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Section 102(g) Prior Invention As Section 103 Prior Art

By Karl F. Jorda

Introduction

By way of introduction it may be worthwhile to recall the APLA survey which was made last year to determine attorney experience and opinion regarding various subjects including the subject of Bass-type Section 102(g) rejections. The results based on 226 responses were briefly as follows:

1. To the question whether Bass-type 102(g) rejections were increasing in their experience, 51 answered yes but 136 said no, the ratio being 39 to 93 as far as respondents in corporate practice were concerned.

2. The question of whether they were particularly concerned about such rejections was responded to in the negative by 78 but in the positive by 124 and among corporate practitioners the ratio was 52 to 90.

3. 154 respondents believed that such rejections unfairly penalized joint research teams while only 37 felt that that was not so, with corporate attorneys voting 109 to 27 on this issue.[1]

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1 In this survey the views of chemical practitioners was split out and it is interesting to note that they were significantly more concerned about Bass-type rejections: Question 1) 32 to 70; question 2) 31 to 78 (N.B. among non-chemical practitioners the vote was 47 to 46); question 3) 91 to 15.

One can question the statistical significance of these results - and for this reason no particular analysis is called for - but they are of more than passing interest. To the extent the results do reflect majority attorney experience and opinion, they support my opinion and experience - actual and vicarious. I venture to say that had a similar survey been taken in 1975 it would have revealed a greater anti-Bass sentiment and were a similar survey taken today or this year it would produce results that would be milder in comparison to those of last year.

In other words, the dust has settled; the storm has died down. The novelty has worn off. I don't want to say we are back to normal in the sense of pre-Bass practice - that will never happen - but normal in the sense that Section 102(g) as a rule is being applied by the PTO as always in interference contexts and particularly post-interference situations, that is to say that, as far as Section 102(g) Bass-type rejections by the PTO are concerned, i.e., Section 102(g)/103 rejections in purely ex parte contexts, the PTO is backing or laying off a bit.

The PTO doesn't know the facts surrounding a claimed invention and is really not in a position to make such rejections except in very special cases. Abuses and undue extensions have ceased, as I will show later when I talk about developments in greater detail. In short, we have not gotten any Bass-type rejections from the PTO lately nor it seems has anybody else.[1]

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1 I have talked to as many colleagues in the patent field as I could in recent weeks about the incidence of Bass-type rejections and the consensus seems to be that they have virtually disappeared.

Having said this, I must add quickly that I have no intentions to minimize the effects and the implications of In re Bass,[1] especially in corporate research and situations involving team projects and various basic and improvement inventions with different inventorship. In other words, I do not want to be responsible for any feeling of complacency. In this respect we must not forget the duty of candor and full disclosure of material facts to the PTO and the new Rules of Practice which go into effect March 1, 1977 and in particular revised Rule 56. It should be remembered that this revised rule requires, in the interpretation of the PTO, that not only material prior art patents and publications must be brought to the attention of the PTO but also prior public uses, sales, and the like which, if it includes anything, includes prior inventions of co-workers.

One could really decry life under Bass and the authors of PLP and other commentators have done this. And one could wax dramatic about the Bass rule, e.g., at a Connecticut Patent Law Association Meeting last year I started my talk about In re Bass by declaiming "There is a specter abroad; there is a cancer growing. It is called In re Bass."

In infringement and validity litigation we have a different story, it seems. The tempo and incidence of Section 102(g) defenses and attacks has increased, as I will show later, but otherwise the courts continue to grapple with Section 102(g) defenses or attacks and in this respect there is not too much difference in the pre- and post-Bass periods.

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1 177 USPQ 178 (CCPA 1973)

Now let us take a step backward and talk briefly about In re Bass and what it stands for and what its implications and ramifications are especially for corporate or institutional R&D.[1]

In re Bass: Its Holdings, Implications and Complications

The facts and issues in the Bass case are fairly simple but the split judicial holdings are something else. The subject matter involved in the Bass case was a vacuum system for controlling and collecting waste on a special type of carding machine. The invention was a joint endeavor of Bass, Jenkins and Horvat which combined (a) a first suction means, (b) a second suction means disposed at a different location and (c) a collecting screen located beneath the machine. The examiner rejected certain of the combination claims under Section 103 based on a combination of references. One was an earlier filed Bass and Horvat patent which disclosed one of the two suction means employed in the combination invention at bar, another was the Jenkins' patent which disclosed the form of the collecting screen utilized by Bass, Jenkins & Horvat. In order to remove the Bass, Horvat and Jenkins patents as references, Bass, Jenkins & Horvat submitted a Rule 131 affidavit.

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1 I never mentioned In re Hellsund, 177 USPQ 170 (CCPA, 1973), in my prior talks and my published paper and I don't mention it here except in this aside or footnote even though everybody else, i.e., commentators, authors, examiners uttered Hellsund in the same breath with Bass. To me Hellsund is purely and simply a case dealing with admissions and that is a distinct and separate subject and in and of itself a subject for a paper or talk. Had it not been decided and published together with Bass and had not Judge Rich made a statement in his "dissent" that you just cannot reject on the ground of admission qua admission but the rejection has to have a statutory basis and the only statutory basis in the case at bar was Section 102(g), Hellsund would be as forgotten as the obscurest of cases.

The examiner held the affidavit was sufficient to remove the patents as Section 102(e) references since it antedated the filing dates of both patents, but the examiner, and the board in affirming his position, deemed them proper references under Section 102(g) since the evidence of record indicated the inventions disclosed in the two patents were made before the Bass, Jenkins & Horvat combination invention was conceived.

The main issue before the CCPA was whether Section 102(g) makes available as "prior art", within the meaning of Section 103, the prior invention of another who has not abandoned, suppressed or concealed it.

While all judges agreed that the record did not establish that the "prior inventions" were made before the combination invention at bar - in fact there was evidence that there was simultaneous reduction to practice - and therefore unanimously reversed the Board's holding, they totally disagreed on "the principal point of law involved.[1]

Judges Rich and Rosenstein in their opinion answered the issue as stated above in the affirmative but Judges Baldwin and Almond "dissented" in effect in the strongest terms. Their opinion is in diametrical opposition. Judge Lane went along with Judges Rich and Rosenstein only part way. His position, to me, is a good compromise. He was willing to permit the use of Section 102(g) prior art apart from its use in interference and post-interference situations if the prior invention was disclosed in an issued patent as it was in the case at bar.

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1 177 USPQ at 187

The Bass decision is thought to stand for the proposition that Section 103 prior art includes Section 102(g) prior inventions, that is, all inventions made in this country before an applicant or patentee made his invention provided an earlier invention was not abandoned, suppressed or concealed. But the only novel element in the Bass case is the purely ex parte use in the PTO of Section 102(g) in combination with Section 103 and completely apart from any interference.

Apart from some deplorable Supreme Court cases probably no case has been discussed and decried as much as the Bass case and no case has been said to change traditional practice as much as the Bass case. For instance, the effective dates of U.S. patents, publications and public uses are "rolled back" to the invention dates. Sections 102(a) and 102(e) have become superfluous. Rule 131 affidavits, terminal disclaimers and the practice of filing related applications on the same date are out. And this is just for starters! Yet, the Bass case is not and cannot be relied on as authority and precedent. That should not come as a surprise. Apart from having been mentioned in passing only in the St. Regis Paper v. Bemis[1] case and in In re McKellin,[2] the Bass decision has been referred to in only one case, a Court of Claims case, namely, Jamesbury v. US[3] but together with Sutter Products v. Pettibone and Milliken[4] and Grinnel v. VEPC[5], and the patent was held valid in the face of a Section 102(g) defense because the invention was adjudged unobvious.

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1 188 USPQ 119 (S.D. Ill. N.D. 1975)
2 188 USPQ 435 and 444 (CCPA 1975)
3 183 USPQ 484 (Ct/Cls 1974)
4 166 USPQ 100 (7th Cir 1970)
5 156 USPQ 443 (E.D. Va. 1967)

Lawrence Dodds in an August 1974 JPOS commentary[1] concludes persuasively after careful analysis of the holdings that "the majority of the Court found that the ruling of Judge Rich was dictum. The only member of the Court who agreed with Judge Rich was Judge Rosenstein of the U.S. Customs Court ... (which) has scant contact with developments in the Patent Law."[2]

With respect to complications caused in patent practice by In re Bass and especially as regards corporate and institutional R&D activity, I have already intimated earlier that various hallowed and time-honored practices need be reexamined to say the least, and perhaps even radically changed especially in view of the candor requirements.

The things I mentioned are Rule 131 affidavits, terminal disclaimers, same-day (or also reverse-order) filings. The concept of "rolling back" US patents, publications and public uses to their invention dates turns topsy-turvy the established validity and infringement law and practice. It vastly increases the available prior art because it goes far beyond Section 102(a) and 102(e) - which become surplusage as some say - and because it throws out such venerable doctrines as those represented by Lilly v. Brenner, Hilmer II, Schlittler. The rules that abandoned applications and Defensive Publications are not prior art are or were also in danger. Make no bones about it: In re Bass spells radical and drastic changes!

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1 56 JPOS 544 (1974)
2 Id. at 545

New Developments - Recent Court Cases

There have been a number of district and circuit court decisions during the past year worthy of mention even though they do involve a standard Section 102(g) defense or attack and could have come down in perhaps identical fashion in the pre-Bass era. At any rate, none even referred to Bass, much less relied on it as I mentioned before.

The first one I want to go into, however, is of 1975 vintage and is in my JPOS article and does not even advert to Section 102(g). But it is very relevant and bears repetition and emphasis, especially in view of the new rules on candor and the duty of disclosure. It is Timely Products v. Aaron[1] in which the Circuit Court, through Judge Conner, affirmed the invalidity holding of the District Court for the Southern District of New York with respect to Aaron patent 3,392,264 on electrically heated footware. In this case Aaron had tried to overcome the prior patent of a co-worker, Costanzo, through a Rule 131 affidavit. This patent was one of several references. However, the District Court ruled that Aaron had failed to prove a conception date prior to Costanzo's filing date. Thus this patent was part of the prior art which rendered the claims obvious. In addition, a fraud issue had been raised in connection with the filing of the Rule 131 affidavit, and with respect to this issue, Judge Conner ruled as follows:

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1 187 USPQ 257 (2nd Cir. 1975)

> "Aaron concealed from the Patent Office not only the fact that Costanzo was the person who had cooperated in his work prior to Costanzo's filing date; he concealed the even more important facts that the sock disclosed and claimed in Costanzo's patent had been conceived, reduced to practice and even offered for sale before he (Aaron) started work on his alleged improvement, and that he knew all about the Costanzo sock and used it as the point of departure for his work. Thus he was well aware that, even though he might be able to swear back of Costanzo's filing date, he could not antedate the Costanzo's invention. Costanzo's work was clearly part of the prior art from which Aaron's alleged advance should have been measured. Armour & Co. v. Swift & Co., ... 175 USPQ 70, 71-72 (7th Cir. 1972). By concealing his knowledge of Costanzo's sock, Aaron caused the Patent Office to appraise his contribution from the reference point of an earlier state of the art and thus erroneously to credit him with Costanzo's advance as well as his own."

Mentioning in passing Dunlop Holdings v. Ram Golf,[1] which invalidated a patent on golf balls under Section 102(g)[2], I want to deal next with Westwood Chemical v. Dow Corning[3] and Ortho Pharmaceutical v. American Hospital Supply[4].

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1 188 USPQ 383 (N.D. Ill. E. Div. 1974), aff'd 188 USPQ 481 (7th Cir. 1975)

2 The authors of Patent Law Perspectives (PLP) recently blasted this decision stating that Justice Stevens led a 7th Circuit panel astray in holding that a commercial use though non-informing of a product was an invalidating prior public use. See 1976 PLP Sec. A.3[1]-37. "The appeals court apparently could not bear to treat Wagner's active use of Surlyn covered golf balls as concealment or suppression of the invention under Section 102(g), even though it did not teach the public how to practice the claimed invention." Id. at 38-39.

3 189 USPQ 649 (E.D. Mich., S. Div. 1975)

4 190 USPQ 397 (7th Cir. 1976)

In the former a patent held by Westwood on pigmented silicone elastomers was held invalid in the face of a Section 102(g) defense based on prior independent secret work done at Dow Corning. The court held that a

> "prior invention which will invalidate a patent under §102(g) need not involve use of the invention in public. Prior private or secret knowledge is available as prior art ... This independent work of others is also clearly evidence of obviousness."[1]

The language as in most such holdings is a bit loose but it seems that Dow Corning had a big in-depth R&D project in this area while the Westwood patent was but a paper patent in the sense that it was based on graphite chemistry and not in use.

In the Ortho Pharmaceutical case a Section 102(g) attack failed and AHS's patent on substances relating to testing of blood-coagulation was held valid in a decision written by Senior Judge Terry. As regards the Section 102(g) issue which was combined and joined with Section 102(f), the court held:

> "We also cannot accept Ortho's contention that Dr. Ratnoff rather than Speck was the first discoverer of the subject matter of the claims in suit. Experiments by both Speck and Wilbourn established that Dr. Ratnoff had, not a true solution of dissolved ellagic acid, but merely a suspension of undissolved ellagic acid particles. The record as a whole supports the District Court's finding that any activation of the Hageman factor obtained by Dr. Ratnoff's reagent was caused by these undissolved particles of ellagic acid. In contrast to what Dr. Ratnoff did, Speck prepared a reagent in which the ellagic acid was in true solution."

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1 189 USPQ at 666.

Another case out of this Circuit - they all seem to come from this area - is Grain Products v. Lincoln Grain.[1] In this case a patent applied for in 1960 on cold water dispersible cereal products was voided under Section 102(g) because in 1949 an employee of plaintiff "produced gelatinized cereal adhesive on a plastics extruder ... (and) made 35 tests using corn meal and flour and varying moisture, die area, feed rate and extruder temperature". The court considered this work as the "prior invention of the subject matter" of defendant's patent by plaintiff's employee. Based on this prior work the court went on to hold the patent also invalid under Section 103.

These separate invalidity grounds under Section 102(g), on the one hand, and Section 103, on the other, based on the same facts can be found in these district and circuit court holdings quite frequently. This must be a hold-over from the pre-Bass period. Judge Rich apparently has not yet been able to educate these federal judges sufficiently to speak in terms of Section 102(g) prior inventions as Section 103 prior art which is the proper approach if the prior invention was not identical to the claimed invention and if this prior art invention is the only prior art relied on.

The last two cases are very recent ones that have so far been published only in BNA's PTC Journal. They are Continental Copper & Steel v. New York Wire,[2] a decision of the

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1 191 USPQ 177 (S.D. Ind. Indianapolis Div. 1976)

2 311 PTCJ A-5 (1/13/77)

District Court for Middle Pennsylvania and Norris Industries v. Tappan[1] which was handed down by the District Court for Central California. In the former a Section 102(g) defense and in the latter a Section 102(g) attack were successfully propounded. In the former, according to BNA's summarization,

> "(b)oth parties manufacture wire screen cloth for sale to screen door and window manufacturers. A particularly vexing problem faced by the industry was how to create safe, ravel-free edges on screens without bulk. In 1959, defendant New York Wire Company filed a patent application for an adjustable spreader which applied bands of plastic to the cloth and its edges. The defendant's claims were rejected by the PTO and the application was officially abandoned in 1961. However, the spreader used by defendant remained in existence and use. In 1963, plaintiff Continental, after numerous amendments, was issued a patent for a process which also employed a system of plastic banding. Thereafter, plaintiff commenced this patent infringement suit against New York Wire.
>
> Judge Herman, after reviewing the prior art that proved fatal to New York Wire's application, concludes that this same prior art also renders Continental's patent invalid for obviousness under 35 U.S.C. Section 103.
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> An alternative finding of the court is that even if the process were patentable, New York Wire rather than Continental was the first inventor. Although New York Wire had abandoned its application, it did not abandon the invention (which the court says was nearly identical to Continental's invention)."

In the decision itself the Court discusses at quite some length the requirements of a Section 102(g) defense and the matter of burden of proof with respect to a Section 102(g) issue.

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1 313 PTCJ A-20 (1/27/77)

In the Norris Industries case the court invalidated a patent on a microwave oven having a radiant heating element for simultaneously browning food while cooking with microwave energy. There were three grounds of invalidity: double patenting, obviousness under the Andersons-Black Rock & Sakraida v. Ag Pro doctrines and anticipation under Section 102(g). The BNA renders or summarizes this Section 102(g) holding as follows:

> "Norris refers Judge Whelan to ... the 1947 work of Schroeder. Schroeder mounted a microwave generator in an oven range. In the oven cavity, the range used sheath type heating units (Calrods) for radiant heating. Schroeder's device therefore included all of the same elements, arranged in the same manner and operating to produce the same results as required in each of the claims of Tappan's patents. Tappan claims, however, that Schroeder 'abandoned' the invention because he pursued an improved device rather than the original one. The court rejects this argument on the ground that Schroeder's basic concept remained the same. Accordingly, Judge Whelan concludes that Tappan's patents are anticipated under §102(g) and obvious under 35 U.S.C. §103."

Again, the court holds the patent invalid under Section 102(g) and Section 103 separately rather than invalid as anticipated under Section 102(g) if identical or invalid as obvious under Section 103 based on a Section 102(g) prior invention if not identical. Perhaps this is a very fine point and a very formalistic view but note that Judge Rich with his characteristic thoroughness went to some length in straightening out the Bass attorneys on the proper phraseology.[1]

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1 "Appellants' brief refers to the rejection in this case as 'a section 102(g) rejection,' which it is not, and we therefore clarify that matter at the outset. The rejection is for obviousness under §103 based on alleged prior inventions of others which are deemed to be 'prior art' within the meaning of that term in §103 by virtue of §102(g)." 177 USPQ at 183.

Unfortunately or fortunately, depending on which side of the fence you find yourself, this recent 1976 line of cases goes far beyond what Maurice Klitzman discovered with respect to 1974 decisions involving Section 102(g): for every case where a Section 102(g) defense or attack fails there are at least two cases where such a defense or attack succeeds.[1] In 1976 the ratio, in fact, appears to be more like 1 to 6.

This seems to fly in the face of Klitzmann's statement that the "102(g) invalidity defense is not easily proven"[2] as well as Judge Rich's statement in Bass that

> "there are many other defenses much easier to establish and it is a rare case where the effort of going back to the date of invention of a prior inventor is worth the cost. In particular, Section 102(e) makes patents unquestioned prior art for all purposes as of their United States filing dates and the date of invention is usually not enough earlier to make a difference in the result."[3]

In comparison to the incidence of Section 102(g) defenses or attacks in infringement litigation in the pre-Bass area, it appears to me that reliance on Section 102(g) has picked up considerably. This Section is used now with much greater frequency which is probably due to the greater awareness on the part of attorneys of the Section 102(g) opportunity. This is the bad news.[4]

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1 58 JPOS 505, 521 (1976)

2 Klitzman, Id. at 519

3 177 USPQ at 186, footnote 7

4 On the positive side, no apparent anomalies or undue extensions appear in this line of cases as in some prior cases, as for instance in Allen v. Brady Co., 184 USPQ 385 (7th Cir. 1974) where the court held that the invention disclosed in an abandoned application can be used as Section 102(g) prior art since the abandonment occurred after the filing date of the patent in suit and Del Mar Engineering v. US, 186 USPQ 42 (Ct/Cls 1975) where it was held that in spite of abandonment of work on the Dart Missile the Section 102(g) defense was available because abandonment occurred after Del Mar entered the picture.

Recent Developments - PTO Rejections

In the area of patent prosecution, I have some good news for you. In my previous talk and in my article[1] I mentioned a rash of Section 102(g)/103 rejections that we had to cope with in our shop. Since then all but one of them have been overcome and some of the resolutions are very interesting indeed. One such rejection had reached the Board of Appeals. In that one a Defensive Publication was cited under Section 102(g) as effective as of its filing date after the Board had reversed the Examiner who had applied it initially under Section 102(a) as effective as of its filing date and not its publication date. The Examiner relied on the Manual of Patent Examining Procedure (MPEP) Sec. 711.06(a) which permitted this.

However, shortly after we filed our Brief the claims were indicated to be allowable. In the Brief we had argued that the PTO had failed to carry the burden of proof that the Defensive Publication applicants had invented the claimed subject matter prior to our Swiss invention, pointing out that though the Swiss priority dated after the filing date of the Defensive Publication there was the possibility of prior importation of the Swiss invention. Also we argued that the burden of proof was not carried that the Defensive Publication applicant had not abandoned the invention. In fact, we argued, participation in the Defensive Publication Program before our Swiss filing date evidenced an intention to abandon the invention. The prompt allowance surprised and pleased us. But according to the

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1 58 JPOS, at 529

Ex parte Osmond et al.[1] decision, the PTO Board of Appeals had decided already a few months before that a Defensive Publication cannot be relied on under Section 102(g) as it cannot be construed as a constructive reduction to practice of the subject matter disclosed (there having been no evidence of record of actual reduction to practice).

In a prior Ex parte Osmond et al.,[2] decision it had been held by an enlarged Board that a Defensive Publication was not available as evidence of prior knowledge as of its filing date. This parallels our case to a T.

In my article I also mentioned that we had Section 102(g) rejections in five cases based on the foreign priority dates of US patent references. In one Office Action, for example, the Examiner stated: "The priority document translation does not remove the rejection. In re Bass, ... and In re Hellsund ... authorize Section 103 rejections based on Section 102(g). Note that 35 USC 119 states that an application 'shall have the same effect' as if it were filed in this country on the date that a proper priority application was filed." Such rejections are untenable, to say the least. Foreign inventions are involved which are clearly excluded from the sweep of Section 102(g) and such references are not available under Section 102(e) as of the foreign priority date in view of the Hilmer II[3] and Lilly v. Brenner[4] cases.

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1 191 USPQ 340 (Bd./App., 1976)

2 191 USPQ 334 (Bd./App., 1973)

3 In re Hilmer, 165 USPQ 255 (CCPA 1970)

4 Eli Lilly v. Brenner, 153 USPQ 95 (D.C. Cir. 1967)

In four of these cases these rejections were overcome by arguing that the foreign-origin patent references covered foreign inventions and were available only as of their U.S. filing dates while the subject cases enjoyed earlier foreign priority dates. In one case, the earliest one, we did regrettably not press the issue but took out a patent with allowed narrower claims.

In one case, we received a 102(g) rejection from the PTO in which the Examiner relied on the U.S. priority date of a foreign patent reference, holding that "(the German patent) is available as a reference despite its (later) publication date in view of the disclosure of its priority document U.S. application ... See In re, Bass ...; In re, Hellsund ..." This is a tougher one! We are still working on this one but in the direction of distinguishing it from the "prior invention". But here too, as Dennis Albrecht pointed out in a July 1974 JPOS article[1], there are some limitations and safeguards. In view of problems with Section 122 and Rule 14 regarding secrecy of pending applications, Albrecht concludes that an

> "examiner should never rely on any part of a foreign patent publication as a reference under Section 102(g) unless he has (1) obtained an English language translation of the foreign patent publication and (2) compared it word-for-word with the disclosure in the U.S. priority application (whether pending or abandoned). ... it is submitted that a Section 102(g) rejection over the foreign patent publication should not be sustained in the absence of corroborating evidence as to the scope of the disclosure in ... (the) priority document."

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1 Dennis L. Albrecht, "Foreign Patent Publications Claiming Priority Based on a U.S. Application. Are they Prior Art under 35 USC 102(g)?", 56 JPOS 422 (1974)

Lately, that is, for at least over a year we have not seen any Section 102(g) rejections except in "lost counts" or post-interference situations, nor, it appears, has anybody else.

Possible Solutions

By now I have already clearly intimated that PTO rejections involving Section 102(g)/103 issues - should there still be any - are not likely to be well-taken and hence are controvertible except in special situations. From the above it is clear that any Section 102(g)/103 rejections can be successfully argued, apart from drawing patentable distinctions which is, of course, also a possibility, where 1) a reference is on abandoned application, 2) where a reference is a later Defensive Publication, 3) where a reference is a U.S. patent with a later filing date but claiming an earlier foreign priority date, 4) where a reference is a later publication with an earlier date of receipt by the publisher and 5) where a reference is a later foreign patent claiming earlier U.S. priority (but this is more difficult as indicated above). There is no need to buckle under and give in without a fight.

After all, Section 102(g) - as bad as it is as far as its implications and ramifications are concerned - has some significant built-in limitations and breaks.[1]

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1 This is also why Judge Rich wanted to rely on it in In re Hellsund

Prior invention under Section 102(g) has to constitute, in the first place, an invention that was clearly reduced to practice (rather than being just an incomplete or abandoned experiment). A clear reduction to practice is not always the case and not always provable. Secondly, this prior invention must not have been abandoned, suppressed, or concelaed. Here too abandonment, suppression or concealment does take place quite often and carrying the burden of proof on this issue has its problems too. Apropos burden of proof, at least clear and convincing evidence must be brought to bear. Uncorroborated self-serving statements of an alleged prior inventor will get nowhere.

Further, you can always try, when faced with a Section 102(g)/103 rejection or defense or attack, to establish unobviousness.

In my paper I point to a number of decisions where Section 102(g)/103 rejections or defenses or attacks failed for one reason or another be it because the claimed invention was reduced simultaneously as the "prior" invention or was unobvious nonetheless or the prior invention was abandoned or suppressed or concealed or was incomplete and not reduced to practice or perhaps can even be considered to have been forfeited because of undue delay in filing.[1]

By the way, the practice of swearing back through Rule 131 affidavits, is not necessarily tabu, as has been stated.

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1 58 USPQ at 532-533

Such affidavits can certainly be used with respect to patents of foreign origin, foreign patents and foreign applications and since the body of foreign art and U.S. patents of foreign origin is vastly growing, this is not a minor exception. Also, such affidavits can be used with respect to U.S. patent and publication references of others who are not co-workers since their prior work may fail the test of reduction to practice or may have been abandoned, suppressed or concealed or forfeited.

However, with respect to prior art of co-workers, Rule 131 affidavits are indeed "out" unless you find there was simultaneous reduction to practice as in the Bass case itself in which event Rule 132 affidavits are proper.[1]

Otherwise - and this is also the case as regards the practices (or dodges) of using terminal disclaimers or filing applications on the same date - unobviousness should be established or elections should be made or perhaps more reliance should be placed on trade secret protection.[2]

Another possible solution and perhaps the best one, though a long shot, is a legislative one. What could and should be done is to change the law on inventorship. As presently

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1 Edward C. Walterscheid, "Rule 131 Practice", 57 JPOS 336, 347-348 (1975)

2 As regards trade secrets, Roger Milgrim is putting the Klitzman JPOS article as well as mine among the appendices of his book on "Trade Secrets" and is referring to these articles in his talks on trade secrets. The added Bass-based complications in the patent field discussed in these articles together with recent cases dealing with concealment and suppression signify to him the desirability of shifting further away from patents towards trade secrets for protection. He has also asked me to give a talk on the topic of In re Bass and the propriety of holding patentable matter as a trade secret in a PLI June Trade Secrets Program and in that connection I will scrutinize this subject from the trade secrets point of view.

interpreted and John Pearne's article in last year's JPOS[1] in part to the contrary notwithstanding, joint inventors must have contributed to all claims. Most regrettably, a provision recommended by the Presidential Commission and found in some Patent Law Revision bills, e.g., S. 1321[2] and S. 214[3] was removed from S. 2255.[4] It is the following:

> "In an application for patent naming two or more inventors, it shall not be necessary for each person named as an inventor to be a joint inventor of the subject matter asserted in any claim."

Such a provision would help tremendously to ease the negative impact on corporate or institutional research of Section 102(g) combined with Section 103. It would make it possible to combine improvement inventions with basic inventions in one case in many instances.

I renew my battle cry again: Let's fight for such a legislative revision!

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1 John F. Pearne, "Must Each Inventor Named in a Joint Patent Application Have Made an Inventive Contribution to Each of the Claims Thereof?", 58 JPOS 205 (April 1976)

2 Hart, 93rd Congress, 1st Session, Section 116(b)

3 Fong, 94th Congress, 1st Session, Section 116(b)

4 McClellan, 94th Congress, 1st Session

Karl F. Jorda

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