

# Class 8: Obviousness

## Administrative

Next Time 239-57; 257-63

A few more terms needed to understand the "Claim Construction" section

- Specification / Written Description.
- Claims and Elements / Limitations
- Prosecution History / File Wrapper

## Last Time

Novelty Hypotheticals

### Basic Facts

Invention: Max invents the Clickable Sharpie on July 1, 2003.

Elements

1. Sharpie
2. Clickable button on top.
3. Spring-loaded, retractable mechanism



Hypo 1: On June 30, 2003, his rival Eleanor invents the same thing (same exact elements)

- Not Novel
- Unless E isn't in "this country"

Hypo 2: On June 30, 2003, Eleanor publishes article laying out all elements of invention.

- Not novel (patented or described in print.)
- no matter which country

Hypo 3: On June 30, 2003, Eleanor, in Belgium, published a blog post read by only her mom about the invention. Google's Spider indexes post three weeks later.

- Depends on whether a post "published" online but not accessible through a search engine is satisfies Hall's "public accessibility" test.
- Fact that it is online is not a problem -- MPEP says that online publication counts as "printed publication"

Hypo 4: Max himself had an earlier prototype he created with essentially all of the elements on January 1, 2003.

- Novel.
- Point: you can't render your own work non-novel.

Hypo 5: On June 1, 2003, Eleanor invents all of it, except she uses gravity, not a spring; on June 2, 2003, Anna invents all of it, except she uses a button on the side, not on the top. Both publish immediately.

- Novel.
- Single piece of prior art must include all elements to anticipate.
- But, maybe obvious.

### More Facts

- Max invented July 1, 2003
- Max files his patent application on December 21, 2004.

Hypo 5: Competitor publishes article in "Markers and Pens" magazine, published December 19, 2003, describing Max's bold new invention.

- Barred by statutory bar.
- Regardless of country of publication.

Hypo 6: Inventor himself sends prototypes to 50 of "best customers" on December 19, 2003.

- Probably a statutory bar.
- Perhaps not if NDAs signed by all customers.

Hypo 7: Inventor gives one prototype to best friend on December 19, 2003

- Similar to Egbert v. Lippman
- Depends on whether friend was sworn to secrecy.

**Class 8: Obviousness**

Why a Nonobviousness requirement?

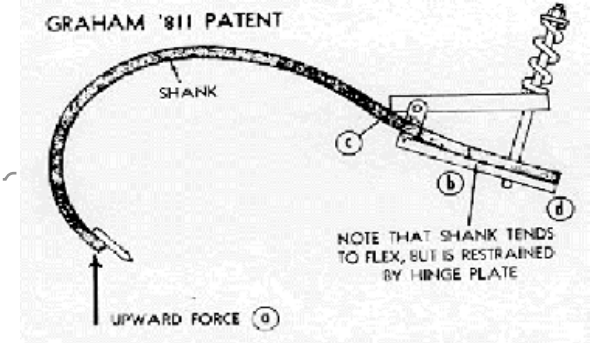
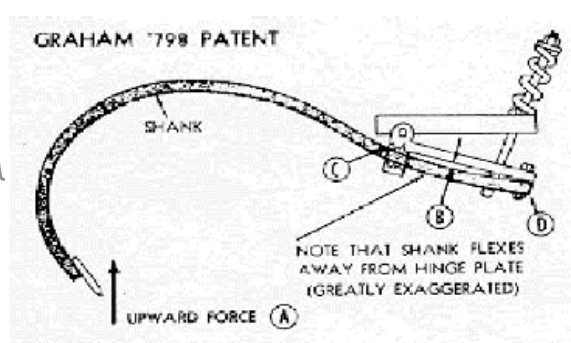
Graham v. John Deere

What's wrong with a system that rewards novelty alone?

Section 103 (218)

Prior art attached shank to the TOP of the moving part of the hinge with a bolt.  
 Basic Facts { 798 Patent attached shank instead to the BOTTOM of the moving part to achieve three improvements  
 Supremes 1966

{ Less wear on fixed part of hinge.  
 More flexing, less likely to break  
 Less fishtailing (prior art had no stirrup to stop side-to-side movement).



How to Measure obviousness?

Test

Graham (219): Ultimate Q is Q of Law, lends itself to basic factual inquiries.

Three threshold factual questions.

1. Scope and content of the prior art.
2. Differences between the prior art and the claims at issue.
3. Level of ordinary skill in the art.

Three "secondary considerations"

1. Commercial success
2. Long-felt but unsolved needs.
3. Failure of others.

# Class 8: Obviousness

## How to Measure obviousness?

### Amazon One-Click Patent

#### Basic Idea:

#### Obvious?

#### Prior Art

- Previous Shopping Carts
- Going to store physically
- 'account with store'
- b2b
  - repeat customer shipping agreements
- bar tab
- fedex and ups online
  - websites that remember your information
- credit cards themselves
- vending machines

#### Secondary Considerations

## Combining References, the Problem of Hindsight, and PHOSITA

### Combining References: The Fed Circuit Rule: Vaeck and Dembiczak

#### Dembiczak

#### Invention

"A large trash bag made of orange plastic and decorated with lines and facial features"

#### Key Limitations

- Flexible, waterproof bag
- Orange
- Facial indicia ("at least two of an eye")

#### Great facts!

- 7 Million sold in 1990 alone.
- Engendered a rash of thefts around Houston.
- Sparked protective measures such as greasing the bags with petroleum jelly!

#### Prior Art (231)

- Orange Crepe Paper + facial feature cut-outs + wadded newspapers == craft fun!
- painted paper bag full of newspapers with painted facial features
- gusseted bag
- Trash bags