

A Prior Art References and the Anticipation Rule

Fundamental to the bars/novelty inquiry is to ask whether the invention is new to the public, which means asking whether a single prior art reference came before the invention; how does this relate to the doctrine of anticipation, and how does that doctrine relate to claim limitations?

A prior art reference anticipates a claim when the reference has or discloses what the claim recites. The disclosure or teaching of the reference is evaluated through the perspective and knowledge of a POSITA. Finally, anticipation is often called a “four-corners” doctrine because, using the example of a printed publication as a prior art reference, the basic anticipation doctrine says that everything necessary to fit within the claim language must be found within the “four corners” of that printed publication.

Using the symbolic approach to modeling claim scope discussed in Chapter 4, consider the hypothetical claim presented in that chapter, repeated here for convenience.

A modular wall section, comprising:

an edge-wise rectangular outer metal shell where the longer side of the rectangle is within the length range of 2 feet to 5 feet;

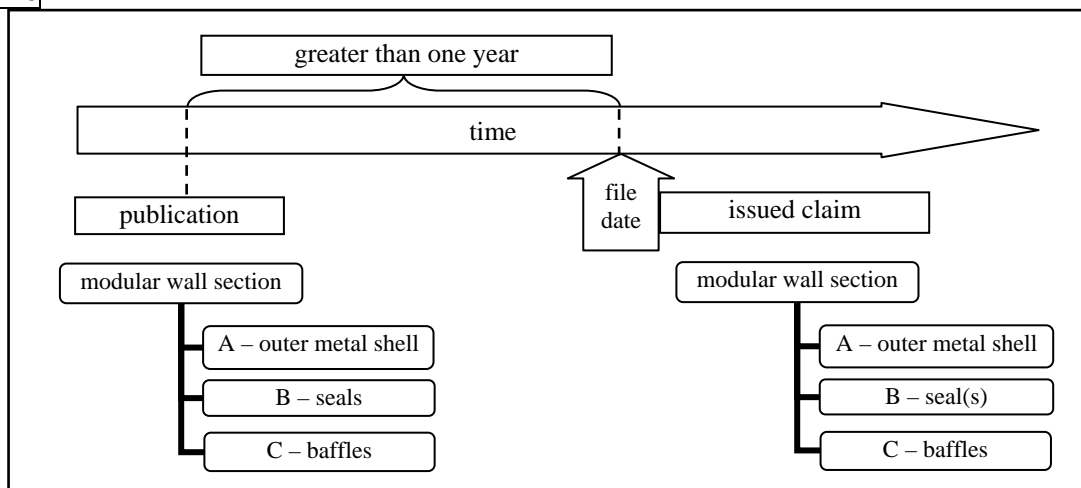
one or more seals on one or both of the shorter sides of the rectangle for interfacing with other modular wall sections; and

vertically inclined baffles extending inwardly from the outer metal shell.

Assume that three years before the U.S. filing date of the hypothetical claim, an article publishes in a German technical magazine. The article was written by a third party unrelated to the original applicant of the hypothetical claim. Most German engineers who work on structures such as modular walls subscribe to the magazine. The article describes an embodiment of what the claim recites. That is, it gives words and pictures showing a modular wall section with an outer metal shell {A}, two seals {B}, and baffles {C}; the details of which fit within the language of the hypothetical claim.

The publication in Germany is a § 102(b) claim-invalidating prior art event. It became a “printed publication” in a § 102 sense more than one year before the filing date of the application. The diagram below illustrates.

Diagram 6



To express the diagram in words, a patent lawyer might say: the § 102(b) printed publication reference disclosing ABC anticipates the claim ABC and invalidates that claim because the reference occurred more than a year before the earliest effective U.S. filing date of the claim.

Notice the phrase “earliest effective U.S. filing date.” in the prior paragraph. That phrase won’t be used elsewhere in this book’s discussion but is the most technically correct way to refer to the filing date of a U.S. patent. Hereafter, this book’s discussion will simply say “filing date” or “U.S. filing date.” However, the next few paragraphs will give a brief introduction to the meaning behind the arcane phrase “earliest effective U.S. filing date.” And, some of the cases will use the phrase.

The key concept is that a patent application can take as its filing date the filing date of a parent application. The child application would be called a continuation application.¹⁴ For example, assume a hypothetical parent application with an actual U.S. filing date of November 15, 2005. Further assume a hypothetical child application with an actual U.S. filing date of April 24, 2007. The effective U.S. filing date for the child application is the November 2005 date so long as the child application establishes “priority” to the parent. To establish priority and obtain the benefit for the child of the parent’s earlier filing date, the child application must meet a multi-prong test for priority. Parts of that test are ministerial, but one part refers back to this book’s discussion of the written description doctrine. The claims in the child application must have written description support in the originally filed disclosure of the parent. This is conceptually equivalent to the scenario discussed just before the *Gentry Gallery* case where an applicant modifies her claims during patent prosecution. Do you see why?

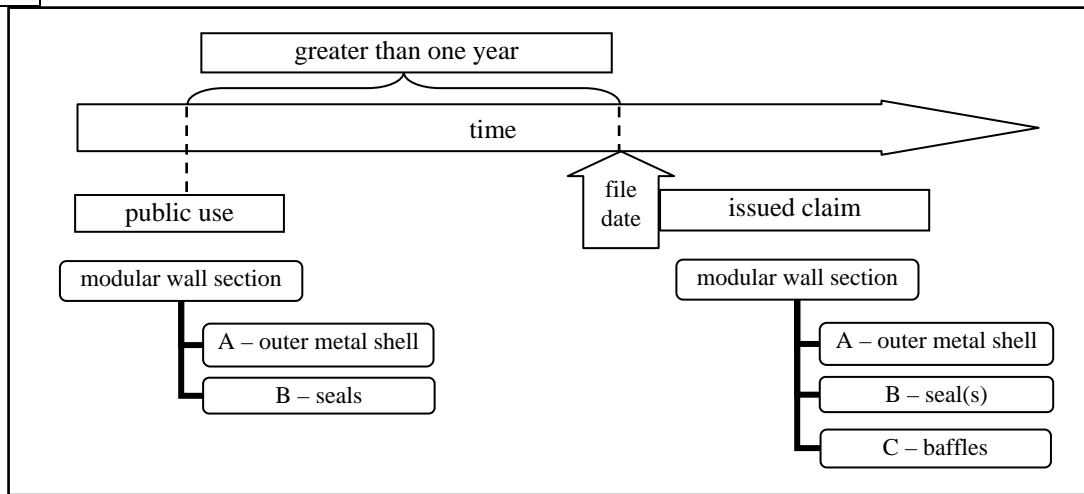
How does the earlier effective filing date help the child application? It might not. Whether it does or not depends on the prior art. For example, using the parent and child dates in the prior paragraph, assume that a printed publication by someone unrelated to the applicant appears in Brazil on December 15, 2005, and that the Brazil publication’s disclosure anticipates all claims in the child application. In this situation, without the benefit of the parental filing date, all claims of the child application are invalidated under § 102(b). Do you see why? With the benefit of the parental filing date, the Brazil “printed publication,” while fitting within the meaning of that statutory phrase in § 102(b), is not a prior art reference for the child application because it is not *prior*. For purposes of § 102(b), given the effective filing date of the child, the Brazil article did not occur early enough in time to invalidate the child’s claims.

Leaving the concepts of priority and continuation applications, the two preceding hypothetical scenarios imagined printed publications in Brazil and Germany. Under what constitutes a “printed publication” in both sections 102(b) and 102(a), it would not matter if those articles were published in Portuguese and German. An article is still a printed publication even if published in a non-English language.

Returning to the modular wall section hypothetical claim, consider the diagram below.

¹⁴ Technically, there are three names for different types of continuation applications: continuation-in-part; continuation; or divisional. Those distinctions will be put aside here.

Diagram 7



The diagram shows a public use. Its timing is stipulated to be “prior” to the § 102(b) barring date of one year before filing (typically called the “critical date”). Is the public use a prior art reference that anticipates the claim? Does the public use disclose what the claim recites? A patent lawyer might say: the prior art reference public use of AB doesn’t anticipate the claim to ABC; even though it is prior, it doesn’t invalidate the claim because it doesn’t meet the anticipation test.

Now, examine the full statutory language of sections 102(a) and 102(b).

35 U.S.C. § 102 Conditions for patentability; novelty and loss of right to patent.

A person shall be entitled to a patent unless —

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States . . .

First, notice the identical phrase in each subsection: “patented or described in a printed publication in this or a foreign country.” Patents and printed publications have the same statutory meaning in both subsections. They are both invalidating events when occurring in the U.S. or another country. Second, the timing for what makes a reference “prior” and thus potentially invalidating (if it anticipates) is different in the two subsections. This will be explored below. However, the examples in the two diagrams earlier in this chapter illustrate the timing aspect of § 102(b). Third, notice the difference between “known or used” in § 102(a) and “in public use or on sale” in § 102(b). Each of those sets of potentially claim invalidating events only operate if they occur in “this country” – in the U.S. Most of the remainder of this chapter involves further understanding the distinctions just recited.

To complete the introductory discussion concerning prior art, anticipation, and in particular one aspect of the meaning of “printed publication,” consider the following case.