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IP WEBINAR SERIES

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Anticipation

March 15 |

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Webinar開始の前に

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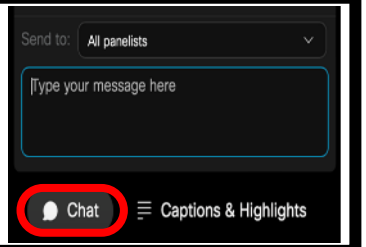

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§102 ANTICIPATION BASICS

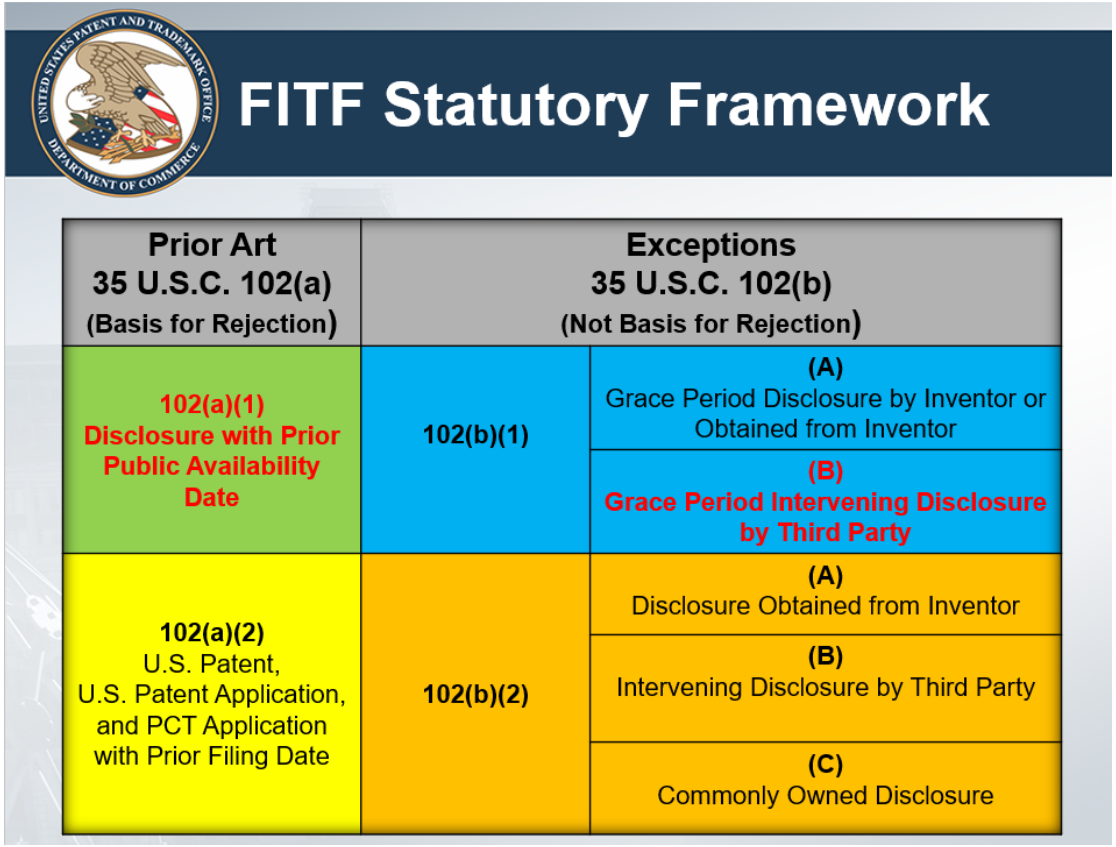
35 U.S.C. §102

(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; or

(2) the claimed invention was **described in a patent issued under section 151, or in an application for patent published or deemed published under section 122(b)**, in which the patent or application, as the case may be, names another inventor and was effectively filed before the effective filing date of the claimed invention.

35 U.S.C. §102


FITF Statutory Framework
Prior Art
35 U.S.C. 102(a)
(Basis for Rejection)
Exceptions
35 U.S.C. 102(b)
(Not Basis for Rejection)
102(a)(1)
Disclosure with Prior Public Availability Date
102(b)(1)
(A)
Grace Period Disclosure by Inventor or Obtained from Inventor
(B)
Grace Period Intervening Disclosure by Third Party
102(a)(2)
U.S. Patent, U.S. Patent Application, and PCT Application with Prior Filing Date
102(b)(2)
(A)
Disclosure Obtained from Inventor
(B)
Intervening Disclosure by Third Party
(C)
Commonly Owned Disclosure

35 U.S.C. §102

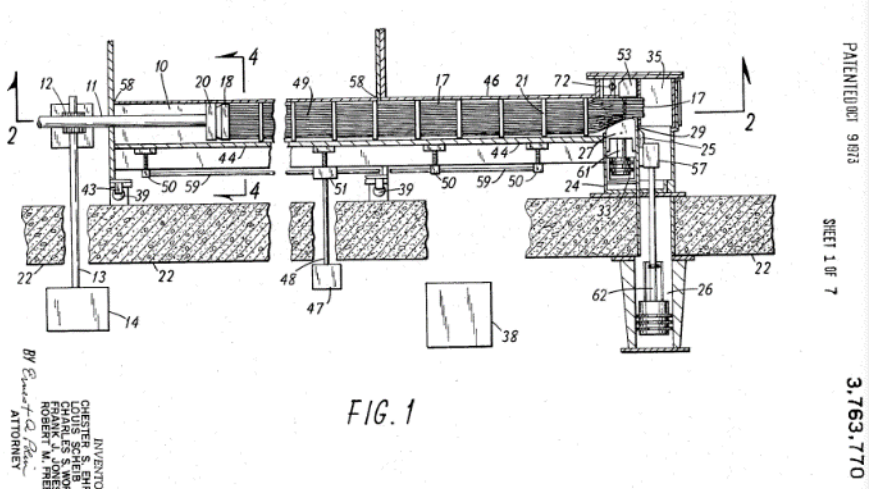
"A prior art reference anticipates a patent's claim … 'when the **four corners of . . . document describe every element of the claimed invention**, either expressly or **inherently**, such that a person of ordinary skill in the art could practice the invention **without undue experimentation**.'"

See Virnetx Inc. v. Apple, Inc. (Fed. Cir. 2016)

"We thus hold that unless a reference discloses within the four corners of the document not only all of the limitations claimed but also **all of the limitations arranged or combined in the same way as recited in the claim**, it cannot be said to prove prior invention of the thing claimed and, thus, cannot anticipate under 35 U.S.C. § 102."

See Net Moneyin v. Verisign (Fed. Cir. 2008)

"Arranged or combined in the same way"



It is clear, moreover, that the device disclosed in the '770 patent, had it come after issuance of the '315 patent, **could not be found an infringement of the asserted claims**. The district court's analysis treated the claims **as mere catalogs of separate parts, in disregard of the part-to-part relationships set forth in the claims and that give the claims their meaning**.

See Lindemann Maschinenfabrik v. Am. Hoist (Fed. Cir. 1984)

“multiple, distinct teachings”

Thus, it is not enough that the prior art reference discloses part of the claimed invention, which an ordinary artisan might supplement to make the whole, or that it includes **multiple, distinct teachings that the artisan might somehow combine** to achieve the claimed invention.

See Net Moneyin v. Verisign (Fed. Cir. 2008)

"at once envisage"

"A reference can anticipate a claim even if it '**does not expressly spell out**' all the limitations arranged or combined as in the claim, if a person of skill in the art, reading the reference, would '**at once envisage**' the claimed arrangement or combination."

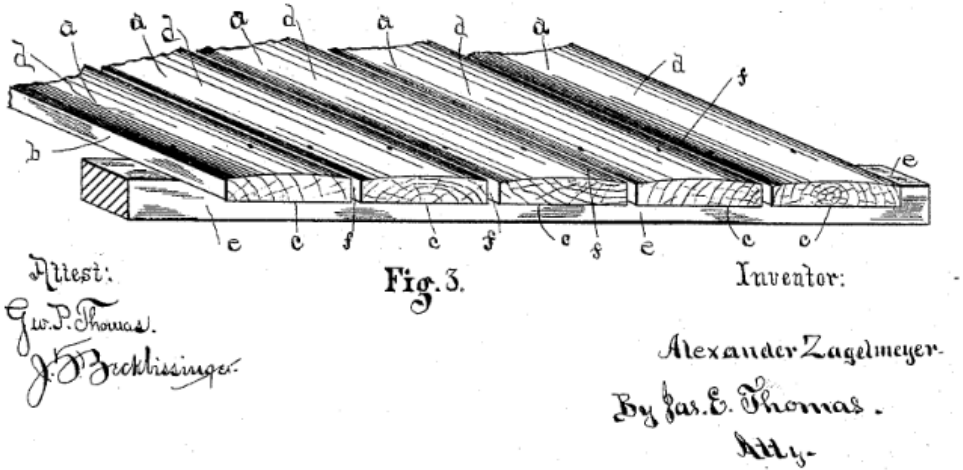
See Kennametal Inc. v. Ingersoll Cutting Tool Co. (Fed. Cir. 2005)

"subject matter thereby defined"

"The invention is not the language of the claim but the **subject matter thereby defined**. Thus, a prior art inventor need not conceive of its invention **using the same words as the patentee** would later use to claim it."

See Adasa Inc. v. Avery Dennison Corp. (Fed. Cir. 2022)

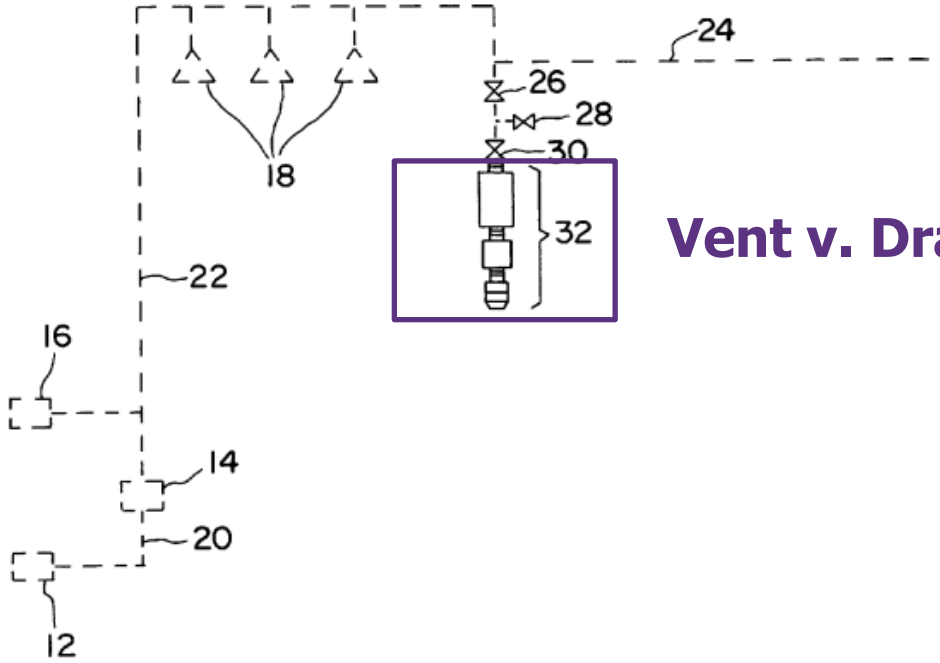
Patent Drawings



"**Patent drawings do not define the precise proportions** of the elements and may not be relied on to show particular sizes if the specification is **completely silent on the issue**."

See Hockerson-Hallberstadt v. Avia Group Intern. Inc. (Fed.Cir. 2017)

Purpose of the Disclosure



Vent v. Drain

See S-Tek Sys., LLC v. Engineered Corrosion Sols. LLC (Fed.Cir. 2018)

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INHERENCY

35 U.S.C. §102

A prior art reference anticipates a patent's claim under § 102(e) "when the four corners of [that] . . . document describe every element of the claimed invention, either expressly or **inherently**, such that a [PHOSITA] could practice the invention without **undue experimentation**."

See Spansion, Inc. v. Int'l Trade Comm'n (Fed. Cir. 2010)

35 U.S.C. §102 Inherency

"Anticipation by inherent disclosure is appropriate only when the reference discloses prior art that **must necessarily include the unstated limitation**."

See Transclean Corp. v. Bridgewood Services, Inc. (Fed. Cir. 2002)

"There are strict requirements before a finding of inherent anticipation is made. Indeed, **inevitability** is at the heart of inherency."

See Howmedica Ostenoics Corp. v. Zimmer, Inc. (Fed. Cir. 2016)

"The mere fact that a certain thing **may result** from a given set of circumstances is **not sufficient**."

See White v. H.J. Heinz Co. (Fed. Cir. 2016)

White v. H.J. Heinz Co. (Fed. Cir. 2016)

[US8231026] 14. A container for carrying various condiments, comprising:

a continuous sidewall, a peripheral shoulder portion extending outwardly from the continuous sidewall;

an open end formed by the peripheral shoulder portion;

a closed end forming a bottom floor;

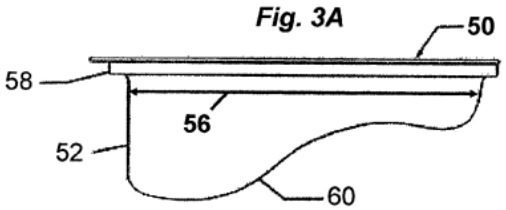
a removable cover over the open end, the removable cover attached to the peripheral shoulder portion;

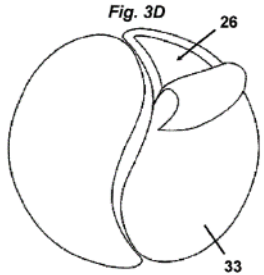
the container forming a wide end and a narrow end;

the removable cover is peelable from the wide end of the container;

The cover totally removable from the wide end of the container to access the wide end of the container; and,

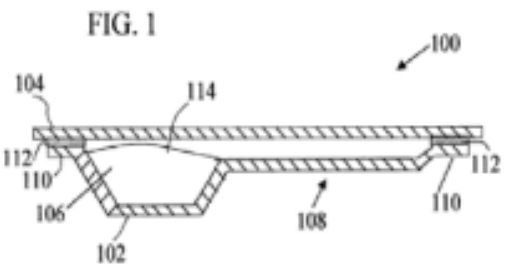
the cover removable from the narrow end to squirt or squeeze a condiment from the container.

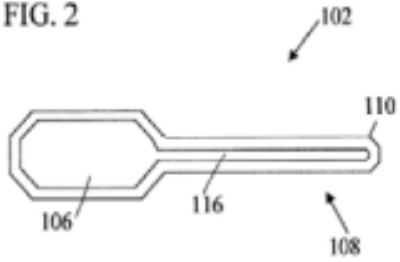


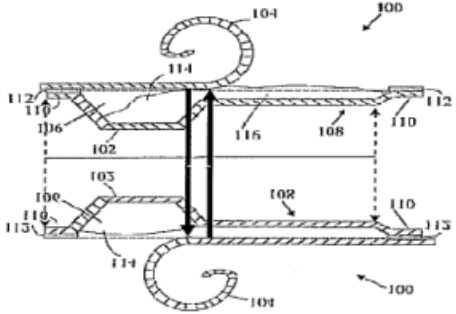


White v. H.J. Heinz Co. (Fed. Cir. 2016)

"The cover totally removable from the wide end of the container"







Fed. Cir.: *Selker* neither depicts in any drawing, nor describes in any textual disclosure, structure that might prevent the cover from being removed from both ends of Selker's package. Rather, the PTAB determined that *Selker* expressly **disclose[d] reliance upon the user to refrain from peeling the cover back from either end of the package any more than necessary**.

Other Key Consideration for Anticipation

"We thus hold that unless a reference discloses within the four corners of the document not only all of the limitations claimed but also **all of the limitations arranged or combined in the same way as recited in the claim**, it cannot be said to prove prior invention of the thing claimed and, thus, cannot anticipate under 35 U.S.C. § 102."

See Net Moneyin v. Verisign (Fed. Cir. 2008)

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ENABLEMENT

Enablement

"Long ago our predecessor court recognized that **a non-enabled disclosure cannot be anticipatory** (because it is not truly prior art) if that disclosure fails to `enable one of skill in the art to reduce the disclosed invention to practice' … The patentee bears the burden to show that the prior art reference is not enabled and, therefore, disqualified as relevant prior art for an anticipation inquiry."

See Amgen Inc. v. Hoechst Marion Roussel, Inc., (Fed. Cir. 2003)

Enablement

"The standard for enablement of a prior art reference for purposes of anticipation under §102 **differs** from the enablement standard under 35 U.S.C. § 112…a prior art reference **need not demonstrate utility** in order to serve as an anticipating reference under §102."

See Rasmusson v. SmithKline Beecham Corp., (Fed. Cir. 2005)

"§112 provides that the specification **must enable one skilled in the art to 'use' the invention** whereas §102 makes no such requirement as to an anticipatory disclosure."

See In re Hafner, (CCPA 1969)

Enablement

"prior art patents and publications enjoy a presumption of enablement, and the patentee/applicant has the burden to prove nonenablement for such prior art."

See Apple Inc. v. Corephotonics, Ltd., (Fed. Cir. 2021)

v.

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DISCLOSURE ERROR

Disclosure Error

" Since the listing of CF3 CF2 CHClBr in Clements is an error obvious to one of ordinary skill in the art, it cannot be said to describe or suggest that compound to those in the art.

See In re Yale (CCPA 1970)

Disclosure Error

"compresses the center of the image and the edges of the image and expands an intermediate zone of the image located between the center and the edges of the image."

FIG. 6

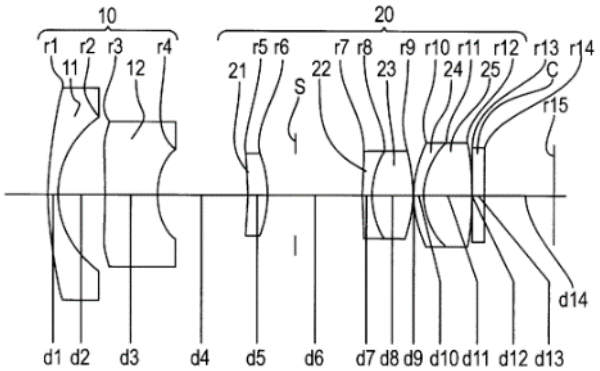

TABLE 5

FNO = 1:1.3
f = 1.00
W = 58.5
fB = 2.79 (=0.437/1.51633 + 2.501)

Surface No.	R	D	Nd	vd
1	11.660	0.364	1.77250	49.6
2	3.274	1.637	—	—
3*	−8.060	2.485	1.49176	57.4
4*	3.032	3.046	—	—
5	−11.339	0.655	1.84666	23.8
6	−3.881	0.546	—	—
diaphragm	∞	2.417	—	—
7	28.148	0.327	1.84666	23.8
8	3.022	1.455	1.51633	64.1
9	−4.790	0.036	—	—
10	4.000	0.327	1.84666	23.8
11	2.425	1.637	1.77250	49.6
12	−11.318	0.000	—	—
13	∞	0.437	1.51633	64.1
14	∞	2.501	—	—
15	∞	—	—	—

*designates an aspherical surface with rotation symmetry around the optical axis.
Aspherical Data:
No.3: K = 0.00, A4 = 0.30330 × 10^{-1}, A6 = −0.43125 × 10^{-2}, A8 = 0.46329 × 10^{-3}, A10 = −0.24092 × 10^{-4}
No.4: K = 0.00, A4 = 0.50708 × 10^{-1}, A6 = −0.52255 × 10^{-2}, A8 = 0.34087 × 10^{-2}, A10 = −0.73846 × 10^{-3}

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ANNOUNCEMENTS

IP Webinar Series: Better Safe than Sorry 2024

No. 1: Important IP Cases (2024.01.26)

No. 2: Anticipation [Nagoya] (2024.03.15)

No. 3: Patent Marking [Osaka] (2024.06.14)

No. 4: [MLB Tokyo] (2024.08.23)

No. 5: [MLB Silicon Valley] (2024.10.22)

No. 6: [Fukuoka] (2024.11.28)

Introduction Campaign

Anticipation (新規性違反)アンケート

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1. 今回のウェビナーの感想は？

不満				満足
1	2	3	4	5
○	○	○	○	○

2. 今回が初めての参加の方で、ご紹介者がいる場合はその方のお名前をご記入ください

THANK YOU