

Chapter 17

Novelty

Objectives

Part A – Understand the concept of novelty. Apply the rules for determining novelty under AIA and pre-AIA regimes (including statutory bars).

Part B – Understand how and why courts apply special meanings to “on sale”; “printed publication”; “public use”, and “experimental use” in determining issues relating to novelty and statutory bars.

Part C – Understand the concept of priority. Apply the pre-AIA rules relating to priority disputes.

Teaching Tip: Novelty introduces new terminology and foreign concepts for many students. Examples are imperative to ensure comprehension. Consider budgeting an hour for Part A’s description of rule mechanics.

Introduction to Novelty

- Start the discussion of novelty on a basic level, explaining that novelty is about the *newness* of an invention. State the rule simply: An invention must be new to be patentable. This is intuitive to students.
- Ask students why we have the novelty requirement. (The legal monopoly of patent law imposes a cost on society, removing the invention from the public domain.)
- Remind students that *each claim* is evaluated for novelty. One claim may lack novelty, whereas other claims in a patent application may be valid and enforceable.

PART A – STATUTORY RULES

Terminology dealing with novelty quickly bewilders students. Take time to teach the meanings of these new terms: *prior art*; *anticipation*; *reference*; *priority date*. Walk through a simple example that employs these terms. Show the “Richard & Hillary” example from the PPT slides.

Two Sets of Rules

Another source of confusion for students is the difference between the AIA and pre-AIA regimes. Spend time emphasizing that two distinct sets of rules govern the issue of novelty. Emphasize the importance of the filing date as the means for determining which set of rules governs. March 16, 2013 should be rote for students. Teach each set of rules separately.

Pre-AIA

List the novelty-defeating prior art (i.e., public use; printed publication; patent or application). At this point, I do not go into detail as to the meanings of these terms; that will come in Part B. Simply emphasize that if one of these events occur prior to the *invention date*, the invention lacks novelty.

After explaining novelty-defeating prior art, introduce the *statutory bars* as a sort of novelty-defeating provision. (You might mention, though, that case law does not employ the term *novelty* in referring to the statutory bars, even though the statutory bars have the effect of precluding patent validity based on earlier activity.) Emphasize that statutory bars concern the *filing date*: certain activities cannot occur more than one year before the filing date. At this point, explain that *critical date* is a label meaning more than one year before the filing date. Explain that in many instances, statutory bars apply to inventor's own activity.

AIA

List the novelty-defeating prior art (i.e., public use; printed publication; on sale; otherwise available to public). Emphasize that if this prior art occurs prior to the *filing date*, the invention lacks novelty.

Explain the *public-disclosure exception* for inventors: public disclosures by the inventor made within one year of filing do not count as prior art for the inventor. Those disclosures serve as prior art for any future inventors, and any reference that comes after the inventor's disclosures will not defeat the inventor's novelty.

Examples

After providing these black-letter rules, apply the rules to simple hypotheticals.

- Show the “Abe invents Widget” example from the PPT slides.
This example is good for a graphical illustration of how the rules work.
- Show the “Bill & George” example from the PPT slides.

The two hypotheticals in the Bill & George example are good to contrast the pre-AIA and AIA rules. The same set of simple facts leads to different outcomes under the different rules.

Hypo 1: Bill's invention is novel. Emphasize that pre-AIA rules apply because filing date is prior to March 16, 2013. Bill is first to invent. George's publication occurs within a year of Bill's filing date, so statutory bars do not apply.

Hypo 2: Bill's invention is *not* novel. Emphasize that AIA rules apply because Bill's filing date is after March 16, 2013. Prior to Bill's filing date, George creates prior art with his June publication. Explain that the public-disclosure exception does not apply here because Bill does not make any public disclosure within a year of his filing.

- Additional example: "Gary & Sherry" (Example 1 on page 838 of casebook).
- Additional example: "Linus" (Examples 2 & 3 on page 839).

PART B – MEANINGS OF TERMS

Explain that courts have developed meanings for the terms that describe events or references that count as prior art. Stress that policy considerations have played a large role in the determination of these meanings.

1. On Sale

Ask the questions: What does it mean for an invention to be on sale? Does the invention need to actually be built to be on sale? Does there need to be an actual sale, or is a mere offer sufficient to trigger “on sale”?

Explain that the Supreme Court answered these questions in the Pfaff case. First, however, note that it is necessary to understand “Reduction to Practice” to understand rules relating to “on sale.” Ask a student the meaning of Reduction to Practice (on page 842).

Pfaff v. Wells Electronics, Inc.

Facts: In Nov. 1980, Texas Instruments (TI) asked Wayne Pfaff to develop a device for use with semiconductors. Pfaff obliged. Pfaff prepared detailed engineering drawings of the device that described the design, dimensions, and materials. By March 17, 1981, Pfaff had shown a sketch of the drawings to a representative of TI. On April 8, TI gave Pfaff a receipt for an oral order that TI made with Pfaff earlier. Later that summer, Pfaff reduced the invention to practice.

Pfaff filed for a patent on April 19, 1982. (Pfaff's critical date was April 19, 1981.)

Wells Electronics started manufacturing a competing socket that allegedly infringed. Pfaff sued Wells.

Issue: Did Pfaff's interaction with TI trigger the on-sale bar?

Procedural History: The district court held that Wells had infringed Pfaff's patent; Pfaff's activity did not trigger the on-sale bar. The appellate court reversed, holding that the on-sale bar applied; Pfaff's claims were invalid.

Supreme Court holding: Affirmed appellate court. Pfaff's claims were invalid under the on-sale bar.

Reasoning:

The Supreme Court introduced a two-prong test for determining whether the on-sale bar applies:

- (1) The product must be the subject of a commercial offer for sale.

Here, Pfaff's acceptance of an order prior to April 8, 1981, makes it clear that such an offer had been made.

(2) The invention must be ready for patenting. This condition can be satisfied in two ways:

(i) prior to the critical date, the inventor reduced the invention to practice; or

(ii) prior to the critical date, the inventor prepared drawings or other descriptions that would enable a PHOSITA to make and use the invention.

Here, Pfaff had fully disclosed the invention in the drawings that he sent to TI prior to March 17, 1981.

The Court held that that Pfaff had made an offer for sale of his invention and that at that time, his invention was ready for patenting. Pfaff's claims were invalid under the on-sale bar.

Teaching Tips (*Pfaff*):

- Emphasize that although Pfaff had not yet reduced the invention to practice, he had still offered it for sale, sufficient to trigger the statutory bar.
- Refer to Learned Hand's quotation at the end of the case, to the effect that an inventor cannot "exploit his discovery competitively after it is ready for patenting." Ask why commercial exploitation prior to patenting may harm the public interest. (Answer: Because the public comes to rely on the technology prior to the grant of the patent.)
- Explain that the first prong of the *Pfaff* test (commercial offer for sale) is governed by contract law. (See Note 6 after case.) Point out that contract law recognizes a difference between a license and a commercial offer for sale. (See Note 7 after case).

2. Printed Publication

Ask students what the words "printed publication" suggests to them? Stepping outside of patent law, does *printed publication* suggest a physical object containing information, like a book, a periodical, or a magazine? Does it suggest a certain degree of permanency?

Explain that the Federal Circuit has construed *printed publication* very broadly to serve the policy end of that criterion for patentability. (Public reliance on the invention can arise through many forms of "publication"—not merely a physical book.)

Explain that the key to determining whether a reference is a printed publication is *public accessibility*. Courts look at evidence on whether the reference is publicly accessible: copies distributed and indexed in a publicly-accessible library or database indicates printed publication. Temporary display of information may or may not be a printed publication, depending on several factors suggesting public accessibility.

In re Klopfenstein

Facts: Carol Klopfenstein and John Brent developed methods of preparing foods comprising extruded soy cotyledon fiber. The methods lowered serum cholesterol levels while raising HDL cholesterol levels in mammals.

In October 1998, Klopfenstein, Brent, and a colleague named Liu presented their methods during a conference of the American Association of Cereal Chemists (AACC). Their presentation consisted of 14 printed slides that were pasted onto poster boards and displayed continuously for two and a half days. This 14-slide presentation is called *the Liu reference*.

In November 1998, the Liu reference was displayed for less than a day at an Agriculture Experiment Station (AES) at Kansas State University.

On October 30, 2000, Klopfenstein and Brent applied for a patent on their methods. (Every limitation in their claims was disclosed in the Liu reference.)

Issue: Did the Liu reference anticipate the claims of Klopfenstein and Brent?

Procedural history: The PTO rejected the application on the grounds that the Liu reference anticipated the claims. The PTO Appeals Board affirmed the examiner, holding that the Liu reference was a “printed publication.”

Federal Circuit holding: Affirmed. The Liu reference is a printed publication.

Reasoning:

The Federal Circuit stressed that public accessibility is the criterion for judging whether a reference constitutes a printed publication. Distribution and indexing have served as proxies for public accessibility, but distribution and indexing are not the only indicators.

In emphasizing public accessibility, the court recited four past cases addressing printed publication:

1. *In re Cronyn* – College students presented their undergraduate theses to a defense committee consisting of four faculty members. The theses were catalogued in an index in the college’s main library. The indexed information contained only the

student's name and title of her thesis. The actual theses themselves were neither included in the index nor made publicly accessible. The *Cronyn* court held that the theses were not sufficiently accessible to constitute a printed publication.

2. *In re Hall* – A thesis was filed and indexed in a university library. Copies of the indexed thesis itself were made freely available to the general public by the university. The *Hall* court found that this evidence established “public accessibility.”
3. *MIT v. AB Fortia* – A paper was delivered orally to 500 persons having ordinary skill in the relevant art. At least six copies of the paper were physically distributed. The *MIT* court held that the paper in question was a “printed publication,” especially given that copies were distributed.
4. *In re Wyer* – An Australian patent application was kept on microfilm at the Australian Patent Office. It was unknown whether there was any actual viewing or dissemination of the patent application. The *Wyer* court determined that the microfilm was sufficiently accessible to the public to constitute a printed publication.

The Liu reference was never distributed to the public and never indexed. So the court employed several factors to determine whether its temporary display constituted a printed publication:

- (1) Length of time the display was exhibited. This factor informs the opportunity for the public to capture, process, and retain the information. The more transient the display, the less likely it is to be considered a “printed publication” (and vice-versa).

Here, the Liu reference was displayed for a total of three days. It was shown at the AACC meeting for two and a half days and at the AES meeting for less than one day.

- (2) Expertise of target audience. This factor suggests how easily those who viewed it could retain the displayed material.

Here, the target audience at the AACC and AES meetings were chemists and others having ordinary skill in the relevant art.

- (3) Expectations that the material would not be copied. Where professional and behavioral norms suggest a reasonable expectation that the information will not be copied, the court is less likely to find a “printed publication.” Protective measures (e.g., license agreements, non-disclosure agreements, anti-copying

software, a disclaimer) may create a reasonable expectation that the information will not be copied.

Here, Klopfenstein and Brent did not take measures to protect the information they displayed. The professional norms did not suggest a reasonable expectation against copying. There was no disclaimer. Anyone could take notes or photograph it.

- (4) Ease with which the material could be copied. The more complex a display, the more difficult it will be to capture the information (and vice-versa).

Here, of the 14 slides: 1 was a title; 1 was an acknowledgement; 4 presented graphs and charts; 8 had information in bullet-point format, with no more than three bullet points per slide. No bullet point was longer than two concise sentences. The novel information was contained in only a few slides; it would be easy to copy.

Teaching Tips (*Klopfenstein*)

- Emphasize the underlying policy for the printed-publication criterion: to prevent withdrawal of disclosures already in possession of the public. See Note 6 after case.
- Explain that indexing and cataloguing of the information in a publicly accessible place will constitute a printed publication. The closer call is when the information is only temporarily displayed. *Klopfenstein* illustrates an analysis of such a temporary display.
- Give a simple example of a professor who has made a PowerPoint display that presents a novel invention. The professor would like to present this at an academic conference. Analyze this hypothetical under the four *Klopfenstein* factors. Ask students how they would advise the professor.

3. Public Use

Ask students whether they think that a good amount of the public must be using an invention before the invention will be considered a “public use”? How widespread must the use be?

Explain that courts have interpreted *public use* very broadly, such that it applies where the public is not restricted from gaining access to knowledge about or use of the invention.

Emphasize that this interpretation does not require that a significant portion of the public actually know of or use the invention.

Rosaire v. Baroid Sales Division

Facts: In 1935 and 1936, Abraham Teplitz extracted and analyzed rock and soil samples for the purpose of determining whether oil existed in an area. (Teplitz was working for Gulf Oil Corp.) Teplitz did not conceal his work or in any way exclude the public from viewing him. Teplitz did not complete his oil prospecting in the area, however. Neither Teplitz nor Gulf Oil ever published his method of oil prospecting.

In 1936, Rosaire (plaintiff) and Horvitz invented methods for prospecting oil. Two patents issued for their methods. Importantly, their methods reflected the methods that Teplitz had employed earlier (although Rosaire and Horvitz apparently did not know of Teplitz).

In 1947, Baroid began employing the same patented methods for oil prospecting.

In 1949, Baroid refused to pay Rosaire a license to use the method. Rosaire sued Baroid for infringement.

Issue: Did Teplitz's earlier oil prospecting anticipate Rosaire's claims?

Procedural History: The district court held that Teplitz's activity in 1935 and 1936 anticipated Rosaire's claims.

Appellate Court holding: Affirmed the district court. Teplitz's activity was a public use that anticipated Rosaire's claims.

Reasoning:

The court addressed two issues:

- (1) Did Teplitz actually reduce the method to practice?
- (2) If Teplitz did RTP, did his activity constitute a public use?

On the first issue, the court explains the general principle that an unsuccessful experiment does not anticipate a future invention. If Teplitz quit his oil prospecting because he wasn't certain whether the method actually worked, then Rosaire's invention would be novel. But the court holds otherwise: Teplitz quit his oil prospecting because the area did not lend itself to a proper application of the test. His quitting was not due to uncertainty as to whether the method would work. Hence, Teplitz had perfected the method of oil prospecting. His field trial was evidence of that conclusion.

On the second issue, the court noted that the work was done "openly and in the ordinary course of the activities of the employer." Moreover, there was not any "deliberate attempt at concealment or effort to exclude the public," nor were there "any instructions of secrecy to the employees performing the work." His work could therefore be known by the public.

Teaching Tips (*Rosaire*)

- Emphasize the court's stance that the use was public simply because the public could have gained access to the use. There was no evidence that members of the public were witnessing Teplitz – but they could have, and that is all that matters.
- Focus on the distinction between the two issues: (1) Actual RTP and (2) Public Use. (Help students not to confuse the two separate analyses.) Although the case introduces public use, it is also useful to teach the principle that an unsuccessful experiment does not negate novelty for a future invention.

Egbert v. Lippman

Facts: In early 1855, Samuel Barnes invented an improved corset spring. (Some students do not know what a corset spring is, so it is helpful to explain the corset spring at this point.)

In early 1855 and again in 1858, Barnes gave the corset spring that he had invented to “an intimate friend.” Barnes replaced the corset springs several times for the friend.

In 1863, Barnes showed the corset springs to Joseph Sturgis. Barnes explained how to make and use them.

Barnes applied for a patent in March 1866.

Interesting facts outside the case: The intimate friend was named Frances Willis. Barnes married Willis in 1863. Barnes died a month after the patent issued in July 1866. His wife, Frances, remarried in 1870, becoming Frances Egbert. She inherited the patent from Barnes and sued Phillip Lippmann for infringement.

Issue: Did Barnes make a public use of the patent more than two years prior to his application date?

District Court: Yes. Dismissal.

Supreme Court holding: Affirmed trial court. Barnes made a public use more than two years before his application date, making his claims invalid.

Reasoning:

The Court explained the following points of law:

- (1) One article in use is sufficient to be a public use.

- (2) The number of persons making the use does not determine whether a public use occurs. The key is whether the use is somehow restricted or limited.
- (3) Even if the public cannot openly observe an invention in use, it may be a public use. Again, the key is whether there is any restriction on the use.
- (4) On the other hand, even if a use is open to public view, if it is made to test the invention, the use is not a public one.

Here, the unrestricted nature of the corset spring suggests its public use. Importantly, by the time Barnes applied for a patent, the invention had become universal among the relevant public. This fact is good to draw out the policy reason for denying patents to those inventions that the public could come to rely on.

Dissent:

Justice Miller argues that the public could not actually observe the corset springs. He contends that the word *public* must suggest that the use be made to, and be observable by, the public.

Teaching Tips (*Egbert*)

- Pose the hypothetical that the friend who received the corset spring from Barnes immediately goes to a competing corset manufacturer after receiving it from Barnes. She then sells it that manufacturer. Use this hypothetical to illustrate the reason that public use includes seemingly private uses that are unrestricted.
- Often a few students may not know what a corset is. Consider taking a moment to explain its meaning at the beginning of the case.

Moleculon Research Corp. v. CBS, Inc.

This case is a helpful review case that introduces a few corollary principles of the public-use and on-sale bars. Students appreciate the sort of technology at issue—the Rubik's Cube.

Facts: In 1962, Larry Nichols began working for Moleculon Research Corp.

In 1968, Nichols made a wooden prototype of a three-dimensional puzzle (similar to the Rubik's Cube).

In January 1969, the president of Moleculon, Dr. Obermayer, saw Nichols's wooden puzzle sitting on Nichols's work desk. Obermayer expressed interest in the puzzle;

Nichols explained how it worked. Obermayer suggested that Moleculon try to commercialize it.

In March 1969, Nichols assigned all his rights in the puzzle invention to Moleculon. Moleculon promised him a share of any proceeds.

On March 3, 1970, Nichols filed for a patent on the puzzle, on behalf of Moleculon.

Moleculon sued CBS for infringing the patent because it manufactures the Rubik's Cube.

Issue: Did Obermayer's conversation in January 1969 constitute a public use? Did the transaction between Nichols and Moleculon in March 1969 constitute a sale?

District court: No public use or sale was made. Claims are not invalid under the statutory bars.

Federal Circuit holding: Affirmed district court.

Reasoning:

As for the *public-use* bar, Nichols did not give over the invention to a member of the public for unrestricted use. Nichols retained control of both the puzzle's use and distribution of information about it. Regarding Nichols's interaction with Obermayer, CBS failed to adduce evidence showing that a public use occurred. Also, the court rejected the argument that Nichols's interaction with Obermayer constituted a private "pursuit into commercial enterprise" of the invention.

As for the *on-sale* bar, the court distinguished between a sale of the rights to the invention and a sale of the actual wooden model. The former would not trigger the on-sale bar. There is no evidence that Nichols sold the wooden model.

Teaching Tips (*Moleculon*)

- Review the importance of retaining control over the invention so as not to trigger the public-use bar. Ask students to consider the likely conversation between Obermayer and Nichols in January 1969. Ask whether they think that Nichols actually retained control.
- Emphasize the importance of commercial enterprise in the public-use analysis. Pose the hypothetical that Nichols had instead come to Moleculon asking it to manufacture his invention. Ask whether this would have changed the court's analysis. (See Note 7 after case.)
- Explain the difference between a sale of the embodiment and a sale of the patent rights.

Experimental Use Exception

Review the Court's statement in *Egbert* that a use for testing purposes is not a public use. Ask how a court should determine whether a use is for testing purposes—i.e., an experimental use. Ask students how the public would be harmed by recognizing a use to be experimental when in fact it is not.

Lough v. Brunswick Corp.

Facts: Steven Lough is a boat repairman who invented an upper seal assembly for a boat motor. The assembly prevented corrosion. He constructed six prototypes in the spring of 1986. He installed one in his own boat. He gave one to a friend who installed it in his boat. Lough installed one in the boat of the marina owner where he worked and another in the boat of a marina customer. He gave two to longtime friends. Lough did not charge anyone for these prototypes. For over a year after these installations, Lough neither asked for nor received any comments about their performance.

On June 6, 1988, Lough filed a patent application, which issued about a year later.

Lough sued Brunswick on June 12, 1993 for patent infringement.

Issue: Did Lough make a public use prior to his critical date of June 6, 1987?

District court: A jury found that a public use had not occurred, and that Brunswick had infringed (awarding \$1.5 million). The district court denied Brunswick's Motion for Judgment as a Matter of Law.

Federal Circuit holding: Lough committed a public use when he installed the prototypes in others' boats. They were not experimental uses. Judgment reversed.

Reasoning:

The court teaches that the evaluation of whether a use is public should comport with four policies:

- (1) discouraging removal of inventions from the public domain, which the public reasonably believes are freely available;
- (2) favoring the prompt and widespread disclosure of inventions;
- (3) allowing the inventor a reasonable amount of time following sales activity to determine the potential economic value of a patent; and
- (4) prohibiting the inventor from commercially exploiting the invention for a period greater than the statutorily prescribed time.

The court then states the experimental-use exception to the public-use bar: “A patentee may negate a showing of public use by coming forward with evidence that its use of the invention was experimental.”

The court next considers several factors in evaluating whether Lough’s use is experimental:

- (1) number of prototypes and duration of testing – Lough gave away only five prototypes, but he did so for an indefinite time period;
- (2) whether records or progress reports were made concerning the testing – Lough kept no records nor inspected the seal assemblies after the installations. He never followed up.
- (3) the existence of a secrecy agreement between the patentee and the party performing the testing – Lough did not enter any secrecy agreements with any recipients of the prototypes.
- (4) whether the patentee received compensation for use of the invention – No compensation for Lough, but the court states that this is not dispositive.
- (5) the extent of control the inventor maintained over the testing – “Lough did not maintain any supervision and control over the seals during the alleged testing.”

The court does recognize that it requires less of inventors that are less sophisticated than a large corporation. In this instance, though, the lack of records and overall failure to monitor compel the conclusion that Lough did not engage in an experimental use.

Teaching Tips (*Lough*)

- Emphasize that the test for experimental use examines the totality of the circumstances, including the sophistication of the inventor.
- Ask students what Lough should have done to have effectively made an experimental use. What would your student advise her client-inventor to do if that client-inventor would like to test his invention using members of the public?
- Contrast this case with *City of Elizabeth v. American Nicholson Pavement Co.* Note 6 after the case provides a summary of the case, with a lengthy excerpt explaining the Supreme Court’s reasoning. *City of Elizabeth* is good to illustrate a use of an invention *by the public* that does not count as a public use under patent law.

PART C – PRIORITY

Introduce the concept of priority by posing a simple hypothetical such as: Abe invents a widget before Bill, but Bill files first. Who is awarded priority over the invention? Remind students that the answer will depend on whether AIA or pre-AIA rules govern. Walk students through the simple analysis: Pre-AIA recognizes priority according to the first to invent; AIA recognizes priority according to the first to file.

Explain that AIA rules are fairly straightforward because the filing date is clear. Only a few exceptions exist to this general rule of first to file (see page 885 of the casebook for a list).

Explain that pre-AIA rules are a bit more complex. Make sure that students understand that absent exceptional circumstances, RTP date determines date of invention (review actual RTP and constructive RTP). Then introduce the exceptional circumstances (see page 886): (1) RTP2 Inventor is first to conceive and worked with reasonable diligence from just before RTP1 inventor's conception date to his own RTP date and toward filing his patent; or (2) RTP1 inventor abandoned, suppressed, or concealed his invention.

Provide a simple example of the exceptional circumstance. Show the "Jimmy & Gerald" example on the PPT slides.

Griffith v. Kanamaru

Facts: Tsuneo Kanamaru invented a chemical compound useful for treating diabetes. He applied for a patent on November 17, 1982.

Owen Griffith is a professor of biochemistry at Cornell University. He invented the same compound as Kanamaru. Griffith conceived the invention by June 30, 1981 and he reduced to practice on January 11, 1984. During the time between conception and RTP, there were three months of inactivity: in those three months, Griffith was waiting for outside funding and for a specific graduate student who needed the experience for her degree.

The PTO held an interference to determine the issue of priority.

Procedural history: The Board held that Griffith failed to establish priority over Kanamaru.

Federal Circuit holding: Affirmed the Board. Griffith failed to show reasonable diligence between his conception and RTP date.

Reasoning:

The court recited the standard that Griffith must establish reasonable diligence between immediately before Kanamaru's filing date (November 17, 1982) until Griffith's reduction to practice date (January 11, 1984).

The three-month period of inactivity is the basis for failing to show reasonable diligence. The court rejects Griffith's two arguments justifying the three-month delay: (1) that he was waiting for outside funding, per Cornell's policy; and (2) that he was waiting for a particular graduate student who needed the experience. Regarding the outside funding, the court held that outside funding is akin to commercial development in this context. The delay is not related to a problem with creating the invention. Regarding the particular graduate student, the court noted that there was not a shortage of other personnel to assist. Because Griffith placed his work as second and third priority in his work to do, he could not show reasonable diligence.

The court did recognize that "reasonable everyday problems and limitations encountered by an inventor" may excuse inactivity.

Teaching Tips (*Griffith*)

- Emphasize that solicitation of funds is not a valid reason for delaying reduction to practice.
- Explain the policy underlying the case: encourage early disclosure of the invention. Ask students how this policy would be thwarted if courts were to recognize patent rights even where an inventor had delayed reducing to practice or filing a patent application.
- Reiterate that continuous work does not mean that an inventor must work every day on reducing an invention to practice. It does not mean that an inventor cannot take breaks from her work. Ask students how a court might determine what constitutes "reasonable everyday problems" for particular inventions.
- Explain that provisional patent applications can establish a filing date that is earlier than a regular patent application. See Note 6 following the case.