



UNIVERSITY OF
MARYLAND
SCHOOL OF LAW

**PATENT LAW
UPDATE**

*Space
Sys./Loral, Inc.*
v.
*Lockheed
Martin Corp.*

No. 00-1269
Federal Circuit
Nov. 13, 2001

*“The fact that a
concept is
eventually
shown to be
workable does
not
retrospectively
convert the
concept into
one that was
‘ready for
patenting’ at
the time of
conception.
[T]he on sale
bar does not
arise when
there is
‘additional
development
after the offer
for sale.’”*

On November 13, 2001, the Federal Circuit reversed and remanded the district court’s summary judgment that U.S. Patent No. 4,537,375 is invalid under 35 U.S.C. § 102(b) because the patented invention was on sale more than one year before the patent application was filed. The patented technology related to an attitude control system for maintaining the position and orientation of a satellite. The Federal Circuit noted:

[T]he district court ruled that all that is required for an invention to be ready for patenting is “legal conception of every element of every claim.” The court described “legal conception” as a mental act, and held that it is not necessary to enable an invention that is fully conceived, in order for the invention to be ready for patenting. . . . That is incorrect.

[T]wo ways to show that an invention is ready for patenting are if it has been actually reduced to practice, or if “prior to the critical date the inventor had prepared drawings or other descriptions of the invention that were sufficiently specific to enable a person skilled in the art to practice the invention.” [I]t must be “clear that no aspect of the invention was developed after the critical date.”

Lockheed argues that Dr. Chan’s rough drawings showed the essential principles of the invention, although in lesser detail than was later available and included in the patent application. SSL responds that many months of development were required in order to learn the information that was essential to an operable invention, and that the drawings do not show an enabled invention. . . . “The word ‘invention’ must refer to a concept that is complete, rather than merely one that is ‘substantially complete.’ It is true that reduction to practice ordinarily provides the best evidence that an invention is complete . . . it does not follow that proof of reduction to practice is necessary in every case.”

[R]eduction to practice was not necessary in every case; but . . . a conception, having neither a reduction to practice nor an enabling description, [does not equate with] ready for patenting as a matter of law. To be “ready for patenting” the inventor must be able to prepare a patent application, that is, to provide an enabling disclosure as required by 35 U.S.C. §112. For a complex concept such as the prebias technique, wherein the inventor himself was uncertain whether it could be made to work, a bare conception that has not been enabled is not a completed invention ready for patenting. Although conception can occur before the inventor has verified that his idea will work when development and verification are needed in order to prepare a patent application that complies with §112, the invention is not yet ready for patenting.

Lockheed argues that since Dr. Chan’s proposal included the system’s four steps that are set forth in the claim, the idea was “ready for patenting” as a matter of law, even if it were not then enabled. However, the patent statute requires an enabling disclosure of how to make and use the invention. The fact that a concept is eventually shown to be workable does not retrospectively convert the concept into one that was “ready for patenting” at the time of conception. [T]he on sale bar does not arise when there is “additional development after the offer for sale.”