

Patent Law & Policy

Session 23

10/12/08

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Pfaff v. Wells Elec. (S. Ct. 1998)

- Pfaff starts work in 11/1980 at TI's request
 - Critical date = 4/19/1981
- Anything "on sale" before 4/19/1981?
 - 4/8/1981: TI provides Pfaff written confirmation of prior oral order for 30K sockets, \$91K
 - Pfaff fills order in 7/1981, from subcontractor
- When was Pfaff's invention actually reduced to practice?

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Pfaff cont'd

- Trial court
 - no bar - “socket not reduced to practice”
- Federal Circuit
 - bar - “socket substantially complete”
- Supreme Court ...
 - “On sale” if “the subject of a commercial offer for sale” **and** “ready for patenting”
 - Why not require reduction-to-practice before sale ?
 - Proof that Pfaff’s socket was “ready for patenting” ?

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Abbott v. Geneva (Fed Cir 1999)

- Abbott sells hypertension drug, “Hytrin”
 - Abbott’s pill has dihydrate form of Teraz HyChl
 - Also 4 anhydrous forms of Teraz HyChl
 - `207 patent, claim 4 - anhydrous Form IV
- Critical date = Oct 18, 1993
- Invention “on sale” before this date?

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Abbott Labs cont'd

- Seller in US – Byron Chemical Company
- Purchasers in US ...
 - Geneva Pharm - the accused infringer!
 - 11 pounds in 1989-90
 - 11 pounds in 1991
 - Warner Chilcott Labs – 11 pounds in 1992
- Later testing showed that Form IV was sold
 - Parties to the sale did not know it at the time

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Abbott Labs cont'd

- Abbott - “Invention could not have been on sale because it had not yet been conceived”
- Federal Circuit – “conception not relevant”
 - Why isn't conception relevant here ?
- Difference between . . .
 - “this thing was ready for patenting”
 - “I was ready to patent this thing”
 - What policy supports focus on first of these ?

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