First Inventor to File (FITF) Comprehensive Training

Prior Art Under the AIA

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LINGDI 1016

Topics for Discussion

- Introduction to prior art and effective filing date
- 35 U.S.C. 102(a)(1) and its exceptions
- 35 U.S.C. 102(a)(2) and its exceptions
- Declarations under 37 CFR 1.130
- Obviousness rejections under 35 U.S.C. 103

Prior Art Under the AIA in General

- Just as under pre-AIA law, AIA § 102 begins with the phrase "[a] person shall be entitled to a patent unless . . . ."

- This phrase in AIA § 102 maintains the principle that the Office bears the burden of explanation if it refuses to grant the patent.

Prior Art Identified in 35 U.S.C. 102(a)(1) and 102(a)(2)

Only two subsections of the AIA identify prior art:

- **102(a)(1)** for a prior public disclosure, regardless of how the disclosure was made, as of the date it was publicly accessible

  and

- **102(a)(2)** for a U.S. patent, U.S. patent application publication (PGPub), or WIPO published PCT (international) application, as of the date its subject matter was effectively filed.

The availability of a disclosure as prior art under 102(a)(1) or 102(a)(2) depends upon the effective filing date of the claimed invention.

Foreign Priority Claims and the Effective Filing Date (EFD)

- Unlike pre-AIA law, the AIA provides that a foreign priority date can be the effective filing date of a claimed invention.

- **The foreign priority date is the effective filing date of the claimed invention IF**
  - the foreign application supports the claimed invention under 112(a), AND
  - the applicant has perfected the right of priority by providing
    - a certified copy of the priority application, and
    - a translation of the priority application (if not in English).

Determining the Effective Filing Date (EFD) Requires a Claim-by-Claim Analysis

- Just as under pre-AIA law, determining the effective filing date of the claimed invention is a claim-by-claim analysis.

- Different claims in the same application may have different effective filing dates.

Topics for Discussion

- Introduction to prior art and effective filing date
- 35 U.S.C. 102(a)(1) and its exceptions
- 35 U.S.C. 102(a)(2) and its exceptions
- Declarations under 37 CFR 1.130
- Obviousness rejections under 35 U.S.C. 103

AIA Statutory Framework

Prior Art 35 U.S.C. 102(a) (Basis for Rejection)	Exceptions 35 U.S.C. 102(b) (Not Basis for Rejection)	
102(a)(1) Disclosure with Prior Public Availability Date	**102(b)(1)**	**(A)** Grace Period Disclosure by Inventor or Obtained from Inventor
		(B) Grace Period Intervening Disclosure by Third Party
102(a)(2) U.S. Patent, **Published** U.S. Patent Application, and **Published** PCT Application with Prior Filing Date	**102(b)(2)**	**(A)** Disclosure Obtained from Inventor
		(B) Intervening Disclosure by Third Party
		(C) Commonly Owned Disclosures

35 U.S.C. 102(a)(1)

§ 102. Conditions for patentability; novelty

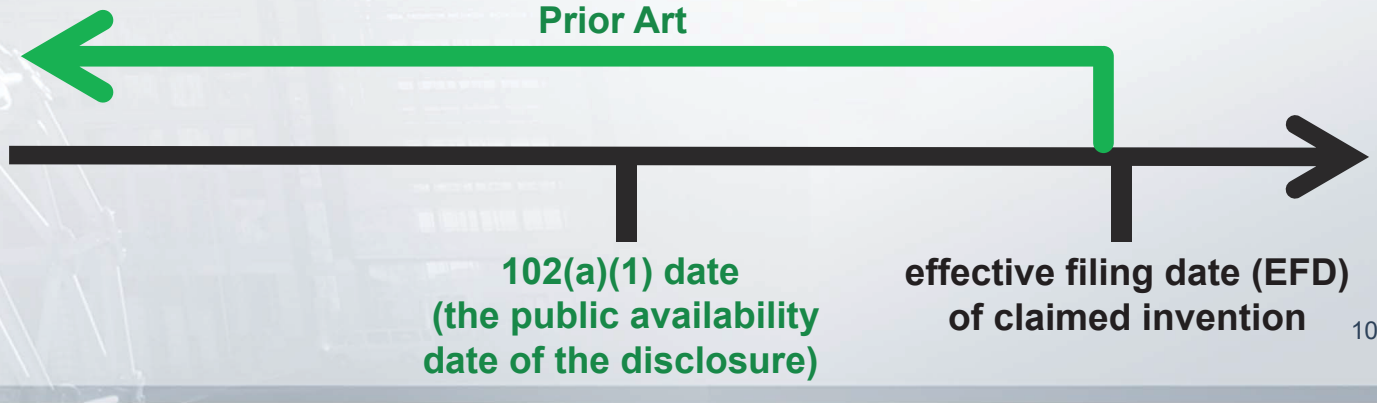
(a) NOVELTY; PRIOR ART.—A person shall be entitled to a patent unless—

(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

35 U.S.C. 102(a)(1): Disclosures Having a Prior Public Availability Date

102(a)(1) precludes a patent if a claimed invention was, before the effective filing date of the claimed invention:

- patented;
- described in a printed publication;
- in public use;
- on sale; or
- otherwise available to the public.



35 U.S.C. 102(a)(1): "Patented"

"Patented" under 102(a)(1) refers to:

- an issued U.S. patent
- an issued foreign patent in any language

This is <u>not</u> a change from pre-AIA law.
See MPEP 2126.

35 U.S.C. 102(a)(1): "Described in a Printed Publication"

"Printed publication" under 102(a)(1) may include:

- U.S. patent application publications and WIPO published PCT (international) applications
- foreign patent documents (patents and published applications)
- journal articles, technical manuals, magazines, newspapers, and books
- poster presentations and handouts at scientific meetings
- advertising
- material posted on Internet Web sites

This is <u>not</u> a change from pre-AIA law. See MPEP 2128.

35 U.S.C. 102(a)(1): "Described in a Printed Publication" (cont.)

Important facts about a "printed publication" under 102(a)(1):

- A printed publication is prior art as of the date that it is publicly accessible.
- The printed publication may be in any language.

This is <u>not</u> a change from pre-AIA law. See MPEP 2128.

35 U.S.C. 102(a)(1): "In Public Use" and "On Sale"

	uses		sales	
	pre-AIA	AIA	pre-AIA	AIA
1. Must the use or sale have been "public"?*	yes	yes	no	yes
2. Must the use or sale itself have enabled someone to make and use the claimed invention under 35 U.S.C. 112?	no	no	no	no
3, May the use or sale have occurred outside the United States?	no	yes	no	yes
4. May the use or sale be evidenced by a document that itself does not have a sufficiently early publication date to qualify as prior art?	yes	yes	yes	yes

*Note that some pre-AIA case law may no longer apply under the AIA; see the Examination Guidelines at 78 Fed. Reg. 11059, 11062.

35 U.S.C. 102(a)(1): "Otherwise Available to the Public"

"Otherwise available to the public" is a new catch-all provision of 102(a)(1) that has no counterpart in pre-AIA law. For example:

- an oral presentation at a scientific meeting
- a demonstration at a trade show
- a lecture or speech
- a statement made on a radio talk show
- a YouTube video, Web site, or other on-line material (this type of disclosure may also qualify as a printed publication under AIA and pre-AIA law)

Exceptions to Prior Art under 35 U.S.C. 102(a)(1)

- Even though a disclosure of subject matter falls within the scope of 102(a)(1), it may not be used in a prior art rejection if one of the exceptions stated in 102(b)(1) applies.

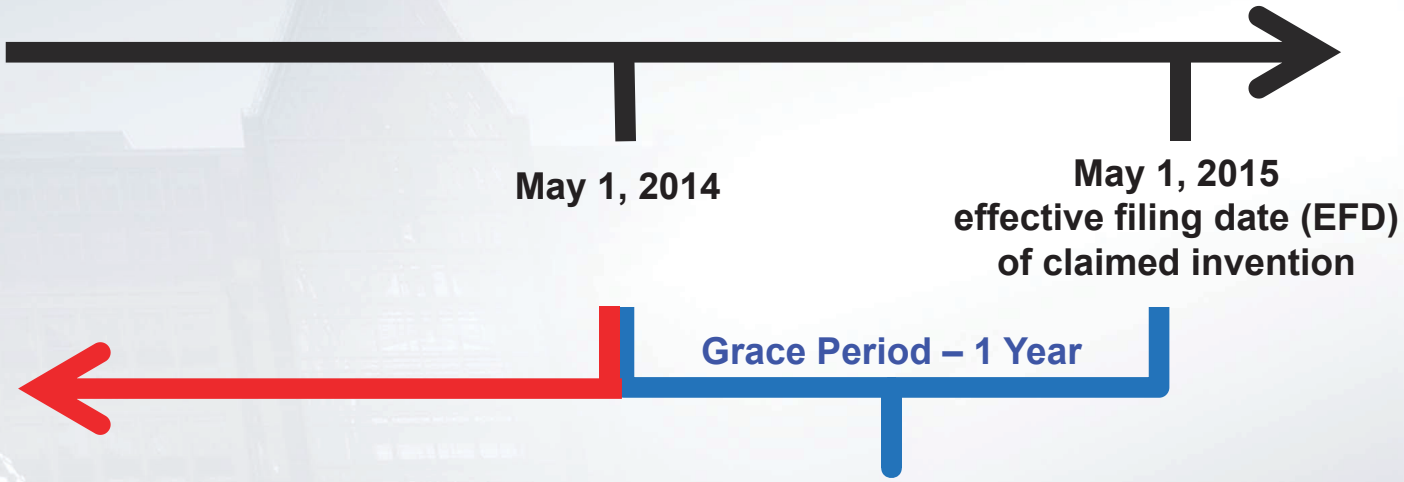
- The two exceptions are stated in 102(b)(1)(A) and 102(b)(1)(B), and involve potential prior art disclosures made within the grace period, which is the one-year period preceding the effective filing date of the claimed invention.

REMEMBER: The 102(b)(1) exceptions apply to 102(a)(1) prior art!

AIA Statutory Framework

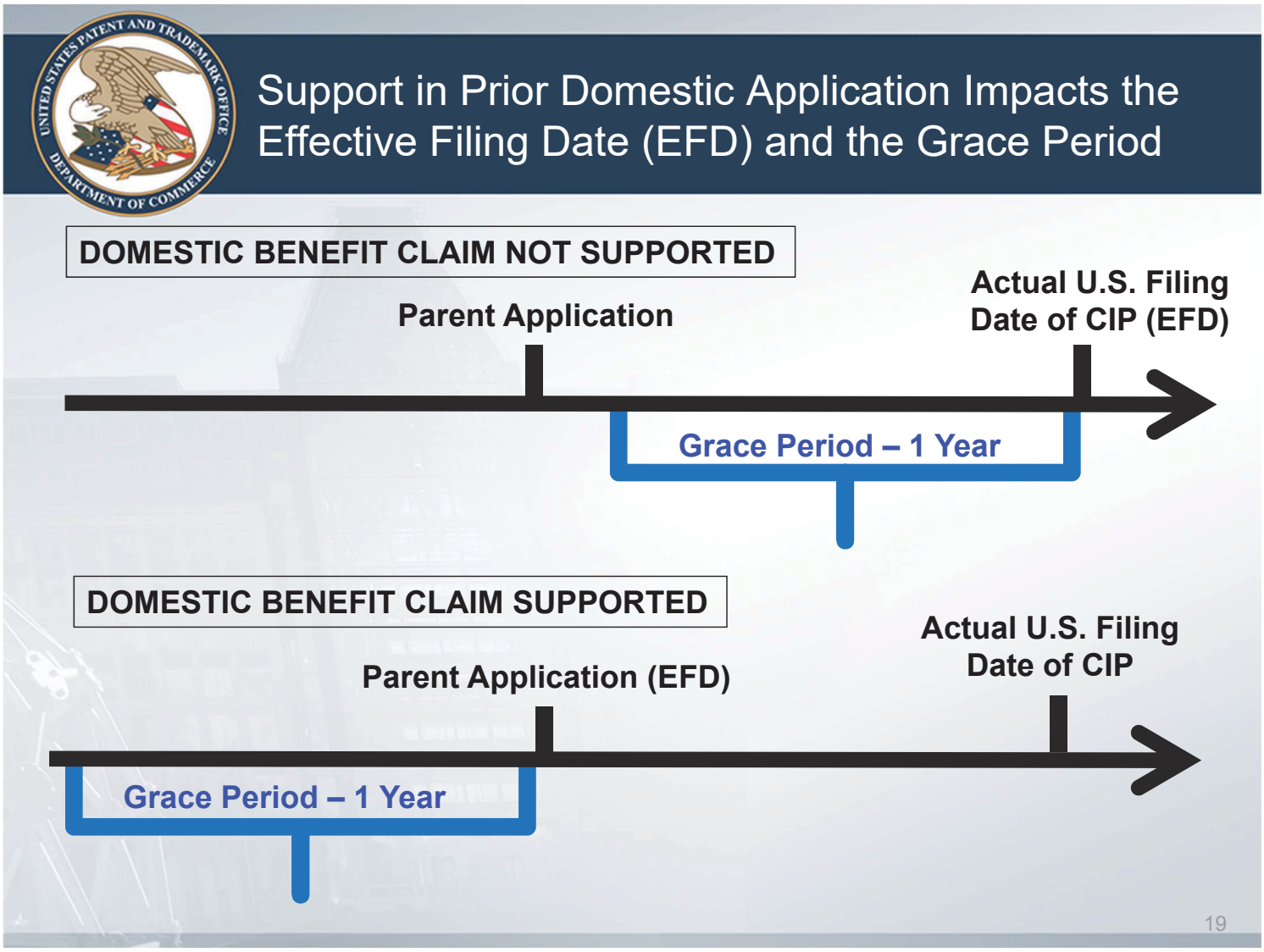
Prior Art 35 U.S.C. 102(a) (Basis for Rejection)	Exceptions 35 U.S.C. 102(b) (Not Basis for Rejection)	
102(a)(1) Disclosure with Prior Public Availability Date	**102(b)(1)**	**(A)** Grace Period Disclosure by Inventor or Obtained from Inventor
		(B) Grace Period Intervening Disclosure by Third Party
102(a)(2) U.S. Patent, **Published** U.S. Patent Application, and **Published** PCT Application with Prior Filing Date	**102(b)(2)**	**(A)** Disclosure Obtained from Inventor
		(B) Intervening Disclosure by Third Party
		(C) Commonly Owned Disclosures

No Exceptions for 102(a)(1) Disclosures Made Before the Grace Period



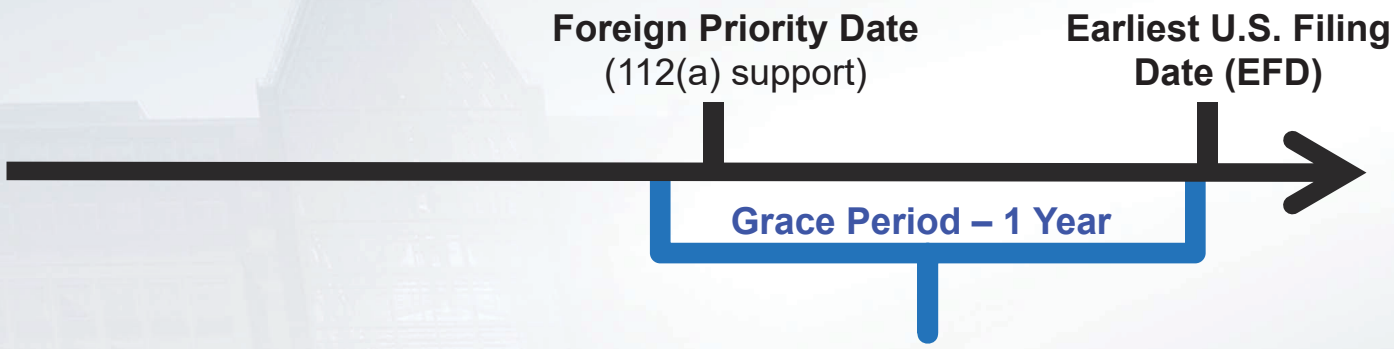
NO EXCEPTIONS for disclosures made **before** May 1, 2014 (best prior art dates)

POSSIBLE EXCEPTIONS under 102(b)(1)(A) & 102(b)(1)(B) for disclosures made **on or after** May 1, 2014 but before May 1, 2015

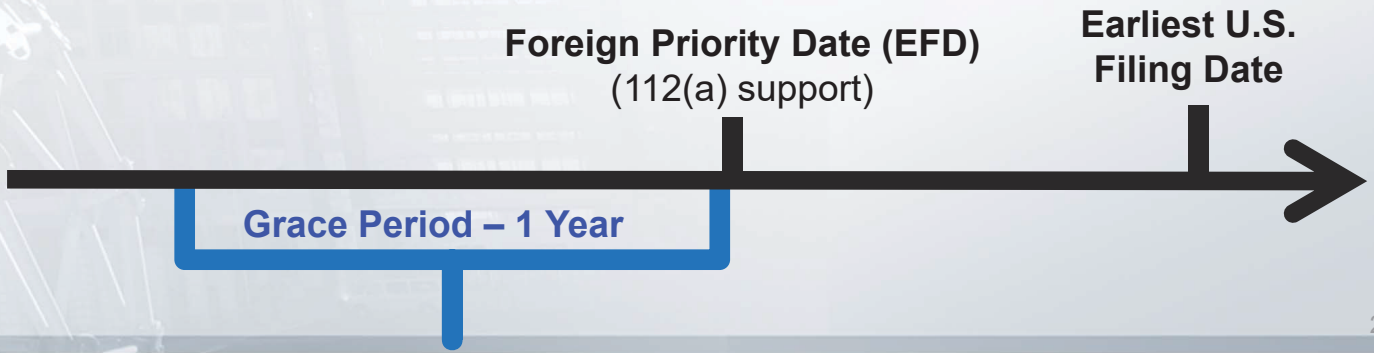

Support in Prior Domestic Application Impacts the Effective Filing Date (EFD) and the Grace Period
DOMESTIC BENEFIT CLAIM NOT SUPPORTED
Parent Application
Actual U.S. Filing Date of CIP (EFD)
Grace Period – 1 Year
DOMESTIC BENEFIT CLAIM SUPPORTED
Parent Application (EFD)
Actual U.S. Filing Date of CIP
Grace Period – 1 Year
19

Support and Perfecting Foreign Priority Both Impact the Effective Filing Date (EFD) and the Grace Period

FOREIGN PRIORITY CLAIM NOT PERFECTED



FOREIGN PRIORITY CLAIM PERFECTED



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Foreign Priority and Possible Grace Period Exceptions to 102(a)(1) Prior Art

Foreign priority and time intervals to consider for the 102(a)(1) reference date:

- more than one year before the foreign priority date claimed
- one year or less before the foreign priority date claimed
- on or after the foreign priority date claimed and before the earliest U.S. filing date (intervening reference)

Foreign Priority Situations: 102(a)(1) Reference Date > 1 Year Before the Foreign Priority Date Claimed

- A 102(a)(1) disclosure made more than one year before the claimed foreign priority date (before the earliest possible effective filing date) has <u>the best prior art date</u> to apply in a rejection.

- A rejection based upon such a reference CANNOT be overcome by perfecting the foreign priority claim and/or invoking an exception under 102(b)(1).

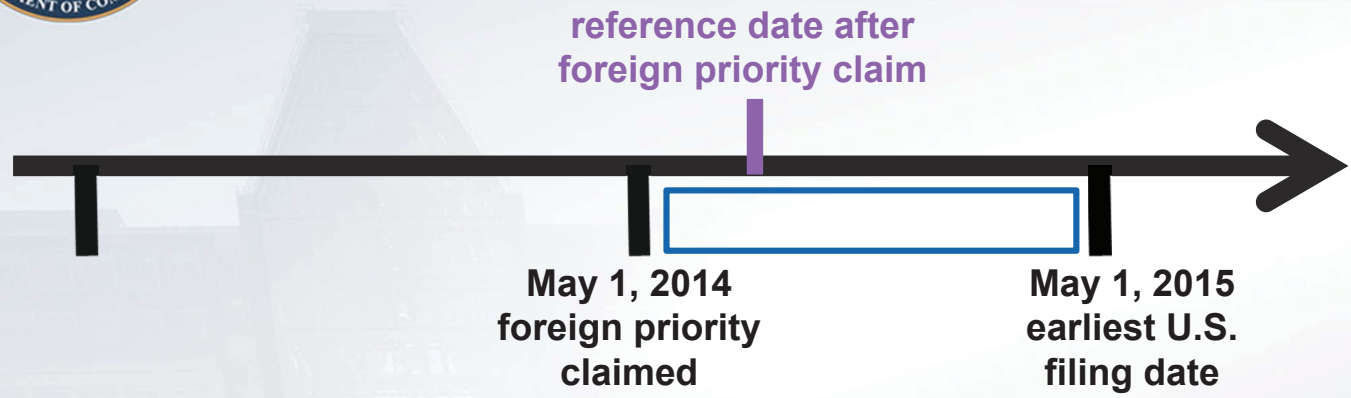
Foreign Priority Situations: 102(a)(1) Reference Date < 1 Year Before the Foreign Priority Date Claimed

A 102(a)(1) disclosure made one year or less before the claimed foreign priority date (the earliest possible effective filing date) has <u>the second best prior art date</u> to apply in a rejection.

To overcome a proper rejection based on such a reference without amending the claims, the applicant could:

(1) perfect the foreign priority claim <u>AND ALSO</u>
(2) invoke an exception under 102(b)(1).

Foreign Priority Situations: 102(a)(1) Reference Date After the Foreign Priority Date Claimed

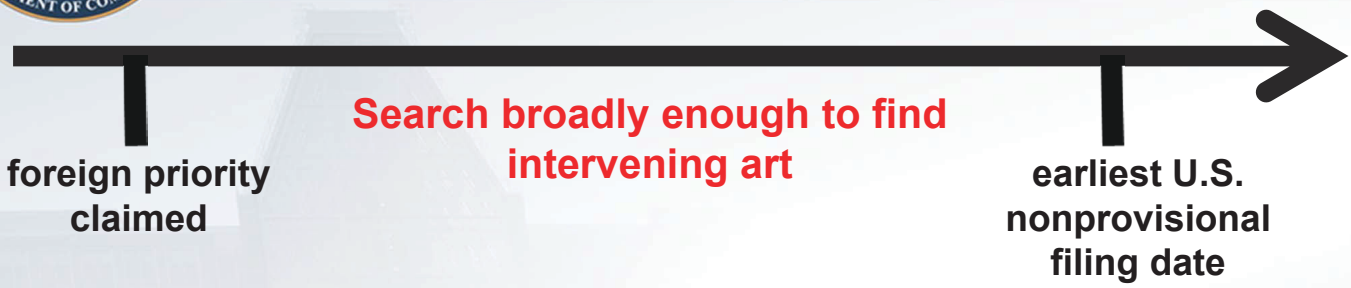


A 102(a)(1) disclosure made before the U.S. filing date but after the claimed foreign priority date has <u>the third best prior art date</u> to apply in a rejection.

To overcome a proper rejection based on such a reference without amending the claims, the applicant could EITHER:

(1) perfect the foreign priority claim <u>OR</u>
(2) invoke an exception under 102(b)(1).

Foreign Priority and Scope of Search



- Search to find all relevant art.
- If intervening art is the best art to use in a rejection, the examiner must make and maintain a rejection over such art unless
  - the applicant has perfected the foreign priority claim <u>and</u>
  - the foreign application supports the claimed invention

  or the applicant has otherwise overcome the rejection.

35 U.S.C. 102(b)(1)(A) Exception to 102(a)(1) Prior Art: Inventor-Originated Disclosures

(b) EXCEPTIONS.—

(1) DISCLOSURES MADE 1 YEAR OR LESS BEFORE THE EFFECTIVE FILING DATE OF THE CLAIMED INVENTION.—A disclosure made 1 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—

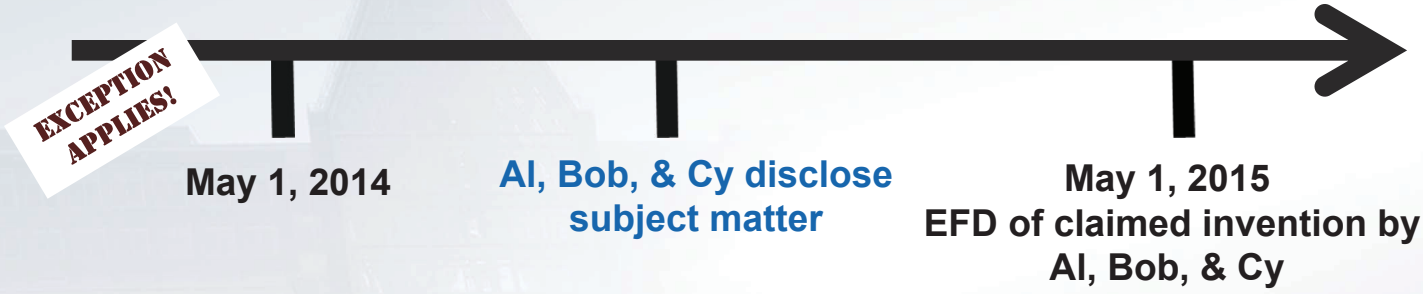
(A) the disclosure was made by the inventor or joint inventor or by another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor

35 U.S.C. 102(b)(1)(A) Exception to 102(a)(1): Inventor-Originated Disclosure During Grace Period

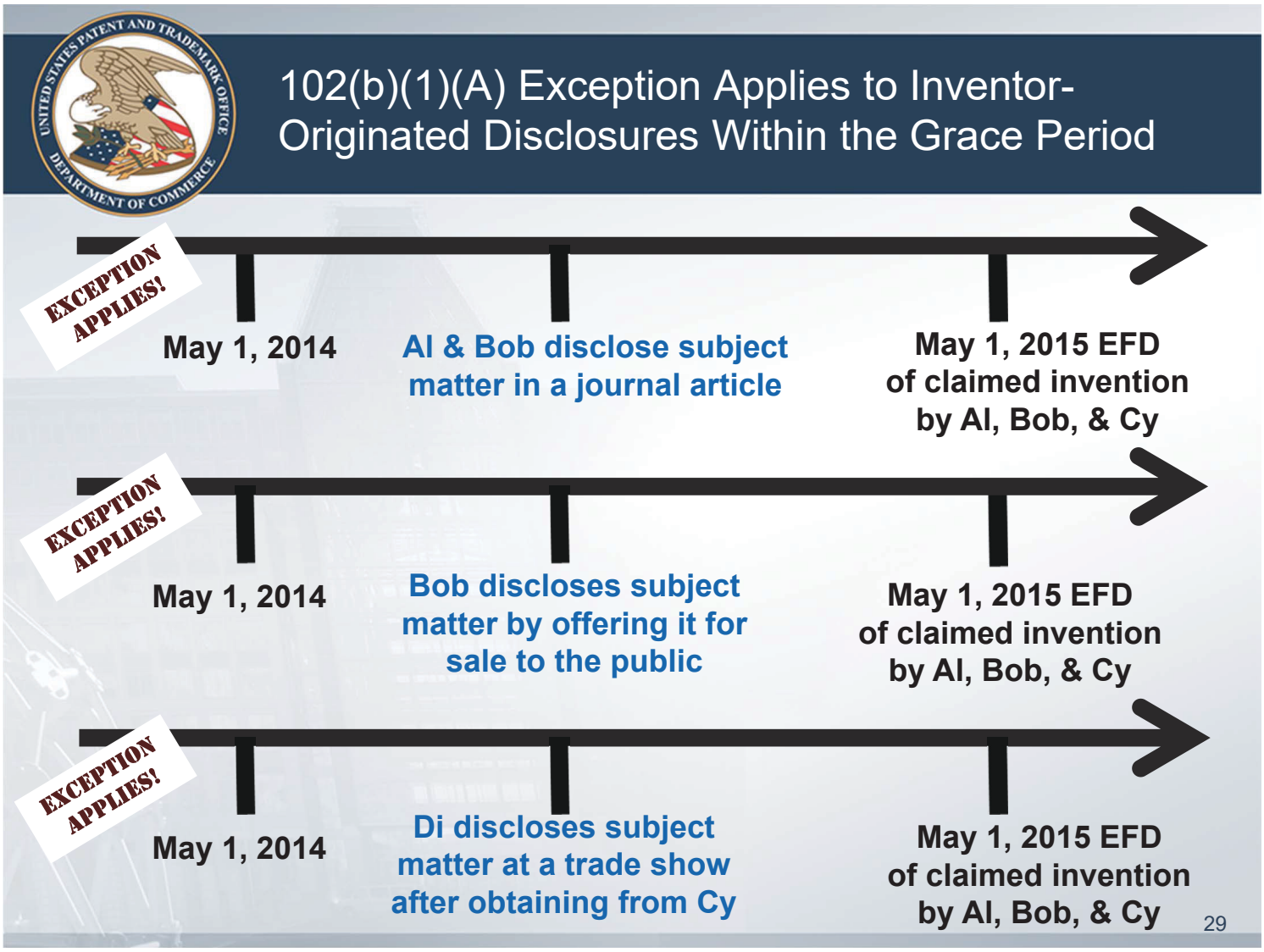
For this exception to apply to a disclosure, the disclosure must be:

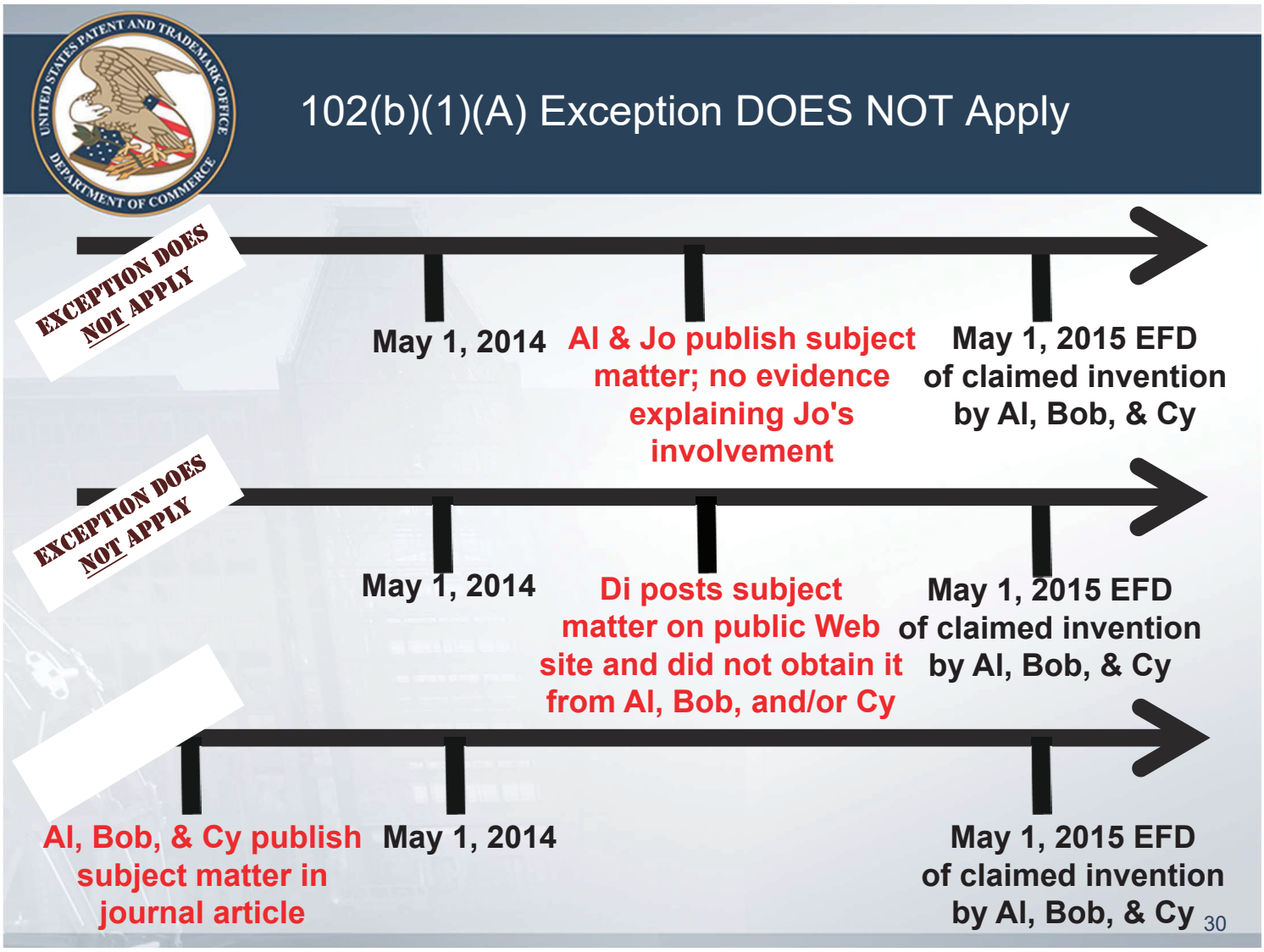
- within the grace period and
- an "inventor-originated disclosure" that is made by
  - the inventive entity ("the inventor"),
  - one or more joint inventors, or
  - "another" who obtained the disclosed subject matter from the inventor or a joint inventor either directly or indirectly.

102(b)(1)(A) Exception Applies to a Grace Period Disclosure by the Inventor



Even though the disclosure of Al, Bob, and Cy meets the requirements of 102(a)(1), it is <u>not prior art</u> to the claimed invention because the 102(b)(1)(A) exception applies.


102(b)(1)(A) Exception Applies to Inventor-Originated Disclosures Within the Grace Period
EXCEPTION APPLIES!
May 1, 2014
Al & Bob disclose subject matter in a journal article
May 1, 2015 EFD of claimed invention by Al, Bob, & Cy
EXCEPTION APPLIES!
May 1, 2014
Bob discloses subject matter by offering it for sale to the public
May 1, 2015 EFD of claimed invention by Al, Bob, & Cy
EXCEPTION APPLIES!
May 1, 2014
Di discloses subject matter at a trade show after obtaining from Cy
May 1, 2015 EFD of claimed invention by Al, Bob, & Cy
29


102(b)(1)(A) Exception DOES NOT Apply
EXCEPTION DOES NOT APPLY
May 1, 2014
Al & Jo publish subject matter; no evidence explaining Jo's involvement
May 1, 2015 EFD of claimed invention by Al, Bob, & Cy
EXCEPTION DOES NOT APPLY
May 1, 2014
Di posts subject matter on public Web site and did not obtain it from Al, Bob, and/or Cy
May 1, 2015 EFD of claimed invention by Al, Bob, & Cy
Al, Bob, & Cy publish subject matter in journal article
May 1, 2014
May 1, 2015 EFD of claimed invention by Al, Bob, & Cy
30

35 U.S.C. 102(b)(1)(B) Exception to 102(a)(1) Prior Art

(b) EXCEPTIONS.—

(1) DISCLOSURES MADE 1 YEAR OR LESS BEFORE THE EFFECTIVE FILING DATE OF THE CLAIMED INVENTION.—A disclosure made 1 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—

. . . .

(B) 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.

35 U.S.C. 102(b)(1)(B) Exception to 102(a)(1) Prior Art: Inventor-Originated Disclosure Prior to Third Party Disclosure

For this exception to apply to a third party's disclosure of subject matter X:

- the third party's disclosure must have been made during the claimed invention's grace period,
- an inventor-originated disclosure must have been made prior to the third party's disclosure, and
- both must have disclosed subject matter X.

Disclosures by Others: Important Distinction Between "Another" and "Third Party" in the Exceptions

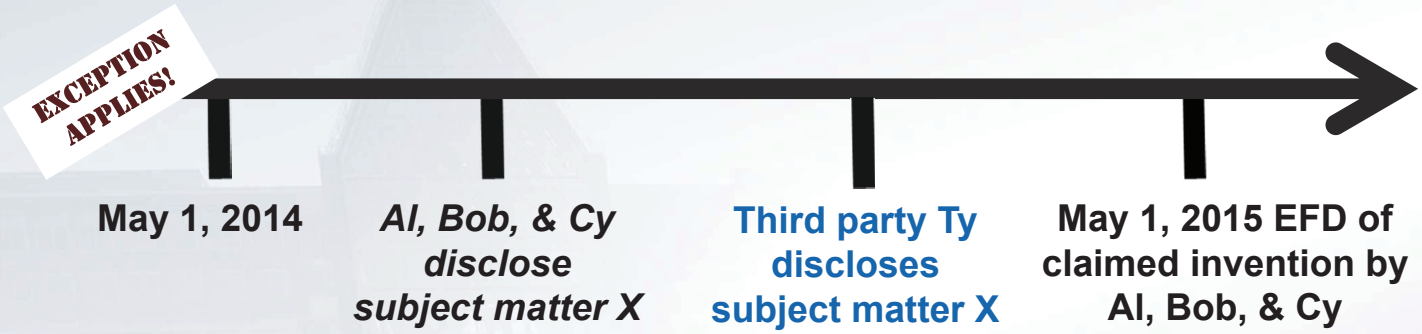
"another"

someone who disclosed subject matter that was obtained directly or indirectly from one or more members of the inventive entity

"third party" (applies to 102(b)(1)(B) and 102(b)(2)(B))

someone who disclosed subject matter but did **not** obtain it, directly or indirectly, from a member of the inventive entity

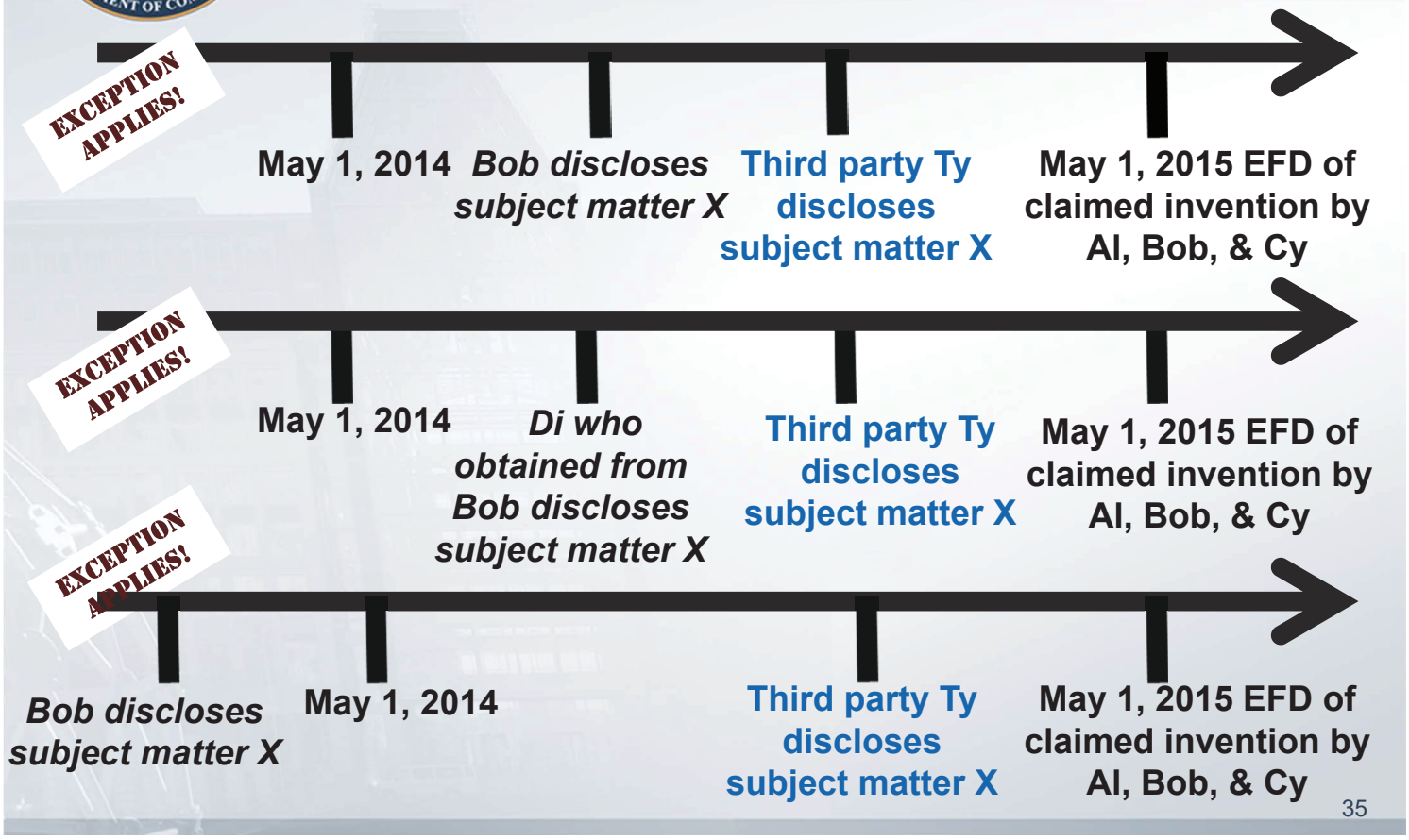
35 U.S.C. 102(b)(1)(B) Exception to 102(a)(1) Prior Art: Inventor-Originated Disclosure Prior to Third Party Disclosure



Even though the disclosure of Ty meets the requirements of 102(a)(1), it is <u>not prior art</u> to the claimed invention because the 102(b)(1)(B) exception applies.

Note: The disclosure of Al, Bob, and Cy is also not prior art because a different exception – 102(b)(1)(A) – applies.

35 U.S.C. 102(b)(1)(B) Exception to 102(a)(1) Prior Art: Inventor-Originated Disclosure Prior to Third Party Disclosure (cont.)



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"Shielding" the Claimed Invention from Potential Prior Art under 102(b)(1)(B)

Inventor-originated prior public disclosure

When the 102(b)(1)(B) exception applies, the inventor's prior public disclosure of subject matter X acts to "shield" the claimed invention from a prior art rejection based on the third party's intervening disclosure of subject matter X.

Mode of Disclosure of the "Subject Matter" under 102(b)(1)(B)

Although the same "subject matter" must be disclosed, there is no requirement:

- that the inventor-originated disclosure and the third party's intervening disclosure be made in the same manner; or
- that the two disclosures be made using identical words, figures, tables, or other forms of expression.

"The Subject Matter Disclosed" under 102(b)(1)(B)

OBVIOUS ≠ SAME SUBJECT MATTER

Even if an intervening disclosure by a third party is obvious over an inventor-originated prior public disclosure, this is **not** a disclosure of the same subject matter and the 102(b)(1)(B) exception does not apply.

102(b)(1)(B) "Shielding" Only Eliminates "the Same Subject Matter" as Prior Art under 102(a)(1)

IMPORTANT!

- Only that portion of the third party's intervening disclosure that was previously in an inventor-originated disclosure (i.e., "the same subject matter") is unavailable as prior art when the 102(b)(1)(B) exception applies.

- Any portion of the third party's intervening disclosure that was not part of the previous inventor-originated disclosure is still available for use in a prior art rejection. In other words, the claimed invention is not shielded from that portion of the third party's disclosure.

Does the Inventor-Originated Disclosure Shield the Claimed Invention from the Third Party's Intervening Disclosure under 102(b)(1)(B)?

When considering whether a shield applies, the examiner should ask:

> What subject matter of the third party's intervening disclosure is found in a previous inventor-originated public disclosure?

IMPORTANT: For the purpose of applying the exception, it is not proper to compare either the inventor's prior disclosure or the third party's intervening disclosure to the claimed invention.

Does the Inventor's Disclosure Shield the Claimed Invention from the Third Party's Intervening Disclosure under 102(b)(1)(B)?

inventor's prior public disclosure	third party's intervening disclosure	Does the inventor's prior public disclosure act as a shield?
X (e.g., a flat-head screw)	General category that includes X (e.g., a screw)	Yes. Rejection cannot be based on third party's disclosure of a general category that includes X.
X (e.g., a flat-head screw)	List of species that includes X (e.g., flat-head screw, Phillips head screw, and hex head screw)	Partially. Rejection can be based on third party's disclosure of other species, but not on the disclosure of X.
General category (e.g., screws)	A species within the general category (e.g., flat-head screw)	No. Rejection can be based on third party's disclosure of the species.

Does the Inventor's Disclosure Shield the Claimed Invention from the Third Party's Intervening Disclosure under 102(b)(1)(B)?

inventor's prior public disclosure	third party's intervening disclosure	Does the inventor's prior public disclosure act as a shield?
X (e.g., methyl)	General category (e.g., alkyl)	Yes. Rejection cannot be based on third party's disclosure of a general category that includes X.
X (e.g., methyl)	List of species that includes X (e.g., methyl, ethyl, and propyl)	Partially. Rejection can be based on third party's disclosure of other species, but not on the disclosure of X.
General category (e.g., alkyl)	Species X (e.g., methyl) within the general category	No. Rejection can be based on third party's disclosure of the species.

Topics for Discussion

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AIA Statutory Framework

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		(B) Grace Period Intervening Disclosure by Third Party
102(a)(2) U.S. Patent, **Published** U.S. Patent Application, and **Published** PCT Application with Prior Filing Date	**102(b)(2)**	**(A)** Disclosure Obtained from Inventor
		(B) Intervening Disclosure by Third Party
		(C) Commonly Owned Disclosures

35 U.S.C. 102(a)(2)

§ 102. Conditions for patentability; novelty

(a) NOVELTY; PRIOR ART.—A person shall be entitled to a patent unless—

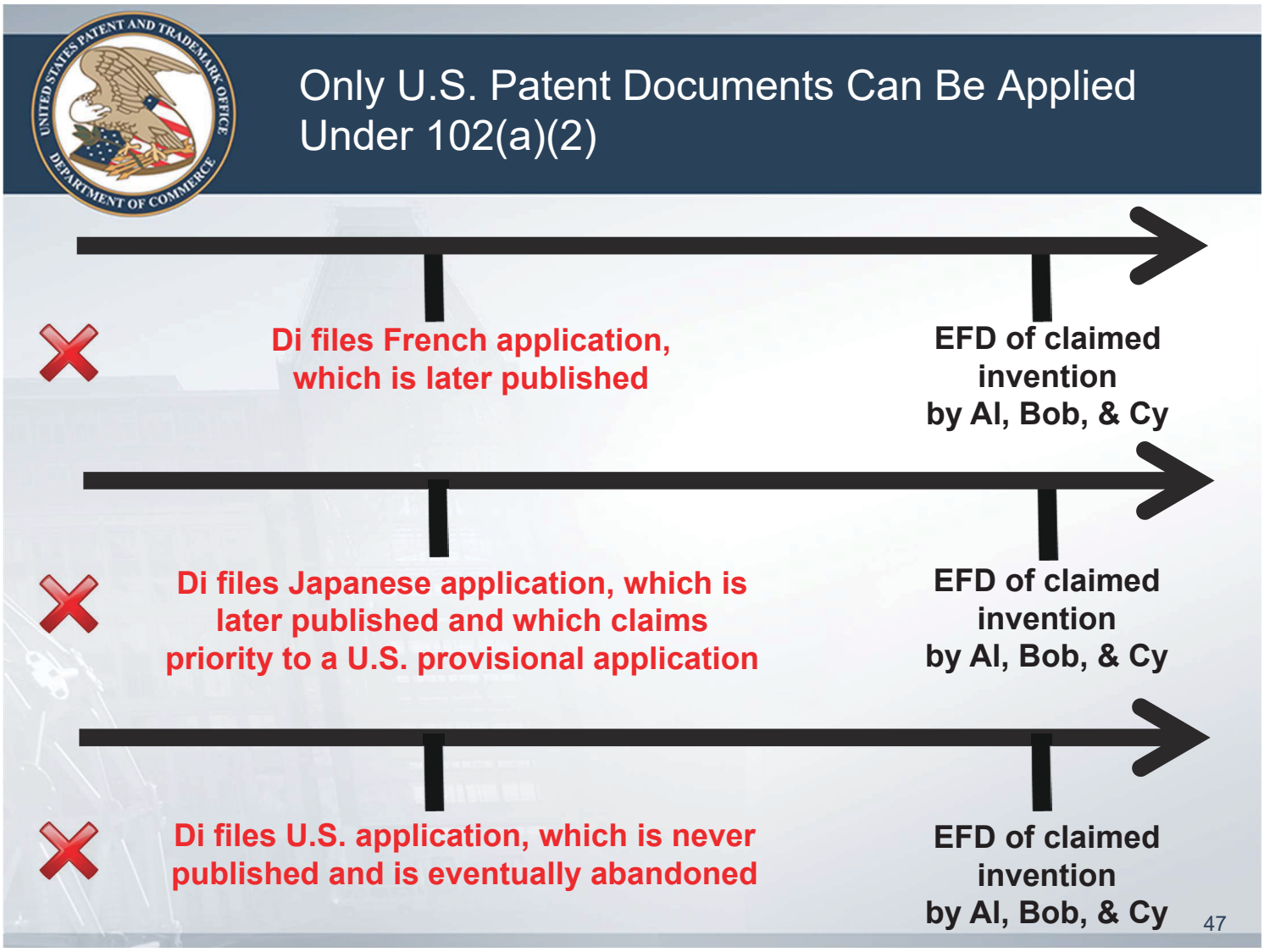
. . . .

(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.

35 U.S.C. 102(a)(2): U.S. Patent Documents and the Statutory Language

document type	statutory language
U.S. patent	"a patent issued under section 151"
U.S. patent application publication (PGPub)	"application for patent" that is "published . . . under section 122(b)"
WIPO published PCT (international) applications that designate the United States	"application for patent" that is "deemed published under section 122(b)" (see 35 U.S.C. 374)

CAUTION: Foreign patent documents (for example, JP or GB patents or published applications) **cannot** be prior art as of their filing date under 102(a)(2). However, they may be printed publication prior art under 102(a)(1).


Only U.S. Patent Documents Can Be Applied Under 102(a)(2)
Di files French application, which is later published
EFD of claimed invention by Al, Bob, & Cy
Di files Japanese application, which is later published and which claims priority to a U.S. provisional application
EFD of claimed invention by Al, Bob, & Cy
Di files U.S. application, which is never published and is eventually abandoned
EFD of claimed invention by Al, Bob, & Cy
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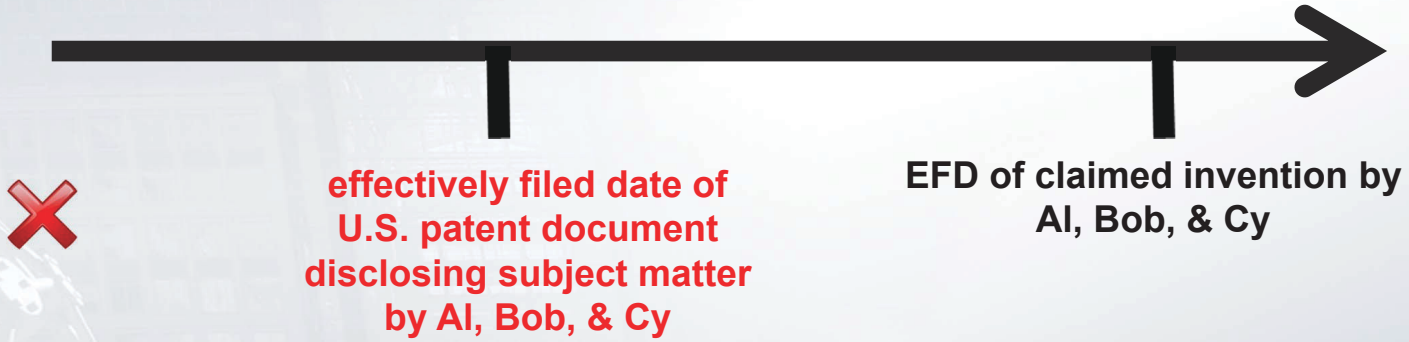
35 U.S.C. 102(a)(2): Important Points about WIPO Published PCT (International) Applications

- A WIPO published PCT application must have designated the United States in order to be 102(a)(2) prior art. PCT applications filed on or after January 1, 2004 automatically designate the United States.

- There is no requirement that the WIPO published PCT application have been filed on or after November 29, 2000, or have been published in English. This is a distinction from pre-AIA 102(e).

35 U.S.C 102(a)(2) Documents Must Name "Another Inventor"

Under 102(a)(2), a disclosure in a U.S. patent document, including a WIPO published PCT (international) application, is <u>not prior art</u> unless the document names "another inventor" (i.e., a different inventive entity).



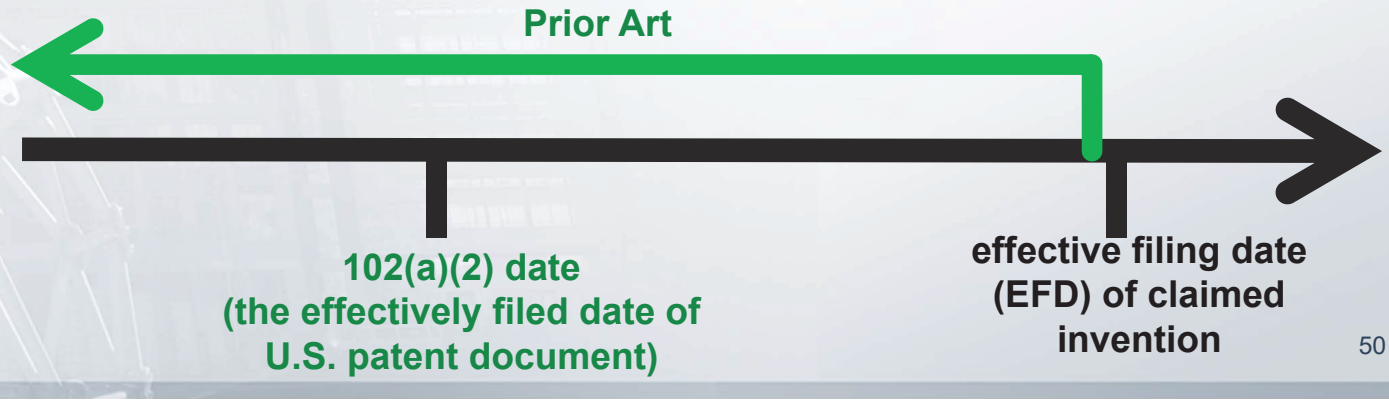
Because both inventive entities are the same in this illustration, the U.S. patent document <u>cannot</u> be prior art under 102(a)(2).

102(a)(2) References Must Have an Effectively Filed Date Before the EFD of the Claimed Invention

102(a)(2) precludes a patent if, before the effective filing date of a claimed invention, the claimed invention was described in a:

- U.S. Patent;
- U.S. Patent Application Publication; or
- WIPO published PCT (international) application that designated the United States,

that names a different inventive entity and was effectively filed before the effective filing date of the claimed invention.



35 U.S.C. 102(d) Explains "Effectively Filed Date" for 102(a)(2) Prior Art

§ 102. Conditions for patentability; novelty

(d) PATENTS AND PUBLISHED APPLICATIONS EFFECTIVE AS PRIOR ART.—For purposes of determining whether a patent or application for patent is prior art to a claimed invention under subsection (a)(2), such patent or application shall be considered described in the patent or application—

(1) if paragraph (2) does not apply, as of 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 a right of priority under section 119, 365(a), or 365(b), or to claim the benefit of an earlier filing date under section 120, 121, or 365(c), based upon 1 or more prior filed applications for patent, as of the filing date of the earliest such application that describes the subject matter.

35 U.S.C. 102(d) Explains "Effectively Filed Date" for U.S. Patent Documents under 102(a)(2)

A U.S. patent document may be applied as prior art as of its effectively filed date. The effectively filed date for 102(a)(2) references according to 102(d) is the earlier of:

- the actual filing date of the U.S. patent or the published application (U.S. or WIPO), or
- the filing date of the earliest application to which the U.S. patent or the published application (U.S. or WIPO) is entitled to claim a right of foreign priority or domestic benefit which describes the subject matter.

35 U.S.C 102(d) is NOT the basis for a prior art rejection.

Relying on the "Effectively Filed Date" of a Reference During Examination

- To rely on an effectively filed date that is earlier than the actual filing date of a potential 102(a)(2) reference:
  - the U.S. patent document must claim priority to or benefit of the prior foreign or domestic application AND
  - the prior (foreign or domestic) application must describe the subject matter being relied upon.
- Priority to a prior foreign application need NOT have been perfected to rely on the effectively filed date of a 102(a)(2) reference in a rejection.

Obtaining a Copy and/or Translation of a Foreign Priority Document

- When a potential 102(a)(2) reference that is a U.S. patent or U.S. PGPub of an application filed on or after March 16, 2013 claims priority to a foreign application, a certified or interim copy of the foreign application will usually be present in the image file wrapper (IFW) of the application.
- Consult STIC for a copy of the foreign application and a translation if:
  - there is no certified or interim copy of the foreign application in the IFW of the application, or
  - a translation is not available via the examiner's desktop tools.

Exceptions to Prior Art under 35 U.S.C. 102(a)(2)

- Even though a 102(a)(2) reference describes the claimed invention, the reference may not be used in a prior art rejection if one of the exceptions stated in 102(b)(2) applies.

- The three exceptions are stated in 102(b)(2)(A), 102(b)(2)(B), and 102(b)(2)(C). Unlike the 102(b)(1) exceptions that apply to 102(a)(1) disclosures, the 102(b)(2) exceptions do not involve the one-year grace period.

REMEMBER: The 102(b)(2) exceptions apply to 102(a)(2) prior art!

AIA Statutory Framework

Prior Art 35 U.S.C. 102(a) (Basis for Rejection)	Exceptions 35 U.S.C. 102(b) (Not Basis for Rejection)	
102(a)(1) Disclosure with Prior Public Availability Date	**102(b)(1)**	**(A)** Grace Period Disclosure by Inventor or Obtained from Inventor
		(B) Grace Period Intervening Disclosure by Third Party
102(a)(2) U.S. Patent, **Published** U.S. Patent Application, and **Published** PCT Application with Prior Filing Date	**102(b)(2)**	**(A)** Disclosure Obtained from Inventor
		(B) Intervening Disclosure by Third Party
		(C) Commonly Owned Disclosures

35 U.S.C. 102(b)(2)(A) Exception to 102(a)(2) Prior Art: Subject Matter Disclosed Was Obtained from Inventor

(b) EXCEPTIONS.—

. . . .

(2) DISCLOSURES APPEARING IN APPLICATIONS AND PATENTS.—A disclosure shall not be prior art to a claimed invention under subsection (a)(2) if—

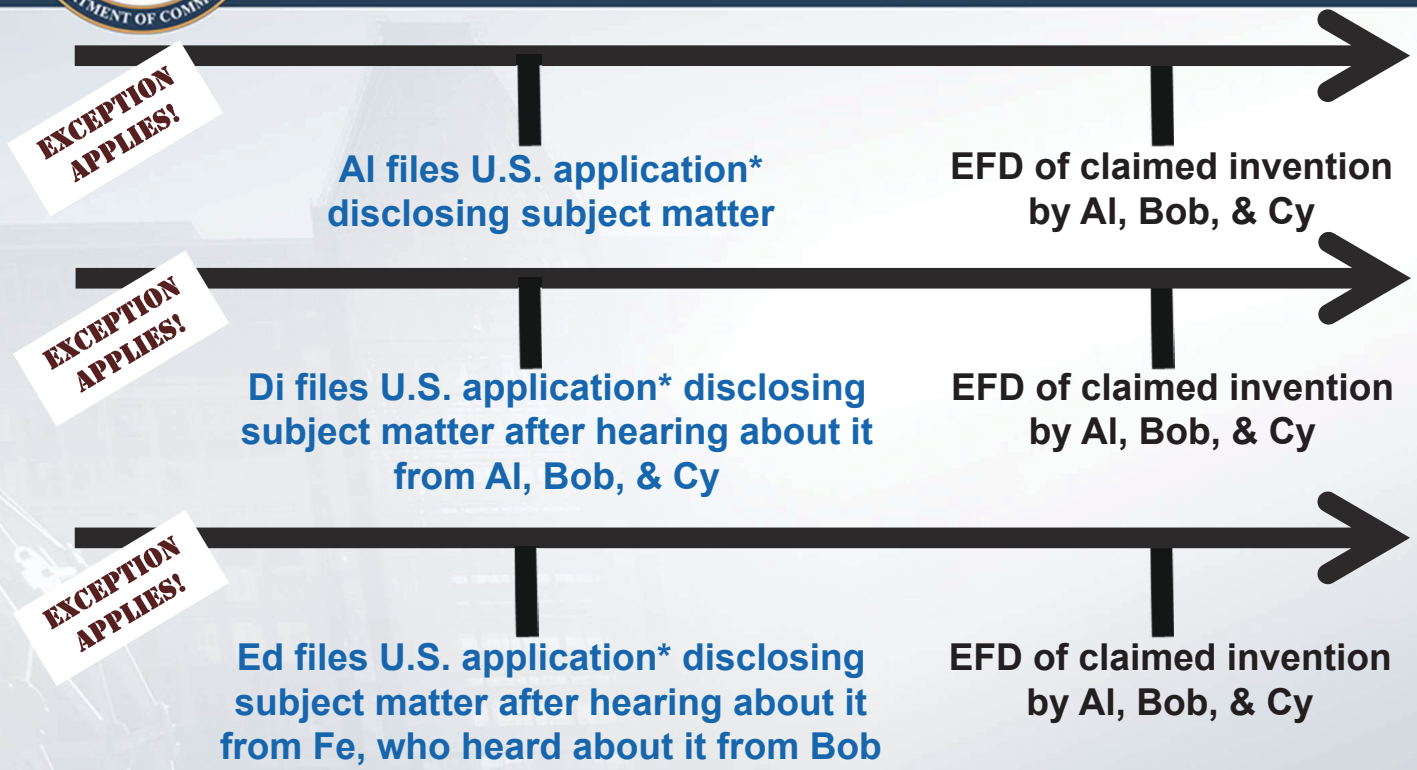
(A) the subject matter disclosed was obtained directly or indirectly from the inventor or a joint inventor

102(b)(2)(A) Exception to 102(a)(2) Prior Art

- Under the 102(b)(2)(A) exception, a 102(a)(2) reference is <u>not prior art</u> as of the effectively filed date if "the subject matter disclosed" was obtained from one or more members of the inventive entity, either directly or indirectly.

- This is similar to the exception in 102(b)(1)(A).

102(b)(2)(A) Exception Applies



*The U.S. application has been published.

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35 U.S.C. 102(b)(2)(B) Exception to 102(a)(2) Prior Art: Subject Matter In a Previous Inventor-Originated Disclosure

(2) DISCLOSURES APPEARING IN APPLICATIONS AND PATENTS.—A disclosure shall not be prior art to a claimed invention under subsection (a)(2) if—

. . . .

(B) 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

Applying the 102(b)(2)(B) Exception

For this exception to apply to a third party's U.S. patent document disclosing subject matter X:

- the third party's U.S. patent document must have been effectively filed before the effective filing date of the claimed invention,
- an inventor-originated disclosure must have been made prior to the third party's effectively filed date, and
- both must have disclosed subject matter X.

Applying the 102(b)(2)(B) Exception

Even though the application of Ty meets the requirements of 102(a)(2), it is <u>not prior art</u> to the claimed invention because the 102(b)(2)(B) exception applies.

The public disclosure of Al, Bob, and Cy may or may not be prior art; the 102(b)(1)(A) exception would apply to that disclosure if it were made within the grace period.

35 U.S.C. 102(b)(2)(C) Exception to 102(a)(2) Prior Art: Common Ownership

(2) DISCLOSURES APPEARING IN APPLICATIONS AND PATENTS.—A disclosure shall not be prior art to a claimed invention under subsection (a)(2) if—

. . . .

(C) 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.

IMPORTANT: The common ownership exception does <u>not</u> apply to public disclosures under 102(a)(1).

35 U.S.C. 102(b)(2)(C) Exception to 102(a)(2) Prior Art: Common Ownership (cont.)

For the 102(b)(2)(C) exception to apply, the subject matter of the potential 102(a)(2) reference and the claimed invention in the application under examination must have been:

- owned by the same person,
- subject to an obligation of assignment to the same person, <u>or</u>
- deemed to have been owned by or subject to an obligation of assignment to the same person

not later than the effective filing date of the claimed invention.

If this exception applies, a U.S. patent document cannot be used as 102(a)(2) prior art as of its effectively filed date, but it may still be used as 102(a)(1) prior art as of its publication or patent date.

Common Ownership and Joint Research Agreements under 102(c)

(c) COMMON OWNERSHIP UNDER JOINT RESEARCH AGREEMENTS.—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 subsection (b)(2)(C) if—

(1) the subject matter disclosed was developed and the claimed invention was made by, or on behalf of, 1 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

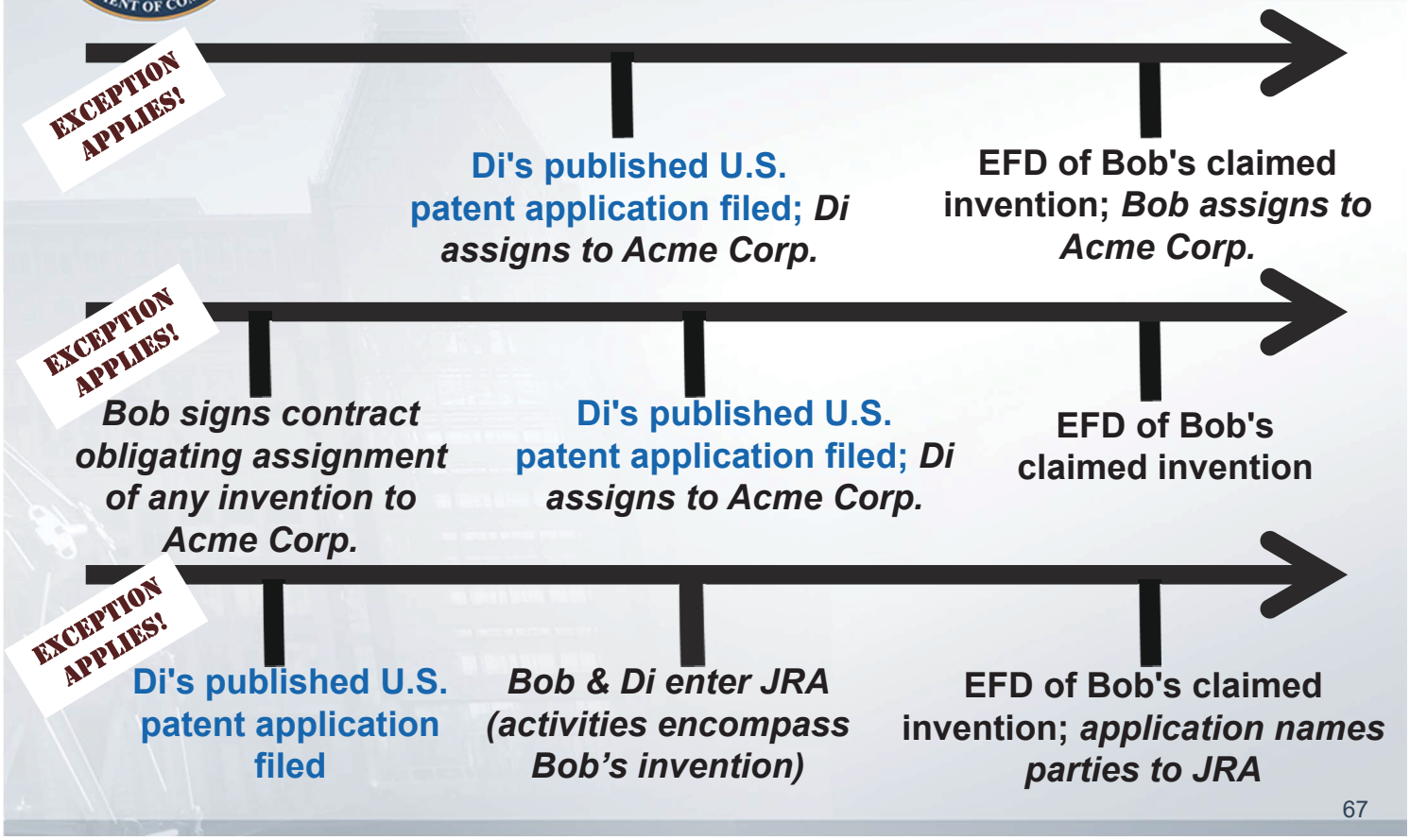
(3) the application for patent for the claimed invention discloses or is amended to disclose the names of the parties to the joint research agreement.

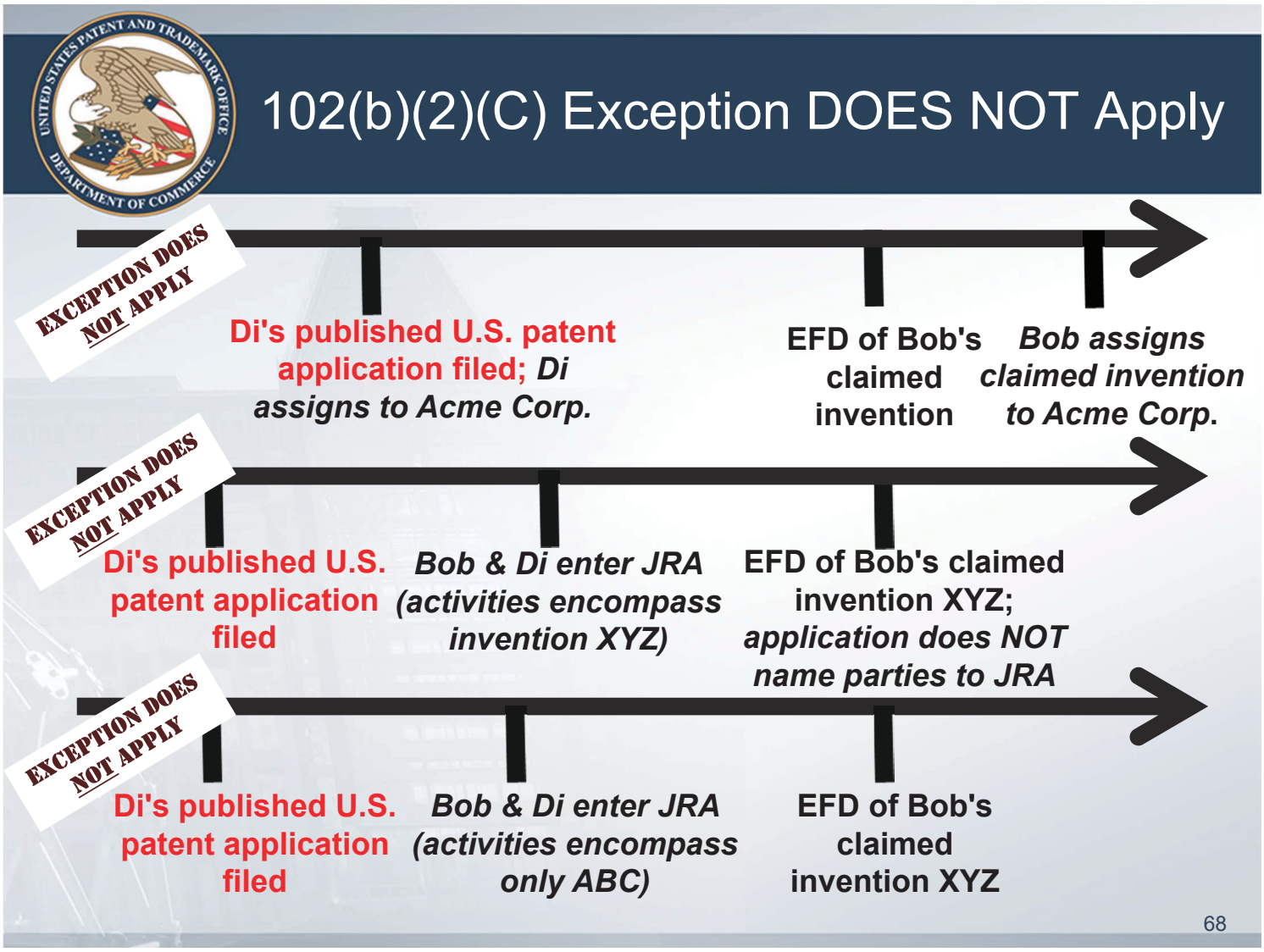
"Deemed" Common Ownership under 102(c)

There are three conditions for the 102(b)(2)(C) common ownership exception in view of a joint research agreement (JRA) under 102(c):

- the subject matter disclosed in a potential prior art U.S. patent document was developed, and the claimed invention was made, by or on behalf of parties to a JRA that was in effect not later than the effective filing date of the claimed invention,
- the claimed invention was made as a result of activities within the scope of the JRA, **and**
- the application that includes the claimed invention must name, or be amended to name, the parties to the JRA.

102(b)(2)(C) Exception Applies




102(b)(2)(C) Exception DOES NOT Apply
EXCEPTION DOES NOT APPLY
Di's published U.S. patent application filed; Di assigns to Acme Corp.
EFD of Bob's claimed invention
Bob assigns claimed invention to Acme Corp.
EXCEPTION DOES NOT APPLY
Di's published U.S. patent application filed
Bob & Di enter JRA (activities encompass invention XYZ)
EFD of Bob's claimed invention XYZ; application does NOT name parties to JRA
EXCEPTION DOES NOT APPLY
Di's published U.S. patent application filed
Bob & Di enter JRA (activities encompass only ABC)
EFD of Bob's claimed invention XYZ
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Common Ownership Exception: AIA vs. pre-AIA Comparison

The 102(b)(2)(C) exception is similar to pre-AIA 103(c), but with some important differences:

- The AIA common ownership exception applies to anticipation as well as obviousness rejections, whereas the pre-AIA 103(c) exception applies only to obviousness rejections in which the prior art qualifies only under pre-AIA 102(e), (f), or (g).

- Under the AIA, common ownership must exist no later than the effective filing date of the claimed invention. By contrast, pre-AIA 103(c) requires common ownership as of the date that the claimed invention was made.

- Under both pre-AIA and AIA practice, a statement is sufficient and a declaration is not needed to establish common ownership.

Topics for Discussion

- Introduction to prior art and effective filing date
- 35 U.S.C. 102(a)(1) and its exceptions
- 35 U.S.C. 102(a)(2) and its exceptions
- Declarations under 37 CFR 1.130
- Obviousness rejections under 35 U.S.C. 103

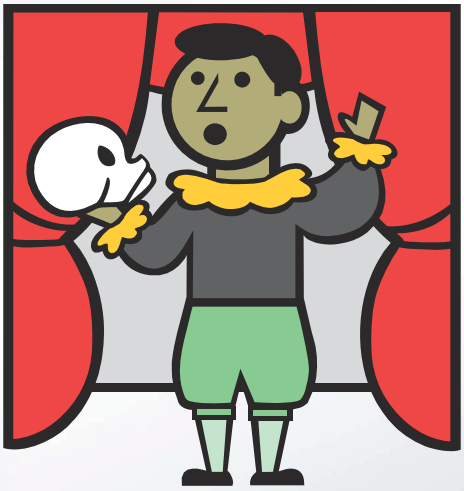
Declarations under 37 CFR 1.130

- An applicant may overcome or avoid a rejection under 102(a)(1) or 102(a)(2) by filing a declaration under 37 CFR 1.130
- Declarations under 37 CFR 1.130 are used to invoke an exception.

declaration rule	applicable exception	purpose
1.130(a)	102(b)(1)(A) and (b)(2)(A)	attribution: showing that the disclosure is the inventor's work
1.130(b)	102(b)(1)(B) and (b)(2)(B)	prior public disclosure: showing that the third party's disclosure was preceded by a an inventor-originated disclosure of the subject matter

To Reject or Not to Reject? That Is the Question.

- Unless the record is clear that an exception applies, the examiner <u>must make</u> or maintain any applicable rejection.
- When the record is clear that an exception applies, the examiner <u>should not make</u> or maintain any rejection under 102(a)(1) or 102(a)(2).



Situations Where the Record Is Clear and No Declaration is Needed: 102(a)(1)

A rejection should not be made based on a 102(a)(1) disclosure made during the grace period if:

- The authorship of the disclosure only includes one or more joint inventor(s) or the entire inventive entity of the application under examination.
- The specification of the application under examination identifies the disclosure as having been made by or having originated from one or more members of the inventive entity.

Situations Where the Record Is Clear and No Declaration is Needed: 102(a)(2)

A rejection should not be made based on a 102(a)(2) disclosure if:

- The inventive entity of the disclosure only includes one or more joint inventor(s), but not the entire inventive entity, of the application under examination.
- The specification of the application under examination identifies the disclosure as having been made by or having originated from one or more members of the inventive entity.

Topics for Discussion

- Introduction to prior art and effective filing date
- 35 U.S.C. 102(a)(1) and its exceptions
- 35 U.S.C. 102(a)(2) and its exceptions
- Declarations under 37 CFR 1.130
- Obviousness rejections under 35 U.S.C. 103

AIA Amendments to 35 U.S.C. 103

§ 103. Conditions for patentability; non-obvious subject matter

A patent for a claimed invention may not be obtained, ... 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.

AIA Amendments to 35 U.S.C. 103

pre-AIA 103 section	corresponding section in AIA
103(a) obviousness	103 – focus is now on effective filing date rather than date of invention, but otherwise the standard for determining obviousness is unchanged; examiner guidance in view of KSR v. Teleflex still applies
103(b) biotechnological processes	none
103(c) common ownership	102(b)(2)(C) and 102(c)

Prior Art Available Under 103

In order to be available as a reference in a 103 rejection, either alone or in combination, the reference must be available under 102(a)(1) or 102(a)(2).

This is <u>not</u> a change from pre-AIA 102 and 103(a).

For Questions…

- Intranet link:
  http://ptoweb.uspto.gov/patents/fitf

- Mail box for questions:
  FITF_examiner_questions@uspto.gov

- Lead FITF Points of Contact

Lead FITF Points of Contact

Contact	Business Unit
Cassandra Spyrou	TC 2600 & 2800
Chris Grant	TC 2100, 2400 & OPT
Tom Hughes	TC 3600, 3700 & CRU
Kathleen Bragdon	TC 1600, 1700 & 2900
Gerald Leffers	OPQA/ TC 1600, 1700 & 2900
Steve Saras	OPQA/ TC 2600 & 2800
MaryBeth Jones	OPQA/ TC 3600, 3700 & CRU
Don Sparks	OPQA/ TC 2100, 2400 & OPT

Thank You!

Please Stay for Questions

Time Code

- Turn in your attendance cards with your name and Art Unit
- Time code = **ATRAIN 0118 090101**