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DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

37 CFR Part 1

[Docket No.: PTO-P-2012-0024]

Examination Guidelines for Implementing the First Inventor To File Provisions of the Leahy-Smith America Invents Act

AGENCY: United States Patent and Trademark Office, Commerce.

ACTION: Examination Guidelines.

SUMMARY: The United States Patent and Trademark Office (Office) is publishing examination guidelines concerning the first inventor to file provisions of the Leahy-Smith America Invents Act (AIA). The AIA amends the patent laws pertaining to the conditions of patentability to convert the U.S. patent system from a “first to invent” system to a “first inventor to file” system, treats patents and patent application publications as prior art as of their earliest effective U.S., foreign, or international filing date, eliminates the requirement that a prior public use or sale activity be “in this country” to be a prior art activity, and treats commonly owned or joint research

agreement patents and patent application publications as being by the same inventive entity for purposes of novelty, as well as nonobviousness. The changes to the conditions of patentability in the AIA result in greater transparency, objectivity, predictability, and simplicity in patentability determinations. The Office is providing these examination guidelines to Office personnel, and notifying the public of these guidelines, to assist in the implementation of the first inventor to file provisions of the AIA. These examination guidelines also clarify, in response to the public comment, that there is no requirement that the mode of disclosure by an inventor or joint inventor be the same as the mode of disclosure of an intervening disclosure (e.g., inventor discloses his invention at a trade show and the intervening disclosure is in a peer-reviewed journal). Additionally, there is no requirement that the disclosure by the inventor or a joint inventor be a verbatim or ipsissimis verbis disclosure of an intervening disclosure in order for the exception based on a previous public disclosure of subject matter by the inventor or a joint inventor to apply. These guidelines also clarify that the exception applies to subject matter of the intervening disclosure that is simply a more general description of the subject matter previously publicly disclosed by the inventor or a joint inventor.

DATES: Effective March 16, 2013.

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(kathleen.fonda@uspto.gov)), of the Office of the Deputy Commissioner for Patent Examination Policy.

SUPPLEMENTARY INFORMATION: The AIA¹ was enacted into law on September 16, 2011. Section 3 of the AIA amends the patent laws to: (1) convert the patent system from a “first to invent” system to a “first inventor to file” system; (2) eliminate the requirement that a prior public use or sale activity be “in this country” to be a prior art activity; (3) treat U.S. patents and U.S. patent application publications as prior art as of their earliest effective filing date, regardless of whether the earliest effective filing date is based upon an application filed in the United States or in another country; and (4) treat commonly owned patents and patent application publications, or those resulting from a joint research agreement, as being by the same inventive entity for purposes of 35 U.S.C. 102 and 103. The changes in section 3 of the AIA take effect on March 16, 2013. The Office is providing these examination guidelines to Office personnel, and notifying the public of these guidelines, to assist in the implementation of the first inventor to file provisions of the AIA.

These examination guidelines do not constitute substantive rulemaking and do not have the force and effect of law. The examination guidelines set out the Office’s interpretation of 35 U.S.C. 102 and 103 as amended by the AIA, and advise the public and Office personnel on how the changes to 35 U.S.C. 102 and 103 in the AIA impact the provisions of the Manual of Patent Examining Procedure (MPEP)² pertaining to 35 U.S.C. 102 and 103. The guidelines have been developed as a matter of internal Office management and

are not intended to create any right or benefit, substantive or procedural, enforceable by any party against the Office. Rejections will continue to be based upon the substantive law, and it is these rejections that are appealable. Failure of Office personnel to follow the guidelines is not, in itself, a proper basis for either an appeal or a petition.

These examination guidelines apply the case law on pre-AIA 35 U.S.C. 102 and 103 to interpret the provisions of AIA 35 U.S.C. 102 and 103 where the AIA retains principles of pre-AIA 35 U.S.C. 102 and 103. Office personnel may and should continue to rely upon pre-AIA 35 U.S.C. 102 and 103 case law and the discussion of that case law in MPEP chapter 2100, except where these guidelines specifically indicate that the AIA does not retain a principle of pre-AIA 35 U.S.C. 102 and 103. The provisions of AIA 35 U.S.C. 102 and 103 will be further clarified as the case law on the first inventor to file provisions of the AIA develops, and the Office will provide additional or revised guidelines as necessary.

Table of Contents:

Discussion of the Public Comments

General Discussion of the Recurrent Issues Raised in the Comments

Responses to Specific Comments

Examination Guidelines for 35 U.S.C. 102 and 103 as amended by the First Inventor To File Provisions of the Leahy-Smith America Invents Act

I. Overview of the changes to 35 U.S.C. 102 and 103 in the AIA.

II. Detailed discussion of AIA 35 U.S.C. 102(a) and (b).

A. Effective filing date of the claimed invention.

B. Provisions pertaining to disclosures before the effective filing date of the claimed invention.

1. Prior art under AIA 35 U.S.C. 102(a)(1) (patented, described in a printed publication, or in public use, on sale, or otherwise available to the public).

a. Patented.

b. Described in a printed publication.

c. In public use.

d. On sale.

e. Otherwise available to the public.

f. No requirement of “by others.”

g. Admissions.

h. The meaning of “disclosure.”

2. Prior art exceptions under 35 U.S.C. 102(b)(1) to AIA 35 U.S.C. 102(a)(1).

a. Prior art exception under AIA 35 U.S.C. 102(b)(1)(A) to AIA 35 U.S.C. 102(a)(1) (grace period inventor or inventor-originated disclosure exception).

i. Grace period inventor disclosure exception.

ii. Grace period inventor-originated disclosure exception.

b. Prior art exception under AIA 35 U.S.C. 102(b)(1)(B) to AIA 35 U.S.C. 102(a)(1) (inventor or inventor-originated prior public disclosure exception).

C. Provisions pertaining to subject matter in a U.S. patent or application for a U.S. patent effectively filed before the effective filing date of the claimed invention.

1. Prior art under AIA 35 U.S.C. 102(a)(2) (U.S. patents, U.S. patent application publications, and World Intellectual Property Organization (WIPO) publications of international applications (WIPO published applications)).

a. WIPO published applications.

b. Determining when subject matter was effectively filed under AIA 35 U.S.C. 102(d).

c. Requirement of “names another inventor.”

2. Prior art exceptions under 35 U.S.C. 102(b)(2) to AIA 35 U.S.C. 102(a)(2).

a. Prior art exception under AIA 35 U.S.C. 102(b)(2)(A) to AIA 35 U.S.C. 102(a)(2) (inventor-originated disclosure exception).

b. Prior Art Exception under AIA 35 U.S.C. 102(b)(2)(B) to AIA 35 U.S.C. 102(a)(2) (inventor or inventor-originated prior public disclosure exception).

c. Prior Art Exception under AIA 35 U.S.C. 102(b)(2)(C) to AIA 35 U.S.C. 102(a)(2) (Common Ownership or Obligation of Assignment).

D. Use of affidavits or declarations under 37 CFR 1.130 to overcome prior art rejections.

1. Showing that the disclosure was made by the inventor or a joint inventor.

2. Showing that the subject matter disclosed had been previously publicly disclosed by the inventor or a joint inventor.

3. Showing that the disclosure was made, or that subject matter had been previously publicly disclosed, by another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor.

4. Enablement.

5. Who may file an affidavit or declaration under 37 CFR 1.130.
 6. Situations in which an affidavit or declaration is not available.
- III. Joint research agreements.
 - IV. Improper naming of inventors.
 - V. AIA 35 U.S.C. 103
 - VI. Applicability date provisions and determining whether an application is subject to the first inventor to file provisions of the AIA.
 - A. Applications filed before March 16, 2013.
 - B. Applications filed on or after March 16, 2013.
 - C. Applications subject to the AIA but also containing a claimed invention having an effective filing date before March 16, 2013.
 - D. Applicant statement in transition applications containing a claimed invention having an effective filing date on or after March 16, 2013.

Discussion of the Public Comments: The Office published a notice of proposed rulemaking and a notice of proposed examination guidelines on July 26, 2012, to implement the first inventor to file provisions of section 3 of the AIA. See [Changes To Implement the First Inventor To File Provisions of the Leahy-Smith America Invents Act](#), 77 FR 43742 (July 26, 2012) (notice of proposed rulemaking), and [Examination Guidelines for Implementing the First Inventor To File Provisions of the Leahy-Smith America Invents Act](#), 77 FR 43759 (July 26, 2012) (notice of proposed examination guidelines). The Office also conducted a roundtable discussion with the public on September 6, 2012, to obtain public input from organizations and individuals on issues

relating to the Office's proposed implementation of the first inventor to file provisions of the AIA. See Notice of Roundtable on the Implementation of the First Inventor To File Provisions of the Leahy-Smith America Invents Act, 77 FR 49427 (Aug. 16, 2012). The Office also conducted a number of roadshow presentations in September of 2012 that included a discussion of the first inventor to file provisions of the AIA. The Office received approximately seventy comments (from intellectual property organizations, governmental organizations, academic and research institutions, industry, law firms, and individuals) in response to these notices. The comments germane to the proposed changes to the rules of practice will be discussed in the final rule that revises the rules of practice in title 37 of the Code of Federal Regulations (CFR) in light of the changes in section 3 of the AIA. The comments germane to the proposed examination guidelines (other than those specific to the proposed rules) and the Office's responses to the comments follow:

General Discussion of the Recurrent Issues Raised in the Comments: A number of comments addressed the following issues raised in the proposed examination guidelines.

The Office indicated in the proposed examination guidelines that AIA 35 U.S.C. 102(a)(1) does not expressly state whether a sale must be "sufficiently" public to preclude the grant of a patent on the claimed invention, and sought the benefit of public comment on the extent to which public availability plays a role in "on sale" prior art defined in AIA 35 U.S.C. 102(a)(1). See Examination Guidelines for Implementing the First Inventor To File Provisions of the Leahy-Smith America Invents Act, 77 FR at

43765. The Office received a number of comments on this question. These examination guidelines indicate that the Office views the “or otherwise available to the public” residual clause of the AIA’s 35 U.S.C. 102(a)(1) as indicating that secret sale or use activity does not qualify as prior art. These examination guidelines also indicate that an activity (such as a sale, offer for sale, or other commercial activity) is secret (non-public) if, for example, it is among individuals having an obligation of confidentiality to the inventor. The specific comments on this issue are discussed in greater detail in the Responses to Specific Comments section.

The Office also indicated in the proposed examination guidelines that the subject matter in the prior disclosure being relied upon under AIA 35 U.S.C. 102(a) must be the same “subject matter” as the subject matter previously publicly disclosed by the inventor for the exceptions in AIA 35 U.S.C. 102(b)(1)(B) and 102(b)(2)(B) to apply, and that the exceptions in AIA 35 U.S.C. 102(b)(1)(B) and 102(b)(2)(B) do not apply even if the only differences between the subject matter in the prior art disclosure that is relied upon under AIA 35 U.S.C. 102(a) and the subject matter previously publicly disclosed by the inventor are mere insubstantial changes, or only trivial or obvious variations. See Examination Guidelines for Implementing the First Inventor To File Provisions of the Leahy-Smith America Invents Act, 77 FR at 43767 and 43769. The Office also received a number of comments on this issue. These examination guidelines maintain the identical subject matter interpretation of AIA 35 U.S.C. 102(b)(1)(B) and 102(b)(2)(B). However, these examination guidelines also clarify that there is no requirement that the mode of disclosure by an inventor or joint inventor (e.g., publication, public use, sale activity) be

the same as the mode of disclosure of the intervening disclosure, and also does not require that the disclosure by the inventor or a joint inventor be a verbatim or ipsissimis verbis disclosure of the intervening disclosure. In addition, these examination guidelines also clarify that if subject matter of the intervening disclosure is simply a more general description of the subject matter previously publicly disclosed by the inventor or a joint inventor, the exception in AIA 35 U.S.C. 102(b)(1)(B) applies to such subject matter of the intervening disclosure. The specific comments on this issue are also discussed in greater detail in the Responses to Specific Comments section.

Responses to Specific Comments:

Comment 1: One comment suggested that Office actions clearly indicate whether an application is examined under the pre-AIA first to invent provisions or the AIA first inventor to file provisions, and provide the reasons the pre-AIA first to invent provisions or the AIA first inventor to file provisions apply to the application.

Response: The Office plans to indicate in the Office's Patent Application Locating and Monitoring (PALM) system whether the Office is treating an application as subject to pre-AIA 35 U.S.C. 102 and 103 (a pre-AIA application) or AIA 35 U.S.C. 102 and 103 (an AIA application). Members of the public may access this information via the Patent Application Information Retrieval (PAIR) system. Furthermore, form paragraphs for use in Office actions will be developed which will identify whether the provisions of pre-AIA 35 U.S.C. 102 and 103 or AIA 35 U.S.C. 102 and 103 apply if there is a rejection based

upon 35 U.S.C. 102 or 103. The Office does not plan to provide a specific explanation in an Office action of why the pre-AIA first to invent provisions or the AIA first inventor to file provisions apply to an application unless the matter is called into question.

Comment 2: One comment suggested that in determining whether an application is an AIA application or a pre-AIA application, a procedure should be available to ensure that disputes concerning whether an application is an AIA application or a pre-AIA application are readily resolved.

Response: The Office plans to have staff in each Technology Center who are able to assist Office personnel in determining whether the application is a pre-AIA application or an AIA application. If an issue arises during the course of examination about whether the application is a pre-AIA application or an AIA application, Office personnel may consult with these staff members. If a disagreement between the applicant and an examiner cannot be resolved informally and results in a rejection that would otherwise be inapplicable, the applicant may respond to the merits of the rejection with an explanation of why the Office's treatment of the application as a pre-AIA application or an AIA application is improper. Ultimately, if there is a disagreement between the applicant and an examiner as to whether the application is subject to pre-AIA 35 U.S.C. 102 and 103 or AIA 35 U.S.C. 102 and 103, and the propriety of a rejection turns on the resolution of this question, the disagreement would need to be resolved on appeal.

Comment 3: One comment questioned whether a patent is valid if examined under the wrong prior art regime.

Response: The bases for invalidity are specified in 35 U.S.C. 282(b) and have not changed with implementation of the AIA, except for the removal of best mode as a grounds to cancel, invalidate, or render unenforceable a claim of a patent. Specifically, AIA 35 U.S.C. 282(b) provides the following bases for invalidity: (1) noninfringement, absence of liability for infringement, or unenforceability; (2) invalidity of the patent or any claim in suit on any ground specified in part II of title 35, United States Code, as a condition for patentability; (3) invalidity of the patent or any claim in suit for failure to comply with: (A) any requirement of 35 U.S.C. 112, except that the failure to disclose the best mode shall not be a basis on which any claim of a patent may be canceled or held invalid or otherwise unenforceable; or (B) any requirement of 35 U.S.C. 251; and (4) any other fact or act made a defense by title 35.

Comment 4: One comment took issue with the use of the phrases “claimed invention” and “claim to a claimed invention” in the proposed examination guidelines. The comment argued that AIA 35 U.S.C. 100(j), 102, and 103 use the phrase “claimed invention,” and that the phrase “a claim to a claimed invention” is used only in section 3(n) of the AIA (the effective date provisions for section 3).

Response: The examination guidelines have been revised to use the phrase “claimed invention” when discussing the provisions of AIA 35 U.S.C. 100(j), 102, and 103.

Comment 5: One comment suggested clearly differentiating between “claim” in the sense of a claim to a claimed invention and “claim” in the sense of a benefit or priority claim.

Response: With respect to a claimed invention, the examination guidelines use the phrase “claimed invention” or the phrase “a claim to a claimed invention.” With respect to a claim to priority or benefit under 35 U.S.C. 119, 120, 121, or 365, the examination guidelines use the term “claim” along with either benefit or priority in the same sentence to distinguish a benefit or priority claim from a claimed invention.

Comment 6: Several comments suggested that the examination guidelines maintain the status quo with respect to the terms “on sale” and “public use” to force issues such as whether secret sales qualify as prior art to the courts as soon as possible. Another comment suggested that the Office serves a gatekeeper role and that ultimately the courts will provide clarity on open legal questions presented by the AIA. Thus, the comment recommended that the Office construe the statute in a manner biased against applicants so that issues concerning the meaning of AIA 35 U.S.C. 102 and 103 quickly and expeditiously move to the courts for resolution.

Response: The Office appreciates that the courts may ultimately address questions concerning the meaning of AIA 35 U.S.C. 102 and 103. However, as a practical matter, the Office needs to provide examination guidelines so that the public is aware of how the

Office will apply AIA 35 U.S.C. 102 and 103. The Office considers its interpretation of AIA 35 U.S.C. 102 and 103 as set forth in these examination guidelines to be the correct interpretation of AIA 35 U.S.C. 102 and 103 based upon the statutory language of the AIA and its legislative history.

Comment 7: A number of comments suggested that public availability should be a requirement for “on sale” activities under AIA 35 U.S.C. 102(a)(1), and that non-public uses and non-public sales or offers for sale do not qualify as prior art under the AIA. The comments suggesting that public availability should be a requirement for “on sale” activities under AIA 35 U.S.C. 102(a)(1) gave the following reasons: (1) the catch-all phrase “otherwise available to the public” in AIA 35 U.S.C. 102(a)(1) and case law cited in the legislative history of the AIA supports the view that “available to the public” should be read as informing the meaning of all of the listed categories of prior art in AIA 35 U.S.C. 102(a)(1); (2) the removal of derivation under pre-AIA 35 U.S.C. 102(f) and prior invention under pre-AIA 35 U.S.C. 102(g) as prior art indicates that the AIA intended to do away with “secret” prior art; (3) public availability is the intent of AIA, and for the Office to construe the statute otherwise would erode the availability of patent protection in the United States, and weaken the economy; (4) interpreting the “on sale” provision to require public availability is good public policy in that it would lower litigation costs by simplifying discovery, and would reduce unexpected prior art pitfalls for inventors who are not well-versed in the law.

Several comments, however, suggested that the legislative history of the AIA is insufficient to compel the conclusion that Congress intended to overturn pre-AIA case law³ holding that an inventor's non-public sale before the critical date is a patent-barring "on sale" activity as to that inventor. One comment suggested that commercial uses that are not accessible to the public are nonetheless disqualifying prior art because Metallizing Engineering⁴ and other pre-AIA case law interpreting "public use" and "on sale" continue to apply under the AIA, and do not require public availability. The comment further suggested that commercial uses that are accessible to the public, even if such accessibility is not widespread, are disqualifying prior art to all parties. Another comment suggested that Metallizing Engineering and other forfeiture doctrines should be preserved because they serve important public policies. Another comment suggested that if the Office does adopt the position that Metallizing Engineering is overruled, and that any sale under AIA 35 U.S.C. 102(a)(1) must be public, the Office should promulgate a rule requiring that any secret commercial use of the claimed invention more than one year prior to the effective filing date be disclosed to the Office. Another comment indicated that sales between joint ventures and sales kept secret from the "trade" should still be considered prior art under AIA 35 U.S.C. 102(a)(1).

One comment suggested that under AIA 35 U.S.C. 102(a)(1) there are two general categories of prior art, with each having subcategories: the first category is patents and printed publications, and the second category is "on sale," "public use," or "otherwise available to the public." The comment suggested that "otherwise available to the public" clause only modifies the second category: "public use" and "on sale."

Response: The starting point for construction of a statute is the language of the statute itself.⁵ A patent is precluded under AIA 35 U.S.C. 102(a)(1) if “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.” AIA 35 U.S.C. 102(a)(1) contains the additional residual clause “or otherwise available to the public.” Residual clauses such as “or otherwise” or “or other” are generally viewed as modifying the preceding phrase or phrases.⁶ Therefore, the Office views the “or otherwise available to the public” residual clause of the AIA’s 35 U.S.C. 102(a)(1) as indicating that secret sale or use activity does not qualify as prior art.⁷

The Office’s interpretation of AIA 35 U.S.C. 102(a)(1) also ensures that the AIA grace period can extend to all of the documents and activities enumerated in AIA 35 U.S.C. 102(a)(1) that would otherwise defeat patentability. In addition, this interpretation avoids the very odd potential result that the applicant who had made his invention accessible to the public for up to a year before filing an application could still obtain a patent, but the inventor who merely used his invention in secret one day before he filed an application could not obtain a patent. Finally, the Office’s interpretation is consistent with the interpretation that was clearly expressed by the bicameral sponsors of the AIA during the congressional deliberations on the measure.⁸

With respect to suggestions concerning what information concerning patentability must be disclosed to the Office (secret commercial sale or use), 37 CFR 1.56 provides that

applicants have a duty to disclose all information known to be material to patentability as defined in 37 CFR 1.56, and there is no reason to treat public or non-public commercial sale or use or activity differently from other information.

With respect to comments that Metallizing Engineering and other forfeiture doctrines should be preserved because they serve important public policies, the Office notes that the choice of which public policies to pursue through the definition of prior art is made by Congress, not by the Office. Also, some of the purposes ascribed to these doctrines in case law appear to be ill-suited to or inconsistent with the AIA. The problem of delayed filing of applications is unique to pre-AIA 35 U.S.C. 102, under which an applicant can rely on a secret invention date in order to establish a priority date.

Comment 8: A comment suggested that offers for sale must be public in order to constitute prior art under AIA 35 U.S.C. 102(a)(1) and that an offer for license is not an offer for sale.

Response: The case law distinguishing between offers for sale and offers for license under pre-AIA 35 U.S.C. 102(b) is equally applicable under AIA 35 U.S.C. 102(a)(1) as the AIA did not amend 35 U.S.C. 102 to change the treatment of the prior art effect of an offer for license. The U.S. Court of Appeals for the Federal Circuit (Federal Circuit) has held that “a ‘license’ that merely grants rights under a patent cannot per se trigger the application of the on-sale bar,”⁹ and that “[a]n offer to enter into a license under a patent for future sale of the invention covered by the patent when and if it has been developed

. . . is not an offer to sell the patented invention that constitutes an on-sale bar.”¹⁰ If a transaction or offer with respect to an invention constitutes licensing within the meaning of these cases, the offer or transaction does not implicate the on sale bar. However, if the licensing of an invention makes the invention available to the public, patentability would be independently barred by the residual clause of AIA 35 U.S.C. 102, which precludes patenting of a claimed invention that was “available to the public” more than one year before the effective filing date of the claimed invention.

Comment 9: One comment requested guidance on what might be required for showing disclosure of a previously secret process to produce an “on sale” product, e.g., through reverse engineering.

Response: Any rejection of a claim under AIA 35 U.S.C. 102 requires evidence of a prior disclosure of the claimed invention via a document or activity as defined in AIA 35 U.S.C. 102(a)(1), or evidence that the claimed invention was effectively filed prior to the effective filing date of the application under examination as defined in AIA 35 U.S.C. 102(a)(2). Thus, any rejection of a claim under AIA 35 U.S.C. 102(a)(1) on the basis of a prior disclosure of the claimed invention via a sale or an offer for sale of a product produced by a previously secret process (e.g., a situation in which the public could learn the claimed process by examining the product) would need to be supported by some amount of documentary evidence or an affidavit or declaration. However, once any potentially patent-defeating sale or use is shown, evidence as to whether that sale or use

made the invention available to the public should be accessible to the applicant and it is thus appropriate to require the applicant to come forward with that evidence.¹¹

Comment 10: Several comments suggested that a public use or sale need not be enabling to constitute prior art under AIA 35 U.S.C. 102(a)(1).

Response: The case law provides that the enablement inquiry is applicable to the question of whether a claimed invention is described in a patent, published patent application, or printed publication, but is not applicable to the question of whether a claimed invention is “in public use” or “on sale.”¹² The Office does not view the AIA as changing this principle of pre-AIA case law.

Comment 11: One comment sought clarification on whether a “motion for sale” was included with the prior art category of “on sale.”

Response: Insofar as a “motion for sale” is equal to an “offer for sale,” the Office understands that the pre-AIA case law on “offers for sale” would equally apply under the AIA. The on sale provision of pre-AIA 35 U.S.C. 102(b) is triggered if the invention is both: (1) the subject of a commercial offer for sale; and (2) ready for patenting.¹³

Traditional contract law principles are applied when determining whether a commercial offer for sale has occurred.¹⁴

Comment 12: One comment questioned whether the experimental use exception to public use would continue under the AIA first inventor to file provisions.

Response: Under pre-AIA case law, the experimental use exception negates a use that would otherwise defeat patentability. Neither the AIA nor its legislative history expressly addresses whether the experimental use exception applies to a public use under AIA 35 U.S.C. 102(a)(1), or to a use that makes the invention available to the public under the residual clause of AIA 35 U.S.C. 102(a)(1). Because this doctrine arises infrequently before the Office, and is case-specific when it does arise, the Office will approach this issue when it arises on the facts presented.

Comment 13: One comment sought elaboration on what constitutes “publicly available” within the context of 35 U.S.C. 102(a)(1). The comment sought input on the transitory nature of on-line materials, economic factors regarding accessibility to public materials, restrictions on access, and password or user agreement access to on-line materials.

Response: MPEP § 2128 discusses whether material that is posted on the Internet or that is challenging to access is sufficiently accessible to the public to be considered a “printed publication” under pre-AIA 35 U.S.C. 102. Since the “otherwise available to the public” clause of AIA 35 U.S.C. 102(a)(1) encompasses these materials, the case law on whether material is available and accessible as discussed in MPEP § 2128 will guide the Office and the public in making determinations as to whether any particular disclosure is sufficiently publicly available under the “otherwise available to the public” clause of

AIA 35 U.S.C. 102(a)(1). The Federal Circuit recently reiterated that the ultimate question is whether the material was “available to the extent that persons interested and ordinarily skilled in the subject matter or art[,] exercising reasonable diligence, can locate it.”¹⁵ The determination of whether material was publicly available does not turn on the logistical or economic issues a person would face in gaining access to the material. For example, material whose distribution was restricted to persons involved in a specific project was considered not publicly accessible,¹⁶ but material housed in a library that provides access to the public was considered publicly accessible even though a person would need to engage in considerable travel to actually gain access to the material.¹⁷

Comment 14: One comment questioned whether, in order for a WIPO publication to be considered prior art under AIA 35 U.S.C. 102(a)(2), the PCT application must enter the national stage in the United States (analogous to the requirement for a WIPO publication to enter the national stage in Japan in order to be considered prior art as of its priority date in Japan). The comment also suggested that if a WIPO publication will be prior art as of its priority date under AIA 35 U.S.C. 102(a)(2) when published in any language, the Office should provide a translation to the applicant against whose claims the WIPO publication has been cited.

Response: Under AIA 35 U.S.C. 102(a)(2), a person shall be entitled to a patent unless the claimed invention was described in an application for patent that was published or “deemed published” pursuant to 35 U.S.C. 122(b). In accordance with 35 U.S.C. 374, the WIPO publication of a PCT international application designating the United States is

deemed a publication under 35 U.S.C. 122(b). Thus, the Office cannot set forth an interpretation that a WIPO publication can be prior art under AIA 35 U.S.C. 102(a)(2) only if the PCT application enters the national stage in the United States because that interpretation would conflict with AIA 35 U.S.C. 102(a)(2) and 35 U.S.C. 374. Patent documents and non-patent-literature are prior art under pre-AIA 35 U.S.C. 102(a) and 102(b) regardless of the language of the publication. Although the Office does not currently provide translations as a matter of course for non-English-language patent documents and non-patent-literature, translation services are available to Office personnel for use on a case-by-case basis. See MPEP § 901.05(d). If an Office action relies upon a document in a language other than English, a translation (machine or human) will be made of record if necessary for the record to be clear as to the precise facts relied upon in support of the rejection. See MPEP § 706.02 (section II).

Comment 15: One comment suggested that the Office adopt a process to avoid granting a patent on a later-filed application claiming subject matter disclosed in an earlier-filed application by another.

Response: The Office is in the process of developing a Patents End-to-End (PE2E) patent application processing system that will permit Office personnel to text search pending applications that have not yet been published, which will help avoid granting a patent on a later-filed application claiming subject matter disclosed in an earlier-filed application by another. However, in the event that a patent is issued on a later-filed application claiming subject matter disclosed in an earlier-filed application, the applicant

in the earlier-filed application may request early publication of the application under 37 CFR 1.219 and cite the resulting patent application publication in the file of the later-filed application under 35 U.S.C. 301 and 37 CFR 1.501.

Comment 16: One comment requested clarification as to whether the Office will continue to apply the Hilmer¹⁸ doctrine to pre-AIA applications.

Response: Under the “Hilmer doctrine,” the foreign priority date of a U.S. patent (or U.S. patent application publication) may not be relied upon in determining the date that the U.S. patent (or U.S. patent application publication) is effective as prior art under pre-AIA 35 U.S.C. 102(e). AIA 35 U.S.C. 102(d) eliminates the Hilmer doctrine. The “Hilmer doctrine” as discussed in MPEP § 2136.03 remains applicable to pre-AIA applications because AIA 35 U.S.C. 102(d) does not apply to pre-AIA applications.

Comment 17: One comment expressed concern that Office personnel would rely on a foreign priority date as the applicable prior art date for rejecting a claim in an application under examination solely because the prior art patent document reference was “entitled to claim priority to, or benefit of” a prior-filed application. The comment suggested use of machine translations to ensure proper reliance on the earlier filing date.

Response: The issue is similar to the current situation in which a U.S. patent or U.S. patent application publication claims the benefit under 35 U.S.C. 119(e) of a provisional application, except that foreign priority applications are originally filed in a foreign

patent office and may be in a language other than English. The Office is revising 37 CFR 1.55 in a separate action (RIN 0651-AC77) to ensure that a copy of a foreign priority application (a certified copy from the foreign patent office, an interim copy from the applicant, or a copy via a priority document exchange program) is available for situations in which a U.S. patent or U.S. patent application publication has a prior art effect as of the filing date of a foreign priority application. As discussed previously, if an Office action relies upon a document in a language other than English, a translation (machine or human) will be made of record if necessary for the record to be clear as to the precise facts relied upon in support of the rejection. See MPEP § 706.02 (section II).

Comment 18: One comment suggested that when applying prior art as of its earliest effective filing date to a claim in an application under 35 U.S.C. 102(a)(2), the applicant should be able to rebut the rejection by establishing that the subject matter relied upon for the rejection is not supported in the earlier filed application from which a benefit or priority is sought and hence may not be prior art under AIA 35 U.S.C. 102(a)(1) or 102(a)(2).

Response: AIA 35 U.S.C. 102(d) provides that for purposes of determining whether a patent or application for patent is prior art to a claimed invention under AIA 35 U.S.C. 102(a)(2), the patent or application shall be considered to have been effectively filed, with respect to any subject matter described in the patent or application, as of the earlier of the actual filing date of the patent or the application for patent, or the filing date of the earliest application that describes the subject matter and for which the patent or

application for patent is entitled to claim a benefit or right of priority under 35 U.S.C. 119, 120, 121, or 365. Thus, if an applicant believes the subject matter relied on in a rejection under AIA 35 U.S.C. 102(a)(2) is not supported by a prior application for which benefit or priority is claimed under 35 U.S.C. 119, 120, 121, or 365, it is appropriate for the applicant to argue that the application does not contain support for the subject matter and that the patent or application is available as prior art under AIA 35 U.S.C. 102(a)(2) only as of the benefit or priority date of the earliest application that does describe the subject matter. This is similar to current practice under pre-AIA 35 U.S.C. 102(e).¹⁹

Comment 19: One comment suggested that the level of enablement for a prior art reference to be applicable to the claims of an application as described by the Office in accordance with Donohue²⁰ fails to consider a line of cases that Donohue recognizes.

Response: The Office cited to Donohue simply to indicate the level of enablement required for a prior art reference to anticipate a claim in an application. The Office does not view the AIA as changing the pre-AIA enablement requirement for prior art references.

Comment 20: One comment indicated that the examination guidelines were overly broad with respect to admissions as prior art. Another comment urged that the treatment of admissions, especially to transition applications (applications filed on or after March 16, 2013, that claim priority to or the benefit of the filing date of an earlier application that was filed prior to March 16, 2013), be treated on a case-by-case basis.

Response: The Office included a discussion of admissions as prior art in the examination guidelines simply to indicate that the Office does not view the AIA as changing the status quo with respect to the use of admissions as prior art. The Office's position on the use of admissions as prior art is discussed at MPEP § 2129.

Comment 21: One comment questioned how the time of day of a sale in a foreign jurisdiction would be determined for purposes of prior art.

Response: As with current practice under pre-AIA 35 U.S.C. 102, the Office does not take time of day into consideration in making determinations of activities or documents that constitute prior art under AIA 35 U.S.C. 102(a)(1).

Comment 22: One comment supported the Office's interpretation of the evidence needed to establish reliance on the AIA 35 U.S.C. 102(b)(1)(A) and 102(b)(2)(A) provisions relating to showing that the subject matter of a disclosure was obtained directly or indirectly from an inventor or a joint inventor.

Response: The Office has adopted 37 CFR 1.130(a) as a mechanism for an applicant to submit information to establish the facts and evidence when necessary to rely upon the exception provisions in AIA 35 U.S.C. 102(b)(1)(A) or 102(b)(2)(A). The showing should provide facts, not conclusions, to show that the disclosure, although not made directly by the inventor or joint inventor, originated with the inventor or joint inventor.

Comment 23: One comment suggested that when there are any discrepancies in inventorship on an application as compared to authorship of a prior art publication that is potentially excepted as prior art under AIA 35 U.S.C. 102(b)(1)(A), an applicant should be required to present a showing that the publication is not available as prior art even when it is apparent that the prior art disclosure is a grace period disclosure from an inventor. Several comments indicated that a grace period publication should be treated under the exception in AIA 35 U.S.C. 102(b)(1)(A) when there is any overlap between authorship and inventorship.

Response: AIA 35 U.S.C. 102(b)(1)(A) provides that a grace period disclosure “shall not be prior art” to a claimed invention if “the disclosure was made by the inventor or a joint inventor or by another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor.” When the Office can readily ascertain by examination of inventorship and authorship that a certain disclosure falls under AIA 35 U.S.C. 102(b)(1)(A), the Office will not apply such a document in a prior art rejection. Alternatively, when there are additional named individuals on a prior art publication as compared to the inventors named on a patent application, it is incumbent upon the applicant to provide a satisfactory showing that the additional named authors did not contribute to the claimed subject matter.²¹

Comment 24: One comment requested clarification on what constitutes an “unequivocal” statement from the inventor or a joint inventor that he/she invented the subject matter of a

publication such that the publication is not prior art in accordance with AIA 35 U.S.C. 102(b)(1)(A), and requested clarification on what constitutes a “reasonable explanation” to explain the presence of additional authors on the publication. Another comment suggested that the examination guidelines should define as precisely as possible what is needed to establish that a disclosure originated with an inventor, and questioned the intent of the statement in the examination guidelines that an unequivocal assertion may be accepted in the absence of evidence to the contrary. The comment also suggested that the examination guidelines should make clear whether or not evidence that a disclosure originated from the inventor will be rejected if it is not initially presented. Several comments requested examples of acceptable affidavits or declarations under 37 CFR 1.130.

Response: The evidence required to show that a disclosure originated with the inventor or a joint inventor (e.g., whether an “unequivocal” statement from the inventor or a joint inventor is sufficient, or an explanation is a reasonable explanation of the presence of additional authors on the publication) is necessarily a case-by-case determination. Given the fact-specific nature of affidavits and declarations, the Office cannot provide a “template” of an acceptable affidavit or declaration under 37 CFR 1.130. However, the case law on pre-AIA 35 U.S.C. 102(a) and (e) contains examples of affidavits or declarations that were found acceptable to show that a disclosure originated with the inventor.²² There is no requirement that such evidence be present on filing, although early presentation will streamline prosecution.

Comment 25: One comment stated that to address situations where there are overlapping inventors between an application under examination and a prior art reference under AIA 35 U.S.C. 102(a)(2), a declaration to attribute certain inventive activities from the prior art to the named inventors should be a viable mechanism to overcome a rejection on this basis.

Response: Under pre-AIA 35 U.S.C. 102, attribution of inventive activities to disqualify prior art references was permitted pursuant to 37 CFR 1.132, as discussed in MPEP §§ 716.10 and 2131.01. The Office is promulgating a new 37 CFR 1.130 to provide for the disqualification of a disclosure as prior art on the basis of attribution (37 CFR 1.130(a)) or a prior public disclosure of the inventor's or a joint inventor's own work (37 CFR 1.130(b)) under AIA 35 U.S.C. 102(b). An applicant may establish attribution of a cited prior art reference to the inventor or joint inventor via an affidavit or declaration under 37 CFR 1.130(a).

Comment 26: One comment questioned whether a publication of a foreign patent application during the year preceding the filing of a patent application could qualify as AIA 35 U.S.C. 102(a)(1) prior art that is potentially excepted under AIA 35 U.S.C. 102(b)(1)(A) if it is "a disclosure [during the grace period] by another who obtained the subject matter directly or indirectly from the inventor or joint inventor."

Response: An applicant may establish that the foreign patent application publication was by another who obtained subject matter disclosed in the foreign patent application

publication directly or indirectly from the inventor or joint inventor via an affidavit or declaration under 37 CFR 1.130(a).

Comment 27: One comment questioned whether an assignee, to whom the inventors are obligated to assign their rights, who was selling a product within the scope of the inventor's claims during the grace period, would be able to rely on the AIA 35 U.S.C. 102(b)(1)(A) provisions that the "disclosure was made by another who obtained the subject matter directly or indirectly from the inventor or joint inventor."

Response: A sale by an assignee, to whom the inventors are obligated to assign their rights, may qualify as a sale "by another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor" within the meaning of AIA 35 U.S.C. 102(b)(1)(A).

Comment 28: One comment indicated that the Office's guidelines regarding the reliance on the AIA 35 U.S.C. 102(b)(1)(A) or 102(b)(2)(A) exception appear to apply to any inventor or inventor-originated disclosure which is prior art under AIA 35 U.S.C. 102(a)(1) or 102(a)(2) regardless of the relationship of the disclosed subject matter and the claimed invention.

Response: Strictly speaking, neither AIA 35 U.S.C. 102(b)(1)(A) nor 102(b)(2)(A) requires a relationship between "the subject matter disclosed" and the claimed invention. As a practical matter, however, if the subject matter disclosed (e.g., contained in a

publication that would qualify as prior art under 35 U.S.C. 102(a)) is not relevant to the claimed invention, there will be no occasion to inquire into whether the disclosure could be disqualified as prior art under 35 U.S.C. 102(b)(1)(A) or 102(b)(2)(A).

Comment 29: One comment interpreted the provisions of AIA 35 U.S.C. 102(b)(2)(A) as requiring not only that the subject matter disclosed be “obtained directly or indirectly from the inventor or a joint inventor,” but also that the disclosure upon which the rejection is based in the application under examination be owned by the same entity.

Response: This interpretation appears to combine the provision of AIA 35 U.S.C. 102(b)(2)(A) with the common ownership disqualification provision of AIA 35 U.S.C. 102(b)(2)(C). Each of subparagraph (A) and subparagraph (C) of AIA 35 U.S.C. 102(b)(2) stands alone and forms an independent basis for disqualifying references that otherwise qualify as prior art under 35 U.S.C. 102(a)(2).

Comment 30: A number of comments, including comments from a number of universities and university groups, opposed the Office’s interpretation of the subparagraph (B) provision of AIA 35 U.S.C. 102(b)(1) or 102(b)(2) (the subparagraph (B) provision), requiring that the subject matter previously publicly disclosed by the inventor be identical to the subject matter of the disclosure to be disqualified under the subparagraph (B) provision (identical subject matter approach). The comments opposing the Office’s interpretation of the subparagraph (B) provision stated that: (1) the Office’s identical subject matter approach is not supported by a reasonable reading of the statute

and is contrary to the intent of the AIA; (2) the Office's identical subject matter approach violates the superfluity canon of statutory construction as it would render the provision worthless; (3) the Office's identical subject matter approach is disadvantageous to inventors who must seek venture capital, and to academics who must publish their results; (4) the Office's identical subject matter approach is unworkable due to the ease with which the Internet can be fraudulently used to publish trivial variations of an inventor's disclosed work, thereby depriving him or her of patent protection; and (5) the Office's identical subject matter approach is unworkable because even those acting in good faith, such as by publishing an editorial commenting on a disclosed invention, may create prior art which would deprive an inventor of a patent on his or her invention. Several comments suggested that the Office's interpretation of the subparagraph (B) provision is an unwarranted extrapolation of the statute that constitutes substantive rulemaking, fails to maintain the bedrock of separation of powers, is contrary to the intent and function of the grace period, and exceeds the intended scope for interpretive rules.

The Office of Advocacy of the Small Business Administration (SBA-Advocacy) also indicated that it has heard from many patent stakeholders (within the university-based and non-profit research community, as well as the startup inventor community) that they have concerns with the Office's interpretation of the subparagraph (B) provision (discussed previously) and suggested there are alternative legal interpretations of the subparagraph (B) provision that would address these concerns. SBA-Advocacy encouraged the Office to examine the merits of alternative interpretations of the subparagraph (B) provision.

Several comments, by contrast, suggested that the proposal to require identity of disclosure in order for an inventor to invoke the subparagraph (B) provision is appropriate and entirely consistent with the intent of the AIA. According to these comments, the intent of the AIA was to provide a grace period with regard to inventor-originated disclosures, but not with regard to independently created third-party disclosures (except in the unlikely event of identity of disclosure). The comments stated that to provide a grace period for non-identical subject matter would thwart the intent to create a first inventor to file system, as well as the intent to provide a system that moves toward harmonizing U.S. patent law with the laws of other countries. Several comments suggested that the simplicity of the Office's interpretation of the subparagraph (B) provision, i.e., not permitting variations between the shielding disclosure and the cited prior art disclosure in order for the exception to apply, was appropriate and would reduce litigation costs.

Response: As discussed previously, the starting point for construction of a statute is the language of the statute itself.²³ Subparagraph (B) of each of AIA 35 U.S.C. 102(b)(1) and 102(b)(2) provides that certain disclosures shall not be prior art if “the subject matter disclosed had, before such disclosure [or before such subject matter was effectively filed under 102(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.” Subparagraph (B) of each of AIA 35 U.S.C. 102(b)(1) and 102(b)(2) uses a single instance of the phrase “the subject matter” to describe both the content of

the prior art disclosure and the content of the inventor's previous public disclosure. If "the subject matter" disclosed in the prior art varies from "the subject matter" that had been previously 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), there are two discrete subject matters. The single instance of the phrase "the subject matter" in subparagraph (B) of each of AIA 35 U.S.C. 102(b)(1) and 102(b)(2) cannot reasonably be read as concurrently describing two discrete subject matters. Therefore, the single instance of the phrase "the subject matter" in subparagraph (B) of each of AIA 35 U.S.C. 102(b)(1) and 102(b)(2) cannot reasonably be interpreted as including variations within its ambit.

Next, other provisions in title 35 (pre-AIA and as amended by the AIA), help to inform the meaning of the phrase "the subject matter" in subparagraph (B) as like words in the same statute are presumed to carry the same meaning.²⁴ AIA 35 U.S.C. 100 defines inventor and joint inventor or coinventor with respect to the individual or individuals "who invented or discovered the subject matter of the invention," and defines "claimed invention" as "the subject matter defined by a claim in a patent or an application for a patent."²⁵ 35 U.S.C. 112(b) provides that "[t]he specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the inventor or a joint inventor regards as the invention."²⁶ The phrase "the subject matter" has never been read to permit the inclusion of variations within its ambit in these provisions, or in any other provision in title 35. In addition, pre-AIA title 35 and the AIA contain a modifier such as "substantially" where variation between subject matter is

contemplated (e.g., pre-AIA 35 U.S.C. 135(b)(1),²⁷ AIA 35 U.S.C. 135(a),²⁸ 35 U.S.C. 154(d)(2),²⁹ and 35 U.S.C. 252³⁰). The absence of the “substantially” modifier or similar terminology in subparagraph (B) of each of AIA 35 U.S.C. 102(b)(1) and 102(b)(2) further supports the conclusion that this provision does not contemplate variation in subject matter.

Additionally, the Office’s interpretation of this provision is consistent with the canon of statutory construction requiring effect to be given to every clause and every word of a statute where possible.³¹ The Office’s interpretation of the subparagraph provision (B) gives effect to each clause and each word in the subparagraph (B) provision. To reach the alternative interpretations proffered by the comments, the Office would need to ignore or re-write the words of the subparagraph (B) provision. Specifically, the Office would be required to re-draft the subparagraph (B) provision to provide that a disclosure shall not be prior art if “substantially the same subject matter disclosed had, before such disclosure, or before such subject matter was effectively filed, 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” to embrace variations of the subject matter, and would be required to re-draft the subparagraph (B) provision to provide that a disclosure shall not be prior art if, “the claimed invention had, before such disclosure, or before such subject matter was effectively filed, 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,” to embrace “any disclosure” or any subject matter disclosed after a disclosure of the claimed invention. The Office,

however, has no authority to enforce concepts that simply do not square with the express language of subparagraph (B) of each of 35 U.S.C. 102(b)(1) and 102(b)(2).³²

Further, the legislative history of subparagraph (B) of AIA 35 U.S.C. 102(b)(1) and 102(b)(2) is inconclusive with respect to what is embraced by the phrase “the subject matter.” Committee Report 112-98 indicates that 35 U.S.C. 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.”³³ The legislative history of subparagraph (B) of AIA 35 U.S.C. 102(b)(1) and 102(b)(2) does not definitively specify whether “any disclosure” means “any disclosure” of the same subject matter, “any disclosure” of the same or substantially the same subject matter, “any disclosure” of the subject matter of the claimed invention, or “any disclosure” of any subject matter.³⁴

The Office has considered the alternative interpretations of the subparagraph (B) provision submitted in the public comment. The Office has clarified, in response to the public and SBA-Advocacy comment, that: (1) there is no requirement that the mode of disclosure by an inventor or joint inventor be the same as the mode of disclosure of an intervening disclosure (e.g., inventor discloses his invention at a trade show and the intervening disclosure is in a peer-reviewed journal); (2) there is no requirement that the disclosure by the inventor or a joint inventor be a verbatim or ipsissimis verbis disclosure of an intervening disclosure in order for the exception based on a previous public

disclosure of subject matter by the inventor or a joint inventor to apply; and (3) the exception applies to subject matter of the intervening disclosure that is simply a more general description of the subject matter previously publicly disclosed by the inventor or a joint inventor. The more expansive alternative interpretations of the subparagraph (B) provision, however, are not supported by the language of the subparagraph (B) provision for the reasons stated in the responses to this comment and the comments that follow.

Comment 31: One comment indicated a need for clarification on what constitutes an insubstantial or trivial difference (and what constitutes “same subject matter”) and suggested that mere wording changes should not be interpreted too strictly. Several comments suggested that slight variations or differences in wording should be permitted when relying on the subparagraph (B) provision of AIA 35 U.S.C. 102(b)(1) and 102(b)(2). Another comment similarly suggested that the subparagraph (B) provision should, to the extent the subject matter in the reference is within the scope of the inventor’s public disclosure, shield the inventor from citation of the intervening prior art.

Response: The Office understands that not all inventors refer to the same inventive concepts using the exact same language. The Office is clarifying in these examination guidelines that the subparagraph (B) provisions of AIA 35 U.S.C. 102(b)(1) and 102(b)(2) do not require that the mode of disclosure by an inventor or joint inventor (e.g., publication, public use, sale activity) be the same as the mode of disclosure of the intervening disclosure, and also does not require that the disclosure by the inventor or a joint inventor be a verbatim or ipsissimis verbis disclosure of the intervening disclosure.

In addition, the Office is also clarifying that if subject matter of the intervening disclosure is simply a more general description of the subject matter previously publicly disclosed by the inventor or a joint inventor, the exception in AIA 35 U.S.C. 102(b)(1)(B) applies to such subject matter of the intervening disclosure.

Comment 32: Several comments suggested using approaches to the subparagraph (B) provisions of AIA 35 U.S.C. 102(b)(1) and 102(b)(2) akin to that of 37 CFR 1.131, in that an intervening disclosure would be disqualified as prior art if the inventor's prior disclosure disclosed either the entire invention as claimed, or as much of the invention as was disclosed in the intervening disclosure. Several comments suggested that the subparagraph (B) provisions should apply if the inventor's disclosure discloses at least as much of the claimed invention as is disclosed in the intervening disclosure. Another comment suggested that an acceptable standard for determining whether claimed subject matter was described for the purpose of the subparagraph (B) provisions is whether one of ordinary skill in the art would have considered the claimed subject matter to have been described in the disclosure.

Response: Pre-AIA 35 U.S.C. 102(a) provided that a person was not entitled to a patent if "the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, **before the invention thereof by the applicant for patent**" (emphasis added). Thus, under pre-AIA 35 U.S.C. 102(a), an applicant could disqualify (or antedate) a grace period disclosure by showing that the disclosure was the inventor's own work or that the disclosure was after the applicant's

date of invention. AIA 35 U.S.C. 102(b) retains the pre-AIA principle that an applicant may disqualify a grace period disclosure by showing that the disclosure was the inventor's or a joint inventor's own work (AIA 35 U.S.C. 102(b)(1)(A)), but does not retain the principle that an inventor may antedate a grace period disclosure by showing that the disclosure was after the applicant's date of invention. Since the AIA does not retain the principle of pre-AIA 35 U.S.C. 102(a) that a grace period disclosure that does not represent the inventor's own work may be antedated by showing prior invention by the inventor, the pre-AIA 35 U.S.C. 102(a) case law and concepts pertaining to the antedating of a grace period disclosure that does not represent the inventor's own work by showing prior invention by the inventor is not instructive with respect to the applicability of the subparagraph (B) provisions of AIA 35 U.S.C. 102(b)(1) and 102(b)(2). Instead, under the subparagraph (B) provisions of AIA 35 U.S.C. 102(b)(1) and 102(b)(2), the question is whether the subject matter disclosed had, before such disclosure was made or before such subject matter was effectively filed, 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.³⁵

The subparagraph (B) provisions do not provide for an analysis of what subject matter is claimed in order to determine when the subparagraph (B) provisions apply. An intervening grace period disclosure would be disqualified under the subparagraph (B) provisions if the inventor's prior public disclosure disclosed as much of the subject matter of the invention as was disclosed in the intervening disclosure. This, however, is a comparison of the subject matter of the inventor's prior public disclosure and the subject

matter of the intervening disclosure as provided for in the subparagraph (B) provisions, and is not a comparison of the subject matter of inventor's prior public disclosure with the claimed invention. Additionally, any subject matter disclosed by the intervening disclosure not also disclosed in the inventor's prior public disclosure would not be disqualified under the subparagraph (B) provisions.

Comment 33: One comment stated that the identical disclosure approach to the subparagraph (B) provisions of AIA 35 U.S.C. 102(b)(1) and 102(b)(2) is not consistent with treating the inventor's disclosure as if it were a patent application. The comment stated that a broad disclosure can support broad claims, and that later disclosure of a species within the claimed genus does not defeat patentability of the genus. Another comment suggested that the Office treat inventor disclosures like provisional applications under the subparagraph (B) provisions, such that any claimed feature that had been disclosed by the inventor is insulated from attack by an intervening disclosure.

Response: The subparagraph (B) provisions of AIA 35 U.S.C. 102(b)(1) and 102(b)(2) do not provide for an inventor's public disclosure prior to filing a patent application to be treated as if it were the filing of a patent application.

Comment 34: One comment suggested that there is "asymmetry" between patent-defeating derivation proceedings under AIA 35 U.S.C. 135 and the subparagraph (B) provisions of AIA 35 U.S.C. 102(b)(1) and 102(b)(2), and indicated that the Federal courts have set forth rules to achieve symmetry in cases addressing pre-AIA 35 U.S.C.

102(g) and 37 CFR 1.131 practice. One comment suggested that the term “subject matter” in the subparagraph (B) provisions should be interpreted as it is when deciding to institute an interference proceeding, and that the phrase need not require identical disclosures in order for the exception to apply.

Response: There is “asymmetry” between patent defeating derivation proceedings under AIA 35 U.S.C. 135 and the subparagraph (B) provisions of AIA 35 U.S.C. 102(b)(1) and 102(b)(2) due to the express statutory language differences between these provisions. AIA 35 U.S.C. 135 applies to a claim to an invention that is the “same or substantially the same” as a claim of an earlier application. As discussed previously, the subparagraph (B) provisions do not modify “the subject matter” with the phrase “substantially the same.” Given this statutory language difference, it would not be appropriate to interpret subparagraph (B) of AIA 35 U.S.C. 102(b)(1) and 102(b)(2) to provide symmetry with AIA 35 U.S.C. 135.

Comment 35: One comment requested clarification regarding what constitutes a public disclosure as compared to a disclosure within the meaning of the description of the prior art exception under AIA 35 U.S.C. 102(b)(1)(B). Another comment indicated that it is unclear what would constitute an earlier “public disclosure” by the inventor in order to rely on the AIA 35 U.S.C. 102(b)(1)(B) exception to shield the applicant from prior art that is available before the effective filing date but after the inventor’s own public disclosure. The comment specifically questioned if a public oral disclosure would be such a public disclosure.

Response: In order for an inventor to be able to rely on an earlier disclosure under AIA 35 U.S.C. 102(b)(1)(B) (including an earlier oral disclosure), some evidence is necessary to show that the subject matter relied upon for the rejection had been previously publicly disclosed by the inventor. Whether a “disclosure” is a “public disclosure” such that it constitutes prior art under AIA 35 U.S.C. 102(a)(1) is a case-by-case analysis which is governed by the case law discussed in MPEP §§ 2126 through 2128.

Comment 36: One comment suggested that there is no justification for requiring that an inventor’s prior public disclosure to another be enabling of anything.

Response: An affidavit or declaration under 37 CFR 1.130(a) or (b) need not demonstrate that the disclosure by the inventor, a joint inventor, or another who obtained the subject matter disclosed directly or indirectly from an inventor or a joint inventor was an “enabling” disclosure of the subject matter within the meaning of 35 U.S.C. 112(a). The question under AIA 35 U.S.C. 102(b) is whether: (1) the disclosure in question was made by the inventor or a joint inventor, or the subject matter disclosed was obtained directly or indirectly from the inventor or a joint inventor (37 CFR 1.130(a));³⁶ or (2) the subject matter disclosed had, before such disclosure was made or before such subject matter was effectively filed, 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 (37 CFR 1.130(b)).³⁷

Comment 37: One comment requested clarification on how to show communication so as to enable one of ordinary skill in the art to make and use the invention when relying on the grace period inventor-originated disclosure exception (AIA 35 U.S.C. 102(b)(1)(A)) to disqualify prior art.

Response: The Office has revised the guidance on the grace period inventor-originated disclosure exception to indicate that what is required, within one year prior to the effective filing date, is communication of the subject matter by the inventor or a joint inventor prior to its disclosure by a non-inventor. The level of communication in the inventor's or joint inventor's disclosure need not be sufficient to teach one of ordinary skill how to make and use so as to comply with 35 U.S.C. 112(a).

Comment 38: One comment questioned what action an applicant could take when the applicant suspects that the prior art is derived from the applicant's own work, but the deriver has not submitted an application. The comment stated that the information necessary to show derivation is the state of mind of the deriver, and that the applicant does not always have access to the information to support a showing of derivation.

Response: Unless the other party (the suspected deriver) has submitted his or her own application, the issue for the applicant is disqualifying the prior art under AIA 35 U.S.C. 102(b) rather than showing derivation under AIA 35 U.S.C. 135. If the prior art disclosure was made one year or less before the effective filing date of the claimed invention, the applicant may submit an affidavit or declaration under 37 CFR 1.130 to

show that the disclosure was by a party who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor and thus disqualify the prior art under 35 U.S.C. 102(b)(1)(A). As discussed in these examination guidelines, this does not require a showing of derivation under AIA 35 U.S.C. 135.

Comment 39: One comment suggested that prior art that is disqualified under AIA 35 U.S.C. 102(b)(2)(C) cannot be properly used to show the state of the art for purposes of, e.g., a lack of enablement rejection. The comment stated that the Office's position is in conflict with the MPEP.

Response: MPEP § 2124 indicates that documents published after the effective filing date may be used to show factual evidence regarding the factors needed to establish that undue experimentation would have been needed to make and use the invention. A document under AIA 35 U.S.C. 102(a)(2) by its very nature meets this criteria, i.e., it is a publication after the critical date which can be used as evidence to support a lack of enablement rejection by providing facts relevant to the weighing of the Wands factors³⁸ to support a 35 U.S.C. 112(a) lack of enablement rejection.

Comment 40: One comment suggested that the AIA 35 U.S.C. 102(b)(2)(C) provisions apply to prior art that qualifies under both AIA 35 U.S.C. 102(a)(1) and 102(a)(2) because there is no language in the statute which says that the AIA 35 U.S.C. 102(b)(2)(C) provision “only” applies to prior art under AIA 35 U.S.C. 102(a)(2) art.

Response: The introductory language of AIA 35 U.S.C. 102(b)(2) provides that: “[a] disclosure shall not be prior art to a claimed invention under [AIA 35 U.S.C. 102(a)(2)] if” Thus, by the terms of AIA 35 U.S.C. 102(b)(2), the provisions of subparagraphs (A), (B), and (C) of 35 U.S.C. 102(b)(2) apply only to disclosures under AIA 35 U.S.C. 102(a)(2). If a patent or published application qualifies as prior art under both AIA 35 U.S.C. 102(a)(1) and AIA 35 U.S.C. 102(a)(2), the disqualification under AIA 35 U.S.C. 102(b)(2)(C) would remove the patent or published application with respect to the patent or published application qualifying under AIA 35 U.S.C. 102(a)(2). Such a patent or published application would still qualify as prior art under AIA 35 U.S.C. 102(a)(1). The proposed examination guidelines indicated that AIA 35 U.S.C. 102(b)(2) provides an exception only for prior art under AIA 35 U.S.C. 102(a)(2). The proposed examination guidelines did not state that a disclosure must qualify as prior art only under AIA 35 U.S.C. 102(a)(2) in order for the AIA 35 U.S.C. 102(b)(2) exception to apply.

Comment 41: One comment indicated that the description of Hazeltine³⁹ regarding interpretation of the AIA 35 U.S.C. 103 provisions is in conflict with the statutory language, in that the AIA shifted the temporal focus from the invention date to effective filing date.

Response: In Hazeltine, the U.S. Supreme Court held that a U.S. patent that qualified as prior art only under pre-AIA 35 U.S.C. 102(e) may be used in combination with other prior art to show that a claimed invention was obvious under pre-AIA 35 U.S.C. 103,

notwithstanding that the disclosure of such U.S. patent may not have been known or available to the public on the date of invention or the effective filing date of the claimed invention.⁴⁰ The Office agrees that the temporal focus has shifted from the invention date to effective filing date. However, the principle in Hazeltine that certain prior art under 35 U.S.C. 102 that may not be publicly available on the critical date (i.e., prior art under pre-AIA 35 U.S.C. 102(e) or prior art under AIA 35 U.S.C. 102(a)(2)) is also applicable under AIA 35 U.S.C. 103.

Comment 42: A comment stated that 35 U.S.C. 115, which requires an oath or declaration by the inventor, is a more appropriate section than 35 U.S.C. 101 on which to base a rejection for failure to name the appropriate inventor. Another comment indicated that the case law on 35 U.S.C. 101 is not straightforward and hence might not be the appropriate avenue to resolve disputes regarding the proper naming of inventors.

Response: In addition to requiring an inventor's oath or declaration from each inventor, AIA 35 U.S.C. 115(a) provides that: “[a]n application for patent that is filed under section 111(a) or commences the national stage under section 371 shall include, or be amended to include, the name of the inventor for any invention claimed in the application.” While pre-AIA 35 U.S.C. 115 has not previously served as a statutory basis for rejecting a claim for failure to name the proper inventorship, pre-AIA 35 U.S.C. 115 did not require that an application include, or be amended to include, the name of the inventor for any invention claimed in the application. Therefore, until the courts clarify which, if any, statute forms the basis for rejecting a claim where the application fails to

include, or has not been amended to include, the name of the inventor(s), the Office considers a rejection under both 35 U.S.C. 101⁴¹ and 115 the best course of action. To the extent that there is a concern that the recent case law surrounding 35 U.S.C. 101 is unclear, the Office notes that this recent case law pertains only to subject matter eligibility, not to the application of 35 U.S.C. 101 to the inventorship question, and thus this case law would not aggravate the complexity of inventorship disputes.

Comment 43: One comment requested clarification from the Office regarding the use of a derivation proceeding where improper inventors are named in a patent.

Response: If a patent is issued to someone other than the inventor, a patent applicant can file a petition for derivation with respect to the issued patent pursuant to 35 U.S.C. 135. The Office has implemented the patent derivation proceedings provided for in the AIA in a separate rulemaking. See Changes To Implement Derivation Proceedings, 77 FR 56068 (Sept. 11, 2012). Additional information concerning patent derivation proceedings is available on the AIA micro site (under Inter Partes Disputes) on Office's Internet web site at http://www.uspto.gov/aia_implementation/bpai.jsp#heading-4.

Comment 44: One comment requested clarification on how a defense of derivation could be used to invalidate a patent. The comment requested clarification on how a minor variation derived from one inventor and claimed by another could be invalidated under 35 U.S.C. 101.

Response: A patent applicant can use the provisions of 35 U.S.C. 135 to resolve derivation issues with a patent owner. Similarly, a patent owner can use the provisions of 35 U.S.C. 291 to resolve derivation issues with another patent owner. If the issue is one of inventorship in a granted patent, a party may raise the issue of compliance with 35 U.S.C. 101 before the Patent Trial and Appeal Board in a post-grant proceeding or before a Federal court involving patent infringement as a defense under 35 U.S.C. 282.

Comment 45: One comment took issue with the Office’s interpretation of the effective date provisions indicating application of pre-AIA 35 U.S.C. 102(g) provisions to applications examined under AIA 35 U.S.C. 102 and 103 where the application contains claims supported by a pre-AIA application.

Response: Section 3(n)(1) of the AIA provides that amendments made by section 3 of the AIA “shall apply to any application for patent, and to any patent issuing thereon” that contains or contained at any time: (1) a claim to a claimed invention that has an effective filing date that is on or after March 16, 2013; or (2) a specific reference under 35 U.S.C. 120, 121, or 365(c) to any patent or application that contains or contained at any time such a claim. Section 3(n)(2) of the AIA provides that the provisions of 35 U.S.C. 102(g), 135, and 291 as in effect on March 15, 2013, “shall apply to each claim of an application for patent, and any patent issued thereon,” for which the amendments made by section 3 of the AIA also apply, if such application or patent contains or contained at any time: (1) a claim to an invention having an effective filing date that occurs before March 16, 2013; or (2) a specific reference under 35 U.S.C. 120, 121, or 365(c) to any

patent or application that contains or contained at any time such a claim. While the “shall apply to” language of sections 3(n)(1) and 3(n)(2) is not parallel, section 3(n)(2) does indicate that the provisions of 35 U.S.C. 102(g), 135, and 291 as in effect on March 15, 2013, shall apply to “each claim” of an application for patent, and not simply the claim or claims having an effective filing date that occurs before March 16, 2013, if the condition specified in section 3(n)(2) occurs. Therefore, “each claim” of an application presenting a claim to a claimed invention that has an effective filing date before March 16, 2013, but also presenting claims to a claimed invention that has an effective filing date on or after March 16, 2013, is subject to AIA 35 U.S.C. 102 and 103 and is also subject to the provisions of 35 U.S.C. 102(g), 135, and 291 as in effect on March 15, 2013.

Comment 46: Several comments opposed changing from a “first to invent” system to a “first inventor to file” system, arguing that a “first inventor to file” system favors large corporations and negatively impacts independent inventors, small businesses, entrepreneurs, and technical professionals, and will have a significant economic impact on a substantial number of small entities. Several comments suggested that the examination guidelines are an economically significant guidance document and must comply with the requirements of the Good Guidance Bulletin⁴² of the Office of Management and Budget (OMB) for economically significant guidance documents. One comment suggested that the examination guidelines are an economically significant guidance document because the conversion of the U.S. patent system from a “first to invent” to a “first inventor to file” system is arguably one of the most comprehensive overhauls of the U.S. patent system since its inception. Another comment cited

statements by the AIA's legislative sponsors and Administration officials and several articles concerning the first inventor to file system, and argued that the Office, in its implementation of the first inventor to file system, has ignored a number of economic effects, such as: (1) loss of access to investment capital; (2) diversion of inventor time into patent applications; (3) weaker patent protection due to hasty filing; (4) higher patent prosecution costs due to a hastily prepared initial application; (5) higher abandonment rates; and (6) changes in ways of doing business. Several comments suggested that the Office's interpretation of certain provisions of the AIA is an unwarranted extrapolation of the statute that constitutes substantive rulemaking.

Response: The U.S. patent system is converted from a "first to invent" to a "first inventor to file" system by operation of section 3 of the AIA regardless of whether the Office issues or publishes examination guidelines. The Office must revise its practices to be consistent with the changes in "first inventor to file" provisions of section 3 of the AIA to conform to the new patent laws. In doing so, these examination guidelines do not modify the conditions of patentability specified in AIA 35 U.S.C. 102 and 103 and do not change the rights and obligations specified in AIA 35 U.S.C. 102 and 103 based upon the Office's view of what would be a better policy choice. Rather, these examination guidelines simply set out examination guidelines for Office personnel in order to explain AIA 35 U.S.C. 102 and 103 based upon the Office's understanding of the provisions of AIA 35 U.S.C. 102 and 103 as written by Congress, and place the public on notice of those examination guidelines. Therefore, these examination guidelines do not amount to substantive rulemaking.⁴³

The discussion of the significance or impacts of section 3 of the AIA by the AIA's legislative sponsors and Administration officials, in articles concerning the first inventor to file system, and in the discussions in the comments relating to the impacts of the adoption of a first inventor to file system, pertains to the changes in section 3 of the AIA per se and not to these examination guidelines. The examination guidelines have been reviewed by OMB as a significant guidance document, but the examination guidelines are not considered to be economically significant as that term is defined in the Good Guidance Bulletin.

Comment 47: One comment suggested that the examination guidelines should state their precise legal effect. The comment suggested that the Office lacks the statutory authority to issue an interpretation of this statute, and as such the examination guidelines should make clear that they are only examination guidelines, not an interpretation. The comment further suggested that the examination guidelines should indicate that they have no binding effect on the public or on the courts and are not entitled to Chevron⁴⁴ deference, but that under 35 U.S.C. 3(a) and the Good Guidance Bulletin the examination guidelines are binding on Office employees and should be reviewable by petition under 37 CFR 1.181.

Response: As discussed previously, these examination guidelines do not constitute substantive rulemaking and do not have the force and effect of law. However, the Office has the authority to publish a notice setting out its interpretation of substantive patent law

under 35 U.S.C. 101, 102, 103, 112, or other section of title 35, regardless of whether such interpretation has the force and effect of law.⁴⁵ These examination guidelines have been developed as a matter of internal Office management and (like the discussion of patentability in general in MPEP chapter 2100 and the Good Guidance Bulletin⁴⁶) do not create any right or benefit, substantive or procedural, enforceable by any party against the Office. These examination guidelines are not “binding” on the public or Office personnel in that rejections will continue to be based upon the substantive law, and it is these rejections that are appealable. Failure of Office personnel to follow the guidelines is not, in itself, a proper basis for either an appeal or a petition. The question of the level of deference to which the examination guidelines are entitled is not a patent examination issue.

Comment 48: One comment questioned whether the amendments to 35 U.S.C. 102 and 103 in the AIA applied to plant applications and patents. The comment suggested that the Office make an exception for plant applications and patents and also continue to apply the one year grace period to plant applications and patents.

Response: 35 U.S.C. 161 provides that the provisions of 35 U.S.C. relating to patents for inventions shall apply to patents for plants, except as otherwise provided. There is nothing in section 3 of the AIA that provides for an exception for plant applications and patents with respect to any of the provisions of AIA 35 U.S.C. 102 and 103. Thus, the provisions of AIA 35 U.S.C. 102 and 103 (including the one-year grace period in

AIA 35 U.S.C. 102(b)(1)(A) for inventor disclosures) are applicable to plant applications and patents.

Comment 49: Several comments requested that the Office provide examples, or suggested hypothetical situations for the Office to use as examples.

Response: The Office will post examples on the AIA micro site on Office's Internet web site.

Comment 50: One comment requested clarification regarding the meaning of "first inventor to file," specifically the terms "first," "inventor," and "to file."

Response: The phrase "First Inventor to File" is simply the title of section 3 of the AIA. The conditions for patentability based upon novelty and nonobviousness are set forth in AIA 35 U.S.C. 102 and 103, which do not always result in the first inventor to file an application being entitled to a patent (e.g., AIA 35 U.S.C. 102(a)(1) precludes an inventor who is the first person to file an application for patent, but who published an article describing the claimed invention more than one year before the application was filed, from being entitled to a patent). Thus, it is appropriate for these examination guidelines to place the focus on the provisions of AIA 35 U.S.C. 102 and 103, rather than on the meaning of the terms "first," "inventor," and "to file."

Examination Guidelines for 35 U.S.C. 102 and 103 as amended by the First Inventor To File Provisions of the Leahy-Smith America Invents Act

I. Overview of the changes to 35 U.S.C. 102 and 103 in the AIA. The AIA continues to employ 35 U.S.C. 102 to set forth the scope of prior art that will preclude the grant of a patent on a claimed invention, but adjusts what qualifies as such prior art. Specifically, the AIA sets forth what qualifies as prior art in two paragraphs of 35 U.S.C. 102(a). AIA 35 U.S.C. 102(a)(1) provides that a person is not entitled to a patent if 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. AIA 35 U.S.C. 102(a)(2) provides that a person is not entitled to a patent if the claimed invention was described in a patent issued under 35 U.S.C. 151, or in an application for patent published or deemed published under 35 U.S.C. 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. AIA 35 U.S.C. 102(b) sets forth exceptions to prior art established in AIA 35 U.S.C. 102(a). Specifically, AIA 35 U.S.C. 102(b)(1) sets forth exceptions to prior art established in AIA 35 U.S.C. 102(a)(1), and AIA 35 U.S.C. 102(b)(2) sets forth exceptions to prior art established in AIA 35 U.S.C. 102(a)(2).

The AIA also provides definitions in 35 U.S.C. 100 of the meaning of the terms “claimed invention,” “effective filing date,” “the inventor,” and “joint inventor” (or “coinventor”). The AIA defines the term “claimed invention” in 35 U.S.C. 100(j) as the subject matter

defined by a claim in a patent or an application for a patent. The AIA defines the term “effective filing date” for a claimed invention in a patent or application for patent (other than a reissue application or reissued patent) in 35 U.S.C. 100(i)(1) as meaning the earliest of: (1) the actual filing date of the patent or the application for the patent containing the claimed invention; or (2) the filing date of the earliest provisional, nonprovisional, international (PCT), or foreign patent application to which the patent or application is entitled to benefit or priority as to such claimed invention. The AIA defines the term “the inventor” as the individual or if a joint invention, the individuals collectively who invented or discovered the subject matter of the invention in 35 U.S.C. 100(f), and defines the term “joint inventor” and “co-inventor” to mean any one of the individuals who invented or discovered the subject matter of a joint invention in 35 U.S.C. 100(g).

As discussed previously, AIA 35 U.S.C. 102(a)(1) provides that a person is not entitled to a patent if 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. Under pre-AIA 35 U.S.C. 102(a) and (b), knowledge or use of the invention (pre-AIA 35 U.S.C. 102(a)), or public use or sale of the invention (pre-AIA 35 U.S.C. 102(b)), was required to be in the United States to qualify as a prior art activity. Under the AIA, a prior public use, sale activity, or other disclosure has no geographic requirement (i.e., need not be in the United States) to qualify as prior art.

AIA 35 U.S.C. 102(b)(1) provides that a disclosure made one year or less before the effective filing date of a claimed invention shall not be prior art under 35 U.S.C.

102(a)(1) with respect to the claimed invention if: (1) 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; or (2) the subject matter disclosed had, before such disclosure, been publicly disclosed by the inventor or a joint inventor or by another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor. Thus, AIA 35 U.S.C. 102(b)(1) provides a one-year grace period (grace period) after a first disclosure of an invention within which the inventor, assignee, obligated assignee, or other party having sufficient interest may file a patent application. The one-year grace period in AIA 35 U.S.C. 102(b)(1) is measured from the filing date of the earliest U.S. or foreign patent application to which a proper benefit or priority claim as to such invention has been asserted in the patent or application. Notably, the one-year grace period in pre-AIA 35 U.S.C. 102(b) is measured from only the filing date of the earliest application filed in the United States (directly or through the PCT).

The date of invention is not relevant under AIA 35 U.S.C. 102. Thus, a prior art disclosure could not be disqualified or antedated by showing that the inventor invented the claimed invention prior to the effective date of the prior art disclosure of the subject matter (e.g., under the provisions of 37 CFR 1.131).

As discussed previously, AIA 35 U.S.C. 102(a)(2) provides that a person is not entitled to a patent if the claimed invention was described in a U.S. patent, a U.S. patent application

publication, or an application for patent deemed published under 35 U.S.C. 122(b), that names another inventor and was effectively filed before the effective filing date of the claimed invention. Under 35 U.S.C. 374, a World Intellectual Property Organization (WIPO) publication of a Patent Cooperation Treaty (PCT) international application that designates the United States is an application for patent deemed published under 35 U.S.C. 122(b) for purposes of AIA 35 U.S.C. 102(a)(2). Thus, under the AIA, WIPO publications of PCT applications that designate the United States are treated as U.S. patent application publications for prior art purposes, regardless of the international filing date, whether they are published in English, or whether the PCT international application enters the national stage in the United States. Accordingly, a U.S. patent, a U.S. patent application publication, or a WIPO publication of a PCT application (WIPO published application) that designates the United States, that names another inventor and was effectively filed before the effective filing date of the claimed invention, is prior art under AIA 35 U.S.C. 102(a)(2). Under pre-AIA 35 U.S.C. 102(e), a WIPO published application designating the United States is treated as a U.S. patent application publication only if the PCT application was filed on or after November 29, 2000, and published under PCT Article 21(2) in the English language.⁴⁷

AIA 35 U.S.C. 102(d) defines “effectively filed” for the purpose of determining whether a U.S. patent, U.S. patent application publication, or WIPO published application is prior art under AIA 35 U.S.C. 102(a)(2) to a claimed invention. A U.S. patent, U.S. patent application publication, or WIPO published application is considered to have been effectively filed for purposes of its prior art effect under 35 U.S.C. 102(a)(2) with respect

to any subject matter it describes on the earliest of: (1) the actual filing date of the patent or the application for patent; or (2) if the patent or application for patent is entitled to claim the benefit of, or priority to, the filing date of an earlier U.S. provisional, U.S. nonprovisional, international (PCT), or foreign patent application, the filing date of the earliest such application that describes the subject matter of the claimed invention. Thus, a U.S. patent, a U.S. patent application publication, or WIPO published application is effective as prior art as of the filing date of the earliest application to which benefit or priority is claimed and which describes the subject matter relied upon, regardless of whether the earliest such application is a U.S. provisional or nonprovisional application, an international (PCT) application, or a foreign patent application.

AIA 35 U.S.C. 102(b)(2)(A) and (B) provide that a disclosure shall not be prior art to a claimed invention under 35 U.S.C. 102(a)(2) if: (1) the subject matter disclosed was obtained directly or indirectly from the inventor or a joint inventor; or (2) the subject matter disclosed had, before such subject matter was effectively filed under 35 U.S.C. 102(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. Thus, under the AIA, a U.S. patent, U.S. patent application publication, or WIPO published application that was not issued or published more than one year before the effective filing date of the claimed invention is not prior art to the claimed invention if: (1) the U.S. patent, U.S. patent application publication, or WIPO published application was by another who obtained the subject matter disclosed from the inventor or a joint inventor; or (2) the inventor or a joint inventor, or another who obtained the

subject matter disclosed from an inventor or joint inventor, had publicly disclosed the subject matter before the effective filing date of the U.S. patent, U.S. patent application publication, or WIPO published application.

Additionally, AIA 35 U.S.C. 102(b)(2)(C) provides that a disclosure made in a U.S. patent, U.S. patent application publication, or WIPO published application shall not be prior art to a claimed invention under 35 U.S.C. 102(a)(2) if, not later than the effective filing date of the claimed invention, the subject matter disclosed and the claimed invention were owned by the same person or subject to an obligation of assignment to the same person. This provision replaces the exception in pre-AIA 35 U.S.C. 103(c) that applied only in the context of an obviousness analysis under 35 U.S.C. 103 to prior art that was commonly owned at the time the claimed invention was made, and which qualified as prior art only under pre-AIA 35 U.S.C. 102(e), (f), and/or (g). Thus, the AIA provides that certain prior patents and published patent applications of co-workers and collaborators are not prior art either for purposes of determining novelty (35 U.S.C. 102) or nonobviousness (35 U.S.C. 103). This exception, however, applies only to prior art under AIA 35 U.S.C. 102(a)(2), namely, U.S. patents, U.S. patent application publications, or WIPO published applications effectively filed, but not published, before the effective filing date of the claimed invention. This exception does not apply to prior art that is available under 35 U.S.C. 102(a)(1), that is, patents, printed publications, public uses, sale activities, or other publicly available disclosures published or occurring before the effective filing date of the claimed invention. A prior disclosure, as defined in AIA 35 U.S.C. 102(a)(1), by a co-worker or collaborator is prior art under AIA 35 U.S.C.

102(a)(1) unless it falls within an exception under AIA 35 U.S.C. 102(b)(1), regardless of whether the subject matter of the prior disclosure and the claimed invention was commonly owned not later than the effective filing date of the claimed invention.

The AIA eliminates the provisions in pre-AIA 35 U.S.C. 102(c) (abandonment of the invention), 102(d) (premature foreign patenting), 102(f) (derivation), and 102(g) (prior invention by another). Under the AIA, abandonment of the invention or premature foreign patenting is not relevant to patentability. Prior invention by another is likewise not relevant to patentability under the AIA unless there is a prior disclosure or filing of an application by another. The situation in which an application names a person who is not the actual inventor as the inventor (pre-AIA 35 U.S.C. 102(f)) will be handled in a derivation proceeding under 35 U.S.C. 135, by a correction of inventorship under 37 CFR 1.48 to name the actual inventor, or through a rejection under 35 U.S.C. 101⁴⁸ and 35 U.S.C. 115.⁴⁹

AIA 35 U.S.C. 102(c) provides for common ownership of subject matter made pursuant to joint research agreements. Under 35 U.S.C. 100(h), the term “joint research agreement” as used in AIA 35 U.S.C. 102(c) is defined as a written contract, grant, or cooperative agreement entered into by two or more persons or entities for the performance of experimental, developmental, or research work in the field of the claimed invention. AIA 35 U.S.C. 102(c) specifically provides that subject matter disclosed and a claimed invention shall be deemed to have been owned by the same person or subject to an obligation of assignment to the same person in applying the provisions of

AIA 35 U.S.C. 102(b)(2)(C) if: (1) the subject matter disclosed was developed and the claimed invention was made by, or on behalf of, one or more parties to a joint research agreement that was in effect on or before the effective filing date of the claimed invention; (2) the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement; and (3) the application for patent for the claimed invention discloses or is amended to disclose the names of the parties to the joint research agreement.

AIA 35 U.S.C. 103 provides that a patent for a claimed invention may not be obtained, notwithstanding that the claimed invention is not identically disclosed as set forth in 35 U.S.C. 102, if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains. In addition, AIA 35 U.S.C. 103 provides that patentability shall not be negated by the manner in which the invention was made. This provision tracks pre-AIA 35 U.S.C. 103(a), except that the temporal focus for the obviousness inquiry is before the effective filing date of the claimed invention, rather than at the time of the invention. The provisions of pre-AIA 35 U.S.C. 103(c) have been replaced with AIA 35 U.S.C. 102(b)(2)(C) and (c), and the provisions of pre-AIA 35 U.S.C. 103(b) pertaining to biotechnological processes have been eliminated.

AIA 35 U.S.C. 102 and 103 take effect on March 16, 2013. These new provisions apply to any patent application that contains or contained at any time: (1) a claim to a claimed

invention that has an effective filing date that is on or after March 16, 2013; or (2) a designation as a continuation, divisional, or continuation-in-part of an application that contains or contained at any time a claim to a claimed invention that has an effective filing date that is on or after March 16, 2013.⁵⁰ AIA 35 U.S.C. 102 and 103 also apply to any patent resulting from an application to which AIA 35 U.S.C. 102 and 103 were applied.⁵¹

The AIA provides that the provisions of pre-AIA 35 U.S.C. 102(g)⁵² apply to each claim of an application for patent if the patent application: (1) contains or contained at any time a claim to a claimed invention having an effective filing date that occurs before March 16, 2013; or (2) is ever designated as a continuation, divisional, or continuation-in-part of an application that contains or contained at any time a claim to a claimed invention that has an effective filing date before March 16, 2013.⁵³ Pre-AIA 35 U.S.C. 102(g) also applies to any patent resulting from an application to which pre-AIA 35 U.S.C. 102(g) applied.⁵⁴

If an application (1) contains or contained at any time a claimed invention having an effective filing date that is before March 16, 2013, or ever claimed a right of priority or the benefit of an earlier filing date under 35 U.S.C. 119, 120, 121, or 365 based upon an earlier application that ever contained a claimed invention having an effective filing date that is before March 16, 2013, and (2) also contains or contained at any time any claimed invention having an effective filing date that is on or after March 16, 2013, or ever claimed a right of priority or the benefit of an earlier filing date under 35 U.S.C. 119,

120, 121, or 365 based upon an earlier application that ever contained a claimed invention having an effective filing date that is on or after March 16, 2013, then AIA 35 U.S.C. 102 and 103 apply to the application, and each claimed invention in the application is also subject to pre-AIA 35 U.S.C. 102(g).

II. Detailed discussion of AIA 35 U.S.C. 102(a) and (b). AIA 35 U.S.C. 102(a) defines the prior art that will preclude the grant of a patent on a claimed invention unless an exception in AIA 35 U.S.C. 102(b) is applicable. Specifically, AIA 35 U.S.C. 102(a) provides 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; or

(2) the 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.”⁵⁵

As an initial matter, Office personnel should note that the introductory phrase “[a] person shall be entitled to a patent unless” remains unchanged from the pre-AIA version of 35 U.S.C. 102. Thus, 35 U.S.C. 102 continues to provide that the Office bears the initial burden of explaining why the applicable statutory or regulatory requirements have not

been met if a claim in an application is to be rejected. The AIA also does not change the requirement that whenever a claim for a patent is rejected or an objection or requirement is made, the Office shall notify the applicant thereof and state the reasons for such rejection, objection, or requirement, and provide such information and references as may be useful to the applicant in judging of the propriety of continuing the prosecution of the application.⁵⁶

The categories of prior art documents and activities are set forth in AIA 35 U.S.C. 102(a)(1) and (a)(2). These documents and activities are used to determine whether a claimed invention is novel or nonobvious. The documents upon which a prior art rejection may be based are an issued patent, a published application, and a non-patent printed publication. Evidence that the claimed invention was in public use, on sale, or otherwise available to the public may also be used as the basis for a prior art rejection. Note that a printed publication that does not have a sufficiently early publication date to itself qualify as prior art under AIA 35 U.S.C. 102(a)(1) may be competent evidence of a previous public use, sale activity, or other availability of a claimed invention to the public where the public use, sale activity, or other public availability does have a sufficiently early date to qualify as prior art under AIA 35 U.S.C. 102(a)(1).⁵⁷

AIA 35 U.S.C. 102(b) sets out exceptions to AIA 35 U.S.C. 102(a), in that prior art that otherwise would be included in AIA 35 U.S.C. 102(a) shall not be prior art if it falls within an exception in AIA 35 U.S.C. 102(b).

Exceptions to the categories of prior art defined in AIA 35 U.S.C. 102(a)(1) are provided in AIA 35 U.S.C. 102(b)(1). Specifically, AIA 35 U.S.C. 102(b)(1) states that a disclosure made one year or less before the effective filing date of a claimed invention shall not be prior art to the claimed invention under subsection (a)(1) if —

- The disclosure was made by the inventor or a joint inventor or by another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor; 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.”⁵⁸

Exceptions to the categories of prior art defined in AIA 35 U.S.C. 102(a)(2) are provided in AIA 35 U.S.C. 102(b)(2). Specifically, AIA 35 U.S.C. 102(b)(2) states that a disclosure shall not be prior art to a claimed invention under subsection (a)(2) 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 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.”⁵⁹

Although some of the prior art provisions of AIA 35 U.S.C. 102(a) and (b) will seem familiar, especially in comparison to pre-AIA 35 U.S.C. 102(a), (b), and (e), the AIA has introduced a number of important changes with respect to prior art documents and activities (collectively, “disclosures”). First, the availability of a disclosure as prior art is measured from the effective filing date of the claimed invention no matter where that filing occurred. Second, the AIA adopts a global view of prior art disclosures and thus does not require that a public use or sale activity be “in this country” to be a prior art activity. Finally, a catch-all “otherwise available to the public” category of prior art is added.

A. Effective filing date of the claimed invention. Pre-AIA 35 U.S.C. 102(a) and (e) reference patent-defeating activities occurring before the applicant invented the claimed invention. AIA 35 U.S.C. 102(a)(1) and (a)(2) make no mention of the date of the invention, but instead concern documents that existed or activities that occurred “before the effective filing date of the claimed invention.” As a result, it is no longer possible to antedate or “swear behind” certain prior art disclosures by making a showing under 37 CFR 1.131 that the applicant invented the claimed subject matter prior to the effective date of the prior art disclosure.

The AIA defines the term “effective filing date” for a claimed invention in a patent or application for patent (other than a reissue application or reissued patent) as the earliest of: (1) the actual filing date of the patent or the application for the patent containing the

claimed invention; or (2) the filing date of the earliest application for which the patent or application is entitled, as to such invention, to a right of priority or the benefit of an earlier filing date under 35 U.S.C. 119, 120, 121, or 365.⁶⁰ Thus, the one-year grace period in AIA 35 U.S.C. 102(b)(1) is measured from the filing date of any U.S. or foreign patent application to which the patent or application is entitled to benefit or priority as to such invention, whereas the one-year grace period in pre-AIA 35 U.S.C. 102(b) is measured from only the filing date of the earliest application filed in the United States (directly or through the PCT).

As under pre-AIA law, the effective filing date of a claimed invention is determined on a claim-by-claim basis and not an application-by-application basis. That is, the principle that different claims in the same application may be entitled to different effective filing dates vis-à-vis the prior art remains unchanged by the AIA.⁶¹ However, it is important to note that although prior art is applied on a claim-by-claim basis, the determination of whether pre-AIA 35 U.S.C. 102 and 103 or AIA 35 U.S.C. 102 and 103 apply is made on an application-by-application basis. Section VI discusses the applicability date provisions of section 3 of the AIA.

Finally, the AIA provides that the “effective filing date” for a claimed invention in a reissued patent or application for a reissue patent shall be determined by deeming the claim to the claimed invention to have been contained in the patent for which reissue was sought.⁶²

B. Provisions pertaining to disclosures before the effective filing date of the claimed invention.

1. Prior art under AIA 35 U.S.C. 102(a)(1) (patented, described in a printed publication, or in public use, on sale, or otherwise available to the public). Prior art documents and activities which may preclude patentability are set forth in AIA 35 U.S.C. 102(a)(1). Such documents and activities include prior patenting of the claimed invention, descriptions of the claimed invention in a printed publication, public use of the claimed invention, placing the claimed invention on sale, and otherwise making the claimed invention available to the public. These examination guidelines will discuss each prior art document and activity that might preclude patentability under AIA 35 U.S.C. 102(a)(1) in turn.

a. Patented. AIA 35 U.S.C. 102(a)(1) indicates that prior patenting of a claimed invention precludes the grant of a patent on the claimed invention. This means that if a claimed invention was patented in this or a foreign country before the effective filing date of the claimed invention, AIA 35 U.S.C. 102(a)(1) precludes the grant of a patent on the claimed invention. The effective date of the patent for purposes of determining whether the patent qualifies as prior art under AIA 35 U.S.C. 102(a)(1) is the grant date of the patent. There is an exception to this rule if the patent is secret as of the date the rights are awarded.⁶³ In such situations, the patent is available as prior art as of the date the patent was made available to the public by being laid open for public inspection or disseminated in printed form.⁶⁴ The phrase “patented” in AIA 35 U.S.C. 102(a)(1) has the same

meaning as “patented” in pre-AIA 35 U.S.C. 102(a) and (b). For a discussion of “patented” as used in pre-AIA 35 U.S.C. 102(a) and (b), see generally MPEP § 2126.

Although an invention may be described in a patent and not claimed therein, the grant date would also be the applicable prior art date for purposes of relying on the subject matter disclosed therein as “described in a printed publication,” provided that the patent was made available to the public on its grant date. It is helpful to note that a U.S. patent that issues after the effective filing date of a claimed invention under examination is not available as prior art against that invention under AIA 35 U.S.C. 102(a)(1), but could be available as prior art under AIA 35 U.S.C. 102(a)(2).

b. Described in a printed publication. If a claimed invention is described in a patent, published patent application, or printed publication, such a document may be available as prior art under AIA 35 U.S.C. 102(a)(1). Both pre-AIA 35 U.S.C. 102(a) and (b) and AIA 35 U.S.C. 102(a)(1) use the term “described” with respect to an invention in a prior art printed publication. Likewise, AIA 35 U.S.C. 102(a)(2) uses that term with respect to U.S. patents, U.S. patent application publications, and WIPO published applications. Thus, the Office does not view the AIA as changing the extent to which a claimed invention must be described for a prior art document to anticipate the claimed invention under 35 U.S.C. 102.

While the conditions for patentability of AIA 35 U.S.C. 112(a) require a written description of the claimed invention that would have enabled a person skilled in the art to

make as well as use the invention, the prior art provisions of AIA 35 U.S.C. 102(a)(1) and (a)(2) require only that the claimed invention be “described”⁶⁵ in a prior art document (patent, published patent application, or printed publication). The two basic requirements that must be met by a prior art document in order to describe a claimed invention such that it is anticipated under AIA 35 U.S.C. 102 are the same as those under pre-AIA 35 U.S.C. 102. First, “each and every element of the claimed invention” must be disclosed either explicitly or inherently, and the elements must be “arranged or combined in the same way as in the claim.”⁶⁶ Second, a person of ordinary skill in the art must have been enabled to make the invention without undue experimentation.⁶⁷ Thus, in order for a prior art document to describe a claimed invention such that it is anticipated under AIA 35 U.S.C. 102(a)(1) or (a)(2), it must disclose all elements of the claimed invention arranged as they are in the claim, and also provide sufficient guidance to enable a person skilled in the art to make the claimed invention. There is, however, no requirement that a prior art document meet the “how to use” requirement of 35 U.S.C. 112(a) in order to qualify as prior art.⁶⁸ Furthermore, compliance with the “how to make” requirement is judged from the viewpoint of a person of ordinary skill in the art, and thus does not require that the prior art document explicitly disclose information within the knowledge of such a person.⁶⁹

There is an additional important distinction between the written description that is necessary to support a claim under 35 U.S.C. 112(a) and the description sufficient to anticipate the subject matter of the claim under AIA 35 U.S.C. 102(a)(1) or (a)(2).⁷⁰ To provide support for a claim under 35 U.S.C. 112(a), it is necessary that the specification

describe and enable the entire scope of the claimed invention. However, in order for a prior art document to describe a claimed invention under AIA 35 U.S.C. 102(a)(1) or (a)(2), the prior art document need only describe and enable one skilled in the art to make a single species or embodiment of the claimed invention.⁷¹

An anticipatory description it is not required in order for a disclosure to qualify as prior art, unless the disclosure is being used as the basis for an anticipation rejection. In accordance with pre-AIA case law concerning obviousness, a disclosure may be cited for all that it would reasonably have made known to a person of ordinary skill in the art. Thus, the description requirement of AIA 35 U.S.C. 102(a)(1) and (a)(2) does not preclude an examiner from applying a disclosure in an obviousness rejection under AIA 35 U.S.C. 103 simply because the disclosure is not adequate to anticipate the claimed invention under AIA 35 U.S.C. 102(a)(1) or (a)(2).

c. In public use. Under pre-AIA 35 U.S.C. 102(b), that an invention was “in public use” precluded the grant of a patent only if such public use occurred “in this country.” Under AIA 35 U.S.C. 102(a)(1), there is no geographic limitation on where prior public use or public availability occurs. Furthermore, a public use would need to occur before the effective filing date of the claimed invention to constitute prior art under AIA 35 U.S.C. 102(a)(1).

The pre-AIA case law also indicates that a public use will bar patentability if the public use occurs before the critical date⁷² and the invention is ready for patenting.⁷³ Under

pre-AIA 35 U.S.C. 102(b), the uses of an invention before the patent's critical date that constitute a "public use" fall into two categories: the use either "(1) was accessible to the public; or (2) was commercially exploited."⁷⁴ Whether a use is a pre-AIA 35 U.S.C. 102(b) public use also depends on who is making the use of the invention. "[W]hen an asserted prior use is not that of the applicant, [pre-AIA 35 U.S.C.] 102(b) is not a bar when that prior use or knowledge is not available to the public."⁷⁵ In other words, a use by a third party who did not obtain the invention from the inventor named in the application or patent is an invalidating use under pre-AIA 35 U.S.C. 102(b) only if it falls into the first category: that the use was accessible to the public. On the other hand, "an inventor's own prior commercial use, albeit kept secret, may constitute a public use or sale under [pre-AIA 35 U.S.C.] 102(b), barring him from obtaining a patent."⁷⁶ Also, an inventor creates a public use bar under pre-AIA 35 U.S.C. 102(b) when the inventor shows the invention to, or allows it to be used by, another person who is "under no limitation, restriction, or obligation of confidentiality" to the inventor.⁷⁷

Further, under pre-AIA 35 U.S.C. 102(a), "in order to invalidate a patent based on prior knowledge or use" by another in this country prior to the patent's priority date, "that knowledge or use must have been available to the public."⁷⁸ Patent-defeating "use," under pre-AIA 35 U.S.C. 102(a), includes only that "use which is accessible to the public."⁷⁹

As discussed previously, public use under AIA 35 U.S.C. 102(a)(1) is limited to those uses that are available to the public. The public use provision of AIA 35 U.S.C.

102(a)(1) thus has the same substantive scope, with respect to uses by either the inventor or a third party, as public uses under pre-AIA 35 U.S.C. 102(b) by unrelated third parties or uses by others under pre-AIA 35 U.S.C. 102(a).

As also discussed previously, once an examiner becomes aware that a claimed invention has been the subject of a potentially public use, the examiner may require the applicant to provide information showing that the use did not make the claimed process accessible to the public.

d. On sale. The pre-AIA case law indicates that on sale activity will bar patentability if the claimed invention was: (1) the subject of a commercial sale or offer for sale, not primarily for experimental purposes; and (2) ready for patenting.⁸⁰ Contract law principles apply in order to determine whether a commercial sale or offer for sale occurred. In addition, the enablement inquiry is not applicable to the question of whether a claimed invention is “on sale” under pre-AIA 35 U.S.C. 102(b).⁸¹ The phrase “on sale” in AIA 35 U.S.C. 102(a)(1) is treated as having the same meaning as “on sale” in pre-AIA 35 U.S.C. 102(b), except that the sale must make the invention available to the public. For a discussion of “on sale” as used in pre-AIA 35 U.S.C. 102(b), see generally MPEP § 2133.03(b) et seq.

Under pre-AIA 35 U.S.C. 102(b), if an invention was “on sale,” patentability was precluded only if the invention was on sale “in this country.” Under AIA 35 U.S.C. 102(a)(1), there is no geographic limitation on where the sale or offer for sale may occur.

When formulating a rejection, Office personnel should consider evidence of sales activity, regardless of where the sale activity took place.

The pre-AIA 35 U.S.C. 102(b) “on sale” provision has been interpreted as including commercial activity even if the activity is secret. AIA 35 U.S.C. 102(a)(1) uses the same “on sale” term as pre-AIA 35 U.S.C. 102(b). The “or otherwise available to the public” residual clause of AIA 35 U.S.C. 102(a)(1), however, indicates that AIA 35 U.S.C. 102(a)(1) does not cover secret sales or offers for sale. For example, an activity (such as a sale, offer for sale, or other commercial activity) is secret (non-public) if it is among individuals having an obligation of confidentiality to the inventor.⁸²

e. Otherwise available to the public. AIA 35 U.S.C. 102(a)(1) provides a “catch-all” provision, which defines a new additional category of potential prior art not provided for in pre-AIA 35 U.S.C. 102. Specifically, a claimed invention may not be patented if it was “otherwise available to the public” before its effective filing date. This “catch-all” provision permits 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 within another category of prior art as defined in AIA 35 U.S.C. 102(a)(1). The availability of the subject matter to the public may arise in situations such as a student thesis in a university library,⁸³ a poster display or other information disseminated at a scientific meeting,⁸⁴ subject matter in a laid-open patent application,⁸⁵ a document electronically posted on the Internet,⁸⁶ or a commercial transaction that does not constitute a sale under

the Uniform Commercial Code.⁸⁷ Even if a document or other disclosure is not a printed publication, or a transaction is not a sale, either may be prior art under the “otherwise available to the public” provision of AIA 35 U.S.C. 102(a)(1), provided that the claimed invention is made sufficiently available to the public.

f. No requirement of “by others.” A key difference between pre-AIA 35 U.S.C. 102(a) and AIA 35 U.S.C. 102(a)(1) is the requirement in pre-AIA 35 U.S.C. 102(a) that the prior art relied on was “by others.” Under AIA 35 U.S.C. 102(a)(1), there is no requirement that the prior art relied upon be by others. Thus, any prior art which falls under AIA 35 U.S.C. 102(a)(1) need not be by another to constitute potentially available prior art. However, disclosures of the subject matter made one year or less before the effective filing date of the claimed invention by the inventor or a joint inventor or another who obtained the subject matter directly or indirectly from the inventor or a joint inventor may fall within an exception under AIA 35 U.S.C. 102(b)(1) to AIA 35 U.S.C. 102(a)(1).

g. Admissions. The Office will continue to treat admissions by the applicant as prior art under the AIA. A statement by an applicant in the specification or made during prosecution identifying the work of another as “prior art” is an admission which can be relied upon for both anticipation and obviousness determinations, regardless of whether the admitted prior art would otherwise qualify as prior art under AIA 35 U.S.C. 102.⁸⁸ For a discussion of admissions as prior art, see generally MPEP § 2129.

h. The meaning of “disclosure.” The AIA does not define the term “disclosure,” and AIA 35 U.S.C. 102(a) does not use the term “disclosure.” AIA 35 U.S.C. 102(b)(1) and (b)(2), however, each state conditions under which a “disclosure” that otherwise falls within AIA 35 U.S.C. 102(a)(1) or 102(a)(2) is not prior art under AIA 35 U.S.C. 102(a)(1) or 102(a)(2).⁸⁹ Thus, the Office is treating the term “disclosure” as a generic expression intended to encompass the documents and activities enumerated in AIA 35 U.S.C. 102(a) (i.e., being patented, described in a printed publication, in public use, on sale, or otherwise available to the public, or being described in a U.S. patent, U.S. patent application publication, or WIPO published application).

2. Prior art exceptions under 35 U.S.C. 102(b)(1) to AIA 35 U.S.C. 102(a)(1).

a. Prior art exception under AIA 35 U.S.C. 102(b)(1)(A) to AIA 35 U.S.C.

102(a)(1) (grace period inventor or inventor-originated disclosure exception). AIA 35 U.S.C. 102(b)(1)(A) provides exceptions to the prior art provisions of AIA 35 U.S.C. 102(a)(1). These exceptions limit the use of an inventor’s own work as prior art, when the inventor’s own work has been publicly disclosed by the inventor, a joint inventor, or another who obtained the subject matter directly or indirectly from the inventor or joint inventor. AIA 35 U.S.C. 102(b)(1)(A) provides that a disclosure which would otherwise qualify as prior art under AIA 35 U.S.C. 102(a)(1) is not prior art if the disclosure was made: (1) one year or less before the effective filing date of the claimed invention; and (2) by the inventor or a joint inventor, or by another who obtained the subject matter directly or indirectly from the inventor or joint inventor. These guidelines will first

discuss issues pertaining to disclosures within the grace period by the inventor or a joint inventor (“grace period inventor disclosures”) and then subsequently discuss issues pertaining to disclosures within the grace period by another who obtained the subject matter directly or indirectly from the inventor or joint inventor (“grace period inventor-originated disclosures”). Section II.A. of these examination guidelines discusses the “effective filing date” of a claimed invention.

i. Grace period inventor disclosure exception. AIA 35 U.S.C. 102(b)(1)(A) first provides that a disclosure which would otherwise qualify as prior art under AIA 35 U.S.C. 102(a)(1) may be disqualified as prior art if the disclosure is made: (1) one year or less before the effective filing date of the claimed invention; and (2) by the inventor or a joint inventor. Thus, a disclosure that would otherwise qualify as prior art under AIA 35 U.S.C. 102(a)(1) will not be treated as prior art by Office personnel if the disclosure is made one year or less before the effective filing date of the claimed invention, and the evidence shows that the disclosure is by the inventor or a joint inventor. What evidence is necessary to show that the disclosure is by the inventor or a joint inventor requires case-by-case treatment, depending upon whether it is apparent from the disclosure itself or the patent application specification that the disclosure is by the inventor or a joint inventor.

Office personnel will not apply a disclosure as prior art under AIA 35 U.S.C. 102(a)(1) if it is apparent from the disclosure itself that it is by the inventor or a joint inventor. Specifically, Office personnel will not apply a disclosure as prior art under

AIA 35 U.S.C. 102(a)(1) if the disclosure: (1) was made one year or less before the effective filing date of the claimed invention; (2) names the inventor or a joint inventor as an author or an inventor; and (3) does not name additional persons as authors on a printed publication or inventors on a patent. This means that in circumstances where an application names additional persons as inventors relative to the persons named as authors in the publication (e.g., the application names as inventors A, B, and C, and the publication names as authors A and B), and the publication is one year or less before the effective filing date, it is apparent that the disclosure is a grace period inventor disclosure, and the publication would not be treated as prior art under AIA 35 U.S.C. 102(a)(1). If, however, the application names fewer inventors than a publication (e.g., the application names as inventors A and B, and the publication names as authors A, B and C), it would not be readily apparent from the publication that it is by the inventor or a joint inventor and the publication would be treated as prior art under AIA 35 U.S.C. 102(a)(1).

The Office is also revising the rules of practice in a separate action (RIN 0651-AC77) to provide that applicants can include a statement of any grace period inventor disclosures in the specification (37 CFR 1.77(b)(6)). An applicant is not required to use the format specified in 37 CFR 1.77 or identify any prior disclosures by the inventor or a joint inventor (unless necessary to overcome a rejection), but identifying any prior disclosures by the inventor or a joint inventor may expedite examination of the application and save applicants (and the Office) the costs related to an Office action and reply. If the patent application specification contains a specific reference to a grace period inventor disclosure, the Office will consider it apparent from the specification that the disclosure is

by the inventor or a joint inventor, provided that the disclosure does not name additional authors or inventors and there is no other evidence to the contrary. The applicant may also provide a copy of the disclosure (e.g., copy of a printed publication).

The Office is also revising the rules of practice in a separate action (RIN 0651-AC77) to provide a mechanism for filing an affidavit or declaration (under 37 CFR 1.130) to establish that a disclosure is not prior art under AIA 35 U.S.C. 102(a) due to an exception in AIA 35 U.S.C. 102(b). In the situations in which it is not apparent from the disclosure or the patent application specification that the disclosure is by the inventor or a joint inventor, the applicant may establish by way of an affidavit or declaration that a grace period disclosure is not prior art under AIA 35 U.S.C. 102(a)(1) because the disclosure was by the inventor or a joint inventor. Section II.D.1. of these examination guidelines discusses the use of affidavits or declarations to show that the disclosure was made by the inventor or a joint inventor under the exception of AIA 35 U.S.C. 102(b)(1)(A) for a grace period inventor disclosure.

ii. Grace period inventor-originated disclosure exception. AIA 35 U.S.C.

102(b)(1)(A) also provides that a disclosure which would otherwise qualify as prior art under AIA 35 U.S.C. 102(a)(1) may be disqualified as prior art if the disclosure was made: (1) one year or less before the effective filing date of the claimed invention; and (2) by another who obtained the subject matter directly or indirectly from the inventor or a joint inventor. Thus, if a disclosure upon which the rejection is based is by someone who obtained the subject matter from the inventor or a joint inventor, and was made one

year or less before the effective filing date of the claimed invention, the applicant may establish by way of an affidavit or declaration that the disclosure is not prior art under AIA 35 U.S.C. 102(a)(1) because the disclosure was by another who obtained the subject matter directly or indirectly from the inventor or a joint inventor. Section II.D.3. of these examination guidelines discusses the use of affidavits or declarations to show that a disclosure was by another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor under the exception of AIA 35 U.S.C. 102(b)(1)(A) for a grace period inventor-originated disclosure.

b. Prior art exception under AIA 35 U.S.C. 102(b)(1)(B) to AIA 35 U.S.C.

102(a)(1) (inventor or inventor-originated prior public disclosure exception). AIA 35 U.S.C. 102(b)(1)(B) provides additional exceptions to the prior art provisions of AIA 35 U.S.C. 102(a)(1). These exceptions disqualify a disclosure of subject matter that occurs after the subject matter had been publicly disclosed by the inventor, a joint inventor, or another who obtained the subject matter directly or indirectly from the inventor or joint inventor. Specifically, AIA 35 U.S.C. 102(b)(1)(B) provides that a disclosure which would otherwise qualify as prior art under AIA 35 U.S.C. 102(a)(1) (patent, printed publication, public use, sale, or other means of public availability) may be disqualified as prior art if: (1) the disclosure was made one year or less before the effective filing date of the claimed invention; and (2) the subject matter disclosed had been previously publicly disclosed by the inventor, a joint inventor, or another who obtained the subject matter directly or indirectly from the inventor or joint inventor. The previous public disclosure of the subject matter by the inventor, a joint inventor, or

another who obtained the subject matter directly or indirectly from the inventor or joint inventor must itself be a disclosure within the one-year grace period (i.e., be either a grace period inventor disclosure by the inventor or a joint inventor or be a grace period inventor-originated disclosure by another who obtained the subject matter directly or indirectly from the inventor or joint inventor). Otherwise, the previous public disclosure of the subject matter would qualify as prior art under AIA 35 U.S.C. 102(a)(1) that could not be disqualified under AIA 35 U.S.C. 102(b)(1). Section II.A. of these examination guidelines discusses the “effective filing date” of a claimed invention. Section II.D.2. of these examination guidelines discusses the use of affidavits or declarations to show that the subject matter disclosed had, before such disclosure, been publicly disclosed by the inventor or a joint inventor, and section II.D.3. of these examination guidelines discusses the use of affidavits or declarations to show that another obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor.

The exception in AIA 35 U.S.C. 102(b)(1)(B) applies if the “subject matter disclosed [in the intervening disclosure] had, before such [intervening] disclosure, been publicly disclosed by the inventor or a joint inventor”⁹⁰ The exception in AIA 35 U.S.C. 102(b)(1)(B) focuses on the “subject matter” that had been publicly disclosed by the inventor or a joint inventor. There is no requirement under AIA 35 U.S.C. 102(b)(1)(B) that the mode of disclosure by the inventor or a joint inventor (e.g., patenting, publication, public use, sale activity) be the same as the mode of disclosure of the intervening grace period disclosure. There is also no requirement that the disclosure by the inventor or a joint inventor be a verbatim or ipsissimis verbis disclosure of the

intervening grace period disclosure.⁹¹ What is required for subject matter in an intervening grace period disclosure to be excepted under AIA 35 U.S.C. 102(b)(1)(B) is that the subject matter of the disclosure to be disqualified as prior art must have been previously publicly disclosed by the inventor or a joint inventor.

The exception in AIA 35 U.S.C. 102(b)(1)(B) applies to the subject matter in the disclosure being relied upon as prior art for a rejection under AIA 35 U.S.C. 102(a)(1) (an intervening disclosure) that was also publicly disclosed by the inventor or a joint inventor before such intervening disclosure. The subject matter of an intervening grace period disclosure that was not previously publicly disclosed by the inventor or a joint inventor is available as prior art under AIA 35 U.S.C. 102(a)(1). For example, the inventor or a joint inventor had publicly disclosed elements A, B, and C, and a subsequent intervening grace period disclosure discloses elements A, B, C, and D, then only element D of the intervening grace period disclosure is available as prior art under AIA 35 U.S.C. 102(a)(1).

In addition, if subject matter of an intervening grace period disclosure is simply a more general description of the subject matter previously publicly disclosed by the inventor or a joint inventor, the exception in AIA 35 U.S.C. 102(b)(1)(B) applies to such subject matter of the intervening grace period disclosure. For example, if the inventor or a joint inventor had publicly disclosed a species, and a subsequent intervening grace period disclosure discloses a genus (i.e., provides a more generic disclosure of the species), the intervening grace period disclosure of the genus is not available as prior art under AIA 35

U.S.C. 102(a)(1). Conversely, if the inventor or a joint inventor had publicly disclosed a genus, and a subsequent intervening grace period disclosure discloses a species, the intervening grace period disclosure of the species would be available as prior art under AIA 35 U.S.C. 102(a)(1). Likewise, if the inventor or a joint inventor had publicly disclosed a species, and a subsequent intervening grace period disclosure discloses an alternative species not also disclosed by the inventor or a joint inventor, the intervening grace period disclosure of the alternative species would be available as prior art under AIA 35 U.S.C. 102(a)(1).

Finally, AIA 35 U.S.C. 102(b)(1)(B) does not discuss “the claimed invention” with respect to either the subject matter disclosed by the inventor or a joint inventor, or the subject matter of the subsequent intervening grace period disclosure. Any inquiry with respect to the claimed invention is whether or not the subject matter in the prior art disclosure being relied upon anticipates or renders obvious the claimed invention. A determination of whether the exception in AIA 35 U.S.C. 102(b)(1)(B) is applicable to subject matter in an intervening grace period disclosure does not involve a comparison of the subject matter of the claimed invention to either the subject matter disclosed by the inventor or a joint inventor, or to the subject matter of the subsequent intervening grace period disclosure.

C. Provisions pertaining to subject matter in a U.S. patent or application for a U.S. patent effectively filed before the effective filing date of the claimed invention.

1. Prior art under AIA 35 U.S.C. 102(a)(2) (U.S. patents, U.S. patent application publications, and World Intellectual Property Organization (WIPO) publications of international applications (WIPO published applications)). AIA 35 U.S.C. 102(a)(2) sets forth three types of patent documents that are available as prior art as of the date they were effectively filed with respect to the subject matter relied upon in the document if they name another inventor: (1) U.S. patents; (2) U.S. patent application publications; and (3) WIPO published applications. These documents may have different prior art effects under pre-AIA 35 U.S.C. 102(e) than under AIA 35 U.S.C. 102(a)(2).

a. WIPO published applications. AIA 35 U.S.C. 102(a)(2) explicitly references U.S. patents and U.S. patent application publications. Moreover, the WIPO publication of a PCT international application that designates the United States is an application for patent deemed published under 35 U.S.C. 122(b) for purposes of AIA 35 U.S.C. 102(a)(2) under 35 U.S.C. 374. Thus, under the AIA, WIPO publications of PCT applications that designate the United States are treated as U.S. patent application publications for prior art purposes, regardless of the international filing date, whether they are published in English, or whether the PCT international application enters the national stage in the United States. Accordingly, a U.S. patent, a U.S. patent application publication, or a WIPO published application that names another inventor and was effectively filed before the effective filing date of the claimed invention, is prior art under AIA 35 U.S.C. 102(a)(2). This differs from the treatment of a WIPO published application under pre-AIA 35 U.S.C. 102(e), where a WIPO published application is

treated as a U.S. patent application publication only if the PCT application was filed on or after November 29, 2000, and published under PCT Article 21(2) in the English language.

A U.S. patent, U.S. patent application publication, or WIPO published application is prior art under AIA 35 U.S.C. 102(a)(1) if its issue or publication date is before the effective filing date of the claimed invention in question. If the issue date of the U.S. patent or publication date of the U.S. patent application publication or WIPO published application is not before the effective filing date of the claimed invention, it may still be applicable as prior art under AIA 35 U.S.C. 102(a)(2) if it was “effectively filed” before the effective filing date of the claimed invention in question with respect to the subject matter relied upon to reject the claim. Section II.A. of these examination guidelines discusses the “effective filing date” of a claimed invention. AIA 35 U.S.C. 102(d) sets forth the criteria to determine when subject matter described in a U.S. patent, U.S. patent application publication, or WIPO published application was “effectively filed” for purposes of AIA 35 U.S.C. 102(a)(2).

b. Determining when subject matter was effectively filed under AIA 35 U.S.C. 102(d). AIA 35 U.S.C. 102(d) provides that a U.S. patent, U.S. patent application publication, or WIPO published application is prior art under AIA 35 U.S.C. 102(a)(2) with respect to any subject matter described in the patent or published application as of either its actual filing date (AIA 35 U.S.C. 102(d)(1)), or the filing date of a prior application to which there is a priority or benefit claim (AIA 35 U.S.C. 102(d)(2)). A

U.S. patent, U.S. patent application publication, or WIPO published application “is entitled to claim” priority to, or the benefit of, a prior-filed application if it fulfills the ministerial requirements of: (1) containing a priority or benefit claim to the prior-filed application; (2) being filed within the applicable filing period requirement (depending with or within twelve months of the earlier filing, as applicable); and (3) having a common inventor or being by the same applicant.⁹²

The AIA draws a distinction between actually being entitled to priority to, or the benefit of, a prior-filed application in the definition of effective filing date of a claimed invention in AIA 35 U.S.C. 100(i)(1)(B), and merely being entitled to claim priority to, or the benefit of, a prior-filed application in the definition of effectively filed in AIA 35 U.S.C. 102(d).⁹³ As a result of this distinction, the question of whether a patent or published application is actually entitled to priority or benefit with respect to any of its claims is not at issue in determining the date the patent or published application was “effectively filed” for prior art purposes.⁹⁴ Thus, as was the case even prior to the AIA,⁹⁵ there is no need to evaluate whether any claim of a U.S. patent, U.S. patent application publication, or WIPO published application is actually entitled to priority or benefit under 35 U.S.C. 119, 120, 121, or 365 when applying such a document as prior art.

AIA 35 U.S.C. 102(d) requires that a prior-filed application to which a priority or benefit claim is made must describe the subject matter from the U.S. patent, U.S. patent application publication, or WIPO published application relied upon in a rejection. However, AIA 35 U.S.C. 102(d) does not require that this description meet the

requirements of 35 U.S.C. 112(a). As discussed previously with respect to AIA 35 U.S.C. 102(a)(1), the Office does not view the AIA as changing the extent to which a claimed invention must be described for a prior art document to anticipate the claimed invention under AIA 35 U.S.C. 102.

The AIA also eliminates the so-called Hilmer doctrine.⁹⁶ Under the Hilmer doctrine, pre-AIA 35 U.S.C. 102(e) limited the effective filing date for U.S. patents (and published applications) as prior art to their earliest U.S. filing date. In contrast, AIA 35 U.S.C. 102(d) provides that if the U.S. patent, U.S. patent application publication, or WIPO published application claims priority to one or more prior-filed foreign or international applications under 35 U.S.C. 119 or 365, the patent or published application was effectively filed on the filing date of the earliest such application that describes the subject matter.⁹⁷ Therefore, if the subject matter relied upon is described in the application to which there is a priority or benefit claim, a U.S. patent, a U.S. patent application publication, or WIPO published application is effective as prior art as of the filing date of the earliest such application, regardless of where filed.

c. Requirement of “names another inventor.” To qualify as prior art under AIA 35 U.S.C. 102(a)(2), the prior art U.S. patent, U.S. patent application publication, or WIPO published application must “name[s] another inventor.” This means that if there is any difference in inventive entity between the prior art U.S. patent, U.S. patent application publication, or WIPO published application and the application under examination or patent under reexamination, the U.S. patent, U.S. patent application

publication, or WIPO published application satisfies the “names another inventor” requirement of AIA 35 U.S.C. 102(a)(2). Thus, in the case of joint inventors, only one inventor needs to be different for the inventive entities to be different. Even if there are some inventors in common in a U.S. patent, a U.S. patent application publication, or WIPO published application and in a later-filed application under examination or patent under reexamination, the U.S. patent, a U.S. patent application publication, or WIPO published application qualifies as prior art under AIA 35 U.S.C. 102(a)(2) unless an exception in AIA 35 U.S.C. 102(b)(2) is applicable.

2. Prior art exceptions under 35 U.S.C. 102(b)(2) to AIA 35 U.S.C. 102(a)(2).

a. Prior art exception under AIA 35 U.S.C. 102(b)(2)(A) to AIA 35 U.S.C. 102(a)(2) (inventor-originated disclosure exception). AIA 35 U.S.C. 102(b)(2)(A) provides an exception to the prior art provisions of AIA 35 U.S.C. 102(a)(2). This exception limits the use of an inventor’s own work as prior art, when the inventor’s own work is disclosed in a U.S. patent, U.S. patent application publication, or WIPO published application by another who obtained the subject matter directly or indirectly from the inventor or joint inventor.

Specifically, AIA 35 U.S.C. 102(b)(2)(A) provides that a disclosure which would otherwise qualify as prior art under AIA 35 U.S.C. 102(a)(2) may be disqualified as prior art if the subject matter disclosed was obtained directly or indirectly from the inventor or a joint inventor. Thus, if the subject matter in a U.S. patent, U.S. patent application

publication, or WIPO published application upon which the rejection is based is by another who obtained the subject matter from the inventor or a joint inventor, the applicant may establish by way of an affidavit or declaration that a disclosure is not prior art under AIA 35 U.S.C. 102(a)(2). Section II.D.3. of these examination guidelines discusses the use of affidavits or declarations to show that the disclosure was by another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor under the exception of AIA 35 U.S.C. 102(b)(2)(A) for an inventor-originated disclosure.

b. Prior art exception under AIA 35 U.S.C. 102(b)(2)(B) to AIA 35 U.S.C. 102(a)(2) (inventor or inventor-originated prior public disclosure exception).

AIA 35 U.S.C. 102(b)(2)(B) provides additional exceptions to the prior art provisions of AIA 35 U.S.C. 102(a)(2). These exceptions disqualify subject matter that was effectively filed by another after the subject matter had been publicly disclosed by the inventor, a joint inventor, or another who obtained the subject matter directly or indirectly from the inventor or joint inventor.

Specifically, AIA 35 U.S.C. 102(b)(2)(B) provides that a disclosure which would otherwise qualify as prior art under AIA 35 U.S.C. 102(a)(2) (a U.S. patent, U.S. patent application publication, or WIPO published application) may be disqualified as prior art if the subject matter disclosed had been previously publicly disclosed by the inventor, a joint inventor, or another who obtained the subject matter directly or indirectly from the inventor or joint inventor. The previous public disclosure of the subject matter by the

inventor, a joint inventor, or another who obtained the subject matter directly or indirectly from the inventor or joint inventor must itself be a public disclosure (i.e., be either an inventor disclosure by the inventor or a joint inventor or be an inventor-originated disclosure by another who obtained the subject matter directly or indirectly from the inventor or joint inventor). If a previous public disclosure by the inventor or which originated with the inventor is not within the grace period of AIA 35 U.S.C. 102(b)(1), it would qualify as prior art under AIA 35 U.S.C. 102(a)(1), and could not be disqualified under AIA 35 U.S.C. 102(b)(1). Section II.D.2. of these examination guidelines discusses the use of affidavits or declarations to show that the subject matter disclosed had, before such disclosure, been publicly disclosed by the inventor or a joint inventor, and section II.D.3. of these examination guidelines discusses the use of affidavits or declarations to show that another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor.

Similar to the previous discussion of AIA 35 U.S.C. 102(b)(1)(B), the exception in AIA 35 U.S.C. 102(b)(2)(B) applies if the “subject matter disclosed [in the intervening disclosure] had, before such [intervening] disclosure [was effectively filed], been publicly disclosed by the inventor or a joint inventor”⁹⁸ The exception in AIA 35 U.S.C. 102(b)(2)(B) focuses on the “subject matter” that had been publicly disclosed by the inventor or a joint inventor. There is no requirement under 35 U.S.C. 102(b)(2)(B) that the mode of disclosure by the inventor or a joint inventor (e.g., patenting, publication, public use, sale activity) be the same as the mode of disclosure of the intervening U.S. patent, U.S. patent application publication, or WIPO published application. There is also

no requirement that the disclosure by the inventor or a joint inventor be a verbatim or ipsissimis verbis disclosure of the intervening U.S. patent, U.S. patent application publication, or WIPO published application. What is required for subject matter in the intervening U.S. patent, U.S. patent application publication, or WIPO published application to be excepted under AIA 35 U.S.C. 102(b)(2)(B) is that the subject matter must have been previously publicly disclosed by the inventor or a joint inventor or must have originated with the inventor.

The exception in AIA 35 U.S.C. 102(b)(2)(B) applies to the subject matter in the intervening U.S. patent, U.S. patent application publication, or WIPO published application being relied upon for a rejection under AIA 35 U.S.C. 102(a)(2) that was also publicly disclosed by the inventor or a joint inventor (or have originated with the inventor) before the date the subject matter relied upon was effectively filed. The subject matter of an intervening U.S. patent, U.S. patent application publication, or WIPO published application that was not previously publicly disclosed by the inventor or a joint inventor (or by another who obtained the subject matter from the inventor or joint inventor) is available as prior art under AIA 35 U.S.C. 102(a)(2). For example, if the inventor or a joint inventor had publicly disclosed elements A, B, and C, and a subsequent intervening U.S. patent, U.S. patent application publication, or WIPO published application discloses elements A, B, C, and D, then only element D of the intervening U.S. patent, U.S. patent application publication, or WIPO published application is available as prior art under AIA 35 U.S.C. 102(a)(2).

In addition, if subject matter of an intervening U.S. patent, U.S. patent application publication, or WIPO published application is simply a more general description of the subject matter previously publicly disclosed by the inventor or a joint inventor, the exception in AIA 35 U.S.C. 102(b)(1)(B) applies to such subject matter of the intervening U.S. patent, U.S. patent application publication, or WIPO published application disclosure. For example, if the inventor or a joint inventor had publicly disclosed a species, and a subsequent intervening U.S. patent, U.S. patent application publication, or WIPO published application discloses a genus (i.e., provides a more generic disclosure of the species), the disclosure of the genus in the intervening U.S. patent, U.S. patent application publication, or WIPO published application is not available as prior art under AIA 35 U.S.C. 102(a)(2). Conversely, if the inventor or a joint inventor had publicly disclosed a genus, and a subsequent intervening U.S. patent, U.S. patent application publication, or WIPO published application discloses a species, the disclosure of the species in the subsequent intervening U.S. patent, U.S. patent application publication, or WIPO published application would be available as prior art under AIA 35 U.S.C. 102(a)(2). Likewise, if the inventor or a joint inventor had publicly disclosed a species, and a subsequent intervening U.S. patent, U.S. patent application publication, or WIPO published application discloses an alternative species not also disclosed by the inventor or a joint inventor, the disclosure of the alternative species in the intervening U.S. patent, U.S. patent application publication, or WIPO published application would be available as prior art under AIA 35 U.S.C. 102(a)(2).

Finally, AIA 35 U.S.C. 102(b)(2)(B) does not discuss “the claimed invention” with respect to either the subject matter disclosed by the inventor or a joint inventor, or the subject matter of the subsequent intervening U.S. patent, U.S. patent application publication, or WIPO published application. Any inquiry with respect to the claimed invention is whether or not the subject matter in the prior art disclosure being relied upon anticipates or renders obvious the claimed invention. A determination of whether the exception in AIA 35 U.S.C. 102(b)(2)(B) is applicable to subject matter in an intervening U.S. patent, U.S. patent application publication, or WIPO published application does not involve a comparison of the subject matter of the claimed invention to either the subject matter disclosed by the inventor or a joint inventor, or to the subject matter of the subsequent intervening U.S. patent, U.S. patent application publication, or WIPO published application.

c. Prior art exception under AIA 35 U.S.C. 102(b)(2)(C) to AIA 35 U.S.C.

102(a)(2) (common ownership or obligation of assignment). AIA 35 U.S.C.

102(b)(2)(C) provides an additional exception to the prior art provisions of AIA 35 U.S.C. 102(a)(2). The exception of AIA 35 U.S.C. 102(b)(2)(C) disqualifies subject matter disclosed in a U.S. patent, U.S. patent application publication, or WIPO published application from constituting prior art under AIA 35 U.S.C. 102(a)(2) if 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.” AIA 35 U.S.C. 102(b)(2)(C) resembles pre-AIA 35 U.S.C. 103(c) in that both concern common ownership, and both offer an avenue

by which an applicant may avoid certain prior art. However, there are significant differences between AIA 35 U.S.C. 102(b)(2)(C) and pre-AIA 35 U.S.C. 103(c).

If the provisions of AIA 35 U.S.C. 102(b)(2)(C) are met, a U.S. patent, U.S. patent application publication, or WIPO published application that might otherwise qualify as prior art under AIA 35 U.S.C. 102(a)(2) is not available as prior art under either AIA 35 U.S.C. 102 or 103. Under pre-AIA 35 U.S.C. 103(c), such prior art could preclude patentability under pre-AIA 35 U.S.C. 102, even if the conditions of pre-AIA 35 U.S.C. 103(c) were met. The consequence of this distinction is that a published application or an issued patent that falls under the common ownership exception of AIA 35 U.S.C. 102(b)(2)(C) may not be applied in either an anticipation or an obviousness rejection.

It is important to note the circumstances in which the AIA 35 U.S.C. 102(b)(2)(C) exception does not remove U.S. patents, U.S. patent application publications, or WIPO published applications as a basis for any rejection. Even if the U.S. patent or U.S. published application is not prior art under AIA 35 U.S.C. 102 or 103 as a result of AIA 35 U.S.C. 102(b)(2)(C), a double patenting rejection (either statutory under 35 U.S.C. 101 or non-statutory, sometimes called obviousness-type) may still be made on the basis of the U.S. patent or U.S. patent application publication. Furthermore, the U.S. patent, U.S. patent application publication, or WIPO published application that does not qualify as prior art as a result of AIA 35 U.S.C. 102(b)(2)(C) may be cited, in appropriate situations, to indicate the state of the art when making a lack of enablement rejection

under 35 U.S.C. 112(a). A document need not qualify as prior art to be applied in the context of double patenting⁹⁹ or enablement.¹⁰⁰ Also, the AIA 35 U.S.C. 102(b)(2)(C) exception does not apply to a disclosure that qualifies as prior art under AIA 35 U.S.C. 102(a)(1) (disclosures made before the effective filing date of the claimed invention). Thus, if the issue date of a U.S. patent or publication date of a U.S. patent application publication or WIPO published application is before the effective filing date of the claimed invention, it may be prior art under AIA 35 U.S.C. 102(a)(1), regardless of common ownership or the existence of an obligation to assign.

The Office is also revising the rules of practice in a separate action (RIN 0651-AC77) to include provisions that pertain to commonly owned or joint research agreement subject matter (37 CFR 1.104(c)(4) and (c)(5)). 37 CFR 1.104(c)(4) applies to an application that is subject to AIA 35 U.S.C. 102 and 103, and 37 CFR 1.104(c)(5) applies to an application that is subject to pre-AIA 35 U.S.C. 102 and 103. Commonly owned subject matter under AIA 35 U.S.C. 102 and 103 is treated under 37 CFR 1.104(c)(4)(i), and commonly owned subject matter under pre-AIA 35 U.S.C. 102 and 103 is treated under 37 CFR 1.104(c)(5)(i).

A clear and conspicuous statement by the applicant (or the applicant's representative of record) that the claimed invention of the application under examination and the subject matter disclosed in the U.S. patent, U.S. patent application publication, or WIPO published application (prior art) to be excluded under AIA 35 U.S.C. 102(b)(2)(C) were owned by the same person or subject to an obligation of assignment to the same person

not later than the effective filing date of the claimed invention will be sufficient to establish that the AIA 35 U.S.C. 102(b)(2)(C) exception applies. When relying on the provisions of pre-AIA 35 U.S.C. 103(c), the applicant (or the applicant's representative) could provide a similar statement required to disqualify the cited prior art. The applicant may present supporting evidence such as copies of assignment documents, but is not required to do so. Furthermore, the Office will not request corroborating evidence in the absence of independent evidence which raises doubt as to the veracity of such a statement. The statement under AIA 35 U.S.C. 102(b)(2)(C) will generally be treated by Office personnel analogously to statements made under pre-AIA 35 U.S.C. 103(c).¹⁰¹

D. Use of affidavits or declarations under 37 CFR 1.130 to overcome prior art rejections. The Office is also revising the rules of practice in a separate action (RIN 0651-AC77) to provide a mechanism in 37 CFR 1.130 for filing an affidavit or declaration to establish that a disclosure that was not made more than one year before the effective filing date of the claimed invention is not prior art under AIA 35 U.S.C. 102(a) due to an exception in AIA 35 U.S.C. 102(b). Under 37 CFR 1.130(a), an affidavit or declaration of attribution may be submitted to disqualify a disclosure as prior art because it was made by the inventor or a joint inventor, or by one who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor. Under 37 CFR 1.130(b), an affidavit or declaration of prior public disclosure may be submitted to disqualify an intervening disclosure as prior art if: (1) the subject matter disclosed had been publicly disclosed by the inventor or a joint inventor before the disclosure of the subject matter on which the rejection is based; or (2) the subject matter disclosed had

been publicly disclosed by the inventor or a joint inventor before the date the subject matter in the U.S. patent, U.S. patent application publication, or WIPO published application on which the rejection is based was effectively filed.

1. Showing that the disclosure was made by the inventor or a joint inventor.

AIA 35 U.S.C. 102(b)(1)(A) provides that a grace period disclosure shall not be prior art to a claimed invention under AIA 35 U.S.C. 102(a)(1) if the disclosure was made by the inventor or a joint inventor. An applicant may show that a disclosure was made by the inventor or a joint inventor by way of an affidavit or declaration under 37 CFR 1.130(a) (an affidavit or declaration of attribution).¹⁰² Where the authorship of the prior art disclosure includes the inventor or a joint inventor named in the application, an “unequivocal” statement from the inventor or a joint inventor that he/she (or some specific combination of named inventors) invented the subject matter of the disclosure, accompanied by a reasonable explanation of the presence of additional authors, may be acceptable in the absence of evidence to the contrary.¹⁰³ However, a mere statement from the inventor or a joint inventor without any accompanying reasonable explanation may not be sufficient where there is evidence to the contrary.¹⁰⁴ This is similar to the current process for disqualifying a publication as not being by “others” discussed in MPEP § 2132.01, except that AIA 35 U.S.C. 102(b)(1)(A) requires only that the disclosure be by the inventor or a joint inventor.

2. Showing that the subject matter disclosed had been previously publicly disclosed by the inventor or a joint inventor. AIA 35 U.S.C. 102(b)(1)(B) provides

that a grace period disclosure shall not be prior art to a claimed invention under AIA 35 U.S.C. 102(a)(1) if subject matter disclosed had, before such disclosure, been publicly disclosed by the inventor or a joint inventor. Similarly, AIA 35 U.S.C. 102(b)(2)(B) provides that a disclosure shall not be prior art to a claimed invention under AIA 35 U.S.C. 102(a)(2) if the subject matter disclosed had, before such subject matter was effectively filed under AIA 35 U.S.C. 102(a)(2), been publicly disclosed by the inventor or a joint inventor. An applicant may show that the subject matter disclosed had been publicly disclosed by the inventor or a joint inventor before the disclosure or effective filing date of the subject matter on which the rejection was based by way of an affidavit or declaration under 37 CFR 1.130(b) (an affidavit or declaration of prior public disclosure). Specifically, the affidavit or declaration must identify the subject matter publicly disclosed and establish the date and content of their earlier public disclosure. If the earlier public disclosure was a printed publication, the affidavit or declaration must be accompanied by a copy of the printed publication in accordance with 37 CFR 1.130(b)(1). If the earlier disclosure was not a printed publication, the affidavit or declaration must describe the earlier disclosure with sufficient detail and particularity to determine that the earlier disclosure is a public disclosure of the subject matter, as required by 37 CFR 1.130(b)(2).

The manner of disclosure of subject matter referenced in an affidavit or declaration under 37 CFR 1.130(b) is not critical. Just as the prior art provision of AIA 35 U.S.C. 102(a)(1) encompasses any disclosure that renders a claimed invention “available to the public,” any manner of disclosure may be evidenced in an affidavit or declaration under 37 CFR

1.130(b). That is, when using an affidavit or declaration under 37 CFR 1.130(b) to disqualify an intervening disclosure as prior art based on a prior public disclosure by an inventor or a joint inventor, it is not necessary for the subject matter to have been disclosed in the same manner or using the same words. For example, the inventor or a joint inventor may have publicly disclosed the subject matter in question via a slide presentation at a scientific meeting, while the intervening disclosure of the subject matter may have been made in a journal article. This difference in the manner of disclosure or differences in the words used to describe the subject matter will not preclude the inventor from submitting an affidavit or declaration under 37 CFR 1.130(b) to disqualify the intervening disclosure (e.g., a journal article) as prior art.

3. Showing that the disclosure was made, or that subject matter had been previously publicly disclosed, by another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor. AIA 35 U.S.C.

102(b)(1)(A), 102(b)(1)(B), 102(b)(2)(A), and 102(b)(2)(B) each provide similar treatment for disclosures of subject matter by another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor. Specifically, AIA 35 U.S.C. 102(b)(1)(A) provides that a grace period disclosure shall not be prior art to a claimed invention under AIA 35 U.S.C. 102(a)(1) if the disclosure was made by another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor, and AIA 35 U.S.C. 102(b)(2)(A) provides that a disclosure shall not be prior art to a claimed invention under AIA 35 U.S.C. 102(a)(2) if the subject matter disclosed was obtained directly or indirectly from the inventor or a joint inventor. In

addition, AIA 35 U.S.C. 102(b)(1)(B) and 102(b)(2)(B) provide that a grace period disclosure shall not be prior art to a claimed invention under AIA 35 U.S.C. 102(a)(1), and that a disclosure shall not be prior art to a claimed invention under AIA 35 U.S.C. 102(a)(2), if the subject matter disclosed had, before such disclosure, been publicly disclosed by another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor. An applicant may also show that another obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor in an affidavit or declaration under 37 CFR 1.130(a) or (b). Thus, an applicant may make use of a prior public disclosure by another during the grace period if the applicant can establish that subject matter disclosed originated with the inventor or a joint inventor and that the subject matter was communicated by the inventor or a joint inventor, directly or indirectly. Any documentation which provides evidence of the communication of the subject matter by the inventor or a joint inventor to the entity that made the disclosure of the subject matter should accompany the affidavit or declaration.

4. Enablement. An affidavit or declaration under 37 CFR 1.130(a) or (b) need not demonstrate that the disclosure by the inventor, a joint inventor, or another who obtained the subject matter disclosed directly or indirectly from an inventor or a joint inventor was an “enabling” disclosure of the subject matter within the meaning of 35 U.S.C. 112(a). Rather, an affidavit or declaration under 37 CFR 1.130 must show that: (1) the disclosure in question was made by the inventor or a joint inventor, or the subject matter disclosed was obtained directly or indirectly from the inventor or a joint inventor (37 CFR 1.130(a));¹⁰⁵ or (2) the subject matter disclosed had, before such disclosure was made or

before such subject matter was effectively filed, 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 (37 CFR 1.130(b)).¹⁰⁶

5. Who may file an affidavit or declaration under 37 CFR 1.130. In accordance with 37 CFR 1.130, the applicant or patent owner may submit an affidavit or declaration. When an assignee, obligated assignee, or person showing sufficient proprietary interest is the applicant under 35 U.S.C. 118 rather than the inventor, the inventor may sign an affidavit or declaration under 37 CFR 1.130 to disqualify a disclosure of the invention as prior art, but the declaration must be filed by a party having authority to take action in the application. Authority to file papers in an application generally does not lie with the inventor if the inventor is not the applicant.

6. Situations in which an affidavit or declaration is not available. The provisions of 37 CFR 1.130 are not available if the rejection is based upon a disclosure made more than one year before the effective filing date of the claimed invention. The AIA retains the principle of the one-year statutory time bar of pre-AIA 35 U.S.C. 102(b) in that a disclosure more than one year before the effective filing date of a claimed invention is prior art under the AIA's 35 U.S.C. 102(a)(1) that cannot be disqualified under 35 U.S.C. 102(b)(1).

Additionally, the provisions of 37 CFR 1.130 may not be available if the rejection is based upon a U.S. patent or U.S. patent application publication of a patented or pending

application naming another inventor if: (1) the patent or pending application claims an invention that is the same or substantially the same as the applicant's or patent owner's claimed invention; and (2) the affidavit or declaration contends that an inventor named in the U.S. patent or U.S. patent application publication derived the claimed invention from the inventor or a joint inventor named in the application or patent. The provisions of 37 CFR 1.130 are not available if it would result in the Office issuing or confirming two patents containing patentably indistinct claims to two different parties.¹⁰⁷ In this situation, an applicant or patent owner may file a petition for a derivation proceeding pursuant to 37 CFR 42.401 et seq. (37 CFR 1.130(c)).

III. Joint research agreements. AIA 35 U.S.C. 102(c) provides three conditions that must be satisfied in order for subject matter disclosed which might otherwise qualify as prior art, and a claimed invention, to be treated as having been owned by the same person or subject to an obligation of assignment to the same person in applying the joint research agreement provisions of AIA 35 U.S.C. 102(b)(2)(C). First, the subject matter disclosed must have been developed and the claimed invention must have been made by, or on behalf of, one or more parties to a joint research agreement that was in effect on or before the effective filing date of the claimed invention.¹⁰⁸ The AIA defines the term “joint research agreement” as a written contract, grant, or cooperative agreement entered into by two or more persons or entities for the performance of experimental, developmental, or research work in the field of the claimed invention.¹⁰⁹ Second, the claimed invention must have been made as a result of activities undertaken within the scope of the joint research agreement.¹¹⁰ Third, the application for patent for the claimed invention must

disclose, or be amended to disclose, the names of the parties to the joint research agreement.¹¹¹ Joint research agreement subject matter under AIA 35 U.S.C. 102 and 103 is treated under 37 CFR 1.104(c)(4)(ii), joint research agreement subject matter under pre-AIA 35 U.S.C. 102 and 103 is treated under 37 CFR 1.104(c)(5)(ii). If these conditions are met, the joint research agreement prior art is not available as prior art under AIA 35 U.S.C. 102(a)(2).

The provisions of AIA 35 U.S.C. 102(c) generally track those of the Cooperative Research and Technology Enhancement Act of 2004 (CREATE Act).¹¹² The major differences between AIA 35 U.S.C. 102(c) and the CREATE Act are that: (1) the new provision is keyed to the effective filing date of the claimed invention, while the CREATE Act focused on the date that the claimed invention was made; and (2) the CREATE Act provisions only applied to obviousness rejections and not to anticipation rejections.

In order to invoke a joint research agreement to disqualify a disclosure as prior art, the applicant (or the applicant's representative of record) must provide a statement that the disclosure of the subject matter on which the rejection is based and the claimed invention were made by or on behalf of parties to a joint research agreement under AIA 35 U.S.C. 102(c). The statement must also assert that the agreement was in effect on or before the effective filing date of the claimed invention, and that the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement. When relying on the provisions of pre-AIA 35 U.S.C. 103(c), the applicant or his attorney or

agent of record could provide a similar statement to disqualify the cited prior art as to the issue of obviousness. If the names of the parties to the joint research agreement are not already stated in the application, it is necessary to amend the application to include the names of the parties to the joint research agreement in accordance with 37 CFR 1.71(g). As is the case with establishing common ownership, the applicant may, but is not required to, present evidence supporting the existence of the joint research agreement. Furthermore, the Office will not request corroborating evidence in the absence of independent evidence which raises doubt as to the existence of the joint research agreement.

As discussed previously, the AIA 35 U.S.C. 102(b)(2)(C) exception does not apply to a disclosure that qualifies as prior art under AIA 35 U.S.C. 102(a)(1) (disclosures made before the effective filing date of the claimed invention). Thus, if the issue date of a U.S. patent or publication date of a U.S. patent application publication or WIPO published application is before the effective filing date of the claimed invention, it may be prior art under AIA 35 U.S.C. 102(a)(1), regardless of the fact that the subject matter disclosed and the claimed invention resulted from a joint research agreement.

IV. Improper naming of inventors. Although the AIA eliminated pre-AIA 35 U.S.C. 102(f), the patent laws still require the naming of the actual inventor or joint inventors of the claimed subject matter.¹¹³ The Office presumes that the named inventor or joint inventors in the application are the actual inventor or joint inventors be named on the patent.¹¹⁴ Where an application names an incorrect inventorship, the

applicant should submit a request to correct inventorship under 37 CFR 1.48. In the rare situation where it clear that the application does not name the correct inventorship and the applicant has not filed a request to correct inventorship under 37 CFR 1.48, Office personnel should reject the claims under 35 U.S.C. 101 and 35 U.S.C. 115.¹¹⁵

V. AIA 35 U.S.C. 103. AIA 35 U.S.C. 103 continues to set forth the nonobviousness requirement for patentability.¹¹⁶ There are, however, some important changes from pre-AIA 35 U.S.C. 103.

The most significant difference between the AIA 35 U.S.C. 103 and pre-AIA 35 U.S.C. 103(a) is that AIA 35 U.S.C. 103 determines obviousness as of the effective filing date of the claimed invention, rather than as of the time that the claimed invention was made. Under pre-AIA examination practice, the Office uses the effective filing date as a proxy for the invention date, unless there is evidence of record to establish an earlier date of invention. Thus, as a practical matter during examination, this distinction between the AIA 35 U.S.C. 103 and pre-AIA 35 U.S.C. 103 will result in a difference in practice only when the case under examination is subject to pre-AIA 35 U.S.C. 103, and there is evidence in the case concerning a date of invention prior to the effective filing date. Such evidence is ordinarily presented by way of an affidavit or declaration under 37 CFR 1.131.

Next, AIA 35 U.S.C. 103 differs from that of pre-AIA 35 U.S.C. 103 in that AIA 35 U.S.C. 103 requires consideration of “the differences between the claimed

invention and the prior art,” while pre-AIA 35 U.S.C. 103 refers to “the differences between the subject matter sought to be patented and the prior art.” This difference in terminology does not indicate the need for any difference in approach to the question of obviousness.¹¹⁷

Further, AIA 35 U.S.C. 103 does not contain any provision similar to pre-AIA 35 U.S.C. 103(b). Pre-AIA 35 U.S.C. 103(b) is narrowly drawn, applying only to nonobviousness of biotechnological inventions, and even then, only when specifically invoked by the patent applicant. Pre-AIA 35 U.S.C. 103(b) provides that under certain conditions, “a biotechnological process using or resulting in a composition of matter that is novel under section 102 and nonobvious under subsection [103(a)] of this section shall be considered nonobvious.” In view of the case law since 1995,¹¹⁸ the need to invoke pre-AIA 35 U.S.C. 103(b) has been rare.

Finally, AIA 35 U.S.C. 103 eliminates pre-AIA 35 U.S.C. 103(c), but corresponding provisions have been introduced in AIA 35 U.S.C. 102(b)(2)(C) and 102(c).

Pre-AIA 35 U.S.C. 103(c) applied if subject matter qualified as prior art only under pre-AIA 35 U.S.C. 102(e), (f), and/or (g), and only in the context of obviousness under pre-AIA 35 U.S.C. 103(a). If subject matter developed by another person was commonly owned with the claimed invention, or if the subject matter was subject to an obligation of assignment to the same person, at the time the claimed invention was made, then pre-AIA 35 U.S.C. 103(a) did not preclude patentability. Furthermore, under the pre-AIA 35 U.S.C. 103(c), if a joint research agreement was in place on or before the

date that the claimed invention was made, the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement, and the application for patent was amended to disclose the names of the parties to the joint research agreement, common ownership or an obligation to assign was deemed to exist. As discussed previously, AIA 35 U.S.C. 102(b)(2)(C) and 102(c) expand on this concept. Under the AIA, the common ownership, the obligation to assign, or the joint research agreement must exist on or before the effective filing date of the claimed invention, rather than on or before the date the invention was made. If the provisions of AIA 35 U.S.C. 102(b)(2)(C) are met, a disclosure is not prior art at all, whereas under pre-AIA 35 U.S.C. 103(c), certain prior art merely was defined as not precluding patentability. Finally, disclosures disqualified as prior art under AIA 35 U.S.C. 102(b)(2)(C) and 102(c) may not be applied in either an anticipation or an obviousness rejection. However, such disclosures could be the basis for statutory double patenting or non-statutory (sometimes referred to as obviousness-type) double patenting rejections.

Generally speaking, and with the exceptions noted herein, pre-AIA notions of obviousness will continue to apply under the AIA. AIA 35 U.S.C. 102(a) defines what is prior art both for purposes of novelty under AIA 35 U.S.C. 102 as well as for purposes of obviousness under AIA 35 U.S.C. 103.¹¹⁹ Thus, if a document qualifies as prior art under AIA 35 U.S.C. 102(a)(1) or (a)(2), and is not subject to an exception under AIA 35 U.S.C. 102(b), it may be applied for what it describes or teaches to those skilled in the art in a rejection under AIA 35 U.S.C. 103.¹²⁰ Office personnel should continue to follow guidance for formulating an appropriate rationale to support any conclusion of

obviousness. See MPEP § 2141 et seq. and the guidance documents available at http://www.uspto.gov/patents/law/exam/ksr_training_materials.jsp.

VI. Applicability date provisions and determining whether an application is subject to the first inventor to file provisions of the AIA. Because the changes to 35 U.S.C. 102 and 103 in the AIA apply only to specific applications filed on or after March 16, 2013, determining the effective filing date of a claimed invention for purposes of applying AIA 35 U.S.C. 102 and 103 provisions or pre-AIA 35 U.S.C. 102 and 103 provisions is critical.

A. Applications filed before March 16, 2013. The changes to 35 U.S.C. 102 and 103 in the AIA do not apply to any application filed before March 16, 2013. Thus, any application filed before March 16, 2013, is governed by pre-AIA 35 U.S.C. 102 and 103 (i.e., the application is a pre-AIA application). Note that neither the filing of a request for continued examination, nor entry into the national stage under 35 U.S.C. 371, constitutes the filing of a new application. Accordingly, even if a request for continued examination under 37 CFR 1.114 is filed after March 16, 2013, in an application that was filed before March 16, 2013, the application remains subject to pre-AIA 35 U.S.C. 102 and 103. Similarly, a PCT application filed under 35 U.S.C. 363 before March 16, 2013, is subject to pre-AIA 35 U.S.C. 102 and 103, regardless of whether the application enters the national stage under 35 U.S.C. 371 before or after March 16, 2013.

B. Applications filed on or after March 16, 2013. AIA 35 U.S.C. 102 and 103 take effect on March 16, 2013. AIA 35 U.S.C. 102 and 103 apply to any patent application that contains or contained at any time a claim to a claimed invention that has an effective filing date that is on or after March 16, 2013. If a patent application contains or contained at any time a claim to a claimed invention having an effective filing date on or after March 16, 2013, AIA 35 U.S.C. 102 and 103 apply to the application (i.e., the application is an AIA application). If there is ever even a single claim to a claimed invention in the application having an effective filing date on or after March 16, 2013, AIA 35 U.S.C. 102 and 103 apply in determining the patentability of every claimed invention in the application. This is the situation even if the remaining claimed inventions all have an effective filing date before March 16, 2013, and even if the claim to a claimed invention having an effective filing date on or after March 16, 2013, is canceled.

If an application filed on or after March 16, 2013, that did not previously contain any claim to a claimed invention having an effective filing date on or after March 16, 2013, (a pre-AIA application) is amended to contain a claim to a claimed invention having an effective filing date on or after March 16, 2013, the application becomes an AIA application (AIA 35 U.S.C. 102 and 103 apply to the application), provided that the newly added claimed invention has support under 35 U.S.C. 112(a) in the application filed on or after March 16, 2013. The application also remains subject to AIA 35 U.S.C. 102 and 103 even if the claim to a claimed invention having an effective filing date on or after March 16, 2013, is subsequently canceled. If an amendment after an Office action

causes the application to change from being governed by pre-AIA 35 U.S.C. 102 and 103 (from being a pre-AIA application) to being governed by AIA 35 U.S.C. 102 and 103 (to being a AIA application), any new ground of rejection necessitated by the change in applicable law would be considered a new ground of rejection necessitated by an amendment for purposes of determining whether the next Office action may be made final.¹²¹

As 35 U.S.C. 132(a)¹²² prohibits the introduction of new matter into the disclosure, an application may not contain a claim to a claimed invention that does not have support under 35 U.S.C. 112(a) in the application (that is directed to new matter). Thus, an application cannot “contain” a claim to a claimed invention that is directed to new matter for purposes of determining whether the application ever contained a claim to a claimed invention having an effective filing date on or after March 16, 2013.¹²³ Therefore, an amendment (other than a preliminary amendment filed on the same day as such application) seeking to add a claim to a claimed invention that is directed to new matter in an application filed on or after March 16, 2013, that, as originally filed, discloses and claims only subject matter also disclosed in a previously filed pre-AIA application to which the application filed on or after March 16, 2013, is entitled to priority or benefit under 35 U.S.C. 119, 120, 121, or 365, would not change the application from a pre-AIA application into an AIA application.

C. Applications subject to the AIA but also containing a claimed invention having an effective filing date before March 16, 2013. Even if AIA 35 U.S.C. 102 and

103 apply to a patent application, pre-AIA 35 U.S.C. 102(g) also applies to every claim in the application if it: (1) contains or contained at any time a claimed invention having an effective filing date that occurs before March 16, 2013; or (2) is ever designated as a continuation, divisional, or continuation-in-part of an application that contains or contained at any time a claimed invention that has an effective filing date that occurs before March 16, 2013. Pre-AIA 35 U.S.C. 102(g) also applies to any patent resulting from an application to which pre-AIA 35 U.S.C. 102(g) applied.

Thus, if an application contains, or contained at any time, any claimed invention having an effective filing date that occurs before March 16, 2013, and also contains, or contained at any time, any claimed invention having an effective filing date that is on or after March 16, 2013, each claim must be patentable under AIA 35 U.S.C. 102 and 103, as well as pre-AIA 35 U.S.C. 102(g), for the applicant to be entitled to a patent. However, an application will not otherwise be concurrently subject to both pre-AIA 35 U.S.C. 102 and 103 and AIA 35 U.S.C. 102 and 103.

For these reasons, when subject matter is claimed in an application having priority to or the benefit of a prior-filed application (e.g., under 35 U.S.C. 120, 121, or 365(c)), care must be taken to accurately determine whether AIA or pre-AIA 35 U.S.C. 102 and 103 applies to the application.

D. Applicant statement in transition applications containing a claimed invention having an effective filing date on or after March 16, 2013. The Office is

revising 37 CFR 1.55 and 1.78 in a separate action (RIN 0651-AC77) to require that if a nonprovisional application filed on or after March 16, 2013, claims the benefit of or priority to the filing date of a foreign, U.S. provisional, U.S. nonprovisional, or international application that was filed prior to March 16, 2013, and also contains or contained at any time a claimed invention having an effective filing date on or after March 16, 2013, the applicant must provide a statement to that effect. This information will assist the Office in determining whether the application is subject to AIA 35 U.S.C. 102 and 103 or pre-AIA 35 U.S.C. 102 and 103.

Date: February 11, 2013 _____
Teresa Stanek Rea
Acting Under Secretary of Commerce for Intellectual Property and
Acting Director of the United States Patent and Trademark Office

¹ See Pub. L. 112-29, 125 Stat. 284 (2011).

² All MPEP references are to MPEP (8th ed. 2001) (Rev. 9 Aug. 2012).

³ See D.L. Auld Co. v. Chroma Graphics, 714 F.2d 1144 (Fed. Cir. 1983) and W.L. Gore & Assocs. v. Garlock, Inc., 721 F.2d 1540 (Fed. Cir. 1983).

⁴ Metallizing Engineering Co. v. Kenyon Bearing and Auto Parts, 153 F.2d 516 (2d Cir. 1946).

⁵ See United States v. Hohri, 482 U.S. 64, 69 (1987); Kelly v. Robinson, 479 U.S. 36, 43 (1986).

⁶ See Universal City Studios v. Reimerdes, 111 F.Supp. 2d. 294, 325 (S.D.N.Y. 2000) (the phrase “or otherwise traffic in” modifies the preceding phrases “offer” and “provide”); Strom v. Goldman Sachs & Co., 202 F.3d 138, 146-47 (2nd. Cir. 1999) (the phrase “or any other equitable relief” modifies at least the immediately preceding phrase “back pay” demonstrating that Congress considered back pay a form of equitable relief).

⁷ See 157 Cong. Rec. 1370 (Mar. 8, 2011) (“The Committee’s understanding of the effect of adding the words ‘or otherwise available to the public’ is confirmed by judicial construction of this phraseology. Courts have consistently found that when the words ‘or otherwise’ or ‘or other’ when used to add a modifier at the end of a string of clauses, the modifier thus added restricts the meaning of the preceding clauses.”).

⁸ 157 Cong. Rec. S1496 (Mar. 9, 2011) (“[S]ubsection 102(a) was drafted in part to do away with precedent under current law that private offers for sale or private uses or secret processes practiced in the United States that result in a product or service that is then made public may be deemed patent-defeating prior art. That will no longer be the case. In effect, the new paragraph 102(a)(1) imposes an overarching requirement for availability to the public, that is a public disclosure, which will limit paragraph 102(a)(1) prior art to subject matter meeting the public accessibility standard that is well-settled in current law, especially case law of the Federal Circuit.”); 157 Cong. Rec. H4429 (June 22, 2011) (“[C]ontrary to current precedent, in order to trigger the bar in the new 102(a) in our legislation, an action must make the patented subject matter ‘available to the public’ before the effective filing date”). One commenter suggested that Senator Leahy’s remarks cannot be considered to be legislative history because they appeared in the Congressional Record on the day after the Senate acted on S. 23, the Senate version of the AIA. However, the bill that was eventually enacted into law, H.R. 1249, was considered in both the House and Senate after Senator Leahy’s statement was printed in the record. Also, the committee report for the bill that became law cites to Senator Leahy’s remarks in its discussion of AIA 35 U.S.C. 102. See H.R. Rep. No. 112-98 at 43, n.20 (2011). The same commenter also suggested that AIA 35 U.S.C. 102(a) should not be construed to impose an overarching public availability requirement because a bill that was introduced in Congress six years earlier more clearly imposed such a standard, even eliminating sales and uses entirely as independent bars to patentability. The Office’s role, however, is not to determine whether Congress could have enacted a statute that is clearer and more forceful, but rather it is to determine the most likely meaning of the statute that Congress actually did enact.

⁹ See In re Kollar, 286 F.3d 1326, 1330 n.3 (Fed. Cir. 2002).

¹⁰ See Elan Corp., PLC v. Andrx Pharmaceuticals, Inc., 366 F.3d 1336, 1341 (Fed. Cir. 2004).

¹¹ See TP Laboratories, Inc. v. Professional Positioners, Inc., 724 F.2d 965, 971 (Fed. Cir. 1984) (“[I]f a prima facie case is made of public use, the patent owner must be able to point to or must come forward with convincing evidence to counter that showing.”); Star Fruits S.N.C. v. U.S., 393 F.3d 1277, 1284 (Fed. Cir. 2005) (“So long as the request from the examiner for information is not arbitrary or capricious, the applicant cannot impede the examiner’s performance of his duty by refusing to comply with an information requirement which proceeds from the examiner’s view of the scope of the law to be applied to the application at hand. To allow such interference would have the effect of forcing the Office to make

patentability determinations on insufficient facts and information. Such conduct inefficiently shifts the burden of obtaining information that the applicant is in the best position to most cheaply provide onto the shoulders of the Office and risks the systemic inefficiencies that attend the issue of invalid patents.”).

¹² See In re Epstein, 32 F.3d 1559, 1568 (Fed. Cir. 1994) (“the question is not whether the sale, even a third party sale, ‘discloses’ the invention at the time of the sale, but whether the sale relates to a device that embodies the invention”) (citing J.A. La Porte, Inc. v. Norfolk Dredging Co., 787 F.2d 1577, 1583 (Fed. Cir. 1986)); see also Zenith Elecs. Corp. v. PDI Commc’n Sys., Inc., 522 F.3d 1348, 1356 (Fed. Cir. 2008) (a public use itself need not be enabling).

¹³ See Pfaff v. Wells Elecs., Inc., 525 U.S. 55, 67 (1998).

¹⁴ See Linear Tech. Corp. v. Micrel, Inc., 275 F.3d 1040, 1048 (Fed. Cir. 2001), and Group One, Ltd. v. Hallmark Cards, Inc., 254 F.3d 1041, 1047 (Fed. Cir. 2001); see also MPEP 2133.03(b).

¹⁵ See Voter Verified, Inc. v. Premier Election Solutions, Inc., 687 F.3d 1374, 1380 (Fed. Cir. 2012) (quoting SRI Int’l, Inc. v. Internet Sec. Sys., Inc., 511 F.3d 1186, 1194 (Fed. Cir. 2008) and Bruckelmyer v. Ground Heaters, Inc., 445 F.3d 1374, 1378 (Fed. Cir. 2006)) (indicating that indexing is a relevant factor, but not a prerequisite, to public availability).

¹⁶ See Northern Telecom Inc. v. Datapoint Corp., 908 F.2d 931, 936 (Fed. Cir. 1990).

¹⁷ See In re Lister, 583 F.3d 1307, 1313 (Fed. Cir. 2009) (explaining the distinction between access to materials being restricted to authorized persons as in Northern Telecom, and a person needing to take steps to gain access to the materials, noting that significant travel that would have been necessary for a person to gain access to the dissertation in In re Hall, 781 F.2d 897 (Fed. Cir. 1986)).

¹⁸ See In re Hilmer, 359 F.2d 859 (CCPA 1966).

¹⁹ See MPEP § 2136.02 II and 2136.03 IV.

²⁰ In re Donohue, 766 F.2d 531 (Fed. Cir. 1985).

²¹ See In re Katz, 687 F.2d 450, 455 (CCPA 1982) (stating that it is incumbent upon the appellant to provide a satisfactory showing which would lead to a reasonable conclusion that appellant is the sole inventor where there is a grace period publication listing individuals in addition to appellant).

²² See, e.g., In re DeBaun, 687 F.2d 459 (CCPA 1982), In re Katz, 687 F.2d 450 (CCPA 1982), and In re Mathews, 408 F.2d 1393 (CCPA 1969).

²³ See United States v. Hohri, 482 U.S. 64, 69 (1987); Kelly v. Robinson, 479 U.S. 36, 43 (1986).

²⁴ See Brown v. Gardner, 513 U.S. 115, 118 (1994) (presumption that a given term is used to mean the same thing throughout a statute).

²⁵ See 35 U.S.C. 100(f), (g), and (j).

²⁶ See 35 U.S.C. 112(b).

²⁷ Pre-AIA 35 U.S.C. 135(b)(2) provides that “[a] claim which is the same as, or for the same or substantially the same subject matter as, a claim of an application published under section 122(b) of this title may be made in an application filed after the application is published only if the claim is made before one year after the date on which the application is published.”

²⁸ Pre-AIA 35 U.S.C. 135(a) provides that “[a]ny such petition may be filed only within the 1-year period beginning on the date of the first publication of a claim to an invention that is the same or substantially the same as the earlier application’s claim to the invention, shall be made under oath, and shall be supported by substantial evidence.”

²⁹ Pre-AIA 35 U.S.C. 154(d)(2) provides that “[t]he ‘right under [35 U.S.C. 154(d)(1)] to obtain a reasonable royalty shall not be available under this subsection unless the invention as claimed in the patent is substantially identical to the invention as claimed in the published patent application.”

³⁰ Pre-AIA 35 U.S.C. 252 provides that “[t]he surrender of the original patent shall take effect upon the issue of the reissued patent, and every reissued patent shall have the same effect and operation in law, on the trial of actions for causes thereafter arising, as if the same had been originally granted in such amended form, but in so far as the claims of the original and reissued patents are substantially identical, such surrender shall not affect any action then pending nor abate any cause of action then existing, and the reissued patent, to the extent that its claims are substantially identical with the original patent, shall constitute a continuation thereof and have effect continuously from the date of the original patent.”

³¹ See Duncan v. Walker, 533 U.S. 167, 174 (2001) (quoting United States v. Menasche, 348 U.S. 528, 538-39 (1955)).

³² See Shannon v. United States, 512 U.S. 573, 584 (1994) (no authority to enforce concepts gleaned solely from legislative history that have no statutory reference point).

³³ See H.R. Rep. No. 112-98 at 73 (2011).

³⁴ There are floor statements that discuss what would be encompassed by the term “the subject matter” in subparagraph (B) of 35 U.S.C. 102(b)(1) and 102(b)(2). One can find support for the “same subject matter” standard (157 Cong. Rec. 1496-97 (Mar. 9, 2011) (“An additional clarification we have been asked about deals with subparagraph 102(b)(1)(B). . . . The inventor is protected not only from the inventor’s own disclosure being prior art against the inventor’s claimed invention, but also against the disclosures of any of the same subject matter in disclosures made by others being prior art against the inventor’s claimed invention under section 102(a) or section 103—so long as the prior art disclosures from others came after the public disclosure by the inventor.”)), as well as for the “the subject matter of the claimed invention” standard (157 Cong. Rec. 1370 (Mar. 8, 2011) (“Under the first subparagraph (B), at section 102(b)(1)(B), if an inventor publicly discloses his invention, no subsequent disclosure made by anyone, regardless of whether the subsequent discloser obtained the subject matter from the inventor, will constitute prior art against the inventor’s subsequent application for patent in the United States. The parallel provision at section 102(b)(2)(B) applies the same rule to subsequent applications: if the inventor discloses his invention, a subsequently filed application by another will not constitute prior art against the inventor’s later-filed application for patent in the United States, even if the other filer did not obtain the subject matter from the first-disclosing inventor.”)). See also H.R. Rep. No. 110-314 at 57 (2007) (the provision disqualifying prior art if “the subject matter had, before such disclosure, been publicly disclosed by the inventor or a joint inventor or others who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor” disqualifies any prior art under section 102(a)(1) if “the same subject matter” had already been publicly disclosed by the inventor).

³⁵ See 35 U.S.C. 102(b)(1)(B) or 102(b)(2)(B).

³⁶ See 35 U.S.C. 102(b)(1)(A) or 102(b)(2)(A).

³⁷ See 35 U.S.C. 102(b)(1)(B) or 102(b)(2)(B).

³⁸ *In re Wands*, 858 F.2d 731, 737 (Fed. Cir. 1988). In *Wands*, the Federal Circuit set forth the following factors to consider when determining whether undue experimentation is needed: (1) the breadth of the claims; (2) the nature of the invention; (3) the state of the prior art; (4) the level of one of ordinary skill; (5) the level of predictability in the art; (6) the amount of direction provided by the inventor; (7) the existence of working examples; and (8) the quantity of experimentation needed to make or use the invention based on the content of the disclosure.

³⁹ See *Hazeltine Res., Inc. v. Brenner*, 382 U.S. 252 (1965).

⁴⁰ See *Hazeltine Res., Inc. v. Brenner*, 382 U.S. 252, 256 (1965) (a previously filed patent application to another pending in the Office, but not patented or published, at the time an application is filed constitutes part of the “prior art” within the meaning of 35 U.S.C. 103).

⁴¹ The Office is also treating such a situation under 35 U.S.C. 101 because 35 U.S.C. 282 makes a distinction between a failure to comply with 35 U.S.C. 112 and a failure to comply with 35 U.S.C. 115, in that a failure to comply with any requirement of 35 U.S.C. 112 (except the failure to disclose the best mode) is listed in 35 U.S.C. 282(b)(3)(A) as a defense in any action involving the validity or infringement of a patent, whereas a failure to comply with 35 U.S.C. 115 is not discussed in 35 U.S.C. 282(b). In addition, 35 U.S.C. 115(i)(3) provides that a patent shall not be invalid or unenforceable based upon the failure to comply with a requirement under 35 U.S.C. 115 if the failure is remedied as provided under 35 U.S.C. 115(i)(1).

⁴² See *Final Bulletin for Agency Good Guidance Practices*, 72 FR 3432 (Jan. 25, 2007).

⁴³ See *Cooper Techs. Co. v. Dudas*, 536 F.3d 1330, 1336 (Fed. Cir. 2008) (explaining that in distinguishing between substantive and interpretative rules, a rule is substantive when it affects a change in existing law or policy that affects individual rights and obligations, where a rule which merely clarifies or explains existing law or regulations is interpretative). As these examination guidelines are not substantive rulemaking, but merely examination guidelines that set out the Office’s interpretation of 35 U.S.C. 102 and 103 as amended by the AIA, these examination guidelines are exempt from the notice-and-comment requirements of 5 U.S.C. 553(b) (or any other law) and the thirty day advance publication requirement of 5 U.S.C. 553(d). See *Cooper Techs.*, 536 F.3d at 1336-37 (stating that 5 U.S.C. 553, and thus 35 U.S.C. 2(b)(2)(B), does not require notice and comment rulemaking for “interpretative rules, general statements of policy, or rules of agency organization, procedure, or practice”) (quoting 5 U.S.C. 553(b)(A)); see also *Mikkilineni v. Stoll*, 410 Fed. Appx. 311, 313 (Fed. Cir. 2010) (Office’s 2009 guidelines concerning 35 U.S.C. 101 are interpretive, rather than substantive, and are thus exempt from the notice and comment requirements of 5

U.S.C. 553). As prior notice and an opportunity for public comment are not required pursuant to 5 U.S.C. 553 or any other law, neither a regulatory flexibility analysis nor a certification under the Regulatory Flexibility Act (5 U.S.C. 601 *et seq.*) is required. See 5 U.S.C. 603.

⁴⁴ Chevron v. Natural Res. Def. Council, 467 U.S. 837 (1984).

⁴⁵ See Animal Legal Def. Fund v. Quigg, 932 F.2d 920, 930-31 (Fed. Cir. 1991); see also 35 U.S.C.

3(a)(2)(A) (“[t]he Director shall be responsible for providing policy direction and management supervision for the Office and for the issuance of patents and the registration of trademarks” and “shall perform these duties in a fair, impartial, and equitable manner”).

⁴⁶ See Final Bulletin for Agency Good Guidance Practices, 72 FR 3432, 3440 (Jan. 25, 2007).

⁴⁷ Under 35 U.S.C. 102(e) as amended by the American Inventors Protection Act of 1999 (AIPA) (Pub. L. 106-113, 113 Stat. 1501 (1999) and the Intellectual Property and High Technology Technical Amendments Act of 2002 (Public Law 107-273), the international filing date of a PCT application is a U.S. filing date for prior art purposes under 35 U.S.C. 102(e) if the international application: (1) has an international filing date on or after November 29, 2000; (2) designated the United States; and (3) was published under PCT Article 21(2) in English. See MPEP § 706.02(f)(1). The AIA amends 35 U.S.C. 102, 363, and 374 to provide simply that the publication under the PCT of an international application designating the United States shall be deemed a publication under 35 U.S.C. 122(b).

⁴⁸ See 35 U.S.C. 101 (“[w]hoever invents or discovers . . . , may obtain a patent therefor, subject to the conditions and requirements of this title); see also P.J. Federico, Commentary on the New Patent Act, 75 J. Pat. & Trademark Off. Soc’y 161, 179 (1993) (noting that pre-AIA 35 U.S.C. 102(f) is perhaps unnecessary since 35 U.S.C. 101 provides that (“[w]hoever invents or discovers . . . , may obtain a patent therefor, subject to the conditions and requirements of this title”).

⁴⁹ See 35 U.S.C. 115 (“An application for patent that is filed under section 111(a) or commences the national stage under section 371 shall include, or be amended to include, the name of the inventor for any invention claimed in the application.”)

⁵⁰ See Pub. L. No. 112-29, § 3(n)(1), 125 Stat. at 293.

⁵¹ See Pub. L. No. 112-29, § 3(n)(1), 125 Stat. at 293.

⁵² 35 U.S.C. 102(g) precludes the grant of a patent if: (1) during the course of an interference conducted under 35 U.S.C. 135 or 291, another inventor involved therein establishes, to the extent permitted in 35 U.S.C. 104, that before such person’s invention thereof the invention was made by such other inventor and not abandoned, suppressed, or concealed, or (2) before such person’s invention thereof, the invention was made in this country by another inventor who had not abandoned, suppressed, or concealed it.

⁵³ See Pub. L. No. 112-29, § 3(n)(2), 125 Stat. at 293.

⁵⁴ See Pub. L. No. 112-29, § 3(n)(2), 125 Stat. at 293.

⁵⁵ See 35 U.S.C. 102(a).

⁵⁶ See 35 U.S.C. 132(a).

⁵⁷ See In re Epstein, 32 F.3d 1559 (Fed. Cir. 1994).

⁵⁸ See 35 U.S.C. 102(b)(1).

⁵⁹ See 35 U.S.C. 102(b)(2).

⁶⁰ See 35 U.S.C. 100(i)(1).

⁶¹ See MPEP § 706.02(VI).

⁶² See 35 U.S.C. 100(i)(2).

⁶³ See In re Ekenstam, 256 F.2d 321, 323 (CCPA 1958); see also MPEP § 2126.01.

⁶⁴ See In re Carlson, 983 F.2d 1032, 1037 (Fed. Cir. 1992); see also MPEP § 2126.

⁶⁵ See Novo Nordisk Pharma., Inc. v. Bio-Tech. Gen. Corp., 424 F.3d 1347, 1355 (Fed. Cir. 2005) (discussing pre-AIA 35 U.S.C. 112, first paragraph, and pre-AIA 35 U.S.C. 102).

⁶⁶ See In re Gleave, 560 F.3d 1331, 1334 (Fed. Cir. 2009), citing Eli Lilly & Co. v. Zenith Goldline Pharms., Inc., 471 F.3d 1369, 1375 (Fed. Cir. 2006); Net MoneyIN, Inc. v. VeriSign, Inc., 545 F.3d 1359, 1370 (Fed. Cir. 2008); In re Bond, 910 F.2d 831, 832-33 (Fed. Cir. 1990).

⁶⁷ See In re Gleave, 560 F.3d 1331, 1334 (Fed. Cir. 2009) (citing Impax Labs., Inc. v. Aventis Pharms., Inc., 545 F.3d 1312, 1314 (Fed. Cir. 2008), and In re LeGrice, 301 F.2d 929, 940-44 (CCPA 1962)).

⁶⁸ See In re Gleave, 560 F.3d 1331, 1334 (Fed. Cir. 2009); see also In re Schoenwald, 964 F.2d 1122, 1124 (Fed. Cir. 1992) (holding that a claimed compound was anticipated even though the prior art reference did not disclose a use for the compound); Schering Corp. v. Geneva Pharms., Inc., 339 F.3d 1373, 1380-81 (Fed. Cir. 2003) (pointing out that actually reducing the invention to practice is not necessary in order for a

prior art reference to anticipate); Impax Labs. Inc. v. Aventis Pharm. Inc., 468 F.3d 1366, 1382 (Fed. Cir. 2006) (stating that “proof of efficacy is not required for a prior art reference to be enabling for purposes of anticipation”).

⁶⁹ See In re Donohue, 766 F.2d 531, 533 (Fed. Cir. 1985).

⁷⁰ See Rasmussen v. SmithKline Beecham Corp., 413 F.3d 1318 (Fed. Cir. 2005).

⁷¹ See Vas-Cath Inc. v. Mahurkar, 935 F.2d 1555, 1562 (Fed. Cir. 1991) (“As the court pointed out, ‘the description of a single embodiment of broadly claimed subject matter constitutes a description of the invention for anticipation purposes . . . , whereas the same information in a specification might not alone be enough to provide a description of that invention for purposes of adequate disclosure.’”) (quoting In re Lukach, 442 F.2d 967 (CCPA 1971)); see also In re Van Langenhoven, 458 F.2d 132 (CCPA 1972), and In re Russetta, 255 F.2d 687 (CCPA 1958).

⁷² Under pre-AIA 35 U.S.C. 102(b), the critical date is the date that is one year prior to the date of application for patent in the United States.

⁷³ See Invitrogen Corp. v. Biocrest Mfg. L.P., 424 F.3d 1374, 1379-80 (Fed. Cir. 2005).

⁷⁴ See American Seating Co. v. USSC Group, Inc., 514 F.3d 1262, 1267 (Fed. Cir. 2008).

⁷⁵ See Woodland Trust v. Flowertree Nursery, Inc., 148 F.3d 1368, 1371 (Fed. Cir. 1998).

⁷⁶ See Woodland Trust v. Flowertree Nursery, Inc., 148 F.3d 1368, 1370 (Fed. Cir. 1998).

⁷⁷ See American Seating Co. v. USSC Group, Inc., 514 F.3d 1262, 1267 (Fed. Cir. 2008).

⁷⁸ See Woodland Trust v. Flowertree Nursery, Inc., 148 F.3d 1368, 1370 (Fed. Cir. 1998).

⁷⁹ See Woodland Trust v. Flowertree Nursery, Inc., 148 F.3d 1368, 1370 (Fed. Cir. 1998) (quoting Carella v. Starlight Archery, 804 F.2d 135, 139 (Fed. Cir. 1986)).

⁸⁰ See Pfaff v. Wells Elecs., Inc., 525 U.S. 55, 67 (1998).

⁸¹ See In re Epstein, 32 F.3d 1559, 1568 (Fed. Cir. 1994).

⁸² Cf. Clock Spring, L.P. v. Wrapmaster, Inc., 560 F.3d 1317, 1325 (Fed. Cir. 2009) (an invention is in public use if it is shown to or used by an individual other than the inventor under no limitation, restriction, or obligation of confidentiality to the inventor).

⁸³ See, e.g., In re Cronyn, 890 F.2d 1158 (Fed. Cir. 1989); In re Hall, 781 F.2d 897 (Fed. Cir. 1986); In re Bayer, 568 F.2d 1357 (CCPA 1978).

⁸⁴ See, e.g., In re Klopfenstein, 380 F.3d 1345 (Fed. Cir. 2004), Massachusetts Institute of Technology v. AB Fortia, 774 F.2d 1104 (Fed. Cir. 1985).

⁸⁵ See, e.g., In re Wyer, 655 F.2d 221 (CCPA 1981); see also Bruckelmyer v. Ground Heaters, Inc., 445 F.3d 1374 (Fed. Cir. 2006).

⁸⁶ See, e.g., Voter Verified, Inc. v. Premier Election Solutions, Inc., 687 F.3d 1380-81 (Fed. Cir. 2012), In re Lister, 583 F.3d 1307 (Fed. Cir. 2009), and SRI Int’l, Inc. v. Internet Sec. Sys., Inc., 511 F.3d 1186 (Fed. Cir. 2008).

⁸⁷ See, e.g., Group One, Ltd. v. Hallmark Cards, Inc., 254 F.3d 1041 (Fed. Cir. 2001).

⁸⁸ See Riverwood Int’l Corp. v. R.A. Jones & Co., 324 F.3d 1346, 1354 (Fed. Cir. 2003); Constant v. Advanced Micro-Devices Inc., 848 F.2d 1560, 1570 (Fed. Cir. 1988).

⁸⁹ See 35 U.S.C. 102(b)(1) (“[a] disclosure made one year or less before the effective filing date of a claimed invention shall not be prior art to the claimed invention under [35 U.S.C. 102](a)(1)”) and 102(b)(2) (“[a] disclosure shall not be prior art to a claimed invention under [35 U.S.C. 102](a)(2)”); see also H.R. Rep. No. 112-98 at 43 (2011) (indicating that the grace period provision of 35 U.S.C. 102(b) would apply to all patent applicant actions during the grace period that would create prior art under 35 U.S.C. 102(a)).

⁹⁰ See 35 U.S.C. 102(b)(1)(B).

⁹¹ See In re Kao, 639 F.3d 1057, 1066 (Fed. Cir. 2011) (subject matter does not change as a function of how one chooses to describe it).

⁹² See 157 Cong. Rec. 1370 (Mar. 8, 2011) (distinguishing between the core requirement that the prior-filed application include an enabling disclosure and the ministerial requirements that the applications be copendent and specifically referenced); see also MPEP § 201.08 (permitting a claim to the benefit of a prior-filed application in a continuation-in-part application provided that the continuation-in-part application has a common inventor, has copendency with the prior-filed application, and includes a specific reference to the prior-filed application, regardless of whether the prior-filed application contains support under 35 U.S.C. 112 for any claim in the continuation-in-part application).

⁹³ The legislative history of the AIA discusses an important distinction between ministerial entitlement to make a priority or benefit claim, and actual legal entitlement to the priority or benefit. In section 100(i), which defines the effective filing date of the patent under review, the patent must be entitled to the priority or benefit itself under the relevant sections. In section 102(d), however, the application need only be entitled to claim the benefit or priority under those sections. This difference in language distinguishes between the core requirement of section 120 et al.—that the application include an enabling disclosure—and the ministerial requirements of that section—that the application be copendent and specifically referenced. In effect, an application that meets the ministerial requirements of copendency and specific reference is entitled to claim the benefit or priority, but only an application that also offers an enabling disclosure is actually entitled to the benefit or priority itself. See 157 Cong. Rec. 1370 (Mar. 8, 2011).

⁹⁴ See In re Wertheim, 646 F.2d 527 (CCPA 1981), which relies upon Alexander Milburn Co. v. Davis-Bournonville, 270 U.S. 390 (1926), for its conclusion that the patent must actually be entitled to the benefit of the prior-application for any subject matter in the patent to have a prior art date under 35 U.S.C. 102(e) as of the filing date of the prior application. The legislative history of the AIA indicates that paragraph (2) of AIA 102(d) is intended to overrule what remained of In re Wertheim, 646 F.2d 527 (CCPA 1981), which appeared to hold that only an application that could have become a patent on the day that it was filed can constitute prior art against another application or patent. See 157 Cong. Rec. 1369-70 (Mar. 8, 2011). The Office has previously indicated that the reasoning of In re Wertheim, 646 F.2d 527 (CCPA 1981), did not survive the amendment to 35 U.S.C. 102(e) in the American Inventor’s Protection Act. See, e.g., Ex parte Yamaguchi, 88 U.S.P.Q.2d 1606, 1610-12 (Bd. Pat. App. & Interf. 2008). In In re Giacomini, 612 F.3d 1380 (Fed. Cir. 2010), the Federal Circuit held that a patent was effective as prior art as of the filing date of a provisional application claimed under 35 U.S.C. 119(e), so long as the subject matter upon which the rejection was based was described in the provisional application filing.

⁹⁵ See MPEP § 2136.03 IV (“In other words, the subject matter used in the rejection must be disclosed in the earlier-filed application in compliance with 35 U.S.C.112, first paragraph, in order for that subject matter to be entitled to the earlier filing date under 35 U.S.C. 102(e).”); see also Ex parte Yamaguchi, 88 U.S.P.Q.2d 1606, 1610-12 (Bd. Pat. App. & Interf. 2008) (discussing the legislative displacement of In re Wertheim, 646 F.2d 527 (CCPA 1981), prior to enactment of the AIA by the provisional application provisions of the Uruguay Round Agreements Act (URAA) (Pub. L. 103-465, 108 Stat. 4809 (1994)), and the eighteen-month publication provisions of the American Inventor’s Protection Act of 1999 (AIPA)).

⁹⁶ As discussed previously, in In re Hilmer, 359 F.2d 859 (CCPA 1966), the CCPA held that reliance on the foreign priority date of a reference applied in a rejection under pre-AIA 35 U.S.C. 102(e) was improper.

⁹⁷ When examining an application to which the changes in 35 U.S.C. 102 and 103 do not apply, Office personnel will continue to apply the Hilmer doctrine, and foreign priority dates may not be used in determining 35 U.S.C.102(e) prior art dates. Note that the international filing date of a published PCT application may be the 35 U.S.C. 102(e) prior art date under pre-AIA law under certain circumstances. See MPEP § 706.02(f).

⁹⁸ See 35 U.S.C. 102(b)(2)(B).

⁹⁹ See MPEP § 804.03 (prior art disqualified under the CREATE Act may be the basis for a double patenting rejection).

¹⁰⁰ See MPEP § 2124 (publications after the critical date may be used to show factual evidence that, as of an application’s filing date, undue experimentation would have been required to make or use the invention, that a parameter absent from the claims was or was not critical, that a statement in the specification was inaccurate, that the invention was inoperative or lacked utility, that a claim was indefinite, or that characteristics of prior art products were known).

¹⁰¹ See MPEP § 706.02(I)(2)(II).

¹⁰² See In re Katz, 687 F.2d 450, 455 (CCPA 1982).

¹⁰³ See In re DeBaun, 687 F.2d 459, 463 (CCPA 1982).

¹⁰⁴ See Ex parte Kroger, 219 USPQ 370 (Bd. App. 1982) (affirming rejection notwithstanding declarations by the alleged actual inventors as to their inventorship in view of a nonapplicant author submitting a letter declaring the nonapplicant author’s inventorship).

¹⁰⁵ See 35 U.S.C. 102(b)(1)(A) or 102(b)(2)(A).

¹⁰⁶ See 35 U.S.C. 102(b)(1)(B) or 102(b)(2)(B).

¹⁰⁷ See In re Deckler, 977 F.2d 1449, 1451-52 (Fed. Cir. 1992) (35 U.S.C. 102, 103, and 135 “clearly contemplate – where different inventive entities are concerned – only one patent should issue for inventions

which are either identical to or not patentably distinct from each other”) (quoting Aelony v. Arni, 547 F.2d 566, 570 (CCPA 1977)).

¹⁰⁸ See 35 U.S.C. 102(c)(1).

¹⁰⁹ See 35 U.S.C. 100(h).

¹¹⁰ See 35 U.S.C. 102(c)(2).

¹¹¹ See 35 U.S.C. 102(c)(3).

¹¹² See Pub. L. 108-453, 118 Stat. 3596 (2004), which was an amendment to pre-AIA 35 U.S.C. 103(c).

Congress has made it clear that the intent of AIA 35 U.S.C. 102(c) is to continue the promotion of joint research activities that was begun under the CREATE Act, stating in section 3(b) of the AIA that “[t]he United States Patent and Trademark Office shall administer section 102(c) of title 35, United States Code, in a manner consistent with the legislative history of the CREATE Act that was relevant to its administration by the United States Patent and Trademark Office.” See 125 Stat. at 287.

¹¹³ See 35 U.S.C. 115(a) (“[a]n application for patent that is filed under [35 U.S.C.] 111(a) or commences the national stage under [35 U.S.C.] 371 shall include, or be amended to include, the name of the inventor for any invention claimed in the application”).

¹¹⁴ See MPEP § 2137.01.

¹¹⁵ As discussed previously, 35 U.S.C. 101 provides that “[w]hoever invents or discovers . . . , may obtain a patent therefor, subject to the conditions and requirements of this title,” while 35 U.S.C. 115 requires that “[a]n application for patent that is filed under section 111(a) or commences the national stage under section 371 shall include, or be amended to include, the name of the inventor for any invention claimed in the application.”

¹¹⁶ AIA 35 U.S.C. 103 provides: “A patent for a claimed invention may not be obtained, notwithstanding that the claimed invention is not identically disclosed as set forth in section 102, if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains. Patentability shall not be negated by the manner in which the invention was made.”

¹¹⁷ As pointed out by the Federal Circuit, “[t]he term ‘claims’ has been used in patent legislation since the Patent Act of 1836 to define the invention that an applicant believes is patentable.” Hoechst-Roussel Pharms., Inc. v. Lehman, 109 F.3d 756, 758 (Fed. Cir. 1997) (citing Act of July 4, 1836, ch. 357, § 6, 5 Stat. 117). Furthermore, in Graham v. John Deere, 383 U.S. 1 (1966), the second of the Supreme Court’s factual inquiries (the “Graham factors”) is that the “differences between the prior art and the claims at issue are to be ascertained.” Graham, 383 U.S. at 17. Thus, in interpreting 35 U.S.C. 103 as enacted in the 1952 Patent Act – language that remained unchanged until enactment of the AIA – the Court equated “the subject matter sought to be patented” with the claims.

¹¹⁸ As stated in MPEP § 706.02(n), in view of the Federal Circuit’s decisions in In re Ochiai, 71 F.3d 1565 (Fed. Cir. 1995) and In re Brouwer, 77 F.3d 422 (Fed. Cir. 1996), the need to invoke pre-AIA 35 U.S.C. 103(b) rarely arose. Those cases continue to retain their validity under the AIA.

¹¹⁹ See Hazeltine Res., Inc. v. Brenner, 382 U.S. 252, 256 (1965) (a previously filed patent application to another pending in the Office, but not patented or published, at the time an application is filed constitutes part of the “prior art” within the meaning of 35 U.S.C. 103).

¹²⁰ This is in accordance with pre-AIA case law indicating that in making determinations under 35 U.S.C. 103, “it must be known whether a patent or publication is in the prior art under 35 U.S.C. 102.” Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1568 (Fed. Cir. 1987). However, while a disclosure must enable those skilled in the art to make the invention in order to anticipate under 35 U.S.C. 102, a non-enabling disclosure is prior art for all it teaches for purposes of determining obviousness under 35 U.S.C. 103. Symbol Techs. Inc. v. Opticon Inc., 935 F.2d 1569, 1578 (Fed. Cir. 1991); Beckman Instruments v. LKB Produkter AB, 892 F.2d 1547, 1551 (Fed. Cir. 1989) (“Even if a reference discloses an inoperative device, it is prior art for all that it teaches.”).

¹²¹ See MPEP § 706.07(a).

¹²² 35 U.S.C. 132(a) provides that “[n]o amendment shall introduce new matter into the disclosure of the invention.”

¹²³ The MPEP set forth the following process for treating amendments that are believed to contain new matter: (1) a new drawing should not be entered if the examiner discovers that the drawing contains new matter (MPEP § 608.02); and (2) amendments to the written description or claims involving new matter are

ordinarily entered, but the new matter is required to be canceled from the written description and the claims directed to the new matter are rejected under 35 U.S.C. 112(a) (MPEP § 608.04). This process for treating amendments containing new matter is purely an administrative process for handling an amendment seeking to introduce new matter into the disclosure of the invention in violation of 35 U.S.C. 132(a), and for resolving disputes between the applicant and an examiner as to whether a new drawing or amendment to the written description or claims would actually introduce new matter into the disclosure of the invention.