

## CASES ON NOVELTY

PENNOCK v. DIALOGUE, 1829, S.Ct.

The invention was initially treated as a trade secret and was the subject of commercial exploitation. It was filed for a patent at a much later date.

It was held that the law provides for a specific duration for patents and that patents are intended to fall in the public domain and common use, after the expiration of their 20 years period. The practice of initially keeping an invention secret and then seeking to benefit from patent protection is not legitimate, because it essentially circumvents – it prolongs the limited duration of the patent. When it was filed for a patent, the invention was no longer new.

GAYLER v. WILDER, 1850 , S.Ct.

It was about a vault mechanism.

The technical rule which was the subject matter of the patent had been used before the filing of the patent by someone else, but only for his own private use and was kept secret by him, while when he passed away it ceased to be known.

It was held that there was no disclosure invalidating novelty; so, the prerequisite of novelty was met. The technical rule was only in the private knowledge of one man, who had it as a secret, and with his death this knowledge was lost.

CITY OF ELIZABETH, 1878, S.Ct.

The inventor had made experimental use of the invention, to confirm its efficiency. Knowledge of this experimental use had been received by many people. The invention related to the method of laying materials for paving roads.

It was held that although third parties had knowledge of the invention, because that knowledge was the result of experimental use, the element of novelty is not negated and not lost.

See for the experimental use and subsequent EMD decision *v. GE*, 2005, F. Cir. : This decision confirmed that experimental use does not constitute novelty of the invention, as long as such experimental use is objectively necessary. The decision lists thirteen factors that help determine whether experimental use is necessary.

*EGBERT v. LIPPMANN*, 1881, S.Ct.

The case concerned a support mechanism for women's corsets.

The inventor had for many years used the mechanism only on his wife's corsets. It was a purely private use, as a corset is a product that is worn under clothing and is not visible. At some point the inventor had presented the invention privately to a friend. After several years, the inventor applied for and received a patent. On the basis of the patent he brought an action against the defendant who had in the meantime invented a similar corset support mechanism himself.

It was held that prior use, even if entirely private, constituted disclosure and that the invention, when the patent was filed, was no longer novel. The decision particularly disapproved of the lack of interest on the part of the inventor to file for a patent in time.

*ROSAIRE v. BARIOD*, 1955, FedCir

The invention related to a technical rule that was previously fully known to another company, which had even privately tested the application of the invention, but this company had neither made use of the invention publicly, nor had it made available products incorporating it, nor they intended to use it, nor did they keep it secret and confidential.

It was held that the element of novelty was not present.

This decision differs from the *Gayler v. Wilder*. The reason for this difference is that in *Gayler v. Wilder* the party who knew the invention, was keeping it secret and private, while in the present decision this was not the case.

PFAFF v. WELLS, 1998 , S.Ct.

An engineer had designed a product to the order of an industry. He had presented the invention with designs of the product and generally had completed all the work that could lead to a patent filing. The product itself was not yet on the market. Finally, the application for a patent was submitted much later. It was held that, when the patent application was filed, the invention was no longer novel.

ATLAS POWDER v. IRECO, 1999, Fed.Cir .

The case involved an invention for explosives.

The description of the later patent differed from the description of an earlier patent, only in that it stated that the materials of the invention must be in “an adequately ventilated environment”. This, although not stated in the earlier patent, was absolutely necessary for the invention to be practiced and worked, and the reason it was not expressly stated was that it was entirely self-evident.

It was held that the later patent was not novel. The reference to "ventilated environment" was not sufficient to make the patent applied for novel.

IN RE KLOPFENSTEIN, 2004, Fed.Cir .

Before a patent application was filed, an announcement of the invention had been made at a scientific conference, although this announcement had not been published in the proceedings of the conference, nor in its official program.

It was held that there was disclosure of the patent and that the novelty condition was not met.