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**A Study on Novelty Provision in Patent Law
Based on the United States Patent Case Laws**

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During the research and development process, inventors may have a need to **expose their inventions to the public** for various reasons, such as paper publishing and product testing.

However, certain actions can cause the invention to lose novelty, and the regulations concerning prior arts that affecting novelty vary across countries. Especially the **First-inventor-to-file system** in the United States is very unique and different from the **First-to-file system** in Taiwan.

Novelty provisions in the U.S.

The Leahy-Smith America Invents Act

35 U.S.C. 102 in Pre-AIA

Novelty

- Regarding "when to invent" a invention, the determination is based on the "invention date."
- When multiple inventors are involved in the same invention, the first inventor to complete it is given priority, and the subsequent one will lose novelty due to prior disclosure.

Loss of Right to Patent (Statutory Bars)

- Regarding "when to fill" a patent application, the determination is based on the "filling date."
- The inventor may still be barred by law from obtaining a patent due to delay or laxity in filing patent application.

35 U.S.C. 102 in AIA

Prior art

- Patented, described in a printed publication, or in public use, on sale, or otherwise available to the public before the effective filing date.
- The determination is based on the "effective filing date."

Exception

- The grace period in the previous provisions is continued, adopting a so-called "first to disclose" system, whereby any subsequent disclosure within one year of the disclosure of the invention by the inventor will not destroy the novelty.

Novelty provisions in the U.S.

The first to disclose system



In this example, since A have disclosed the invention, B's later application can be excluded and therefore **A can obtain a patent.**

However, in other countries, such as Taiwan, **neither A nor B can obtain a patent** unless A can prove that B knew of the invention from his side.

Novelty provisions in the U.S.

Types of Prior Art

Described in a Printed Publication



- ◆ Dissemination to specific or unspecified groups, for example, presentation at seminars, distribution of materials such as product catalogues at exhibitions.
- ◆ Providing access to a specific location for a non-specific public, for example, placing papers in libraries, uploading to online databases, social media, etc.

- ◆ **Core Policy:** To protect the public's right to use inventions, encourage disclosure for industrial progress, prevent undue monopolies by inventors, and provide a one-year period to assess the market value.
- ◆ **Exception of experimental use :** Allowing inventors to test and improve inventions before the discovery is fully completed.



In public use
or on sale



Recent cases on 35 U.S.C § 102

- ◆ *Acceleration Bay, LLC v. Activision Blizzard Inc.*, 908 F.3d 765 (Fed. Cir. 2018).
- ◆ *Polara Engineering Inc v. Campbell Company*, 894 F.3d 1339 (Fed. Cir. 2018).
- ◆ *Junker v. Medical Components, Inc.*, 32 F.4th 1161 (Fed. Cir. 2022).



Novelty provisions in the U.S.

Publication bar—Acceleration Bay, LLC, 908 F.3d 765 (Fed. Cir. 2018).

Background

The petitioner Blizzard filed a total of six IPR applications against three US patents held by the patentee Acceleration Bay, relating to a broadcast technology for overlaying broadcast channels on a peer-to-peer communications network.

Blizzard has filed IPR applications based on two sets of references, one of which consists of a technical report by Meng-Jang Lin et al. in the field of broadcast communications (*Lin article*), which is uploaded to the Computer Science and Engineering (CSE) Technical Reports library of the University of California, San Diego (UCSD).

At the IPR stage, the PTAB held that *Lin* was **not a printed publication** for the purposes of the patent law, and this conclusion was upheld by the Federal Circuit.

Novelty provisions in the U.S.

Publication bar—Acceleration Bay, LLC, 908 F.3d 765 (Fed. Cir. 2018).

Grounds

A reference is publicly accessible if it was disseminated or otherwise made available to the extent that **person interested and ordinarily skilled in the subject matter or art, exercising reasonable diligence**, can locate it.

Moreover, the ‘public accessibility’ requires more than “technical accessibility”. In this case, the Board examines *Lin*’s **public accessibility** based on two questions: (1) “Whether a person of ordinary skill (POSA) interested in network broadcasting techniques would have been independently aware of the CSE Technical Reports Library website. (2) whether a person of ordinary skill, upon accessing the website, would have been able to find *Lin*.”

In the end, the Court found that POSA has **no motive** for accessing the database, nor is the literature **meaningfully indexed** or **searchable**. Thus, *Lin* is not a printed publication under § 102 .

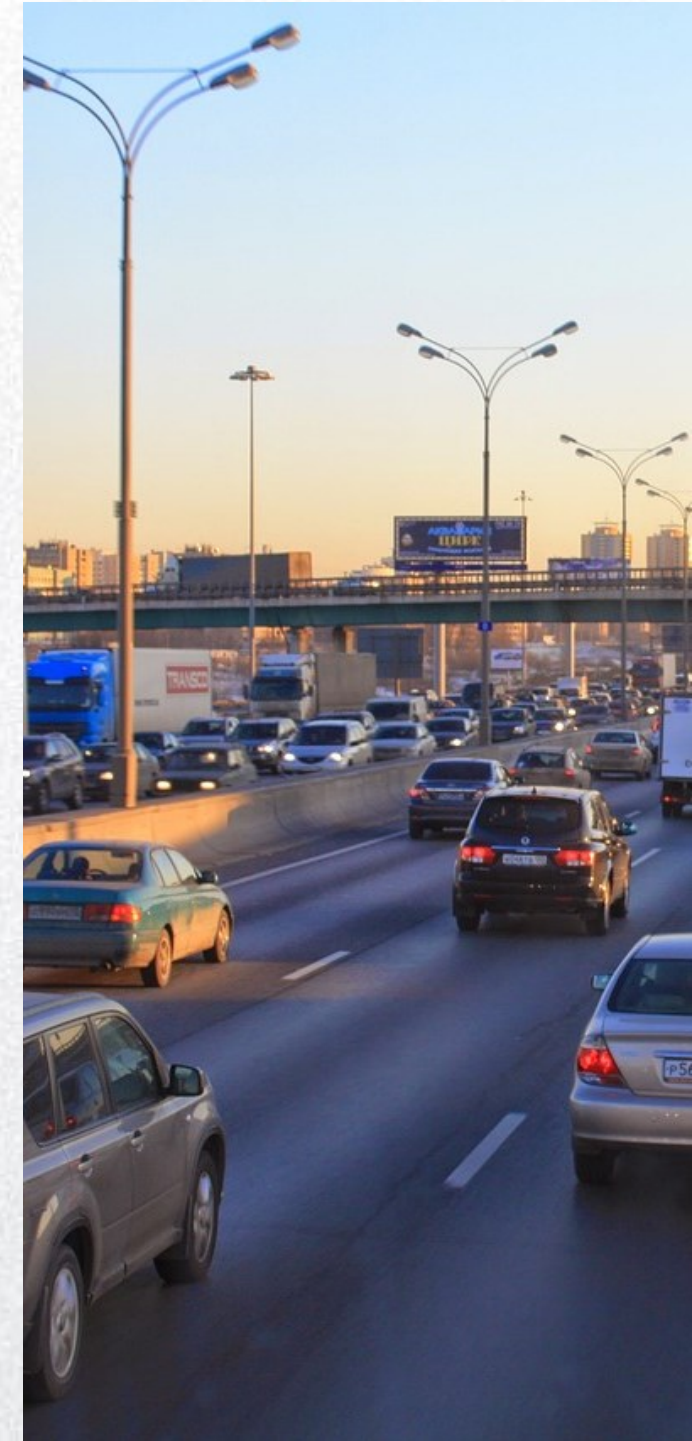
Novelty provisions in the U.S.

Public use bar— Polara Engineering Inc, 894 F.3d 1339 (Fed. Cir. 2018).

Background

The plaintiff Polara brought a patent infringement action against the defendant, Campbell, alleging that its Advisor Advanced Accessible Pedestrian Station (APS) product infringed its US patent. The patent at issue relates to a two-wire button used on traffic signs at intersections and provides vibro-tactile messages through the system to alert pedestrians when they should cross the intersection controlled by the traffic sign.

In the action, the defendant filed a motion for JMOL in the District Court, arguing that the issued patent was invalid due to a **public use bar**. The District Court, on the basis of the jury's opinion, held that the issued patent was valid because the plaintiff's use was **an experimental use**, and this opinion was upheld by the Federal Court.



Novelty provisions in the U.S.

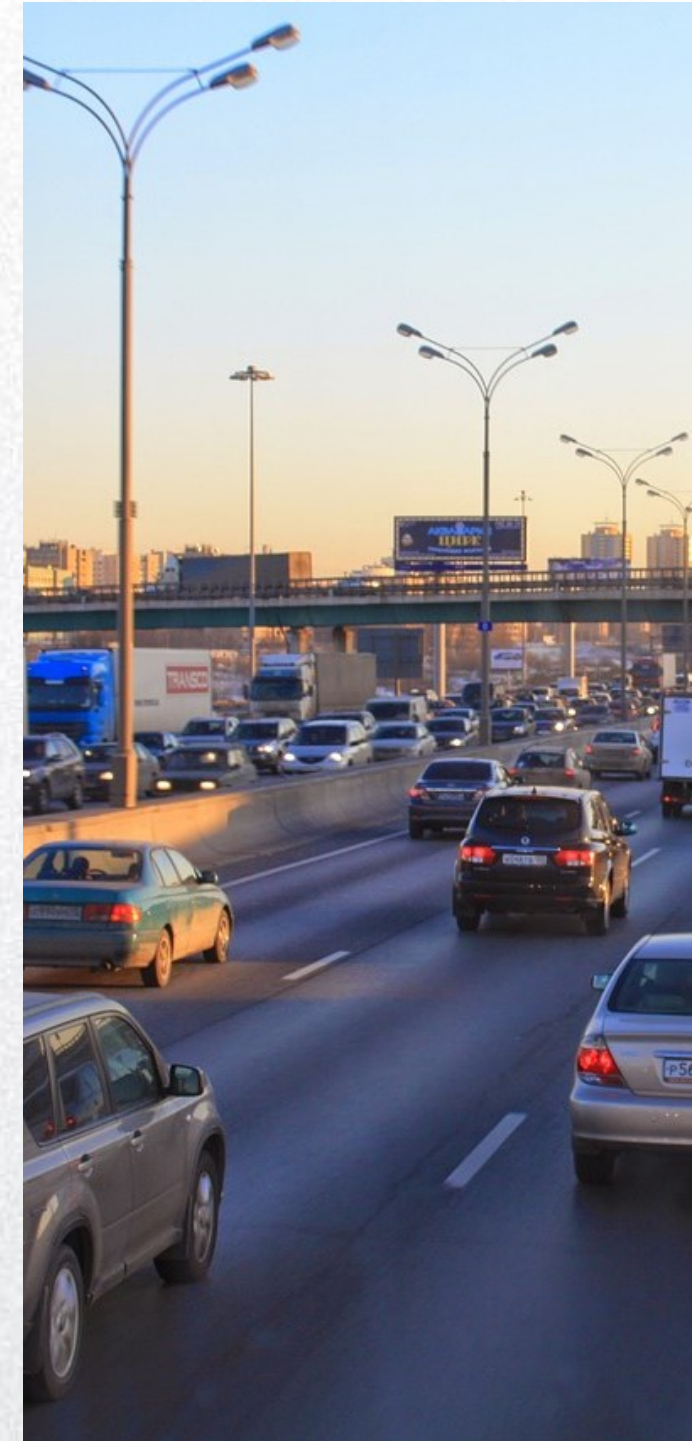
Public use bar— Polara Engineering Inc, 894 F.3d 1339 (Fed. Cir. 2018).

Grounds

The public use bar is triggered “where, before the critical date, the invention is in public use and ready for patenting.” However, “an inventor who seeks to perfect his discovery may conduct extensive testing without losing his right to obtain a patent—**even if such testing occurs in the public eye.**”

The Court determined that Polara’s intention was experimental, supported by thorough documentation of the invention’s experimentation process, the necessity to test it on real roads, and a detailed description of the step-by-step testing procedure. This included **factors** like the need for public testing, the assessment of the conditions of actual use, the degree of control over the test, and the degree of commercial exploitation.

Importantly, the portion that Polara was testing is actually the **claimed feature** (*i.e.* the “digital data signals”), which is described in the claim.





Novelty provisions in the U.S.

On sale bar— Junker, 32 F.4th 1161 (Fed. Cir. 2022).

Background

The plaintiff, Junker, owns a US design patent for a Mickey Mouse ear-shaped handle for an Introducer Sheath. In 2013, Junker filed a patent infringement lawsuit against Medical Components, claiming that their medical device products infringed on the issued patent. The defendants arguing that the patent was invalid due to the on-sale bar.

Prior to the critical date, Xentek, a collaborator of the inventor, sent several letters to a third party which **included a price list for the disputed product's various sizes**, stating that the prices were for bulk shipping, non-sterile, free on board (FOB), and with payment due on a net 30-day basis after delivery.

During the action, the defendant contended that these quotation letters **constituted a commercial offer for sale**, triggering the on sale bar. The District Court initially ruled that the plaintiff's conduct did not trigger the sales bar, but this decision was overturned by the Federal Circuit.

Novelty provisions in the U.S.

On sale bar— Junker, 32 F.4th 1161 (Fed. Cir. 2022).

Grounds

The on-sale bar might be triggered if there is a commercial offer to sell the claimed invention. The product does not need to be actually sold, it is enough for the "offer to sell" to be specific, **enabling the other party to enter into a binding contract by accepting it.**

The District Court referred to the Restatement of Contracts, contending that a "**quotation**" is merely a preliminary negotiation and not a definite offer. However, the Federal Circuit determined that **this letter differed from a typical "unsolicited" quotation letter.**

Although the delivery time was not mentioned, **the terms of the transaction provided in the letter**, such as payment methods, delivery arrangements, product conditions upon delivery, and purchasing information for different sizes of products, were sufficiently complete. The recipient only needed to simply respond to the letter, and a binding contract would be constituted.

Conclusion and personal view

Regulations in Europe and Taiwan



EPC Article 54 – Novelty

(2) The state of the art shall be held to comprise everything *made available to the public* by means of a written or oral description, by use, or in any other way, before the date of filing of the European patent application.”



R.O.C Patent Law, paragraph 1 of Article 22 –

An invention which is industrially applicable may be granted a patent upon application in accordance with this Act, unless the invention was (1) disclosed in a printed publication, (2) publicly exploited or (3) publicly known prior to the filing of the patent application.

Conclusion and personal view

Comparison of different regulations

Events	United State	Europe and Taiwan
An unlimited reference that POSA can barely locate it	✗	✓
An experimental use that public might able to see	✗	✓
A secret sale that didn't disclose the technical information	✓	✗



Conclusion and personal view

Personal view

The requirements for novelty vary among countries

Novelty requirement is crucial for obtaining a patent, but regulations regarding novelty differ among countries. Lack of familiarity with the examination standards can result in premature public disclosure of an invention and cause irreversible harm.

Regarding the prior arts that affect novelty, European and Taiwanese patent systems consider whether the invention is “**made available to the public.**” On the other hand, the United States has developed its own unique standards based on a century of case law. These standards introduce concepts not commonly found in other countries.

Applicants who directly apply their own country's regulations to the US patent system risk encountering discrepancies in judgment and with the courts. Therefore, caution is necessary when navigating the different regulations.



THANK YOU FOR LISTENING