



UNIVERSITY OF  
MARYLAND  
SCHOOL OF LAW

**PATENT LAW  
UPDATE**

***Dow Chem. Co.  
v.  
Astro-Valcour,  
Inc.***

No. 01-1003  
Federal Circuit  
Sept. 28, 2001

***“Whether [an  
inventive entity]  
understood  
that it had  
produced a  
legally  
patentable  
invention is  
immaterial for  
purposes of  
§ 102(g)(2). It  
is enough that  
the [inventors]  
appreciated the  
fact of their  
invention.”***

On September 28, 2001, the Federal Circuit affirmed the district court’s summary judgment that certain claims U.S. Patents No. B1 4,640,933, No. 4,694,027, and No. 4,663,361 (the Park patents) are invalid under 35 U.S.C. § 102(g). The patented technology related to isobutane-blown plastic foam. The Federal Circuit noted:

Dow urges that an “inventor” must be a person who conceives of an invention and reduces it to practice, either actually (by making the invention) or constructively (by filing a patent application), and that because the version of § 102(g) in effect at the time the Park patents were secured applied only to prior makings of the invention by another inventor, prior art under § 102(g) is limited to prior makings by someone who conceived the invention and reduced it practice. [U]nder the pre-1999 version of the statute, as with the current version, it must be shown that an “inventor” made the claimed invention to establish a first-inventor defense under § 102(g). However, we disagree with Dow’s contention that no one at AVI was an inventor.

Dow’s argument is that even if AVI reduced the Park invention to practice in 1984, AVI nevertheless failed to conceive of any invention that occurred as a result of its 1984 testing and production of foam, and thus no one at AVI can be considered to be an inventor, as required by 102(g). Dow [contends] that one cannot be an inventor without recognizing or appreciating that he invented something. We disagree.

[T]he date of the conception of a prior inventor’s invention is the date the inventor first appreciated the fact of what he made. [A]n inventor [need not] be the first to appreciate the patentability of the invention. . . . AVI’s employees immediately appreciated what they had made, and indeed its significance, when they made isobutane-blown foam in March and August 1984. . . . AVI clearly recognized and appreciated the existence of its new process and product. Whether AVI understood that it had produced a legally patentable invention is immaterial for purposes of § 102(g)(2). It is enough that the AVI employees appreciated the fact of their invention. . . .

Dow also asserts that, even if AVI is a prior inventor, AVI suppressed or concealed the invention such that its invention does not qualify as § 102(g) prior art. . . . Dow urges that the two and one-half year delay between AVI’s first making and publicly disclosing its invention “gives rise to a presumption that AVI abandoned, suppressed and concealed its alleged invention.” [We decline to create a rule that] a delay of a certain length of time gives rise to presumption of abandonment, suppression, or concealment. [D]uring the 30 months between first making the isobutane-blown foam and selling the foam, AVI actively and continuously took steps towards the commercialization of the foam, including the procurement of financing to build a new production plant and the attention to safety considerations associated with using isobutane as a blowing agent. A prior inventor is not required to take the fastest route to commercialization, but only to make “reasonable efforts to bring the invention to market.”