



This document is scheduled to be published in the Federal Register on 07/26/2012 and available online at <http://federalregister.gov/a/2012-17898>, and on FDsys.gov

[3510-16-P]

DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

37 CFR Part 1

[Docket No.: PTO-P-2012-0024]

Examination Guidelines for Implementing the First-Inventor-to-File Provisions of the Leahy-Smith America Invents Act

AGENCY: United States Patent and Trademark Office, Commerce.

ACTION: Request for comments.

SUMMARY: The United States Patent and Trademark Office (Office) is publishing proposed examination guidelines concerning the first-inventor-to-file (FITF) provisions of the Leahy-Smith America Invents Act (AIA). The AIA amends the patent laws pertaining to the conditions of patentability to convert the United States patent system from a “first to invent” system to a “first inventor to file” system, treats United States patents and United States patent application publications as prior art as of their earliest effective United States, foreign, or international filing date, eliminates the requirement that a prior public use or sale activity be “in this country” to be a prior art activity, and treats commonly owned or joint research agreement patents and patent application publications as being by the same inventive entity for purposes of novelty, as well as

nonobviousness. The changes to the conditions of patentability in the AIA result in greater transparency, objectivity, predictability, and simplicity in patentability determinations. These guidelines will assist Office personnel in, and inform the public of how the Office is, implementing the FITF provisions of the AIA. The Office is concurrently proposing in a separate action (RIN 0651-AC77) published elsewhere in this issue of the Federal Register to amend the rules of practice in patent cases to implement the FITF provisions of the AIA.

DATES: Written comments must be received on or before October 5, 2012.

ADDRESSES: Comments should be sent by electronic mail message over the Internet addressed to: fitf_guidance@uspto.gov. Comments may also be submitted by mail addressed to: Mail Stop Comments – Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, marked to the attention of Mary C. Till, Senior Legal Advisor, Office of Patent Legal Administration, Office of the Deputy Commissioner for Patent Examination Policy.

Comments may also be sent by electronic mail message over the Internet via the Federal eRulemaking Portal, <http://www.regulations.gov>.

Although comments may be submitted by postal mail, the Office prefers to receive comments by electronic mail message over the Internet in order to facilitate posting on the Office's Internet Web site. Plain text is preferred, but comments may also be submitted in ADOBE® portable document format or MICROSOFT WORD® format. Comments not submitted electronically should be submitted on paper, and will be digitally scanned into ADOBE® portable document format.

The comments will be available for public inspection at the Office of the Commissioner for Patents, currently located at Madison Building East, Tenth Floor, 600 Dulany Street, Alexandria, Virginia. Comments also will be available for viewing via the Office's Internet Web site (<http://www.uspto.gov>). Because comments will be made available for public inspection, information that the submitter does not desire to be made public, such as an address or phone number, should not be included in the comments.

FOR FURTHER INFORMATION CONTACT: Mary C. Till, Senior Legal Advisor (telephone (571) 272-7755; e-mail mary.till@uspto.gov) or Kathleen Kahler Fonda, Senior Legal Advisor (telephone (571) 272-7754; e-mail kathleen.fonda@uspto.gov), of the Office of the Deputy Commissioner for Patent Examination Policy. Alternatively, mail may be addressed to Ms. Till or Ms. Fonda at Commissioner for Patents, attn: FITF, P.O. Box 1450, Alexandria, VA, 22313-1450.

SUPPLEMENTARY INFORMATION: The AIA¹ was enacted into law on September 16, 2011. Section 3 of the AIA amends the patent laws to: (1) convert the United States

patent system from a “first to invent” system to a “first inventor to file” system; (2) eliminate the requirement that a prior public use or sale activity be “in this country” to be a prior art activity; (3) treat U.S. patents and U.S. patent application publications as prior art as of their earliest effective filing date, regardless of whether the earliest effective filing date is based upon an application filed in the U.S. or in another country; and (4) treat commonly owned patents and patent application publications, or those resulting from a joint research agreement, as being by the same inventive entity for purposes of 35 U.S.C. 102 and 103. The changes in section 3 of the AIA take effect on March 16, 2013.

These proposed guidelines do not constitute substantive rulemaking and do not have the force and effect of law. The proposed guidelines set out the Office’s interpretation of 35 U.S.C. 102 and 103 as amended by the AIA, and advise the public and the Patent Examining Corps on how the changes to 35 U.S.C. 102 and 103 in the AIA impact the provisions of the Manual of Patent Examining Procedure (MPEP) pertaining to 35 U.S.C. 102 and 103. The guidelines have been developed as a matter of internal Office management and are not intended to create any right or benefit, substantive or procedural, enforceable by any party against the Office. Rejections will continue to be based upon the substantive law, and it is these rejections that are appealable. Failure of Office personnel to follow the guidelines is not, in itself, a proper basis for either an appeal or a petition.

Overview of the Changes to 35 U.S.C. 102 and 103 in the AIA: The AIA replaces pre-AIA 35 U.S.C. 102 with provisions that: (1) a person is not entitled to a patent if the claimed invention was patented, described in a printed publication, or in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention (35 U.S.C. 102(a)(1)); and (2) a person is not entitled to a patent if the claimed invention was described in a patent issued under 35 U.S.C. 151, or in an application for patent published or deemed published under 35 U.S.C. 122(b), in which the patent or application, as the case may be, names another inventor, and was effectively filed before the effective filing date of the claimed invention (35 U.S.C. 102(a)(2)). In 35 U.S.C. 100(j), the AIA defines the term “claimed invention” as the subject matter defined by a claim in a patent or an application for a patent. The AIA defines the term “effective filing date” for a claimed invention in a patent or application for patent (other than a reissue application or reissued patent) in 35 U.S.C. 100(i)(1) as meaning the earliest of: (1) the actual filing date of the patent or the application for the patent containing a claim to the claimed invention (claimed invention); or (2) the filing date of the earliest provisional, nonprovisional, international (PCT), or foreign patent application to which the patent or application is entitled to benefit or priority as to such claimed invention. Under pre-AIA 35 U.S.C. 102(a) and (b), knowledge or use of the invention (pre-AIA 35 U.S.C. 102(a)), or public use or sale of the invention (pre-AIA 35 U.S.C. 102(b)), was required to be in the United States to qualify as a prior art activity. Under the AIA, a prior public use, sale activity, or other disclosure has no geographic requirement (i.e., need not be in the United States) to qualify as prior art.

The “first inventor to file” provisions of the AIA eliminate the provisions in pre-AIA 35 U.S.C. 102(c) (abandonment of the invention), 102(d) (premature foreign patenting), 102(f) (derivation), and 102(g) (prior invention by another). Under AIA 35 U.S.C. 102, abandonment of the invention or premature foreign patenting is not relevant to patentability. Prior invention by another is not relevant to patentability unless there is a prior disclosure or filing of an application by another. The situation in which an application names a person who is not the actual inventor as the inventor (pre-AIA 35 U.S.C. 102(f)) will be handled in a derivation proceeding under 35 U.S.C. 135, by a correction of inventorship under 37 CFR 1.48 to name the actual inventor, or under 35 U.S.C. 101.²

The AIA provides in 35 U.S.C. 102(b)(1) that a disclosure made one year or less before the effective filing date of a claimed invention shall not be prior art under 35 U.S.C. 102(a)(1) with respect to the claimed invention if: (1) the disclosure was made by the inventor or joint inventor or by another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor; or (2) the subject matter disclosed had, before such disclosure, been publicly disclosed by the inventor or a joint inventor or by another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor. Thus, AIA 35 U.S.C. 102(b)(1) provides a one-year grace period after a first disclosure of an invention within which to file a patent application. Specifically, AIA 35 U.S.C. 102(b)(1) permits an applicant to disqualify a disclosure of the invention made not more than one year before the effective filing date of the claimed invention that would otherwise be prior art if: (1) the disclosure to be disqualified was by an inventor

or by a party who obtained the disclosed subject matter from an inventor; or (2) an inventor or a party who obtained the disclosed subject matter from an inventor had publicly disclosed the subject matter before the date of the reference disclosure to be disqualified. The one-year grace period in AIA 35 U.S.C. 102(b)(1) is measured from the earliest U.S. or foreign patent application to which the patent or application is entitled to benefit or priority as to such invention, whereas the one-year grace period in pre-AIA 35 U.S.C. 102(b) is measured from only the earliest application filed in the United States.

AIA 35 U.S.C. 100(f) defines the term “inventor” as the individual or if a joint invention, the individuals collectively who invented or discovered the subject matter of the invention. AIA 35 U.S.C. 100(g) AIA defines the term “joint inventor” and “co-inventor” to mean any one of the individuals who invented or discovered the subject matter of a joint invention.

The date of invention is not relevant under AIA 35 U.S.C. 102. Thus, a prior art disclosure could not be disqualified or antedated by showing that the inventor invented the claimed invention prior to the effective date of the prior art disclosure of the subject matter (e.g., under the provisions of 37 CFR 1.131).

In accordance with 35 U.S.C. 102(a)(2) of the AIA, a person is not entitled to a patent if the claimed invention was described in a U.S. patent or a U.S. patent application publication that names another inventor and was effectively filed before the effective filing date of the claimed invention. Under 35 U.S.C. 374, a World Intellectual Property

Organization (WIPO) publication of a Patent Cooperation Treaty (PCT) international application that designates the United States is deemed a U.S. patent application publication for purposes of AIA 35 U.S.C. 102(a)(2). Thus, under the AIA, WIPO publications of PCT applications that designate the United States are treated in the same way as U.S. patent application publications for prior art purposes, regardless of the international filing date or whether they are published in English. Accordingly, a U.S. patent, a U.S. patent application publication, or a WIPO publication of a PCT application that designates the United States (WIPO published application), that names another inventor and was effectively filed before the effective filing date of the claimed invention, is prior art under 35 U.S.C. 102(a)(2). Compare with treatment under pre-AIA 35 U.S.C. 102(e), where a WIPO publication of a PCT application designating the United States is treated as a U.S. patent application publication under pre-AIA 35 U.S.C. 102(e) only if the PCT application was filed on or after November 29, 2000, and published under PCT Article 21(2) in the English language.³

In 35 U.S.C. 102(d), the AIA defines “effectively filed” for the purpose of determining whether a U.S. patent, U.S. patent application publication, or WIPO published application is prior art under 35 U.S.C. 102(a)(2) to a claimed invention. A U.S. patent, U.S. patent application publication, or WIPO published application is considered to have been effectively filed for purposes of its prior art effect under 35 U.S.C. 102(a)(2) with respect to any subject matter it describes on the earlier of: (1) the actual filing date of the patent or the application for patent; or (2) if the patent or application for patent is entitled to claim the benefit or priority of the filing date of an earlier U.S. provisional, U.S.

nonprovisional, international (PCT), or foreign patent application, the filing date of the earliest such application that describes the subject matter of the claimed invention. Thus, if the subject matter relied upon is described in the earliest claimed benefit or priority application, a U.S. patent, a U.S. patent application publication or WIPO published application is effective as prior art as of its earliest benefit or priority date, rather than only as of its earliest United States benefit date.

The AIA provides in 35 U.S.C. 102(b)(2)(A) and (B) that a disclosure shall not be prior art to a claimed invention under 35 U.S.C. 102(a)(2) if: (1) the subject matter disclosed was obtained directly or indirectly from the inventor or a joint inventor; or (2) the subject matter disclosed had, before such subject matter was effectively filed under 35 U.S.C. 102(a)(2), been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor. Thus, under the AIA, a U.S. patent, U.S. patent application publication, or WIPO published application that was not issued or published more than one year before the effective filing date of the claimed invention is not prior art to the claimed invention if: (1) the U.S. patent, U.S. patent application publication, or WIPO published application was by a party who obtained the disclosed subject matter from an inventor; or (2) an inventor, or a party who obtained the disclosed subject matter from an inventor, had disclosed the subject matter before the effective filing date of the U.S. patent, U.S. patent application publication, or WIPO published application.

The AIA provides in 35 U.S.C. 102(b)(2)(C) that a disclosure made in a U.S. patent, U.S. patent application publication, or WIPO published application shall not be prior art to a claimed invention under 35 U.S.C. 102(a)(2) if, not later than the effective filing date of the claimed invention, the subject matter disclosed and the claimed invention were owned by the same person or subject to an obligation of assignment to the same person. This provision replaces the exception in pre-AIA 35 U.S.C. 103(c) that applied only in the context of 35 U.S.C. 103 to prior art that was commonly owned at the time the claimed invention was made, and which qualifies as prior art only under pre-AIA 35 U.S.C. 102(e), (f), or (g). AIA 35 U.S.C. 102(b)(2)(C) provides an exception to prior art that qualifies only under 35 U.S.C. 102(a)(2) but that applies in the context of anticipation or obviousness to prior art that was commonly owned not later than the effective filing date of the claimed invention.

Thus, the AIA provides that certain prior patents and patent applications of co-workers and collaborators are not prior art either for purposes of determining novelty (35 U.S.C. 102) or nonobviousness (35 U.S.C. 103). This exception, however, applies only to AIA 35 U.S.C. 102(a)(2) type of prior art: namely, U.S. patents, U.S. patent application publications, or WIPO published applications effectively filed, but not published, before the effective filing date of the claimed invention. This exception does not apply to prior art that is available under 35 U.S.C. 102(a)(1), that is, patents, printed publications, public uses, sale activities, or other publicly available disclosures published or occurring before the effective filing date of the claimed invention. A prior disclosure, as defined in 35 U.S.C. 102(a)(1), by a co-worker or collaborator is prior art under 35 U.S.C. 102(a)(1)

unless it falls within an exception under 35 U.S.C. 102(b)(1), regardless of whether the subject matter of the prior disclosure and the claimed invention were commonly owned not later than the effective filing date of the claimed invention.

The AIA provides in 35 U.S.C. 102(c) for common ownership of subject matter under joint research agreements. Under 35 U.S.C. 100(h), the term “joint research agreement” is defined as a written contract, grant, or cooperative agreement entered into by two or more persons or entities for the performance of experimental, developmental, or research work in the field of the claimed invention. The AIA 35 U.S.C. 102(c) specifically provides that subject matter disclosed and a claimed invention shall be deemed to have been owned by the same person or subject to an obligation of assignment to the same person in applying the provisions of AIA 35 U.S.C. 102(b)(2)(C) if: (1) the subject matter disclosed was developed and the claimed invention was made by, or on behalf of, one or more parties to a joint research agreement that was in effect on or before the effective filing date of the claimed invention; (2) the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement; and (3) the application for patent for the claimed invention discloses or is amended to disclose the names of the parties to the joint research agreement.

The AIA provides in 35 U.S.C. 103 that a patent for a claimed invention may not be obtained, notwithstanding that the claimed invention is not identically disclosed as set forth in 35 U.S.C. 102, if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the

effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains. 35 U.S.C. 103 also provides that patentability shall not be negated by the manner in which the invention was made. This provision tracks pre-AIA 35 U.S.C. 103(a), except that the temporal focus for the obviousness inquiry is before the effective filing date of the claimed invention, rather than at the time of the invention. The provisions of pre-AIA 35 U.S.C. 103(c) have been replaced with 35 U.S.C. 102(b)(2)(C) and (c), and the provisions of pre-AIA 35 U.S.C. 103(b) pertaining to biotechnological processes have been eliminated.

The AIA 35 U.S.C. 102 and 103 take effect on March 16, 2013. These new provisions apply to any patent application that contains or contained at any time: (1) a claimed invention that has an effective filing date that is on or after March 16, 2013; or (2) a designation as a continuation, divisional, or continuation-in-part of an application that contains or contained at any time a claimed invention that has an effective filing date that is on or after March 16, 2013.⁴ The AIA 35 U.S.C. 102 and 103 also apply to any patent resulting from an application to which the AIA 35 U.S.C. 102 and 103 applied.⁵

The AIA provides that the provisions of pre-AIA 35 U.S.C. 102(g)⁶ apply to each claim of an application for patent if the patent application: (1) contains or contained at any time a claimed invention having an effective filing date that occurs before March 16, 2013; or (2) is ever designated as a continuation, divisional, or continuation-in-part of an application that contains or contained at any time a claimed invention that has an

effective filing date before March 16, 2013.⁷ Pre-AIA 35 U.S.C. 102(g) also applies to any patent resulting from an application to which pre-AIA 35 U.S.C. 102(g) applied.⁸

Thus, if an application (1) contains or contained at any time any claimed invention having an effective filing date that is before March 16, 2013, or ever claimed a right of priority or the benefit of an earlier filing date under 35 U.S.C. 119, 120, 121, or 365 based upon an earlier application ever containing a claimed invention having an effective filing date that is before March 16, 2013, and (2) also contains or contained at any time any claimed invention having an effective filing date that is on or after March 16, 2013, or ever claimed a right of priority or the benefit of an earlier filing date under 35 U.S.C. 119, 120, 121, or 365 based upon an earlier application ever containing a claimed invention having an effective filing date that is on or after March 16, 2013, then AIA 35 U.S.C. 102 and 103 apply to the application, but each claimed invention is also subject to pre-AIA 35 U.S.C. 102(g).

I. Detailed Discussion of AIA 35 U.S.C. 102(a) and (b): The AIA defines in 35 U.S.C. 102(a) the prior art that will preclude the grant of a patent on a claimed invention unless an exception in 35 U.S.C. 102(b) is applicable. 35 U.S.C. 102(a) specifically provides that “a person shall be entitled to a patent unless —

(1) the claimed invention was patented, described in a printed publication, or in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention; or

(2) the claimed invention was described in a patent issued under section 151, or in an application for patent published or deemed published under section 122(b), in which the patent or application, as the case may be, names another inventor and was effectively filed before the effective filing date of the claimed invention.”⁹

As an initial matter, Office personnel should note that the introductory phrase “[a] person shall be entitled to a patent unless” remains unchanged from the pre-AIA version of 35 U.S.C. 102. Thus, 35 U.S.C. 102 continues to provide that the Office bears the initial burden of explaining why the applicable statutory or regulatory requirements have not been met if a claim in an application is to be rejected. The AIA also does not change the requirement that in rejecting any claim of an application, the Office must establish a prima facie case of unpatentability.

The categories of prior art documents and events are set forth in the AIA’s 35 U.S.C. 102(a)(1) and (a)(2) and serve to qualify prior art activities for purposes of determining whether a claimed invention is novel or non-obvious. The documents upon which a prior art rejection may be based are an issued patent, a published application, and a non-patent printed publication. Evidence that the claimed invention was in public use, on sale, or otherwise available to the public may also be used as the basis for a prior art rejection. Note that a printed publication that does not have a sufficiently early publication date to itself qualify as prior art under 35 U.S.C. 102(a)(1) may still be competent evidence of a previous public use, offer for sale, or other availability of a claimed invention that does have a sufficiently early date to qualify as prior art under 35 U.S.C. 102(a)(1).¹⁰

The AIA in 35 U.S.C. 102(b) sets out exceptions to 35 U.S.C. 102(a), in that prior art that otherwise would be included in 35 U.S.C. 102(a) shall not be prior art if it falls within an exception in 35 U.S.C. 102(b).

35 U.S.C. 102(b)(1) provides exceptions to the categories of prior art defined in 35 U.S.C. 102(a)(1). 35 U.S.C. 102(b)(1) specifically states that a disclosure made one year or less before the effective filing date of a claimed invention shall not be prior art to the claimed invention under subsection (a)(1) if —

- The disclosure was made by the inventor or joint inventor or by another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor; or
- The subject matter disclosed had, before such disclosure, been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor.”¹¹

35 U.S.C. 102(b)(2) provides exceptions to the categories of prior art defined in 35 U.S.C. 102(a)(2). 35 U.S.C. 102(b)(2) specifically states that a disclosure shall not be prior art to a claimed invention under subsection (a)(2) if —

- The subject matter disclosed was obtained directly or indirectly from the inventor or a joint inventor;
- The subject matter disclosed had, before such subject matter was effectively filed under subsection (a)(2), been publicly disclosed by the inventor or a joint inventor

or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor; or

- The subject matter disclosed and the claimed invention, not later than the effective filing date of the claimed invention, were owned by the same person or subject to an obligation of assignment to the same person.”¹²

Although some of the prior art provisions of AIA 35 U.S.C. 102(a) and (b) will seem familiar, especially in comparison to pre-AIA 35 U.S.C. 102(a), (b), and (e), the AIA has introduced a number of important changes with respect to prior art documents and activities (disclosures). First, the availability of a disclosure as prior art is measured from the effective filing date of the claimed invention no matter where that filing occurred. Second, the AIA adopts a global view of prior art disclosures and thus does not require that a public use or sale activity be “in this country” to be a prior art activity. Finally, a catch-all “otherwise available to the public” category of prior art is added.

Effective filing date: Pre-AIA 35 U.S.C. 102(a) and (e) reference patent-defeating activities occurring before the applicant invented the claimed invention. AIA 35 U.S.C. 102(a)(1) and (a)(2) make no mention of the date of the invention, but instead concern documents that existed or events that happened “before the effective filing date of the claimed invention.” As a result, it is no longer possible to antedate or “swear behind” certain prior art disclosures by making a showing under 37 CFR 1.131 that the applicant invented the claimed subject matter prior to the effective date of the prior art disclosure.

The AIA defines the term “effective filing date” for a claimed invention in a patent or application for patent (other than a reissue application or reissued patent) as the earlier of: (1) the actual filing date of the patent or the application for the patent containing the claimed invention; or (2) the filing date of the earliest application for which the patent or application is entitled, as to such invention, to a right of priority or the benefit of an earlier filing date under 35 U.S.C. 119, 120, 121, or 365.¹³ Thus, the one-year grace period in AIA 35 U.S.C. 102(b)(1) is measured from any earlier foreign patent application to which the patent or application is entitled to benefit or priority as to such invention, whereas the one-year grace period in pre-AIA 35 U.S.C. 102(b) is measured from only the earliest application filed in the United States.

As under pre-AIA law, the effective filing date of a claimed invention is determined on a claim-by-claim basis and not an application-by-application basis. That is, the principle that different claims in the same application may be entitled to different effective filing dates vis-à-vis the prior art remains unchanged by the AIA. See MPEP § 706.02(VI) (8th ed. 2001) (Rev. 8, July 2010).

Finally, the AIA provides that the “effective filing date” for a claimed invention in a reissue patent or application for a reissue patent shall be determined by deeming the claim to the claimed invention to have been contained in the patent for which reissue was sought.¹⁴

The meaning of “disclosure”: The AIA does not define the term “disclosure.” In addition, while 35 U.S.C. 102(a) does not use the term “disclosure,” 35 U.S.C. 102(b)(1) and (b)(2) each state conditions under which a “disclosure” that otherwise falls within 35 U.S.C. 102(a)(1) or 102(a)(2) is not prior art under 35 U.S.C. 102(a)(1) or 102(a)(2).¹⁵ Thus, the Office is treating the term “disclosure” as a generic expression intended to encompass the documents and activities enumerated in 35 U.S.C. 102(a) (i.e., being patented, described in a printed publication, in public use, on sale, or otherwise available to the public, or being described in a U.S. patent, U.S. patent application publication, or WIPO published application).

A. Prior Art under AIA 35 U.S.C. 102(a)(1): 35 U.S.C. 102(a)(1) sets forth prior documents and activities which may preclude patentability. Such documents and activities include prior patenting of the claimed invention, descriptions of the claimed invention in a printed publication, public use of the claimed invention, placing the claimed invention on sale, and otherwise making the claimed invention available to the public.

Patented: AIA 35 U.S.C. 102(a)(1) indicates that prior patenting of a claimed invention precludes the grant of a patent on the claimed invention. This means that if a claimed invention was patented in this or a foreign country before the effective filing date of the claimed invention, 35 U.S.C. 102(a)(1) precludes the grant of a patent on the claimed invention. The effective date of the patent for purposes of prior art is the grant date of the patent for determining whether the patent qualified as prior art under 35 U.S.C. 102(a)(1).

There is an exception to this rule if the patent is secret as of the date the rights are awarded.¹⁶ In such situations, the patent is available as prior art as of the date the patent was made available to the public by being laid open for public inspection or disseminated in printed form.¹⁷ The phrase “patented” in AIA 35 U.S.C. 102(a)(1) has the same meaning as “patented” in pre-AIA 35 U.S.C. 102(a) and (b). For a discussion of “patented” as used in pre-AIA 35 U.S.C. 102(a) and (b), see generally MPEP § 2126.

Although an invention may be described in a patent and not claimed therein, the grant date or publication date of the published application would also be the applicable prior art date for purposes of relying on the subject matter disclosed therein as “described in a printed publication,” provided that the patent was made available to the public on its grant date. It is helpful to note that a U.S. patent that issues after the effective filing date of the claimed invention is not available as prior art under 35 U.S.C. 102(a)(1), but could be available as prior art under 35 U.S.C. 102(a)(2).

Described in a printed publication: If a claimed invention is described in a patent, published patent application, or printed publication, such a document may be prior art under 35 U.S.C. 102(a)(1) or (a)(2). Both pre-AIA 35 U.S.C. 102(a) and (b) and AIA 35 U.S.C. 102(a)(1) use the term “described” with respect to an invention in a prior art printed publication. Likewise, AIA 35 U.S.C. 102(a)(2) uses that term with respect to U.S. patents, U.S. patent application publications, and WIPO published applications. Thus, the Office does not view the AIA as changing the description requirement for a prior art document to anticipate a claimed invention under 35 U.S.C. 102.

While the conditions for patentability of AIA 35 U.S.C. 112(a) require a written description of the claimed invention that would have enabled a person skilled in the art to make as well as use the invention, the prior art provisions of 35 U.S.C. 102(a)(1) and (a)(2) require only that the claimed invention be “described.”¹⁸ The two basic requirements that must be met by a prior art disclosure in order to describe a claimed invention under AIA 35 U.S.C. 102 are the same as those under pre-AIA 35 U.S.C. 102. First, “each and every element of the claimed invention” must be disclosed either explicitly or inherently, and the elements must be “arranged or combined in the same way as in the claim.”¹⁹ Second, a person of ordinary skill in the art must have been enabled to make the invention without undue experimentation.²⁰ Thus, in order for a prior art disclosure to describe a claimed invention under 35 U.S.C. 102(a), it must disclose all elements of the claimed invention arranged as they are in the claim, and also provide sufficient guidance to enable a person skilled in the art to make the claimed invention. There is, however, no requirement that a document meet the “how to use” requirement of 35 U.S.C. 112(a) in order to qualify as prior art.²¹ Furthermore, compliance with the “how to make” requirement is judged from the viewpoint of a person of ordinary skill in the art, and thus does not require that the document explicitly disclose information within the knowledge of such a person.²²

There is an additional important distinction between the written description that is necessary to support a claim under 35 U.S.C. 112(a) and the description sufficient to anticipate the subject matter of the claim under 35 U.S.C. 102.²³ To provide support for a

claim under 35 U.S.C. 112(a), it is necessary that the specification describe and enable the entire scope of the claimed invention. However, in order for a prior art disclosure to describe a claimed invention under 35 U.S.C. 102(a)(1) or (a)(2), a prior art document need only describe and enable one skilled in the art to make a single species or embodiment of the claimed invention.²⁴ This is consistent with pre-AIA case law.

In public use: The pre-AIA case law indicates that a public use will bar patentability if the public use occurs before the critical date²⁵ and the invention is ready for patenting.²⁶ Under the pre-AIA case law, the inquiry was whether the use was: (1) accessible to the public; and (2) commercially exploited. The phrase “in public use” in AIA 35 U.S.C. 102(a)(1) is treated as having the same meaning as “in public use” in pre-AIA 35 U.S.C. 102(b). For a discussion of “in public use” in pre-AIA 35 U.S.C. 102(b), see generally MPEP § 2133.03(a) et seq.

Additionally, under pre-AIA 35 U.S.C. 102(b), that an invention was “in public use” precluded a patent only if such public use occurred “in this country.”²⁷ Under AIA 35 U.S.C. 102(a)(1), there is no geographic limitation on the location where a prior public use or public availability may occur. Furthermore, a public use would need to occur before the effective filing date of the claimed invention to constitute prior art under AIA 35 U.S.C. 102(a)(1). When formulating a rejection, Office personnel should consider evidence of public use or other public availability regardless of where the public use or other public availability took place.

On sale: The pre-AIA case law regarding on sale activity indicates that a sale will bar patentability of the invention if the sale of the claimed invention was: (1) the subject of a commercial offer for sale, not primarily for experimental purposes; and (2) ready for patenting.²⁸ With respect to a sale, contract law principles apply in order to determine whether a commercial offer for sale occurred. The phrase “on sale” in AIA 35 U.S.C. 102(a)(1) is treated as having the same meaning as “on sale” in pre-AIA 35 U.S.C. 102(b), except as discussed in this guidance. For a discussion of “on sale” as used in pre-AIA 35 U.S.C. 102(b), see generally MPEP § 2133.03(b) et seq.

Under pre-AIA 35 U.S.C. 102(b), if an invention was “on sale” patentability was precluded only if the invention was on sale “in this country.” Under AIA 35 U.S.C. 102(a)(1), there is no geographic limitation on the location where the sale may occur. When formulating a rejection, Office personnel should consider evidence of sales activity of the claimed invention, regardless of where the sale took place.

The language of AIA 35 U.S.C. 102(a)(1) does not expressly state whether a sale must be “sufficiently” public to preclude the grant of a patent on the claimed invention.²⁹ The Office is seeking the benefit of public comment on this provision prior to issuing its interpretation of the AIA 35 U.S.C. 102(a)(1) “on sale” provision and is not setting out an initial position in this guidance to avoid having an influence on the comments.

Specifically, the Office is seeking comment on the extent to which public availability plays a role in “on sale” prior art defined in 35 U.S.C. 102(a)(1).

Otherwise available prior art: The AIA in 35 U.S.C. 102(a)(1) provides a “catch-all” provision, which defines a new additional category of potential prior art not provided for in pre-AIA 35 U.S.C. 102. Specifically, a claimed invention may not be patented if it was “otherwise available to the public” before its effective filing date. This “catch-all” provision permits decision makers to focus on whether the disclosure was “available to the public,” rather than on the means by which the claimed invention became available to the public or on whether a disclosure constitutes a “printed publication” or falls within another category of prior art as defined in 35 U.S.C. 102(a)(1). The availability of the subject matter to the public may arise in situations such as a student thesis in a university library,³⁰ a poster display or other information disseminated at a scientific meeting,³¹ subject matter in a laid-open patent application,³² a document electronically posted on the Internet,³³ or a commercial transaction that does not constitute a sale under the Uniform Commercial Code.³⁴ Even if a document or other disclosure is not a printed publication, or a transaction is not a sale, either may be prior art under the “otherwise available” provision of 35 U.S.C. 102(a)(1), provided that the claimed invention is made sufficiently available to the public.

No requirement of “by others”: A key difference between pre-AIA 35 U.S.C. 102(a) and AIA 35 U.S.C. 102(a)(1) is the requirement in pre-AIA 35 U.S.C. 102(a) that the prior art relied on was “by others.” Under 35 U.S.C. 102(a)(1), there is no requirement that the prior art relied upon be by others. Thus, any prior art which falls under 35 U.S.C. 102(a)(1) need not be by another to constitute potentially available prior art. However, disclosures of the subject matter made one year or less before the effective filing date of

the claimed invention by the inventor or a joint inventor or another who obtained the subject matter directly or indirectly from the inventor or a joint inventor may fall within an exception under 35 U.S.C. 102(b)(1) to 35 U.S.C. 102(a)(1).

Admissions: The Office will continue to treat admissions by the applicant as prior art under the AIA. A statement by an applicant in the specification or made during prosecution identifying the work of another as "prior art" is an admission which can be relied upon for both anticipation and obviousness determinations, regardless of whether the admitted prior art would otherwise qualify as prior art under the statutory categories of 35 U.S.C. 102.³⁵ See generally MPEP § 2129.

1. Prior art exception under 35 U.S.C. 102(b)(1)(A) to 35 U.S.C. 102(a)(1): The AIA in 35 U.S.C. 102(b)(1)(A) provides exceptions to the prior art provisions of 35 U.S.C. 102(a)(1). These exceptions limit the use of an inventor's own work as prior art, when the inventor has publicly disclosed the work either directly or indirectly. The provisions of 35 U.S.C. 102(b)(1)(A) indicate that a disclosure which would otherwise qualify as prior art under 35 U.S.C. 102(a)(1) is not prior art if the disclosure was made: (1) one year or less before the effective filing date of the claimed invention; and (2) by the inventor or a joint inventor, or by another who obtained the subject matter directly or indirectly from the inventor or joint inventor. These guidelines will first discuss issues pertaining to disclosures within the grace period by the inventor or a joint inventor ("grace period inventor disclosure") and then subsequently discuss issues pertaining to disclosures within the grace period by another who obtained the subject matter directly or

indirectly from the inventor or joint inventor (“grace period non-inventor inventor disclosure”).

Grace period inventor disclosure: 35 U.S.C. 102(b)(1)(A) first provides that a disclosure which would otherwise qualify as prior art under 35 U.S.C. 102(a)(1) is not prior art if: (1) the disclosure is made one year or less before the effective filing date of the claimed invention; and (2) was made by the inventor or a joint inventor. Thus, a disclosure that would otherwise qualify as prior art under 35 U.S.C. 102(a)(1) shall not be prior art if the disclosure is made one year or less before the effective filing date of the claimed invention, and the written record of the patent application shows that the disclosure is by the inventor or a joint inventor. What is necessary to show that the disclosure is by the inventor or a joint inventor requires case-by-case treatment, depending upon whether it is apparent from the disclosure or the patent application specification that the disclosure is by the inventor or a joint inventor.

An examiner would not apply prior art that falls under 35 U.S.C. 102(a)(1) if it is apparent from the disclosure that it is by the inventor or a joint inventor. Specifically, the examiner would not apply a prior art disclosure that falls under 35 U.S.C. 102(a)(1) if the disclosure: (1) was made one year or less before the effective filing date of the claimed invention; (2) names the inventor or a joint inventor as an author or an inventor; and (3) does not name additional persons as authors on a printed publication or inventors on a

patent. This means that in circumstances where an application names additional persons as inventors relative to the persons named as authors in the publication (e.g., the application names as inventors A, B, and C, and the publication names as authors A and B), and the publication is one year or less before the effective filing date, it is apparent that the disclosure is a grace period inventor disclosure, and the publication would not be treated as prior art under 35 U.S.C. 102(a)(1). If, however, the application names fewer inventors than a publication (e.g., the application names as inventors A and B, and the publication names as authors A, B and C), it would not be readily apparent from the publication that it is by the inventor or a joint inventor and the publication would be treated as prior art under 35 U.S.C. 102(a)(1).

In certain circumstances, an examiner would not apply prior art that falls under 35 U.S.C. 102(a)(1) if it is apparent from the patent application specification that the disclosure is by the inventor or a joint inventor. The Office is concurrently proposing in a separate action (RIN 0651-AC77) to revise the rules of practice to provide that applicants can include a statement of any grace period inventor disclosures in the specification (in proposed 37 CFR 1.77(b)). If the specification contains a specific reference to a grace period inventor disclosure, the Office will consider it apparent from the patent application specification that the disclosure is by the inventor or a joint inventor, provided that the disclosure does not name additional authors or inventors and there is no other evidence to the contrary. The applicant may also provide a copy of the disclosure (e.g., copy of a printed publication), and will be required to provide a copy of the disclosure to disqualify

an intervening disclosure under the provisions of 35 U.S.C. 102(b)(1)(B) (discussed subsequently).

An applicant is not required to use the format specified in proposed 37 CFR 1.77 or identify any prior disclosures by the inventor or a joint inventor (unless necessary to overcome a rejection), but identifying any prior disclosures by the inventor or a joint inventor may save applicants (and the Office) the costs related to an Office action and reply, and expedite examination of the application. In this situation, the Office would consider such a disclosure made one year or less before the effective filing date of the claimed invention as falling within the 35 U.S.C. 102(b)(1)(A) exception, and the disclosure would not be treated as prior art under 35 U.S.C. 102(a)(1).

The Office is proposing in a separate action (RIN 0651-AC77) elsewhere in this issue of the Federal Register to revise the rules of practice to provide for situations in which it is not apparent from the disclosure or the patent application specification that the disclosure is by the inventor or a joint inventor (proposed 37 CFR 1.130). Proposed 37 CFR 1.130 would generally provide a mechanism for filing an affidavit or declaration to establish that a disclosure is not prior art under 35 U.S.C. 102(a) due to an exception in 35 U.S.C. 102(b). Proposed 37 CFR 1.130(a)(1) would provide for the situation in which: (1) the disclosure on which the rejection is based was by the inventor or joint inventor; (2) the subject matter disclosed had been publicly disclosed by the inventor or a joint inventor before the disclosure of the subject matter on which the rejection is based; or (3) the subject matter disclosed had been publicly disclosed by the inventor or a joint inventor

before the date the subject matter in the patent or published application on which the rejection is based was effectively filed.

An affidavit or declaration under proposed 37 CFR 1.130(a)(1) could be used to establish that the prior art relied upon in a rejection is an inventor disclosure made during the grace period and subject to the exception of 35 U.S.C. 102(b)(1)(A). Specifically, such an affidavit or declaration could be used to establish that the disclosure upon which the rejection is based: (1) was made one year or less before the effective filing date of the claimed invention; and (2) had been publicly disclosed by the inventor or joint inventor. The affidavit or declaration must show that the disclosure of the subject matter on which the rejection is based is by the inventor or is by a joint inventor.³⁶ Where the authorship of the prior art disclosure includes the inventor or a joint inventor named in the application, an “unequivocal” statement from the inventor or a joint inventor that he/she (or some specific combination of named inventors) invented the subject matter of the disclosure, accompanied by a reasonable explanation of the presence of additional authors, may be acceptable in the absence of evidence to the contrary.³⁷ However, a mere statement from the inventor or a joint inventor may not be sufficient where there is evidence to the contrary.³⁸ This is similar to the current process for disqualifying a publication as not being by “others” discussed in MPEP § 2132.01, except that 35 U.S.C. 102(b)(1)(A) requires only that the disclosure be by the inventor or a joint inventor.

Grace period non-inventor disclosure: 35 U.S.C. 102(b)(1)(A) also provides that a disclosure which would otherwise qualify as prior art under 35 U.S.C. 102(a)(1) is not

prior art if the disclosure was made: (1) one year or less before the effective filing date of the claimed invention; and (2) by another who obtained the subject matter directly or indirectly from the inventor or a joint inventor. Thus, if the disclosure upon which the rejection is based is by someone who obtained the subject matter from the inventor or a joint inventor, the inventor could provide an affidavit or declaration which may overcome the rejection.

As discussed previously, proposed 37 CFR 1.130 would generally provide a mechanism for filing an affidavit or declaration to establish that a disclosure is not prior art due to an exception in AIA 35 U.S.C. 102(b). Proposed 37 CFR 1.130(a)(2) provides for the situation in which: (1) the disclosure on which the rejection is based was by a party who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor; (2) the subject matter disclosed had been publicly disclosed by a party who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor before the disclosure of the subject matter on which the rejection is based; or (3) the subject matter disclosed had been publicly disclosed by a party who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor before the date the subject matter in the patent or patent application publication on which the rejection is based was effectively filed.

Proposed 37 CFR 1.130(a)(2) thus provides for an affidavit or declaration to establish that the named inventor or joint inventor is the inventor of the disclosed subject matter, and that the subject matter was communicated by the inventor or a joint inventor to

another who disclosed it. Such an affidavit or declaration must show that the inventor or a joint inventor is the inventor of the subject matter of the disclosure (in accordance with proposed 37 CFR 1.130(d)), and indicate the communication of the subject matter by the inventor or a joint inventor to another who disclosed the subject matter. Thus, an applicant may benefit from the earlier disclosure by another during the grace period, if the applicant can establish that the inventor or a joint inventor is the actual inventor of the subject matter of the disclosure and that the subject matter was obtained directly or indirectly from the inventor or a joint inventor. Specifically, the applicant must show that a named inventor actually invented the subject matter of the disclosure.³⁹ The applicant must also show a communication of the subject matter of the disclosure sufficient to enable one of ordinary skill in the art to make the subject matter of the claimed invention.⁴⁰ Any documentation which provides evidence of the communication of the subject matter by the inventor or a joint inventor to the entity that earlier disclosed the subject matter should accompany the affidavit or declaration. This is similar to the current process for disqualifying a publication as being derived from the inventor discussed in MPEP §§ 715.01(c) II and 2137.

2. Prior art exception under 35 U.S.C. 102(b)(1)(B) to 35 U.S.C. 102(a)(1): The AIA in 35 U.S.C. 102(b)(1)(B) provides additional exceptions to the prior art provisions of 35 U.S.C. 102(a)(1). These exceptions disqualify a disclosure that occurs after a public disclosure by the inventor, joint inventor, or another who obtained the subject matter directly or indirectly from the inventor or joint inventor. The provisions of 35 U.S.C. 102(b)(1)(B) indicate that a disclosure which would otherwise qualify as prior

art under 35 U.S.C. 102(a)(1) is not prior art if the disclosure was made: (1) one year or less before the effective filing date of the claimed invention; and (2) after a public disclosure of the subject matter of the disclosure which would otherwise qualify as prior art under 35 U.S.C. 102(a)(1) by the inventor or a joint inventor or another who obtained the subject matter directly or indirectly from the inventor or a joint inventor.

The exception in 35 U.S.C. 102(b)(1)(B) applies if the “‘subject matter’ disclosed [in the prior art disclosure] had, before such [prior art] disclosure, been publicly disclosed by the inventor or a joint inventor”⁴¹ Thus, the exception in 35 U.S.C. 102(b)(1)(B) requires that the subject matter in the prior disclosure being relied upon under 35 U.S.C. 102(a) be the same “subject matter” as the subject matter publicly disclosed by the inventor before such prior art disclosure for the exception in 35 U.S.C. 102(b)(1)(B) to apply. Even if the only differences between the subject matter in the prior art disclosure that is relied upon under 35 U.S.C. 102(a) and the subject matter publicly disclosed by the inventor before such prior art disclosure are mere insubstantial changes, or only trivial or obvious variations, the exception under 35 U.S.C. 102(b)(1)(B) does not apply.

Grace period intervening disclosure exception: Under this exception, potential prior art under 35 U.S.C. 102(a)(1) is not prior art if the patent, printed publication, public use, sale, or other means of public availability was made: (1) one year or less before the effective filing date of the claimed invention; and (2) after a “grace period inventor disclosure” or a “grace period non-inventor disclosure” as those terms have been discussed previously.

An affidavit or declaration under 37 CFR 1.130(a)(1) could be used to establish that the subject matter disclosed had been publicly disclosed by the inventor or a joint inventor before the disclosure of the subject matter on which the rejection is based. Such an affidavit or declaration under 37 CFR 1.130(a)(1) must establish that the subject matter disclosed in the cited prior art had been publicly disclosed by the inventor or a joint inventor before the disclosure of the subject matter on which the rejection is based. Specifically, the inventor or joint inventor must establish the date and content of their earlier public disclosure. If the earlier disclosure was a printed publication, the affidavit or declaration must be accompanied by a copy of the printed publication. If the earlier disclosure was not a printed publication, the affidavit or declaration must describe the earlier disclosure with sufficient detail and particularity to determine that the earlier disclosure is a public disclosure of the subject matter.

Alternatively, as discussed previously, an affidavit or declaration under 37 CFR 1.130(a)(2) could establish that the subject matter disclosed had been publicly disclosed by a party who obtained the subject matter directly or indirectly from the inventor or a joint inventor before the disclosure of the subject matter on which the rejection is based. Such an affidavit or declaration under 37 CFR 1.130(a)(2) must establish that the subject matter disclosed in the cited prior art had been publicly disclosed by another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor before the disclosure of the subject matter on which the rejection is based. The affidavit or declaration must specifically show that the inventor or a joint inventor is the

inventor of the subject matter of the earlier public disclosure and indicate the communication of the subject matter to another who disclosed the subject matter. As discussed previously, this is similar to the current process for disqualifying a publication as being derived from the inventor discussed in MPEP section 2137.

Such an affidavit or declaration under 37 CFR 1.130(a)(2) must also establish the date and content of the earlier public disclosure which was made by another who obtained the subject matter directly or indirectly from the inventor or joint inventor. If the earlier disclosure was a printed publication, the affidavit or declaration must be accompanied by a copy of the printed publication. If the earlier disclosure was not a printed publication, the affidavit or declaration must describe the earlier disclosure with sufficient detail and particularity to determine that the earlier disclosure is a public disclosure of the subject matter. Any documentation which provides evidence of the public availability of a non-printed publication prior art and any documentation which provides evidence of the communication of the subject matter by the inventor or a joint inventor to the entity that disclosed the subject matter should accompany the affidavit or declaration.

B. Prior Art under AIA 35 U.S.C. 102(a)(2): AIA 35 U.S.C. 102(a)(2) sets forth three types of patent documents that are available prior art as of the date they were effectively filed with respect to the subject matter relied upon in the document: (1) U.S. patents; (2) U.S. patent application publications; and (3) WIPO published applications. These documents may have different prior art effects under pre-AIA 35 U.S.C. 102(e) and AIA 35 U.S.C. 102(a)(2).

A U.S. patent, U.S. patent application publication, or WIPO published application is prior art under 35 U.S.C. 102(a)(1) if its issue or publication date is before the effective filing date of the claim at issue. If the issue date of the U.S. patent or publication date of the U.S. patent application publication or WIPO published application is not before the effective filing date of the claimed invention, it may still be applicable as prior art under 35 U.S.C. 102(a)(2) if it was “effectively filed” before the effective filing date of the claim at issue with respect to the subject matter relied upon to reject the claim. AIA 35 U.S.C. 102(d) sets forth when subject matter described in a U.S. patent, U.S. patent application publication, or WIPO published application was “effectively filed” for purposes of 35 U.S.C. 102(a)(2).

1. Determining when subject matter was effectively filed under 35 U.S.C.

102(d): 35 U.S.C. 102(d) provides the criteria to determine the date that a U.S. patent, U.S. patent application publication, or WIPO published application was “effectively filed” with respect to the subject matter described in the patent or published application for purposes of constituting prior art under 35 U.S.C. 102(a)(2).

Under 35 U.S.C. 102(d), a U.S. patent, U.S. patent application publication, or WIPO published application is prior art under 35 U.S.C. 102(a)(2) with respect to any subject matter described in the patent or published application as of either its actual filing date (35 U.S.C. 102(d)(1)), or the filing date of a prior application to which there is a priority or benefit claim (35 U.S.C. 102(d)(2)). A U.S. patent, U.S. patent application

publication, or WIPO published application “is entitled to claim” priority to, or the benefit of, a prior-filed application if it fulfills the ministerial requirements of:

(1) containing a priority or benefit claim to the prior-filed application; (2) being filed within the applicable filing period requirement (copending with or within twelve months of the earlier filing, as applicable); and (3) having a common inventor or being by the same applicant.⁴²

The AIA draws a distinction between actually being entitled to priority to, or the benefit of, a prior-filed application in the definition of effective filing date in 35 U.S.C. 100(i)(2), and merely being entitled to claim priority to, or the benefit of, a prior-filed application in the definition of effectively filed in 35 U.S.C. 102(d).⁴³ As a result of this distinction, the question of whether a patent or published application is actually entitled to priority or benefit with respect to any of its claims is not at issue in determining the date the patent or published application was “effectively filed” for prior art purposes.⁴⁴ Thus, there is no need to evaluate whether any claim of a U.S. patent, U.S. patent application publication, or WIPO published application is actually entitled to priority or benefit under 35 U.S.C. 119, 120, 121, or 365 when applying such a document as prior art.

35 U.S.C. 102(d) does require that the prior-filed application to which a priority or benefit claim is made describe the subject matter from the U.S. patent, U.S. patent application publication, or WIPO published application relied upon in a rejection for that subject matter. However, 35 U.S.C. 102(d) does not require that this description meets the requirements of 35 U.S.C. 112(a). As discussed previously with respect to 35 U.S.C.

102(a), the Office views the description requirement as being the same as the pre-AIA description requirement for a prior art disclosure of an invention.

Another important consequence of 35 U.S.C. 102(d) is its impact on the vitality of the so-called Hilmer doctrine.⁴⁵ Under the Hilmer doctrine, pre-AIA 35 U.S.C. 102(e) limited the effective filing date for U.S. patents (and published applications) as prior art to their earliest United States filing date. In contrast, AIA 35 U.S.C. 102(d) provides that if the U.S. patent, U.S. patent application publication, or WIPO published application claims priority to prior-filed foreign or international application under 35 U.S.C. 119 or 365, the patent or published application was effectively filed on the filing date of the earliest such application that describes the subject matter.⁴⁶ Therefore, if the subject matter relied upon is described in the application to which there is a priority or benefit claim, a U.S. patent, a U.S. patent application publication, or WIPO published application is effective as prior art as of the filing date of the earliest such application, regardless of where filed, rather than only as of its earliest United States benefit date.

Requirement of “names another inventor”: To qualify as prior art under 35 U.S.C. 102(a)(2), the prior art U.S. patent, U.S. patent application publication, or WIPO published application must “name[s] another inventor.” This means that if there is any difference in inventive entity between the prior art U.S. patent, U.S. patent application publication, or WIPO published application and the application under examination or patent under reexamination, the U.S. patent, U.S. patent application publication, or WIPO published application satisfies the “names another inventor” provision of 35 U.S.C.

102(a)(2). Thus, in the case of joint inventors, only one inventor needs to be different for the inventive entities to be different. Even if there are some inventors in common in a U.S. patent, a U.S. patent application publication, or WIPO published application and in a later-filed application under examination or patent under reexamination, the U.S. patent, a U.S. patent application publication, or WIPO published application qualifies as prior art under 35 U.S.C. 102(a)(2) unless an exception in AIA 35 U.S.C. 102(b)(2) is applicable.

2. Prior art exception under 35 U.S.C. 102(b)(2)(A) to 35 U.S.C. 102(a)(2):

Under 35 U.S.C. 102(b)(2)(A), certain disclosures will not be considered prior art under 35 U.S.C. 102(a)(2) if the disclosure of the subject matter on which the rejection is based was made by another who obtained the subject matter directly or indirectly from the inventor or a joint inventor.

Non-Inventor Disclosure Exception: 35 U.S.C. 102(b)(2)(A) provides that a disclosure which would otherwise qualify as prior art under 35 U.S.C. 102(a)(2) is not prior art if the disclosure was made by another who obtained the subject matter directly or indirectly from the inventor or a joint inventor. This means that if the disclosure of the subject matter upon which the rejection is based is by another who obtained the subject matter from the inventor or joint inventor, then the inventor could provide an affidavit or declaration to establish that the inventor or joint inventor is the inventor of the subject matter of the disclosure and that such subject matter was communicated to the other entity. Thus, an applicant may benefit from the earlier disclosure by another during the grace period, if the applicant can establish that the inventor or a joint inventor is the

actual inventor of the subject matter of the disclosure and that the subject matter was obtained directly or indirectly from the inventor or a joint inventor.

As discussed previously, proposed 37 CFR 1.130(a)(2) provides for an affidavit or declaration to establish that the named inventor or joint inventor is the inventor of the disclosed subject matter, and that the subject matter was communicated by the inventor or a joint inventor to another who disclosed it. Such an affidavit or declaration must show that the inventor or a joint inventor is the inventor of the subject matter of the disclosure and indicate the communication of the subject matter by the inventor or a joint inventor to another who disclosed the subject matter. Specifically, the inventor must show that a named inventor actually invented the subject matter of the disclosure.⁴⁷ The inventor must also show a communication of the subject matter of the disclosure sufficient to enable one of ordinary skill in the art to make the subject matter of the claimed invention.⁴⁸ Any documentation which provides evidence of the communication of the subject matter by the inventor or a joint inventor to the entity that earlier disclosed the subject matter should accompany the affidavit or declaration. This is similar to the current process for disqualifying a publication as being derived from the inventor discussed in MPEP § 2137.

In circumstances where the claims of the cited prior art, which names another inventor and is a U.S. patent, or U.S. patent application publication, and the claims of the application under examination are directed to the same or substantially the same

invention, the Office may require an applicant to file a petition for derivation proceeding pursuant to 37 CFR 41.401 et seq. of this title.

3. Prior art exception under 35 U.S.C. 102(b)(2)(B) to 35 U.S.C. 102(a)(2): 35 U.S.C. 102(b)(2)(B) provides another exception to the prior art provisions of 35 U.S.C. 102(a)(2). Specifically, 35 U.S.C. 102(b)(2)(B) indicates that certain disclosures are not prior art if the disclosure of the subject matter of the claimed invention to be disqualified was made after a disclosure of the subject matter by the inventor or a joint inventor or after a disclosure of the subject matter by another who obtained the subject matter directly or indirectly from the inventor or joint inventor. In other words, an inventor, joint inventor, or someone who obtained the subject matter directly or indirectly from the inventor or joint inventor, disclosed the subject matter before the disclosure of the subject matter on which the rejection is based.

As discussed previously with respect to 35 U.S.C. 102(b)(1)(B), the exception in 35 U.S.C. 102(b)(2)(B) requires that the subject matter in the prior disclosure being relied upon under 35 U.S.C. 102(a) be the same “subject matter” as the subject matter publicly disclosed by the inventor before such prior art disclosure for the exception in 35 U.S.C. 102(b)(2)(B) to apply.⁴⁹ Even if the only differences between the subject matter in the prior art disclosure that is relied upon under 35 U.S.C. 102(a) and the subject matter publicly disclosed by the inventor before such prior art disclosure are mere insubstantial changes, or only trivial or obvious variations, the exception under 35 U.S.C. 102(b)(2)(B) does not apply.

Intervening disclosure: Under this exception, potential prior art under 35 U.S.C. 102(a)(2) is not prior art if the U.S. patent, U.S. patent application publication, or WIPO published application was effectively filed after the subject matter was first disclosed by the inventor, a joint inventor, or another who obtained it directly or indirectly from the inventor or joint inventor.

As discussed previously, an affidavit or declaration under 37 CFR 1.130(a)(1) could be used to establish that the subject matter disclosed in the cited patent or published application to be disqualified had been publicly disclosed by the inventor or a joint inventor before the date the subject matter in the patent or published application to be disqualified was effectively filed. Specifically, the inventor or joint inventor must establish the date and content of their earlier public disclosure. If the earlier disclosure was a printed publication, the affidavit or declaration must be accompanied by a copy of the printed publication. If the earlier disclosure was not a printed publication, the affidavit or declaration must describe the earlier disclosure with sufficient detail and particularity to determine that the earlier disclosure is a public disclosure of the subject matter.

Alternatively, also as discussed previously, an affidavit or declaration under 37 CFR 1.130(a)(2) could establish that the subject matter disclosed in the cited patent or published application to be disqualified had been publicly disclosed by a party who obtained the subject matter directly or indirectly from the inventor or a joint inventor before the date the subject matter in the patent or published application to be disqualified

was effectively filed. Specifically, the inventor or joint inventor must establish the date and content of their earlier public disclosure. The affidavit or declaration must also show that the inventor or a joint inventor is the inventor of the subject matter disclosed in the patent or published application and indicate the communication of the subject matter to another who disclosed the subject matter. As discussed previously, this is similar to the current process for disqualifying a publication as being derived from the inventor discussed in MPEP § 2137.

Such an affidavit or declaration under 37 CFR 1.130(a)(2) must also establish the date and content of the earlier public disclosure which was made by another who obtained the subject matter directly or indirectly from the inventor or a joint inventor. If the earlier disclosure was a printed publication, the affidavit or declaration must be accompanied by a copy of the printed publication. If the earlier disclosure was not a printed publication, the affidavit or declaration must describe the earlier disclosure with sufficient detail and particularity to determine that the earlier disclosure was a public disclosure of the subject matter. Any documentation which provides evidence of the public availability of a non-printed publication prior art and any documentation which provides evidence of the communication of the subject matter by the inventor or a joint inventor to the entity that disclosed the subject matter should accompany the affidavit or declaration.

In circumstances where the claims of the cited patent or published application to be disqualified is a U.S. patent, or a U.S. patent application publication of a pending or patented application that names another inventor, and the claims of the application under

examination and the cited patent or published application are directed to the same or substantially the same invention, the Office may require applicant to file a petition for derivation proceeding pursuant to 37 CFR 41.401 et seq.

4. Prior art exception under 35 U.S.C. 102(b)(2)(C) to 35 U.S.C. 102(a)(2):

Under 35 U.S.C. 102(b)(2)(C), there is an exception to the prior art defined in 35 U.S.C. 102(a)(2) if the disclosures of the subject matter on which the rejection is based and the claimed invention, not later than the effective filing date of the claimed invention, were owned by the same person or subject to an obligation of assignment to the same person.

In accordance with 35 U.S.C. 102(a)(2), a U.S. patent, U.S. patent application publication, or WIPO published application that describes a claimed invention of an application under examination may be prior art as of its effective filing date. However, 35 U.S.C. 102(b)(2)(C) excludes published applications or patents from 35 U.S.C. 102(a)(2) if the subject matter disclosed in the potential prior art published application or patent, and the claimed invention of the application under examination “were owned by the same person or subject to an obligation of assignment to the same person.” In this situation, the U.S. patent, U.S. patent application publication, or WIPO published application is not available as prior art under 35 U.S.C. 102(a)(2), so long as the common ownership or obligation to assign existed not later than the effective filing date of the claimed invention.

AIA 35 U.S.C. 102(b)(2)(C) resembles pre-AIA 35 U.S.C. 103(c) in that both concern common ownership, and both offer an avenue by which an applicant may avoid certain rejections. However, there are significant differences between AIA 35 U.S.C. 102(b)(2)(C) and pre-AIA 35 U.S.C. 103(c).

If the provisions of 35 U.S.C. 102(b)(2)(C) are met, a U.S. patent, U.S. patent application publication, or WIPO published application that might otherwise qualify as prior art under 35 U.S.C. 102(a)(2) is not available as prior art under either 35 U.S.C. 102 or 103. In contrast, pre-AIA 35 U.S.C. 103(c) merely provided that if its conditions were met, prior art qualifying only under pre-AIA 35 U.S.C. 102(e), (f), or (g), would not preclude patentability under 35 U.S.C. 103. Under pre-AIA 35 U.S.C. 103(c), prior art qualifying only under pre-AIA 35 U.S.C. 102(e), (f), or (g) could preclude patentability under 35 U.S.C. 102, even if the conditions of pre-AIA 35 U.S.C. 103(c) were met. The consequence of this distinction is that a published application or an issued patent that falls under the common ownership provisions of AIA 35 U.S.C. 102(b)(2)(C) may not be applied in either an anticipation or an obviousness rejection.

It is important to note the circumstances in which the AIA 35 U.S.C. 102(b)(2)(C) exception does not remove U.S. patents, U.S. patent application publications, or WIPO published applications as a basis for any rejection. Even if the U.S. patent or U.S. published application is not prior art under 35 U.S.C. 102 or 103 as a result of AIA 35 U.S.C. 102(b)(2)(C), a double patenting rejection (either statutory under 35 U.S.C. 101 or non-statutory, sometimes called obviousness-type) may still be made on the basis of the

U.S. patent or U.S. patent application publication. Furthermore, the U.S. patent, U.S. patent application publication, or WIPO published application that does not qualify as prior art as a result of AIA 35 U.S.C. 102(b)(2)(C) may be cited, in appropriate situations, to indicate the state of the art when making a lack of enablement rejection under 35 U.S.C. 112(a). A document need not qualify as prior art to be applied in the context of double patenting⁵⁰ or enablement.⁵¹ Also, the AIA 35 U.S.C. 102(b)(2)(C) exception does not apply to any disclosure made before the effective filing date of the claimed invention under AIA 35 U.S.C. 102(a)(1). Thus, if the issue date of a U.S. patent or publication date of a U.S. patent application publication or WIPO published application is before the effective filing date of the claimed invention, it may be prior art under AIA 35 U.S.C. 102(a)(1), regardless of common ownership or the existence of an obligation to assign.

The Office is concurrently proposing in a separate action (RIN 0651-AC77) to revise the rules of practice to include provisions that pertain to commonly owned or joint research agreement subject matter (proposed 37 CFR 1.104(c)(4) and (c)(5)). Proposed 37 CFR 1.104(c)(4) would be applicable to applications that are subject to AIA 35 U.S.C. 102 and 103. Proposed 37 CFR 1.104(c)(5) would be applicable to applications that are subject to 35 U.S.C. 102 and 103 as in effect on March 15, 2013 (pre-AIA 35 U.S.C. 102 and 103). Proposed 37 CFR 1.104(c)(4)(i) would pertain to commonly owned subject matter under AIA 35 U.S.C. 102 and 103, and proposed 37 CFR 1.104(c)(5)(i) would pertain to commonly owned subject matter under pre-AIA 35 U.S.C. 102 and 103.

An applicant's clear and conspicuous statement on the record will be sufficient to establish that the AIA 35 U.S.C. 102(b)(2)(C) exception applies. When relying on the provisions of pre-AIA 35 U.S.C. 103(c), the applicant or his attorney or agent of record could provide the statement required to disqualify the cited prior art. Because the practice to rely on the AIA 35 U.S.C. 102(b)(2)(C) provisions is similar to previous provisions under pre-AIA 35 U.S.C. 103(c), the statement from the applicant or his attorney or agent of record would still be sufficient to disqualify such disclosures. The statement must indicate that the claimed invention of the application under examination and the subject matter disclosed in the published application or issued patent (prior art) to be excluded under AIA 35 U.S.C. 102(b)(2)(C) were owned by the same person or subject to an obligation of assignment to the same person not later than the effective filing date of the claimed invention. The applicant may present supporting evidence such as copies of assignment documents, but is not required to do so. Unless an examiner has independent evidence which raises doubt as to the veracity of such a statement, the examiner may not request corroborating evidence. The statement under AIA 35 U.S.C. 102(b)(2)(C) will generally be treated by the examiner analogously to statements made under pre-AIA 35 U.S.C. 103(c). See MPEP § 706.02(1)(2)(II).

II. Joint Research Agreements: 35 U.S.C. 102(c) provides that subject matter disclosed, which might otherwise qualify as prior art, and a claimed invention are treated as having been owned by the same person or subject to an obligation of assignment to the same person in applying the provisions of 35 U.S.C. 102(b)(2)(C) if three conditions are satisfied. First, the subject matter disclosed must have been developed and the claimed

invention must have been made by, or on behalf of, one or more parties to a joint research agreement that was in effect on or before the effective filing date of the claimed invention.⁵² The AIA defines the term “joint research agreement” as a written contract, grant, or cooperative agreement entered into by two or more persons or entities for the performance of experimental, developmental, or research work in the field of the claimed invention.⁵³ Second, the claimed invention must have been made as a result of activities undertaken within the scope of the joint research agreement.⁵⁴ Third, the application for patent for the claimed invention must disclose, or be amended to disclose, the names of the parties to the joint research agreement.⁵⁵ Proposed 37 CFR 1.104(c)(4)(ii) pertains to joint research agreement subject matter under AIA 35 U.S.C. 102 and 103, and proposed 37 CFR 1.104(c)(5)(ii) pertains to joint research agreement subject matter under pre-AIA 35 U.S.C. 102 and 103. If these conditions are met, the joint research agreement prior art is not available as prior art under 35 U.S.C. 102(a)(2).

The provisions of AIA 35 U.S.C. 102(c) generally track those of the Cooperative Research and Technology Enhancement Act of 2004 (CREATE Act).⁵⁶ The major differences between AIA 35 U.S.C. 102(c) and the CREATE Act are that the new provision is keyed to the effective filing date of the claimed invention, while the CREATE Act focused on the date that the claimed invention was made, and that the CREATE Act provisions only applied to prior art obviousness rejections.

In order to invoke a joint research agreement to disqualify a disclosure as prior art, the applicant must provide a statement that the disclosure of the subject matter on which the

rejection is based and the claimed invention were made by or on behalf of parties to a joint research agreement under AIA 35 U.S.C. 102(c). The statement must also assert that the agreement was in effect on or before the effective filing date of the claimed invention, and that the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement. When relying on the provisions of pre-AIA 35 U.S.C. 103(c), the applicant or his attorney or agent of record could provide the statement required to disqualify the cited prior art. Because the practice to rely on the 102(c) provisions is similar to previous provisions under pre-AIA 35 U.S.C. 103(c), the statement from the applicant or his attorney or agent of record would still be sufficient to disqualify such disclosures. If the names of the parties to the joint research agreement are not already stated in the application, it is necessary to amend the application to include the names of the parties to the joint research agreement in accordance with 37 CFR 1.71(g). As is the case with establishing common ownership, the applicant may, but is not required to, present evidence supporting the existence of the joint research agreement. Furthermore, the Office will not request corroborating evidence in the absence of independent evidence which raises doubt as to the existence of the joint research agreement.

As discussed previously, the AIA 35 U.S.C. 102(b)(2)(C) exception does not apply to any disclosure made before the effective filing date of the claimed invention under AIA 35 U.S.C. 102(a)(1). Thus, if the issue date of a U.S. patent or publication date of a U.S. patent application publication or WIPO published application is before the effective filing date of the claimed invention, it may be prior art under AIA 35 U.S.C. 102(a)(1)

regardless of the fact that the subject matter disclosed and the claimed invention resulted from a joint research agreement.

III. Improper Naming of Inventors: Although the AIA eliminated pre-AIA 35 U.S.C. 102(f), the patent laws still require that a patent name the actual inventor or joint inventors of the claimed subject matter. The Office presumes that the named inventor or inventors are the actual inventor or joint inventors.⁵⁷ Where an application names an incorrect inventorship, the applicant should correct the situation via a request to correct inventorship under 37 CFR 1.48. In the rare situation in which it is clear that the application does not name the correct inventorship and the applicant has not filed a request to correct inventorship under 37 CFR 1.48, the appropriate course of action is to reject the claims under 35 U.S.C. 101.⁵⁸

IV. 35 U.S.C. 103: AIA 35 U.S.C. 103 continues to set forth the nonobviousness requirement for patentability.⁵⁹ There are, however, some important changes from pre-AIA 35 U.S.C. 103.

The most significant difference between the AIA 35 U.S.C. 103 and pre-AIA 35 U.S.C. 103(a) is that AIA 35 U.S.C. 103 determines obviousness as of the effective filing date of the claimed invention, rather than as of the time that the invention was made. Under pre-AIA examination practice, the Office uses the effective filing date as a proxy for the invention date, unless there is evidence of record to establish an earlier date of invention. Thus, as a practical matter during examination, this distinction between the AIA

35 U.S.C. 103 and pre-AIA 35 U.S.C. 103 will result in a difference in practice only when the case under examination is subject to pre-AIA 35 U.S.C. 103, and there is evidence in the case concerning a date of invention prior to the effective filing date. Such evidence is ordinarily presented by way of an affidavit or declaration under 37 CFR 1.131.

Next, AIA 35 U.S.C. 103 differs from that of pre-AIA 35 U.S.C. 103 in that the AIA 35 U.S.C. 103 requires consideration of “the differences between the claimed invention and the prior art,” while pre-AIA 35 U.S.C. 103 refers to “the differences between the subject matter sought to be patented and the prior art.” This difference in terminology does not indicate the need for any difference of approach to the question of obviousness.⁶⁰

Further, the AIA 35 U.S.C. 103 eliminates pre-AIA 35 U.S.C. 103(b), and the AIA does not contain any similar provision. Pre-AIA 35 U.S.C. 103(b) is narrowly drawn, applying only to nonobviousness of biotechnological inventions, and even then, only when specifically invoked by the patent applicant. Pre-AIA 35 U.S.C. 103(b) provides that under certain conditions, “a biotechnological process using or resulting in a composition of matter that is novel under section 102 and nonobvious under subsection [103(a)] of this section shall be considered nonobvious.” In view of the case law since 1995,⁶¹ the need to invoke pre-AIA 35 U.S.C. 103(b) has been rare.

Finally, the AIA 35 U.S.C. 103 eliminates pre-AIA 35 U.S.C. 103(c), but corresponding provisions have been introduced in AIA 35 U.S.C. 102(b)(2)(C) and 102(c). Pre-AIA 35

U.S.C. 103(c) applied if subject matter qualified as prior art only under pre-AIA 35 U.S.C. 102(e), (f), or (g), and only in the context of obviousness under pre-AIA 35 U.S.C. 103(a). If subject matter developed by another person was commonly owned with the claimed invention, or if the subject matter was subject to an obligation of assignment to the same person, at the time the claimed invention was made, then pre-AIA 35 U.S.C. 103(a) did not preclude patentability. Furthermore, under the pre-AIA 35 U.S.C. 103(c), if a joint research agreement was in place on or before the date that the claimed invention was made, the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement, and the application for patent was amended to disclose the names of the parties to the joint research agreement, common ownership or an obligation to assign was deemed to exist. As discussed previously, AIA 35 U.S.C. 102(b)(2)(C) and 102(c) expand on this concept. Under the AIA first-inventor-to-file approach, the common ownership, the obligation to assign, or the joint research agreement must exist on or before the effective filing date, rather than on or before the date the invention was made. If the provisions of AIA 35 U.S.C. 102(b)(2)(C) are met, a disclosure is not prior art at all, whereas under pre-AIA 35 U.S.C. 103(c), certain prior art merely was defined as not precluding patentability. Finally, disclosures disqualified as prior art under AIA 35 U.S.C. 102(b)(2)(C) and 102(c) may not be applied in either an anticipation or an obviousness rejection. However, such disclosures could be the basis for statutory double patenting or non-statutory double patenting rejections.

Generally speaking, and with the exceptions noted herein, pre-AIA notions of obviousness will continue to apply under the AIA. It should be noted that AIA 35 U.S.C.

102(a) defines what is prior art both for purposes of novelty under AIA 35 U.S.C. 102 as well as for purposes of obviousness under AIA 35 U.S.C. 103.⁶² Thus, if a document qualifies as prior art under AIA 35 U.S.C. 102(a)(1) or (a)(2), and is not subject to an exception under AIA 35 U.S.C. 102(b), it may be applied for what it describes or teaches to those skilled in the art in a rejection under 35 U.S.C. 103.⁶³ Finally, Office personnel will continue to follow guidance for formulating an appropriate rationale to support any conclusion of obviousness. See MPEP § 2141 et seq. and the guidance documents available at http://www.uspto.gov/patents/law/exam/ksr_training_materials.jsp.

V. Applicability date provisions, determining whether an application is subject to provisions of first inventor to file under AIA: Because the changes to 35 U.S.C. 102 and 103 in the AIA apply only to specific applications filed on or after March 16, 2013, determining the effective filing date of a claimed invention for purposes of applying AIA 35 U.S.C. 102 and 103 provisions or pre-AIA 35 U.S.C. 102 and 103 provisions is critical.

A. Applications filed before March 16, 2013: The changes to 35 U.S.C. 102 and 103 in the AIA do not apply to any application filed before March 16, 2013. Thus, any application filed before March 16, 2013, is governed by pre-AIA 35 U.S.C. 102 and 103. Note that the filing of a request for continued examination is not the filing of a new application.

B. Applications filed on or after March 16, 2013: AIA 35 U.S.C. 102 and 103 take effect on March 16, 2013. AIA 35 U.S.C. 102 and 103 apply to any patent application that contains or contained at any time a claimed invention that has an effective filing date that is on or after March 16, 2013. If a patent application contains or contained at any time a claimed invention having an effective filing date on or after March 16, 2013, 35 U.S.C. 102 and 103, as amended by the AIA, apply to the application. If even a single claim in the application ever has an effective filing date on or after March 16, 2013, AIA 35 U.S.C. 102 and 103 apply in determining the patentability of every claim in the application. This is the situation even if the remaining claimed inventions all have an effective filing date before March 16, 2013, and even if the claimed invention having an effective filing date on or after March 16, 2013, is canceled.

In addition, AIA 35 U.S.C. 102 and 103 apply to any patent application that contains or contained at any time a specific reference under 35 U.S.C. 120, 121, or 365(c) to any patent or application that contains or contained at any time a claimed invention that has an effective filing date that is on or after March 16, 2013. Thus, AIA 35 U.S.C. 102 and 103 apply to any patent application that was ever designated as a continuation, divisional, or continuation-in-part of an application that contains or contained at any time a claimed invention that has an effective filing date that is on or after March 16, 2013. This is the situation even if the application is amended to delete its reference as a continuation, divisional, or continuation-in-part to the prior-filed application, and even if the claimed invention having an effective filing date on or after March 16, 2013, in the prior-filed

application, is canceled. An application filed on or after March 16, 2013, is governed by pre-AIA 35 U.S.C. 102 and 103 only if: (1) the application does not contain and never contained any claimed invention having an effective filing date on or after March 16, 2013; and (2) the application does not contain and never contained a specific reference under 35 U.S.C. 120, 121, or 365(c) to an application that contains or contained at any time a claim that has an effective filing date that is on or after March 16, 2013.

Thus, once a claim that has an effective filing date on or after March 16, 2013, is introduced in an application, or is introduced to an application in its continuity chain, AIA 35 U.S.C. 102 and 103 apply to that application and any subsequent continuation, divisional, or continuation-in-part of that application. Specifically, a patent application may be amended to add a claimed invention having an effective filing date on or after March 16, 2013, or a specific reference under 35 U.S.C. 120, 121 or 365(c) to an application containing a claimed invention having an effective filing date on or after March 16, 2013, that results in the application no longer being subject to pre-AIA 35 U.S.C. 102 and 103 but being subject to AIA 35 U.S.C. 102 and 103. However, no amendment to a claim, or to a specific reference under 35 U.S.C. 120, 121 or 365(c), or both, will result in the application changing from being subject to AIA 35 U.S.C. 102 and 103 to being subject to pre-AIA 35 U.S.C. 102 and 103.

Also, AIA 35 U.S.C. 102 and 103 apply to any patent resulting from an application to which AIA 35 U.S.C. 102 and 103 were applied. Similarly, pre-AIA 35 U.S.C. 102 and

103 apply to any patent resulting from an application to which pre-AIA 35 U.S.C. 102 and 103 were applied.

C. Applications subject to the AIA but also containing a claim having an effective filing date before March 16, 2013: Even if AIA 35 U.S.C. 102 and 103 apply to a patent application, pre-AIA 35 U.S.C. 102(g) also applies to every claim in the application if it: (1) contains or contained at any time a claimed invention having an effective filing date that occurs before March 16, 2013; or (2) is ever designated as a continuation, divisional, or continuation-in-part of an application that contains or contained at any time a claimed invention that has an effective filing date that occurs before March 16, 2013. Pre-AIA 35 U.S.C. 102(g) also applies to any patent resulting from an application to which pre-AIA 35 U.S.C. 102(g) applied.

Thus, if an application contains, or contained at any time, any claimed invention having an effective filing date that occurs before March 16, 2013, and also contains, or contained at any time, any claimed invention having an effective filing date that is on or after March 16, 2013, AIA 35 U.S.C. 102 and 103 apply to the application, but each claim must also satisfy pre-AIA 35 U.S.C. 102(g) for the applicant to be entitled to a patent.

Thus, when subject matter is claimed in an application having priority to or the benefit of a prior-filed application (e.g., under 35 U.S.C. 120, 121 or 365(c)), care must be taken to accurately determine whether AIA or pre-AIA 35 U.S.C. 102 and 103 applies to the application.

D. Applicant statement regarding applicability of AIA provisions to claims in applications filed on or after March 16, 2013: The Office is concurrently proposing the following amendments to 37 CFR 1.55 and 1.78 a separate action (RIN 0651-AC77). First, the Office is proposing to require that if a nonprovisional application filed on or after March 16, 2013, claims the benefit of or priority to the filing date of a foreign, U.S. provisional, U.S. nonprovisional, or international application that was filed prior to March 16, 2013, and also contains or contained at any time a claimed invention having an effective filing date on or after March 16, 2013, the applicant must provide a statement to that effect. Second, the Office is proposing to require that if a nonprovisional application filed on or after March 16, 2013, does not contain a claim to a claimed invention having an effective filing date on or after March 16, 2013, but discloses subject matter not also disclosed in the foreign, provisional, or nonprovisional application, the applicant must provide a statement to that effect. This information will assist the Office in determining whether the application is subject to AIA 35 U.S.C. 102 and 103 or pre-AIA 35 U.S.C. 102 and 103.

Date: July 17, 2012

David J. Kappos
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office

¹ Pub. L. 112-29, 125 Stat. 284 (2011).

² 35 U.S.C. 101 (“[w]hoever invents or discovers . . . , may obtain a patent therefor, subject to the conditions and requirements of this title); see also P.J. Federico, Commentary on the New Patent Act, 75 J. Pat. & Trademark Off. Soc’y 161, 179 (1993) (noting that pre-AIA 35 U.S.C. 102(f) is perhaps unnecessary since 35 U.S.C. 101 provides that (“[w]hoever invents or discovers . . . , may obtain a patent therefor, subject to the conditions and requirements of this title”).

³ Under 35 U.S.C. 102(e) as amended by the American Inventors Protection Act (Public Law 106-113) and the Intellectual Property and High Technology Technical Amendments Act of 2002 (Public Law 107-273), the international filing date of a PCT application is a U.S. filing date for prior art purposes under 35 U.S.C. 102(e) if the international application: (1) has an international filing date on or after November 29, 2000; designated the United States; and (3) is published under PCT Article 21(2) in English. See MPEP § 706.02(f)(1). The AIA amends 35 U.S.C. 102, 363, and 374 to provide simply that the publication under the PCT of an international application designating the United States shall be deemed a publication under 35 U.S.C. 122(b).

⁴ Pub. L. No. 112-29, § 3(n)(1), 125 Stat. at 293.

⁵ Id.

⁶ 35 U.S.C. 102(g) precludes the grant of a patent if: (1) during the course of an interference conducted under 35 U.S.C. 135 or 291, another inventor involved therein establishes, to the extent permitted in 35 U.S.C. 104, that before such person's invention thereof the invention was made by such other inventor and not abandoned, suppressed, or concealed, or (2) before such person's invention thereof, the invention was made in this country by another inventor who had not abandoned, suppressed, or concealed it.

⁷ Pub. L. No. 112-29, § 3(n)(2), 125 Stat. at 293.

⁸ Id.

⁹ 35 U.S.C. 102(a).

¹⁰ In re Epstein, 32 F.3d 1559 (Fed. Cir. 1994).

¹¹ 35 U.S.C. 102(b)(1).

¹² 35 U.S.C. 102(b)(2).

¹³ 35 U.S.C. 100(i)(1).

¹⁴ 35 U.S.C. 100(i)(2).

¹⁵ See 35 U.S.C. 102(b)(1) (“[a] disclosure made one year or less before the effective filing date of a claimed invention shall not be prior art to the claimed invention under [35 U.S.C. 102](a)(1)”) and 102(b)(2) (“[a] disclosure shall not be prior art to a claimed invention under [35 U.S.C. 102](a)(2)”); see also H.R. Rep. No. 112-98, at 43 (2011) (indicating that the grace period provision of 35 U.S.C. 102(b) would apply to all patent applicant actions during the grace period that would create prior art under 35 U.S.C. 102(a)).

¹⁶ In re Ekenstam, 256 F.2d 321 (CCPA 1958); see also MPEP § 2126.01.

¹⁷ In re Carlson, 983 F.2d 1032, 1037 (Fed. Cir. 1992); see also MPEP § 2126.

¹⁸ Novo Nordisk Pharma., Inc. v. Bio-Tech. Gen. Corp., 424 F.3d 1347, 1355 (Fed. Cir. 2005), discussing pre-AIA 35 U.S.C. 112, first paragraph, and pre-AIA 35 U.S.C. 102.

¹⁹ In re Gleave, 560 F.3d 1331, 1334 (Fed. Cir. 2009), citing Eli Lilly & Co. v. Zenith Goldline Pharms., Inc., 471 F.3d 1369, 1375 (Fed. Cir. 2006); Net MoneyIN, Inc. v. VeriSign, Inc., 545 F.3d 1359, 1370 (Fed. Cir. 2008); In re Bond, 910 F.2d 831, 832-33 (Fed. Cir. 1990).

²⁰ Gleave, 560 F.3d at 1334, citing Impax Labs., Inc. v. Aventis Pharms. Inc., 545 F.3d 1312, 1314 (Fed. Cir. 2008); In re LeGrice, 301 F.2d 929, 940-44 (CCPA 1962).

²¹ Gleave, 560 F.3d at 1334; see also In re Schoenwald, 964 F.2d 1122 (Fed. Cir. 1992) (holding that a claimed compound was anticipated even though the prior art reference did not disclose a use for the compound); Schering Corp. v. Geneva Pharms., Inc., 339 F.3d 1373, 1380-81 (Fed. Cir. 2003) (pointing out that actually reducing the invention to practice is not necessary in order for a prior art reference to

anticipate); Impax Labs. Inc. v. Aventis Pharm. Inc., 468 F.3d 1366, 1383 (Fed. Cir. 2006) (stating that “proof of efficacy is not required for a prior art reference to be enabling for purposes of anticipation”).

²² In re Donohue, 766 F.2d 531, 533 (Fed. Cir. 1985).

²³ Rasmussen v. SmithKline Beecham Corp., 413 F.3d 1318 (Fed. Cir. 2005).

²⁴ Vas-Cath Inc. v. Mahurkar, 935 F.2d 1555, 1562 (Fed. Cir. 1991) (“As the court pointed out, ‘the description of a single embodiment of broadly claimed subject matter constitutes a description of the invention for anticipation purposes . . . , whereas the same information in a specification might not alone be enough to provide a description of that invention for purposes of adequate disclosure.’”) (quoting In re Lukach, 442 F.2d 967 (CCPA 1971)); see also In re Van Langenhoven, 458 F.2d 132 (CCPA 1972), and In re Ruschetta, 255 F.2d 68 (CCPA 1958).

²⁵ Under pre-AIA 35 U.S.C. 102(b), the critical date is the date that is one year prior to the date of application for patent in the United States.

²⁶ In vitro Gen Corp. v. Biocrest Mfg. L.P., 424 F.3d 1374 (Fed. Cir. 2005).

²⁷ Similarly, under pre-AIA 35 U.S.C. 102(a), that an invention was “known or used by others” precluded a patent only if such knowledge or use occurred “in this country.”

²⁸ Pfaff v. Wells Elecs., Inc., 525 U.S. 55, 67 (1998).

²⁹ AIA 35 U.S.C. 102(a)(1) uses the same term (“on sale”) as pre-AIA 35 U.S.C. 102(b). The pre-AIA 35 U.S.C. 102(b) “on sale” provision has been interpreted as including commercial activity even if the activity is secret or private. See, e.g., Metallizing Engineering Co. v. Kenyon Bearing & Auto Parts Co., 153 F.2d 516 (2d Cir. 1946). However, 35 U.S.C. 102(a)(1), unlike pre-AIA 35 U.S.C. 102(b), contains the residual clause “or otherwise available to the public.” See 35 U.S.C. 102(a)(1). The legislative history of the AIA indicates that the inclusion of this clause in AIA 35 U.S.C. 102(a)(1) should be viewed as indicating that AIA 35 U.S.C. 102(a)(1) does not cover non-public uses or non-public offers for sale. See 157 Cong. Rec. S.1370 (Mar. 8, 2011) (The Committee’s understanding of the effect of adding the words ‘or otherwise available to the public’ is confirmed by judicial construction of this phraseology. Courts have consistently found that when the words ‘or otherwise’ or ‘or other’ when used as a modifier at the end of a string of clauses restricts the meaning of the preceding clauses.).

³⁰ E.g., In re Cronyn, 890 F.2d 1158 (Fed. Cir. 1989); In re Hall, 781 F.2d 897 (Fed. Cir. 1986); In re Bayer, 568 F.2d 1357 (CCPA 1978).

³¹ E.g., In re Klopfenstein, 380 F.3d 1345, 1348 (Fed. Cir. 2004), Massachusetts Institute of Technology v. AB Fortia, 774 F.2d 1104 (Fed. Cir. 1985).

³² E.g., In re Wyer, 655 F.2d 221 (CCPA 1981); see also Bruckelmyer v. Ground Heaters, Inc., 445 F.3d 1374 (Fed. Cir. 2006).

³³ E.g., In re Lister, 583 F.3d 1307 (Fed. Cir. 2009), and SRI International, Inc. v. Internet Security Systems, Inc., 511 F.3d 1186 (Fed. Cir. 2008).

³⁴ E.g., Group One, Ltd. v. Hallmark Cards, Inc., 254 F.3d 1041 (Fed. Cir. 2001).

³⁵ Riverwood Int’l Corp. v. R.A. Jones & Co., 324 F.3d 1346, 1354 (Fed. Cir. 2003); Constant v. Advanced Micro-Devices Inc., 848 F.2d 1560, 1570 (Fed. Cir. 1988).

³⁶ In re Katz, 687 F.2d 450, 455 (CCPA 1982).

³⁷ In re DeBaun, 687 F.2d 459, 463 (CCPA 1982).

³⁸ Ex parte Kroger, 218 USPQ 370 (Bd. App. 1982) (affirming rejection notwithstanding declarations by the alleged actual inventors as to their inventorship in view of a nonapplicant author submitting a letter declaring the nonapplicant author’s inventorship).

³⁹ In re Facius, 408 F.2d 1396, 1407 (CCPA 1969).

⁴⁰ Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1577 (Fed. Cir. 1997).

⁴¹ 35 U.S.C. 102(b)(1)(B).

⁴² See 157 Cong. Rec. S.1370 (Mar. 8, 2011) (distinguishing between the core requirement that the prior-filed application include an enabling disclosure and the ministerial requirements that the applications be copendent and specifically referenced); see also MPEP § 201.08 (permitting a claim to the benefit of a prior-filed application in a continuation-in-part application provided that the continuation-in-part application has a common inventor, has copendency with the prior-filed application, and includes a specific reference to the prior-filed application, regardless of whether the prior-filed application contains support under 35 U.S.C. 112 for any claim in the continuation-in-part application).

⁴³ The legislative history of the AIA discusses an important distinction between ministerial entitlement to make a priority or benefit claim, and actual legal entitlement to the priority or benefit: In section 100(i),

which defines the effective filing date of the patent under review, the patent must be entitled to the priority or benefit itself under the relevant sections. Here again in section 102(d), however, the application need only be entitled to claim the benefit or priority under those sections. This difference in language distinguishes between the core requirement of section 120 et al.—that the application include an enabling disclosure—and the ministerial requirements of that section—that the application be copendent and specifically referenced. In effect, an application that meets the ministerial requirements of copendency and specific reference is entitled to claim the benefit or priority, but only an application that also offers an enabling disclosure is actually entitled to the benefit or priority itself. See 157 Cong. Rec. S.1370 (Mar. 8, 2011).

⁴⁴ In re Wertheim, 646 F.2d 527 (CCPA 1981), which relies upon Alexander Milburn Co. v. Davis-Bournonville, 270 U.S. 390 (1926), for its conclusion that the patent must actually be entitled to the benefit of the prior-application for any subject matter in the patent to have a prior art date under 35 U.S.C. 102(e) as of the filing date of the prior application. The legislative history of the AIA indicates that: Paragraph (2) [of AIA 102(d)] is intended to overrule what remains of In re Wertheim, 646 F.2d 527 (CCPA 1981), which appeared to hold that only an application that could have become a patent on the day that it was filed can constitute prior art against another application or patent. See 157 Cong. Rec. S.1369-70 (Mar. 8, 2011). The Office has previously indicated that the reasoning of In re Wertheim, 646 F.2d 527 (CCPA 1981), did not survive the amendment to 35 U.S.C. 102(e) in the American Inventors Protection Act. See, e.g., Ex parte Yamaguchi, 88 U.S.P.Q.2d 1606 (Bd. Pat. App. & Inter. 2008). In In re Giacomini, 612 F.3d 1380 (Fed. Cir. 2010), the U.S. Court of Appeals for the Federal Circuit (Federal Circuit) held that a patent was effective as prior art as of the filing date of a provisional application claimed under 35 U.S.C. 119(e).

⁴⁵ In In re Hilmer, 359 F.2d 859, 149 USPQ 480 (CCPA 1966), the CCPA held that reliance on the foreign priority date of a reference applied in a rejection under pre-AIA 35 U.S.C. 102(e) was improper.

⁴⁶ When examining an application to which the changes in 35 U.S.C. 102 and 103 do not apply, Office personnel will continue to apply the Hilmer doctrine, and foreign priority dates may not be used in determining 35 U.S.C.102(e) prior art dates. Note that the international filing date of a PCT application may be the 35 U.S.C.102(e) prior art date under pre-AIA law under certain circumstances. See MPEP § 706.02(f.).

⁴⁷ In re Facius, 408 F.2d 1396, 1407 (CCPA 1969).

⁴⁸ Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1577 (Fed. Cir. 1997).

⁴⁹ 35 U.S.C. 102(b)(2)(B).

⁵⁰ MPEP § 804.03 (prior art disqualified under the CREATE Act may be the basis for a double patenting rejection).

⁵¹ MPEP § 2124 (publications after the critical date may be used to show factual evidence that, as of an application's filing date, undue experimentation would have been required to make or use the invention, that a parameter absent from the claims was or was not critical, that a statement in the specification was inaccurate, that the invention was inoperative or lacked utility, that a claim was indefinite, or that characteristics of prior art products were known).

⁵² 35 U.S.C. 102(c)(1).

⁵³ 35 U.S.C. 100(h).

⁵⁴ 35 U.S.C. 102(c)(2).

⁵⁵ 35 U.S.C. 102(c)(3).

⁵⁶ Pub. L. 108-453, 118 Stat. 3596 (2004)), which was an amendment to pre-AIA 35 U.S.C. 103(c).

Congress has made it clear that the intent of AIA 35 U.S.C. 102(c) is to continue the promotion of joint research activities that was begun under the CREATE Act, stating in section 3(b) of the AIA that “The United States Patent and Trademark Office shall administer section 102(c) of title 35, United States Code, in a manner consistent with the legislative history of the CREATE Act that was relevant to its administration by the United States Patent and Trademark Office.” See 125 STAT. at 287.

⁵⁷ MPEP § 2137.01.

⁵⁸ As discussed in end note 1, 35 U.S.C. 101 provides that: “[w]hoever invents or discovers . . . , may obtain a patent therefor, subject to the conditions and requirements of this title.”

⁵⁹ 35 U.S.C. 103 provides that: A patent for a claimed invention may not be obtained, notwithstanding that the claimed invention is not identically disclosed as set forth in section 102, if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which

the claimed invention pertains. Patentability shall not be negated by the manner in which the invention was made.

⁶⁰ As pointed out by the Federal Circuit, “[t]he term ‘claims’ has been used in patent legislation since the Patent Act of 1836 to define the invention that an applicant believes is patentable.” Hoechst-Roussel Pharmaceuticals, Inc. v. Lehman, 109 F.3d 756, 758 (Fed. Cir. 1997) (citing Act of July 4, 1836, ch. 357, § 6, 5 Stat. 117). Furthermore, in Graham v. John Deere, 383 U.S. 1 (1966), the second of the Supreme Court’s factual inquiries (the “Graham factors”) is that the “differences between the prior art and the claims at issue are to be ascertained.” Graham, 383 U.S. at 17. Thus, in interpreting 35 U.S.C. 103 as enacted in the 1952 Patent Act – language that remained unchanged until enactment of the AIA – the Court equated “the subject matter sought to be patented” with the claims.

⁶¹ As stated in MPEP § 706.02(n), in view of the Federal Circuit’s decisions in In re Ochiai, 71 F.3d 1565 (Fed. Cir. 1995) and In re Brouwer, 77 F.3d 422 (Fed. Cir. 1996), the need to invoke pre-AIA 103(b) rarely arose. Those cases continue to retain their vitality under the AIA.

⁶² Hazeltine Research, Inc. v. Brenner, 382 U.S. 252 (1965) (a previously filed patent application to another pending in the Office, but not patented or published, at the time an application is filed constitutes part of the “prior art” within the meaning of 35 U.S.C. 103).

⁶³ This is in accordance with pre-AIA case law indicating that in making determinations under 35 U.S.C. 103, “it must be known whether a patent or publication is in prior art under 35 U.S.C. 102.” Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1568 (Fed. Cir. 1987). However, while a disclosure must enable those skilled in the art to make the invention in order to anticipate under 35 U.S.C. 102, a non-enabling disclosure is prior art for all it teaches for purposes of determining obviousness under 35 U.S.C. 103. Symbol Techs. Inc. v. Opticon Inc., 935 F.2d 1569, 1578 (Fed. Cir. 1991); Beckman Instruments v. LKB Produkter AB, 892 F.2d 1547, 1551 (Fed. Cir. 1989).