

# Patent Law & Policy

## Session 22

10/8/08

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## Pennock v. Dialogue (S. Ct. 1829)

- Method for making leather tubing
- Pennock invents method in 1811
- Licenses Jenkins to make hose
  - Jenkins makes, sells hose in Philadelphia
  - Sells 13,000+ feet of hose from 1811-1818
- Pennock applies for, gets patent in 1818\*
- Sues Dialogue for infringement

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## Pennock cont'd

- Listed defenses include “anterior to the supposed discovery of the patentee”
  - Held - Not an exclusive list
- Act also bars patent on invention that was “known or used before the application”
  - “the true meaning must be, [it was] not known or used by the public, before the application.”

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## Pennock cont'd

- “[T]he first inventor cannot acquire a good title to a patent; if he suffers the thing invented to go into public use, or to be publicly sold for use, before he makes application for a patent.”
  - NB: No grace period [until 1839 change ]
- Process claim voided by sale of product

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## Egbert v. Lipman (S. Ct. 1881)

- Corset springs / steels
- Sam Barnes applies for patent in 3/1866
  - Statutory grace period = 2 years [ now 1 ]
- Any public use before 3/1864 ?
  - Frances Lee used two pair (1855, 1858)
  - Sam did not make Frances swear to secrecy

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## Egbert cont'd

“He imposed no obligation of secrecy, nor any condition or restriction whatever. They were not presented for the purpose of experiment, nor to test their qualities. ... The donee of the steels used them for years. ... She might have exhibited them to any person, or made other steels of the same kind, and used or sold them without violating any condition or restriction imposed on her by the inventor.”

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## Egbert cont'd

- How many units constitute “public use” ?
  - one is enough, if given without restriction
- How many people constitute “public use” ?
  - one is enough, if given without restriction
- Does it prevent another’s patent?
  - 102(a) – compare *Rosaire* oil prospecting case
  - 102(g) – compare *Peeler* case about Monsanto

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## Moleculon Rsrch (Fed Cir 1986)

- Rotating cubelet puzzle
- Nichols first applies on 3/3/1970
  - Critical date = 3/3/1969
- Any “public use” before critical date ?
  - Model sent to Parker Bros., March 7, 1969 ?
  - Paper models during grad school, 1957-1962 ?
  - Wooden model on desk at work, Jan 1969 ?

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## Road to *Metallizing*

- *Pennock* - licensee's sale of item to public invalidates patent on process for making it
- *Peerless Roll Leaf* (2d Cir 1928) (Hand, L.)
  - Patent on stamping machine
  - Before critical date, patentee used machines in secret and sold stamped products publicly
  - Held: Not invalidating ("no knowledge could possibly be acquired of the machine") [ **error** ]

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## Road to *Metallizing*

- *Gillman* (2d Cir 1940) (Hand, L.)
  - Patent on quilt-filling machine
  - Third party, NOT patentee, used same type of machine in secret and sold quilts publicly
  - Public could not learn about machine from looking at quilt
  - Held : Third party's machine not invalidating

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## *Metallizing* (2d Cir 1946) (Hand, L.)

- Method to prep metal for “metallizing”
  - Restoring worn metal surface with metal spray
- Meduna first applies 8/6/1942
  - Critical date = 8/6/1941
- Any “public use” before critical date ?
  - *Gillman* case has third-party use, not inventor’s

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## Metallizing cont’d

- “[I]t is a condition upon an inventor’s right to a patent that he shall not exploit his discovery competitively after it is ready for patenting; he must content himself with either secrecy, or legal monopoly.”

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