

March 28, 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: aia_implementation@uspto.gov

**Re: Guidance on Implementation of the First-Inventor-to-File Provisions
of the Leahy-Smith America Invents Act (“AIA”)**

Dear Under Secretary Kappos:

The American Intellectual Property Law Association (“AIPLA”) appreciates the opportunity to provide comments to the United States Patent and Trademark Office (“USPTO”) concerning its efforts to provide guidance for the transition to a first-inventor-to-file system under the Leahy-Smith America Invents Act (“AIA”).¹ The following comments are primarily directed to Section 3 of the AIA.

AIPLA is a national bar association with approximately 15,000 members who are primarily lawyers in private and corporate practice and government service and in the academic community. AIPLA represents a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, copyright, and unfair competition law. Our members represent both owners and users of intellectual property.

The AIA is a substantive step in the harmonizing of patent law between the United States and the emergent global intellectual property system in that it adopts a “First-Inventor-to-File” (“FITF”) system while maintaining a 12-month grace period for an inventor’s own disclosures or those derived from him or her. See, e.g., amended 35 U.S.C. §102(b).² Implementation of this new standard will require extensive revisions to the USPTO rules, policies, procedures, and practices.

AIPLA offers the following preliminary observations and suggestions regarding these revisions. As these are preliminary comments, we reserve the right to modify and refine these views as our consideration continues or as proposals are put forward.

¹ Publ. L. No. 112-29, 125 Stat. 284.

² Public Law 112-29, September 16, 2011, 125 STAT. 284, page 3, (<http://www.gpo.gov/fdsys/pkg/PLAW-112publ29/pdf/PLAW-112publ29.pdf>, last accessed March 4, 2012) and Report of the 112th Congress, 1st Session, Report 112-98, Part I, page 3. <http://judiciary.house.gov/issues/Patent%20Reform%20PDFS/CRPT-112hrpt98-pt1.pdf>, last accessed March 4, 2012.

General Comments

The USPTO, on its AIA microsite,³ indicates that it is preparing guidance documents related to a FITF system for release in August 2012. AIPLA endorses this effort and encourages continuing broad dissemination of both general and internal practice and policy guidance as the USPTO has done in the past. More specifically, we encourage the creation of a broad, inclusive, and easily accessible (including downloadable and searchable in electronic form) guidance document. Such a document should incorporate ready reference to legal analyses, policies, procedural changes, managing transitional practices, and, perhaps most importantly, training examples with exemplars that can be referenced and relied upon by both examiners and applicants. (See, e.g., the USPTO's "Flowcharts for 35 U.S.C. §102(e) Dates" dated Nov. 2002.⁴)

AIPLA notes that in some instances there already are policies, procedures, practices, etc., under current law for topics identified below. To the extent these are intended to also apply under the AIA, we encourage careful review and consideration of the changes the AIA brings to the law to be sure they are indeed also applicable under the AIA.

Implementation

The change from the current "first-to-invent" to an FITF system under the AIA is effective on March 16, 2013 (i.e., "upon the expiration of the 18-months beginning on the date of the enactment of this Act"⁵). There will be several groups of patent applications distinguished by their time and method of filing, which can be grouped into pre-, transitional, and post-AIA FITF applications. The guidelines the USPTO prepares for the change to the FITF system should include identifying what law applies to which applications and the rationale for why the law applies to those particular applications, as well as provide examples of the various situations applicants and the USPTO will encounter under the FITF provisions.

Meaning of Terms, Phrases, and Clauses in the AIA

The AIA includes many terms, phrases, and clauses that bear careful scrutiny and will require reference to the legislative history⁶ to determine their meaning. AIPLA recommends that USPTO guidance documents include a reference glossary of legislative language and, to the extent possible, interpretations of specific terms, phrases, and clauses that are continually updated as the AIA is interpreted by law, regulation, courts, and bodies such as the USPTO's Patent Trial and Appeal Board ("PTAB").⁷ This reference will greatly assist applicants and examiners and provide more consistency and predictability during prosecution and post-issuance review.

³ http://www.uspto.gov/aia_implementation/index.jsp, last accessed March 4, 2012.

⁴ Available at <http://www.uspto.gov/web/offices/dcom/olia/aipa/102eflowchart.pdf>, last accessed March 5, 2012.

⁵ *Ibid.*, §3(c).

⁶ The AIA was debated extensively since 2005 when initial versions were introduced in the 109th Congress as H.R. 2795.

⁷ Leahy-Smith America Invents Act, Publ. L. No. 112-29, 125 Stat. 284, §6.

Non-Exhaustive Comments on Specific Terms, Phrases, and Clauses in the AIA

1) 35 U.S.C. §100⁸

Clarification is needed on how to determine the effective filing date of an application. In §100(h)(i)(1), for example, reference is made to using the date of the “patent or application” (or the priority document thereto entitled). In contrast, §100(h)(i)(2) defines effective filing date in the cases of reissue applications and patents as determined by the claimed invention. These are different bases. Therefore, guidance on how the USPTO will determine the effective filing date of an application would be helpful.

2) 35 U.S.C. §102(a)

- a) “Prior art” is defined in terms of the filing date of the “claimed invention” rather than simply the “invention.” Guidance on how the USPTO will interpret this distinction and how it will analyze the claimed invention for prior art purposes would be helpful. Guidance on the requirements for a “claimed invention” versus an “invention’s” date of conception would be helpful.
- b) Prior art is not limited to “others.” Guidance on how the USPTO will interpret prior art that originates with the inventor(s), and examples and analysis of situations likely to be encountered in prosecution and any applicable post-issuance review, would be helpful.
- c) The class of prior art “otherwise available” (OA) is undefined. Guidance regarding availability determinations, language requirements (i.e., treatment of non-English language documents), and the application of OA art, including examples and analysis of situations likely to be encountered in prosecution and any applicable post-issuance review, would be useful.
- d) Guidance on the phrase “deemed published,” including how something is so deemed, applicable dates thereof, and examples and analyses of situations likely to be encountered in prosecution and any applicable post-issuance review, would be helpful. In addition, it would be useful if guidance was provided relating to how pre-AIA case law relates to such things as what is considered “published,” whether and under what circumstances “public availability” remains a factor, and whether something “deemed published” or “otherwise available” needs to have been catalogued and retrievable by the interested public.

3) 35 U.S.C. §102(b)

- a) Guidance on how the USPTO will calculate certain grace periods of “1 year or less before the effective filing date of the claimed invention,” including examples and analysis of situations likely to be encountered in prosecution and any applicable post-issuance review would be helpful.

⁸ *Ibid*, §3(h)(i)(1)/(2).

- b) §102(b) exceptions specifically reference the use of prior art under §102(a)(1) and (a)(2). Examples and analysis of situations likely to be encountered in prosecution and any applicable post-issuance review where an inventor disclosure applied under other statutes including §103 would be helpful.
 - c) The AIA excludes from prior art disclosure by another who obtained the “subject matter” from the inventor. While so-called derivation proceedings are beyond the scope of this letter, we note the USPTO will be challenged with considering such disclosures during prosecution and any applicable post-issuance review, and therefore guidance including examples and analysis of situations likely to be encountered in prosecution and any applicable post-issuance review would be helpful.
 - d) Guidance on how the USPTO will distinguish between a disclosure *per se* (e.g., §102(b)(1)(A)) and the disclosure of the “subject matter” (e.g., §102(b)(1)(B)), and examples and analysis of situations likely to be encountered in prosecution and any applicable post-issuance review would be helpful.
 - e) Guidance on the requirements for establishing “common ownership” and “obligations of assignment,” as well as examples and analysis of situations likely to be encountered in prosecution and any applicable post-issuance review, would be helpful.
 - f) The language of §102(b)(2)(C) “not later than the effective filing date of the claimed invention,” includes many terms (e.g., distinguish between the “subject matter disclosure” and what is meant by the “claimed invention”) subject to interpretation. Guidance relating to the meaning of this phrase, as a whole, as well as examples and analysis of situations likely to be encountered in prosecution and any applicable post-issuance review, would be helpful.
- 4) 35 U.S.C. §102(c)
- a) Guidance on the requirements to show common ownership and how subject matter disclosure and invention claiming will be established, as well as examples and analysis of situations likely to be encountered in prosecution and any applicable post-issuance review would be helpful.
 - b) Guidance on the requirements to show the disclosure of subject matter made “on behalf” of parties is subject to joint research agreements (JRA), as well as examples and analysis of situations likely to be encountered in prosecution, would be helpful.
 - c) Guidance on the requirements to show a claimed invention was the “result” of a JRA, as well as examples and analysis of situations likely to be encountered in prosecution and any applicable post-issuance review would be helpful.

5) 35 U.S.C. §102(d)

Guidance on how the USPTO will consider priority and non-English language documents, as well as examples and analysis of situations likely to be encountered in prosecution and any applicable post-issuance review would be helpful.

6) 35 U.S.C. §103

a) Guidance on the effect of differences between obviousness considerations based upon “subject matter sought to be patented” (pre-AIA) and a “claimed invention” (AIA), as well as examples and analysis of situations likely to be encountered in prosecution and any applicable post-issuance review, would be helpful.

b) The repeal of 35 U.S.C. §104, “Invention made abroad,” has extensive implications relating to *inter alia* the date of invention. Guidance on the effect the AIA will have on foreign disclosures and their applicability to the FITF system and the filing date of the invention, as well as examples and analysis of situations likely to be encountered in prosecution and any applicable post-issuance review, would be helpful.

Legal/Technical Issues

1) The FITF standard is only applicable to applications filed on or after March 16, 2013. Guidance on how the USPTO will determine whether or not this standard applies to a particular application, as well as examples and analysis of situations likely to be encountered in prosecution, would be helpful. (See above referencing pre-, transitional, and post-AIA first-inventor-to-file applications.)⁹

2) English language prosecution

a) Expansion of the pool of available prior art to include non-English language documents and “otherwise available” information anywhere in the world will require guidance regarding how non-English language documents and evidence will be presented by, *inter alia*, the USPTO, applicants, and third parties. Examples and analysis of situations likely to be encountered in prosecution and any applicable post-issuance review would be helpful.

b) Further clarification would be useful regarding who is required to shoulder the legal burden when citing non-English documents and how they shall be cited.

⁹ The USPTO is encouraged to amplify its discussion of how Information Disclosure Statements and the related SB-08 form is to be filled out. Likewise, similar requirements should be made of and expected to be complied with by Examiners on the related PTO-892 form when citing art. The discussion of non-English references may further need to be characterized as to the nature of any English language translation, such as a machine translation. Given the reporting requirements raised by *Therasense* and *McKesson* regarding foreign prosecution as well as prosecution in U.S. applications with substantially similar claims, a discussion of how Office Actions from such related and related cases should be also discussed in such a revised MPEP.

For example, if a non-English document is used in the basis of a patentability determination by the USPTO, what party shoulders the burden to provide appropriate translations? Other examples and analysis of situations likely to be encountered in prosecution and any applicable post-issuance review would also be helpful.

- 3) Guidance on what standard will be used to establish that information was “otherwise available” is needed. Questions to be addressed include: Will printed documentary evidence be required, or will the pool of prior art be expanded to include, for example, declarations by others, court documents, testimony, and other forms of non-written self-authenticating disclosures? How will information subject to confidentiality and secrecy orders be addressed? Other examples and analysis of situations likely to be encountered in prosecution and any applicable post-issuance review would also be helpful.
- 4) Third-party submissions

As noted above (e.g., regarding “other disclosures”), the AIA expands the pool of prior art. Pre-AIA, “prior art” was, for practical purposes,¹⁰ limited to disclosures that were available to the public, in a searchable form, and known. While third-party submissions could be considered by such mechanism as protest,¹¹ and under reissue and reexamination proceedings, third parties will now be able to expand their scope of submissions by, for example, either direct submission to the USPTO or via indirect means such as providing to an applicant. See, e.g., 37 C.F.R. §1.56 (duty to disclose).

Guidance relating not only to procedures for such submissions, but also for how they will be applied to patentability determinations, their evidentiary requirements, the weight of anecdotal, declaratory, and objective evidence would be useful. In addition, the AIA expands the pool of relevant non-English language documents that may not have (easily determined) definitive dates of disclosure (e.g., evidence of the date and scope of prior disclosures and dissemination of indigenous knowledge is often anecdotal).

Other examples and analyses of situations likely to be encountered in prosecution and any applicable post-issuance review would be helpful.

- 5) Guidance as to what law will apply to continuing applications, including continuation-in-part (CIP) applications, as well as applications claiming priority to a provisional application but having additional disclosure to the provisional application is needed.

For example, the AIA distinguishes between an “application” and a “claimed invention.” A CIP application may have an amended disclosure that might impact applicable law. Alternatively, new matter may be introduced that does not affect applicable law but should be addressed under the provisions of 35 U.S.C. §112.

¹⁰ 35 U.S.C. 102 (f) and 102 (g) being generally the exceptions.

¹¹ See, e.g., 37 C.F.R. 1.291 “Protests by the public against pending applications.”

Variations including amendments to claims made before, during, and after prosecution versus changes to the description raise additional ambiguities. Guidance on this situation, as well on other examples and analysis of those situations likely to be encountered in prosecution and any applicable post-issuance review, would be helpful.

Policies and procedures will be needed in determining patent priority among conflicting applications. Procedures might include elaboration of initial presumption of priority, how earlier filed applications will be applied to later filed ones, and the procedure for establishing the date used in applying such applications as prior art. In addition, clarification regarding duty and timing of disclosure by an applicant of information relating to publication and filing dates of inventor(s)' disclosures would also be helpful. For example, how would one disclose dates of public availability in contrast to prior art per se? Would the disclosed dates of public availability be recorded on the face of a patent or published application?"

- 6) It would be helpful if the guidance materials address specific fact patterns that applicants and examiners are likely to encounter. The following is a non-exhaustive list of exemplary fact patterns to consider. The fact patterns should, where appropriate, be developed to include sufficient details regarding what is claimed and what was published, since differences (i.e., whether they are identical or different) can affect the outcome.
 - a) Inventor A and Inventor B both file their respective U.S. patent applications, but neither publishes
 - b) Inventor A publishes and then files a U.S. patent application and Inventor B only publishes
 - i) Inventor A publishes and files the U.S. patent application within a year of the Inventor A publication and before Inventor B publishes
 - ii) Inventor A publishes before Inventor B publishes, but files the U.S. patent application a year after the Inventor A publication
 - iii) Inventor A publishes and files the U.S. patent application within a year of the Inventor A publication but after Inventor B publishes
 - c) Inventor A and B both publish and then file their respective U.S. patent applications
 - i) Inventor A publishes and then files the patent application within a year of the Inventor A publication and before Inventor B publishes or files a U.S. patent application
 - ii) Inventor A publishes and then files the U.S. patent application over a year after the Inventor A publication but before Inventor B publishes or files a patent application
 - iii) Inventor A publishes and then files the U.S. patent application within a year of the Inventor A publication; Inventor B publishes before Inventor A publishes and files the U.S. patent application after Inventor A files the U.S. patent application

- iv) Inventor A publishes and then files the U.S. patent application within a year of the Inventor A publication; Inventor B publishes before Inventor A publishes and files the U.S. patent application before Inventor A files the U.S. patent application
- d) Inventor A files a U.S. patent application after Inventor B claimed priority in a PCT/US application published in English
- e) Inventor A files a U.S. patent application after Inventor B claimed priority in a PCT/US application published in any PCT language
- f) Inventor A files a U.S. patent application after Inventor B claimed priority in a application, but before Inventor B's priority application publishes
- g) Inventor A files a U.S. patent application after Inventor B claimed priority in a application and Inventor B's priority application, nor any application claiming priority thereto ever publishes or issues
- h) Same scenarios as in b-g, except the Inventor A's patent application adds new matter to what was published or in the applicable priority application
- i) Inventor A invents X+Y before Inventor B invents X+Z.
 - i) Both X+Y and X+Z are patentably distinct from X alone, and X+Y and X+Z are both patentably distinct from each other, or only one is patentably distinct from the other

AIPLA is in the process of further developing this list with additional examples, and will provide a supplemental list in due course. We also stand ready to assist the USPTO in addressing these fact patterns and developing appropriate solutions, if requested. However, we note that many of the examples depend on the interpretation of terms as requested by AIPLA, above.

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Thank you for allowing AIPLA the opportunity to provide comments on this important initiative. AIPLA looks forward to further dialogues with the USPTO in finding solutions and defining programs to maintain and enhance the USPTO's mission.

Sincerely,



William G. Barber
AIPLA President