

2013

“Made Available to the Public”—Understanding the Differences of the America Invents Act from the European Patent Convention in Its Definition of Prior Art

Dale Bjorkman

Gilbert Voortmans

Lindsay M. Block

Follow this and additional works at: <https://open.mitchellhamline.edu/cybaris>

Recommended Citation

Bjorkman, Dale; Voortmans, Gilbert; and Block, Lindsay M. (2013) "“Made Available to the Public”—Understanding the Differences of the America Invents Act from the European Patent Convention in Its Definition of Prior Art," *Cybaris®*: Vol. 4 : Iss. 2 , Article 1.

Available at: <https://open.mitchellhamline.edu/cybaris/vol4/iss2/1>

This Article is brought to you for free and open access by the Law Reviews and Journals at Mitchell Hamline Open Access. It has been accepted for inclusion in Cybaris® by an authorized administrator of Mitchell Hamline Open Access. For more information, please contact sean.felhofer@mitchellhamline.edu.

© Mitchell Hamline School of Law

“MADE AVAILABLE TO THE PUBLIC” – UNDERSTANDING THE DIFFERENCES OF THE AMERICA INVENTS ACT FROM THE EUROPEAN PATENT CONVENTION IN ITS DEFINITION OF PRIOR ART.

DALE BJORKMAN[†], GILBERT VOORTMANS[‡] and LINDSAY M. BLOCK[§] **

I.	INTRODUCTION	193
II.	THE STATUTES	194
III.	MEANING OF “AVAILABLE TO THE PUBLIC”	198
	A. <i>The Relevant Disclosure Must Be Available to at Least One Member of the Public</i>	198
	1. <i>Access</i>	198
	2. <i>Confidentiality</i>	199
	3. <i>When the Audience is Not Skilled in the Art</i>	201
	B. <i>The Disclosure Has to Actually Teach the Information To Be Used in Evaluation of Patentability</i>	203
	C. <i>The Technical Teaching of the Prior Art Must Be Enabled</i>	204
	1. <i>Enablement Under the EPC</i>	204
	2. <i>Enablement Under U.S. Law</i>	207
IV.	SPECIFIC CATEGORIES OF PRIOR ART	208
	A. <i>“On sale”</i>	208
	B. <i>Forfeiture</i>	210
	1. <i>Background of Forfeiture in the United States</i>	210
	2. <i>Forfeiture Under the AIA</i>	210
	3. <i>European View of Forfeiture</i>	211

[†] Partner at Kagan Binder, PLLC based in Stillwater, MN.

[‡] Manager, Office of Intellectual Property Counsel, Europe/MEA at 3M, based in Brussels, Belgium, European and Belgian Patent Attorney.

[§] Associate at Kagan Binder, PLLC.

** The opinions expressed herein are those of the authors and do not necessarily reflect the positions of their employers or clients.

C. “Public Use” 211

 1. *Experimental Use* 212

 2. *EPC View of Experimental Use*..... 213

D. *Patented or Described in a Printed Publication—Inherency* 214

 1. *Inherency in the United States*..... 214

 2. *Inherency Under the AIA*..... 215

 3. *Inherency in Europe* 216

V. CONCLUSION..... 217

I. INTRODUCTION

With enactment of the America Invents Act (AIA),¹ U.S. patent law has undergone its biggest change since at least 1952. On March 16, 2013, the final phase of this change was completed by shifting from a “first to invent” to a “first inventor to file” system.² This change is hailed as a large step towards harmonization of U.S. patent law with those of other jurisdictions in the world.

One of the key terms in § 102 of the post-AIA U.S. patent statute is “or otherwise available to the public.”³ This phrase is deceptively familiar to the European practitioner, because it is reminiscent of the definition of the state of the art in Article 54 of the European Patent Convention (EPC), which comprises “everything *made available to the public*.”⁴

While the words are very similar, practitioners both in the United States and elsewhere in the world should not be misled to believe that this similar language will lead to harmonized treatment of the definition of prior art. This article will explain what we believe to be the core philosophies that will result in a very different interpretation of the definition of available prior art.

We predict that the difference in interpretation of this phrase between the patent offices and courts of Europe and the United States will be profound. Essentially, Europeans tend to interpret this phrase to mean that the relevant public has knowledge of the invention itself through the teaching of the prior art. Under the European view, the focus is on whether the skilled artisan is able to *understand* the invention from the prior art disclosure.⁵ In contrast, U.S. practitioners focus instead on whether the object of the invention is in the public domain, and therefore may be available for use as prior art.⁶ The U.S. view focuses more on the ability to prove whether the disclosure itself can be obtained by the public. Additionally, under the U.S. system, the skilled artisan is endowed

¹ Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011).

² *Id.* § 3 (stating that the first inventor to file amendments would take effect eighteen months (Mar. 16, 2013) after the date of enactment of the Act (Sept. 16, 2011)).

³ 35 U.S.C.A. § 102(a)(1) (West 2012) (“(a) Novelty; prior art—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.”).

⁴ European Patent Convention art. 54(2), Oct. 5, 1973, 1065 U.N.T.S. 199 (as amended Nov. 29, 2000) [hereinafter EPC] (emphasis added), *available at* <http://www.epo.org/law-practice/legal-texts/html/epc/2010/e/ar54.html> (“The state of the art shall be held to comprise everything *made available to the public* by means of a written or oral description, by use, or in any other way, before the date of filing of the European patent application.”).

⁵ *See infra* notes 43–45 and accompanying text.

⁶ *See infra* notes 52–53 and accompanying text.

with an expansive ability to repair or adapt a limited prior art disclosure for use as an effective reference against a claim.

We will explain the interpretation of the meaning of “available to the public” by discussing case law of the Boards of Appeal of the European Patent Office (EPO).⁷ Additionally, we will contrast the views of the EPO with a discussion of case law of U.S. courts regarding the interpretation of relevant terms of 35 U.S.C. § 102 under the previous U.S. patent laws (the 1952 Patent Act) that are also present in the new 35 U.S.C. § 102 under the AIA.⁸ From this analysis, we will paint a possible pathway of how the new term “otherwise available to the public” might be construed in future decisions of the U.S. Patent Office and courts in the United States.

II. THE STATUTES

Relevant portions of the EPC and U.S. patent law that are addressed by the AIA and are of interest for the purpose of this article are reproduced in the table below.

EPC Art. 54 ⁹	35 U.S.C. § 102(a) ¹⁰
<p>(1) An invention shall be considered to be new if it does not form part of the state of the art.</p> <p>(2) The state of the art shall be held to comprise everything <i>made available to the public</i> by means of a written or oral description, by use, or in any other way, before the date of filing of the European patent application.</p>	<p>NOVELTY; PRIOR ART.—A person shall be entitled to a patent unless—</p> <p>(1) the claimed invention was patented, described in a printed publication, or in public use, on sale, or <i>otherwise available to the public</i> before the effective filing date of the claimed invention.</p>

As can be seen from a comparison of the relevant statutes, both contain the words “available to the public.”

⁷ See *infra* Part III.

⁸ See *infra* Part IV.

⁹ EPC, *supra* note 4, art. 54(1), (2) (emphasis added).

¹⁰ 35 U.S.C.A. § 102(a)(1) (West 2012) (emphasis added).

The European novelty requirement begins with the concept that an invention is new if it is not a part of the state of the art.¹¹ Paragraph (2) of Article 54 then defines what constitutes prior art—anything that has been made available to the public.¹² Accordingly, the novelty assessment at the EPO starts by a determination of what the prior art is and identification of the relevant portion of the disclosure. In a second step, a comparison is made between the content of that art and the invention as claimed. The EPO Boards of Appeal case law that will be reviewed in some detail below has construed the prior art as being anything made available to the public as a technical teaching (e.g., a collection of technical features).¹³ This interpretation derives from a policy or concept of rewarding new technical teachings to the world so as to thereby enhance and further technology. The purpose of EPC Article 54(1) is thus to prevent that which is already a part of the state of the art from being patented.¹⁴

New 35 U.S.C. § 102 under the AIA, although being labeled “novelty and prior art” does not define prior art *per se*, but rather begins with the concept that a person shall be entitled to a patent unless the invention was disclosed under one or more of recited categories of prior art.¹⁵ The categories of “patented, described in a printed publication, or in public use, on sale” were present in the 1952 Patent Act.¹⁶ However, a large and fairly ambiguous phrase was added to the statute. “[O]therwise available to the public” was added in the United States as a clause that modified at least the two previous novelty bars¹⁷: public use or on sale. Congressional records do not define this term except to say that the act as a whole is meant to harmonize the United States with the rest of the world.¹⁸

Comments made in the legislative history indicate that the terminology “patented, described in a printed publication, or in public use, on sale” were apparently chosen for use in the AIA because they were present in the 1952 Act,

¹¹ EPC, *supra* note 4, art. 54(1).

¹² *Id.* art. 54(2).

¹³ *See infra* Part III.

¹⁴ Bayer, [1982] T 0012/81 [E.P.O.], *available at* <http://www.epo.org/law-practice/case-law-appeals/recent/t810012ep1.html>; Hoechst, [1985] T 0198/84 [E.P.O.], *available at* <http://www.epo.org/law-practice/case-law-appeals/recent/t840198ep1.html> (citing *Bayer*).

¹⁵ 35 U.S.C.A. § 102 (West 2012).

¹⁶ *Compare* 35 U.S.C.A. § 102(a)(1) (West 2012), *with* 35 U.S.C. § 102 (2006) (“A person shall be entitled to a patent unless— . . . (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 . . .”).

¹⁷ As will be discussed in detail below, the uniformity of application of the expression “otherwise available to the public” to interpretation of prior art novelty bars is in question.

¹⁸ 157 CONG. REC. E1219 (daily ed. June 28, 2011) (extension of remarks of Rep. Smith), *available at* <http://www.gpo.gov/fdsys/pkg/CREC-2011-06-28/pdf/CREC-2011-06-28-pt1-PgE1219-2.pdf>.

and so can be understood in the context of case law. However, at least one comment managed to jumble the alternative interpretations of the statute in a single statement, asserting both that the AIA does away with private offers for sale while at the same time asserting that the public accessibility standard has not changed.¹⁹

The impact of the words “otherwise available to the public” was discussed in the congressional record as follows:

The words “otherwise available to the public” were added to section 102(a)(1) during that Congress’s Judiciary Committee mark up of the bill. The word “otherwise” makes clear that the preceding clauses describe things that are of the same quality or nature as the final clause—that is, although different categories of prior art are listed, all of them are limited to that which makes the invention “available to the public.” As the committee report notes at page 9, “the phrase ‘available to the public’ is added to clarify the broad scope of relevant prior art, as well as to emphasize the fact that it [i.e., the relevant prior art] must be publicly available.” In other words, as the report notes, “[p]rior art will be measured from the filing date of the application and will include all art that publicly exists prior to the filing date, other than disclosures by the inventor within one year of filing.”²⁰

By this interpretation, “or otherwise available to the public” should modify the four listed categories of prior art: patented, described in a printed publication, in public use, and on sale. Such an interpretation would suggest that “or otherwise

¹⁹ Senator Leahy stated:

One of the implications of the point we are making is that subsection 102(a) was drafted in part to do away with precedent under current law that private offers for sale or *private uses* or secret processes practiced in the United States that result in a product or service that is then made public may be deemed patent-defeating prior art. That will no longer be the case. In effect, the new paragraph 102(a)(1) imposes an overarching requirement for availability to the public, that is a public disclosure, which will limit paragraph 102(a)(1) prior art to subject matter *meeting the public accessibility standard that is well-settled in current law*, especially case law of the Federal Circuit.

157 CONG. REC. S1496, at S1496 (daily ed. Mar. 9, 2011) (emphasis added) (statement of Rep. Leahy), *available at* <http://www.gpo.gov/fdsys/pkg/CREC-2011-03-09/pdf/CREC-2011-03-09-pt1-PgS1496.pdf>.

²⁰ 157 CONG. REC. S1360, at S1370 (daily ed. Mar. 8, 2011) (alteration in original) (quoting S. REP. 110-259, at 9 (2008)), *available at* <http://www.gpo.gov/fdsys/pkg/CREC-2011-03-08/pdf/CREC-2011-03-08-pt1-PgS1360-2.pdf>.

available to the public” does not add a fifth category of prior art to be cited against a patent claim.

Meanwhile, multiple commentators and even the U.S. Patent Office muddy the application of this phrase by at times referring to it as a “catch all” phrase that simply collects any prior art that might not fit in the listed categories of prior art that are set forth in the statute.²¹ The Final Guidelines from the U.S. Patent Office go farther, stating:

AIA 35 U.S.C. 102(a)(1) provides a “catch-all” provision, which defines a new additional category of potential prior art not provided for in pre-AIA 35 U.S.C. 102. Specifically, a claimed invention may not be patented if it was “otherwise available to the public” before its effective filing date. This “catch-all” provision permits decision makers to focus on whether the disclosure was “available to the public,” rather than on the means by which the claimed invention became available to the public or on whether a disclosure constitutes a “printed publication” or falls within another category of prior art as defined in AIA 35 U.S.C. 102(a)(1).²²

Given this interpretation, the practitioner (and especially the European practitioner) must consider *how* this phrase “or otherwise available to the public” will be deemed to modify the previous understanding of the definition of prior art.

²¹ *American Invents Act Public Forum*, U.S. PATENT & TRADEMARK OFFICE (Mar. 15, 2013), http://www.uspto.gov/aia_implementation/FITF_Public_Training_2013mar12.pptx (slide 26); *see e.g., Otherwise Available to the Public*, POWER PATENT (Mar. 18, 2013), <http://www.powerpatent.com/blog/725-otherwise-available-to-the-public>; *First Inventor to File Patent Takes Effect on March 16, 2013*, BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP (Mar. 13, 2013), http://www.bstz.com/sites/default/files/news/AIA2_March_16_2012.pdf; Jeffery Duncan, *Why Life Sciences Needs to Reassess Their U.S. Patent Strategies*, LIFE SCIENCE LEADER, <http://www.lifescienceleader.com/magazine/past-issues3/item/4244-why-life-sciences-needs-to-reassess-their-us-patent-strategies?list=n> (last visited May 16, 2013); James Morando et al., *The America Invents Act: Key Provisions Affecting Inventors, Patent Owners, Accused Infringers and Attorneys*, http://apps.americanbar.org/litigation/committees/intellectual/roundtables/1111_outline.pdf (last visited May 16, 2013).

²² Examination Guidelines for Implementing the First Inventor To File Provisions of the Leahy-Smith America Invents Act, 78 Fed. Reg. 11,059, 11,075 (Feb. 14, 2013) [hereinafter AIA Guidelines], available at <http://www.gpo.gov/fdsys/pkg/FR-2013-02-14/pdf/2013-03450.pdf> (to be codified at 37 C.F.R. pt. 1).

III. MEANING OF “AVAILABLE TO THE PUBLIC”

While this phrase is new to U.S. practitioners, the case law of the Boards of Appeal of the EPO have construed the meaning of “available to the public” in the context of making a technical teaching available to the public. These decisions make it clear that, under the EPC, three conditions are important in determining if a disclosure is available to the public:

1. the relevant disclosure must be available to at least one member of the public,
2. the disclosure has to actually teach the information to be used in evaluation of patentability, and
3. the technical teaching of the prior art must be enabled.²³

We will examine each of these conditions in light of case law and legislative history to show how the identification of prior art under the EPC and the AIA will be significantly different, despite the apparently common language.

A. The Relevant Disclosure Must Be Available to at Least One Member of the Public

1. Access

There is likely to be agreement between the U.S. and European jurisdictions over many aspects of the first prong of the above analysis. For example, remarkably similar rules have developed under both the EPC and the U.S. 1952 Patent Act regarding the timing of when the disclosure is actually available. Basically, the question about when a journal article, paper, public presentation, and so forth can be obtained by the public is subject to the same logical analysis.²⁴

²³ EUROPEAN PATENT OFFICE, CASE LAW OF THE BOARDS OF APPEAL 69–85 (Legal Research Serv. for the Boards of Appeal ed., 6th ed. 2010) [hereinafter CASE LAW OF THE BOARDS OF APPEAL], *available at* [http://documents.epo.org/projects/babylon/eponet.nsf/0/1ae7315e321e933ec12577bd0024d650/\\$FILE/Case_law_of_the_boards_of_appeal_2010_en.pdf](http://documents.epo.org/projects/babylon/eponet.nsf/0/1ae7315e321e933ec12577bd0024d650/$FILE/Case_law_of_the_boards_of_appeal_2010_en.pdf).

²⁴ For example, while for typical printed media such as newspapers, journals and, in particular, patent publications, the date of their public availability can be easily determined from the mentioned publication date, for other printed matter this may not always be as trivial. This is the case for printed publications issued by companies such as technical brochures and sales literature. *Id.* at 72–73. Often such publications do not bear a clear publication date, or even if they do, it may not be the actual date at which the publication became accessible to the public. *See, e.g.,* *Beloit Tech., Inc. v. Voest-Alpine Industrienanlagenbau Gesellschaft m.b.H.*, [2000] T 0037/96 [E.P.O.], *available at* <http://www.epo.org/law-practice/case-law-appeals/recent/t960037eu1.html>. Also, public availability of printed matter may be determined by the date at which the particular publication is retrievable by a member of the public. Accordingly, in T 0314/99, the Board of

2. Confidentiality

Similarly, U.S. and European jurisdictions both treat agreements to keep information confidential as effective vehicles to preserve the ability to later file for patent rights. Thus, in Europe, prior use is prior art only if and when the circumstances of the prior use are such that the subject matter is available to at least one member of the public in an unrestricted way.²⁵ Information transferred under conditions of secrecy or similar restrictions, express or implied, typically prevent the disclosure from being considered to be available to the public.²⁶

An obligation of secrecy does not need to be in writing and can be a tacit agreement deriving from the particular circumstances. For example, in T 0472/92, the Board accepted that in the case of a joint venture agreement an understanding of confidentiality would normally exist between the parties, either expressly or by implication.²⁷ In another case related to uranium enrichment technology, the Board found that the very nature of this technology and project meant that everyone involved were bound by secrecy.²⁸ Likewise, in T 1076/93 the Board found that a weapon manufacturer was normally expected to behave as if an agreement of confidentiality had been specified, presumably because of the nature of that industry.²⁹

Notably, if unrestricted access to a process is provided to the public, that process will be considered to be made available to the public even if it cannot be shown that a visitor actually did receive the relevant information. For example, as

Appeal decided that the availability of a thesis was not the date on which it arrived in the university library but rather the date on which that thesis was catalogued and thus found when a search was done. *See ExxonMobil Research & Eng'g Co. v. Targor GmbH*, [2001] T 0314/99 [E.P.O.], available at <http://www.epo.org/law-practice/case-law-appeals/recent/t990314eu1.html>. Absent the cataloging, the public had no means to become aware of the thesis and hence it was not publicly available up to that time. *See, e.g., In re Hall*, 781 F.2d 897, 899–900 228 U.S.P.Q. (BNA) 453 (Fed. Cir. 1986) (stating that a single copy of a thesis cataloged in the university's library constitutes sufficient accessibility); *Protein Found., Inc. v. Brenner*, 260 F. Supp. 519, 520–21, 151 U.S.P.Q. (BNA) 561 (D.D.C. 1966) (determining that a magazine's effective prior art date is the date the publication reaches the addressee).

²⁵ *Union Carbide Corp. v. Linde AG*, [1991] T 0245/88 [E.P.O.], available at <http://www.epo.org/law-practice/case-law-appeals/recent/t880245eu1.html>.

²⁶ *Id.* (stating that that several vaporizers that had been installed in a fenced-off area of a shipyard had not been made available to the public as the public did not have unrestricted access to the relevant area).

²⁷ *Sekisui Kaseihin Kogyo Kabushiki Kaisha v. Owens-Illinois, Inc.*, [1996] T 0472/92 [E.P.O.], available at <http://www.epo.org/law-practice/case-law-appeals/recent/t920472ex1.html>.

²⁸ *Hareus Quarzglas GmbH & Co. KG v. Nikon Corp.*, [2000] T 0633/97 [E.P.O.], available at <http://www.epo.org/law-practice/case-law-appeals/recent/t970633eu1.html>.

²⁹ *Marposs Societa' per Azioni v. FAG Kugelfischer George Schäfer & Co.*, [1995] T 1076/93 [E.P.O.], available at <http://www.epo.org/law-practice/case-law-appeals/recent/t931076eu1.html>.

described in EPO Board decision T 0947/99, an ice cream making process had become available to the public when the process was shown to visitors at the manufacturing plant.³⁰ Three declarations were submitted by the opponent allegedly showing that the visitors had access to the relevant process details thus destroying the novelty of the claimed invention.³¹ Each of the three declarations additionally stated that there was no explicit or tacit agreement of confidentiality.³² The Board reasoned that although they would likely not have seen each and every detail of the process the visitors could have asked about such details and would have been given the relevant information.³³ Arriving at its decision the Board observed:

It appears to be well established in the case law of the boards of appeal that for a claimed invention to have been “made available to the public” within the meaning of Article 54(2) EPC before the relevant filing date, information equivalent to the claimed invention must have been accessible to a skilled person. As stated by the Enlarged Board in decisions G 2/88 and G 6/88 (OJ EPO 1990, 93 and 114), “the word ‘available’ carries with it the idea that, for lack of novelty to be found, all the technical features of the claimed invention in combination must have been communicated to the public, *or laid open for inspection.*”³⁴

Similarly, in T 0084/83 a new type of mirror had been fitted to cars for demonstration purposes during a period of several months prior to the effective date of the patent.³⁵ The Board held that this constituted a prior public use because the mirrors could have been inspected by a member of the public (e.g., when they were parked at public locations).³⁶ Whether or not a member of the public actually did inspect the mirror was irrelevant; the mere possibility of someone inspecting the mirror was sufficient to satisfy the criterion of “public availability.”³⁷

³⁰ Unilever PLC, v. Nestec S.A., [2003] T 0947/99 [E.P.O.], *available at* <http://www.epo.org/law-practice/case-law-appeals/recent/t990947eu1.html>.

³¹ *Id.*

³² *Id.*

³³ *Id.*

³⁴ *Id.* (emphasis added).

³⁵ Luchtenberg GmbH, [1983] T 0084/83 [E.P.O.], *available at* <http://www.epo.org/law-practice/case-law-appeals/recent/t830084du1.html>; CASE LAW OF THE BOARDS OF APPEAL, *supra* note 23, at 74.

³⁶ CASE LAW OF THE BOARDS OF APPEAL, *supra* note 23, at 74.

³⁷ *See id.*

The U.S. concept of a novelty destroying disclosure is very similar in both the protection afforded by confidentiality and whether anyone has to in fact receive the information. In the United States, once an invention is in the public domain, it is no longer patentable by anyone.³⁸ A reference has been made publically available if such document has been “disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art exercising reasonable diligence, can locate it.”³⁹

As a long-standing principle of U.S. patent law, once an inventor gives or sells his or her device to another to be used without limitation or restriction, or injunction of secrecy, such use is public.⁴⁰ This is the case even if the use and knowledge of the use is confined to one person.⁴¹ Additionally, once accessibility of a reference is shown, it is not necessary to show that anyone actually inspected or understood the reference.⁴²

3. *When the Audience is Not Skilled in the Art*

Whether or not the audience must be sufficiently skilled in the art is not in agreement between both jurisdictions. In Europe, an oral presentation, accompanied by slides, only makes an invention available to the public if a member of the public would have understood the subject matter.⁴³ In T 1212/97, a presentation was given, accompanied by slides, but no handouts were provided.⁴⁴ The Board concluded that since there was not significant proof regarding the exact content of the lecture or that anyone in the audience could have deduced the invention from the presentation given the nature of a live lecture being such that degree of comprehension of the information that is supposedly disclosed (i.e., the actual communication of information) depends on the manner or speed of the presentation as much as what is actually said.⁴⁵ In view of this lack of proof, the

³⁸ See *SRI Int’l, Inc. v. Internet Sec. Sys., Inc.*, 511 F.3d 1186, 1194, 85 U.S.P.Q.2d (BNA) 1489 (Fed. Cir. 2008) (quoting *Application of Bayer*, 568 F.2d 1357, 1361, 196 U.S.P.Q. (BNA) 670 (C.C.P.A. 1978)).

³⁹ *Brugelmyer v. Ground Heaters, Inc.*, 445 F.3d 1374, 1378, 78 U.S.P.Q.2d (BNA) 1684 (Fed. Cir. 2006) (quoting *I.C.E. Corp. v. Armco Steel Corp.*, 250 F. Supp. 738, 743, 148 U.S.P.Q. (BNA) 537 (S.D.N.Y. 1966)).

⁴⁰ 35 U.S.C.A. § 102(b) (West 2012).

⁴¹ *Egbert v. Lippmann*, 104 U.S. 333, 336 (1881).

⁴² See *In re Lister*, 583 F.3d 1307, 1314, 92 U.S.P.Q.2d (BNA) 1225 (Fed. Cir. 2009).

⁴³ *Genentech, Inc., v. Bristol-Myers Co.*, [2001] T 1212/97 [E.P.O.], available at <http://www.epo.org/law-practice/case-law-appeals/recent/t971212eu1.html>.

⁴⁴ *Id.*

⁴⁵ *Id.*

Board decided that there was insufficient evidence that the information content of the lecture was publicly available.⁴⁶

While it is difficult to predict, it seems likely that a U.S. adjudicator would focus more on the information content of the slides that were in evidence and less on whether the invention was understood by the audience.

Similarly, in T 0877/90 the Board determined that since an oral disclosure took place before a circle of persons, all of who were unable to understand its technical teachings, the oral disclosure was not considered a public disclosure.⁴⁷ “[T]he word ‘public’ in Article 54(2) EPC has the same meaning as the words ‘skilled person’ in Article 83 EPC, but whereas in the case of Article 54(2) EPC the making available to the public of a disclosure is seen from the stand-point of passive reception”⁴⁸ The decision was affirmed later when the Board of Appeal determined that a disclosure is made available to the public when the audience is able to understand and potentially able to further distribute the information to others—when there is no bar of confidentiality.⁴⁹ Again, in T 1212/97 there was no public disclosure because “[n]o instructions were provided to enable the skilled person to carry out the claimed [invention].”⁵⁰ The Board further articulated that “the subject-matter of the claim must be clearly and unambiguously disclosed in the prior publication, and also in a manner which enabled the skilled person to carry it out.”⁵¹

Under U.S. case law, the main factor is not whether the audience is skilled in the art. “It is not public knowledge of his invention that precludes the inventor from obtaining a patent for it, but a public use or sale of it.”⁵² Older precedent and U.S. Patent Office Board decisions go further to indicate that the person receiving the information does not need to understand the significance of the invention, or

⁴⁶ *Id.* The court required certainty beyond a reasonable doubt that the particular information was made available to the public. *Id.*

⁴⁷ Hooper Trading Co. N.V. v. Biotest Pharma GmbH, [1992] T 0877/90 [E.P.O.], available at <http://www.epo.org/law-practice/case-law-appeals/pdf/t900877eu1.pdf>. The court required certainty beyond a reasonable doubt that the particular information was made available to the public. *Id.*

⁴⁸ *Id.*

⁴⁹ Research Found. of State Univ. of N.Y. v. Calgene Inc., [2000] T 0838/97 [E.P.O.], available at <http://www.epo.org/law-practice/case-law-appeals/recent/t970838eu1.html>.

⁵⁰ *Genentech*, [2001] T 1212/97 [E.P.O.].

⁵¹ *Id.*

⁵² *TP Labs., Inc. v. Prof'l Positioners, Inc.*, 724 F.2d 965, 970, 220 U.S.P.Q. (BNA) 577 (Fed. Cir. 1984) (quoting *City of Elizabeth v. Am. Nicholson Pavement Co.*, 97 U.S. 126, 136 (1877)) (referring to the fact that at the time *Elizabeth* was decided the previous law required that if an invention was not kept secret one could not obtain a patent).

even to see the invention that is hidden from view as part of the larger machine.⁵³ Thus, a public use that is not understood by the receiving public was still considered to be a bar under the 1952 Patent Act.

B. The Disclosure Has to Actually Teach the Information To Be Used in Evaluation of Patentability

In the United States, the prior art category of “on sale” historically did not require that the sale be a “teaching” sale.⁵⁴ Likewise, the concept of forfeiture, which was established by case law and did not appear in the 1952 Patent Act, did not require an enabling teaching.⁵⁵ These categories of prior art are not “teaching” prior art in the sense of necessarily disclosing the *technical features* of the invention.

The EPC again stands in contrast to the U.S. approach. In a key opinion, “Availability to the Public,” the EPO Enlarged Board of Appeal applied the concept of prior use of a product and found that any information that could be derived from the publicly available product without undue burden belonged to the state of the art.⁵⁶ Whether or not there was a particular reason to analyze the product for the presence of a particular feature was irrelevant.⁵⁷

In the “Availability to the Public” opinion, the Enlarged Board of Appeal observed that an essential purpose of any technical teaching is to “enable the person skilled in the art to manufacture or use a given product by applying such teaching.”⁵⁸

Where such teaching results from a product put on the market, the person skilled in the art will have to rely on his general technical knowledge to gather all information enabling him to prepare the said product. Where it is possible for the skilled person to discover the composition or the internal structure of the product and to

⁵³ U.S. PATENT & TRADEMARK OFFICE, U.S. DEP’T OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE § 2133.03(a) (8th ed. rev. 8, Aug. 2012) [hereinafter MPEP] (citing Application of Blaisdell, 242 F.2d 779, 783, 113 U.S.P.Q. (BNA) 289 (C.C.P.A. 1957); Hall v. Macneale, 107 U.S. 90, 96–97 (1883); *Ex parte* Kuklo, No. 92-2698, 25 U.S.P.Q.2d (BNA) 1387, 1390 (B.P.A.I. Aug. 31, 1992)), available at <http://www.uspto.gov/web/offices/pac/mpep/s2133.html>.

⁵⁴ The only two requirements of the on sale bar are that the invention was offered for sale and it was ready for patenting. *Pfaff v. Wells Elecs., Inc.*, 525 U.S. 55, 67 (1998).

⁵⁵ *Mason v. Hepburn*, 13 App. D.C. 86, 95 (1898). *Mason* is cited by over 200 subsequent cases.

⁵⁶ Availability to the Public, [1992] G 1/92 [E.P.O.], available at <http://www.epo.org/law-practice/case-law-appeals/pdf/g920001ex1.pdf>.

⁵⁷ *Id.*

⁵⁸ *Id.*

reproduce it without undue burden, then both the product and its composition or internal structure [have been made available to the public and thus] become the state of the art.⁵⁹

However, the EPO Board also noted that “a commercially available product *per se* does not . . . disclose anything beyond its composition or internal structure.”⁶⁰ Extrinsic characteristics, properties, or capabilities that are only revealed when the product is exposed to specifically chosen conditions, other than those of the prior art, are not considered to be disclosed by commercially available products.⁶¹ One of the cases referred to by the Board in its opinion was G2/88, relating to the use of a known compound for a particular purpose based on a new technical effect.⁶² Such characteristics cannot be considered as already having been made available to the public, even if those characteristics are inherent.⁶³ The concept of inherency is alien to the EPC, as will be discussed later in this article.⁶⁴

C. The Technical Teaching of the Prior Art Must Be Enabled

1. Enablement Under the EPC

Boards of Appeal of the EPO have consistently interpreted Article 54(2) to include only reproducible technical teachings as prior art. For example, if a document discloses a chemical compound by its structure, the particular compound will only belong to the prior art if the document contains a teaching on how to make the compound. One of the early decisions of the Boards of Appeal illustrates this. In T 0206/83, the structure of a chemical compound was disclosed, as was its method of making.⁶⁵ However, the document failed to disclose how one skilled in the art could obtain the starting materials using only his common general knowledge.⁶⁶ It is perhaps noteworthy to point out here that patent documents can be used under the EPC to establish or prove the state of common

⁵⁹ *Id.*

⁶⁰ *Id.*

⁶¹ *Id.*

⁶² Mobil Oil Corp. v. Chevron Research Co., [1989] G 2/88 [E.P.O.], available at http://archive.epo.org/epo/pubs/oj1990/p093_185.pdf.

⁶³ *Id.*

⁶⁴ See *infra* Part IV.D.3.

⁶⁵ ICI, [1986] T 0206/83 [E.P.O.], available at <http://www.epo.org/law-practice/case-law-appeals/recent/t830206ep1.html>.

⁶⁶ *Id.*

general knowledge of one skilled in the art only in special or exceptional circumstances.⁶⁷

How a teaching in a document is read and understood by one skilled in the art may significantly change over time. Several decisions of the EPO Boards of Appeal have held that the relevant point in time to interpret the teaching of a piece of prior art for purposes of determining whether a reference enables the skilled artisan to reproduce the invention is the publication date.⁶⁸ Thus, if a particular disclosure is found to be non-enabled when read and understood at the time of its publication based on the knowledge of a skilled artisan, it cannot be used for the purpose of defeating the novelty of the claimed subject matter.

The American practitioner may start to wonder at this point, how and why this all matters: if knowledge has become available later, then the particular non-enabling disclosure would render the claimed matter obvious. This, however, ignores the sometimes-surprising effects of the problem-solution approach that is a well-established method of assessing inventive step at the EPO.⁶⁹ Under the problem-solution approach, one first identifies the closest prior art and determines the differences between the invention and the closest art.⁷⁰ Then, one determines the technical effect brought about by the difference between the invention and the closest art, which defines the *objective* technical problem to be solved.⁷¹ Finally, one examines whether the claimed solution to the objective problem is obvious to the skilled person in view of the state of the art in general.⁷² The U.S. practitioner has trouble understanding the construction of the objective problem when using the problem-solution analysis. This is because the objective problem is not the inventor’s subjective goal, but rather is a problem that is both defined by the differences between the claims and the prior art *and* that also is derivable from the

⁶⁷ Bayer CropScience S.A., [2004] T 0890/02 [E.P.O.], available at <http://www.epo.org/law-practice/case-law-appeals/recent/t020890ep1.html>.

⁶⁸ CASE LAW OF THE BOARDS OF APPEAL, *supra* note 23, at 64 (citing *Lenzing Aktiengesellschaft v. Akzo Faser AG*, [1996] T 0590/94 [E.P.O.]; *Daiichi Seiyaku Co. v. Henkel Kommanditgesellschaft auf Aktien*, [1995] T 0965/92 [E.P.O.]; *Fraunhofer-Gesellschaft v. G. Siempelkamp GmbH & Co.*, [1992] T 0205/91 [E.P.O.]).

⁶⁹ EUROPEAN PATENT OFFICE, GUIDELINES FOR EXAMINATION IN THE EUROPEAN PATENT OFFICE, pt. c, ch. IV, § 11.5 (Apr. 2010) [hereinafter EPO EXAMINATION GUIDELINES], available at

[http://documents.epo.org/projects/babylon/eponet.nsf/0/7ffc755ad943703dc12576f00054cacc/\\$FILE/guidelines_2010_complete_en.pdf](http://documents.epo.org/projects/babylon/eponet.nsf/0/7ffc755ad943703dc12576f00054cacc/$FILE/guidelines_2010_complete_en.pdf).

⁷⁰ *Id.* § 11.5.1.

⁷¹ *Id.* § 11.5.2.

⁷² *Id.*; see also G. Knesch, *Assessing Inventive Step in Examination and Opposition Proceedings in the EPO*, 3 EUR. PAT. CONVENTION, EPI INFO. 95, 95–101 (1994), available at <http://216.92.57.242/downloads/Articles/Knesch-article.pdf>.

prior art.⁷³ In fact, during European prosecution, the objective problem may change if it is decided that a different reference is more relevant, and therefore becomes the closest prior art for the problem-solution analysis.⁷⁴

As can be taken from the above outline of the problem-solution approach, the selection of the closest prior art is an important and critical step. It is well-established case law of the Boards of Appeal of the EPO that the closest prior art is not necessarily that art which has the most technical features in common with the claimed invention but rather that art which relates to a similar purpose or objective. Typically, a defective publication used in an inventive step rejection will have all the technical features in common but is for a particular reason not enabling. However, when such a publication relates to a different purpose or objective, it would likely not qualify as a starting point for the purpose of the problem-solution approach. Formulation of the problem as one of finding a way to cure the defect of the publication would then be regarded as an *ex-post facto* analysis and not an objectively formulated problem. Likely, the purpose and objective to which the claimed invention relates would provide technical effects that are not addressed or foreshadowed in a closest prior art that in addition to being defective also relates to a different purpose and objective. In other words, formulating the problem relative to such a reference, as the closest prior art, in effect amounts to disregarding one or more technical effects and thus to a technical problem that is incomplete.

Under the problem-solution approach, an inventive step rejection that identifies a defective (i.e., non-enabling) publication as the closest prior art must include cure of the defect as part of its objective technical problem. If upon cure of this objective technical problem there is still a non-trivial difference (technical effect) between the closest prior art and the claim, it is very difficult to sustain a rejection based on lack of inventive step. In principle, it is not appropriate to formulate a technical problem on only one of the technical effects achieved and ignore any of the other technical effects that have been achieved by the claimed invention, even if those effects might be seen as inherent once the defect of the publication has been cured. This makes it more likely that the “defective publication” will not be the appropriate starting point for analyzing the patentability of a claim because it may be a disclosure that is not concerned with the purpose or objective of the patent at issue.

Complications caused by selection of a non-enabling reference as the closest prior art can be illustrated by the Board’s decision in T 0835/95, relating to glass

⁷³ See Knesch, *supra* note 72, at 96.

⁷⁴ See *id.*

microspheres.⁷⁵ The opponent in that case attacked the novelty on the basis of a document that at the time of its publication did not enable the making of glass microspheres having the claimed composition.⁷⁶ When the opponent subsequently attempted to start from this document as the closest prior art, the Board stated that the document could not be considered as the closest prior art because it related to a very different purpose (i.e., laser-induced thermonuclear fusion), whereas the microspheres of the patent in suit were intended for use as light-weight fillers.⁷⁷ In essence, the opponent played their “solution card” on curing the defective publication, and could not bridge the gap between the reference and the patent claims with regard to the additional technical effects achieved in the context of microspheres as light-weight fillers.⁷⁸

2. Enablement Under U.S. Law

In contrast, U.S. patent law allows secondary evidence to demonstrate public possession. A § 102 rejection may stand even if the reference itself does not teach one of ordinary skill in the art how to make or use the article because secondary evidence may be used to close this gap and provide the enabling teaching.⁷⁹

When the claimed composition or machine is disclosed identically by the reference, an additional reference may be relied on to show that the primary reference has an “enabled disclosure.”⁸⁰ For example, two compound claims were rejected under § 102(b) over a publication in view of two patents.⁸¹ “The publication disclosed the claimed compound structure [in a non-enabling manner] while the [cited] patents taught methods of making compounds of the general class.”⁸² The court held that the publication taught all the elements of the claim

⁷⁵ *Minn. Mining & Mfg. v. Asahi Glass Co.*, [1999] T 0835/95 [E.P.O.], available at <http://www.epo.org/law-practice/case-law-appeals/recent/t950835eu1.html>.

⁷⁶ *Id.*

⁷⁷ *Id.*

⁷⁸ *See id.*

⁷⁹ *In Re Donohue*, 766 F.2d 531, 533, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985) (“Such possession is effected if one of ordinary skill in the art could have combined the publication’s description of the invention with his won knowledge to make the claimed invention.”); MPEP, *supra* note 53, § 2121.01.

⁸⁰ *Application of Samour*, 571 F.2d 559, 563, 197 U.S.P.Q. (BNA) 1 (C.C.P.A. 1978) (“Additional references cited in a rejection under 35 U.S.C. § 102(b) are not relied on for a suggestion or incentive to combine teachings to meet claim limitations (as in a rejection under 35 U.S.C. § 103), but, rather, to show that the claimed subject matter, every material element of which is disclosed in the primary reference, was in possession of the public.”); *In re Donohue*, 766 F.2d 531, 533–34 (Fed. Cir. 1985); MPEP, *supra* note 53, § 2131.01(I) (citing *Application of Samour*, 571 F.2d 559; *In re Donohue*, 766 F.2d. 531).

⁸¹ MPEP, *supra* note 53, § 2131.01.

⁸² *Id.*

and there was no need to provide a specific motivation to combine the publication with the patents to establish enablement of the publication.⁸³

The U.S. courts go even further and state that a reference is still prior art for all it teaches, even if it discloses an inoperative device.⁸⁴ For the purposes of determining obviousness, a non-enabling reference may therefore qualify as prior art.⁸⁵

IV. SPECIFIC CATEGORIES OF PRIOR ART

The answer to the question of whether a disclosure is “available to the public” begins to get very complicated when considering the categories of prior art, including the so called “secret” prior art of “on sale,” “forfeiture,” and also the special case of certain “public use” disclosures.

A. “On sale”

The U.S. 1952 Patent Act states that a sale of a product is a bar to patentability, and U.S. courts confirm this bar, whether the sale was confidential or non-confidential. Well-established case law supports the view that once a product is offered for sale the on sale bar begins. “Any attempt to use it for a profit, and not by way of experiment . . . would deprive the inventor of his right to a patent.”⁸⁶ There are two conditions that must be met before the on sale bar applies.⁸⁷ First, the product itself must be the subject of a commercial *offer* to sell, and, second, the invention must be ready for patenting.⁸⁸ A product is subject to a commercial offer for sale when the patent owner attempts to “exploit his discovery competitively.”⁸⁹ A commercial offer for sale includes both confidential and non-confidential sales.⁹⁰ Additionally, the sale does not even need to be

⁸³ *Id.*

⁸⁴ Beckman Instruments, Inc. v. LKB Produkter AB, 892 F.2d 1547, 1551, 13 U.S.P.Q.2d (BNA) 1301 (Fed. Cir. 1989).

⁸⁵ Symbol Techs., Inc. v. Opticon, Inc., 935 F.2d 1569, 1578, 19 U.S.P.Q.2d (BNA) 1241 (Fed. Cir. 1991); MPEP *supra* note 53, § 2121.01(II).

⁸⁶ City of Elizabeth v. Am. Nicholson Pavement Co., 97 U.S. 126, 137 (1877).

⁸⁷ Pfaff v. Wells Elecs., Inc., 525 U.S. 55, 67 (1998).

⁸⁸ *Id.* at 66.

⁸⁹ A product is subject to a commercial offer for sale when the patent owner attempts to “exploit his discovery competitively after it is ready for patenting; he must content himself with either secrecy, or legal monopoly.” *Id.* at 68 (quoting Metallizing Eng’g Co. v. Kenyon Bearing & Auto Parts Co., 153 F.2d 516, 520, 68 U.S.P.Q. (BNA) 54 (2d Cir. 1946)).

⁹⁰ Special Devices, Inc. v. OEA, Inc., 270 F.3d 1353, 1357, 60 U.S.P.Q.2d (BNA) 1537 (Fed. Cir. 2001) (“We see no reason why sales for the purpose of the commercial stockpiling of an invention, even if they took place in secret, should merit different treatment.”).

complete. A mere *offer* for sale is sufficient.⁹¹ In fact, there is no requirement that the invention actually be in the hands of the customer and therefore available for reverse engineering.⁹²

Under the AIA, the legislative history indicates that it is the intent of the statute to remove confidential sales as a basis of rejecting patent applications.⁹³ Therefore, the phrase “otherwise available to the public” is considered to modify the understanding of the term “on sale.”⁹⁴ Senator Kyl, one of the bill’s sponsors, further asserted that the sentence structure of the statute by its use of commas between the modifying clause “or otherwise available to the public”⁹⁵ and antecedent clauses establishes that the modifier applies to all of the antecedents.⁹⁶ The legislative history thus attempts to establish that a public availability standard is imposed on all of the categories of prior art enumerated by the bill. The U.S. Patent Office agrees stating that “[t]he ‘or otherwise available to the public’ residual clause . . . indicates that AIA 35 U.S.C. 102(a)(1) does not cover secret sales or offers for sale.”⁹⁷

⁹¹ *Seal-Flex, Inc. v. Athletic Track & Court Constr.*, 98 F.3d 1318, 1324 (Fed. Cir. 1996) (“The general rule is that the on-sale bar starts to accrue when a completed invention is offered for sale.” (citing *Baker Oil Tools, Inc. v. Geo Vann, Inc.*, 828 F.2d 1558, 1563, 4 U.S.P.Q.2d (BNA) 1210 (Fed. Cir. 1987))).

⁹² *J.A. LaPorte, Inc. v. Norfolk Dredging Co.*, 787 F.2d 1577, 1582, 229 U.S.P.Q. (BNA) 435 (Fed. Cir. 1986) (“To hold otherwise would mean adding a requirement that goods be ‘on hand’ and transferred at the time of the sale to invoke the bar, a requirement specifically rejected by this court.” (citing *Barmag Barmer Maschinenfabrik AG v. Murata Machinery, Ltd.*, 731 F.2d 831, 836, 221 U.S.P.Q. (BNA) 561 (Fed. Cir. 1984))).

⁹³ 157 CONG. REC. S5319, at S5320 (daily ed. Sept. 6, 2011) (statement of Sen. Kyl), available at <http://www.gpo.gov/fdsys/pkg/CREC-2011-09-06/pdf/CREC-2011-09-06-pt1-PgS5319-3.pdf> (“Public uses and sales of an invention will remain prior art, but only if they make the invention available to the public. An inventor’s confidential sale of his invention, his demonstration of its use to a private group, or a third party’s unrestricted but private use of the invention will no longer constitute private art. Only the sale or offer for sale of the invention to the relevant public or its use in a way that makes it publicly accessible will constitute prior art.”).

⁹⁴ See 35 U.S.C.A. § 102(a) (West 2012).

⁹⁵ *Id.*

⁹⁶ 157 CONG. REC. S1360, at S1370 (daily ed. Mar. 8, 2011) (statement of Sen. Kyl), available at <http://www.gpo.gov/fdsys/pkg/CREC-2011-03-08/pdf/CREC-2011-03-08-pt1-PgS1360-2.pdf> (“The word ‘otherwise’ makes clear that the preceding clauses describe things that are of the same quality or nature as the final clause—that is, although different categories of prior art are listed, all of them are limited to that which makes the invention ‘available to the public.’”).

⁹⁷ AIA Guidelines, *supra* note 22, at 11,075.

Senator Kyl went on to assert that the understanding of whether an invention has been made “available to the public” is the same as had been previously carried out in determining whether a reference was publicly accessible.⁹⁸

B. Forfeiture

1. Background of Forfeiture in the United States

The concept of forfeiture is that an invention that is used to commercial advantage more than a year before patent filing is barred from patenting by the party that used the invention.⁹⁹ This is a judicially created concept derived from the principle of preventing inappropriate extension of a monopoly beyond the statutory term of a patent.¹⁰⁰ This is different from the “on sale” bar set forth in 102(b), because the sale of a product produced by a secret process that is not capable of being reverse engineered is a bar only against the party that took commercial advantage of the process, and is not a bar against a third party.¹⁰¹

2. Forfeiture Under the AIA

Confusingly, the legislative history instead uses an improper broader definition of forfeiture, stating that “[t]he present bill’s elimination of the patent forfeiture doctrines in favor of a general public availability standard also limits and reconciles the various purposes that previously have been ascribed to section 102’s definition of prior art.”¹⁰²

Thus, when reading the legislative history, comments with respect to forfeiture must be read with the understanding that they relate at least to any manner that a potential patentee could lose patent rights by their own actions.

For purposes of this section, we will use the strict definition of forfeiture as a judicially created concept derived from the principle of preventing inappropriate

⁹⁸ 157 CONG. REC. at S1370 (“Whether an invention has been made available to the public is the same inquiry that is undertaken under existing law to determine whether a document has become publicly accessible, but is conducted in a more generalized manner to account for disclosures of information that are not in the form of documents.”).

⁹⁹ *Metallizing Eng’g Co. v. Kenyon Bearing & Auto Parts Co.*, 153 F.2d 516, 520, 68 U.S.P.Q. (BNA) 54 (2d Cir. 1946) (“[I]t is a condition upon an inventor’s right to a patent that he shall not exploit his discovery competitively after it is ready for patenting; he must content himself with either secrecy, or legal monopoly.”).

¹⁰⁰ *Id.*

¹⁰¹ *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1550, 220 U.S.P.Q. (BNA) 303, 310 (Fed. Cir 1983) (“There is no reason or statutory basis, however, on which [one party’s] secret commercialization of a process, if established, could be held a bar to the grant of a patent to [a different party] on that process.”).

¹⁰² 157 CONG. REC. at S1370.

extension of a monopoly beyond the statutory term of a patent.¹⁰³ It should be noted that the question of whether the AIA eliminates strictly defined “forfeiture” from the U.S. patent landscape is not without some controversy. Law Professor and blogger Dennis Crouch of PATENTLY-O has noted that the only basis in the statute for this interpretation is the residual phrase “otherwise available to the public.”¹⁰⁴ As discussed by Mr. Crouch and sources cited in his blog, this phrase may not be sufficiently explicit language to overrule a United States Supreme Court decision.¹⁰⁵ Eliminating the concept of forfeiture would necessarily entail overturning the long-standing precedent set by Judge Learned Hand in *Metallizing Engineering*, when Judge Hand stated that “it is a condition upon an inventor’s right to a patent that he shall not exploit his discovery competitively after it is ready for patenting; he must content himself with either secrecy, or [a patent].”¹⁰⁶ The legislative history does bolster the position that the AIA does eliminate forfeiture as a basis for rejecting a patent application. However, it should be noted that members of the U.S. Supreme Court indicate that the value of legislative history that does not directly address a topic is questionable.¹⁰⁷ Notably, all major patent law associations, including the AIPLA, the ABA, and the IPO have taken the position that the AIA statute does in fact overturn the concept of forfeiture.¹⁰⁸ It will ultimately be left to the U.S. courts to decide whether the AIA has effectively changed this well-established precedent.

3. *European View of Forfeiture*

Since the governing principle in Europe is that of a public teaching, it comes as no surprise that the concept of forfeiture as barring patentability is not recognized by the EPC. Indeed, as is well established within the EPC, as well as national patent laws of European countries, a secret/non-disclosing use of an invention does not make the invention “available to the public.”

C. “Public Use”

In the United States, the 1952 Patent Act stated that the public use of a product more than a year before the filing of the patent application was a bar to

¹⁰³ See *Metallizing Eng’g Co.*, 153 F.2d at 520.

¹⁰⁴ Dennis Crouch, *Did the AIA Eliminate Secret Prior Art?*, PATENTLYO (Oct. 10, 2012), <http://www.patentlyo.com/patent/2012/10/did-the-aia-eliminate-secret-prior-art.html>.

¹⁰⁵ *Id.*

¹⁰⁶ See *Metallizing Eng’g Co.*, 153 F.2d at 520.

¹⁰⁷ Robert Barnes, *Supreme Court Lawyers Cautious when Offering One Specific Piece of Evidence*, WASH. POST (Apr. 22, 2012), http://articles.washingtonpost.com/2012-04-22/politics/35452738_1_justice-sonia-sotomayor-legislative-history-lawyers-offer (Justice Scalia, for one, is notoriously skeptical of its value, stating that “‘examining the entrails of legislative history’ is a fool’s errand.”).

¹⁰⁸ Dennis Crouch, *supra* note 104.

patentability.¹⁰⁹ For example, an improved kaleidoscope was held to be in public use within the meaning of the 1952 Patent Act § 102(b) because the inventor had demonstrated the device to several guests at a party in her own home.¹¹⁰ Public use includes “any use of [the claimed] invention by a person other than the inventor who is under no limitation, restriction or obligation of secrecy to the inventor.”¹¹¹ The public use bar furthers patent policy by encouraging prompt filing and not allowing an inventor to claim things already in the public realm of knowledge.¹¹² The court considers whether the use was accessible to the public and whether it was commercially exploited.¹¹³ As discussed above in the context of confidentiality and teaching of the reference, the focus of the public use analysis has historically been whether or not the information is available, and not whether the content of the information was understood or even received by anyone.

1. *Experimental Use*

Under the 1952 Patent Act, the term “public use” is subject to the common law rule that “experimental use” is by definition not a public use.¹¹⁴ *City of Elizabeth v. American Nicholson Pavement Co.* is the case that best articulates the experimental use exception.¹¹⁵ The case involved Nicholson who invented a new pavement.¹¹⁶ He laid it in public to see the effects heavily loaded wagons had on it.¹¹⁷ The court record states that he was there almost daily checking the condition of the pavement and asking questions to those who used it.¹¹⁸ The court held that this experimental use is not a public use.¹¹⁹ “So long as he does not voluntarily allow others to make it and use it, and so long as it is not on sale for general use, he keeps the invention under his own control, and does not lose his title to a

¹⁰⁹ 35 U.S.C. § 102(b) (2006).

¹¹⁰ *Beachcombers, Int’l, Inc. v. Wildewood Creative Products, Inc.*, 31 F.3d 1154, 1159–60, 31 U.S.P.Q.2d (BNA) 1653 (Fed. Cir. 1994).

¹¹¹ *Netscape Commc’ns Corp. v. Konrad*, 295 F.3d 1315, 1320, 63 U.S.P.Q.2d (BNA) 295 F.3d 1315 (Fed. Cir. 2002) (quoting *Petrolite Corp. v. Baker Hughes Inc.*, 96 F.3d 1423, 1425, 40 U.S.P.Q.2d 1201 (Fed. Cir. 1996)).

¹¹² *Id.* (quoting *Allied Colloids Inc. v. Am. Cyanamid Co.*, 64 F.3d 1570, 1574 (Fed. Cir. 1995)).

¹¹³ *Invitrogen Corp. v. Biocrest Mfg., L.P.*, 424 F.3d 1374, 1380, 76 U.S.P.Q.2d (BNA) 1741 (Fed. Cir. 2005).

¹¹⁴ *City of Elizabeth v. Am. Nicholson Pavement Co.*, 97 U.S. 126, 135 (1877).

¹¹⁵ *Id.*; *see also* *Bruckelmyer v. Ground Heaters, Inc.*, 445 F.3d 1374, 78 U.S.P.Q.2d (BNA) 1684 (Fed. Cir. 2006).

¹¹⁶ *City of Elizabeth*, 97 U.S. at 127.

¹¹⁷ *Id.* at 133.

¹¹⁸ *Id.*

¹¹⁹ *Id.* at 134–36.

patent.”¹²⁰ Up until passage of the AIA, this negation of public use is still recognized more than 100 years later.¹²¹ The policy is to allow an inventor to perfect his invention before having to file. This allows the invention to conduct extensive research and obtain a patent even if the research takes place in public.¹²²

The AIA law itself and its legislative history does not discuss experimental use. The U.S. Patent Office has taken a wait-and-see attitude, stating:

Under pre-AIA case law, the experimental use exception negates a use that would otherwise defeat patentability. Neither the AIA nor its legislative history expressly addresses whether the experimental use exception applies to a public use under AIA 35 U.S.C. 102(a)(1), or to a use that makes the invention available to the public under the residual clause of AIA 35 U.S.C. 102(a)(1). Because this doctrine arises infrequently before the Office, and is case-specific when it does arise, the Office will approach this issue when it arises on the facts presented.¹²³

As discussed above, the legislative history does state that the terms are known from case law, which suggests that the experimental use exception is intact.¹²⁴ If this view holds, one could argue that the phrase “otherwise available to the public” does *not* modify the understanding of the term “public use,” in contrast to the interpretation that “otherwise available to the public” does modify the understanding of “on sale” as discussed above.

2. EPC View of Experimental Use

The decisions of the EPC do not contain the concept of an “experimental use” exception to exempt certain uses from the prior art. This can be particularly troubling for an applicant given the absence of a grace period in the EPC. What is decisive in establishing, whether a particular use or sale forms part of the state of the art, is the question whether the use was made available to the public. If the use was carried out in a way that restricted or imposed confidentiality on those involved with the use, then the particular use will not form part of the state of the

¹²⁰ *Id.* at 135.

¹²¹ As explained in *TP Labs., Inc. v. Prof'l Positioners, Inc.*, 724 F.2d 965, 971, 220 U.S.P.Q. (BNA) 577 (Fed. Cir. 1984), the difference between “exception” and “negation” is not merely semantic. The burden of proof is on the party attacking the validity of the patent, and the correct question to ask is “was the use a public use?”

¹²² *Pfaff v. Wells Elecs., Inc.*, 525 U.S. 55, 64 (1998).

¹²³ AIA Guidelines, *supra* note 22, at 11,063 (responding to comment 12 that questioned whether the experimental use exception to public use would continue under the AIA first inventor to file provisions).

¹²⁴ H.R. REP. NO. 110-314, at 57 (2007).

art. A number of cases of the EPO Boards of Appeal are concerned with experimental uses and sales where there was no explicit confidentiality agreement but rather an implicit confidentiality was argued.¹²⁵

D. Patented or Described in a Printed Publication—Inherency

1. Inherency in the United States

Under the 1952 Patent Act the teaching of a patent or printed publication may be used for all it fairly discloses, including “inherent disclosures.”¹²⁶

Under the doctrine of inherency, if an element is not expressly disclosed in a prior art reference, the reference will still be deemed to anticipate a subsequent claim if the missing element “is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.”¹²⁷

This doctrine applies to products sold to the public as well as published references. Thus, once a product is sold on the market, any invention that is inherent to the product becomes publicly available prior art and cannot be patented.

U.S. courts have made it clear that disclosures, either expressly or inherently, can be prior art references that can anticipate a claim.¹²⁸ If a reference is silent as to a claimed feature, extrinsic evidence may be used as a resource so long as the evidence “make[s] clear that the missing descriptive matter is necessarily present

¹²⁵ See *Tokai Rubber Indus., Ltd. v. Firma Carl Freudenberg*, [1994] T 0782/92 [E.P.O.], available at <http://www.epo.org/law-practice/case-law-appeals/recent/t920782eu1.html> (wherein the opponent had alleged a public prior use). The public prior use concerned the delivery of fifteen dampers to Daimler Benz in Stuttgart. *Id.* In view of the relatively small number of dampers involved, the Board concluded that delivery of the dampers was intended for experimental or test purposes. *Id.* However, as T 0602/91 illustrates, it is not the experimentation per se that disqualifies a use or test from public availability and thus prior art under the EPC. See CASE LAW OF THE BOARDS OF APPEAL, *supra* note 23, at 81. The opponents in this case had conducted an experiment using the patent proprietor’s invention prior to the effective date of the patent without a confidentiality agreement. *Id.* It was found that the opponent had a financial interest in disclosing the invention to the proprietor’s competitor, and so the disclosure qualified as prior art. *Id.* at 81–82.

¹²⁶ See *SmithKline Beecham Corp. v. Apotex Corp.*, 403 F.3d 1331, 1342, 74 U.S.P.Q.2d (BNA) 1398 (Fed. Cir. 2005).

¹²⁷ *Rosco, Inc. v. Mirror Lite Co.*, 304 F.3d 1373, 1380, 64 U.S.P.Q.2d (BNA) 1676 (Fed. Cir. 2002) (quoting *Cont’l Can Co. USA, Inc. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 U.S.P.Q.2d (BNA) 1746 (Fed. Cir. 1991)).

¹²⁸ *EMI Grp. N. Am., Inc. v. Cypress Semiconductor Corp.*, 268 F.3d 1342, 1350, 60 U.S.P.Q.2d (BNA) 1423 (Fed. Cir. 2001) (citing *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 771, 218 U.S.P.Q. (BNA) 781 (Fed. Cir. 1983)).

in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.”¹²⁹ Further, “Inherency is not necessarily coterminous with the knowledge of those of ordinary skill in the art. Artisans of ordinary skill may not recognize the inherent characteristics or functioning of the prior art.”¹³⁰

In a specific example, an application for a compound applied to sprouts as a fungicide is a bar to later patentability of the application of the same compound to sprouts to achieve a growth regulation effect.¹³¹ The second use, even though not recognized by the skilled artisan as providing a growth regulation effect, was inherently disclosed.¹³²

2. *Inherency Under the AIA*

The legislative history of the AIA speaks of the concept of inherency in the context of the broader concept of “forfeiture.” Specifically, Senator Kyl stated:

Another important aspect of public availability or accessibility is the doctrine of inherency. “Under the doctrine of inherency, if an element is not expressly disclosed in a prior art reference, the reference will still be deemed to anticipate a subsequent claim if the missing element is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill,” a point noted in *Rosco, Inc. v. Mirror Lite Co.*, 304 F.3d 1373, 1380 (Fed. Cir. 2002). This doctrine applies to products sold to the public as well as published references. Thus once a product is sold on the market, any invention that is inherent to the product becomes publicly available prior art and cannot be patented.¹³³

Thus, Senator Kyl asserts that the doctrine of inherency contributes content to that which is made available to the public in a reference or in a product that is sold or made publically available. This is a completely contrary position to the European practitioner’s understanding of what a reference makes “available to the public.” It is unlikely that a U.S. court would reverse this position and adopt the

¹²⁹ *Cont’l Can Co. USA*, 948 F.2d at 1268 (citing *In re Oelrich*, 666 F.2d 578, 581, 212 U.S.P.Q. (BNA) 323 (C.C.P.A. 1981)).

¹³⁰ *MEHL/Biophile Int’l Corp. v. Milgraum*, 192 F.3d 1362, 1365, 52 U.S.P.Q.2d (BNA) 1303 (Fed. Cir. 1999) (citing *In re King*, 801 F.2d 1324, 1326, 231 U.S.P.Q. (BNA) 136 (Fed. Cir. 1986)).

¹³¹ *See In re Cruciferous Sprout Litig.*, 301 F.3d 1343, 1352, 64 U.S.P.Q.2d (BNA) 1202 (Fed. Cir. 2002).

¹³² *See id.*

¹³³ 157 CONG. REC. S1360, at 1370 (daily ed. Mar. 8, 2011) (statement of Sen. Kyl).

European approach even though the words of the statutes of these jurisdictions in this aspect are substantially identical.

3. *Inherency in Europe*

Probably one of the most significant and fundamental differences in interpretations by courts in the United States and the Boards of Appeal of the EPO in the determination of what a disclosure teaches to one skilled in the art is the doctrine of inherency. EPO decisions have held that the doctrine of inherency is not compatible with the requirement of “availabil[ity] to the public” in Article 54(2) EPC.¹³⁴ In a number of decisions, the Enlarged Boards of Appeal deliberated on the use of claims whose limitation lies solely in the stated purpose. The now well-established claim format at the EPO reads as “use of compound X for the purpose Y.”¹³⁵ The Board observed: “[W]here a particular technical effect which underlies such use is described in the patent, . . . the proper interpretation of the claim will require that a functional feature should be implied into the claim, as a technical feature; for example, that the compound actually achieves the particular effect.”¹³⁶

The Enlarged Board applied this principle to a case having a second nonmedical use claim.¹³⁷ The claim read: “Use of (certain compounds) . . . for controlling fungi and for preventive fungus control.”¹³⁸ The relevant prior art disclosed the same compounds in a context of plant growth regulation.¹³⁹ The Examining Division in the appealed decision had rejected the claim for lack of novelty, apparently on the basis that the process of carrying out the invention was the same in the prior art document, and so the claimed effect (outcome) underlying the use of the compound for fungus control must have been achieved in the treatment described in the document.¹⁴⁰ In other words, the technical effect underlying the purpose limitation of the claim was inherently achieved by carrying out the prior art process. In its decision, the Enlarged Board of Appeal stated:

Under the EPC, a hidden or secret use, because it has not been made available to the public, is not a ground of objection to

¹³⁴ Mobil Oil Corp., [1989] G 2/88 [E.P.O.], OFFICIAL JOURNAL EPO (Dec. 11, 1989), available at http://archive.epo.org/epo/pubs/oj1990/p093_185.pdf (Decisions of the Enlarged Board of Appeal).

¹³⁵ *Id.*

¹³⁶ *Id.*

¹³⁷ *Id.*

¹³⁸ *Id.* at 109 (alteration in original).

¹³⁹ *Id.*

¹⁴⁰ *Id.* at 109–10.

validity of a European patent. In this respect, the provisions of the EPC may differ from the previous national laws of some Contracting States, and even from the current national laws of some non-Contracting States. Thus, the question of “inherency” does not arise as such under Article 54 EPC.¹⁴¹

It deserves mention here that the rejection of the application of the doctrine of inherency by the EPO has implications reaching well beyond the question of novelty. This difference in the permitted scope of availability of a given prior art reference as determined by what it is deemed to “make available to the public” is a key factor that may lead to a finding of inventive step in the EPO, whereas under the same set of facts, giving due consideration to what the disclosure “inherently” teaches, U.S. courts may arrive at a finding of obviousness.

V. CONCLUSION

The AIA does not achieve one of the expressly desired goals of harmonization of U.S. patent law with the patent laws of the rest of the world, even though it introduces a phrase that is familiar to European practitioners. This is, on the one hand, because the definition and core philosophy of the concept of what is appropriately available as prior art is fundamentally different. However, as the above comparison of various case law in the respective jurisdictions show, the term “available to the public” found in both the AIA and the EPC will likely be interpreted in a very different way by U.S. courts compared to the Boards of Appeal at the EPO.

While certain categories of prior art will no longer be available for citation in the United States because of the new phrase “otherwise available to the public,” such as confidential sales and secret prior art processes, other categories will likely not be disturbed. It does not appear conceivable that U.S. courts would disregard a whole body of case law pertaining to the pre-AIA law related to inherency or experimental use without clear repudiation in the plain language of the AIA. It is even less likely that U.S. courts will consider interpretation given to the similar terms by tribunals in a foreign jurisdiction. Rather, it is to be expected that U.S. courts will attempt to reconcile the pre-AIA case law with the new law. There is ample opportunity for the courts to do so because terms in 35 U.S.C. § 102 of the 1952 Patent Act¹⁴² also appear in the new 35 U.S.C. § 102 under the AIA.¹⁴³

¹⁴¹ *Id.* at 111–12.

¹⁴² 35 U.S.C. § 102 (2006).

¹⁴³ 35 U.S.C.A. § 102 (West 2012)

We must conclude that the similarity of prior art definitions between U.S. law and that of the EPC will stop at the similarity of the phrase “otherwise available to the public.” Harmonization of the evaluation of availability of many types of disclosures as prior art in the United States as compared to Europe has likely not been achieved by the AIA. On reflection, this is not surprising, given that years of harmonization of patent law in Europe have not achieved harmonization to the extent that the outcome of a particular case in one country is also the outcome in another country.¹⁴⁴ It would be an illusion to think that the amendments to the AIA would achieve such harmonization.

We are concerned that the new phrase in 35 U.S.C. § 102(a) may lead some practitioners, in particular, the European practitioner, to a false sense of security in understanding the AIA. It is to be expected that the term “available to the public” will have a significantly different interpretation in U.S. courts, as compared to how this term is typically interpreted in the EPO. It is the hope of the authors that this article will aid in avoiding confusion among practitioners on both sides of the Atlantic.

¹⁴⁴ See David Perkins & Garry Mills, *Patent Infringement and Forum Shopping in the European Union*, 20 FORDHAM INT’L L.J. 549, 549–50 (1996) (discussing forum shopping and in particular the famous *Epilady* cases).