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Is Novelty Obsolete?: Chronicling the Irrelevance of The Invention Date in US Patent Law

The novelty provisions of US patent law allow inventors to claim priority rights back to their invention date and consequently avoid intervening third party disclosures that could otherwise block patentability. This fundamental tenant of the US system has been regularly threatened with extinction as part of a switch to a first-to-file system. Although the issue has been hotly debated for years, neither side of the debate has any empirical support for their arguments. In a first of its kind multifaceted empirical study of patent prosecution, I examine the role that invention-date based novelty rights play in US patent law.

Summary of Results: Although most patent applications face prior art that – evidence permitting – could have been antedated based on invention-date novelty rights, only 0.7% of applicants actually attempted to assert prior-invention rights. Furthermore, the assertion of rights led directly to an issued patent in a minuscule 0.1% of applications -- 20 of the 17,000+ cases in this my sample. Perhaps going against conventional wisdom, large companies claimed rights back to the invention date more often and more successfully than did small companies or individual inventors. This holds true both in absolute and relative terms. The difficulty and potential expense of attempting to prove prior conception and due diligence or reduction-to-practice are laid-out in a set of ___ recent administrative patent appeals where ___% of attempts to antedate references were rejected. This may also help explain my finding indicating that applicants are more likely to assert novelty rights when the application is highly valuable. A practitioner survey of 1000+ patent law professionals reveals, inter alia, a concern that attempts to antedate are leave patents open to challenge during litigation as “fodder” for litigators.