

AIA **F**irst **I**nventor **t**o **F**ile **H**ands **O**n **W**orkshop



Review of 35 U.S.C. 102(a)(1)
and 35 U.S.C. 102(a)(2)



Potential Prior Art Is Identified in 35 U.S.C. 102(a)(1) and 102(a)(2)

Only two subsections of the AIA identify potential prior art:

- **102(a)(1)** is for **public disclosures** that have a public availability date *before the effective filing date* of the claimed invention under examination.
- **102(a)(2)** is for issued or published U.S. patent documents that are by another and that have an effectively filed date that is *before the effective filing date* of the claimed invention under examination.



Effective Filing Date under the AIA

- The availability of a disclosure as prior art under 102(a)(1) or 102(a)(2) depends upon the effective filing date of the claimed invention.
- Unlike pre-AIA law, the AIA provides that a foreign priority date can be the effective filing date of a claimed invention.
- **The foreign priority date is the effective filing date of the claimed invention IF**
 - the foreign application supports the claimed invention under 112(a), AND
 - the applicant has perfected the right of priority by providing:
 - a certified copy of the priority application, and
 - a translation of the priority application (if not in English).



AIA Statutory Framework

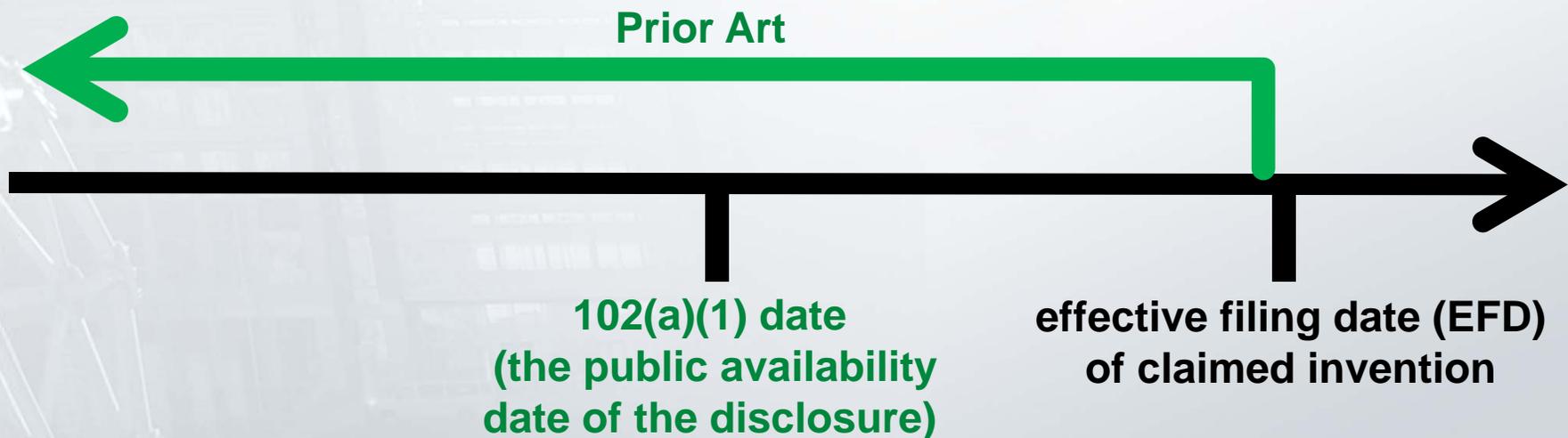
| Prior Art 35 U.S.C. 102(a) (Basis for Rejection) | Exceptions 35 U.S.C. 102(b) (Not Basis for Rejection) | |
|---|--|--|
| 102(a)(1) Disclosure with Prior Public Availability Date | 102(b)(1) | (A) Grace Period Disclosure by Inventor or Obtained from Inventor |
| | | (B) Grace Period Intervening Disclosure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



35 U.S.C. 102(a)(1): Public Disclosure with Public Availability Date before the Effective Filing Date of the Claimed Invention

102(a)(1) potential prior art includes **public disclosures** that have a public availability date before the effective filing date of the claimed invention and are:

- patented;
- described in a printed publication;
- in public use;
- on sale; or
- otherwise available to the public.





102(b)(1)(A) Exception to Potential Prior Art under 35 U.S.C. 102(a)(1)

For the 102(b)(1)(A) exception to apply to a public disclosure under 102(a)(1), the public disclosure must be:

- within the grace period and
- an "inventor-originated disclosure" (i.e., the subject matter in the public disclosure must be attributable to the inventor, one or more co-inventors, or another who obtained the subject matter directly or indirectly from the inventor or a co-inventor).



102(b)(1)(B) Exception to Potential Prior Art under 35 U.S.C. 102(a)(1)

For the 102(b)(1)(B) exception to apply to a third party's disclosure under 102(a)(1):

- the third party's disclosure must have been made during the grace period of the claimed invention,
- an inventor-originated disclosure (i.e. shielding disclosure) must have been made prior to the third party's disclosure, and
- both the third party's disclosure and the inventor-originated disclosure must have disclosed the same subject matter.



Recognizing a 102(b)(1)(A) or 102(b)(1)(B) Exception to a Potential 102(a)(1) Reference

It is clear that one of the 102(b)(1) exceptions applies when:

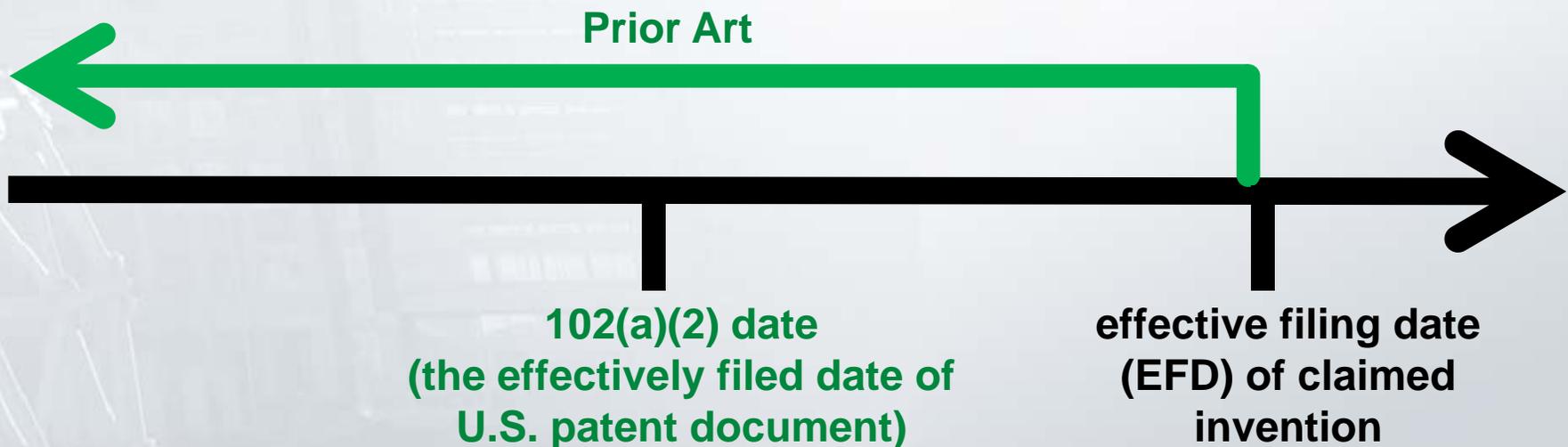
- the authorship of the potential reference disclosure only includes one or more joint inventor(s) or the entire inventive entity of the application under examination, or
- there is an appropriate affidavit or declaration under 37 CFR 1.130(a) (attribution) or 1.130(b) (prior public disclosure), or
- the specification of the application under examination identifies the potential prior art disclosure as having been made by or having originated from one or more members of the inventive entity, in accordance with 37 CFR 1.77(b)(6).



35 U.S.C. 102(a)(2): U.S. Patent Documents with Effectively Filed Date before Effective Filing Date of the Claimed Invention

102(a)(2) potential prior art includes issued or published U.S. patent documents that name another inventor and have an effectively filed date before the effective filing date of the claimed invention:

- U.S. Patent;
- U.S. Patent Application Publication; or
- WIPO published PCT (international) application that designates the United States





102(b)(2)(A) Exception to Potential Prior Art under 35 U.S.C. 102(a)(2)

For the 102(b)(2)(A) exception to apply to a potential prior art U.S. patent document, the U.S. patent document must:

- disclose subject matter that was obtained from one or more members of the inventive entity, either directly or indirectly.



102(b)(2)(B) Exception to Potential Prior Art under 35 U.S.C. 102(a)(2)

For the 102(b)(2)(B) exception to apply to a third party's potential prior art U.S. patent document:

- third party's U.S. patent document must have been effectively filed before the EFD of the claimed invention,
- an inventor-originated disclosure (i.e. shielding disclosure) must have been made prior to the effectively filed date of the third party's U.S. patent document, and
- both the third party's U.S patent document and the inventor-originated disclosure must have disclosed the same subject matter.



Recognizing a 102(b)(2)(A) or 102(b)(2)(B) Exception to a Potential 102(a)(2) Reference

It is clear that the 102(b)(2)(A) or 102(b)(2)(B) exception applies when:

- the inventive entity of the disclosure only includes one or more joint inventor(s), *but not the entire inventive entity*, of the application under examination, or
- there is an appropriate affidavit or declaration under 37 CFR 1.130(a) (attribution) or 1.130(b) (prior public disclosure), or
- the specification of the application under examination identifies the potential prior art disclosure as having been made by or having originated from one or more members of the inventive entity.



102(b)(2)(C) Exception to Potential Prior Art under 35 U.S.C. 102(a)(2)

For the 102(b)(2)(C) exception to apply, the subject matter of the U.S. patent document and the claimed invention in the application under examination must have been:

- owned by the same person,
- subject to an obligation of assignment to the same person, or
- deemed to have been owned by or subject to an obligation of assignment to the same person,

not later than the effective filing date of the claimed invention.



Recognizing a 102(b)(2)(C) Exception to a Potential 102(a)(2) Reference

- A statement on the record that either common ownership in accordance with 102(b)(2)(C) or a joint research agreement in accordance with 102(c) were in place is sufficient.
- A declaration or affidavit is not necessary.