The concept of “possession” is central to much of property law. The first to take possession, or occupy, a wild animal is the owner; first to take possession of lost property is the “finder”; and one who occupies and uses another’s land can become the true owner through adverse possession. Carol Rose views this role of possession as “something that requires a kind of communication, and the original claim to the property looks like a kind of speech, with the audience composed of all others who might be interested in claiming the object in possession.”

These concepts of possession also operate within patent law. Under the 1952 Patent Act we award the patent, with some exceptions, to the first person to invent the relevant innovation. As of March 2013, when relevant provisions of the America Invents Act come into force, we will award patents to the first inventor to file a patent application. In this way, the first to win the possession “race,” either by inventing first or filing a patent application, is awarded the patent.

A necessary prerequisite to either of the regimes is that the inventor have possession of the relevant invention, as demonstrated through their patent application. The patent statute requires the applicant to sufficiently disclose the invention so as to demonstrate that he possesses it and so as to ensure that others in the relevant technological field can make and use the claimed invention without undue experimentation. The extent of the disclosure can impact the scope of the rights afforded under the patent.

Patent law is different than other forms of property, however, in that merely winning the possession race is alone insufficient for the applicant to obtain the patent. The invention must also be new (i.e. novel), a technical term of art that means the invention cannot have been created or described in a single place—such as a prior creation of the exact invention claimed in the patent or a complete description of that invention in a publication such as a scientific article. The invention additionally cannot be merely an obvious variation over what is already known in the relevant technological field. The patent applicants, therefore, must show not only that they are the first to possess the invention by being the first to invent (under the 1952 Act) or the first to file (under the AIA) but also that they are the first to possess the invention ever, relevant to what is publicly known within the relevant field of technology.

This possession-based view of the prior art affords a novel theoretical framework for defining when an invention lacks of novelty (also known as anticipation) and when an invention is obvious. In essence, both of these doctrines, in essence we

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A Possession-based Approach to Patent Validity

Timothy R. Holbrook

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Associate Dean of Faculty and Professor of Law, Emory University School of Law.
are asking whether the public was already in possession of the claimed invention and, thus, the applicant should be denied a patent.