102(a). The 1990 Killit advertisement demonstrates that the chemical composition disclosed in the '000 patent was known in the art well before Matt's application, and an inventor may not receive a patent on an old product simply by discovering a new use for it. *See Hafner*. Although Matt may try to argue that his preferred embodiment of the paint used dried beet juice (which may or may not be in the prior art), this argument will also fail - it is the *claims*, not the specification, which must meet the novelty demands of §102. Since Matt broadly claimed "dried vegetable dye" in his patent, he cannot now

retroactively attempt to limit his claims to preserve validity.

The '888 (method) patent similarly presents significant problems. The most apparent is nonobviousness. Given the existence of prior art finger-painting kits, it does not seem to be a stretch to indicate that the '888 patent is a substitution of a known element (fingers) for another (elbows), with predictable results under the USPTO's post-*KSR* guidelines for nonobviousness.

Worth a passing mention is the possibility that Matt's process patent might also be voided under §102(f), if Matt was not the actual inventor of the elbow-painting process. Matt might be able to argue that Barbara's suggestion is not applicable, since Barbara's idea was that Matt paint the picture of Anna, and Matt's patent claims using a child's elbow to create the picture. However, this might present an obviousness challenge in a manner similar to *Oddz on* - an obvious alteration to Barbara's disclosed idea is to have the toddler herself use her elbows in the creation of the painting, rather than an adult painting a portrait of a toddler with his elbows.

Matt's previous actions might also create a bar to patentability under §102(b) (for both the '000 patent and the '888 patent). Matt's process patent was filed on October 20, 2010 - more than two years after his initial experiment with toddler elbow painting. Matt showed others how to make elbow paintings, and provided the special paint for a profit. These activities would easily trigger §102(b)'s on-sale bar, such that Matt would need to have filed his patent application within one year of making his painting process "publicly available." However, Matt may be able to avoid this result by pointing out that the '567

application (which became the '888 patent) was a continuation-in-part, not an entirely new application, and should therefore be given his filing date of April 20, 2009, which is within the one year grace period of §102(b).

For discussion purposes, we will assume that the '888 patent is somehow able to overcome these objections and is adjudged to be valid - I assume that the '000 cannot. Paynt now must attempt to argue that its sale of painting kits does not infringe Matt's patent. This will be governed by the doctrine of contributory infringement, since the direct infringers (purchasers of Paynt's kits) are unlikely to be identifiable, and Matt may instead pursue a remedy from Paynt. *See Aro II*. However, Paynt will probably be able to avoid even contributory infringement in this case, since there are no indications that Paynt's kits were accompanied by an instruction on how to use the paint kits to create elbow paintings. If substantial non-infringing uses exist, absent such a teaching, there is no infringement. *C.R. Bard*. That is the case here, where fingerpainting is within the prior art. Further, Matt cannot attempt to broaden the scope of his claims under the doctrine of equivalents, since he is estopped from doing so via his narrowing amendment to avoid the prior art fingerpainting kits. *Festo*.

In conclusion, it is unlikely that Matt will prevail on either of his claims - instead, both the '000 and the '888 patent will probably be determined to be invalid for lack of novelty and nonobviousness, respectively. Even if the '888 patent were able to survive validity analysis, the existence of substantial non-infringing uses would probably preclude a finding of contributory infringement by Paynt.

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Answer-to-Question-_3_

To: Judge Newman

From: Law Clerk

Re: AIA §102(a) Application to "Secret" Prior Art

This memorandum will address arguments relating to the proper interpretatino of AIA §102(a) and its applicability in the case of "secret" prior art. I find it inadvisable, both for interpretive and policy reasons, to interpret AIA §102(a) in such a way as to eliminate the category of "secret prior art" from the patent system.

First, from a purely interpretive standpoint, I do not find Senator Leahy's colloquy a necessary, or even an appropriate, interpretation of §102(a). Although §102(a)(1) frequently uses the word "public" or variations thereof, this language was also present in the 1952 Patent Act, and yet was interpreted by courts to have application in "private" contexts. Indeed, the AIA added an expansive *new* term to the categories of prior art: inventions that are "otherwise available to the public." Certainly, at least in cases such as the one discussed regarding Coca-Cola, the claimed invention is otherwise publicly available, and has been for nearly 130 years.

The Coca-Cola case provides another excellent justification for the current state of secret

prior art jurisprudence. The American intellectual property system includes multiple forms of protection; although patent is one, trade secrets also occupies an important place in IP law. The secret prior art cases essentially stand for the proposition that an inventor may select *one* of the many options available to him when protecting his invention - what is not permitted is a "double-dip," wherein an inventor exploits his product for commercial gain until competitors are able to reverse-engineer the product, then file for patent protection to eliminate the possibility of competition, at least for another 20 years.

The source of the proposed interpretation also gives rise to doubt. If Congress, in the plain text of §102(a), had stated a desire to eliminate the restriction on the patentability of "secret prior art," a far different case would be presented. Here, however, the only indication that such was Congress' intent is a colloquy of a single Senator. Concededly, as one of the bill's primary sponsors, Senator Leahy's view should be accorded significant weight. However, the change the Senator advocates is an enormous one - it would involve the overturning of dozens, if not hundreds of cases, and throw a well-settled area of law into chaos. As multiple members of the Supreme Court are fond of saying, "Congress does not hide elephants in mouseholes."

Indeed, the AIA itself contains a provision that seems to apply in precisely the situations Senator Leahy proposes to eliminate. §273 creates a prior use defense to patent infringement when an invention already in use becomes the subject of a patent. In cases such as Coca-Cola, the existence of §273 provides every incentive for Coca-Cola to keep its recipe secret; if a competitor is eventually able to reverse-engineer it, Coca-Cola will continue to be able to produce their soft drink. Of course, §273 could be read the

opposite way as well - the fact that Congress created an apparently interminable prior use defense to patent infringement indicates Congress' desire to more fully protect secret use of an invention. In the absence of a clear statement that these are Congress' desires, I cannot think that such a radical change is required.

However, I also strongly advocate against a decision that relies on the Constitution to invalidate Senator Leahy's understanding of §102(a). To invoke the Constitution in this case is to declare the judicial system the ultimate decision-maker of what policies retard "the progress and science of the useful arts," rather than Congress. This would open the door to judicial intervention in deciding what *kinds* of inventions promote science, and which are harmful or in opposition to the public good. Such a decision would represent a massive incursion of the courts into the patent system, one that previous courts have indicated an unwillingness to undertake. *See, e.g., Chakrabarty.*

Other policy arguments against Senator Leahy's arguments are, I think, equally persuasive. The patent system exists to provide incentives for inventors to disclose their creations and advance the state of human knowledge; this is what was originally thought to justify "the embarrassment of a monopoly." A system that allows (and even encourages) secrecy until the opportune moment is antithetical to such an objective. Long-standing policies of preventing the removal of publicly-accessible products from the public domain also militate against the exclusion secretly used processes and machines from prior art.

Certainly, there are advantages to Senator Leahy's proposal. Chief among them is the

promotion of certainty, and a clear, bright-line rule adjudging whether an invention is in the prior art or not. This would likely accomplish the AIA's goal of simplifying the U.S. patent system and allowing inventors (and the public) to know precisely what their rights are. However, the advantages of increased certainty in one area of patent law might come at the expense of other areas.

In conclusion, I do not believe Senator Leahy's position that the category of secret prior art was eliminated by AIA §102(a) to be a persuasive one - such a drastic policy change should be clearly textually supported, and concerns of the incentives of the patent system and its original purpose to advance human knowledge indicate the impropriety of such a result.