

America Invents Act (AIA) Webinar Series

Webinar 1: First-Inventor-to-File Proposed Rules

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KF: Thank you, Lauren. I am happy to be here today to talk to you about the first-inventor-to-file provision under the AIA. As you know, last September 2011, President Obama signed the America Invents Act into law. This law made sweeping changes in the way that our country decides what inventions are entitled to patents. So, today I am going to talk to you both about the proposed rules for implementing the statutory changes and the proposed examination guidelines. We have a number of goals at the office in providing these materials. First off, we need to provide guidance both to our examiners and to you, the public, on the changes that are going to be made in the implementation of the AIA. We need to address the examination issues that are raised by the AIA, and we have to see to it that through our regulations we are provided the information we need to implement the AIA changes and to examine patent applications appropriately under the provisions of the AIA. Now, as I mentioned, we have two documents published currently. These are both in the *Federal Register* published this past July. One is the proposed rules themselves; the other is the proposed examination guidelines. The comment period for both of these ends this Friday, October 5, so I would like to encourage you, if you haven't already, to take some time to take a look at these two documents and provide us with your written comments this week. I think it is perhaps human nature to not say anything if you think everything looks just fine, but rather only to mention it if you have a complaint to make. But I encourage you to provide comments one way or the other. As it's noted on this slide, the effective date of the first-inventor-to-file provision is March 16, 2013, about six months from now. We will talk, as we go through the slides, about the applications to which the changes will apply. Okay, so far all this has been way of introduction; right now I want to give you a brief overview of the rest of the talk.

The first major section of my talk is going to be about the changes to the Prior Art, and this is largely concerned with materials that are addressed in the guidelines. But of course, the guidelines and the rules documents do go hand-in-hand. Then, the second section of my talk we will discuss what law applies, when your case is treated under AIA first-invention-to-file and when, and when it's treated under the free AIA law. The final section of my talk will be a discussion of the proposed rules.

Ok, this slide gives us a framework of the statute as enacted by Congress. Now you will note over there on the left-hand side under the heading Prior Art, there is at the top 102A1, then below it 102a2. These are, under the AIA, the only two provisions that define Prior Art. So that is to say, all art is now to be found under one of these two sections. On the second column you see the heading Exceptions. Each of these Prior Art exceptions, 102A1 and 102A2, has accompanying exceptions, so sometimes something that would appear to be Prior Art under A1, for example, is not actually Prior Art if it qualifies under one of these exceptions. So we will talk about these as we move through the slides.

Okay, first the 102A1 Prior Art. Under 102A1, there are a number of items that qualify as Prior Art. The section of the statute says that if something is patented, described in a printed publication in public use, or on sale or otherwise available to the public before the effective filing date of the claimed invention, then these are what qualifies as Prior Art. So of course, the first thing to note is the temporal focus. Because we have moved to a first-inventor-to-file system rather than a first-to-invent system, we are looking at that effective filing date of the claimed invention to measure the Prior Art against. Now, you'll see some things look familiar here. If you know what current law is so you have patent described in a printed publication, these are things we see in 102a and 102b under the current law, likewise in public use and on sale those are in the current law as well. However, you should notice that the AIA has no in-this-country limitation. There is no geographic limitation for public use or sale. So public use or sale anywhere in the world can be Prior Art under 102A1. It's also good to note what's not included under the current listing of Prior Art under 102A1. There is no provision corresponding to current 102C, Abandonment of the Invention; there is nothing that looks like current 102D, Premature Foreign Patenting. The 102F provision that someone who is not the inventor is not

entitled to a patent is not reflected in the Prior Art section of the AIA, although it is in other sections of the law. Likewise, we don't have a corollary to 102G, Earlier Invention by Another Who Did Not Abandon, Suppress or Conceal. But we will have more to say about that a little later because there will be some a circumstances where 102G will continue to apply. You will also note this new catchall category, Otherwise Available to the Public, so that's a broad category under 102A1. Something can be Prior Art no matter how it has been made available to the public. Now generally speaking, the 102A1 provisions all have something to do with information that is out there and available to the public. That is sort of the common thread that runs through all of the A21 art. However, there is a circumstance where that is not completely clear, and that is the on-sale provision. Under the current law, under the law pre-AIA that is still in effect today, even an applicant's secret sales can be a barring activity if greater than one year before the filing. But there is a question as to whether under the AIA the sales were intended to be only public sales or to encompass both public and nonpublic sales. So, if you take a look at our guidance document, you will see that the Patent Office has not taken a position on this particular question; rather, we identified the question, we put it out there, and we have asked for your input. So we will have to take a position on this by the time we publish our final rules. Incidentally, we are planning to do that mid-February so the final version of the rules will be out there about a month before the provisions go into effect in mid-March.

Ok, so as we mentioned in the earlier framework slide, the 102A1 Prior Art has corresponding 102B2, Exceptions. So, the Exceptions provisions in 102B talk about disclosures. They say that certain disclosures shall not be Prior Art if certain conditions are fulfilled. Now 102B under the AIA uses this word "disclosure," but 102A does not use the same term. However, the position the office has taken is that this term Disclosures in 102B is to be understood as the generic term for all the ways an invention could have been made available to the public under 102A; so Disclosure is generic to patented printed publications, public use on sale, or otherwise available to the public.

So, we will talk about our first exceptions to 102A1 Prior Art. These are provided for in 102B1, so what we have here is a grace period that is provided for five statutes. So the grace period extends one year prior to the effective filing date for a particular invention. There are two kinds

of disclosures that 102B1 identifies as not being Art under A1 if they qualify for this exception. So, we have an inventor disclosure within the grace period; that is, an inventor publicly discloses his invention within that one-year period before his effective U.S. filing date. The second exception that falls under this section is what we are calling a non-inventor disclosure. Once again we are talking about a disclosure within this one-year grace period; but now we are talking about the disclosure by someone who obtained knowledge of the invention from the inventor.

In the next slide, you see in the right-hand column we have Smith's filing; let's assume that's on July 1, 2014. So Smith files July 1, 2014; then he has a grace period that goes back to July 1, 2013. If Smith publishes his claimed invention within that grace period, that publication by Smith is not Prior Art to Smith, even though it otherwise would appear to be Prior Art under 102A1. So, in essence, this is inventor Smith saying this is my own disclosure. Now you note we have the word "publishes" here on the slide. That's intended by way of example; we are not talking just about a printed publication here. It could be on sale, public use, or otherwise available, so any way Smith made his invention available to the public within that one-year grace period will not count against him as Prior Art.

The next slide is an example of the non-inventor disclosure. So once again we have Smith filing, let's say on July 1, 2014; his grace period goes back to July 1, 2013. So in this example we have Taylor, this is someone else who has obtained knowledge of Smith's invention from Smith, who does the publishing. So Taylor has published Smith's invention during this grace period. So, in essence, what would happen here is Smith would tell us at the patent office that Taylor's disclosure within the grace period was of an invention that originated from Smith. Then Taylor's disclosure, which would otherwise have looked like Prior Art, will not be Prior Art to Smith's application because this 102B1a exception applies.

Ok, we have another exception that applies to 102A1 Prior Art. We are calling this the Grace Period Intervening Disclosure Exception. So, you remember that the grace period extends backward from the effective filing date of the application. What we are talking about is two disclosures of the invention that happened within that grace period. So, if you think of Smith's application date and Smith's earlier disclosure of his own invention within that grace period

year—and then intervening between those two dates is another disclosure of the invention by someone else. This is why we are calling it intervening. It's a third-party disclosure in between Smith's effective filing and Smith's disclosure of his own invention. Now, in this situation, that third party is a stranger to the applicant; it's not someone who has received knowledge of the invention from the inventor.

So here is an example. Once again, Smith files, let's say on July 1, 2014; within that grace period year we have two disclosures. We have a disclosure by Smith, followed by a disclosure by Taylor. Remember, in this circumstance, Taylor is a third party, a stranger to Smith, so this is not a circumstance where Taylor has gotten knowledge of the invention from Smith. We call this intervening because there's Taylor's publication intervening Smith's publication and Smith's filing. Because Smith has disclosed his invention within that one-year period before Taylor disclosed the invention that Smith disclosed, the Taylor publication is not Prior Art to Smith. Another way to look at this is that Smith's publication shields Smith's application from Taylor's disclosure.

Ok, so we've talked already about 102A1 Prior Art. We are going to move now to 102A2 Prior Art. We said before that speaking in general under 102A1, Prior Art, was information that was out there and available to the public. 102A2 Prior Art is different. This is what might be categorized as secret Prior Art. This is Prior Art as of its effective filing date. So, for those of you who are familiar with the law as it stands now, the pre-AIA law, this looks a lot like 102E as currently provided; so 102A2 provides that a U.S. patent, a U.S. patent application publication, or the publication of an international application under PPT that designates the U.S. can be Prior Art as of its effective filing date. I've used this term "effective filing date" a couple of times, and it's time I make mention of this because it's another change that has been brought about by the First-Inventor-to-File provisions of the AIA. So a document can be Prior Art under 102A2—either as of its actual filing date for the U.S. patent published application or as of the date to which the patent or published application is entitled to claim a right of priority or a benefit under any of the listed sections at the bottom of your slide of 35 USC. Now, what's important here is that this provision does away with the Hilmer Doctrine. You know the Hilmer Doctrine stems from a case that concluded that an application, a U.S. application, could not be treated as Prior

Art as of its foreign priority date. Well, that's changed here. So if you look at these 35 USCs that are mentioned, Section 119 subsections a through e encompass the foreign priority claim. Also in 119e is the provisional domestic benefits claim (of course, 120 and 121 are domestic benefits claims), 365 is for international applications. So the effective date is changing in that now the foreign priority date is taken into account when determining the effective filing date of one of the three kinds of publications considered here—the U.S. patents, the U.S. patent applications, or publications of PPT applications that designated the U.S. I will point out that foreign patents still are not Prior Art as of their own foreign application date.

Ok, I am going to move fairly quickly through the next couple of slides because they really mirror slides we've already seen. We are talking now about the exceptions that are in 35 USC 102B2 that apply to Prior Art that qualifies under 102A2. So the first couple of these are going to be familiar, so we have here on this slide the non-inventor disclosure exceptions. We are talking here once again about a disclosure made by somebody else who obtains knowledge from the inventor. This provision of this statute provides that such a disclosure is not Prior Art under 102A2 and, similarly, we have the same kind of intervening disclosure exception for A2 Art as A1 Art. In this example, the effective filing date of the reference intervenes the inventor's effective filing date and the inventor's disclosure. Again, these things have to be within one year; they have to be within that one-year grace period. But if the inventor's disclosures within his own one-year grace period and then following that is the effective filing date of a reference that would appear to apply under 102A2, in fact that reference will not be Prior Art to the inventor's prior disclosure within the grace period year. This is an exception to the commonly owned disclosure exception that is called for in 102B2c, and this is an exception that does not have a counterpart in the exceptions in 102E1. Under the commonly owned disclosure exceptions, in a nutshell, what we are talking about is that an inventor's coworker's patent filing can be excluded from the Prior Art. So, if you are familiar with the pre-AIA Section 102C, this is similar. There is a similarity in that there is a limitation on how the Prior Art qualifies. Here, this commonly owned disclosure exception applies only to 102A2 Prior Art, not the A1 Prior Art; so it applies to Prior Art that is being used as of its effective filing date, but it doesn't apply to A1 Prior Art, which is the publicly available Prior Art. That's similar to the pre-AIA law if you recall that the pre-AIA 102C only applies to Prior Art that qualifies under 102E, 102F, or 102G. There is a

difference, though, from the pre-AIA law. Under the pre-AIA law, you could only invoke the commonly owned 102C provision if you were facing an obvious rejection. Here, under the AIA the commonly owned disclosure exception can be applied both to Prior Art being applied for anticipation and to Prior Art being applied for obviousness

Doing Research Agreements

This is not a separate exception under the statute; rather, AIA section 102C says that Joint Research Agreements can be viewed, can be deemed to fall under the common ownership provision that we just discussed (102E2c). So, in order to invoke the research agreement provision of the AIA and have it count under common ownership exception, the claimed invention has to be made by a party to the joint research agreement, it has to have been within the scope of the joint research agreement that was in place on or before the effective filing date, and the application has to be amended to name the parties to the agreement. Just as we said, in a nutshell the common ownership disclosure exception excluded an inventor's coworker's patent filings from Prior Art; the joint research agreement provision can exclude the inventor research collaborators patent filing from Prior Art.

Ok, I have finished the first major section of my talk; I am moving on now to the applicability provisions of the AIA. So what the AIA says, we know that the provisions take effective March 16, 2013. The AIA provides that any application that includes a claim that has an effective filing date on or after March 16, 2013, gets treated under the provision of the AIA. In addition, any application that has in its domestic or international benefit chain any claim that had an effective filing date on or after March 16, 2013, also gets treated under the AIA. You see the second bullet mentions 35 USC 120, 121 and 365C, so it's something in the domestic and international chain. Now you need to also note that the statute says contained or contained at any time a claim with a post-March 16, 2013, effective filing date. What that means is you can't, after March 16, file an application with some claims with the post-March 16 effective filing date and other claims with the pre-March 16 effective filing date, go on prosecuting the invention, the application for a while, and then decide "uh, well, these post-March claims aren't really so important and I think I'll cancel those, then I'll get pre-AIA treatment for my pre-March 16 effective filing date

claim.” No! It doesn’t work that way. The statute says specifically, contained or contained at any time. So since that application did at one time contain post-March 16 effective filing date claims, it will always have First-Inventor-to-File treatment under the AIA and so will any of its trial case. Ok, the corollary here is if there was never at any time an application filed on or after March 16, or in any case in its domestic national benefit chain a claim with a post-March 16 effective filing date, then pre-AIA law applies. So what I have just said is there are certain cases, as long as all the claims ever in them have an effective filing date before March ’13 that will be treated under pre-AIA law, even though they are filed after this coming March 16. One other point to be made about the question of what law applies. This slide is talking about applications that have claims that straddle the line. So, post-March 16 filing with some post-March 16 effective filing date claims and other pre-March 16 effective filing date claims. What the law says is under this circumstance as we just mentioned, indeed the AIA applies; however, this case is also subject to pre-AIA 102G, 135 and 291. So what is that? Basically, it is the Interference Provisions. The Interference Provisions, the First-to-Invent provisions, that are in the pre-AIA law will apply in this circumstance when you’ve got a case that straddles the line. I’ll also point out to you that 102G under the current pre-AIA law has two sections. One, 102G1, is about Interferences; 102G2 is that ex parte provision that talks about previous invention by another who did not abandon suppress and conceal. That provision will continue to apply as well to these cases that straddle the line. Here’s an example: So we will consider a specification that’s filed before the AIA First-Inventor-to-File implementation date of March 16, 2013, and in that specification we have disclosure of a, b, and c. So it’s clear that that application is going to be examined under pre-AIA law; it doesn’t matter what’s in the claims, the content of the claims isn’t relevant to the inquiry of what law applies here because this case was filed before the implementation date of March 16, 2013. Now, from this parent application is filed a child application after March 16, 2013. Now we have added something new to the specification. Now we not only have the disclosure of a, b and c, but we also now have the disclosure of d. As we already said, it’s going to matter what’s claimed when we are considering the question of what law applies. So we will say we have claim 1 that deals with a through c. Remember that claim is going to have a pre-March 16 effective filing date because that’s the invention that was previously disclosed, and we also have claim 2, which is now claiming that part of the invention d was a post-March 16 effective filing date. This is one of those straddle-the-line examples. So

which law applies? Well, the AIA absolutely applies because you are claiming something with a post-March 16 effective filing date. However, because there is also a claim present in the case with the pre-March 16 effective filing date, those interference provisions of the pre-AIA also will apply; and this is a determination made on an application- by-application basis and not on a claim-by-claim basis. So, I'm not saying here that certain law applies to certain claims and others to other claims. No, the AIA Prior Art provisions apply to all claims, and those particular pre-AIA provisions that deal with the interference apply also to all claims.

I'm moving now to the third and last subdivision of my talk, and from here on out I'm going to be talking about items in proposed rules documents. As I mentioned, we have two documents published in the *Federal Register*. One is guidelines, which I've primarily been discussing up till now; the other is the rules document, and that is what we will talk about from here on out. First, this is proposed rule 37 C.F.R. 1.130. So we have talked about those exceptions, we have talked about a disclosure by the applicant within the grace period, we have talked about a disclosure by someone else who got the knowledge of the invention from the applicant, that disclosure is also during the grace period. If you have disclosures like that, this will provide that you can send us an affidavit or declaration telling us about them. So, you can do it sort of preemptively ahead of time before the examiner picks up the case, in which case the examiner has now been made aware of the particular disclosure is not Prior Art and therefore, won't write that rejection, or alternatively, if the examiner does give you a rejection based on a particular disclosure you can then, during the period of prosecution, send an affidavit or declaration indicating that the document that appeared to be Prior Art is actually not Prior Art because one of these exceptions applies.

Next rule we are going to talk about is the rule requiring a certified copy. So we are talking here about a certified copy of any foreign priority application and the timing for this is within the later of four months from the actual filing date of the application or 16 months of the filing date of the prior foreign application. Now why do we need this? Well, as we've already talked about the Hilmer Doctrine being done away with by the First-Inventor-to-File provisions of the AIA, so what that means is a patent application publication in the United States may be Prior Art under new 102A2 as of its foreign priority date. So we want this information so that it's available when

that document publishes, so that an examiner down the road who picks up this document and wants to apply it as Prior Art will apply it as of the appropriate date. So this is our proposal 1.55A2, the Certify Copy Requirement.

We have three different rules for required statements. Now, these statements apply to non-provisional applications filed on or after March 16, 2013, that claim priority or benefit of a provisional, foreign or non-provisional application filed prior to March 16, 2013. So the statement, and I'm going to talk to you in a moment about what is required to be in a statement, but it only applies to those cases that are, let's say, straddling the line. So, what needs to be in the statement? You have to tell us if an application filed after March 16 contained, or contained at any time, a claim with an opposed March 16 effective filing date. That's for claims. You also need to tell us if that application discloses subject matter, even though it's not claimed, that's also disclosed in the earlier Foreign Provisional or Non-Provisional Applications to which priority or benefit is claimed. OK, that's what you are required to put in the statement under these circumstances. Now we've had some concern about the requirements for the statement, so I want to be sure to convey to you about what is not required. This is, in fact, a fairly minimal requirement because we are not asking you to tell us how many claims or which claims have an effective filing date on or after March 16. We're not asking you to identify the particular subject matter that wasn't disclosed in an earlier statement, and you don't need to make the statement if there is no disclosure of subject matter not also disclosed in an earlier application filed prior to March 16, 2013. I like to analogize this to what you do when you decide if you are filing a continuation in part application. So, once again statements are going to be required only in those cases that straddle the line.

This slide is about the timing for these required statements. You have until the later of these time periods listed on the slide. Four months from either the actual filing date of the later filed application or the entry into the national stage; 16 months from the filing date of the prior filed applied application which you are seeking benefit or priority, and the last time point is the date, of course, that you first presented having an effective file date on or after March 16, 2013. Now, once again these rules are still proposed rules; they haven't gone final. We intend to make the rules, to publish the rules in final form by mid-February. You still have until this week on Friday,

that's Friday, October 5, to get us comments. We are earnestly soliciting your comments. We welcome any input you have for us on either the proposed rules or the proposal guidelines. If anybody still needs to know where to find these two documents we've been talking about, here they are on listed on this Appendix slide. The first one listed here is the actual rule change, proposal rules change document. The second one is the proposed examiner guidance; they were both published in the *Federal Register* this past July.

So, I would like to thank you for your attention this morning; and I would be happy to answer any questions.

LP: Thank you so much, Dr. Fonda.

KF: You're welcome.

LP: Now Dr. Fonda will take any questions for the next 15 minutes. We received a number of questions during the session and also from participants in advance, so please feel free to type your questions in the chatter questions box on your webinar menu, and I'll go ahead by starting with one of the ones we received from people in advance.

Questions

Q1: Does the America Invents Act introduce any new categories of Prior Art?

Dr. Fonda Well, under 102A1, as we mentioned, what qualifies there is documents that have been patented, inventions described in a printed publication, public use or on sale, then there is always this catch-all category, the otherwise available to the public category. So, I think it's clear that otherwise available to the public is intended to be a broad category, such that it doesn't matter how the invention became available to the public. So, yes that otherwise available to the public can be seen as a new category of Prior Art.

Q2: Ok, we have some questions coming in now as well. Earlier on you were talking about some case studies, examples someone has asked if International Rights are preserved in those examples

KF: I'm not sure exactly which examples you are referring to. One thing you have to realize when it comes to the First-Inventor-to-File provisions is that there is a grace period that still pertains. So, the AIA has maintained a grace period in the U.S. So when you are dealing with filing in a so-called absolute novelty country, you need to keep that in mind. A disclosure within the grace period year by the applicant may not be Prior Art to that applicant in the U.S. because it falls under the grace period. But it may still preclude a patent in another jurisdiction that has the absolute novelty requirement. We're really advising people that the best way to first disclose the invention is really in a provisional application, especially if you have these foreign filing issues.

Q3: Is a foreign application considered Prior Art as of the publication date or the foreign patent application date?

KF: The foreign application is going to be Prior Art as of when it's public. So 102A2, the so called secret Prior Art provision, only applies to U.S. patents, U.S. patent publication, and publications of international applications that designate the U.S. So a foreign patent document does not apply as Prior Art as of its own filing date. It will apply as Prior Art as of when it is made public. So it could be a publication under 102A1.

Q4: Who has the right to a patent if Taylor and Smith both publish about Smith's invention but Taylor files a patent application before Smith?

KF: OK, I'm not clear when this disclosure has been made.

KF: So Taylor will have a grace period that goes back one year from Taylor's filing. Smith has filed later than Taylor, so Smith's grace period goes back one year from his own filing. The dates of their disclosures are going to be relevant to the answer to that question. I will point out though that some of the commentary has really said, well what's set up here isn't a First Inventor to File so much as it's the First Inventor to Publish, because it is possible, as we saw on the intervening disclosure example slides that I gave you, that Taylor can be the first one to file, but Taylor will not be entitled to that patent because of Smith's prior disclosure.

Q5: AIA Section 102A2 concerns the Prior Art Status as of the effective filing date of a patent issued under section 151 and an Application for Patent published or deemed published under 122B. What does "deemed published" mean?

KF: Deemed published - that phrase "deemed published" really has to do with 35 U.S.C. 122(b), that's about WIPO publications of PCT applications that designate the U.S. and the other section is 35 U.S.C. 374. So it's this deemed published phrase that actually makes WIPO publications – PCT applications designating the U.S. - Prior Art as of their effective filing dates because under 374 the WIPO publication is deemed a publication under 122B. So in other words, we treat that international publication as if it were a publication of a U.S. patent application.

Q6: Should nondisclosure agreements be redrafted to include a provision of not to file?

KF: Well, I have to say that that's not a question that I am qualified to offer a particular opinion on. What I will say again is that even though there are exceptions under the law for disclosures by inventors and by people who have gained knowledge of the inventions by the inventors, there are perhaps pitfalls to such disclosures. So I think you need to think carefully about what the best strategy should be. And, also as I said before, I think the first disclosure, so to speak, really ought to be in a provisional patent application.

Q7: We just received a follow-up to the Taylor-Smith question (Q4) from your example. The follow-up is: If Taylor filed before Smith but Smith published before Taylor and both were within the one-year period, will Smith get the patent or Taylor or neither?

KF: OK, so now we are talking about Smith files and within Smith's own year grace period Smith has disclosed and in between Smith's disclosure and Smith's filing we have a filing by Taylor. Ok, this is the circumstance where Smith's earlier application shields Smith from what would otherwise be Prior Art, Taylor's Prior Art as of Taylor's effective filing date. So Taylor's filing would be 102A2 Prior Art but for Smith's earlier disclosure so, Taylor's filing is not Prior Art to Smith under this circumstance. So Smith is then entitled to the patent rather than Taylor; and this is what I was alluding to when I said some of the commentators have suggested that we don't really have a First Inventor to File system under the AIA, what we really have is the First Inventor to Publish system.

Q8: Since the AIA implements First-Inventor-to-File, will it still be necessary to maintain records concerning inventorship, such as laboratory notebooks?

KF: That is an interesting question, and I think the clear answer is yes, for a couple of reasons. One is as we talked about certain applications, those applications that straddle the line, the pre-AIA interference practice will continue to go on. So, we are not completely finished with interference practice yet, and we won't be for some time. Also, the other reason things like laboratory notebooks will continue to be important is that there may be a need for documentary evidence to establish inventorship in the context of a derivation proceeding in which one inventor is trying to establish that another inventor named in an earlier application derived the invention from the first inventor without authorization. So yes, the need for documentation such as laboratory notebooks isn't going away.

Q9: Does the AIA introduce any changes to 35 USC 103?

KF: That is a good question. The short answer is that evaluating references and inventions with regard to obviousness isn't going to change under the AIA when it comes to things like the applicability KSR decisions. But, of course the temporal focus has changed, so now the temporal focus is on the effective filing date of the application under examination rather than on the date of invention.

There are a couple of other things if anyone is interested. I didn't mention the AIA does eliminate section 103B, so that was the Biotechnological Processes provision of the pre-AIA law. So that's not continued into the AIA. And also, as we mentioned, pre-AIA 103C the Create Act provisions are similar to 102E2c, Exceptions under the AIA.

Q10: Is it possible some claims in an application will be examined under the provisions of the AIA, while other claims in the same application are examined under pre-AIA law?

KF: Well no, that's not possible. As we said, the determination is going to be made on an application-by-application basis. So, it is true that there can be an application which is treated under the AIA and also is subject to pre-AIA provisions concerning interference. That can happen when the application is filed after March 16, 2013, and contains claims with both the post March 16 effective filing date and other claims with a pre-March 16 effective filing date. So, while you can have a circumstance where AIA and some aspect of pre-AIA both apply, that case that would be true of all the claims in the case, and there will never be a circumstance wherein one particular application claims get AIA treatment and other claims get post-AIA treatment.

Q11: Do you think that patent applications close to be ready for filing around the AIA implementation date should be delayed until after it's implemented?

KF: Well, I think that's going to be a decision that filers are going to have to make for themselves. It's sort of, I think it's going to depend on your assessment of your invention; certainly applicants generally have a knowledge of what is going on in the field, so I don't think there is really any one-size-fits-all advice to answer that question. But I do think it's certainly worth considering if you want pre-AIA treatment, if you think for some reason that's going to be beneficial to you, then by all means get that application filed before March 16.

LP: Ok, I think that's all the time we have for today. Thank you so much, Dr. Fonda, for sharing your expertise with us, and thank you to all the attendees who participated today. You will be able to find the webinar recordings online within 24 to 48 hrs. Also, when the webinar ends, please take a moment to answer the survey questions that will appear. We hope you will join us October 15 for the next webinar in the series, when we cover Patent-related Final Rules.