Dynamic Drinkware, a Technical Trap for the Unwary

Yesterday in Dynamic Drinkware, LLC v. National Graphics, Inc., ___ F.3d ___ (Fed. Cir. 2015)(Lourie, J.)(and as reported in a note that day, attached), the court denied a patent-defeating effect to a United States patent as of its priority date to subject matter common to both a parent (provisional) application and the patent as granted under 35 USC § 102(e)(2).

The holding was keyed to In re Wertheim, 646 F.2d 527, 537 (CCPA 1981), that it is a condition for reliance upon the parent date of a patent that the patent challenger establish that the parent have a disclosure supporting the claimed invention of the patent.

Would the same decision have been reached if the patent challenger had relied upon the effective date of the published application which falls under 35 USC § 102(e)(1). It remains an open question whether Wertheim applies in the event one were to base a patent challenge on the basis of the published application as opposed to the patent, as discussed below.

More importantly, the new statutory wording of the Leahy Smith America Invents Act raises the fundamental question whether the Wertheim condition survives under the new patent law, as seen from the statute itself, also provided below.

---

* 35 USC § 102(e)(2)(pre-Leahy Smith)(“A person shall be entitled to a patent unless …the invention was described in ... a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent[.]”)(emphasis added)

“ 35 USC § 102(e)(1)(pre-Leahy Smith)(“A person shall be entitled to a patent unless …the invention was described in ...an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent[.]”)(emphasis added).
Would a Different Result have been Reached if the Patent Challenger had Relied upon 35 USC § 102(e)(1) instead of 35 USC § 102(e)(2)?

The question is raised for future litigants for cases prior to the Leahy Smith America Invents Act:

Does the condition of Wertheim have any applicability in the case of an application that will be automatically published 18 months from its priority date where the presence vel non of a patentable invention in the parent, provisional application has nothing to do with the automatic publication of the patent application on the 18 month anniversary from the priority date?

An examination of the Wertheim text (attached) shows that the entire basis for the patentability condition is that without disclosure of a patentable invention in the parent the conditions to invoke Alexander Milburn Co. v. Davis-Bournonville Co., 270 U.S. 390 (1926), would not occur based upon the parent disclosure.

But the situation today is entirely different: The automatic publication of applications 18 months from their priority date has nothing to do with whether or not a patentable invention is or is not present in an application and there is essentially no practical way that a patent could be allowed, granted and published all within 18 months from the priority date (factors which address the Milburn-based concerns in Wertheim).
Would a Different Result be Reached under the Leahy Smith America Invents Act under 35 USC § 102(a)(2) combined with 35 USC § 102(d)(2)?

Assuming, arguendo, that Wertheim were applicable to pre-Leahy Smith situations even as to the patent-defeating effect of a published application, does the same result apply under the Leahy Smith law today?

The statute reads as follows:


(a) NOVELTY; PRIOR ART.—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 another inventor and was effectively filed before the effective filing date of the claimed invention.

(d) PATENTS AND PUBLISHED APPLICATIONS EFFECTIVE AS PRIOR ART.—For purposes of determining whether a patent or application for patent is prior art to a claimed invention under subsection (a)(2), such patent or application shall be considered to have been effectively filed, with respect to any subject matter described in the patent or application—

(2) if the patent or application for patent is entitled to claim a right of priority under section 119, 365(a), or 365(b) or to claim the benefit of an earlier filing date under section 120, 121, or 365(c), based upon 1 or more prior filed applications for patent, as of the filing date of the earliest such application that describes the subject matter.

Regards,

Hal
In re Wertheim, 646 F.2d 527, 536-37 (CCPA 1981)

[The approach prior to this case was to define the scope of the patent-defeating disclosure of a parent application under 35 USC § 102(e)/103 to subject matter common to the patent and the parent application without regard as to whether an invention defined in the patent claims is also common to the parent application. Such an approach in a situation where there are continuation-in-part applications ignores the rationale behind the Supreme Court decisions in Milburn and Hazeltine that "but for" the delays in the Patent Office, the patent would have earlier issued and would have been prior art known to the public. The patent disclosure in Milburn was treated as prior art as of its filing date because at the time the application was filed in the Patent Office the inventor was presumed to have disclosed an invention which, but for the delays inherent in prosecution, would have been disclosed to the public on the filing date. A continuation-in-part application, by definition, adds new matter to the parent application previously filed. Thus, the type of new matter added must be inquired into, for if it is critical to the patentability of the claimed invention, a patent could not have issued on the earlier filed application and the theory of Patent Office delay has no application.

Additionally, it is at this point in the analysis that § 120 enters the picture, for the phrase in § 102(e), "on an application for patent," necessarily invokes § 120 rights of priority for prior co-pending applications. If, for example, the PTO wishes to utilize against an applicant a part of that patent disclosure found in an application filed earlier than the date of the application which became the patent, it must demonstrate that the earlier-filed application contains §§ 120/112 support for the invention claimed in the reference patent. For if a patent could not theoretically have issued the day the application was filed, it is not entitled to be used against another as "secret prior art," the rationale of Milburn being inapplicable, as noted above. In other words, we will extend the "secret prior art" doctrine of Milburn and Hazeltine only as far as we are required to do so by the logic of those cases.

Initially then, the question becomes the familiar one of which filing date the Pfluger patent is entitled to for various purposes, including its effectiveness as a § 102(e) reference under § 103 evidencing "prior art." [In re Lund, 376 F.2d 982 (CCPA 1967)]. It is clear that it cannot be used as a reference under § 102(e) alone against the Wertheim invention as of the date of a Pfluger application which does not describe the Wertheim invention, as claimed. See In re Smith 458 F.2d 1389 (CCPA 1972).
The conditions under which a filing date earlier than that of the last in a series of applications on which a patent issues may be accorded to a patent with respect to any given claimed subject matter are clearly set forth in § 120:

“An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States by the same inventor shall have the same effect, as to such invention, as though filed on the date of the prior application.” Emphasis ours.

The first paragraph of § 112 reads:

“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.” Emphasis ours.

We emphasize that the above noted statutes, §§ 102(e), 120, and 112, speak with reference to some specific claimed subject matter by use of the terms emphasized. It is axiomatic in patent law that questions of description, disclosure, enablement, anticipation, and obviousness can only be discussed with reference to a specific claim which identifies "the invention” referred to in the statutes.

Thus, the determinative question here is whether the invention claimed in the Pfluger patent finds a supporting disclosure in compliance with § 112, as required by § 120, in the 1961 Pfluger I application so as to entitle that invention in the Pfluger patent, as "prior art," to the filing date of Pfluger I. Without such support, the invention, and its accompanying disclosure, cannot be regarded as prior art as of that filing date.

As previously noted, new matter can add material limitations which transform an unpatentable invention, when viewed as a whole against the prior art, into a patentable one. A continuation-in-part application, unlike a continuation application, does not necessarily insure that all critical aspects of the later disclosure were present in the parent. Thus, in a situation such as this, only an application disclosing the patentable invention before the addition of new matter, which disclosure is carried over into the patent, can be relied upon to give a reference disclosure the benefit of its filing date for the purpose of supporting a §§ 102(e)/103 rejection.