

**From:** Amanda.CarmanyRampey

**Sent:** Friday, October 05, 2012 7:53 PM

**To:** fitf\_rules

**Subject:** WSPLA Comments on Examination Guidelines for Implementing the First-Inventor-To-File

Attached are comments from the Washington State Patent Law Association on the Examination Guidelines for Implementing the First-Inventor-To-File Provisions of the Leahy-Smith America Invents Act, 77 FR 43,759, published on July 26, 2012.

Thank you,

Amanda J. Carmany-Rampey

**Amanda Carmany-Rampey Ph.D.**

Associate

206-405-2007 Direct

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LAW

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October 5, 2012

**VIA EMAIL ONLY**  
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Mail Stop Comments—Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Attention: Mary C. Till, Senior Legal Advisor, Office of Patent Legal Administration, Office of the Deputy  
Commissioner for Patent Examination Policy

Dear Under Secretary Kappos:

The Washington State Patent Law Association ("WSPLA") appreciates the opportunity to provide comments on the "Examination Guidelines for Implementing the First-Inventor-To-File Provisions of the Leahy-Smith America Invents Act" published on July 26, 2012 in the Federal Register (77 FR 43,759). WSPLA is the leading organization for patent attorneys and other patent professionals in the State of Washington, providing a forum for patent and other intellectual property law issues, and serving as a valuable resource for patent attorneys, agents, educators, students, and owners of intellectual property in our state. WSPLA offers the following comments regarding the proposed examination guidelines for implementing the "first inventor to file" (FITF) system.

As amended by the America Invents Act (AIA), 35 U.S.C. § 102(a) defines the categories of prior art that will preclude the grant of a patent and 35 U.S.C. § 102(b) provides exceptions for certain disclosures that would otherwise qualify as prior art. Specifically, 35 U.S.C. § 102(b)(1) excludes disclosures made 1 year or less before the effective filing date of a claimed invention that would otherwise qualify as prior art under 35 U.S.C. § 102(a)(1)<sup>1</sup> if "the disclosure was made by the inventor or joint inventor or by another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor"<sup>2</sup> or "the subject matter disclosed had, before such disclosure, been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor."<sup>3</sup> For disclosures appearing in applications and patents, the exception in 35 U.S.C. § 102(b)(2) excludes disclosures that would otherwise qualify as prior art under 35 U.S.C. § 102(a)(2)<sup>4</sup> if "the subject matter disclosed was obtained directly or indirectly from the inventor or a joint inventor"; "the subject matter disclosed had, before such subject matter was effectively

<sup>1</sup> "[T]he 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."

<sup>2</sup> 35 U.S.C. § 102 (b)(1)(A).

<sup>3</sup> 35 U.S.C. § 102 (b)(1)(B).

<sup>4</sup> "[T]he claimed invention was described in a patent issued under section 151, or in an application for patent published or deemed published under section 122(b), in which the patent or application, as the case may be, names another inventor and was effectively filed before the effective filing date of the claimed invention."

filed under subsection (a)(2), been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor”; or “the subject matter disclosed and the claimed invention, not later than the effective filing date of the claimed invention, were owned by the same person or subject to an obligation of assignment to the same person.” The legislative history of the AIA indicates that the exceptions established by 35 U.S.C. § 102(b) were intended to protect inventors who publically disclose their invention before filing a patent application by providing a grace period.<sup>5</sup> The proposed examination guidelines, however, practicably eliminate this grace period for any third-party disclosures that are not verbatim reproductions of a prior disclosure by the inventor or joint inventor.

The proposed examination guidelines interpret 35 U.S.C. § 102(b)(1)(B) and 35 U.S.C. § 102(b)(2)(B) as requiring that the “subject matter” publicly disclosed by the inventor and a subsequent third-party be the same in order for the exception to 35 U.S.C. § 102(a)(1) to apply. The proposed examination guidelines state that the prior art exceptions under 35 U.S.C. § 102(b)(1)(B) and 35 U.S.C. § 102(b)(2)(B) do not apply “[e]ven if the only differences between the subject matter in the prior art disclosure that is relied upon under 35 U.S.C. 102(a) and the subject matter publicly disclosed by the inventor before such prior art disclosure are mere insubstantial changes, or only trivial or obvious variations.” The effect of this interpretation is to effectively nullify the prior art exceptions under 35 U.S.C. § 102(b)(1)(B) and 35 U.S.C. § 102(b)(2)(B), except in instances where disclosures by the inventor and a subsequent third-party are practically identical. Such situations are highly unlikely to arise except in circumstances of deliberate copying, which is addressed in 35 U.S.C. § 102(b)(1)(A) and 35 U.S.C. § 102(b)(2)(A). The proposed examination guidelines therefore render 35 U.S.C. § 102(b)(1)(B) and 35 U.S.C. § 102(b)(2)(B) superfluous.

The interpretation of 35 U.S.C. § 102(b)(1)(B) and 35 U.S.C. § 102(b)(2)(B) promulgated in the proposed examination guidelines unduly limits the applicability of the prior art exceptions with respect to subsequent, non-derived, third-party disclosures, such that the exceptions are practically meaningless. The proposed examination guidelines do not cite any authority for this interpretation; to the contrary, the proposed examination guidelines are directly in conflict with the legislative history of the AIA<sup>6</sup>. Further, the proposed examination guidelines do not provide any examples of instances where two independent disclosures by an inventor and a subsequent third-party would not have “insubstantial changes” or “trivial or obvious variations.” Without further guidance, it is reasonable to interpret the provisions of 35 U.S.C. § 102(b)(1)(B) and 35 U.S.C. § 102(b)(2)(B) as being applicable only in instances of *verbatim* reproduction, a scenario likely already provided for under 35 U.S.C. § 102(b)(1)(A) and 35 U.S.C. § 102(b)(2)(A). Thus, it is unclear when, if ever, the prior art exceptions under 35 U.S.C. § 102(b)(1)(B) and 35 U.S.C. § 102(b)(2)(B) would apply under the proposed examination guidelines.

It is the opinion of WSPLA that references to “subject matter” in the provisions of 35 U.S.C. § 102(b)(1)(B) and 35 U.S.C. § 102 (b)(2)(B) should be interpreted to refer to subject matter of the disclosure relevant to the

<sup>5</sup> H.R. Rep. No. 112-98, 112th Cong., 1st Sess. 73 (June 1, 2011) (“New section 102(b) preserves the grace period, ensuring that during the year prior to filing, an invention will not be rendered unpatentable based on any of the inventor’s own disclosures, or any disclosure made by any party after the inventor has disclosed his invention to the public.”).

<sup>6</sup> *Id.*

claimed invention. For example, if a claim to "A and B" is rejected over a disclosure of "A, B, and C," the applicant should not be required to show prior disclosure of the unclaimed "C" in order to obtain protection under 35 U.S.C. § 102(b)(1)(B) and 35 U.S.C. § 102 (b)(2)(B). Such an interpretation would provide meaningful and logical protection to a disclosing inventor under the exception provisions. Moreover, this standard is consistent with the Patent Office's current practice with regard to 37 CFR § 1.131:

The 37 CFR 1.131 affidavit or declaration must establish possession of either the whole invention claimed or something falling within the claim (such as a species of a claimed genus), in the sense that the claim as a whole reads on it.... Further, a 37 CFR 1.131 affidavit is not insufficient merely because it does not show the identical disclosure of the reference(s) or the identical subject matter involved in the activity relied upon. If the affidavit contains facts showing a completion of the invention commensurate with the extent of the invention as claimed is shown in the reference or activity, the affidavit or declaration is sufficient, whether or not it is a showing of the identical disclosure of the reference or the identical subject matter involved in the activity."<sup>7</sup>

This interpretation would preserve the intent of the legislature in drafting 35 U.S.C. § 102(b)(1)(B) and 35 U.S.C. § 102(b)(2)(B).<sup>8</sup> Moreover, such an interpretation is supported by 35 U.S.C. § 102 itself. Specifically, 35 U.S.C. § 102(a)(1) states that a person shall be entitled to a patent unless "the claimed invention was ... described in a printed publication." Accordingly, the correct emphasis for determining the applicability of a publication is its relevancy to "the claimed invention." Further, the burden on the Patent Office would not be substantially increased by such an alteration to the rules – rather, an expanded interpretation of "subject matter" under 35 U.S.C. § 102(b)(1)(B) and 35 U.S.C. § 102(b)(2)(B) would fall in line with current practice with regard to 37 CFR § 1.131.

Thank you,

  
Amanda J. Carmany-Rampey  
Chair, Patent Office Rules and Practices Committee  
WSPLA

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<sup>7</sup> MPEP § 715.02.

<sup>8</sup> See supra note 5.