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Section 102(g) Is Still Available as a Defense for Pre-AIA Patents

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Addressing the issue of inventorship under 35 U.S.C. §102(g), the U.S. Court of Appeals for the Federal Circuit found certain patent claims invalid, finding that the target of the patent infringement allegations invented the technology first. ***The Fox Group Inc. v. Cree Inc.***, Case No. 11-1576 (Fed. Cir., Nov. 28, 2012) (Wallach, J.) (O'Malley, J.; dissenting-in-part).

The Fox Group filed suit against Cree, alleging infringement of a patent directed to silicon carbide crystals. Cree asserted a counterclaim seeking a declaration that the patent was invalid due to Cree having invented the claimed subject matter prior to Fox Group. The district court granted summary judgment in Cree's favor, ruling that the entire patent was invalid in light of a finding that Cree had invented the subject of the claims first. Fox Group appealed.

The Federal Circuit, in affirming part of the district court's decision, found that Cree had indeed conceived and reduced to practice the subject matter prior to Fox Group. Fox Group argued that Cree had abandoned, suppressed or concealed its invention by not filing a patent application, not presenting proof of commercialization that would allow for reverse engineering and not otherwise providing adequate disclosure because Cree failed to reveal the details of the conditions under which it invented the subject matter. The Federal Circuit explained that Cree promptly and publicly disclosed its findings concerning its prior invention of the claimed subject matter in a presentation at the 1995 International Conference and a published paper on the subject. Accordingly, the Court concluded that Cree had made its invention known to the public.

The Federal Circuit, however, reversed the district court's ruling that all of the claims of the patent were invalid and instead held that because there was no case or controversy at the time of the judgment over the unasserted claims, the district court erred in holding the unasserted claims were invalid.

Practice Note: Although soon to be eliminated as prior art for new patents under the America Invents Act, 35 U.S.C. § 102(g) will continue to be a potentially important category of prior art for the near future as pre-AIA patents will remain the prevailing type of patent in infringement suits for at least the next decade.

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