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United States Court of Appeals for the District Circuit

91-1955

IN RE: EMMETT L. BROWN

Decided April 1, 1991

Before RICH and MARKEY, and THYME, District Judge.¹

This appeal is from the decision of the United States Trademark and Patent Office Board of Patent Appeals and Interferences (the Board), affirming the Examiner’s final rejection of all of the claims of Emmett L. Brown’s patent application Serial No. 840,336 filed March 18, 1986, entitled, “Time Machine.” We affirm.

Background

On March 18, 1986, Brown filed a patent application for an invention entitled, “Time Machine.” The application described an admittedly novel apparatus which had formerly been the exclusive province of science fiction novels. According to the invention, under proper operating conditions, a device called a “flux capacitor” could displace the apparatus a specific amount either forward or backwards in time. Temporal displacement would occur upon the application of approximately 1.21 GW of power while the apparatus (in the preferred embodiment, a late model sports car) was travelling at a speed of 88 m.p.h.²

Brown briefly asserts that all of the pre-1985 uses were subject to the “experimental use” doctrine. This doctrine was first established by the classic case of City of Elizabeth v American Nicholson Pavement

¹ Judge Justin Thyme, United States District Court for the Western District of California, sitting by designation.

² While other technical details of the device are truly fascinating, a discussion of them is not necessary for this opinion.

Company, 97 U.S. (7 Otto) 126, 24 L.Ed. 1000 (1878), and has been followed by numerous cases thereafter. See, e.g., Baker Oil Tools, 828 F.2d at 1564, 4 USPQ2d at 1214; Hycor Corporation v Schlueter Co., 740 F.2d 1529, 1535, 222 USPQ 553, 557 (Fed. Cir. 1984); TP Laboratories, 724 F.2d at 971-72, 220 USPQ at 581-82. The Board properly rejected this argument, given (1) the time machine was clearly adequately tested no later than Brown's original return to 1985 from the year 2015, so subsequent use was not "experimental," and (2) the lack of control by Brown over his invention, noted above, defeats any assertion of experimental use. In Re Hamilton, 882 F.2d 1576, 1580, 11 USPQ2d 1890, 1894 (Fed. Cir. 1989).

Brown next makes a number of ingenious arguments resulting from the unique facts of this case. First, he argues that the "one year" filing requirement of §102(b), should be measured from the time of the first reduction to practice (here 1985) rather than uses which occurred in the space-time continuum before then only due to the fact that the invention in question was a time machine. Brown argues that he truly first "used" the machine in October 1985, and filed his patent application within one year thereafter, in March 1986. Brown argues that he could not have filed his application any earlier than 1985, because, although the machine admittedly was "used" numerous times in 1885 and 1955, it had not actually been "invented" until 1985 (at least according to Brown's subjective point of view).

This is the stuff from which science fiction novels are made. The problem is that §102(b), as written, does not recognize glitches in the space-time continuum such as Brown has created. It merely talks about uses more than one year before the patent application. We note that the statute easily could have been written to take Brown's predicament into account, since the concept of time travel was well known by the time of the enactment of the Patent Act in 1952. See H. G. Wells, The Time Machine (1895); R. Heinlein, By His Bootstraps (1941), reprinted in The Menace from Earth (1959) (using a time machine, a man meets himself three times, argues with himself, and even loses some of those arguments).

Brown essentially argues that the Board’s holding is unfair. He argues that any time machine invention would be subject to the problem he has now encountered. That is, as soon as a patent issued, an infringer would use it to build a time machine, travel back in time, and invalidate an otherwise valid patent by “using” the time machine more than one year before the patent application’s filing date. Brown argues that it is inherent that any time machine would be “used” more than one year before it’ patent application was filed, by the very nature of the invention.

Brown thus poses the interesting hypothetical question of whether a post-issuance infringement of his patent by another could provide a defense to a patent infringement claim. This interesting hypothetical has no bearing on this case. Here, Brown himself used, or allowed the use, of his invention more than one year before he filed his patent application. He cannot now complain.

Finally, Brown asks us the following hypothetical question. Suppose he now used his invention to travel back to 1885, and refiled his patent application at that time. Clearly there would be no prior public use problem under §102(b) (or under its predecessor statutes). Such an application would have been filed well before any use of the time machine by anyone.

Although we are not in the business of answering hypothetical questions, in this situation we may respond as follows. Under Brown’s duty of disclosure of material facts to the Patent Office, Brown would be obligated to disclose this opinion to the Patent Office as part of his filing of any such 1885 application. In that case, it appears to us that this opinion would bar any such 1885 application under the doctrine of res judicata – even though under those circumstances, this opinion would not have been written until 100 years in the future.

Conclusion

The Board’s decision rejecting all of the claims is

AFFIRMED