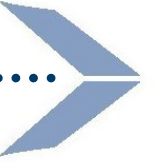




# PRIOR ART IN A LITIGATION WORLD

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# OUTLINE



- 1. PRIOR ART DEFINED**
- 2. NOT PRIOR ART**
- 3. PRIOR ART IN PRACTICE**
- 4. PRIOR ART IN LITIGATION**

- > **Prior Art**: a relative term – art or information prior in time.
  - Generally, it is information that is disclosed to the public in written or oral form, or with use, prior in time to the invention claimed in a pending patent application.
    - MPEP 901; [https://en.wikipedia.org/wiki/Prior\\_art](https://en.wikipedia.org/wiki/Prior_art)
- > 35 USC 102 is the statutory section that, in effect, legally defines 'prior art.'
  - <https://patentlyo.com/patent/2011/09/guest-post-defining-prior-art-under-the-leahy-smith-aia.html>

## PRIOR ART DEFINED



- > **Prior Art**: during examination, R. 1.56(a)(1) requires a duty to disclose prior art to the USPTO.
- > R. 1.104(a)(1) (“On taking up an application for examination ... the examiner ... shall make a thorough investigation of the available prior art relating to the subject matter of the claimed invention.”)
- > Question whether a prior art search is conducted before filing.

- > **Prior Art – Examples**: patents, patent applications, printed publications, public use.
- > Also known in the European Patent Convention as “state of the art.”
  - Sreenivasulu, N. S.; Raju, C. B. (2008). *Biotechnology and Patent Law: Patenting Living Beings*, p. 95. ISBN 9788189542313.

# NOT PRIOR ART



- > **Does not meet the statutory qualifications:** §§ 102 or 103 prior art that implicates anticipation or obviousness inquires due to the substantive disclosure (written description, enablement, etc.) or due to the timelines.
  - Prior art that cannot be verified as to publication date.
- > A company's prior filed patent application will not count as prior art (for any reason) against the company's later-filed application so long as the prior application has not published or issued by the filing-date of the later application.



> **Affidavit/declaration of attribution - R. 1.130(a):**

- > Applicant or patent owner may submit an appropriate affidavit or declaration to disqualify a disclosure as prior art by establishing that the disclosure was made by the inventor or a joint inventor, or the subject matter disclosed was obtained directly or indirectly from the inventor or a joint inventor.

- > **Affidavit/declaration of prior public disclosure - R. 1.130(b):**
- > Applicant or patent owner may submit an appropriate affidavit or declaration to disqualify a disclosure as prior art by establishing that the subject matter disclosed had, before such disclosure was made or before such subject matter was effectively filed, been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor.

- > **Prior Art – Novelty § 102(a)**: A person shall be entitled to a patent unless
- 1) the claimed invention was patented, described in a printed publication, or in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention; or ...

- > **Prior Art – Novelty § 102(a)**: A person shall be entitled to a patent unless
- 2) ) the claimed invention was described in a patent issued under section 151, or in an application for patent published or deemed published under section 122(b), in which the patent or application, as the case may be, names the effective filing date of the claimed invention.

## > Prior Art – Obviousness § 103:

- > A patent for a claimed invention may not be obtained ... if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains.

## > Prior Art – Obviousness § 103:

> The question of obviousness is resolved on the basis of underlying factual determinations including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of ordinary skill in the art; and (4) when in evidence, objective evidence of nonobviousness.

– *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

## > Prior Art – Enablement § 112:

> Although published subject matter is “prior art” for all that it discloses, in order to render an invention unpatentable for obviousness, the prior art must enable a person of ordinary skill to make and use the invention.

– *In re Kumar*, 418 F.3d 1361, 1368 (Fed. Cir. 2005)

## > Prior Art – Searched During Examination:

- Classification Search
- Keywords
- Tools and databases (OACS, eDAN, EAST, WEST, etc.)
- “It is rare that a text search alone will constitute a thorough search of patent documents.” (MPEP 904.02)
- Undated web postings cannot be relied upon (MPEP 2128)
- IDS – whether the applicant did a search?



## > Prior Art – Searched During Litigation:

- Online tools including USPTO, Google, etc.
- Search Firms, both domestic and foreign
  - AI has become a big part of prior art search techniques.
  - Foreign firms pose problems for technology that might require a foreign filing license, but they sometimes have better access to foreign prior art.
- Crowd sourced and/or success fee search groups.
- \$\$\$\$\$\$\$\$

## > Prior Art – Examination v. Litigation:

- > “If we could further narrow this gap in prior art between examination and litigation, then the accuracy of the patent grant – and therefore, its reliability – would increase.”
  - Former Director Andrei Iancu at <https://www.uspto.gov/about-us/news-updates/remarks-director-andrei-iancu-us-chamber-commerce-patent-policy-conference>

## > Prior Art – Examination v. Litigation:

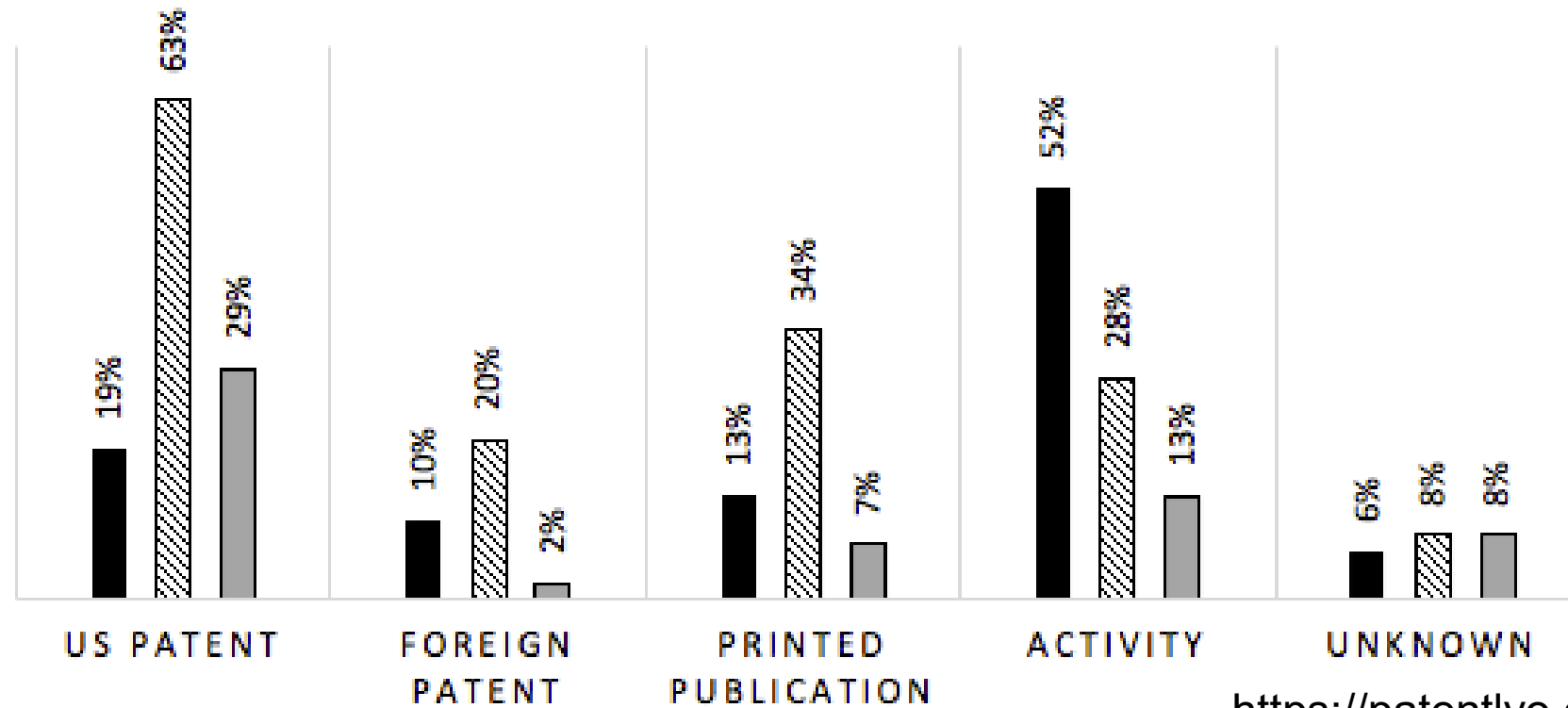
- > One author argues “that policymakers should pay more attention to the patent system’s most important tool for ensuring a patent’s quality: not § 101 or inter partes review, but prior art.”
  - Rantanen, Jason, PatentlyO Blog at <https://patentlyo.com/?s=prior+art+defined> (positing that non-patent literature is not being examined in a majority of US patent application cases, and less than European examiners).

# PRIOR ART IN LITIGATION



## Basis for Invalidity

■ Anticipation    ▨ Obviousness (any)    ■ Obviousness (all)



<https://patentlyo.com/media/2018/11/Image-2.png>

- > **Prior Art Priority to Provisional**: CAFC considers three steps:
1. First the patent challenger cites the prior art and explains its priority claim. Without challenge, the patent is deemed prior art as of its provisional filing date.
  2. Patentee can then argue that the provisional priority claim does not satisfy the Written Description, shifting the burden back to the challenger.
  3. Finally, the patent challenger must prove that the provisional provides proper support.

> **Prior User Rights Defense**: have a couple conditions...

1. An accused infringer must be able to show that it (or its predecessor in title based upon limited transfer rights) began to commercially use the invention at least one year before the patentee's filing date or public disclosure.
2. The defense only applies if the prior user's version of the invention was created independently and without derivation from the patentee's version and the prior user acted in good faith.

- > **Prior Art – Anticipation**: prior date and full disclosure.
- > Every element met in claims, including dependent claims.
- > Clear and convincing evidence standard at the district court level.
- > Broadest reasonable interpretation during IPR.

- > **Prior Art – Obviousness**: “differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious . . . to a person having ordinary skill in the art to which the claimed invention pertains.”
  - *Graham v. John Deere Co.*, 383 U.S. 1 (1966)(outlining test) and *Sup. Ct.*, 550 U.S. 398 (2007) (explaining that test should not be rigid but instead apply common sense).



> **Prior Art – Obviousness:** *Deere* factual prerequisites:

1. The scope and content of the prior art;
2. The differences between the claimed invention and the prior art;
3. The level of ordinary skill in the art;
4. Any objective indicia of nonobviousness.

- > **Prior Art – Obviousness:** In *KSR*, the Court held that the justification for such a combination can be based upon common sense or other evidence and does not require a particular teaching-suggestion-or-motivation found within the prior art itself.
- > First, must be prior art under § 102.
- > Second, must be “analogous art.”
  - What is known (1) in the same field of endeavor or (2) to be addressing the same problem

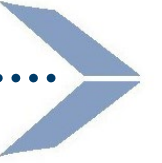
- > **Prior Art – Anticipation v Obviousness**: even split among invalidity rulings on each basis.
  - Anticipation is more relied upon in prior use cases, but does require that one reference teaches every claimed element.
  - Obviousness may offer a broader challenge with multiple references, but then secondary considerations of nonobviousness get to be considered.

- > **Prior Art – Inequitable Conduct**: requires a finding of “fraud,” “inequitable conduct,” or violation of duty of disclosure with respect to any claim in an application or patent, renders all the claims thereof unpatentable or invalid.
- > Inequitable conduct “goes to the patent right as a whole, independently of particular claims.”
  - *In re Clark*, 522 F.2d 623, 626, 187 USPQ 209, 212 (CCPA).

- > **Prior Art – Inequitable Conduct**: the duty of disclosure with respect to any claim in an application or patent.
- > For example, the failure to submit prior art that was material to the issue of patentability.
- > Prior art is not material if it is cumulative.



THANK YOU!



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*Please note: This presentation contains general, condensed summaries of actual legal matters, statutes and opinions for information purposes. It is not meant to be and should not be construed as legal advice. Individuals with particular needs on specific issues should retain the services of competent counsel.*