

From: Cheryl Milone

Sent: Monday, November 05, 2012 11:47 PM

To: fitf_rules

Subject: Comments by Article One Partners, LLC to First Inventor to File Changes to Implement the AIA and Guidelines

Dear Under Secretary Kappos,

Attached please find comments by Article One Partners, LLC to “Changes to Implement the First Inventor to File Provisions of the Leahy-Smith America Invents Act” 77 Fed. Reg. 43732 (July 26, 2012) and “Examination Guidelines for Implementing the First Inventor to File Provisions of the Leahy-Smith America Invents Act” 77 Fed. Reg. 43759 (July 26, 2012).

Please confirm receipt by email.

Best,

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November 5, 2012

The Honorable David J. Kappos
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office
United States Patent and Trademark Office
600 Dulany Street
Alexandria, VA 22314

Via email: fitf_rules@uspto.gov

Re: Comments on: "Changes to Implement the First Inventor to File Provisions of
them Leahy-Smith America Invents Act" 77 Fed. Reg. 43732 (July 26, 2012)

Comments on: "Examination Guidelines for Implementing the First Inventor
to File Provisions of the Leahy-Smith America Invents Act" 77 Fed. Reg.
43759 (July 26, 2012)

Dear Under Secretary Kappos:

Article One Partners, LLC ("AOP") respectfully submits its comments on the "Changes to Implement the First Inventor to File Provisions of the Leahy-Smith America Invents Act" 77 Fed. Reg. 43732 (July 26, 2012) and "Examination Guidelines for Implementing the First Inventor to File Provisions of the Leahy-Smith America Invents Act" as published in the Federal Register at 77 Fed. Reg. 43759 (July 26, 2012).

Article One crowdsources patent research. Our platform is the world's largest patent research community. Our global community is 25,000 plus researchers from 160 countries. The AOP global crowd reflects an advancement in patent research aligned with the America Invents Act's ("AIA") recognition of the globalization of the U.S. patent system. The AOP crowd accomplishes this based on reviewing technology descriptions in AOP research requests and finding prior art with the same technology descriptions. The community works on a technical mapping basis; AOP does not practice law.

We at Article One are honored to work members of the public who have self-selected to research on our platform. AOP feels fortunate to represent the unique view of researchers worldwide. We interact with our researchers on an educational level about the patent system and the identification of prior art globally, as well as the technical mapping of claim language to prior art. Thus, we strongly support that the AIA amendments serve to clarify and simplify legal standards and their application, so that both patent industry members and the public can better understand and access the patent system.

The U.S. Patent and Trademark Office (PTO), with your Honor's leadership, is commendable for its ongoing mission to improve the patent system with a focus on patent quality. As a stakeholder in the patent industry, we appreciate the opportunity to respond to the PTO's request for comments per 77 Fed. Reg. 43732 and 43759.

Article One recommends that the PTO in the Notice of Final Rulemaking or Examiner Guidelines to implement the First Inventor to File AIA provisions explicitly provide that public accessibility is a required component of all categories of prior art under 35 U.S.C. §102(a)(1), including that “otherwise available to the public” provides a catch-all for public disclosures not listed explicitly in 102(a)(1) and a qualifier that each category of prior art under 102(a)(1) requires that the disclosure or activity be accessible to the public. This includes that “on sale” activities must be public to be available as prior art. We respectfully provide our analysis and support below.

The interpretation of “otherwise available to the public” under AIA 35 U.S.C. §102(a)(1)

AIA 102(a)(1) adds the phrase or “otherwise available to the public. The “public” component of the definition of prior art has been the subject of conflicting legal precedent. The PTO final rules are an opportunity to clarify earlier ambiguity. Article One supports the application of public accessibility to the definition of “prior art” based on the phrase “or otherwise available to the public” on two bases: a) to add a catch-all provision ensuring that any prior art *not* captured by the list of categories in 102(a)(1) - “patented, described in a printed publication, or in public use, on sale,” - but which may also be public, does not fall through the cracks, and b) to qualify that each category of prior art under 102(a)(1) requires that the disclosure or activity be accessible to the public (see the definition of “public” below).

Article One further supports the PTO’s stated purpose for “decision makers to focus on whether the disclosure was ‘available to the public,’ rather than on the means by which the claimed invention became available to the public or on whether a disclosure constitutes a ‘printed publication’ or falls with another category of prior art as defined in [102(a)(1)].” 77 Fed. Reg. 43765. In listing examples of such public disclosures, such as posters, information disseminated at a scientific meeting or a document available on the Internet, we believe the PTO correctly reduces ambiguity to direct the focus simply on whether the disclosure is public.

Senator Kyl said as much on the Senate floor, noting that “or otherwise available to the public” had been intended to “clarify the broad scope of relevant prior art.” See 157 Congressional Rec. S 1370. The stated goal of the PTO in implementing the AIA is to increase objectivity and simplicity at a global level in patent determinations. 37 Fed. Reg. 43765.

Article One supports this interpretation of “otherwise available to the public” in order to provide a simplification that all prior art must be public. Members of the public are subject to the patent system regardless of their knowledge of the law, such as when they are faced with a patent litigation. Patent infringement is strict liability. Infringement is found and damages applied even in cases where an infringer has no knowledge or intention of infringing. Thus, the more intuitive the language and application of the law, the better the patent system can serve members of the public subject to the obligations of the patent system as well as stakeholders.

The Definition of “public” under AIA 35 U.S.C. §102(a)(1)

In light of the above, it follows that the term “public” in the phrase “otherwise available to the public” should be applied as a required qualifier of each category of prior art listed in 102(a)(1). The new AIA language should be interpreted to support that *any* public disclosure (“printed publication, public use, on sale, or otherwise available”) *anywhere* (i.e., globally; “foreign country” has been eliminated) before the effective filing date is available as prior art.

The Definition of “On Sale” under AIA 35 U.S.C. §102(a)(1)

In response to the PTO’s request for comments on the “extent to which public availability plays a role in ‘on sale’ prior art,” AOP proposes applying the public component of 102(a)(1) to “on sale” so that only those sales which are truly public are deemed to be prior art. We recommend that the PTO clarify that a sale should be sufficiently public, i.e., not private, in order for the transaction to have been public.

The clarification that a sale means a public sale allows the PTO to focus on *whether* the invention was available rather than *how* it became available by eliminating a decision makers’ need to assess whether a sale was public or private. It is important as well that sales subject to confidentiality agreements should be considered private sales that do not meet the requirement of being public to create prior art.

Because the language (“or otherwise available to the public”) and legislative history (Senator Kyl’s remarks above) emphasize the public characterization of prior art, it follows that private sales remain just that – private sales. See 157 Cong. Rec. S 1370 (March 8, 2011). See also 77 Fed. Reg. 43765, FN 29 (stating that “[t]he legislative history of the AIA indicates that the inclusion of [the clause ‘or otherwise available to the public’] in AIA [102(a)(1)] should be viewed as indicating that [102(a)(1)] does not cover non-public uses or non-public offers for sale” (also citing Senator Kyl)).

Conclusion

AOP thanks the PTO for the opportunity to submit comments. AOP would also like to note that while including “secret” art in the definition of prior art may increase the need for different prior art search techniques, it is not the best outcome for the patent industry and public. Our vision is the ongoing improvement of patent quality. We give our enthusiastic support to a U.S. patent system with this as its focus.

Respectfully submitted,

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CEO and CO-Founder
Article One Partners, LLC