

# Patent Law & Policy

## Session 16

9/24/08

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## Schering Corp. v. Geneva Pharms. (Fed. Cir. 2003)

- Unexpired claim - loratadine metabolite
  - Expired prior art patent - loratadine
- Claim construed to cover metabolite in body
- Is claim anticipated by prior art patent?
  - Does it meet inherency's necessity standard?
  - "No mention of the metabolite in the prior art" - ?
  - "Our clinical tests aren't in the prior art." - ?

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## In re Hafner (CCPA 1969)

- 1959-60 : Hafner files in Germany, U.S.
  - Claims chemical compounds, but no known use
  - U.S. – Utility problem / enablement problem
- 1964 : Hafner re-files in U.S.
  - Claims same compounds, and now knows a use
- Prior Art
  - 1960 - Arnold reference
  - 1961 - German application from Hafner!

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## Hafner cont'd

- PTO theory of how references anticipate ?
- Hafner – ‘PTO is using a double standard’
  - What does he mean?
- CCPA’s view of anticipation-enablement ?
- Could Hafner get a method-of-use claim ?

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## Compare provisions ...

- § 101 / § 112
  - “useful” / “make and use”
- § 102
  - “the invention was ... described in a printed publication”

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## National Tractor Pullers Ass'n v. Watkins (N.D. Ill. 1980)

- [ § 102(a) - “known or used by others” ]
- Tech - tractor pulling sled, patentee Watkins
- NTPA's evidence of invalidity
  - Huls, Harms & Sage
  - 1963ish - drawing on back of mom's tablecloth
- Why isn't it good enough?
  - How are we interpreting “others”?

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