



What is Prior Art in Today's Environment?

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by

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What is Prior Art?

- Issued patents, published applications, published articles, published information.
- Public knowledge or use in the United States by others (not the applicant).
- On sale or in public use in the United States more than one year prior to the date of the application.
- Obvious variations of the above.



What is Prior Art? (cont.)

Prior art must be publicly accessible and is defined as “any relevant knowledge, acts, descriptions, and patents which pertain to, but predate, invention in question.” Blacks’ Law Dictionary 1193 (6th ed. 1990).

Examples:

- Pictures and drawings
- U.S. and Foreign patents
- Published US and foreign patent applications
- Admissions by applicant
- Printed publications
- Documents which establish public use or sale of an invention
- Electronic publications
 - [websites](#)



Pictures and Drawings

- **Pictures and drawings can be used as prior art to the extent they show sufficient structural detail.**



U.S. and Foreign Patents

Patents are relevant prior art for:

- **The specification**
- **Non-preferred embodiments**
- **Disclosed examples**
- **Subject matter incorporated by reference**
- **Anything that would have been reasonably suggested to one having ordinary skill in the art.**



U.S. Published Patent Applications

- **Under certain conditions a rejection under 35 U.S.C. 102(e) or 103 can be made using a published U.S. patent application.**
 - **At 18 months after filing in accordance with 35 USC 122(b) and 37 CFR 211-221.**



Foreign Published Patent Applications

- Like U.S. applications, pending foreign applications are confidential until a certain stage in the patent prosecution proceedings:
 - Upon granting the patent;
 - Or until a certain date, for example, 18 months after filing, as may be specified by the patent laws of each individual country.



Printed Publications

- A reference is a printed publication if it is *accessible* to the public.
 - A reference is proven to be a “printed publication” “upon a satisfactory showing that 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.” *In re Wyer*, 655 F.2d 221, 210 USPQ 790 (CCPA 1981).



Printed Publications (cont'd)

- Orally presented papers can constitute a “printed publication” if written copies of the paper(s) are made available without restriction to all interested persons. *MIT v. AB Fortia*, 774 F.2d 1104, 1109, 227 USPQ 428, 432 (Fed. Cir. 1985).



Printed Publications (cont'd)

- **Internal documents intended to be confidential are not “printed publications” and are unavailable for use as prior art. This is regardless of how many copies are distributed.**



Printed Publications (cont'd)

“While distribution to government agencies and personnel alone may not constitute publication...distribution to commercial companies without restriction on use clearly does.” *Garrett v. United States.*, 422 F.2d 874, 878, 164 USPQ 521, 524 (Ct. Cl. 1970).



Printed Publications (cont'd)

- A publication disseminated by mail is prior art on the date it is received by at least one member of the public. *In re Schlittler*, 234 F.2d 882, 110 USPQ 304 (CCPA 1956).



Documentation and/or Admissions by Applicant

- **Applicant's own work, available to the public more than one year prior to the filing date, is prior art to everyone.**
- **Applicant's disclosure of his or her work within the year before the application filing date of the invention cannot be used as prior art against the same inventor to reject claims.**



Admissions by Applicant

- **Admissions as prior art – work of another**
 - **Statements made during prosecution;**
 - **Reference in the specification to prior art;**
 - **Jepson type claims:**
 - **presumption only – may be overcome.**



Documentation and/or Admissions by Applicant (cont.)

- **Submissions to other government agencies that are made public can be used as prior art.**
 - **E.g., U.S. Securities and Exchange Commission's EDGAR database**
<http://www.sec.gov/edgar.shtml>



Public Use or On Sale Bar (35 U.S.C. 102(b))

- An invention is in “public use” if that invention is publicly used without restriction or obligation of secrecy. There is an experimental use exception.
- A single sale or offer to sell the invention may constitute a bar to patentability.



The Evolution of Prior Art

- Both U.S. and foreign patents have, in the past, been the most relied upon form of prior art publications in patent practice
- However, in some emerging technology areas such as business methods, examiners utilize non patent literature (NPL), especially those in electronically searchable databases.
 - Federal Register notice was published in June, 2001 listing core NPL databases searched by the examiners and asking for public comment.



The Challenge of Prior Art in Today's Environment

- **It can be difficult to identify inventions that may have been common practice or common knowledge in an industry, but have not been documented, nor dated, nor disclosed in a form that is easily accessible by patent examiners.**



Electronic Publications as Prior Art

An electronic publication is considered to be a “printed publication” provided the publication was accessible to persons concerned with the art to which the document relates.



Electronic Publications

(cont'd)

Thus, "whether information is printed, handwritten, or on microfilm or magnetic disk or tape, etc., the individual who wishes to characterize the information as a printed publication...should produce sufficient *evidence of its dissemination* or that it has been otherwise *available and accessible* to persons concerned with the art to which the document relates..." *Wyer*, 655 F.2d at 227, 210 USPQ at 795, *Amazon.com v. Barnesandnoble.com*, 73 F. Supp. 2d 1228, 53 USPQ 2d 1115, 1119 (W.D. Wash. 1999)



Electronic Publications

(cont'd)

- **Prior art disclosures on the Internet or in an on-line database are considered to be publicly available as of the date the item was publicly posted.**
 - **The item must be dated and not temporal**
 - **They must be indexed for subsequent retrieval**



Websites as Prior Art

- **Websites can be used as references if posting dates can be found, and these posting dates predate the invention.**



Software Products as Prior Art

- **Software products can be relied upon as prior art as of the date they were first installed or released.**



Conclusion

- **Broadly stated, prior art is the public disclosure of claim features in a filed patent application before the filing date of that application.**
- **Prior art must be accessible to the public.**
- **In addition to the traditional sources of prior art, examiners are now focusing on electronic publications, websites and software products to examine patents.**



The End

Thank You