

# America Invents Act (AIA) First Inventor to File (FITF)

Effective March 16, 2013



## Overview Follow-Up Video: Statutory Review and Additional Illustrations

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- Hello, welcome to the follow-up video for the America Invents Act, First Inventor to File training.
- Prior to watching this follow-up video, you should have watched the introductory video and attended the live overview training. This video is the final part of your AIA First Inventor to File overview training.
- This video will provide a review of the statutory framework and some additional illustrations of the materials that were presented in the live overview training.
- Each of the illustrations presented here is meant to elaborate on the principles of the live overview training.

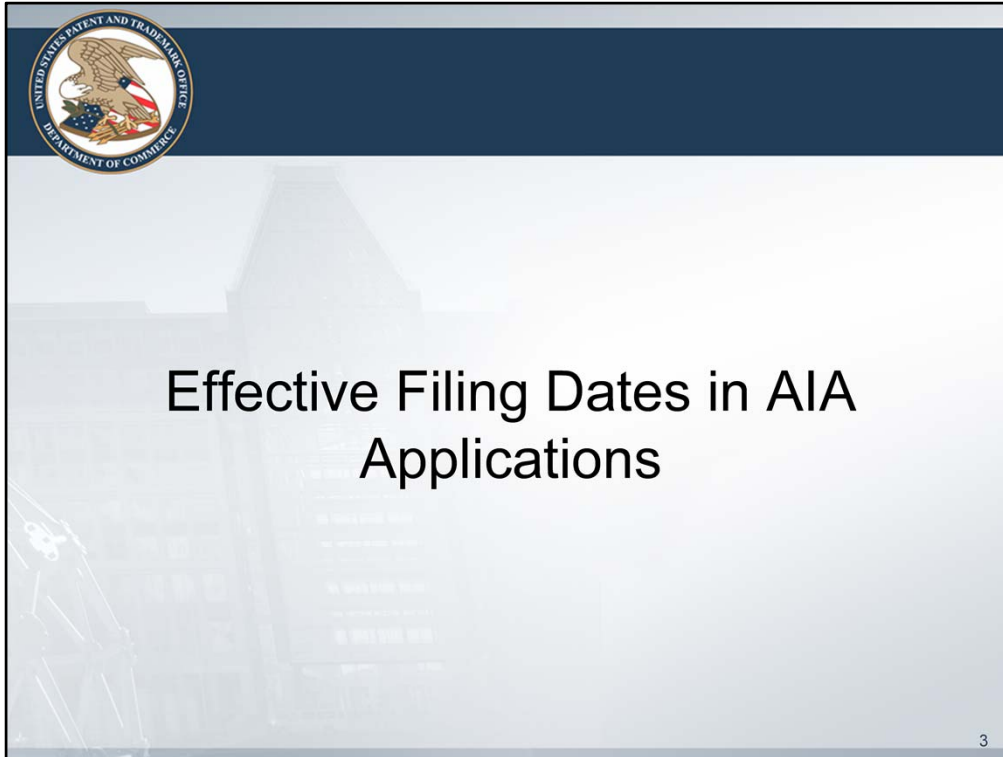


# AIA Statutory Framework

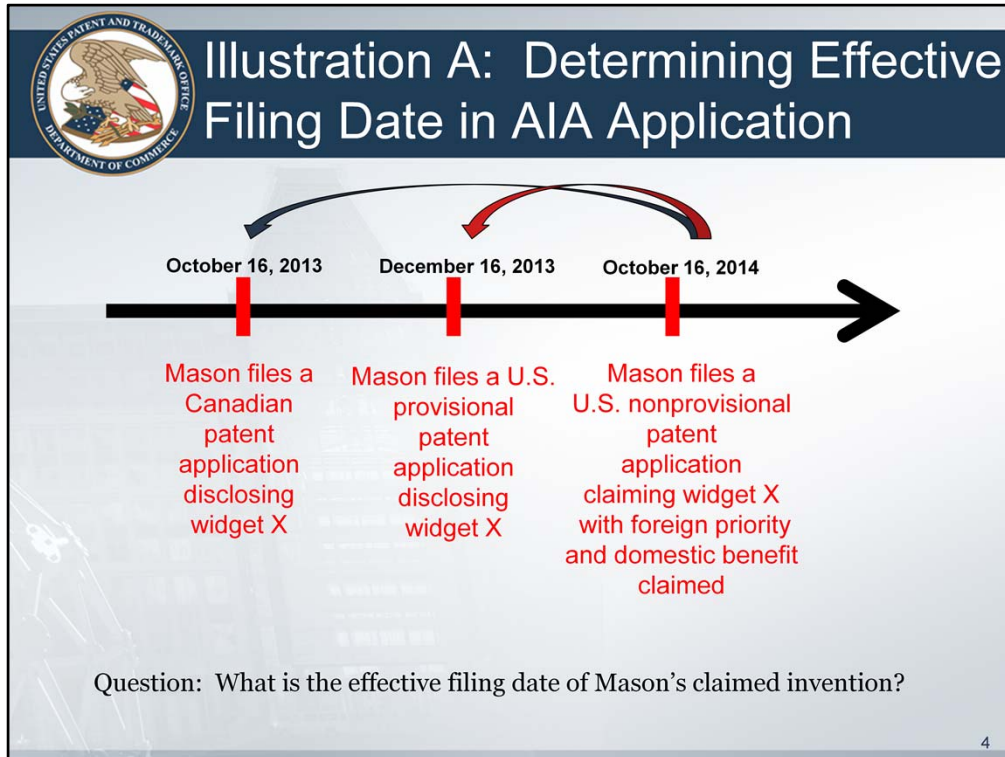
<b>Prior Art</b> <b>35 U.S.C. 102(a)</b> <b>(Basis for Rejection)</b>	<b>Exceptions</b> <b>35 U.S.C. 102(b)</b> <b>(Not Basis for Rejection)</b>	
<b>102(a)(1)</b> Disclosure with Prior Public Availability Date g	<b>102(b)(1)</b> b	<b>(A)</b> Grace Period Disclosure by Inventor or Obtained from Inventor b
		<b>(B)</b> Grace Period Intervening Disclosure by Third Party b
<b>102(a)(2)</b> U.S. Patent, U.S. Patent Application, and PCT Application with Prior Filing Date y	<b>102(b)(2)</b> o	<b>(A)</b> Disclosure Obtained from Inventor o
		<b>(B)</b> Intervening Disclosure by Third Party o
		<b>(C)</b> Commonly Owned Disclosure o

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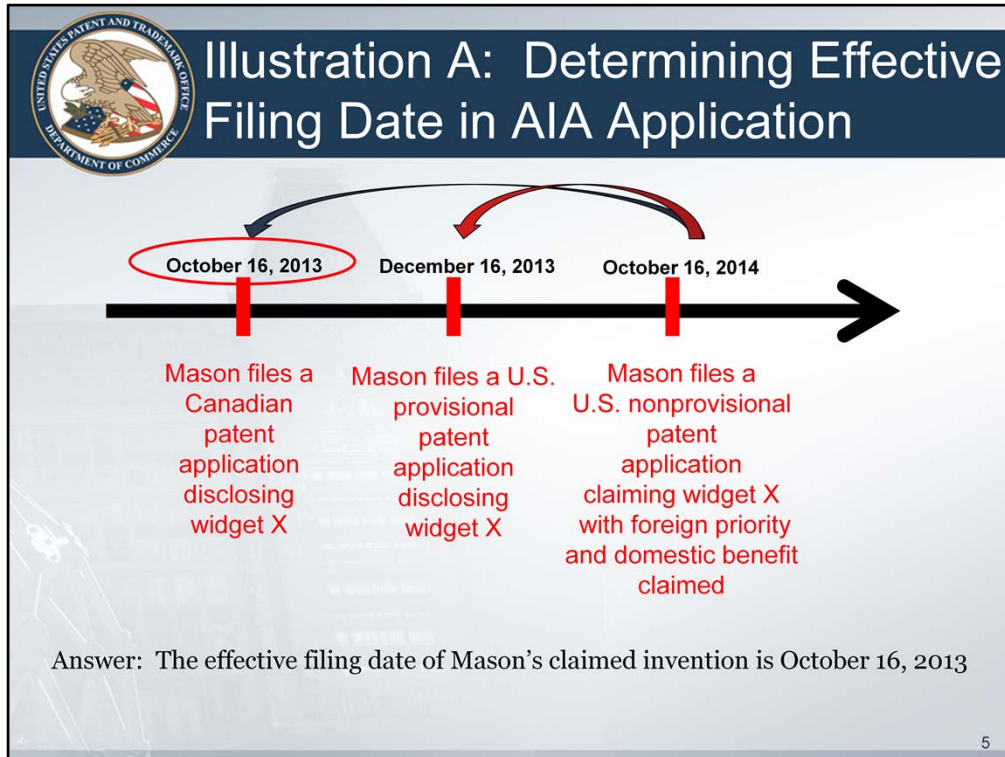
- At this point, you should be familiar with the AIA Statutory Framework as depicted in this chart. As you will recall, rejections will be made either under AIA section 102(a)(1) or 102(a)(2) as shown in the green and yellow boxes (also indicated with “g” and “y”, respectively). Their respective exceptions are provided for under AIA section 102(b)(1) and 102(b)(2), the blue and orange boxes (also indicated with “b” and “o”, respectively). Keep in mind that AIA section 102(b) is **not** the basis for any rejection.
- You should also have received this chart showing the statutory framework during your attendance at the live overview training. Keep this chart handy, along with your other training materials, while you watch this video, so that you can follow along with the illustrations that will be discussed.



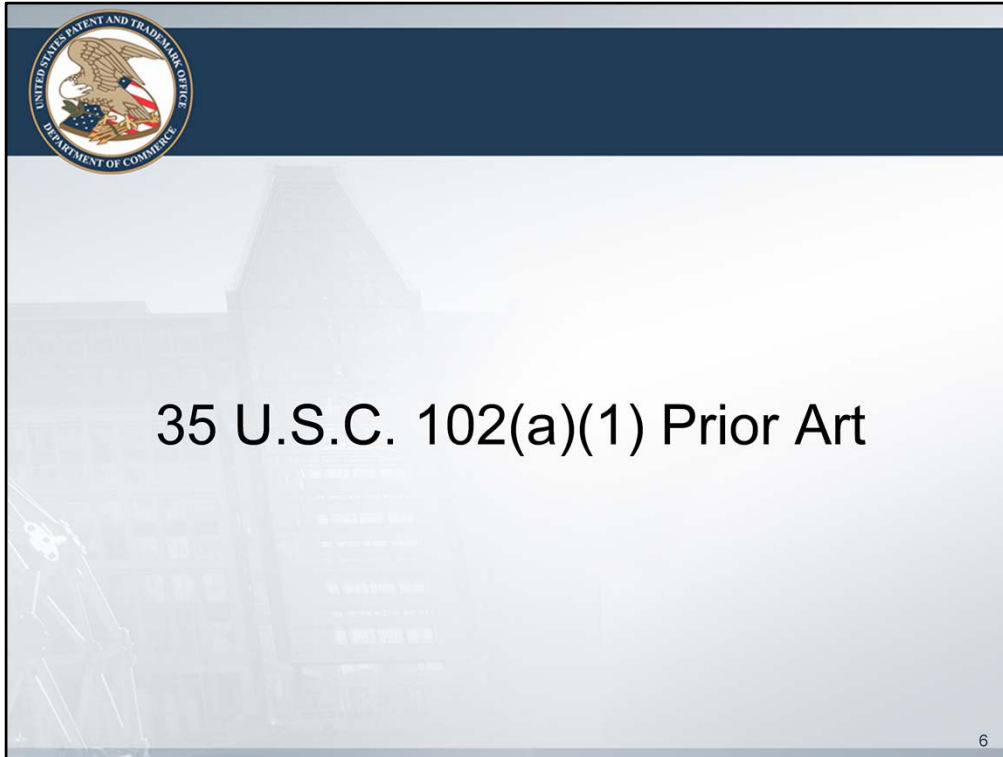
- As you remember from your previous trainings, the effective filing date in AIA applications **will be the earlier of:**
  - (i) the actual filing date of the application containing a claim to the invention; or
  - (ii) the filing date of the earliest application for which the application is entitled to claim domestic benefit or foreign priority as to such invention.
- Notably, a significant difference from the pre-AIA system is that under the AIA, the effective filing date can be a foreign priority filing date.
- Our first illustration will be directed to the determination of the effective filing date for a claimed invention in an AIA Application.



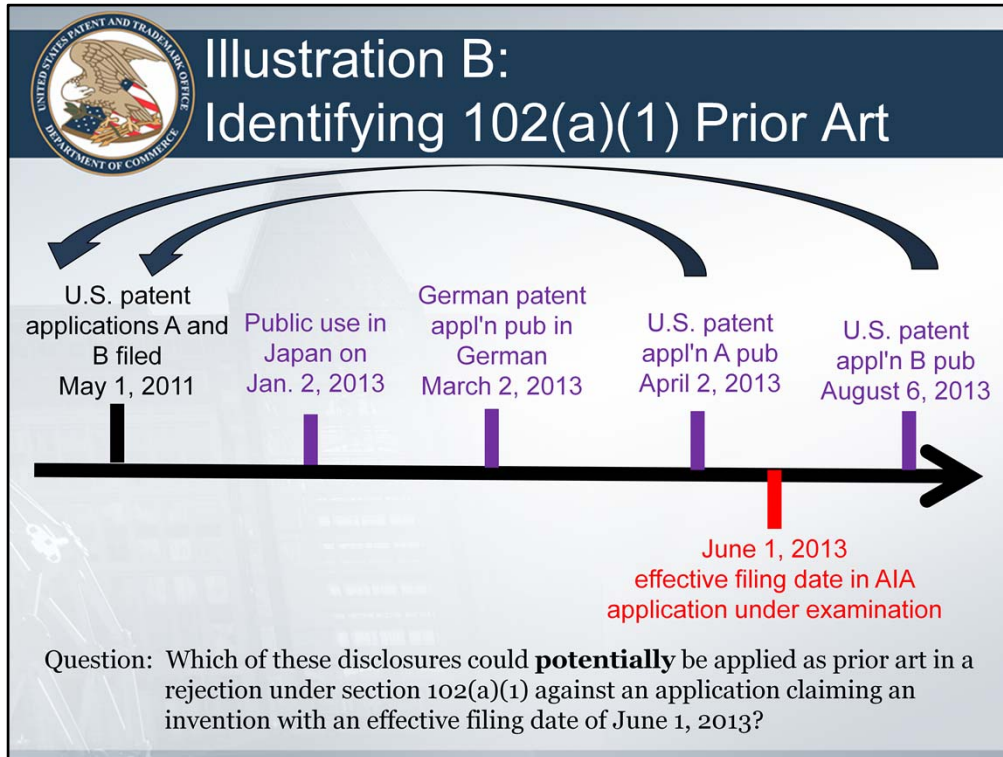
- Illustration A is directed to determining effective filing dates in an AIA application.
- Mason files a nonprovisional patent application claiming widget X on October 16, 2014, which will be examined under AIA.
- He claims priority to his Canadian patent application filed October 16, 2013, as shown by the black arrow; and he claims the benefit of his U.S. provisional application filed December 16, 2013 as shown by the red arrow.
- All applications disclose the exact same subject matter.
- What is the effective filing date of Mason's claimed invention? October 16, 2013? December 16, 2013? Or, October 16, 2014.



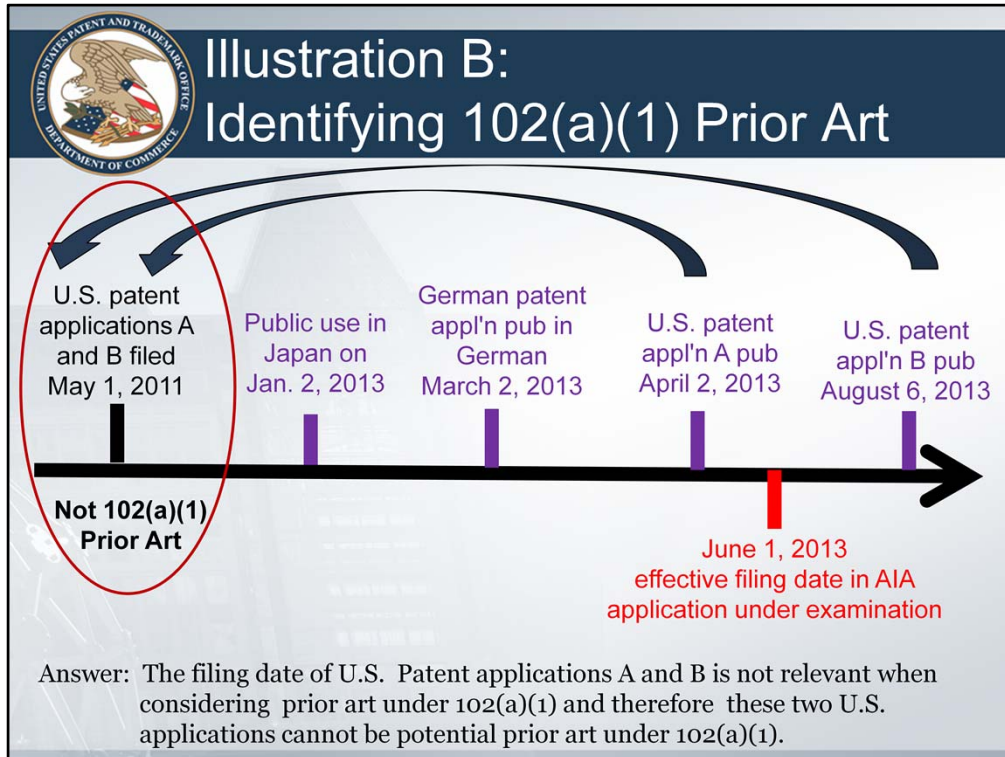
- The answer is that the effective filing date of Mason's claimed invention is October 16, 2013.
- Because this is an AIA application, the effective filing date of the claimed invention would be the earlier of:
  - (i) the actual filing date of the application containing a claim to the invention; or
  - (ii) the filing date of the earliest application for which the application is entitled to claim domestic benefit or foreign priority as to such invention.
- In this example, the earliest filing date, to which Mason's nonprovisional application is entitled to claim benefit, is the filing date of the Canadian patent application as indicated by the red oval. As you remember from your previous training, a significant difference from the pre-AIA system is that under the AIA, the effective filing date of a claimed invention can be a foreign priority filing date.



- Knowing the effective filing date of the invention you are examining is the key to determining what prior art you can apply.
- You have learned that AIA section 102(a)(1), the green box, defines a category of prior art in which "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." These illustrations will reinforce some of the ways that an invention may be made available to the public under AIA section 102(a)(1).
- Keep in mind that, although these illustrations involve anticipatory rejections, prior art that qualifies under either sections 102(a)(1) or 102(a)(2) can be used in an obviousness rejection as well as an anticipation rejection.

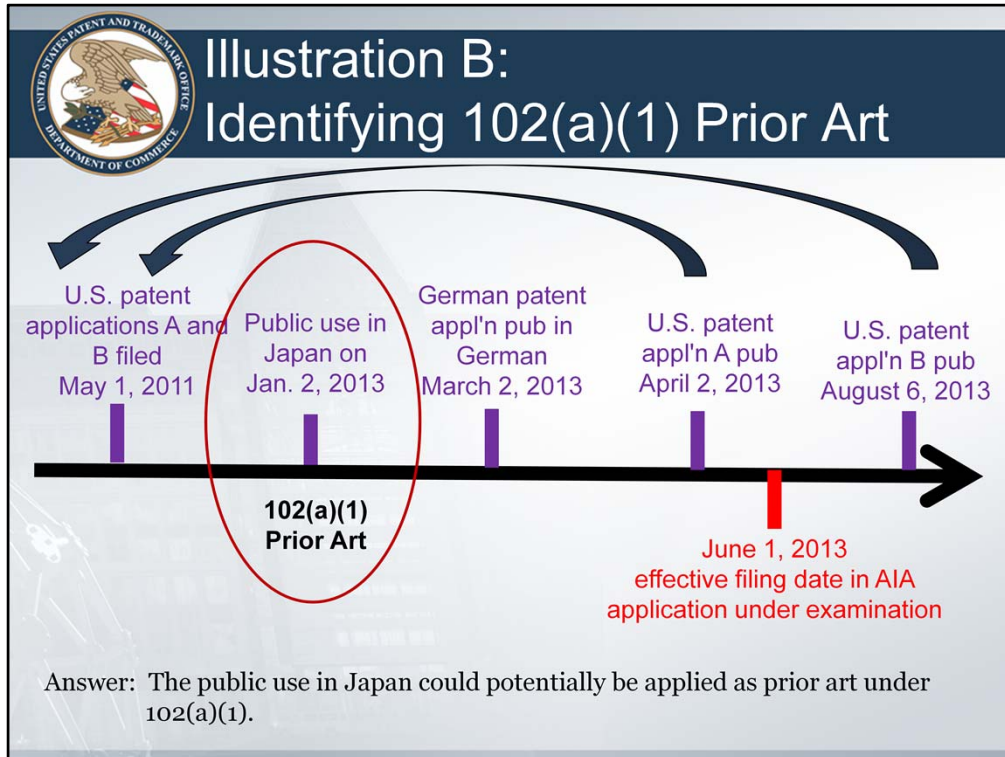


- Now we will move to Illustration B which identifies prior art available under AIA section 102(a)(1).
- We will consider whether each of the disclosure is potentially available as prior art under 102(a)(1) over the next few slides.
- Remember, under section 102(a)(1) **identified on your AIA statutory framework chart as the green box**, we are considering the date that the subject matter in question was made available to the public.
- Now here is the question. Which of these disclosures could **potentially** be applied as prior art in a rejection under section 102(a)(1) against an application claiming an invention with an effective filing date of June 1, 2013? We are not going to consider any exception provisions in Illustration B.

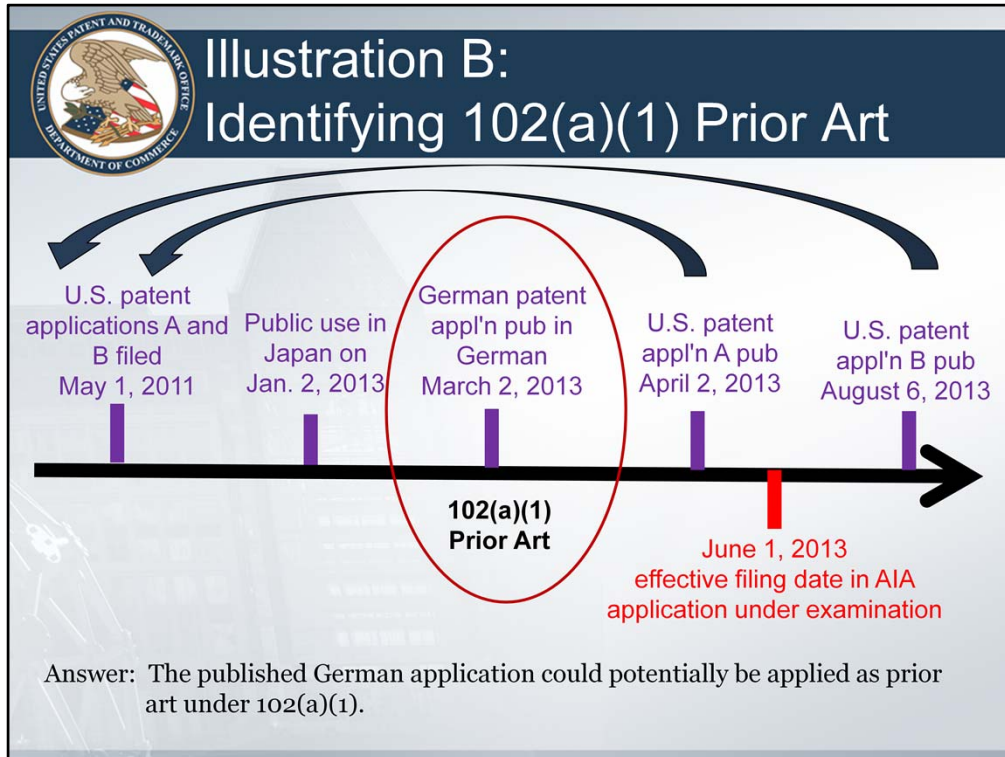


- Starting with U.S. patent applications A and B, we remember that AIA section 102(a)(1) does **not** take into account when a published application is effectively filed. Therefore, the filing date of May 1, 2011 of US Applications A and B is not relevant when considering prior art under 102(a)(1).
- However, under 102(a)(2), it should be noted that the U.S patent application publications A and B **both** would qualify as prior art in the yellow box on our chart, because each was effectively filed on May 1, 2011, which is before the effective filing date of the claimed invention. This concept will be discussed in depth in a later illustration.

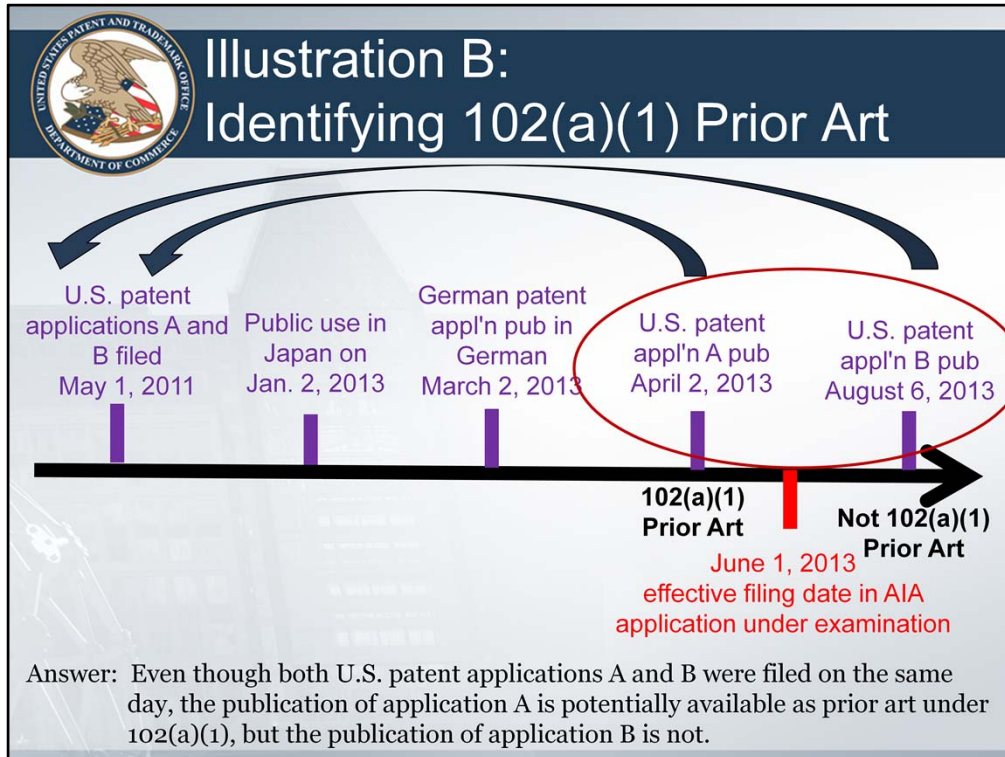




Now let's consider the public use in Japan. Under the AIA, public use **anywhere** in the world before the effective filing date of the claimed invention can be prior art under 102(a)(1). This is a change as compared with pre-AIA 102(a) and 102(b), which required that a use be "in this country" in order to qualify as prior art. In our illustration, the public use in Japan occurred before the effective filing date of the claimed invention, so it could potentially qualify as a prior art under 102(a)(1).



- Let's move now to the German patent application, published **in German** on March 2, 2013. Just as under pre-AIA law, under the AIA, the language of the publication does not matter. The German application was published before the effective filing date of the claimed invention, so it could potentially qualify as prior art under 102(a)(1).



- Lastly, with regard to the publications of U.S. patent applications A and B, publication of application A was available to the public before the effective filing date of the claimed invention. Whereas, publication of application B was **not** available until after the effective filing date of the claimed invention. As a result, even though both were filed on the same day, publication of application A is potentially available as prior art under 102(a)(1), but the publication of application B is not.



## Identifying 102(a)(1) Prior Art

Some other kinds of section 102(a)(1) prior art:

- U.S. and foreign patents as of their issue dates
- Paper or electronic journal articles, as of the date of public availability
- Public presentations at scientific meetings or trade shows
- Public sale activity, anywhere in the world
- Any other means of making the subject matter available to the public

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We have seen patent application publications and public uses as section 102(a)(1) prior art in disclosures we've just reviewed in Illustration B.

This slide lists some other possible section 102(a)(1) prior art, including patents, published articles, public presentations, and public sales.

The AIA has added a catch-all category of prior art that has no counterpart in pre-AIA law: "otherwise available to the public." Therefore, examiners do not need to be concerned about the manner in which the subject matter was made available to the public. Prior art under section 102(a)(1) is not limited to any particular means of making the subject matter publicly available.

The important thing to remember about section 102(a)(1) is that we're talking about events that made the subject matter available to the public. That's why the date that a potential reference patent or application was effectively filed can never be relied on under section 102(a)(1), although it may be relied on under section 102(a)(2).

The illustration features a timeline on a light blue background with a faint image of a patent document. At the top left is the seal of the United States Patent and Trademark Office, Department of Commerce. The title 'Illustration C: Should a 102(a)(1) Rejection Be Made?' is in a dark blue header. A horizontal black arrow points to the right. A purple vertical bar is positioned at the left end of the arrow, with the text 'Stark's public trade show disclosure of Widget X December 20, 2013' above it. A red vertical bar is positioned further to the right on the arrow, with the text 'June 20, 2014 O'Brien files U.S. application under examination claiming Widget X' to its right. At the bottom left, the text reads: 'Question: Is Stark's public trade show disclosure prior art under section 102(a)(1)?'


Now that we have discussed what types of prior art are available under section 102(a)(1), we will take a look at some exceptions that apply under AIA section 102(b)(1).

We will first set forth a basic fact pattern and then present additional facts to see how they affect the question being asked.

The basic fact pattern is as follows: O'Brien filed a US patent application on June 20, 2014, which is under examination, as indicated in red. The effective filing date of the claimed Widget X in O'Brien's application is June 20, 2014. This is an AIA Application.

Stark, at a public trade show, discloses Widget X on December 20, 2013 as shown in purple.


The Question is whether Stark's public trade show disclosure is prior art under section 102(a)(1)?

 Illustration C: Should a 102(a)(1) Rejection Be Made?


Stark's public trade show disclosure of Widget X  
December 20, 2013

June 20, 2014  
O'Brien files U.S. application under examination claiming Widget X

Question: Is Stark's public trade show disclosure prior art under section 102(a)(1)?  
Answer: Yes, Stark's public trade show disclosure is prior art under section 102(a)(1) because it falls within the "otherwise available to the public" category and is prior to O'Brien's effective filing date.



The answer to the basic fact pattern is Yes. Stark's public trade show disclosure is prior art under section 102(a)(1) because it falls within the "otherwise available to the public" category and is prior to O'Brien's effective filing date. Please note, even though Stark's disclosure is not a patent, a printed publication, a public use, or a sale, it is still a public disclosure under section 102(a)(1).



## Illustration C: Should a 102(a)(1) Rejection Be Made?

Stark's public trade show disclosure of Widget X obtained from O'Brien  
December 20, 2013

June 20, 2013

June 20, 2014  
O'Brien files U.S. application under examination claiming Widget X

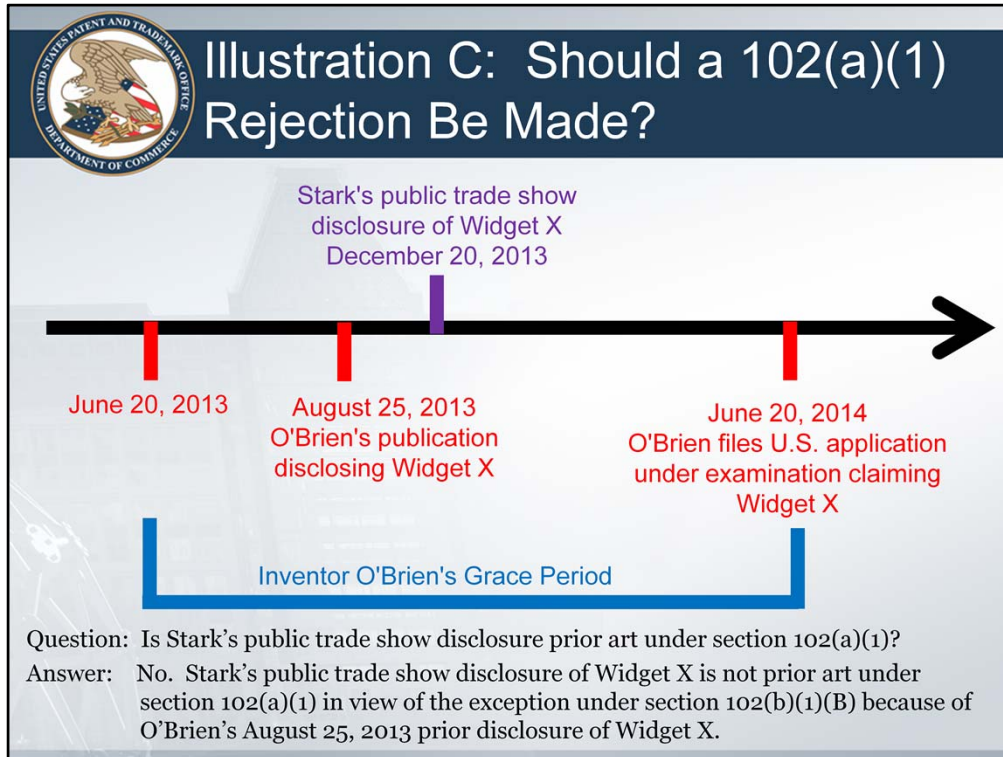
Inventor O'Brien's Grace Period

Question: Is Stark's public trade show disclosure prior art under section 102(a)(1)?  
Answer: No. Because Stark obtained Widget X from O'Brien, Stark's disclosure is not prior art under section 102(a)(1) in view of the exception under section 102(b)(1)(A).

Building on the basic fact pattern, we have added one additional fact on this slide but we are asking the same question.

Here, there is evidence in the record that Stark learned about Widget X from O'Brien. As you recall, the exception under section 102(b)(1)(A) excludes a grace period disclosure by another from being prior art under section 102(a)(1) when the one who disclosed obtained the subject matter from the inventor.

Therefore, Stark's disclosure is not available as prior art against O'Brien's invention.



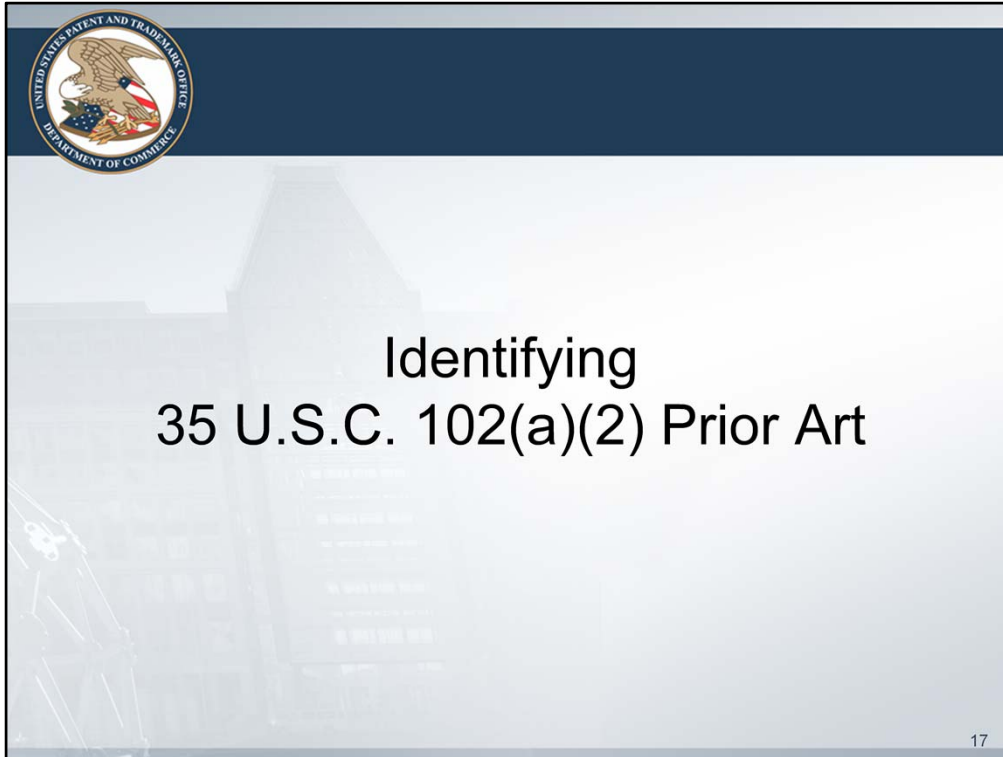
Building again on the basic fact pattern, the additional fact here is that evidence is in the record that O'Brien published Widget X prior to Stark's public trade show disclosure.

As you recall, the exception under section 102(b)(1)(B) excludes a grace period disclosure by a third party from being prior art under section 102(a)(1) when the inventor disclosed the subject matter prior to the third party's disclosure, regardless of whether the third party obtained the disclosure from the inventor or not.

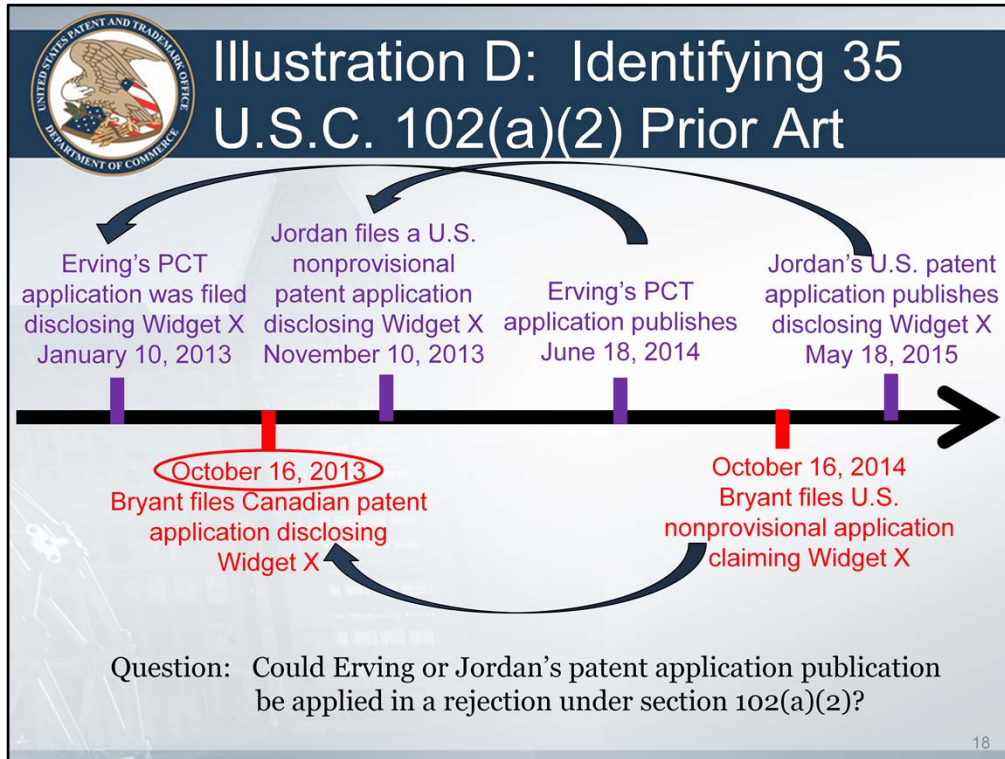
Therefore, the answer here is No. Stark's public trade show disclosure of Widget X is not prior art under section 102(a)(1) in view of the exception under section 102(b)(1)(B) because of O'Brien's August 25, 2013 prior disclosure of Widget X.

Please note that although the prior public disclosure by the invention is not limited to occurring during the grace period, if it did not, it would itself be available as prior art under 102(a)(1).

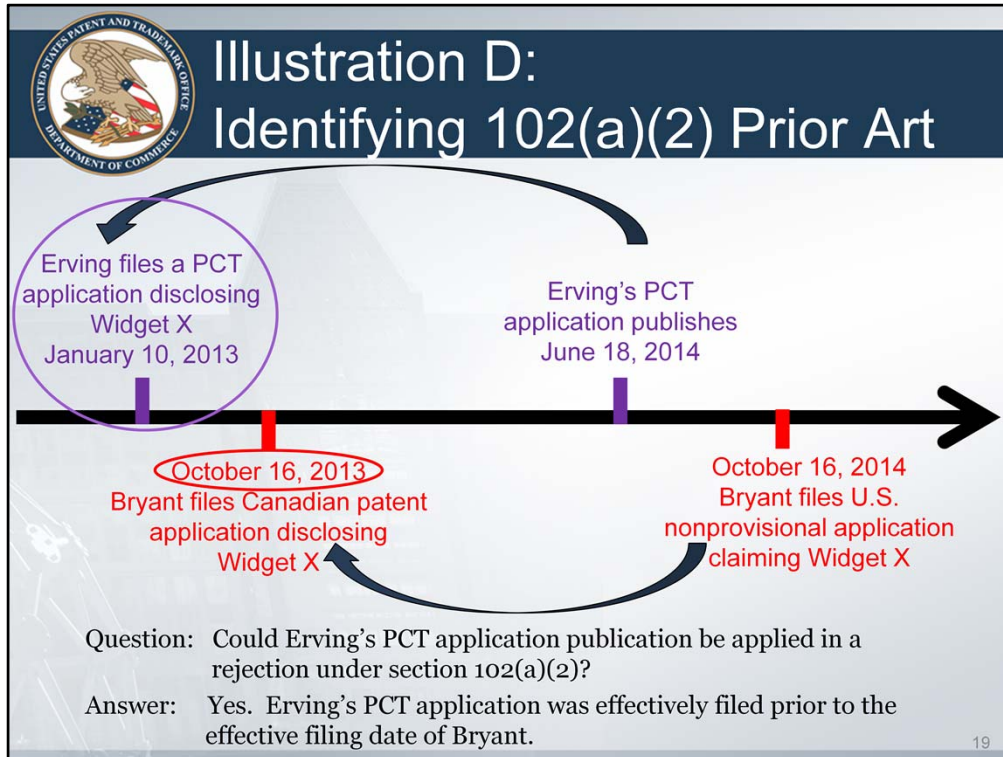




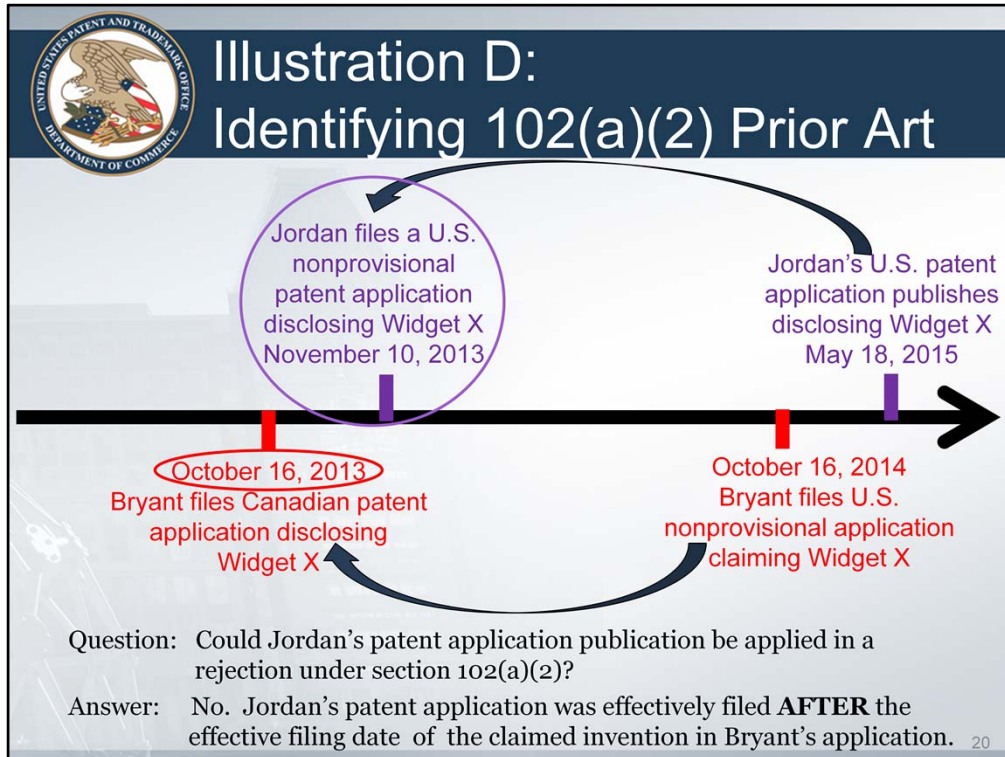
- You have learned that section 102(a)(2), the yellow box on your chart, defines a category of prior art in which the claimed subject matter was described in a U.S. Patent, U.S. Patent Application Publication or PCT publication before the effective filing date of the claimed invention. This illustration will remind you about some of the ways that an invention may be described and effectively filed before the effective filing date of a claimed invention under section 102(a)(2), as well as exceptions to this prior art under section 102(b)(2).
- Again keep in mind that, although these illustrations involve anticipatory rejections, prior art that qualifies under either sections 102(a)(1) or 102(a)(2) can be used in an obviousness rejection as well as an anticipation rejection.



- In this illustration we will consider whether each of the disclosures, shown in purple, qualifies as prior art under section 102(a)(2), the yellow box on your statutory framework chart.
- Remember, under section 102(a)(2), we're looking at the date that the publication disclosing the claimed invention was effectively filed.
- In this illustration, we are examining the Bryant application claiming a Widget X, shown on the bottom of the timeline in red. Bryant filed his nonprovisional application on October 16, 2014, claiming foreign priority to his Canadian application filed on October 16, 2013 disclosing the Widget X. Bryant's application is an AIA Application.
- As discussed in Illustration A, the effective filing date of the claimed invention in an AIA application would be the earlier of:
  - (i) the actual filing date of the application containing a claim to the invention; or
  - (ii) the filing date of the earliest application for which the application is entitled to claim benefit or priority as to such invention.
- As such, the effective filing date of Bryant will be the filing date of his Canadian patent application as shown in the red oval.
- Shown on the top of the timeline in purple, Jordan's U.S. Patent Application was published on May 18, 2015, and is based on an application effectively filed on November 10, 2013.
- Also shown on the top of the timeline in purple, Erving's PCT application was published on June 18, 2014 and is based on an application effectively filed on January 10, 2013.
- Thus, we turn to the question, "Could Erving or Jordan potentially be applied as prior art in a rejection under section 102(a)(2) against Bryant?"



- First we will consider Erving's PCT application publication as possible prior art.
- In order for a published PCT application to be available as prior art under section 102(a)(2), it must have been effectively filed before the effective filing date of the claimed invention under examination.
- Erving was published on June 18, 2014, which is before the U.S. filing date of Bryant's application, but AFTER the effective filing date of Bryant. However, Erving was effectively filed on January 10, 2013 BEFORE the effective filing date of Bryant.
- Thus, Erving's PCT Application publication would qualify as prior art under section 102(a)(2).



- Now, we will consider Jordan's U.S. patent application publication.
- In order for a published U.S. Patent application to be available as prior art under section 102(a)(2), it must have been effectively filed before the effective filing date of the claimed invention under examination.
- Now considering Jordan as possible prior art, Jordan was published on May 18, 2015 which is AFTER the effective filing date of Bryant. Jordan's application was effectively filed on November 10, 2013 which is also AFTER the effective filing date of Bryant.
- Thus, Jordan's U.S. patent application publication is not prior art under 102(a)(2).



## Identifying 102(a)(2) Prior Art

Section 102(a)(2) prior art includes:

- U.S. Patents as of the date they were effectively filed
- U.S. Patent Application Publications as of the date they were effectively filed
- Published PCT applications which designate the United States as of the date they were effectively filed.

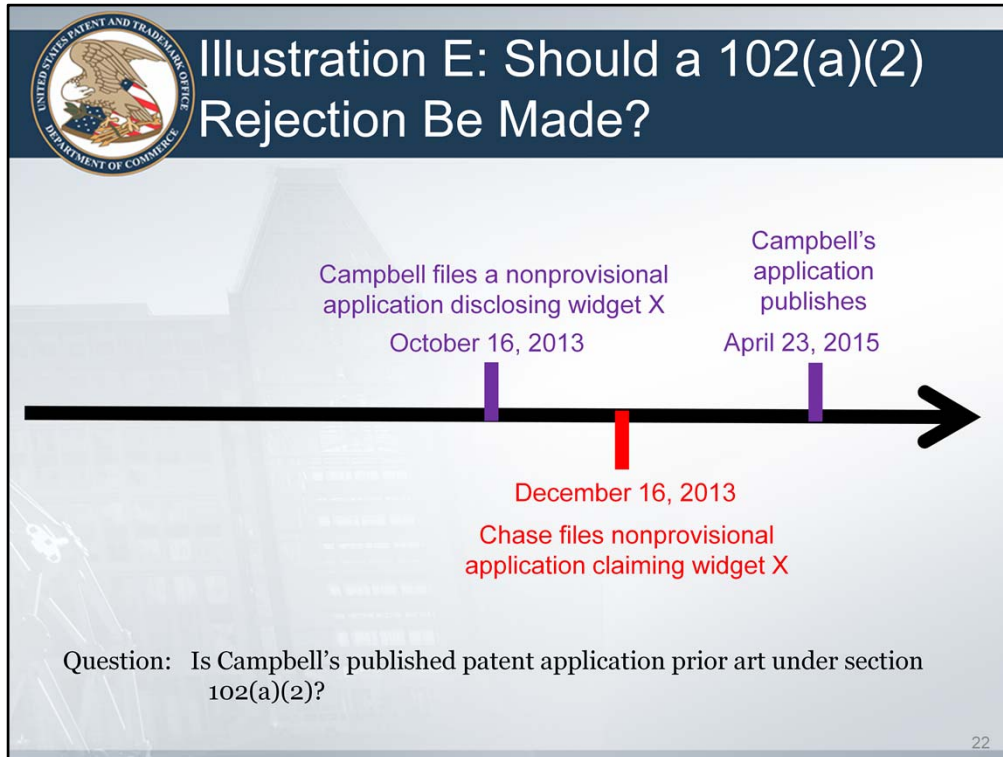
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With respect to section 102(a)(2) prior art, the critical inquiry is whether the patent document being used as a prior art reference was effectively filed before the effective filing date of the claimed invention under examination.

For U.S. patents and U.S. patent application publications being used as a prior art reference, the date they were effectively filed can be either the actual U.S. filing date or the date of foreign priority or domestic benefit which they are entitled to claim.

By statute, published PCT applications designating the United States are deemed publications. Such publications can be applied as prior art as of their actual filing date or the date of foreign priority to which they are entitled to claim benefit.

Now we will turn to our last Illustration on whether to make a prior art rejection under 102(a)(2).




This illustration addresses AIA section 102(a)(2) prior art, as well as the exceptions that apply under AIA section 102(b)(2).

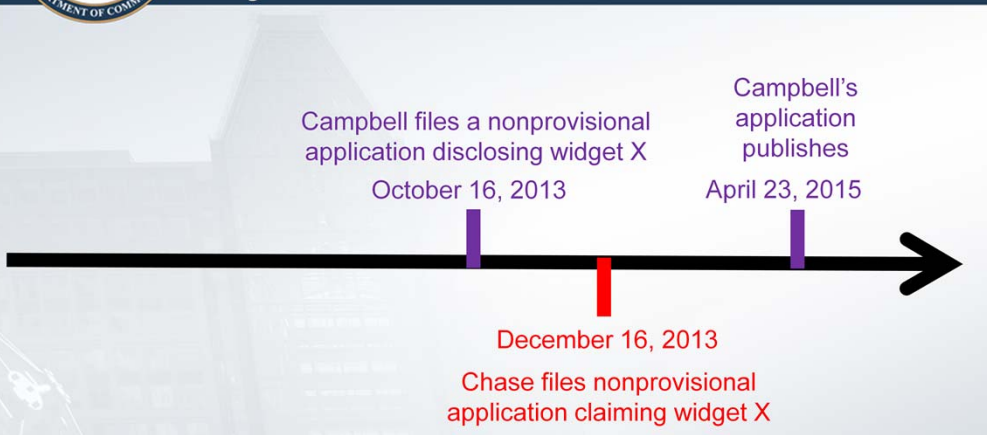
We will first set forth a basic fact pattern and then present additional facts to see how they affect the question being asked.

The basic fact pattern is as follows: Chase filed a US patent application on December 16, 2013, which is under examination, as indicated in red. The effective filing date of the claimed Widget X in Chase's application is December 16, 2013. This is an AIA Application.

Campbell discloses widget X in a patent application publication dated April 23, 2015, which was effectively filed on October 16, 2013.

The Question is whether Campbell's published patent application is prior art under section 102(a)(2)?

 Illustration E: Should a 102(a)(2) Rejection Be Made?



Campbell files a nonprovisional application disclosing widget X  
October 16, 2013


Chase files nonprovisional application claiming widget X  
December 16, 2013

Campbell's application publishes  
April 23, 2015

Question: Is Campbell's published patent application prior art under section 102(a)(2)?  
Answer: Yes. Campbell's published patent application is prior art under 102(a)(2) because it was effectively filed before Chase's effective filing date.

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The answer to the basic fact pattern is Yes. Campbell's published patent application is prior art under section 102(a)(2) because it was effectively filed before the effective filing date of Chase's claimed invention.



## Illustration E: Should a 102(a)(2) Rejection Be Made?

Campbell files a nonprovisional application disclosing widget X where the subject matter of the widget was obtained from Chase

October 16, 2013

December 16, 2013  
Chase files nonprovisional application claiming widget X

Campbell's application publishes

April 23, 2015

Question: Is Campbell's published patent application prior art under section 102(a)(2)?

Answer: No. Campbell's published patent application is not prior art under section 102(a)(2) in view of the exception under section 102(b)(2)(A) because Campbell obtained the subject matter of the widget from Chase.

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Building on the basic fact pattern, the additional fact here is that evidence is in the record that Campbell obtained the subject matter of Widget X from Chase.

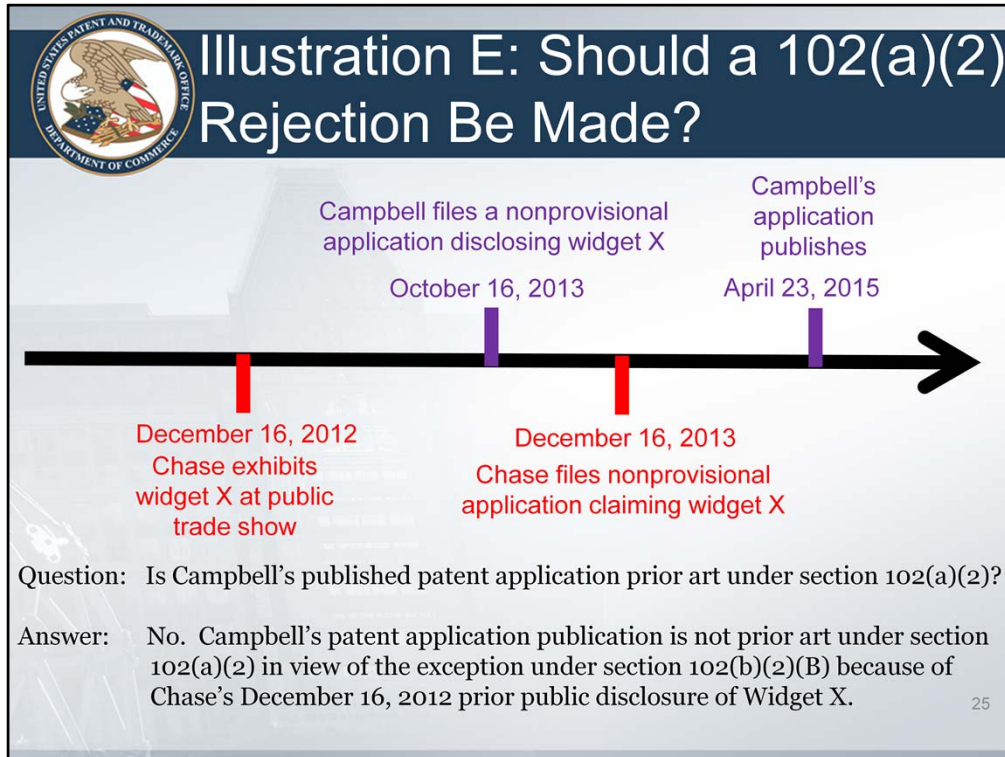
As you recall, the exception under section 102(b)(2)(A) excludes a disclosure by another from being prior art under section 102(a)(2) when the one who disclosed the invention obtained the subject matter of the invention from the inventor.

With this additional fact, we are asking the same question – is Campbell's published patent application now prior art under section 102(a)(2)?

Applying the 102(b)(2)(A) exception here, the answer here is No. **Campbell's published patent application is not prior art under section 102(a)(2) because** there is evidence in the record that Campbell obtained the subject matter of Widget X from Chase.

Therefore, Campbell's disclosure is not available as prior art against Chase's invention.






Building again on the basic fact pattern, the additional fact here is that evidence is in the record that Chase exhibited Widget X prior to the date Campbell effectively filed his patent application.

As you recall, the exception under section 102(b)(2)(B) excludes a disclosure by a third party from being prior art under section 102(a)(2) when the inventor disclosed the subject matter prior to the third party's disclosure, regardless of whether the third party obtained the disclosure from the inventor or not.

Again we are asking the same question – is Campbell's published patent application prior art under section 102(a)(2)?

The answer here is No. **Campbell's published patent application is not prior art under section 102(a)(2) in view of the exception under section 102(b)(2)(B) because of Chase's December 16, 2012 prior public disclosure of Widget X.**



## Illustration E: Should a 102(a)(2) Rejection Be Made?

Campbell files a nonprovisional application disclosing widget X  
(Campbell assigned to Acme)  
 October 16, 2013

Chase files nonprovisional application claiming widget X  
On December 16, 2103, Chase assigned his invention to Acme  
 December 16, 2013

Campbell's application publishes  
 April 23, 2015

Question: Is Campbell's published patent application prior art under section 102(a)(2)?  
 Answer: No. Campbell's published patent application is not prior art under section 102(a)(2) in view of the exception under section 102(b)(2)(C) because the subject matter of Campbell and the claimed invention were commonly assigned not later than the effective filing date of Chase's invention.

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- Building again on the basic fact pattern, the additional facts here are that the disclosure of Campbell was assigned to the ACME when Campbell filed on October 16, 2013. Further, Chase assigned his invention to ACME when he filed on December 16, 2013.
- As you recall, the exception under section 102(b)(2)(C) excludes a disclosure from being prior art under section 102(a)(2) when the subject matter disclosed and the claimed invention were commonly owned not later than the effective filing date of the claimed invention.
- Again, we are asking the same question – is Campbell's published patent application prior art under section 102(a)(2)?
- The answer is No. As we see here, Chase and Campbell both assigned their inventions to ACME prior to Chase's effective filing date. Thus, applying the exception under 102(b)(2)(C), Campbell's published patent application is not prior art under section 102(a)(2) because there is evidence in the record that the widget disclosed by Campbell was owned by the same party that owned the widget of Chase not later than Chase's effective filing date.



## Summary of Key Points from Illustrations A-E

- Rejections are under AIA section 102(a)(1) and 102(a)(2).
- Exceptions are under AIA section 102(b)(1) and 102(b)(2).
- Effective filing dates and effectively filed prior art dates may be **foreign priority dates**.
- Commonly owned disclosures can be excluded from **anticipation** rejections as well as obviousness rejections.


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In conclusion, this video illustrated several key points about examining AIA Applications.

Under the AIA, rejections are made using AIA section 102(a)(1) and 102(a)(2) provided that exceptions from AIA sections 102(b)(1) and 102(b)(2) are not triggered.

The effective filing date of the claimed invention you are examining or the effectively filed date of the prior art reference you are considering applying may now be foreign priority dates.

And lastly, commonly owned disclosures can be excluded from anticipation rejections as well as obviousness rejections.



## Summary of AIA Overview Training

- Examiners should rely on AIA indicators in eDAN and PALM.
- AIA sections 102(a)(1) and 102(a)(2) and AIA sections 102(b)(1) and 102(b)(2) **together** delineate prior art available for anticipation and obviousness rejections.
- Effective filing dates and effectively filed prior art dates may be **foreign priority dates**.
- Comprehensive training coming this summer.
- Lead FITF POCs and Just-In-Time training

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This video completes your Overview Training of the AIA First Inventor to File provisions.

Let's review some key points from the overview training.

Examiners should rely on AIA indicators in eDAN and PALM to determine the AIA status of applications on their docket.

AIA sections 102(a)(1) and 102(a)(2) and AIA sections 102(b)(1) and 102(b)(2) **together** delineate prior art available for anticipation and obviousness rejections.

Effective filing dates and effectively filed prior art dates may be **foreign priority dates**. Please note that crediting the foreign priority date for the date that the reference is effectively filed is **ONLY** done when you are examining an AIA application. It is **NOT** dependent on the reference dates. In other words, the application you are examining controls.

Stay tuned for your Comprehensive training coming this summer to a TC near you.

But if you find yourself examining an AIA application before the next training, visit your TC POC for Just-in-Time training.

Time code = **ATRAIN 0118 090101**



**THANK YOU!**

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The time code for today's training session is on the screen. When claiming your other time for the training, please follow the guidance in the email you received from Andy Faile dated February 28<sup>th</sup>. Thank you.