

B.4.3 Validity—The Claims

4.3b-1 ANTICIPATION

In order for someone to be entitled to a patent, the invention must actually be “new.” [Alleged infringer] contends that claim(s) [] of the [] patent is/are invalid because the claimed invention(s) is/are anticipated or because [patent holder] lost the right to obtain a patent. [Alleged infringer] must convince you of this by clear and convincing evidence, i.e., that the evidence highly probably demonstrates that the claim(s) is/are invalid.

Specifically, [alleged infringer] contends that the following piece[s] of prior art anticipates claim(s) [] of the [] patent: [describe art.]

Anticipation must be determined on a claim-by-claim basis. [Alleged infringer] must prove by clear and convincing evidence that all of the requirements of a claim are present in a single piece of prior art. To anticipate the invention, the prior art does not have to use the same words as the claim, but all of the requirements of the claim must have been disclosed and arranged as in the claim. The claim requirements may either be disclosed expressly or inherently—that is, necessarily implied—such that a person having ordinary skill in the art in the technology of the invention, looking at that one reference, could make and use the claimed invention.

Where [alleged infringer] is relying on prior art that was not considered by the PTO during examination, you may consider whether that prior art is significantly different and more relevant than the prior art that the PTO did consider. If you decide it is different and more relevant, you may weigh that prior art more heavily when considering whether the challenger has carried its clear-and-convincing burden of proving invalidity.

If a dependent claim is anticipated by the prior art, then the claims from which it depends are necessarily anticipated as well.

[For patents having an effective filing date before March 16, 2013 – include those that apply.]

[Alleged infringer] contends that claims [] of the [] patent is/are not new and is/are invalid as anticipated because [the inventor] has lost her or his rights if she or he had already obtained a patent for the invention in a foreign country before the filing date of the application in the United States or the patent application was filed in a foreign country more than a year before the filing date of the application for the patent in the United States.

[Alleged infringer] contends that claims [] of the [] patent is/are not new and is/are invalid as anticipated because it was described in a published patent application filed by another in the United States [or under the PCT system and designated the United States, and was published in English] before [insert date of invention].

[Alleged infringer] contends that claims [] of the [] patent is/are not new and is/are invalid as anticipated because the claimed invention was described in a patent granted on an application for patent by another filed in the United States [or under the PCT system and designated the United States, and was published in English] and the application was filed before [insert date of reduction

to practice or the filing date of the application for the [] patent].

[Alleged infringer] contends that [patent holder] has lost his or her rights because he or she abandoned the invention. To abandon the invention, an inventor must intend to dedicate his or her invention to the public. Such dedication may be either express or implied, by actions or inactions of the inventor. Delay alone in filing a patent application on the invention is not enough to find the required intent.

Authorities

Pre-AIA 35 U.S.C. § 102(a)-(g); *Monsanto Tech. LLC v. E.I. DuPont de Nemours & Co.*, 878 F.3d 1336, 1343 (Fed. Cir. 2018); *Finisar Corp. v. DirectTV Grp., Inc.*, 523 F.3d 1323, 1334 (Fed. Cir. 2008); *Net MoneyIN, Inc. v. Verisign, Inc.*, 545 F.3d 1359, 1369-70 (Fed. Cir. 2008).