



# **AMERICA INVENTS ACT**

## IMPLEMENTATION

### **First Inventor to File: Proposed Rules and Proposed Examination Guidelines**

**The Federal Laboratory Consortium for Technology Transfer  
America Invents Act Webinar Series  
October 1, 2012**

**Kathleen Kahler Fonda  
Senior Legal Advisor  
USPTO Office of Patent Legal Administration**

# First Inventor to File: Goals

- Provide guidance to examiners and the public on changes to examination practice in light of the AIA
- Address examination issues raised by the AIA
- Provide the Office with information to readily determine whether the application is subject to the AIA's changes to 35 U.S.C. 102 and 103



# Date

- Effective Date: March 16, 2013
- Comments Due: October 5, 2012



# Framework

<b>Prior Art</b>	<b>Exceptions</b>	<b>Label</b>
102(a)(1)	102(b)(1)(A)	Grace Period Inventor Disclosures & Grace Period Non-inventor Disclosures
	102(b)(1)(B)	Grace Period Intervening Disclosures
102(a)(2)	102(b)(2)(A)	Non-inventor Disclosures
	102(b)(2)(B)	Intervening Disclosures
	102(b)(2)(C)	Commonly Owned Disclosures



# 35 U.S.C. 102(a)(1): Prior Art

- Precludes a patent if a claimed invention was, before the effective filing date of the claimed invention:
  - Patented;
  - Described in a Printed Publication;
  - In Public Use;
  - On Sale; or
  - Otherwise Available to the Public
- Generally corresponds to the categories of prior art in pre-AIA 35 U.S.C. 102(a) and 35 U.S.C. 102(b)



# Sales

- AIA does not state whether on sale activity must be public to constitute prior art
- USPTO seeking public comment on the extent to which public availability plays a role in “on sale” prior art



# 35 U.S.C. 102(b): Exceptions

- Provides that certain “disclosures” shall not be prior art
- Disclosure is understood to be a generic term intended to encompass the documents and activities enumerated in AIA 35 U.S.C. 102(a)



# Grace Period Inventor and Non-inventor Disclosure Exception

- Grace period exceptions under 35 U.S.C. 102(b)(1) for prior art under 35 U.S.C. 102(a)(1)
- 35 U.S.C. 102(b)(1)(A):
  - A disclosure made one year or less before the effective filing date of the claimed invention shall not be prior art under 35 U.S.C. 102(a)(1) if:
    - The disclosure was made by:
      - the inventor or joint inventor; or
      - another who obtained the subject matter directly or indirectly from the inventor or joint inventor



# Example 1: 102(b)(1)(A) Exception

<b>Smith's Grace Period</b>	
July 2013 to June 2014	July 2014
Smith publishes	Smith files

- Smith gets the patent because Smith's publication was by Smith within a year of filing
- Inventor Smith: "That is my disclosure"



# Example 2: 102(b)(1)(A) Exception

<b>Smith's Grace Period</b>	
July 2013 to June 2014	July 2014
Taylor publishes Smith's subject matter	Smith files

- Smith gets the patent, if Smith shows the subject matter disclosed by Taylor was obtained from Smith
- Inventor Smith: “That disclosure originated from me”



# Grace Period Intervening Disclosure Exception

- Grace period exceptions under 35 U.S.C. 102(b)(1) for prior art under 35 U.S.C. 102(a)(1)
- 35 U.S.C. 102(b)(1)(B):
  - A disclosure made one year or less before the effective filing date of the claimed invention shall not be prior art under 35 U.S.C. 102(a)(1) if:
    - The subject matter disclosed was, before such disclosure, publicly disclosed by:
      - the inventor or joint inventor; or
      - another who obtained the subject matter directly or indirectly from the inventor or joint inventor



# Example 3: 102(b)(1)(B) Exception

Smith's Grace Period		
July 2013 to June 2014		July 2014
Smith publishes	Taylor publishes	Smith files

- Smith gets the patent if the subject matter of Taylor's publication is the same subject matter of Smith's publication.
- Inventor Smith: "I publicly disclosed the subject matter first"



# 35 U.S.C. 102(a)(2): Prior Art

- Precludes a patent to a different inventive entity if a claimed invention was described in a:
  - U.S. Patent;
  - U.S. Patent Application Publication; or
  - WIPO PCT Application Publicationthat was effectively filed before the effective filing date of the claimed invention
- Generally corresponds to the categories of prior art in pre-AIA 35 U.S.C. 102(e)



# Effective Prior Art Date: Definition

- Effective prior art date of subject matter in patents and published applications under AIA 35 U.S.C. 102(a)(2) is:
  - actual filing date of the patent or published application, or
  - date to which the patent or published application is entitled to claim a right of priority or benefit under 35 U.S.C. 119, 120, 121, or 365 which describes the subject matter



# Non-inventor Disclosure Exception

- Exceptions under 35 U.S.C. 102(b)(2) for prior art under 35 U.S.C. 102(a)(2)
- 35 U.S.C. 102(b)(2)(A):
  - A disclosure in an application or patent shall not be prior art under 35 U.S.C. 102(a)(2) if:
    - the disclosure was made by another who obtained the subject matter directly or indirectly from the inventor or joint inventor



# Intervening Disclosures Exception

- Exceptions under 35 U.S.C. 102(b)(2) for prior art under 35 U.S.C. 102(a)(2)
- Exception 2 (35 U.S.C. 102(b)(2)(B)):
  - A disclosure in an application or patent shall not be prior art under 35 U.S.C. 102(a)(2) if:
    - the subject matter disclosed was, before such subject matter was effectively filed, publicly disclosed by:
      - the inventor or joint inventor; or
      - another who obtained the subject matter directly or indirectly from the inventor or joint inventor



# Commonly Owned Disclosure Exception

- Exceptions under 35 U.S.C. 102(b)(2) for prior art under 35 U.S.C. 102(a)(2)
- 35 U.S.C. 102(b)(2)(C):
  - A disclosure made in an application or patent shall not be prior art under 35 U.S.C. 102(a)(2) if:
    - the subject matter and the claimed invention were commonly owned or subject to an obligation of assignment to the same person not later than the effective filing date of the claimed invention



# Joint Research Agreements

- Treatment of joint research agreements under Exception 3
- “Common ownership” exception under 35 U.S.C. 102(b)(2)(C) for 35 U.S.C. 102(a)(2) prior art is applicable if:
  - claimed invention was made by/on behalf of at least one party to a joint research agreement in effect on/before the effective filing date of the claimed invention;
  - claimed invention was made as a result of activities within the scope of the joint research agreement; and
  - application discloses the parties to the joint research agreement



# Applicability of AIA's Prior Art Provisions

- AIA's FITF provisions apply to any application or patent that contains, or contained at any time, a claimed invention having an effective filing date that is on or after March 16, 2013; or
- AIA's FITF provisions apply to any application or patent that contains, or contained at any time, a specific reference under 35 U.S.C. 120, 121, or 365(c) to an application which contains, or contained at any time, a claimed invention having an effective filing date on or after March 16, 2013



# Applicability of Pre-AIA's Prior Art Provisions

- Pre-AIA 35 U.S.C. 102(g), 135, and 291 apply to any AIA application or patent that contains, or contained at any time, any claimed invention having an effective filing date that occurs before March 16, 2013



# Example 4: AIA's Prior Art Provisions Apply

	<b>Parent application filed before 3/16/2013</b>	<b>Child application filed after 3/16/2013 claiming benefit to Parent</b>
Specification includes	A, B, and C	A, B, C, and <b>D</b>
Claims require	Not relevant	Claim 1: A-C Claim 2: A- <b>D</b>

- Child application is subject to AIA prior art provisions because Claim 2 requires D, which is only supported in an application filed after 3/16/2013
- Child application is also subject to pre-AIA prior art provisions (i.e., former 35 U.S.C. 102(g), 135 and, if patented, 291) because Claim 1 has an effective filing date before 3/16/2013



# Proposed Rule: Affidavits or Declarations

- Proposed 37 C.F.R. 1.130: Applicants may submit affidavits or declarations showing that:
  - disclosure upon which a rejection is based was by the inventor or joint inventor, or by another who obtained the subject matter disclosed directly or indirectly from the inventor or joint inventor; or
  - there was a prior public disclosure of the subject matter by the inventor or joint inventor, or by another who obtained the subject matter disclosed directly or indirectly from the inventor or joint inventor



# Proposed Rule: Certified Copy Requirement

- Proposed rule 1.55(a)(2): Certified copy of any foreign priority application must be filed within the later of:
  - 4 months from the actual filing date; or
  - 16 months from the filing date of the prior foreign application
- Certified copy is needed prior to publication since U.S. patents and U.S. patent application publications have a prior art effect under the AIA's 35 U.S.C. 102(a)(2) as of their earliest effective filing date including foreign priority



# Proposed Rule: Required Statements

- Proposed rules 1.55(a)(4), 1.78(a)(3), and 1.78(c)(2): For nonprovisional applications that are:
  - Filed on or after March 16, 2013; and
  - Claim priority/benefit of a foreign, provisional, or nonprovisional application filed prior to March 16, 2013:
    - Applicant must indicate if the application:
      - contains, or contained at any time, a claim having an effective filing date on or after March 16, 2013; or
      - discloses subject matter not also disclosed in the prior foreign, provisional, or nonprovisional application



# Proposed Rule: Required Statements (cont.)

- Applicant is not required to:
  - identify how many or which claims have an effective filing date on or after March 16, 2013;
  - identify the subject matter not disclosed in the prior application; or
  - make the second statement if the application does not disclose subject matter not also disclosed in a relied upon application filed prior to March 16, 2013



# Proposed Rule: Required Statements Timing

- Proposed rules 1.55(a)(4), 1.78(a)(3), and 1.78(c)(2): Statements must be filed within the later of:
  - 4 months from the actual filing date of the later-filed application;
  - 4 months from the date of entry into the national stage;
  - 16 months from the filing date of the prior-filed application from which benefit or priority is sought; or
  - the date that a first claim having an effective filing date on or after March 16, 2013, is presented in the later-filed application



# Appendix

- **Changes to Implement the First Inventor to File Provisions of the Leahy-Smith America Invents Act, 77 Fed. Reg. 43742 (July 26, 2012)**
- **Examination Guidelines for Implementing the First-Inventor-to-File Provisions of the Leahy-Smith America Invents Act , 77 Fed. Reg. 43759 (July 26, 2012)**





# AMERICA INVENTS ACT

## IMPLEMENTATION

**Questions?**



# AMERICA INVENTS ACT

## IMPLEMENTATION

**Thank You**