

From: John Pegram
Sent: Friday, November 02, 2012 5:00 PM
To: Kappos, David; fitf_guidance
Cc: Guetlich, Mark
Subject: AIA section 102 Guideline Comments

Please see the attached letter.

John B. Pegram - Senior Principal
Fish & Richardson P.C. | 52nd Floor, 601 Lexington Avenue, New York, NY 10022-4611
| Tel.: 212-765-5070 | pegram@fr.com

This email message is for the sole use of the intended recipient(s) and may contain confidential and privileged information. Any unauthorized use or disclosure is prohibited. If you are not the intended recipient, please contact the sender by reply email and destroy all copies of the original message.

IRS CIRCULAR 230 DISCLOSURE: Any U.S. tax advice contained in this communication (including any attachments) is not intended or written to be used, and cannot be used, for the purpose of (i) avoiding penalties under the Internal Revenue Code or (ii) promoting, marketing or recommending to another party any transaction or matter addressed herein. (FR08-i203d)

FISH & RICHARDSON P.C.

601 Lexington Avenue,
52nd Floor
New York, New York
10022

Telephone
212 765-5070

Facsimile
212 258-2291

Web Site
www.fr.com

Frederick P. Fish
1855-1930

W.K. Richardson
1859-1951

VIA EMAIL to David.Kappos@uspto.gov
& fitf_guidance@uspto.gov

The Honorable David Kappos
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office
P.O. Box 1450
Alexandra, VA 22313-1450



Re: Section 102(a)(1) Guideline Comments

Dear Director Kappos:

I write in response to the invitation at 77 Fed. Reg. 43762-65 to comment on possible AIA examination guidelines under the provisions of new 35 U.S.C §102(a)(1), providing that “a person shall be entitled to a patent unless (1) The claimed invention was patented, described in a printed publication, or in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention.....”

These are my personal comments as of this date, and do not purport to represent the views of any firm, client or association with which I am associated.

A. Summary

1. The guideline comments reveal that there is a genuine difference of opinion regarding whether the AIA modified the meaning of “in public use,” and “on sale” in Section 102 from the existing law.

2. This is an issue of substantive law that the PTO cannot decide by rulemaking or guidelines. It is highly likely that the issue will be litigated, especially because relevant parts of the existing law are court-made and because the persons urging that the law was changed rely primarily on portions of the legislative history.

ATLANTA

AUSTIN

BOSTON

DALLAS

DELAWARE

HOUSTON

MUNICH

NEW YORK

SILICON VALLEY

SOUTHERN CALIFORNIA

TWIN CITIES

WASHINGTON, DC

3. The most appropriate course is for the Office to not attempt a new interpretation, to apply existing interpretations of the same terms and to expedite any appeals. In particular:

a. The PTO guidelines and examining practice should interpret each of the terms “patented,” “described in a printed publication,” “in public use,” and “on sale” in new section 102(a)(1) in the same way as those same terms in section 102 of the old law have been interpreted in the applicable judicial precedents;

b. The term “, or otherwise available to the public” in new Section 102(a)(1) should be interpreted as an additional, broadening provision, encompassing, for example, disclosures of the type listed under the heading “Otherwise available prior art” in column 2 at 77 Fed. Reg. 43765; and should not be interpreted as limiting or affecting interpretation of other, preceding terms in new section 102(a)(1); and

c. The Office should give special priority to review by appeal of rejections under section 102(a)(1) and other provisions of the AIA where a party contends that the office has wrongly interpreted a provision of the AIA.

B. Discussion

The recommendations summarized above would be most likely to expedite resolution of the questions of interpretation of Section 102(a)(1) and minimize the likelihood that the Office would issue patents later subject to attack on the grounds that they were issued under an improper interpretation of the law. The duty of disclosure would require disclosure, for example, of prior art processes practiced by the applicant in secret.

Further comments on Section 102(a)(1) are set forth below.

1. “Disclosure”

The proposed guidelines, beginning at column 3 of 77 Fed. Reg. 43763, correctly treat “disclosure” as a generic term intended to encompass all of the prior art defined

in Section 102(a). However, the fact that “disclosure” encompasses prior art such as later published patent applications, effective as of their priority date, suggests that “disclosure” cannot be equated with publically available.

2. “Patented”

I agree with the proposed guideline at column 1 on 77 Fed. Reg. 43764 that the term “patented” should be given the same meaning as under pre-AIA Sections 102(a) and (b). However, Examiners should be generally advised to cite prior art patents when possible on grounds of “described in a printed publication” under Section 102(a)(1), rather than as “patented,” because that would avoid the issue of whether the claimed invention of a pending application was “patented” in the prior art reference.

3. “Described in a printed publication”

I agree with the Office’s opinion that AIA does not change this requirement from corresponding language in pre-AIA Sections 102(a) and (b). The Office is correct to point out that the enablement requirement applied to such prior art has not been the same as that which an application must satisfy under Section 112. There does not appear to have been any intent to modify this distinction in the legislative history of the AIA.

4. “In public use” and “on sale”

I believe that the proposed guidelines are correct in instructing that the terms “in public use” and “on sale” in AIA Section 102(a)(1) should be treated as having the same meaning as in Pre-AIA Section 102(b). While some persons have suggested that the additional phrase “, or otherwise available to the public” was intended to limit “public use” and “on sale,” I suggest that the best course for the PTO would be to apply existing law and expedite any appeals raising an issue of interpretation the AIA.

I note, however, that the proposed guidelines for “public use” and “on sale” rejections include a vague discussion of “public availability” standards. In light of the use of the same statutory language as in prior law, and the disputes regarding the effect of the added phrase “, or otherwise available to the public”, the Office should leave the issue of whether that phrase modifies the “public use” and “on sale” standards to the courts,

and should refrain from issuing guidelines on “public availability” with respect to the “public use” and “on sale” requirements.

5. “*Otherwise available prior art*”

The plain meaning of this language, without resort to legislative history, is to add disclosures that are available to the public and that may not be included in the pre-existing categories of “patented,” “described in a printed publication,” in public use” or “on sale.” In my opinion, the Office is correct in issuing guidelines, as indicated at column 2 on 77 Fed. Reg. 43765, indicating how Examiners should cite such art. Because such art may be less permanent and readily accessible than printed publications, for example, I suggest that Examiners be given more detailed guidelines.

Respectfully submitted,

s/ John B. Pegram

John B. Pegram

cc: mark.guetlich@uspto.gov