

Prior Art in U.S. Patent Law: A Legal Research Guide

Jonathan M. Weber

22 June 2006

Contents

1	Introduction	
	A brief overview of patent processes and vocabulary	2
2	Research Strategy	3
2.1	Library Collections and Legal Information Services	4
2.2	Encyclopediae and Introductory Materials	6
2.3	Statutes and Regulations	7
2.4	Patents	7
2.5	Cases	8
2.6	Law Reviews and Journals	9
2.7	Practice	10
2.8	Historical Research	11
2.9	Updates	12
3	Resources	
	An annotated list of research materials	13
3.1	General Resources	13
3.2	Reference Works	15
3.3	Treatises	15
3.4	Articles and Annotations	16
3.5	Primary Materials	18
3.6	Practical Materials	21
3.7	Citators	21

1 Introduction

A brief overview of patent processes and vocabulary

A **patent** is a type of **intellectual property**, a legal instrument issued by a government conveying to a private owner the right to exclude others from making, using, selling, or importing an **invention** for a limited period of time, in exchange for the public **disclosure** of how the invention is made and used. (Until such time, this information may be a **trade secret**.) In the United States, patents may be granted for inventions of “process, machine, manufacture, or composition of matter.”¹

The process of invention involves **conception**, the ideation of the invention, and **reduction to practice**, the actual practice of making and using the invention, by an **inventor**.² The inventor may or may not be the recipient of the patent, who is called the **patentee**.

In the U.S. patents are obtained by submitting a **specification** for the invention to the U.S. Patent and Trademark Office (USPTO) for a procedure of **examination**. This may take place at any time after the **invention date**, but must take place within one year of the **public use** or sale of the invention, unless it was **experimental use**.

The application makes specific **claims** about the scope of the patent. The examiners of the USPTO evaluate the **patentability** of the invention based on its **novelty**, **nonobviousness**, and **utility**. The examiners may grant or deny the patent.

The novelty and nonobviousness of an invention is evaluated against the **prior art**. Prior art may include previous patents, publication, or sale of an invention—**anticipation** of the invention—by the applicant or others. **Double patenting**—the patenting of the same invention twice, or the patenting of an obvious variant of an existing patent—is not allowed.

The patent system of the United States is unusual in that patents are awarded to the **first to invent**, in opposition to the **first to file** patent systems used throughout the rest of the world. As a result, it is important to carefully examine evidence of prior art to determine which of rival applicants for the same invention has the earliest invention date. This is achieved through the procedure of **interference**, an *inter partes* proceeding in the USPTO. Interference proceedings are heard by the Board of Patent Appeals

¹35 U.S.C.S. §101 (2006).

²Or multiple inventors, jointly or independently.

and Interferences (the Board). Alternatively, an *ex parte* procedure is used where there is only a single applicant but prior art has been asserted to exist (by an examiner or other party) preventing the granting of the patent.

If a granted patent is found to have an error of a non-deceptive nature requiring it to be revised, it can undergo **reissue**. **Reexamination** can be requested by any party (including third parties or the personnel of USPTO) to resolve questions of validity around the prior art of a granted patent. There are two procedural variants of reexamination, an *ex parte* reexamination or an *inter partes* reexamination. The validity of a granted patent can also be challenged in a U.S. Federal District Court.

Appeals to refusals in *ex parte* examination or reexamination, *inter partes* reexamination, and reissue can be appealed to the Board. Board decisions can be appealed to the U.S. District Court for the District of Columbia or to the U.S. Court of Appeals for the Federal Circuit.³ The Federal Circuit also has nationwide appellate jurisdiction for patent cases originating in District Courts.

Once a patent is successfully granted, the patentee has the right to prevent others from making, using, selling, or importing the invention until the expiration of the **patent term**. The patentee may create **licensing** agreements with other parties to permit these activities, or may sell the patent outright to another party. It may pursue **infringement** claims against other parties participating in these activities without the patentee's permission. An infringement suit may be brought in a U.S. Federal District Court.

Only registered patent agents or attorneys, who have passed the patent exam, may practice before the USPTO in proceedings such as examinations and interferences. Any attorney who may practice in the appropriate federal courts may bring cases such as infringement cases or appeals from the USPTO to a court.

2 Research Strategy

This research guide focuses specifically on prior art in establishing the validity of U.S. patents, including challenges during application (such as interference) and after issuance (reexamination, litigation, and appeals); it does not focus on infringement, licensing, or other issues related to valid, issued patents,

³Appeals of Board decisions in *inter partes* reexaminations are available only to patentees and not to third party participants.

nor on foreign patents. (However, many of the resources listed here may be useful in research on patents in general.)

This guide is aimed at a researcher familiar with the U.S. legal system and with basic legal research materials, although not necessarily with patent law. An annotated list of sources is included in §3, *infra.*. For another bibliography of materials on patents, see *Encyclopedia of Legal Information Sources: A Bibliographic Guide to Approximately 29,000 Citations for Publications, Organizations, and Other Sources of Information on 480 Law-Related Subjects...* (the title says it all; there are several pages of resources on patents).

The following sections lay out a suggested research strategy for topics relating to prior art in U.S. patent law. As in all legal research, carefully observe footnotes and cross-references in the sources you consult, since they often lead to cases and other useful materials.

The vocabulary introduced in the introduction provides good entry points for browsing tables of contents and indexes in print materials and for searching online systems. For explanations of patent terms through reference to case law, see *Modern Patent Law Precedent: Dictionary of Key Terms and Concepts*.⁴ You may also find it helpful to consult a general legal dictionary such as *Black's Legal Dictionary*, and *Bieber's Dictionary of Legal Abbreviations* and *Burton's Legal Thesaurus* may be useful in understanding terms as well.

2.1 Library Collections and Legal Information Services

Beyond the vocabulary of patent law, to navigate materials in libraries it is often useful to know the pertinent call numbers and subject headings. You will most commonly find Library of Congress call numbers and subject headings in use, but you may also encounter the Superintendent of Documents (SuDoc) call number system on government-produced materials.

Library of Congress call numbers: KF generally is U.S federal law.

- KF2972–2983 is U.S. intellectual property law in general.
- KF3093–3165 approximately is U.S. patent law. The range begins with general resources and continues to patentability, licensing, and infringement.

⁴*infra.*, §3.2.1

Library of Congress Subject Headings: The following subject headings often have additional subheadings (sometimes several levels) divided into geographic locales or more specific subjects.

- Intellectual property
- Patents
- Patent assignments
- Patent extensions
- Patent forms
- Patent infringement
- Patent laws and legislation
- Patent lawyers
- Patent licenses
- Patent offices
- Patent practice
- Patent searching
- Patent suits

SuDoc Call Numbers: C21 covers the publications of the USPTO.

In addition to whatever law libraries to which the researcher has access, depository libraries (in the Federal Depository Library Program for federal government information in general⁵ and the Patent and Trademark Depository Library Program for patents in particular⁶) are available in many locations and may provide additional materials. Additionally, GPOAccess⁷—the website of the government printing office—and the website of USPTO⁸ contain many materials potentially of use. (Specific materials on the USPTO website are described in more detail later in this research guide.)

Online legal information services—LexisNexis and Westlaw⁹—are familiar resources to many legal researchers. If you are fortunate enough to have access to these services, they provide a wealth of information, from statutes and regulations, to cases and citation services, to secondary materials. Both services have subject-oriented collections of materials, including those for

⁵ *infra.*, §3.1.1

⁶ *infra.*, §3.1.2

⁷ <http://www.gpoaccess.gov>

⁸ *infra.*, §3.1.3

⁹ *infra.*, §3.1.4

patent law. Many print resources described in this research guide are also available electronically on LexisNexis and Westlaw.

*Chisum on Patents*¹⁰ is a multivolume looseleaf that contains comprehensive coverage of patent law. In addition to a number of volumes making up a large treatise on patents, it also includes collected statutes, treaties, regulations, and legislative histories, and a digest of cases dealing with patent law. It collects relevant materials in a useful single package for the researcher.

2.2 Encyclopaediae and Introductory Materials

In an unfamiliar area of the law, it will benefit the researcher to begin with introductory materials, such as textbooks and encyclopedia entries.

The standard legal encyclopaediae, *American Jurisprudence*¹¹ and *Corpus Juris Secundum*,¹² both have extensive entries on patents. Of the two, *Am. Jur. 2d* has the better organized article and provides more straightforward guidance to those just beginning their research.

An Introduction to Patent Law by Mueller¹³ is an excellent text for the student or attorney new to the topic of patent law. It clearly lays out the vocabulary and the statutory and case law in the area of patents and examines the process of patenting from invention through application, as well as litigation, defenses, and other pertinent issues.

Intellectual Property: The Law of Copyrights, Patents and Trademarks,¹⁴ from the *Hornbook* series, is also a good introductory text. Its focus on intellectual property in general is broader, but it has a series of chapters devoted to an in-depth exploration of patent law and has many citations to relevant cases.

For in-depth treatises on patent law, see *Chisum on Patents*¹⁵ and *Moy's Walker on Patents*.¹⁶ Find additional treatises in library catalogs or by consulting *Legal Looseleaves in Print* and similar sources.

¹⁰ *infra.*, §3.1.5

¹¹ *infra.*, §3.2.2

¹² *infra.*, §3.2.3

¹³ *infra.*, §3.3.1

¹⁴ *infra.*, §3.3.2

¹⁵ *infra.*, §3.1.5

¹⁶ *infra.*, §3.3.3

2.3 Statutes and Regulations

The power of Congress to issue patents is established in Article I, Section 8 of the U.S. Constitution and the statutes enacted by Congress are codified in Title 35 of the U.S. Code.¹⁷ The U.S. Code is available in print in many libraries (and in all FDLP libraries) as well as online at GPOAccess. You may wish to consult an annotated code such as the U.S. Code Annotated or U.S. Code Service (or their online variations at **Westlaw** and **LexisNexis**). The annotations provide valuable insight into the reasoning and interpretation of the statutes and citations to relevant cases and other materials.

The regulations of USPTO are codified in Title 37 of the Code of Federal Regulations,¹⁸ which is also available online at GPOAccess or through **LexisNexis** and **Westlaw**. The USPTO also publishes the *Manual of Patent Examining Procedure (M.P.E.P.)*,¹⁹ a handbook of the practices and procedures of patent examination for examiners and patent agents and attorneys. It is available as a looseleaf or paperbound volume, or electronically on the USPTO website or on **LexisNexis** and **Westlaw**. It represents the detailed procedural information for the USPTO which is not codified in the U.S. Code or Code of Federal Regulations.

The collected statutes and regulations are also available in *Consolidated Patent Laws* and *Consolidated Patent Rules* respectively, published periodically by USPTO, and also in Appendices L and R of *M.P.E.P.*. You should check to see which version is the most recently updated.

See also **Updates** in §2.9, *infra.*, for more information on the update mechanisms for federal statutes and regulations and how to obtain the most current information.

2.4 Patents

An important part of understanding prior art is to find patents already granted. Each PTDLP library receives copies of every patent granted by USPTO (in mixtures of print, microfiche, and electronic forms). USPTO also provides searchable databases of patents on its website. The database **PatFT** contains images of patent documents back to the origin of the U.S. patent system in 1790 and full-text searchability back to 1976; **AppFT** has full-text

¹⁷ *infra.*, §3.5.1

¹⁸ *infra.*, §3.5.2

¹⁹ *infra.*, §3.5.3

search of pending applications for patents.²⁰ LexisNexis and Westlaw also have patent search facilities.

The USPTO also publishes its *Official Gazette*²¹ weekly. The *Official Gazette* provides notices about the USPTO, including announcements of filings and requests for various proceedings, patent expirations, and registration of patent agents and attorneys. It also includes abbreviated versions of patent applications submitted. The *Official Gazette* is also available online.

2.5 Cases

Patent matters fall solely within the jurisdiction of federal courts. Litigation on the validity or infringement of patents can be brought in any U.S. Federal District Court. Appeals of some USPTO procedures appear before the USPTO's Board of Patent Appeals and Interferences, and from there can be appealed to the U.S. Federal District Court for the District of Columbia or to the U.S. Court of Appeals for the Federal Circuit.

*U.S. Patents Quarterly*²² is a reporting system from BNA for cases in all of the above jurisdictions and their appellate courts dealing with intellectual property—patents, trademarks, copyrights, and trade secrets. It is digested annually in *U.S. Patents Quarterly Digest* and a cumulative index of the digests is issued every five years. It uses its own topic classification system. Topic 115 deals with patentability, and relevant subtopics for prior art include the following:

- 115.04—Date of invention
- 115.07—Anticipation
- 115.09—Obviousness

Chisum on Patents digests cases in the Court of Appeals for the Federal Circuit (only) with bearing on patent law. The digest volumes of *Chisum* are also available separately as the *Patent Law Digest*.²³ *Chisum* uses a topic classification system primarily based on the outline of the statutory laws of patents.

If you do not have access to a patent-specific case-finding system, you can find federal court cases in general reporters such as those in West's *National Reporter System*. Reports appear in the *Federal Supplement* (District Court

²⁰ *infra.*, §3.5.4

²¹ *infra.*, §3.5.5

²² *infra.*, §3.5.6

²³ Published by Matthew Bender, 1 v. paperback, replaced annually.

opinions), the *Federal Reporter* (appellate courts), and the *Supreme Court Reporter*. These are digested in West's *Federal Practice Digest*. The West topic number for patents is 291, and key numbers relating to prior art include the following:

- 291k16–k36.2—Invention, Obviousness
- 291k37–k45—Novelty
- 291k50–k74—Anticipation

Reports of these cases are also available in the reporters and digests of other publishers or online through LexisNexis and Westlaw. Many of the federal courts also publish recent opinions on their websites; consult the website of the U.S. Court System for details on specific courts.²⁴ The U.S. Court of Appeals for the Federal District has its opinions since October of 2004 online.²⁵

The *Official Gazette* contains very brief descriptions of the judgments of the Board of Patent Appeals and Interferences. The Board's website²⁶ has the “precedential” decisions of the Board (decisions that are considered to create law) as well as links for finding non-precedential decisions (which rule on the specifics of the case at hand only).

A handful of cases with especial interest to the notion of prior art are included in the annotated list of references.²⁷

2.6 Law Reviews and Journals

Articles in law reviews and journals can often shed light on a particular question of law. Indexes to legal periodicals, such as LegalTrac, HeinOnline, and *Index to Legal Periodicals* are increasingly online sources, but many libraries may still have paper indexes.

A few journals with particular interest in the research of patent law include the following:

- *BNA's Patent, Trademark, & Copyright Journal*—Weekly news coverage and legal analysis of intellectual property law.

²⁴<http://www.uscourts.gov/courtlinks/>

²⁵<http://www.fedcir.gov/dailylog.html>

²⁶<http://www.uspto.gov/web/offices/dcom/bpai/index.html>

²⁷*infra.*, §§3.5.7–3.5.9

- *AIPLA Quarterly Journal*—Published by the American Intellectual Property Law Association, a national bar association of IP lawyers, and produced at the George Washington University Law School.
- *Journal of the Patent and Trademark Office Society*—A monthly scholarly journal published by the Patent and Trademark Office Society.
- *Patent World*—A commercial monthly magazine of news and features, with an international focus.

A few articles on the topic of prior art are included in the annotated list of sources.²⁸

Related to law review articles are the extensive annotations of cases appearing in American Law Reports. There are several ALR annotations dealing with patent law, and one that touches on the notion of prior art is included in the annotated list of sources.²⁹

Occasionally articles of wider interest on legal topics appear in popular periodicals, in newspapers and magazines. Use any of the wide variety of indexes of these periodicals to locate articles.

2.7 Practice

There are a number of professional associations for practitioners in the area of patents that provide newsletters and journals, email listservs, conferences and meetings, continuing legal education, and a wealth of other services and information. The largest associations include:

- American Intellectual Property Law Association³⁰
- National Association of Patent Practitioners³¹
- Association of Patent Law Firms³²
- Patent and Trademark Office Society³³
- American Bar Association, Section of Patent, Trademark, and Copyright Law³⁴

²⁸ *infra.*, §§3.4.2–3.4.3

²⁹ *infra.*, §3.4.4

³⁰ <http://www.aipla.org/>

³¹ <http://www.napp.org/>

³² <http://www.aplf.org/>

³³ <http://www.ptos.org/>

³⁴ <http://www.abanet.org/intelprop/home.html>

You can locate associations and newsletters using indexes like the *Encyclopedia of Associations* and *Legal Newsletters in Print*.

To find attorneys in the area of patent law, you may consult a general directory such as *Martindale-Hubbell* or the American Bar Association website. Additionally, USPTO has a registry of patent agents and attorneys.³⁵ Only these registered agents and attorneys may appear before USPTO in proceedings. (Any appropriately licensed attorney may bring patent litigation in a court, however.) The registry is searchable on the USPTO website.

Directories such as the *Federal Yellow Book* and *Judicial Yellow Book* can help you locate personnel at USPTO or in the court system. USPTO also has an employee directory on its website.³⁶

Several resources provide rules, forms, commentary, and advice on practice in the area of patent law. Several looseleaves are especially valuable.

Patent Office Rules and Practice contains Title 37 of the Code of Federal Regulation (the patent rules) with extensive commentary and reference to cases. It also includes an index to patent-related sections of the U.S. Code and Code of Federal Regulations, a copy of the *Manual of Patent Examining Procedure*, several volumes of forms, and an index and compilation of notices appearing in the *Official Gazette* dealing with rules and procedure.

Two titles from the Practising Law Institute offer detailed practical advice for patent attorneys. *Patent Law: A Practitioner's Guide* covers the prosecution of patents and dealings with the USPTO, including many forms and Q&A's. *Patent Litigation* offers detailed procedural information and suggestions for proceeding with litigation, including litigation for infringement or validity, appeal, defenses, and damages.

For other practical materials: USPTO has an extensive array of forms on its website. *Chisum* contains the rules for the Court of Appeals for the Federal Circuit. Court rules, forms, and practice books for federal courts in general may also be of use, depending on jurisdiction.

2.8 Historical Research

Patents can be found historically in the database of patents on the USPTO website or in Patent and Trademark Depository Libraries back to the origin of the U.S. patent system.

³⁵<http://des.uspto.gov/OEDCI/>

³⁶<http://www.uspto.gov/web/menu/emploc.htm>

For historical cases, *U.S. Patents Quarterly* reaches back to 1929. Before the Court of Appeals for the Federal Circuit was created in 1982, the Court of Customs and Patent Appeals heard patent appeal cases from USPTO. An official reporter for this court was published from 1929 until 1967. Before the Federal Circuit, the Courts of Appeals in the geographic circuits heard appeals on patent cases from the District Courts.

Legislative history research can be performed in standard research tools like Thomas from the Library of Congress³⁷ and the publications of the Congressional Information Service (online at LexisNexis Congressional). Today's patent laws were created substantially in their modern form by the Patent Act of 1952. An extensive commentary on the legislative history of the act by P.J. Federico was republished in the *Journal of the Patent and Trademark Office Society* in 1993.³⁸ Substantial patent acts were also passed in 1790, 1793, 1836, and 1870. *Chisum* also contains materials on these acts.

2.9 Updates

As always when doing legal research, you need to ensure that the information you find is as up-to-date as possible.

With online resources like Westlaw and LexisNexis, updates happen automatically (but may still be hours or even days behind in some instances). With other resources, you should check when the last update occurred to see how recent your information is. For looseleaves, check the “blue pages” of filing instructions at the front of the binder. These will have the dates of the updates. For bound volumes, check for pocket parts in the back of the book. Case reporters and other volumes that come out regularly may have the most recent information in paperback volumes at the end of the set that will eventually be replaced by a bound volume.

For statutes (the U.S. Code) and regulations and rules (the Code of Federal Regulations and the *Manual of Patent Examining Procedure*), updates happen in specified ways. Statutes enacted by Congress appear in *Statutes at Large* until they are codified into the U.S. Code. New and revised regulations appear in the *Federal Register*. Notices of the USPTO that do not rise to the level of regulation appear in the *Official Gazette*.

You can find an unofficial version of the U.S. Code with regular updates

³⁷<http://thomas.loc.gov>

³⁸*infra.*, §3.4.1

from the Legal Information Institute at Cornell.³⁹ The GPO also maintains an unofficial e-CFR with the most current updates from the *Federal Register*.⁴⁰

Beyond checking the date information was last updated, you should do a citation search (“Shepardize”). You can use the print Shepard’s or the online services (Shepard’s from LexisNexis or KeyCite from Westlaw⁴¹). This is especially important for cases, as they may be overruled, but can be performed for statutes, regulations, and even patents. When Shepardizing most patents, you’ll simply find that the patent has expired, but occasionally you’ll find a patent was involved in litigation or other interesting circumstances.

3 Resources

An annotated list of research materials

The resources listed here are those mentioned in the research strategy outlined above. Resources that are general in nature—e.g. *Black’s Law Dictionary* or GPOAccess—have been omitted except where more specific information about their applicability to patent research is useful. Several specific articles and cases with particular interest in research on the notion of prior art are included.

3.1 General Resources

3.1.1. Federal Depository Library Program (FDLP) libraries.

URL <http://www.gpoaccess.gov/fdlp.html>

The Federal Depository Library Program provides libraries with government documents, based from a core collection that includes primary legislative materials. There is at least one FDLP library in each Congressional district and the documents received as part of the FDLP must be open to the public. Visit the website of the FDLP to find a depository library.

³⁹<http://www.law.cornell.edu/uscode/>

⁴⁰<http://www.gpoaccess.gov/ecfr/>

⁴¹*infra.*, §3.7.1

- 3.1.2. Patent and Trademark Depository Library Program (PTDLP) libraries.
URL <http://www.uspto.gov/go/ptdl/>

The Patent and Trademark Depository Library Program provides libraries with extensive materials from the USPTO, including patents, the *Manual of Patent Examining Procedure* and the Manual of Patent Classification, and the *Official Gazette*. Libraries in the PTDLP must make a minimum of 20 years backfile of patents available to the public, and many have all patents ever granted in the United States (in microfiche, print, and/or electronic forms). Visit the website of the PTDLP to find a depository library.

- 3.1.3. U.S. Patent and Trademark Office (USPTO), Patents website.
URL <http://www.uspto.gov/main/patents.htm>

The patents website of USPTO has a wealth of free information, including the *M.P.E.P.* and other documents, patent databases, information on filing applications for patents, forms, the *Official Gazette*, decisions of the Board of Patent Appeals and Interferences, a searchable registry of patent agents and attorney, and contact information for USPTO employees. See also §3.5.4 for the databases of patents and patent applications.

- 3.1.4. LexisNexis and Westlaw.

Both LexisNexis and Westlaw have information on all aspects of patents. Both services have special collections of sources (“tabs”) that assemble together resources with statutory and case law, patents, practical materials, and secondary sources.

- 3.1.5. Chisum, Donald S. *Chisum on Patents*. BNA (looseleaf, 14vv.). Also available on LexisNexis and Westlaw.

Chisum contains an extensive treatise on patent law as well as the collected statutes and regulations on patents, legislative history documents, the rules of practice for the U.S. Court of Appeals for the Federal Circuit, and digests of cases from that court.

3.2 Reference Works

- 3.2.1. Aisenberg, Irwin M. *Modern Patent Law Precedent: Dictionary of Key Terms and Concepts*. West (hardbound, 1v.), updated annually. Also available on Westlaw.

This dictionary traces terms in patent law by their use in statutes, regulations, and court opinions, providing extensive citations.

- 3.2.2. “Patents” in *American Jurisprudence*, Second Edition. 60 *Am.Jur.2d*.

This encyclopedia article is some 704 pages long, and has an extensive and descriptive outline to point the researcher to the relevant passages. Relevant sections for prior art include Ch. IV on first inventorship (§§81–91), Ch. VII on nonobviousness (§§148–245), Ch. IX on loss of right to patent (§§258–279), Ch. XIV on prior art references (§§528–645), Ch. XVI on interferences, and Ch. XVII-XIX on appeals and suit to obtain patent (§§646–688).

- 3.2.3. “Patents” in *Corpus Juris Secundum*. 69 *C.J.S.*

This article, at 654 pages, is equally as extensive as that in *Am.Jur.2d*, but is less intelligibly organized and more difficult to navigate. Relevant sections for prior art include Ch. II on patentability (§§13–119) and Ch. IV, subch. C and D, on interference, review of decisions, and remedies for refusal (§§159–202).

3.3 Treatises

- 3.3.1. Mueller, Janice M. *An Introduction to Patent Law*. Aspen (paperback, 1v.), second edition, 2006.

This is an excellent introductory text covering all aspects of patents for an audience new to the subject. It clearly covers the processes of prosecuting and litigating patents, focusing on the statutory bases for the system and their interpretations by courts.

- 3.3.2. Schechter, Roger E. and John R. Thomas. *Intellectual Property: The Law of Copyrights, Patents and Trademarks* (Hornbook Series). West (hardbound, 1v.), 2003.

This text gives an introduction to intellectual property in Ch. 1 and covers patents extensively in Ch. 13–23. The aspects of patent law are covered in detail by reference to statutes and the court opinions that have interpreted them. Ch. 13 provides an introduction to the law of patents. For specific information on prior art, see Ch. 16–17, on novelty and nonobviousness, respectively.

- 3.3.3. Moy, R. Carl. *Moy's Walker on Patents*. West (looseleaf, 4vv.), fourth edition, follows *Lipscomb's Walker on Patents*.

A lengthy treatise on the topic of patent law, comparable to *Chisum* but without the additional case digests and other information. Part II covers patentability.

3.4 Articles and Annotations

- 3.4.1. Federico, P.J. “Commentary on the new Patent Act.” *J. Patent and Trademark Off. Soc’y* 75(3): 161–231 (1993).

This extensive commentary on the legislative history of the 1952 Patent Act originally appeared in the U.S.C.A. but was removed from a later edition. It was reprinted in the Journal of the Patent and Trademark Office Society in 1993 and is a valuable asset to understanding the history and intent of the Act.

- 3.4.2. Krikorian, Charles R. “Inherent anticipation: how to invalidate a patent with guinea pig hair and broccoli sprouts.” *Intellectual Property & Technology Law Journal* 17(11): 11–14 (2005).

This article examines inherent anticipation, a doctrine established by the Court of Appeals for the Federal Circuit wherein anticipatory art can be implied by prior patents or publications without being expressly detailed. It examines

several cases decided under the doctrine and provides advice for handling the issue in the drafting of patent claims.

- 3.4.3. Markowitz, Michael I. “Being creative about being creative: why and how the inventive process should be documented.” *Intellectual Property & Technology Law Journal* 17(10): 6–12 (2005).

Priority of invention can be a complicated determination when one party has an earlier date of conception but a later date of reduction to practice and filing the patent application. In such an instance, it is important to show diligence between conception and reduction to practice. This article examines the importance of documentation during this phase of invention and how it may be used to prove an earlier date of invention.

- 3.4.4. Kobylak, Wesley. “Meaning of term ‘printed publication’ under 35 U.S.C.A. §102(a) and (b), denying patentability to invention described in printed publication before invention by applicant or more than one year prior to date of patent application.” 70 *A.L.R. Fed.* 796 (1984, updated 2004).

35 U.S.C. §102 refers to “printed publication” as a category of evidence of prior invention (in addition to previous patents). Description of the invention by the applicant in “printed publication” more than one year prior to application is also a bar to patenting (considered a public use of the invention). This ALR annotation examines the meaning of “printed publication” in decisions of courts, finding generally that such a document be intentionally widely distributed, disseminated, or made available to the public, including limited pertinent segments of the public, even if the document is photocopied, electronic, or otherwise not strictly “printed”. An extensive array of circumstances and many kinds of documents are covered by copious reference to court opinions.

3.5 Primary Materials

- 3.5.1. U.S. Code and U.S. Constitution. 35 U.S.C. (also U.S.C.A., U.S.C.S., LexisNexis and Westlaw, *Chisum, M.P.E.P.* App. L); updated by *Statutes at Large*. URL <http://www.gpoaccess.gov/uscode/index.html>

The power of Congress to create a system of patents is established in the U.S. Constitution, Article 1, Section 8, clause 8—the “intellectual property clause”—which states that Congress shall have the power “to promote the Progress of the Sciences and useful Arts by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.” Title 35 of the U.S. Code codifies the patent system. The sections of Title 35 that pertain most closely to the notion of prior art are §§102–103; reexamination and prior art citation is covered in §301 *et seq.*; interference in §135.

- 3.5.2. Code of Federal Regulations (also e-CFR, LexisNexis and Westlaw, *Chisum, M.P.E.P.* App. R); updated by *Federal Register*. URL <http://www.gpoaccess.gov/cfr/index.html>

Title 37 of the Code of Federal Regulations contains the patent rules. Sections pertaining to prior art include §1.501 *et seq.* on prior art citation in *ex parte* reexamination and §1.902 on prior art citation in *inter partes* reexamination.

- 3.5.3. *Manual of Patent Examining Procedure*
URL <http://www.uspto.gov/web/offices/pac/mpep/index.html>

M.P.E.P. contains the detailed procedures for patent examination, based on the U.S. Code, Code of Federal Regulations, and the notices published in the *Official Gazette*. §900 *et seq.* covers prior art and §2200 *et seq.* cover the citation of prior art in reexamination. The *M.P.E.P.* includes procedural information for application, interference, reexamination, appeal of decisions, and many other matters.

- 3.5.4. USPTO patent databases: PatFT and AppFT (also on LexisNexis and Westlaw, in PTDLP libraries).

URL <http://www.uspto.gov/patft/index.html>

USPTO has two databases of patents: PatFT contains images of patent documents back to the origin of the U.S. patent system in 1790 and full-text searchability back to 1976; AppFT has full-text search of pending applications for patents. Complex search parameters are available, including dates, documents numbers, abstracts and claims, inventors and patentees, examiners and agents or attorneys, and subject classification. (Patents are classified according to a system published in the Manual of Patent Classification.⁴²)

- 3.5.5. *The Official Gazette of the U.S. Patent and Trademark Office* (also on USPTO website, LexisNexis and Westlaw, and in Patent Office Rules and Practice)

The *Official Gazette* is published weekly and contains notices and a digest of patents granted. The notices include information about fees, filings and decisions, registrations of patent agents and attorneys, and patent expirations. There is a consolidated listing of the important notices and rule changes 1964–1998 and copies of the *Official Gazette* to date are available in libraries or on the USPTO website. LexisNexis and Westlaw can search the *Official Gazette*, and Patent Office Rules and Practice has a compilation of notices and a cumulative index.

- 3.5.6. *U.S. Patents Quarterly*, BNA.

Reports intellectual property–related cases (patents, trademarks, copyrights, trade secrets) from U.S. District Courts, Courts of Appeals including the Federal Circuit, the Supreme Court, USPTO decisions, and the Board of Patent Appeals and Interferences, among others. Published weekly and indexed monthly, with bound volumes issued quarterly and an annual digest and index. Cumulative digest index every five

⁴²Published by USPTO in paper and online at <http://www.uspto.gov/web/patents/classification/>.

years. See §2.5, *supra*, for topic numbers relevant to prior art.

3.5.7. *Woodland Trust v. Flowertree Nursery*. 148 F.3d 1368, 1370 (Fed Cir. 1998).

This case examines the notion of prior knowledge or use of an invention in determining a patent’s validity. The Court of Appeals for the Federal Circuit found that to invalidate a patent on this basis, the knowledge or use must have been available to the public, and further upheld the notion that oral evidence alone could not be clear and convincing evidence of such prior knowledge and use.

3.5.8. *In re Bass*, 474 F.2d 1276 (CCPA 1973).

This appeal to the Court of Customs and Patent Appeals from the Board of Patent Appeals in USPTO examined the relationship of prior art for nonobviousness (35 U.S.C. §103) with that for novelty (35 U.S.C. §102(g)). Based on the legislative history, the court found that it is clear that prior art under §103 is at least the statutory material in §102, and that “prior invention” in §102(g) is also “prior art” in the meaning of §103. This case was seminal in clarifying the relation or distinction of the matters of prior art in these two sections of the statute; however portions dealing with prior invention that was non-public were overturned by later amendment to the statutes.

3.5.9. *Graham v. John Deere Co.*, 383 U.S. 1 (1966).

This landmark case marked the first time the Supreme Court interpreted the Patent Act of 1952. It involved the (then-new) provisions in 35 U.S.C. §103 regarding obviousness. The court unanimously found that the statute codified existing judicial precedent in its language involving obviousness to a “person with ordinary skill in the art” without affecting the previously required level of innovation.

3.6 Practical Materials

- 3.6.1. Horwitz, Lester. *Patent Office Rules and Practice*. Matthew Bender (looseleaf, 12vv.), updated quarterly.

Contains Title 37 of the C.F.R. with extensive commentary, an index of the patent-related sections of the U.S. Code and C.F.R., *M.P.E.P.*, several volumes of forms, and an index and compilation of notices and rule changes in the *Official Gazette*.

- 3.6.2. Hildreth, Ronald. *Patent Law: A Practitioner's Guide*. PLI (looseleaf, 1 v.).

Covers the prosecution of patents and dealings with the USPTO, including many forms and Q&A's.

- 3.6.3. Pretty, Laurence H., ed. *Patent Litigation*. PLI (looseleaf, 1vv.).

Detailed procedural information and suggestions for proceeding with litigation for infringement or validity, appeal, defenses, and damages.

3.7 Citators

- 3.7.1. Shepard's and KeyCite

Both Shepard's (print or online in LexisNexis) and KeyCite (online in Westlaw) allow citation searching on patents to find patent history, including expiration and interpretation or invalidation in court cases.