

## • "Congress intended statutory subject matter 'include anything under the sun that is made by man.' "Diamond v. Chakrabarty, 447 U.S. 303, 309, (U.S.,1980). FLH FROMMER LAWRENCE & HAUG UP

### • "This is not to suggest that § 101 has no limits or that it embraces every discovery. The laws of nature, physical phenomena, and abstract ideas have been held not patentable. Thus, a new mineral discovered in the earth or a new plant found in the wild is not patentable subject matter. Likewise, Einstein could not patent his celebrated law that E=mc; nor could Newton have patented the law of gravity. Such discoveries are 'manifestations of · · · nature, free to all men and reserved exclusively to none.' "Diamond v. Chakrabarty, 447 U.S. 303, 309 (1980) (internal citations omitted). • The Court held that a man-made microorganism was patentable. Id.

### **DIAMOND V. DIEHR**

 The Federal Circuit explained the holding in Diehr as follows: "mathematical algorithms are not patentable subject matter to the extent that they are merely abstract ideas." <u>State St. Bank & Trust Co. v. Signature</u> <u>Financial Group, Inc.</u>, 149 F.3d 1368, 1373 (Fed. Cir. 1998).

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### USEFUL, CONCRETE, AND TANGIBLE RESULT

- The Federal Circuit explained the difference between patentable compute programs and abstract mathematical principles, while holding a computerized process patentable:
  - "this is not a disembodied mathematical concept which may be characterized as an 'abstract idea,' but rather a specific machine to produce a useful, concrete, and tangible result." <u>In re Alappat</u>, 33 F.3d 1526, 1544 (Fed. Cir. 1994).

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### **ONE-CLICK SHOPPING**

- The trend seems to that processes that can be tied to a computer are patentable.
- See <u>Amazon.com</u>, <u>Inc. v.</u>
   <u>Barnesandnoble.com</u>, <u>Inc.</u>,
   239 F.3d 1343 (Fed. Cir. 2001) (holding patent, directed to a method of one-click shopping over the internet, valid).

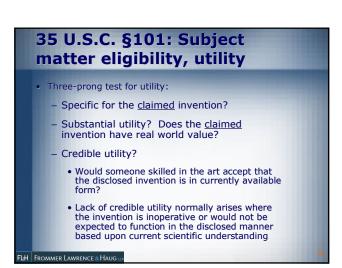
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### STATUTORY BASIS FOR INOPERABILITY

- Process Control Corp. v. HydReclaim Corp., 190
   F.3d 1350, 1359 (Fed.Cir.1999)
  - § 101 Utility
    - The impossible is not useful
  - § 112 Enablement Requirement
    - Whatever is impossible cannot be enabled

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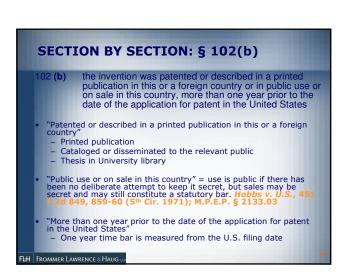
## Claims found inoperable because they require violating the principle of conservation of mass - Process Control Corp. v. HydReclaim Corp., 190 F.3d 1350, 1359 (Fed.Cir.1999) Claims to a perpetual motion machine ruled inoperable - Newman v. Quigg, 877 F.2d 1575 (Fed.Cir.1989)

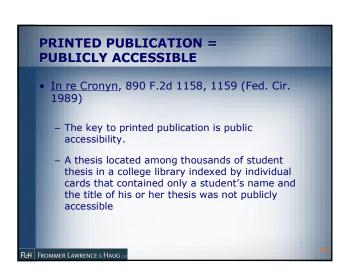


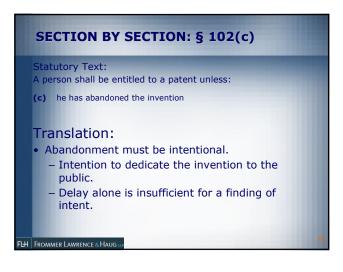


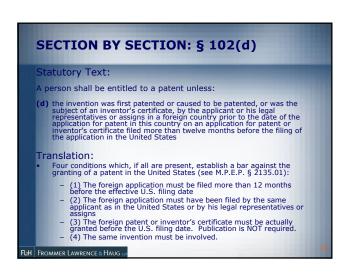


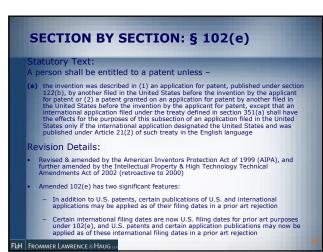
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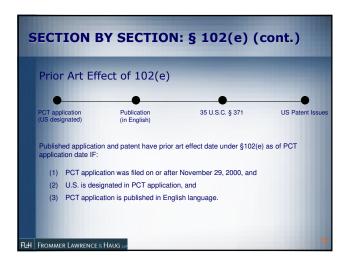


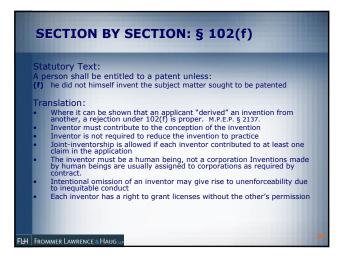




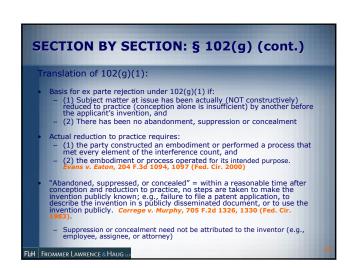








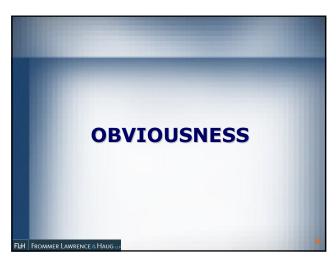
# SECTION BY SECTION: § 102(g) Statutory Text: A person shall be entitled to a patent unless: (g) (1) during the course of an interference conducted under section 135 or section 291, another inventor involved therein establishes, to the extent permitted in section 104, that before such person's invention thereof the invention was made by such other inventor and not abandoned, suppressed, or concealed, or (2) before such person's invention thereof, the invention was made in this country by another inventor who had not abandoned, suppressed, or concealed it. In determining priority of invention under this subsection, there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.



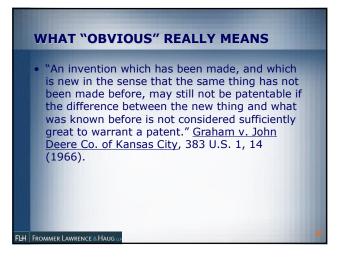
## SECTION BY SECTION: § 102(g) (cont.) Translation of 102(g)(2): "Invention was made in this country" = conception and reduction to practice (actual or constructive) in the United States. "By another" = ANY difference in inventorship (even one inventor). "Abandoned, suppressed, or concealed" = see above A previously abandoned application which was not copending with a subsequent application is evidence only of conception, and does not provide an earlier filing date based upon a constructive reduction to practice. M.P.E.P. § 2138.04. Constructive reduction to practice requires compliance with 35 U.S.C. § 112, ¶ 1. "Reasonable diligence" = reasonable attorney diligence and engineering diligence Critical period for establishing diligence for one who was first to conceive but later to reduce to practice the invention begins not at the time of conception, but just prior to the entry into the field of the party who was first to reduce to practice and continues until the first conceiver reduces to practice. M.P.E.P. § 2138.06. Affirmative acts or acceptable excuses required to show diligence for entire critical period. Critical period ends with actual or constructive reduction to practice.

PRIOR ART			
§	What?	When?	Where?
102(a)	Knowledge or Use by others OR Patented or Published	Prior to invention	Knowledge and Use = U.S.  Patented or Published = anywhere
102(b)	Patented or Published OR Used or On Sale	More than one year prior to U.S. application	Patented or Published = anywhere  Used or On Sale = U.S.
102(c)	Abandoned	Any time	Anywhere
102(d)	Patented or subject of inventor's certificate	More then one year prior to U.S. application	Foreign Country
102(e)	Described in a published application by another OR Described in a patent granted in the to another	Prior to invention	U.S., but foreign applications filed prior to November 29, 2000 receive special treatment
102(f)	Incorrect Inventorship	Any time	Anywhere
102(g)	Invention by another and not abandoned, suppressed, or concealed	Prior to applicant's invention	Anywhere for 102(g)(1) U.S. for 102(g)(2)

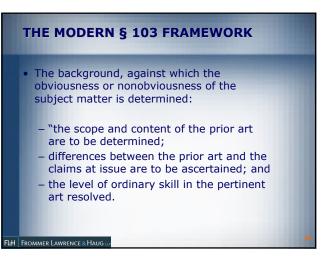




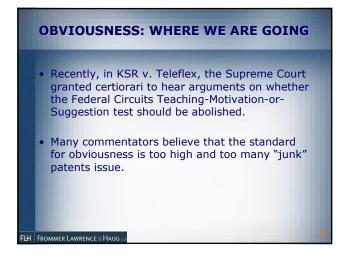
## THE FROMMER LAWRENCE & HAUGLD • An applicant is not entitled to a patent "if the difference between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains."



## • The 1952 Patent Act (The Act) codified an obviousness requirement • The Act also destroyed the "flash of genius" test • Developed the modern § 103 framework



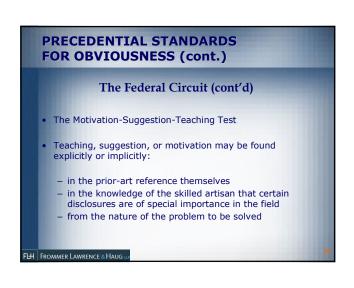
# Such secondary considerations as - commercial success, - long felt but unsolved needs, - failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have relevancy." Graham, 383 U.S. at 694.



## Many of the companies filing amicus briefs also feel the obviousness standard is too high. At oral argument, the Justices seemed to agree that the test needed to be changed. None of the justices proposed an alternative test that seems satisfactory, however.

### PRECEDENTIAL STANDARDS FOR OBVIOUSNESS The Supreme Court • Nonobviousness is ultimately a question of law that turns on "several basic factual inquiries" such as: - the scope and content of the prior art; - differences between the claims and the prior art; - the level of ordinary skill in the pertinent art; and - secondary considerations. See Graham v. John Deere Co., 383 U.S. 1, 12 (1966)

## PRECEDENTIAL STANDARDS FOR OBVIOUSNESS (cont.) The Federal Circuit • The Motivation-Suggestive-Teaching Test • When obviousness is based on multiple prior-art references, there must be some "suggestion, teaching, or motivation" that would have led a person of ordinary skill in the art to combine the relevant prior art in the manner claimed. See Abbott Labs. v. Andrx Pharmaceuticals, Inc., 452 F. 3d 1331 (Fed. Cir. 2006) In re Kahn, 441 F. 3d 977 (Fed. Cir. 2006)



### WRITTEN DESCRIPTION

- 35 U.S.C. § 112, First Paragraph
- "The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention."
- Whether a specification complies with the written description requirement is a question of fact – <u>Gentry</u> <u>Gallery</u>.

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### **PURPOSE OF WRITTEN DESCRIPTION**

- "The purpose of the written description requirement is to prevent an applicant from later asserting that he invented that which he did not. . . ." Amgen, 314 F.3d 1313.
- "The purpose ... is to ensure that the scope of the right to exclude, as set forth in the claims, does not overreach the scope of the inventor's contribution to the field of art as described in the patent specification." Reiffin II.

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### **INDEFINITENESS**

- 35 U.S.C. 112, paragraph 2:
  - The claims must "particularly point[] out and distinctly claim[] the subject matter the applicant regards as his invention."

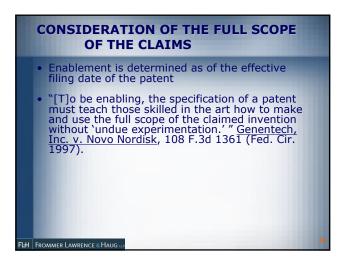
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### **ENABLEMENT**

- 35 U.S.C. § 112, First Paragraph
  - "The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention."

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## ENABLEMENT AND WRITTEN DESCRIPTION ARE DISTINCT We have interpreted [35 U.S.C. 112, paragraph 2] as requiring a "written description" of an invention separate from enablement FLH FROMMER LAWRENCE & HAUGING.



# PACTORS THE COURT CONSIDERS IN ENABLEMENT (1) the quantity of experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention,

## FACTORS THE COURT CONSIDERS IN ENABLEMENT (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims. In re Wands, 858 F.2d 731, 737 (Fed. Cir. 1988); Enzo Biochem, Inc. v. Calgene, Inc., 188 F.3d 1362 (Fed. Cir. 1999).

### Genentech

- The standard for enablement of nascent technology:
- "Where ... the claimed invention is the application of an unpredictable technology in the early stages of development, an enabling description in the specification must provide those skilled in the art with a specific and useful teaching. Genentech has not shown that the '199 patent provides that teaching." Genentech, 108 F.3d at 1367-68.

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### **BEST MODE**

- 35 U.S.C. § 112, ¶ 1
  - "The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention."

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### **BEST MODE**

• "Whether an applicant has complied with the best mode requirement of section 112 is a question of fact. . . ." <u>Bayer AG v. Schein</u> <u>Pharmaceuticals, Inc.</u>, 301 F.3d 1306, 1312 (Fed. Cir. 2002).

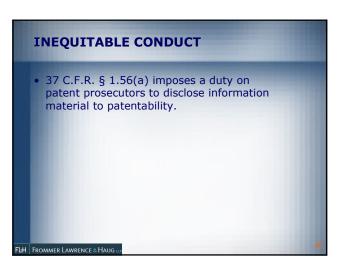
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### **BEST MODE IS A SUBJECTIVE INQUIRY**

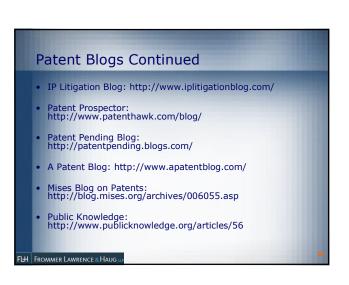
 "Unlike enablement, the existence of a best mode is a purely subjective matter depending upon what the inventor actually believed at the time the application was filed. Because of the subjective nature of the best mode inquiry, the best mode disclosure requirement-unlike enablement-cannot be met by mute reference to the knowledge of one of skill in the art. The reason is pragmatic.

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## SCOPE OF BEST MODE REQUIREMENT "[T]he best mode disclosure requirement only refers to the invention defined by the claims." Id. at 1315. Patentee was not required to disclose a "best mode" of creating two starting materials for creating the claimed compound. In re Brebner, 455 F.2d 1402 (C.C.P.A. 1972)



## Intellectual Property Blogs • The Invention Blog: http://nip.blogs.com/ • Patently-O: http://www.patentlyo.com/patent/ • Just a Patent Examiner: http://just-n-examiner.livejournal.com/ • PHOSITA: http://just-n-examiner.livejournal.com/ • Patent the Progress: http://www.promotetheprogress.com/ • The Peer to Patent Project: http://cairns.typepad.com/peertopatent/



Socratic Dialogue: "Are patents and copyrights morally justified? The philosophy of property rights and ideal objects." Tom G. Palmer, Harvard Journal of Law & Public Policy (vol. 3, no. 3, Summer 1990)

