From: Bird, John M.
Sent: Friday, October 05, 2012 5:48 PM
To: fitf_guidance
Subject: Comment regarding Interpretation of 102(b)(1)(B) and (b)(2)(B) [IWOV-DCDOC1.FID33983]

Dear Sirs,

The Fed. Reg. Notice dated July 26, 2012, at page 43767 provides a discussion of the PTO's interpretation of 102(b)(1)(B) and (b)(2)(B). However, there is no guidance regarding what constitutes the same "subject matter" for 102(b)(1)(B) and (b)(2)(B) other than that " 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."

The Final Examination Guidelines should explain that the same "subject matter" does not require that the disclosure by the 3rd party and the disclosure by the inventor (joint inventor, or another who obtained the subject matter directly or indirectly from the inventor or joint inventor) be identical. Of course, there will always be differences between the disclosures of unrelated parties.

Please consider adding to the guidelines that the determination as to whether the disclosures are the same "subject matter" would be made in consideration of the claimed "subject matter" and whether features of the claimed "subject matter" are met by the 3rd party disclosure. For example:

If the invention = A + B + C, the inventor's disclosure meets A+ B, and the 3rd party's disclosure also meets A + B, the exception would apply.

If the invention = A + B + C, the inventor's disclosure meets A+ B, and the 3rd party's disclosure meets A + C, the exception would not apply.

If the invention = A + B + C, the inventor's disclosure meets A+B1, and the 3rd party's disclosure meets A+B2, where each of B1 and B2 although different meet the same claim feature B, the exception would also apply. Otherwise, it will be impossible to apply the exception because any small difference between the disclosures that is unrelated to the claim scope will prevent this exception from ever being used.

The examples above are situations where the 3rd party disclosure would be prior art used in 103 rejection to emphasize that the test for 102(b)(1)(B) and (b)(2)(B) is a comparison between the 3rd party disclosure and the disclosure by the inventor (joint inventor, or another who obtained the subject matter directly or indirectly from the inventor or joint inventor). But this comparison cannot be in a vacuum and thus must be made in consideration of the features of the claimed "subject matter."

The views expressed in this comment are entirely my own and do not necessarily represent the views of my firm.

Thank you,
John Bird

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