International Problem
International Problem

Ann conceives in France
International Problem

Ann conceives in France

Ann RTPs in France
International Problem

Ann conceives in France

Ann RTPs in France

Ann applies in France
International Problem

Ann conceives in France

Ann RTPs in France

Ann applies in France

Bill conceives in USA
Ann conceives in France

Ann RTPs in France

Bill RTPs in USA

Ann applies in France

Bill conceives in USA
International Problem

Ann conceives in France

Less than 12 months

Ann RTPs in France

Ann applies in USA

Bill RTPs in USA

Bill conceives in USA

Ann applies in France

Bill conceives in USA
Ann conceives in France

Less than 12 months

Ann RTPs in France

Bill RTPs in USA

Bill conceives in USA

Bill applies in USA

Ann applies in USA

Ann applies in France
Suppose Ann’s application and Bill’s application claim same invention
Suppose Ann’s application and Bill’s application claim same invention

- PTO will declare an interference
Suppose Ann’s application and Bill’s application claim same invention

- PTO will declare an interference
- Ann would prevail under either of two alternative grounds:
  - Ann “invented first”
    - Under 102(g)(1), Ann’s inventive activity post-1/1/1996 counts unless she abandoned, concealed, or suppressed the invention
  - 119 (implementing the Paris Convention) permits Ann to assert as a priority date for her US application, the date of her French application
    - Constructive RTP before Bill’s actual RTP
International Problem

Ann conceives in France

Less than 12 months

Bill RTPs in USA

Ann RTPs in France

Bill applies in USA

Ann applies in USA

Ann conceives in France

Bill applies in USA
Suppose Ann’s application discloses the substance of Bill’s invention but doesn’t claim it
Suppose Ann’s application discloses the substance of Bill’s invention but doesn’t claim it

• No interference
International Problem

Ann conceives in France

Less than 12 months

Bill RTPs in USA

Ann applies in USA

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Bill conceives in USA

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Ann applies in USA

Bill RTPs in USA

Bill conceives in USA

Bill applies in USA

Ann’s US application published
International Problem

Ann conceives in France

Ann applies in USA

Bill applies in USA

Bill RTPs in USA

Bill conceives in USA

Ann’s US application published

Ann’s US patent granted

Less than 12 months
Suppose Ann’s application discloses the substance of Bill’s invention but doesn’t claim it

• No interference
Suppose Ann’s application discloses the substance of Bill’s invention but doesn’t claim it

• No interference
• Ann’s French patent application is not a problem, because 102(e) only applies to US applications
Suppose Ann’s application discloses the substance of Bill’s invention but doesn’t claim it

• No interference
Suppose Ann’s application discloses the substance of Bill’s invention but doesn’t claim it

- No interference
- What if Ann’s French patent is subsequently granted?
  - 102(a) would apply, but because the grant would be after Bill’s date of invention, it would not threaten him
Suppose Ann’s application discloses the substance of Bill’s invention but doesn’t claim it

- No interference
Suppose Ann’s application discloses the substance of Bill’s invention but doesn’t claim it

• No interference
• What about Ann’s US patent application?
  – Either the grant of Ann’s US patent or the publication of Ann’s US patent application will make the contents of Ann’s US application “prior art” for Bill – as of the date of Ann’s US application – 102(e)
  – But Bill RTP’d earlier, so 102(e) will not block the grant of Bill’s US patent
Ann conceives in France

Less than 12 months

Bill RTPs in USA

Bill conceives in USA

Ann RTPs in France

Ann applies in France

Bill applies in USA

Ann applies in USA

Ann’s US patent granted

Ann’s US application published
International Problem

Ann conceives in France

Ann applies in USA

Bill applies in USA

Ann RTPs in France

Less than 12 months

Bill RTPs in USA

Bill conceives in USA

Ann’s US application published

Ann’s US patent granted
Suppose Ann’s application discloses the substance of Bill’s invention but doesn’t claim it

- But isn’t the effective date of Ann’s US patent application the date of Ann’s French patent application?
  - §119, implementing the Paris Convention
  - If so, then it would defeat Bill
Ann conceives in France

Ann applies in USA

Bill applies in USA

Bill RTPs in USA

Less than 12 months

Ann RTPs in France

Bill conceives in USA

Ann’s US application published

Ann’s US patent granted
International Problem

Ann conceives in France

Ann applies in USA

Bill conceives in USA

Ann RTPs in France

Ann applies in France

Bill RTPs in USA

Ann’s US application published

Ann’s US patent granted

§119

Less than 12 months
Suppose Ann’s application discloses the substance of Bill’s invention but doesn’t claim it

• But isn’t the effective date of Ann’s US patent application the date of Ann’s French patent application?
  – §119, implementing the Paris Convention
  – If so, then it would defeat Bill
Suppose Ann’s application discloses the substance of Bill’s invention but doesn’t claim it

• But isn’t the effective date of Ann’s US patent application the date of Ann’s French patent application?
  – §119, implementing the Paris Convention
  – If so, then it would defeat Bill

• No – *Hilmer*
International Problem

Ann conceives in France

§119
Less than 12 months

Ann RTPs in France

Ann applies in France

Bill applies in USA

Bill RTPs in USA

Bill conceives in USA

Ann’s US application published

Ann’s US patent granted
Ann conceives in France

Ann RTPs in France

Ann applies in France

Bill RTPs in USA

Bill conceives in USA

Bill applies in USA

Ann’s US application published

Ann’s US patent granted

§119

Less than 12 months
International Problem

Ann conceives in France

Less than 12 months

Bill RTPs in USA

Bill applies in USA

Bill conceives in USA

Ann applies in USA

Ann RTPs in France

Ann applies in France

Bill’s US patent granted

Ann’s US application published

Ann’s US patent granted
Suppose Ann’s application discloses the substance of Bill’s invention but doesn’t claim it

- But surely Ann invented the invention before Bill. Shouldn’t Bill’s US patent be blocked by the fact that someone else (namely Ann) invented first?
Suppose Ann’s application discloses the substance of Bill’s invention but doesn’t claim it.

- But surely Ann invented the invention before Bill. Shouldn’t Bill’s US patent be blocked by the fact that someone else (namely Ann) invented first?
- 102(g)(2) applies
  - Only inventive activity “in this country” counts
Suppose Ann’s application discloses the substance of Bill’s invention but doesn’t claim it.

- But surely Ann invented the invention before Bill. Shouldn’t Bill’s US patent be blocked by the fact that someone else (namely Ann) invented first?
- 102(g)(2) applies
  - Only inventive activity “in this country” counts
- So Bill’s US patent will be granted
International Problem

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Bill conceives in USA

Ann applies in USA

Bill applies in USA

Less than 12 months

Ann RTPs in France

Ann applies in France

Bill RTPs in USA

Bill conceives in USA

Ann’s US application published

Ann’s US patent granted
Ann conceives in France

Less than 12 months

Ann RTPs in France
Ann applies in France

Bill RTPs in USA
Bill conceives in USA

Bill applies in USA

Ann’s US application published
Ann’s US patent granted

Bill’s US patent granted
Ann conceives in France

Bill conceives in USA

Ann applies in USA

Bill applies in USA

Ann RTPs in France

Bill RTPs in USA

Less than 12 months

Ann’s US application published

Ann’s US patent granted

Bill’s US patent granted

Carol infringes Bill’s patent
Suppose Ann’s application discloses the substance of Bill’s invention but doesn’t claim it.

- If Bill brings an infringement action against Carol, Carol will defend on the ground that Bill’s patent is invalid under:
  - 102(e)
  - 102(g)
Suppose Ann’s application discloses the substance of Bill’s invention but doesn’t claim it

- If Bill brings an infringement action against Carol, Carol will defend on the ground that Bill’s patent is invalid under:
  - 102(e): Carol will lose because of *Hilmer*
  - 102(g)
Suppose Ann’s application discloses the substance of Bill’s invention but doesn’t claim it

- If Bill brings an infringement action against Carol, Carol will defend on the ground that Bill’s patent is invalid under:
  - 102(e): Carol will lose because of *Hilmer*
  - 102(g): Carol will lose because of the geographic limitations of 102(g)(2)