Even if Cited Art is Ancient History, Your Claims Might Still be History: 'Old' Art Cited in Office Actions

by Peter Malen

The patent statute provides in part that "...*Whoever invents or discovers any <u>new</u> and useful process, machine, manufacture, or composition of matter, or any <u>new</u> and useful improvement thereof, may obtain a patent therefor*..." 35 USC § 101. Emphasis added. For the purposes of this note, the operative word is "*new*."

Underlying this statutory "*newness*" requirement for patentability is a policy judgment that a person ought not be able to obtain a patent on known technology whose free availability the public relies on, or has the right to rely on. Obtaining a patent on known, or "*old*" technology, would vest a right in the patentee to prevent others from using that technology, notwithstanding that prior to the issuance of that patent right, such technology was freely available for use by the public. In effect, the patentee could 'pull the rug out' from under those who had previously relied on free availability of the technology. Not only would such a result be unfair to the public, but it would also introduce uncertainty as to whether or not, at any given time, the public could use, or continue to use, technology thought to be freely available. Hence, the newness requirement set forth in the statute.

With this background in mind, it is sometimes the case that in rejecting claims as unpatentable, the United States Patent and Trademark Office will cite relatively "*old*" art as evidence that the claimed invention is not new. Here, the term "*old*" refers not only to art that was in the public domain prior to filing of the patent application but art that is also old in the historical sense, e.g., a patent that issued in the late 1800s or early 1900s.

When apprised of a rejection based on old art, clients sometimes question the validity of the rejection, mistakenly believing that the age of the cited art somehow undercuts the rejection. In fact, while the age of the art may have other implications, the age has nothing to do with the availability of that art as a valid basis for rejecting the claims. The lesson then is that even if the cited art is ancient history, your claims could still be history.