



America Invents Act, also referred to as AIA, in its First Inventor to File Provision (FITF) redefines Prior Art. These changes will affect any application with a claimed invention having an effective filing date on or after March 16, 2013 **so we will slowly transition to examining these applications as they rise to the top of our dockets.** These applications will be known as AIA Applications and be easily identified in eDAN and PALM. All other applications will be referred to as Pre-AIA Applications (FTI).

The objective of this video is to introduce you to the new statute. It will provide a basic understanding of the statutory framework of AIA 35 USC 102 to make future training more effective.

To help you through this transition, training will be offered in three phases. While this video will not answer all of your questions, understanding the content of this video will help prepare you for the next phase of your training.



## AIA Training Plan

- Overview Training: How to know if your application is subject to the new AIA (FITF) provisions and introduction to the new statutory framework (March 2013)
- Comprehensive training (June/July 2013)
- Just-in-time training: available as needed (March through July 2013)



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Training will begin in March with an overview of the AIA (FITF) provisions. It will provide instruction on how to know if your application is subject to the new provisions, and it will also introduce the new statutory framework. Comprehensive training will follow in the summer.

Examiners should rely on AIA indicators that will be available in both PALM and eDan to quickly determine whether their application is AIA or Pre-AIA. **Since the provisions of AIA apply to applications with a claimed invention having an effective filing date on or after March 16, 2012, you should not immediately find yourself working on AIA Applications.** However, if you do, just in time training will be provided as needed by Points of Contact in your Technology Center until the Comprehensive Training is rolled out this summer.

Now let's take a look at the impact that the AIA FITF provisions have on 35 USC 102.



## AIA Impact on 35 U.S.C. 102

Pre-AIA 35 U.S.C. 102 A person shall be entitled to a patent unless—	AIA 35 U.S.C. 102 Concordance
(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or	102(a)(1)
(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or	102(a)(1)
(c) He has abandoned the invention	No corresponding provision
(d) The invention was first patented or described in a printed publication in a foreign country, or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or	No corresponding provision
(e) The invention was described in (1) An application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) A patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language, or	102(a)(2)
(f) He did not invent the invention	101 and 115
(g) during the course of the invention process, the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or	No corresponding provision
(2) Before such invention process, the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or	No corresponding provision

This chart shows how pre-AIA section 102 compares to the framework of the AIA’s section 102.

Pre-AIA sections 102(a) and (b) provide for rejections on the basis of prior public disclosures. The AIA’s counterpart of these sections is AIA section 102(a)(1). AIA section 102(a)(1) is not simply a restatement of pre-AIA sections 102(a) and (b) but does pertain to the same type of prior art, that is, prior public disclosures.

Pre-AIA sections 102(c) and (d) have no counterpart in the AIA.

Pre-AIA section 102(e) provides for rejections on the basis of prior-filed U.S. patents, U.S. patent application publications, or published PCT applications previously filed by another. The AIA’s counterpart of this section is AIA section 102(a)(2). Again, AIA section 102(a)(2) is not simply a restatement of pre-AIA section 102(e) but does pertain to the same type of prior art, that is, prior-filed U.S. patents, U.S. patent application publications, or published PCT applications by another.

Pre-AIA sections 102(f) and 102(g) have no counterpart in the AIA.



# 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	<b>102(b)(1)</b>	<b>(A)</b> Grace Period Disclosure by Inventor or Obtained from Inventor
		<b>(B)</b> Grace Period Intervening Disclosure by Third Party
<b>102(a)(2)</b> U.S. Patent, U.S. Patent Application, and PCT Application with Prior Filing Date	<b>102(b)(2)</b>	<b>(A)</b> Disclosure Obtained from Inventor
		<b>(B)</b> Intervening Disclosure by Third Party
		<b>(C)</b> Commonly Owned Disclosure



This chart illustrates the statutory framework of the AIA's section 102.



# 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	<b>102(b)(1)</b>	<b>(A)</b> Grace Period Disclosure by Inventor or Obtained from Inventor
		<b>(B)</b> Grace Period Intervening Disclosure by Third Party
<b>102(a)(2)</b> U.S. Patent, U.S. Patent Application, and PCT Application with Prior Filing Date	<b>102(b)(2)</b>	<b>(A)</b> Disclosure Obtained from Inventor
		<b>(B)</b> Intervening Disclosure by Third Party
		<b>(C)</b> Commonly Owned Disclosure

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Section 102(a), in the first column, provides the basis for any rejection. The AIA's section 102(a)(1), the green shaded box, provides for rejections on the basis of disclosures; that is, patents, publications, sales and uses, made public before the applicant's effective filing date. The AIA's section 102(a)(2), the yellow shaded box, provides for rejections on the basis of U.S. patents, U.S. patent application publications, or published PCT applications, by another, that were effectively filed before the applicant's effective filing date. Under the AIA, prior art used in any rejection will be on the basis of either section 102(a)(1) or 102(a)(2).



# 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	<b>102(b)(1)</b>	<b>(A)</b> Grace Period Disclosure by Inventor or Obtained from Inventor
<b>102(a)(2)</b> U.S. Patent, U.S. Patent Application, and PCT Application with Prior Filing Date	<b>102(b)(2)</b>	<b>(B)</b> Grace Period Intervening Disclosure by Third Party
		<b>(A)</b> Disclosure Obtained from Inventor
		<b>(B)</b> Intervening Disclosure by Third Party
		<b>(C)</b> Commonly Owned Disclosure

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Section 102(b) provides for exceptions to section 102(a). It is not a basis for a rejection. Specifically, (b)(1), the blue shaded boxes, provides exceptions that apply to (a)(1); and (b)(2), the orange shaded boxes, provides exceptions that apply to (a)(2).



# 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	<b>102(b)(1)</b>	<b>(A)</b> Grace Period Disclosure by Inventor or Obtained from Inventor
		<b>(B)</b> Grace Period Intervening Disclosure by Third Party
<b>102(a)(2)</b> U.S. Patent, U.S. Patent Application, and PCT Application with Prior Filing Date	<b>102(b)(2)</b>	<b>(A)</b> Disclosure Obtained from Inventor
		<b>(B)</b> Intervening Disclosure by Third Party
		<b>(C)</b> Commonly Owned Disclosure

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Section 102(b)(1), the blue shaded boxes, provides two exceptions for disclosures within the grace period. The grace period is the period that is one year or less before the applicant's effective filing date. There is no exception for a public disclosure that is outside this one-year grace period. The first exception in (b)(1) is for grace period disclosures of an inventor's own work, either by an inventor or by another who obtained the work from an inventor. The second exception in (b)(1) is for grace period disclosures, by another, of subject matter that was previously publicly disclosed by an inventor.



# 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	<b>102(b)(1)</b>	<b>(A)</b> Grace Period Disclosure by Inventor or Obtained from Inventor
		<b>(B)</b> Grace Period Intervening Disclosure by Third Party
<b>102(a)(2)</b> U.S. Patent, U.S. Patent Application, and PCT Application with Prior Filing Date	<b>102(b)(2)</b>	<b>(A)</b> Disclosure Obtained from Inventor
		<b>(B)</b> Intervening Disclosure by Third Party
		<b>(C)</b> Commonly Owned Disclosure

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Section 102(b)(2), the orange shaded boxes, provides three exceptions for disclosures in U.S. patents, U.S. patent application publications, or published PCT applications, by another, that were applied for before the applicant's effective filing date. The first exception in (b)(2) is for disclosures of an inventor's own work, by another, who obtained the work from an inventor and is similar to the first exception in (b)(1). The second exception in (b)(2) is for disclosures by another of subject matter that was previously publicly disclosed by an inventor and is similar to the second exception in (b)(1). The third exception in (b)(2) is for commonly owned disclosures and has no corresponding provision in (b)(1).



## Changes For AIA Applications

- Rejections under Pre-AIA 35 USC 102 (a)-(g) are **OUT**. Rejections under AIA 35 USC 102(a)(1) and 102(a)(2) are **IN**.
- Effective filing dates and effective prior art dates may be afforded to **foreign filing dates**.
- Swearing behind a reference (i.e. 131 Affidavit) is **OUT**. Showing prior public disclosure is **IN**.
- Commonly owned disclosures also may be excluded from some **anticipation** rejections.



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In conclusion, a lot of big changes are coming for AIA Applications.

As we discussed for AIA Applications,

rejections under Pre-AIA 35 USC 102 (a)-(g) are OUT. Rejections under AIA 35 USC 102(a)(1) and 102(a)(2) are IN.

Additional changes to be discussed in the comprehensive training include:

Effective filing dates and effective prior art dates may be afforded to foreign filing dates.

Swearing behind a reference using a 131 Affidavit is OUT.

Showing prior public disclosure is IN.

Commonly owned disclosures also may be excluded from some anticipation rejections similar to the current 103(c) exclusion for obviousness rejections.

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