



# AMERICA INVENTS ACT

## IMPLEMENTATION

# Welcome

## First-Inventor-to-File Roundtable

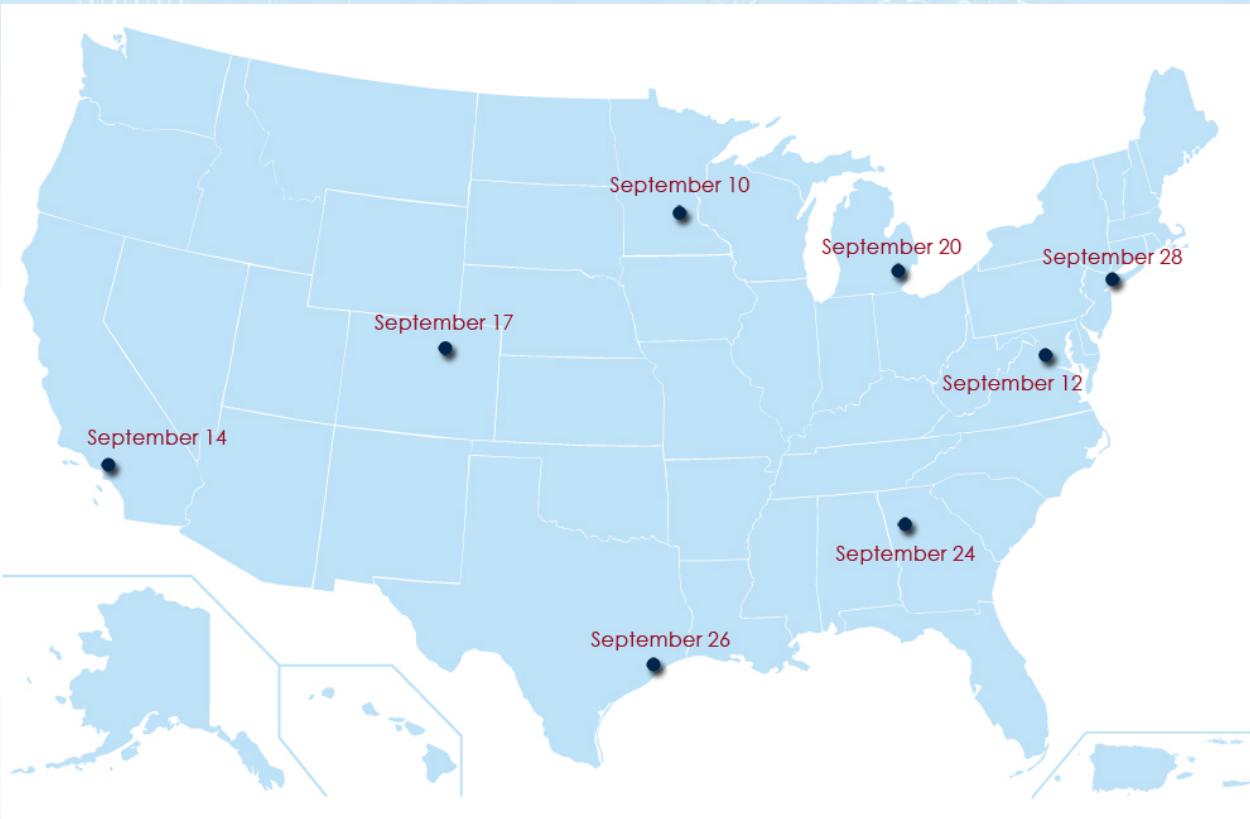
September 6, 2012

# Agenda

Time	Topic
1:30 PM	Opening Remarks: David Kappos, Under Secretary and USPTO Director
1:40 PM	USPTO Presentation on First-Inventor-to-File Proposed Rules and Examination Guidelines: Mary Till, Senior Legal Advisor, Office of Patent Legal Administration
2:10 PM	<p>Pre-Scheduled Commentary</p> <p>2:10 PM Robert Armitage, for American Bar Association, Intellectual Property Law Section</p> <p>2:20 PM Q. Todd Dickinson, Executive Director, American Intellectual Property Law Association</p> <p>2:30 PM Herb Wamsley, Executive Director, Intellectual Property Owners Association</p> <p>2:40 PM Mark Reyland, Executive Director, United Inventors Association</p> <p>2:50 PM John Vaughn, Executive Vice President, Association of American Universities</p> <p>3:00 PM Tom Filarski, for Licensing Executives Society</p> <p>3:10 PM Soonhee Jang, Vice President and Chief IP Counsel, DuPont Industrial BioSciences</p> <p>3:20 PM Peter Thurlow, Partner, for New York Intellectual Property Law Association</p> <p>3:30 PM Courtenay Brinkerhoff, Partner, Foley &amp; Lardner</p> <p>3:40 PM Brad Pedersen, for Minnesota Intellectual Property Law Association</p> <p>3:50 PM Kevin Greenleaf, Attorney, Schwegman, Lundberg &amp; Woessner, P.A.</p> <p>4:00 PM Tom Kowalski, Shareholder, Vedder Price, P.C.</p>
	Unscheduled Commentary and Questions/Answers
	Closing Remarks



# Roadshows



Date	Location
Monday, Sept 10	Minneapolis, MN
Wednesday, Sept 12	Alexandria, VA
Friday, Sept 14	Los Angeles, CA
Monday, Sept 17	Denver, CO
Thursday, Sept 20	Detroit, MI
Monday, Sept 24	Atlanta, GA
Wednesday, Sept 26	Houston, TX
Friday, Sept 28	New York, NY



# AMERICA INVENTS ACT

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# Introductory Remarks

**Director David Kappos**



# **AMERICA INVENTS ACT**

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

**Mary Till**  
**Senior Legal Advisor**  
**Office of Patent Legal Administration**

# Goals

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



# Date

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



# Framework

## Prior Art

## Exceptions

102(a)(1)

102(b)(1)(A)-Grace Period Inventor Disclosures &  
-Grace Period Non-inventor Disclosures

102(b)(1)(B)-Grace Period Intervening Disclosures

102(a)(2)

102(b)(2)(A)-Non-inventor Disclosures

102(b)(2)(B)-Intervening Disclosures

102(b)(2)(C)-Commonly Owned Disclosures





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

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



# Sales

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



9/8/2012

**AMERICA INVENTS ACT**  
IMPLEMENTATION

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

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



# Grace Period Inventor and Non-inventor Disclosure Exception

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



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

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

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



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

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

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



# Grace Period Intervening Disclosure Exception

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



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

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

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





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

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



# Effective Prior Art Date: Definition

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



# Non-inventor Disclosure Exception

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



# Intervening Disclosures Exception

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



# Commonly Owned Disclosure Exception

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



# Joint Research Agreements

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



# Applicability of AIA's Prior Art Provisions

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



# Applicability of Pre-AIA's Prior Art Provisions

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





# Example 4: AIA's Prior Art Provisions Apply

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

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



# Proposed Rule: Affidavits or Declarations

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



# Proposed Rule: Certified Copy Requirement

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



# Proposed Rule: Required Statements

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



# Proposed Rule: Required Statements (cont.)

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



# Proposed Rule: Required Statements Timing

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



# Appendix

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





# AMERICA INVENTS ACT

## IMPLEMENTATION

# First-Inventor-to-File Roundtable





# AMERICAN INVENTS ACT

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# American Bar Association, Intellectual Property Law Section

**Robert Armitage**



# First-Inventor-to-File Roundtable

Alexandria, Virginia

September 6, 2012

1:30 p.m. – 4:30 p.m. EST

## USPTO Guidelines for Implementation

Robert A. Armitage  
Immediate Past Chair



# **A Section White Paper: Agenda for 21<sup>st</sup> Century Patent Reform**

- Adopt The First-Inventor-To-File Principle
- Define Prior Art Through “Best Practices”

**Revised September 2010**

The views expressed herein are on behalf of the American Bar Association Section of Intellectual Property Law. Except as expressly noted, they have not been approved by the House of Delegates or the Board of Governors of the American Bar Association and should not be construed as representing the policy of the American Bar Association.

# “Best practices” means eliminating all “loss of right to patent” provisions...

Adopt the first-inventor-to-file principle as part of U.S. patent law. Do so by maintaining the traditional inventor-focused features of U.S. patent law. These include the inventor’s one-year “grace period” and protections against so-called “self-collision.” A consensus now exists among U.S.-based NGOs on this once controversial issue. Moreover, it appears a compelling starting point from which to construct a coordinated set of patent reform proposals. It will result in increased productivity in the examination of applications for patent, which is urgently needed as pendency of applications for patent continues to rise, given the constrained resources of the United States Patent and Trademark Office (“PTO”). It will facilitate opening a limited term post-grant window during which patent oppositions may be filed and help assure that a post-grant opposition can address all issues of patent validity. It also will reduce the costs of *and increase the number of patents awarded to* independent inventors. The most recent data available suggests they are experiencing an accelerating loss in patents as a result of treaty-mandated changes to U.S. patent law made in 1994. Thus, this change will serve the patent system and its various constituencies well. It also will further efforts aimed at greater international patent harmonization.

Enact the consensus “best practices” for implementing a first-inventor-to-file system. These “best practices” – developed in the patent harmonization context – include eliminating certain “loss of right” conditions for patentability that will be rendered unnecessary. In this regard we refer to the 2001 statements of U.S.-based NGOs (National Association of Manufacturers, Biotechnology Industry Association, Intellectual Property Owners Association, and the American Intellectual Property Law Association) developed in the context of “best practices” for international patent harmonization. The ABA IPL Section endorses these same “best practices” in the context of a first-to-file system. Their enactment into domestic law should clarify through unmistakable statutory language and clear legislative history that all publicly accessible knowledge of an invention, whether express or inherent, would remain prior art and would continue to include use, sale, offers for sale or other disclosures resulting in public accessibility.

# Simpler, less subjective, more efficient, more accurate, more complete...

Many of these reforms – first-inventor-to-file, “best practices” prior art reforms, and facilitating the increased applicant responsibility initiative – will make the work of the United States Patent and Trademark Office simpler, more efficient, and more accurate and complete. Less will be left to the courts to resolve.

Other reforms are aimed at driving down the costs of enforcing patents. These reforms remove almost all subjective factors from patent litigation – factors that complicate life and drive up costs for both the patent owners and accused infringers. As recommended by the National Research Council, the “best mode,” “inequitable conduct,” and “willful infringement” issues would disappear from most patent litigation.

While patents are inventors’ property rights that should and must command respect, still other reforms are aimed at preventing that respect from rising to the level of intimidation – forcing accused infringers to pay tribute to questionable patents rather than have a rational business case for taking a questionable patent back to the United States Patent and Trademark Office or into the courts to challenge its validity or infringement. The creation of a post-grant opposition proceeding and scaling back on willfulness allegations are targeted to work effectively to this end.

With so many areas where the patent system must perform better to meet the rising expectations for all the constituencies that it serves, a convincing case now exists for moving ahead in a coordinated fashion with all the reforms that are outlined above.

# IPL Section Resolution TF-2— *Objectively-Based Prior Art Definition*

**Strong,  
Consistent  
Reform  
Supporter**

RESOLVED, that the Section supports, in principle, in enacting first-inventor-to-file reforms, an objectively based definition of prior art and conditions for patentability, including provisions that continue to afford inventors a 1-year grace period in which to file an application for patent and that prevent certain prior-filed patent applications by the same or related persons from being used as patent-defeating prior art; and

**Part of  
AIPLA, IPO,  
BIO, & NAM  
Consensus**

# IPL Section Resolution TF-2:

## *Eliminate Archaic Features of Law*

SPECIFICALLY, the Section favors legislation in this context that would—

- (a) eliminate from U.S. patent law provisions relating to—
  - (1) abandonment as set forth in 35 U.S.C. § 102(c) as a basis for a loss of right to patent;
  - (2) premature foreign patenting as set forth in 35 U.S.C. § 102(d) as an element of prior art or a basis for a loss of right to patent;
  - (3) an inventor's forfeiture of his or her right to patent an invention once placed "in public use or on sale" as set forth in 35 U.S.C. § 102(b) by providing that no such loss of right to patent an invention can arise unless the invention had become reasonably and effectively accessible to persons of ordinary skill in the art more than one year before the inventor sought a patent for the invention;
  - (4) prior art as set forth in 35 U.S.C. § 102(f), under which non-public knowledge of the inventor, not otherwise qualifying as prior art, can render an invention made by such inventor obvious, by:
    - (A) repealing section 102(f) and
    - (B) codifying elsewhere in Title 35, United States Code, that the right to seek and obtain a patent is solely the right of the individual or individuals who made the invention for which a patent is sought (or, where applicable, the assignee of such inventor);
  - (5) the provisions currently in 35 U.S.C. § 102(g) providing that "secret prior art" (and/or loss of right to patent) can exist as from the date an invention of another inventor was made;
  - (6) the provisions currently in 35 U.S.C. §§ 102(a), (e), and (g) that permit the inventor to rely upon proofs of dates of invention in order to eliminate as prior art to an invention subject matter that would otherwise represent prior art relative to the effective filing date for the invention;
  - (7) the geographic restrictions on prior art currently in 35 U.S.C. §§ 102(a) and (b) that require proofs of knowledge or use in the United States;
  - (8) the English language requirement currently in 35 U.S.C. § 102(e), relating to published international applications for patent that can qualify as prior art as of their respective filing dates; and

# IPL Section Resolution TF-2:

## *Eliminate Archaic Features of Law*

SPECIFICALLY, the Section favors legislation in this context that would—

(a) eliminate from U.S. patent law provisions relating to—

**Eliminate §102(c) abandonment bar.**

basis for a loss of right to patent; C. § 102(d) as an element of prior art

(3) an invention that has been described in print “in public use or on sale” as set forth in § 102(b) to patent an invention that is not obvious to persons of ordinary skill in the art at the time of the invention:

**Eliminate §102(d) foreign patenting bar .**

**Eliminate §102(c) forfeiture bar.**

ordinary skill in the art at the time of the invention; (4) prior art of an inventor, not otherwise described in § 102(b), that is not obvious to persons of ordinary skill in the art at the time of the invention:

**Eliminate §102(f) Oddzon prior art.**

(A) repealing section 102(f) and (B) codifying elsewhere in Title 35, United States Code, that the right to seek and obtain a patent is solely the right of the individual or individuals who made the invention for which a patent is sought (or, where applicable, the assignee of such inventor);

(A) repealing section 102(f) and

(B) codifying elsewhere in Title 35, United States Code, that the right to seek and obtain a patent is solely the right of the individual or individuals who made the invention for which a patent is sought (or, where applicable, the assignee of such inventor);

**Eliminate §102(g) prior invention prior art.**

(5) the provisions currently in 35 U.S.C. §§ 102(a), (e), and (g) that permit the inventor to rely upon proofs of dates of invention in order to eliminate as prior art to an invention subject matter that would otherwise represent prior art relative to the effective filing date for the invention:

(6) the provisions currently in 35 U.S.C. §§ 102(a), (e), and (g) that permit the inventor to rely upon proofs of dates of invention in order to eliminate as prior art to an invention subject matter that would otherwise represent prior art relative to the effective filing date for the invention;

(7) the geographic restrictions currently in 35 U.S.C. §§ 102(a)-(b) that require proofs of knowledge or use in the United States or in a foreign country that

**Eliminate §§102(a)-(b) geographic restrictions.**

(8) the English language requirement currently in 35 U.S.C. § 102(e), relating to published international applications for patent that can qualify as prior art as of their respective filing dates; and



# IPL Section Resolution TF-2: *Public accessibility touchstone for prior art*

(b) provide a definition of prior art, to be used for both novelty and non-obviousness determinations, stating that a patent for a claimed invention may not be obtained if—

(1) the claimed invention was patented, described in a printed publication, or otherwise publicly known—

(A) more than one year before the effective filing date of the claimed invention or

(B) before the effective filing date of the claimed invention other than through disclosures made by the inventor or a joint inventor or by others who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor, or

(2) the claimed invention was described in an issued patent or in an application for patent published as provided in 35 U.S.C. § 122 or 35 U.S.C. § 374, in which the application or the patent names another inventor and was effectively filed before the effective filing date of the claimed invention; and

(3) subject matter would be regarded as publicly known for the purposes qualifying as prior art only when it becomes reasonably and effectively accessible, either through its use or through its disclosure by other means where:

(A) reasonable accessibility requires that the subject matter can be accessed by persons of ordinary skill in the art to which the subject matter pertains without resort to undue efforts and

(B) effective accessibility requires that its content can be comprehended by persons of ordinary skill in the art to which the subject matter pertains without resort to undue efforts; and

# IPL Section Resolution TF-2: *Public accessibility touchstone for prior art*

(b) provide a definition of prior art, to be used for both novelty and non-obviousness determinations, stating that a patent for a claimed invention may not be obtained if—

(1) the claimed invention was patented, described in a printed publication, or otherwise publicly known—

(A) **§102(a)(1) prior art must be publicly known.** invention or  
(B) before the effective filing date of the claimed invention other than through disclosures made by the inventor or a joint inventor or by others who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor, or

(2) the claimed invention was described in an issued patent or in an application for patent, in which the application or the patent names the inventor or joint inventor, or the applicant, as the inventor or joint inventor, or the applicant, on or after the filing date of the claimed invention; and

(3) subject matter would be regarded as publicly known for the purposes qualifying as prior art only when it becomes reasonably and effectively accessible, either through its use or through its disclosure by other means where;

(A) reasonable accessibility requires that the subject matter can be accessed by persons of ordinary skill in the art to which the subject matter pertains without resort to undue efforts and

(B) effective accessibility requires that its content can be comprehended by persons of ordinary skill in the art to which the subject matter pertains without resort to undue efforts; and

**Availability to the public = public accessibility.**

**Hilmer doctrine becomes moot.**

# Summary of ABA IPL Section Positions From TF-2

- The Section supports a 1-year grace period in which §102(a) prior art disclosures and §102(b) exceptions thereto operate coextensively with respect to the acts and actions of the inventor, coworkers, and collaborators.
- The former reach of the “in public use” and “on sale” provisions in pre-AIA §102(b) is inoperative under post-AIA law to the extent of acts and activities that are not publicly accessible – that is, are not available to the public.



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# United Inventors Association

**Mark Reyland**



**The United Inventors Association of America**  
**A Nonprofit Educational Foundation**

Dedicated to the development of free educational tools  
that help inventors understand the inventing and  
commercialization processes

USPTO First Inventor to File Roundtable  
September 6<sup>th</sup> 1012

## **A Shared Responsibility.....**

The responsibility to file an application for patent protection in a TIMELY manner is now that of the inventor

The responsibility for ensuring the person filing that application is that of the Federal Government



USPTO First Inventor to File Roundtable  
September 6<sup>th</sup> 1012

## § 1.63 Oath or declaration

“State that the person making the oath or declaration believes the named inventor or inventors to be the original and first inventor or inventors of the subject matter which is claimed and for which a patent is sought.”





## Options for Consideration?

- The requirement to show an inventor's notebook prior to filing an application?
- A stronger Oath?
- A notarized abstract of the invention process?
- A note from your Mother?





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# DuPont Industrial BioSciences

**Soonhee Jang**



# **Comments on Proposed Rules – First Inventor to File under the AIA**

**Soonhee Jang**

**First-Inventor-to-File Roundtable  
Madison North Auditorium Alexandria, Virginia  
September 6, 2012**

## COMMENTS – PRIOR ART

### Does secret commercialization constitute “on sale”?

- *Does public availability play a role in the “on sale” prior art defined in 35 U.S.C. 102(a)(1) under AIA?*
  - At issue in *Metallizing Engineering* was the secret commercialization of a process that produced a product sold into the stream of commerce
  - *Metallizing Engineering* does not touch the issue involving a secret sale of a product per se
  - There is a divergence of opinion as to whether it was the intent of Congress to overturn the forfeiture doctrine established in *Metallizing Engineering*
  - The statute states: “the claimed invention was patented, described in a printed publication, **or in public use, on sale or otherwise available to the public.**” On sale is part of the larger phrase “OR in public use, on sale or otherwise ...” -- secret sales or secret use not prior art.
  - If it is treated as prior art under AIA 102 (a)(1), the patentability bar would be applied to any independent third party

## COMMENTS - GRACE PERIOD DISCLOSURE PROVIDED IN SPECIFICATION

### *Prior Art Exception Under 102(b)(1)(A) to 102(a)(1) - Disclosures by Inventors*

- Proposed Guideline: A statement that a grace period disclosure is by the inventor(s), and will not be considered prior art, when it is apparent that the grace period disclosure is by the inventor(s), **i.e. does not name any other persons/authors or contains other information to the contrary.**
- The proposed guideline applies “apparent” standard and puts burden on the applicants to prove when it is not “apparent”
- Most disclosures (papers, posters, presentations) of the subject matter often contain other individuals (more authors than inventors) who contributed to the work, but were not inventors in the endeavor, such as technicians and assistants
- The guideline should allow for these types of grace period disclosures to be described in the specification as well as those that are apparent in lieu of filing an affidavit or declaration to establish that a disclosure is not prior art

# COMMENTS - INDEPENDANT DISCLOSURE AFTER INVENTOR DISCLOSURE

- The proposed guidelines state:
- *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”*
  - “Same” is not used in the statute
- *Even if the only differences between the subject matter in the prior art disclosure ... and the subject matter publicly disclosed by the inventor ... are mere insubstantial changes, or only trivial or obvious variations, the exception ... does not apply.*
- A independent disclosure not related to the inventor in all likelihood will not be the “same” as described in the inventor disclosure
- The guidelines as written requiring disclosures to be the “same” will result in the exception hardly applying to an independent disclosure
- Similarly for the exception in 35 U.S.C. 102(b)(2)(B) as well
- Should not have a bright-line “same” requirement; a case by case evaluation.

## COMMENTS – AFFIDAVIT PRACTICE

- Generally recommend to minimize requirements for filing Affidavits or Declarations
- **§ 1.55 and § 1.78 under AIA require applicants to make a statement ...**“upon reasonable belief, this application contains at least one claim that has an effective filing date on or after March 16, 2013”. There is a similar requirement for added subject matter.
- The determination should be made by the Examiner rather than requiring an applicant to make a statement whether the application contains at least one claim that has an effective filing date on or after March 16, 2013.
- The Rule should provide for a mechanism to rebut or petition an amended claim found by an Examiner to be no longer entitled to the claimed earlier priority. Such a mechanism may be, for example, requiring the Examiner to reject the claim on new matter/priority grounds without entering the amendment, and/or making such a rejection a petitionable one.





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# AMERICA INVENTS ACT

## IMPLEMENTATION

# First-Inventor-to-File Roundtable



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# New York Intellectual Property Law Association

**Peter Thurlow**

# AIA: First-Inventor-to-File Roundtable At USPTO, September 6, 2012

Peter G. Thurlow  
Partner, Jones Day  
New York Intellectual Property Law Association

## “§ 102. Conditions for patentability; novelty

“(a) NOVELTY; PRIOR ART.—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

## “§ 102. Conditions for patentability; novelty

- ▶ “(b) EXCEPTIONS.—
- ▶ “(1) DISCLOSURES MADE 1 YEAR OR LESS BEFORE THE EFFECTIVE FILING DATE OF THE CLAIMED INVENTION.—A disclosure made 1 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—
- ▶ “(A) 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
- ▶ “(B) 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.

## “§ 102. Conditions for patentability; novelty

- ▶ “(2) DISCLOSURES APPEARING IN APPLICATIONS AND PATENTS.— A disclosure shall not be prior art to a claimed invention under subsection (a)(2) if—
- ▶ “(A) the subject matter disclosed was obtained directly or indirectly from the inventor or a joint inventor;
- ▶ “(B) 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
- ▶ “(C) 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.

## Purpose: First-to-File Rules

- ▶ (1) Converts the United States patent system from a “first to invent” system to a “first inventor to file” system;
- ▶ (2) Treats 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;
- ▶ (3) Eliminates the requirement that a prior public use or sale be “in this country” to be a prior art activity; and
- ▶ (4) Treats commonly owned or joint research agreement patents and patent application publications as being by the same inventive entity for purposes of 35 U.S.C. 102, as well as 35 U.S.C. 103.



## Proposed First-to-File Rules: Comments:

- ▶ 1) Eliminate the requirement that a certified copy of the foreign application be filed within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior foreign application.
- ▶ 2) Expand Priority Document Exchange program – countries participating in this program include the JPO, KPO, and EPO.
- ▶ 3) Require “statement” only when “new subject matter” is added to an application, rather than changes to a specification that are only made to place the application in a form common to U.S. practice – (If a nonprovisional application filed on or after March 16, 2013, claims the benefit of the filing date of a foreign application filed prior to March 16, 2013, does not contain a claim to a claimed invention that has an effective filing date on or after March 16, 2013, but discloses subject matter not also disclosed in the foreign application, the applicant must provide a statement to that effect within the later of four months from the actual filing date of the later-filed application, ... or sixteen months from the filing date of the prior foreign application.

## Proposed First-to-File Rules: Comments:

- ▶ 4) Review definition of “Inventorship” in AIA – The term “inventor” or inventorship as used in this chapter means the individual or, if a joint invention, the individuals collectively who invented or discovered the *subject matter* of the invention.
- ▶ Compare to the term “claimed invention” means the subject matter defined by a claim in a patent or an application for a patent.”

## Practice Tips

- ▶ Increase in Patent Application Filings on or before March 15, 2013?

First, the world of prior art that can be used to reject a pre-FTF application is smaller than a later filing. In addition, public use and on sale activity outside the United States are not counted as prior art.

Second, you can "swear behind" certain prior art in a pre-FTF application, but you lose that ability for filings after March 16, 2013.

Third, a pre-FTF application will not be subject to a post grant review proceeding.

- ▶ Conception still important? Yes, due to derivation proceedings.



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**Foley & Lardner LLP**

**Courtenay Brinckerhoff**



Comments:  
USPTO  
First-Inventor-To-  
File Roundtable  
September 6, 2012



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 **FOLEY**  
FOLEY & LARDNER LLP

# Disclaimer



My comments today do not necessarily reflect the views of Foley & Lardner LLP or its clients.

# New 102(b) and Proposed Rule 130



- The statute outlines exceptions for certain disclosures made one year or less before the effective filing date and for certain disclosures contained in earlier filed, later published U.S. patent applications.
- New Rule 130 outlines requirements for invoking the exceptions, some of which appear to go beyond the statutory requirements.
  - Inventorship
  - Communication of an enabling disclosure
  - No trivial differences between disclosures



# New 35 U.S.C. § 102(b)(1)



Disclosures made 1 year or less before the effective filing date [are not prior art] if—

(A) the disclosure was made by the inventor ... or by another who obtained the subject matter disclosed directly or indirectly from the inventor

# Proposed Rule 130(b)



## Proposed Rule 130(b)

- the affidavit or declaration ... must provide a satisfactory showing that the inventor or a joint inventor is in fact the inventor of the subject matter of the disclosure.

## Guidelines:

- The Rule 130 Declaration should establish that the disclosure at issue
  - was made one year or less before the effective filing date of the claimed invention; and
  - had been publicly disclosed by the inventor/ joint inventor.
- if the disclosure names authors who are not inventors, the applicant can provide an “unequivocal” statement from the inventor(s) that he/she/they “invented the subject matter of the disclosure,” together with “a reasonable explanation of the presence of additional authors.”  
(similar to current practice under MPEP § 2132.01)

# New 35 U.S.C. § 102(b)(1)



Disclosures made 1 year or less before the effective filing date [are not prior art] if—

(A) the disclosure was made by the inventor ... or by another who obtained the subject matter disclosed directly or indirectly from the inventor

# Proposed Rule 130(d)



## Proposed Rule 130(d)

- an affidavit or declaration ... must provide a satisfactory showing that the inventor or a joint inventor is the inventor of the subject matter of the disclosure and directly or indirectly communicated the subject matter of the disclosure to the party.

## Guidelines

- The Rule 130 Declaration should establish that:
  - the inventor/joint inventor is the inventor of the subject matter of the disclosure;
  - the inventor/joint inventor communicated the subject matter to another who disclosed it; and
  - the communication was sufficient to enable one of ordinary skill in the art to make the subject matter of the claimed invention.

# New 35 U.S.C. § 102(b)(1)



Disclosures made 1 year or less before the effective filing date [are not prior art] if—

(B) **the subject matter disclosed had**, before such disclosure, **been publicly disclosed by the inventor** ... or another who obtained the subject matter disclosed directly or indirectly from the inventor ...

# Proposed Rule 130(c)



## Proposed Rule 130(c)

- the affidavit or declaration ... must identify and provide the date of the earlier disclosure ... by the inventor ... and provide a satisfactory showing that the inventor ... is the inventor of the subject matter of the earlier disclosure. ...

## Guidelines

- The Rule 130 Declaration should establish:
  - that the inventor/joint inventor is the inventor of the subject matter of the earlier public disclosure;
  - that there was a communication of the subject matter to another who publicly disclosed it; and
  - the date and content of the earlier public disclosure.

# New 35 U.S.C. § 102(b)(1)



Disclosures made 1 year or less before the effective filing date [are not prior art] if—

(B) **the subject matter disclosed had**, before such disclosure, **been publicly disclosed by** inventor ... or **another who obtained the subject matter disclosed directly or indirectly from the inventor ...**

# Proposed Rule 130(e)



## Proposed Rule 130(e)

- an affidavit or declaration ... must identify and provide the date of the earlier disclosure ... by the party who obtained the subject matter disclosed directly or indirectly from the inventor ... and also provide a satisfactory showing that the inventor ... is the inventor of the subject matter of the earlier disclosure and directly or indirectly communicated the subject matter of the disclosure to the party. ...

## Guidelines

- The Rule 130 Declaration should 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/joint inventor before the cited disclosure;
  - that the inventor/ joint inventor is the inventor of the subject matter of the cited disclosure;
  - a communication of the subject matter to another who disclosed the subject matter;
  - the date and content of the shielding disclosure



# Guidelines



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 \* \* \* .” 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.

# New 35 U.S.C. § 102(b)(2)



(2) DISCLOSURES APPEARING IN APPLICATIONS AND PATENTS.—A disclosure shall not be prior art to a claimed invention under subsection (a)(2) if—

- (A) the subject matter disclosed was obtained directly or indirectly from the inventor or a joint inventor;
- (B) 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...

# Proposed Rule 130(f)



(f) ... The Office may require the applicant to file a petition for a derivation proceeding pursuant to Sec. 42.401 et seq. of this title if the rejection is based upon a U.S. patent or U.S. patent application publication of a patented or pending application naming another inventor and the patent or pending application claims an invention that is the same or substantially the same as the applicant's claimed invention.

# Derivation Requirements



- derivation fee (proposed at \$400)
- petition must be filed within one year after the first publication of a claim to an invention that is the same or substantially the same as the earlier application's claim to the allegedly derived invention
- showing that petitioner has at least one claim that is (i) the same or substantially the same as the respondent's claimed invention; and (ii) not patentably distinct from the invention disclosed to the respondent
- demonstration that invention was derived from an inventor named in the petitioner's application and, without authorization, the earliest application claiming such invention was filed.
- submission of substantial evidence, including at least one affidavit addressing communication of the derived invention and lack of authorization that, if un rebutted, would support a determination of derivation. The showing of communication must be corroborated.

# Thank you!



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# AMERICA INVENTS ACT

## IMPLEMENTATION

# First-Inventor-to-File Roundtable



# AMERICA INVENTS ACT

## IMPLEMENTATION

# Minnesota Intellectual Property Law Association

**Brad Pedersen**

# AIA FIRST-INVENTOR-TO-FILE

*Proposed Rules and Guidelines  
published July 26, 2012*

**Presentation for USPTO Roundtable**

Brad D. Pedersen  
for the

Minnesota Intellectual Property Law Association (MIPLA)

September 6, 2012



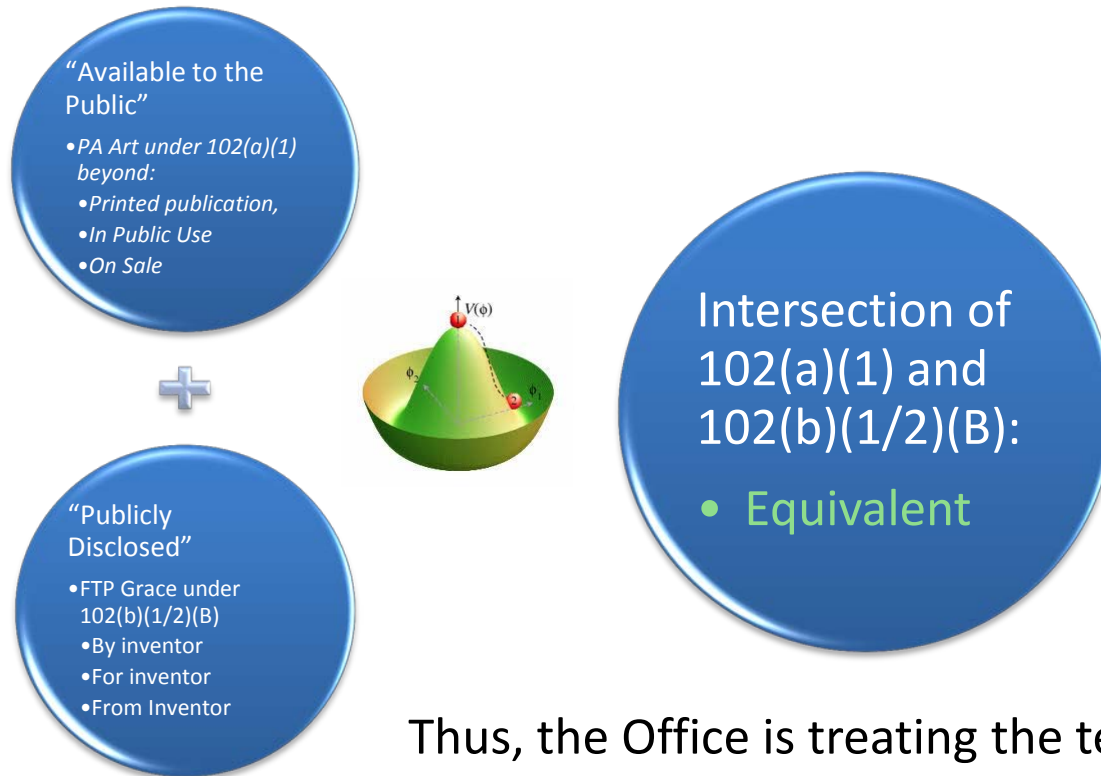
## Main Comments on Proposed Rules/Guidelines

- **Proposals “Get it Right” by balancing the Office’s *prima facie* burden with incentives for Early Identification of Priority and Exceptions Claims**
- **Proposals “Get it Right” by Assuming Symmetry between what is 102(a) Publicly Available vs. 102(b) Publicly Disclosed**
- **Proposals “Get it Wrong” by Creating an Asymmetry in FTP Exceptions between Inventor – subpara. (A) – and 3<sup>rd</sup> Party –subpara. (B)**

## Striking a Balance for Encouraging Applicants To Assert Priority/Exceptions Early

- Office affirms that it has the *prima facie* burden
- Presumptions/penalties on proving entitlement are the right incentives to encourage early assertion of these issues
- Office should consider whether 4 months is the right time period for all situations:
  - cases that involve missing parts or
  - if the Office adopts a “Track 3” option

# Symmetry Between What is Publicly Available Prior Art & What Triggers FTP Grace Exceptions is a Good Thing



Thus, the Office is treating the term “disclosure” [as used in 35 U.S.C. 102(b)] as a generic expression intended to encompass the documents and activities enumerated in 35 U.S.C. 102(a).

*Fed. Reg. Vol. 77, No. 144, pp. 43763-74.*

## Office Should Provide Further Guidance On What is “Otherwise Publicly Available”

- Agree that private “offers for sale” should not qualify
- MIPLA is still considering the “on sale” question
- Office should consider more guidance on
  - the “permanence” issue in terms of online materials
  - the “economic” issue in terms of high priced materials

## Key Concern – Asymmetry in the FTP Exceptions

- Asymmetry is Wrong both as a matter of:
  - Policy
  - Practicality
- Cuts against AIA policy of encouraging early disclosure of new inventions
- Places unneeded burdens on both Applicants and Examiners
  - Applicants have to preserve and resort to derivation under subpara. (A)
  - Examiners have to learn and apply a new standard
  - Office may be overwhelmed with derivation petitions

# Narrow vs. Broad Construction for 3<sup>rd</sup> Party FTP Grace:

## What Is Scope Triggered for subpara. (B) Exceptions?

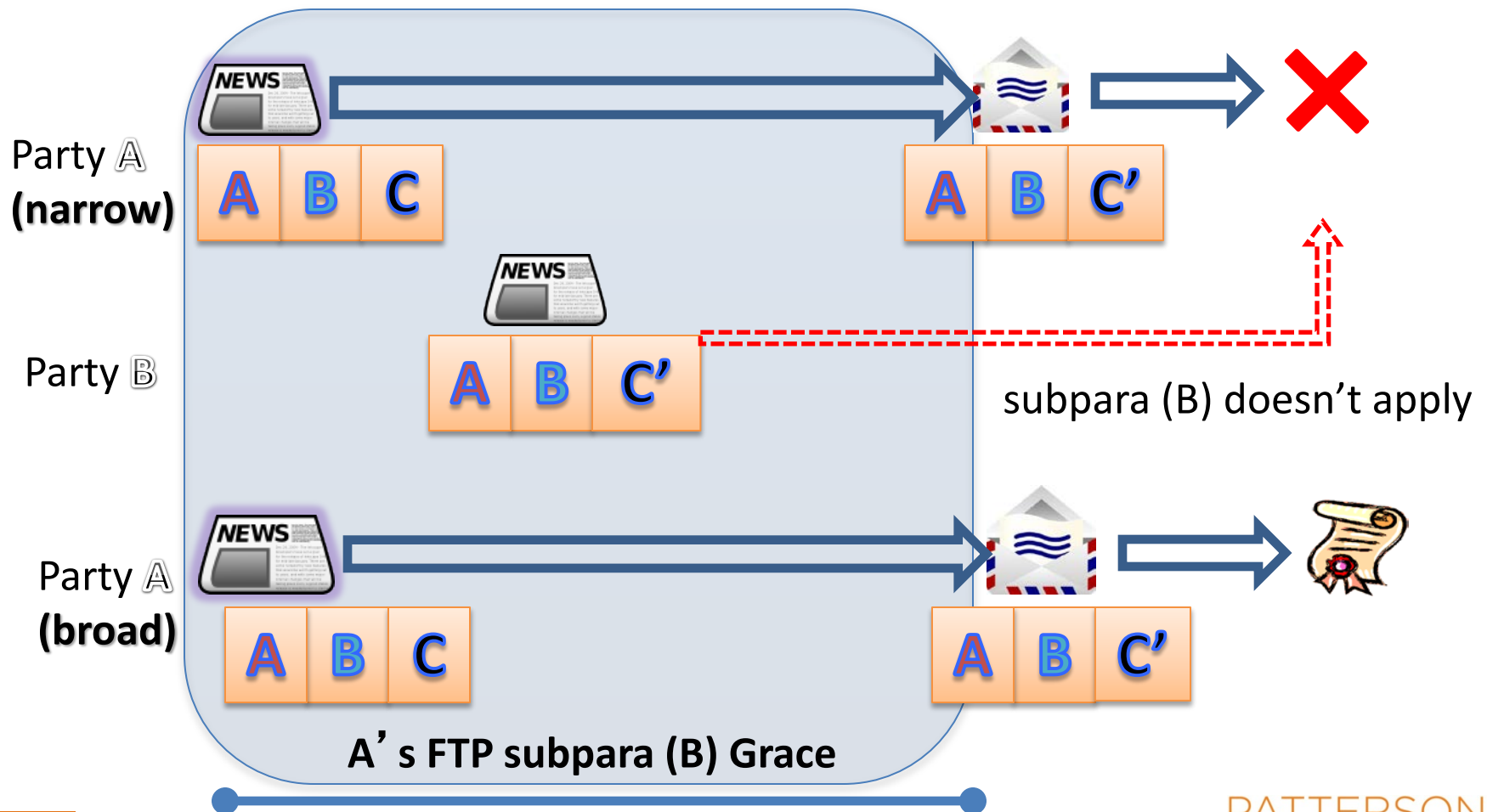
Even if the only differences between the subject matter in the prior art disclosure that is relied upon under 35 U.S.C. 102(a) and the subject matter publicly disclosed by the inventor before such prior art disclosure are mere insubstantial changes, or only trivial or obvious variations, the exception under 35 U.S.C. 102(b)(1)(B) does not apply.

*Fed. Reg. Vol. 77, No. 144, pp. 43767*

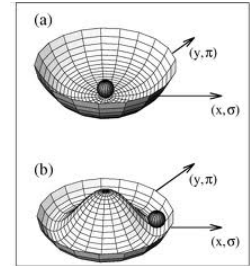


Scenario: A publishes A+B+C first, but files for A+B+C' after B publicly discloses A+B+C' where C' is an obvious/trivial variation

**Different Result?:** *Under narrow construction, subpara(B) will not remove B's disclosure with respect to C'*



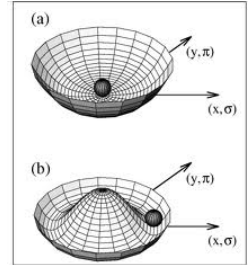
## Problems with the Asymmetry for the Examiners



- Guidelines create an entirely new standard
  - “insubstantial change” or “trivial variation”
- Is standard applied to disqualify all or only a portion of the intervening art?
  - Just the differences in intervening art “that is relied upon” can disqualify the exception
  - This violates the standard for anticipation – reference as a whole should be what is considered
- Can intervening art be used in obviousness rejection as the motivation to combine?



## Problems with the Asymmetry for the Applicants



- Forces all Applicants to preserve evidence for possible derivation under subpara. (A)
  - Standard for proving derivation adopts the *New England Braiding* decision to cover obvious variations derived from an inventor's work
- Forces Applicants to police public disclosures to add enumerable trivial or obvious variations
  - Creates a de facto first-to-file system
- Raises big concerns with respect to protecting genus/species inventions

# Comparisons of Derivation Scenarios under subpara. (A) vs. FTI or FTF

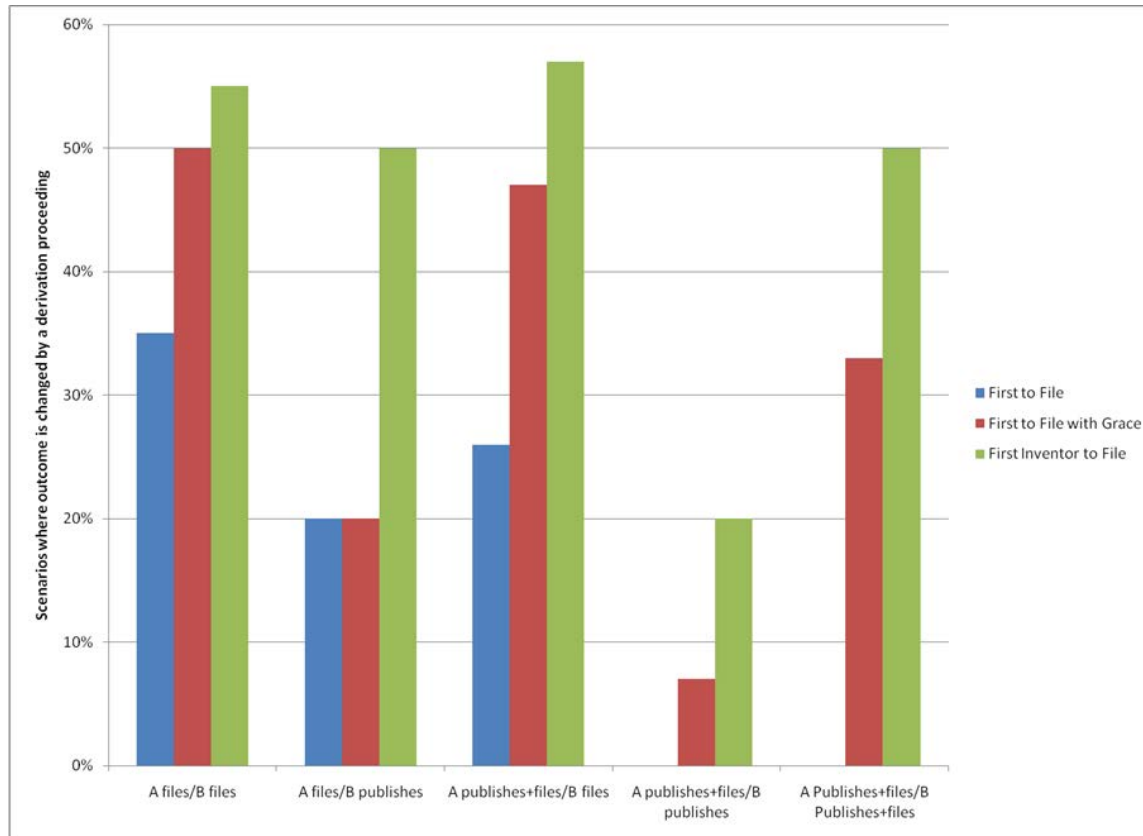
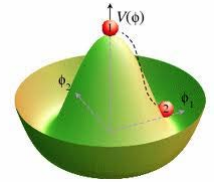


FIG. 3 – Scenarios involving fact patterns with derivation issues (based on hypothetical evaluation of weighted likelihood of 200 typical fact patterns from “The Matrix” article at Cybaris IP Law Review)

See, <http://web.wmitchell.edu/cybaris/wp-content/uploads/2010/05/01.Pedersen.05-12-10-vFINAL.WITHAPPENDIX.pdf>

## Better Approach is to not Break Symmetry Between subpara. (A) and subpara. (B)



- Same standard of “obvious variations” being included in the exception encourages early publication and use of FTP exceptions
- Examiners already know how to apply the standard of patentably distinct to determine whether exception applies
- Eliminates need for Applicants to police derivation/variation issues in their publications
- Preserves Office resources by avoiding a deluge of derivation petitions

# Thank You!

## About Brad Pedersen

Brad Pedersen is a patent attorney with more than 25 years of experience in patent law, engineering, business and entrepreneurship. He is a partner and the chair of the patent practice group at Patterson Thuente Christensen Pedersen, P.A., an intellectual property law firm in Minneapolis, Minnesota. Brad concentrates his practice in the areas of high-technology, computer, software and medical device patent prosecution strategy, licensing and litigation.

Brad is one of the more knowledgeable IP attorneys in the U.S. when it comes to the patent reform. Since it was first introduced in 2005, he has actively followed the developments and debate surrounding patent reform at the agency, legislative and judicial levels. He educates clients and colleagues by writing and presenting on the imminent changes and strategies for dealing with the reforms.

A special thanks to Justin Woo, Tracy Dann, and Michelle Arcand for their invaluable help on these materials.

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## About Patterson Thuente IP

Patterson Thuente Christensen Pedersen, P.A. helps creative and inventive clients worldwide protect, and profit from, their ideas. Practicing in the areas of patents, trademark, copyright, trade secrets, IP litigation, international IP protection, licensing and post-grant proceedings, the firm's attorneys excel at finding strategic solutions to complex intellectual property matters.

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