



USPTO

Implementation of

AIA

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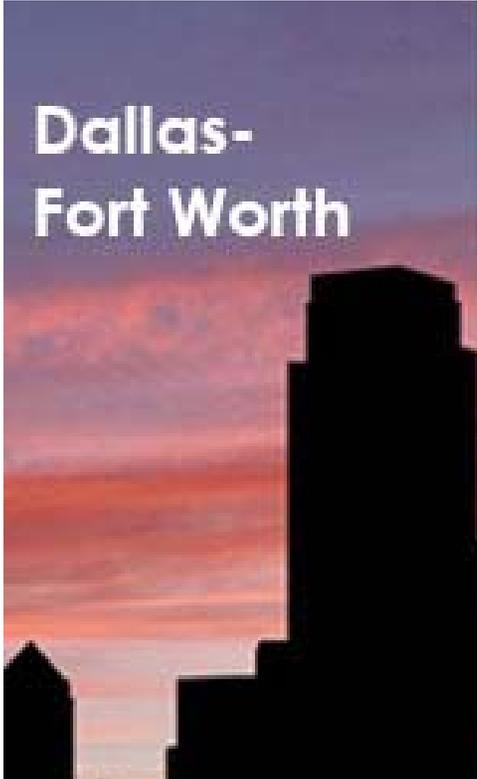
Greater New York Region

U.S. Patent and Trademark Office

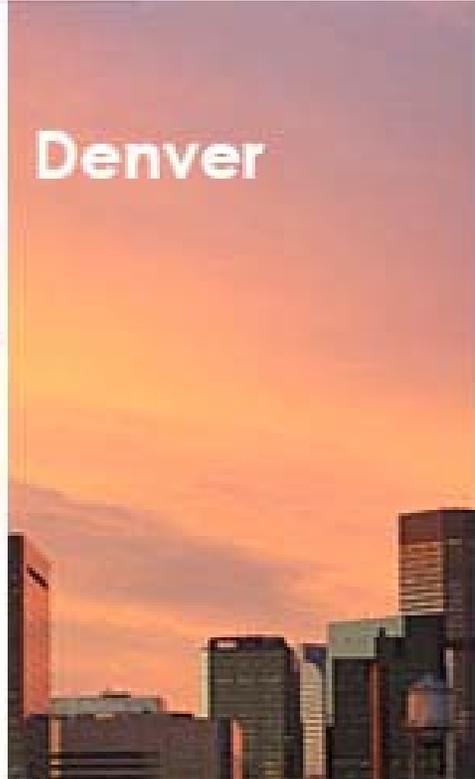
Department of Commerce

Satellite Office Program

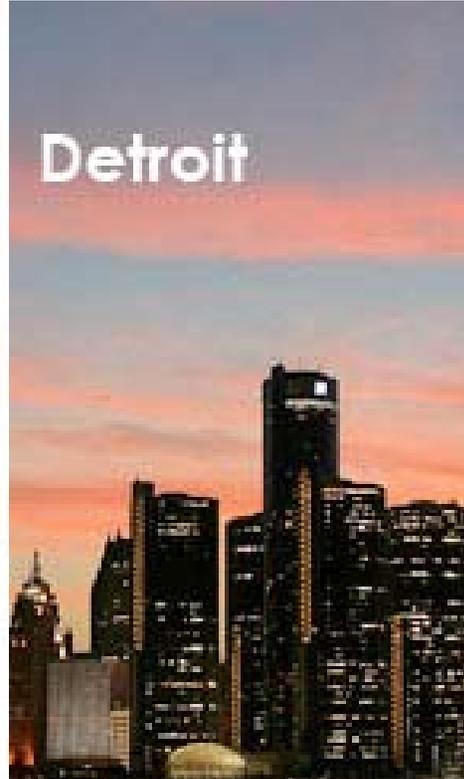
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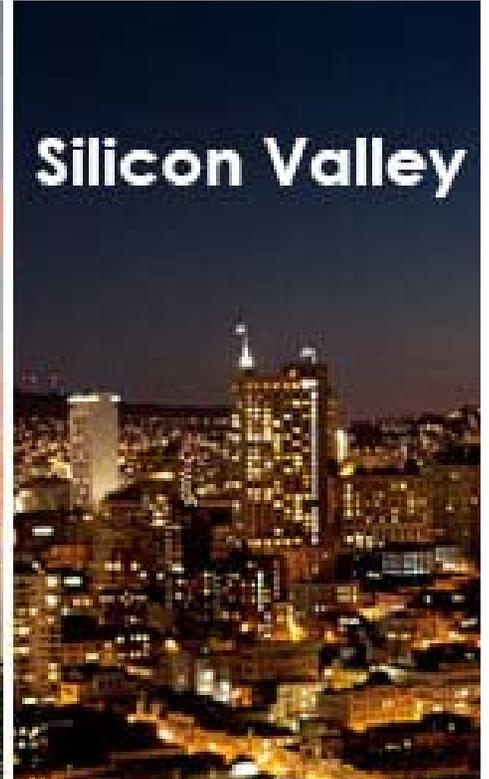
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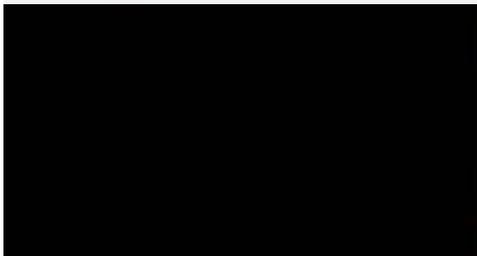
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Silicon Valley



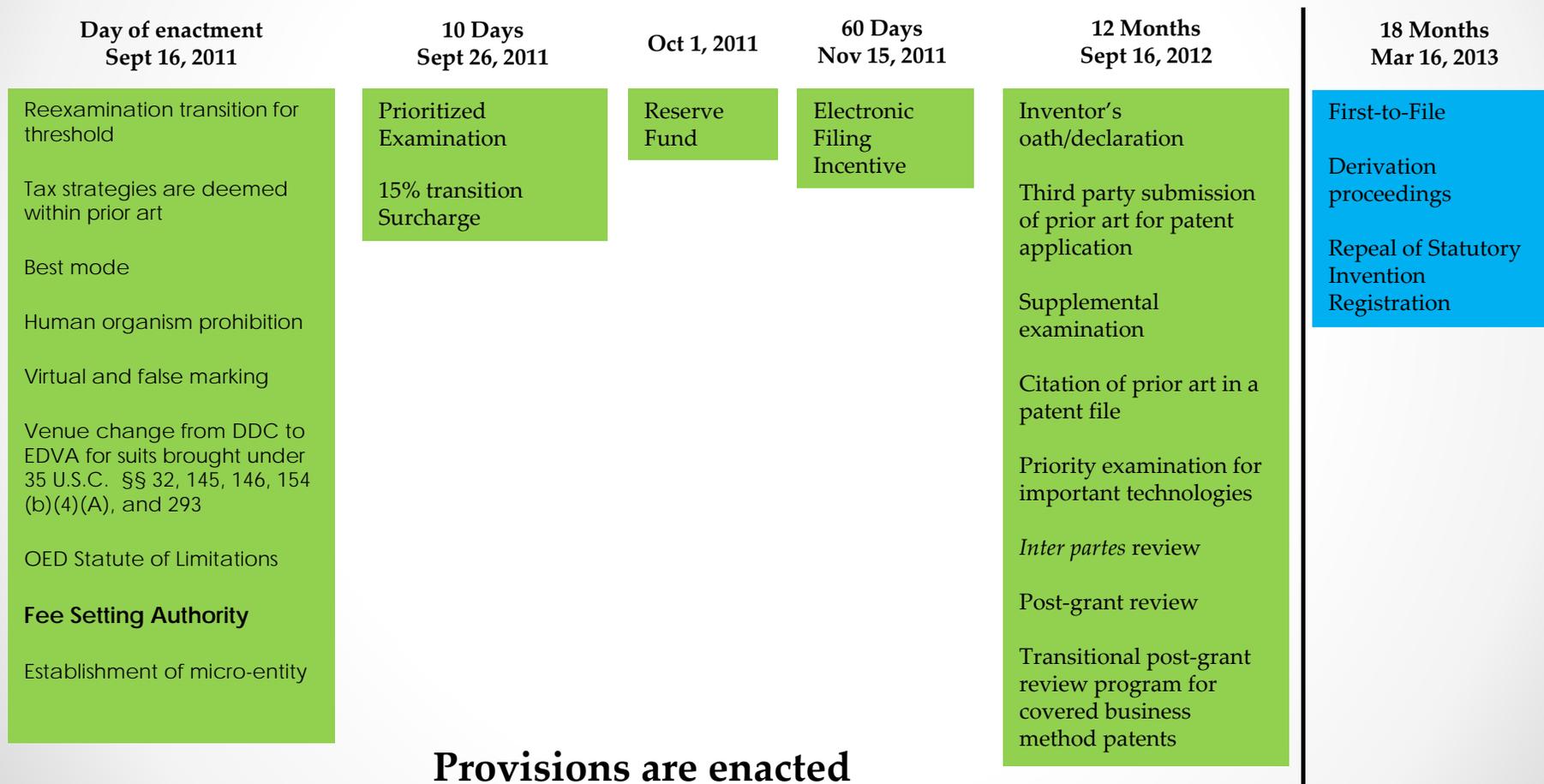
● historic expansion ● regional job growth ● an innovation ecosystem ● concepts of operation



Expanded Outreach in NYC



AIA Implementation Timeline



First Inventor to File: Ongoing Rulemaking

- Effective Date: March 16, 2013
- Comment Period closed November 5, 2012
- Roundtable on First-Inventor-to-File Provision held September 6, 2012 at USPTO headquarter in Alexandria, VA

Goals of Rulemaking

- 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

AIA Changes to 102

- AIA transitions U.S. to a first-inventor-to-file system
 - Interferences eliminated
 - New derivation proceedings created
 - Derivation can be used to disqualify certain disclosures from being prior art during 1 year grace period.
- Hybrid between first-to-invent (current U.S. law) and first-to-file (used in all other industrialized countries)
- *Compare* old section 102 to new section 102(a)(2) (which precludes a patent if the invention was described in a US patent or published US patent application effectively filed by another before the applicant's effective filing date.) Prior art can be a foreign filing date.
- Note, 102(e) has been eliminated and new 102(d) eliminates *Hilmer* issue.

One Year Grace Period

- Maintains a 1-year grace period for inventor disclosures:
 - An inventor will have a one-year grace period within which to publicly disclose their invention before filing a patent application, then disclosure will not be defeating prior art (note this grace period is not the same as existing law).
- Compare old section 102(b) to new section 102(b)(1)
 - Old 102(b) provided a one-year grace period against patents and printed publications (anywhere) and public uses or "on sale" in the US. What qualified as "on sale" was defined by case law.
 - New 102(b)(1) provides that a disclosure is not prior art if the disclosure was made one year or less before the effective filing date of the claimed invention and (A) the disclosure was made by the inventor or someone, who obtained the subject matter from the inventor, or (B) before the disclosure, the subject matter was publicly disclosed (e.g. published) by the inventor or someone who obtained the subject matter from the inventor .

Section 102 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

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