

# America Invents Act

“that’s not prior art to me!”

November 14, 2012

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GILCHRIST, P.A.

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INTELLECTUAL PROPERTY ATTORNEYS

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# Roadmap

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- I. Introduction**
- II. The Statute**
- III. The Proposed Rules**
- IV. Practice Tips**
- V. Conclusions and questions**



# Ready the coffee!

## §102 Statute Marked-Up

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(a) Novelty; Prior Art- A person shall be entitled to a patent unless--

~~\_(a) 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, or~~

~~(b1) the claimed invention was patented ~~or~~<sub>2</sub> described in a printed publication ~~in this or a foreign country~~<sub>2</sub> or in public use ~~or~~<sub>2</sub> on sale ~~in this country~~, more than one year prior<sub>2</sub> or otherwise available to the public before the effective filing date of the application for patent in the United States, claimed invention; or~~

# §102 Statute Marked-Up

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(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.

(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; or

(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.

# §102 Statute Marked-Up

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(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;

(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; or

(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.

(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-

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(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;

# §102 Statute Marked-Up

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(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.<sup>4</sup>

(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 to have been effectively filed, with respect to any subject matter 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.

~~(c) he has abandoned the invention, or~~

~~(d) the invention was first patented or caused to be patented, or was the subject of an inventor's certificate, by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application for patent or inventor's certificate filed more than twelve months before the filing of the application in the United States, or~~

# §102 Statute Marked-Up

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~~{e} the invention was described in~~

~~{1} an application for patent, published under section 122 (b), by another filed in the United States before the invention by the applicant for patent or~~

~~{2} a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351 (a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international~~

# §102 Statute Marked-Up

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~~application designated the United States and was published under Article 21(2) of such treaty in the English language; [1] or~~

~~(f) he did not himself invent the subject matter sought to be patented, or~~

~~(g) \_\_\_\_\_~~

~~(1) during the course of an interference conducted under section 135 or section 291, another inventor involved therein establishes, to the extent permitted in section 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. In determining priority of invention under this subsection, there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.~~

## Take a breath (stop checking FaceBook on Iphone/Android), What does this mean?

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- **Convert the United States patent system from a “first to invent” system to a “first inventor to file” system**
- **Treats United States patents and United States patent application publications as prior art as of their earliest effective United States, foreign, or *international filing date***
- **Eliminates the requirement that a prior public use or sale be “in this country” to be a prior art activity**
- **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**
- **Repeals the provisions pertaining to statutory invention registrations**

## §102(a)

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- **§102(a)(1) broadly defines prior art for events occurring anywhere in the world**
- **“In this country” language stricken out**
- **Critical date is no longer date of invention, but date of filing**
- **USPTO seeking comment on whether sale activities need to be public to qualify as prior art**
- **§102(a)(2) defines the effect of prior filed patent applications and patents by other inventors**
  - **Broader than current §102(e), reaches back to foreign priority dates**
  - **No need to publish PCT applications in English to qualify as prior art**
- **Bottom line: The world of prior art will expand on Judgment Day**

# §102(b) Exceptions

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- **§102(b)(1) defines the exceptions to §102(a)(1)**
- **One year grace period for**
  - inventor's own public disclosures
  - disclosures obtained from the inventor, and
  - shield against independent disclosures made after inventor's own public disclosure within the grace period
- **§102(b)(2) defines the exceptions to §102(a)(2) removes**
  - prior filed applications that were derived from the inventor, and
  - prior filed applications that were filed after inventor's own disclosure of the same subject matter (practice note, applicant needs to file application within one year of applicant's disclosure so that his disclosure is not prior art)

# §102(b)(2)(C) Common Owned Non-Prior Art

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- **Intended to replace old §103(c), provides exceptions to §102(a)(2)**
- **Differences**
  - applies to both novelty and obviousness rather than current law applying only to obviousness
  - in other words, completely removes them as prior art (unless prior application has published before second filing, i.e. §102(a)(1) prior art)
  - Critical date is no longer date of invention, but the second filing date
- **Possibility for applicant to buy out the prior art before the second filing**

**New law, so where is the typical atrocious, end the practice as we know it, proposed rules from the USPTO?**

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**July 26, 2012, USPTO publishes proposed rules to implement the first inventor to file provisions of the Leahy-Smith America Invents Act**

- **[http://www.uspto.gov/aia\\_implementation/first-inventor-to-file\\_proposed\\_rules.pdf](http://www.uspto.gov/aia_implementation/first-inventor-to-file_proposed_rules.pdf) or (77 Fed. Reg. 43742)**
- **Comments originally due October 5, 2012, then extended November 5, 2012**
- **Comments published at [http://www.uspto.gov/patents/law/comments/fitf\\_rules.jsp](http://www.uspto.gov/patents/law/comments/fitf_rules.jsp)**

## How do you know when it applies, really?

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- **Applications that are pending before March 16, 2013, and continuation and divisional applications that claim priority to such applications will continue to be governed by the current “first-to-invent” version of § 102**
  - Yes, you cannot forget the prior law for... forever!
- **Applications that claim priority to a foreign application filed before March 16, 2013 will also maintain first to invent**
- **The so called Poison Pill: If one of your claims (e.g. CIP) includes new subject matter that has an effective filing date after Judgment day, your entire application is forever treated as first to file, even if you subsequently cancel the new claims**
- **This poison pill applies to all subsequent continuation applications and is irrevocable**

# Applications That Straddle Judgment Day

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- **Straddling applications are non-provisional applications filed after Judgment Day, but claim priority to a provisional or foreign application filed before the date**
  - CIP applications also
- **These applications will require claim-by-claim analysis to avoid the poison pill issue**
- **“The Office is proposing additional requirements for nonprovisional applications filed on or after March 16, 2013, that claim the benefit of the filing date of a foreign, provisional, or nonprovisional application filed prior to March 16, 2013”**
  - Requiring a statement from applicant

# What is this Statement?

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- **If such a nonprovisional application contains at any time a claim to a claimed invention that has an effective filing date on or after March 16, 2013, the applicant must provide a statement to that effect within the later of**
  - **four months from the actual filing date of the later-filed application,**
  - **four months from the date of entry into the national stage in an international application,**
  - **sixteen months from the filing date of the prior-filed application, or**
  - **the date that a first claim to a claimed invention that has an effective filing date on or after March 16, 2013, is presented in the application**

# What is this Statement, Again?

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- **In addition, if such a nonprovisional application does not contain a claim to a claimed invention that has an effective filing date on or after March 16, 2013, but discloses subject matter not also disclosed in the foreign, provisional, or nonprovisional application, the applicant must provide a statement that the application includes subject matter not disclosed in the foreign, provisional, or nonprovisional application within the later of**
  - **four months from the actual filing date of the later-filed application,**
  - **four months from the date of entry into the national stage in an international application, or**
  - **sixteen months from the filing date of the prior-filed application.**

## So, how will these exceptions work?

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- **To except Inventor's own disclosures, applicant will need to file a Rule 130 Declaration**
- **Rule 130 Declaration**
  - disclosure at issue was made one year or less before the filing date, and
  - disclosure had been publicly disclosed by the inventor or joint inventor
- **If publication includes authors who are not inventors, the Rule 130 Declaration must include an unequivocal statement that other authors were not true inventors and an explanation for their listing as authors**
- **Alternatively, applicant can include these disclosures in application with the required Rule 130 Declaration requirements and avoid the need for the Declaration**

# More Exceptions

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- **To except another person's disclosure that was obtained from the inventor, applicant will need to file a Rule 130 Declaration**
- **Rule 130 Declaration**
  - the inventor/ joint inventor is the inventor of the subject matter of the disclosure
  - the inventor/ joint inventor communicated the subject matter to another who disclosed it, and
  - the communication was sufficient to enable one of ordinary skill in the art to make the subject matter of the claimed invention

# Shielding Disclosures

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- **To except another person's disclosure that was subsequent to inventor's own disclosure (or obtained from the inventor), applicant will need to file a Rule 130 Declaration**
- **Rule 130 Declaration (inventor shielding disclosure)**
  - that the inventor/joint inventor is the inventor of the subject matter of the earlier public disclosure
  - that there was a communication of the subject matter to another who publicly disclosed it, and
  - the date and content of the earlier (shielding) public disclosure
- **Rule 130 Declaration (non-inventor shielding disclosure)**
  - that the subject matter disclosed in the cited prior art had been publicly disclosed by another who obtained the subject matter disclosed directly or indirectly from the inventor/joint inventor before the cited disclosure
  - that the inventor/ joint inventor is the inventor of the subject matter of the cited disclosure
  - a communication of the subject matter to another who disclosed the subject matter, and
  - the date and content of the shielding disclosure

## Before we get all excited about shields and such...

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- **USPTO is requiring near identity between shielding disclosure and the prior art disclosure**
- **Mere trivial and insubstantial differences are enough to foul up the exception**
  - **The exception in 35 U.S.C. 102(b)(1)(B) applies if the “‘subject matter’ disclosed [in the prior art disclosure] had, before such [prior art] disclosure, been publicly disclosed by the inventor or a joint inventor \* \* \* .” Thus, the exception in 35 U.S.C. 102(b)(1)(B) requires that the subject matter in the prior disclosure being relied upon under 35 U.S.C. 102(a) be the same “subject matter” as the subject matter publicly disclosed by the inventor before such prior art disclosure for the exception in 35 U.S.C. 102(b)(1)(B) to apply. Even if the only differences between the subject matter in the prior art disclosure that is relied upon under 35 U.S.C. 102(a) and the subject matter publicly disclosed by the inventor before such prior art disclosure are mere insubstantial changes, or only trivial or obvious variations, the exception under 35 U.S.C. 102(b)(1)(B) does not apply.**

# Water On the Parade

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- **USPTO is requiring some serious record keeping from applicants**
- **For each exception, the USPTO will require a showing that the inventor was the actual inventor of the subject matter in the disclosure**
  - **Inventor logs**
- **The communication of the inventor will also be required for some of the exceptions**
- **Evidence of the content of any shielding disclosure**

## Some Bureaucratic Elements

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- **To better handle straddling applications that claim foreign priority, USPTO will now require submission of certified priority documents by the later of**
  - four months from the actual filing date of the application, or
  - sixteen months from the filing date of the prior foreign application
- **Also needed since old 102e art now reaches back to foreign priority date**
- **Claim for foreign priority must be in the ADS, not the application**
- **New application section for prior inventor disclosures to avoid the need for Rule 130 Declarations in the future**

# Practice Tips

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- **If at all possible, file your new application, provisional application, CIP, PCT, Paris Convention application before Judgment Day**
- **Do not rely of shielding disclosures to save you, the identity requirement may cause issues**
- **If inventor makes a disclosure, file a provisional as soon as possible**
- **Start contacting clients now to prevent misery as Judgment Day approaches**
- **When filing provisional applications, be sure to include one claim. When filing the utility, file the exact same provisional with a preliminary amendment so that there is no question support is derived from the prior provisional application**

## More Practice Tips

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- **First Inventor to File (FITF) -- race to the Patent Office**
- **Expansion of prior art, and globalization of prior art (removes prior geographic limits)**
- **“Effective filing date” of invention – claim by claim, and, if priority, the EFD is based on provisional, non-provisional, PCT, or foreign priority application**
- **“Effective filing date” of prior art – based on provisional, non-provisional, PCT, or foreign prior art application**
- **Some prior art patents and published applications can be used for both novelty and obviousness rejections (in EPO, novelty only)**

# Yet More Practice Tips

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- **No more swearing behind a reference**
- **The one year grace period is for a disclosure by or on behalf of the inventor**
- **Obviousness date no longer date of invention, but EFD**
- **Tsunami of filings before the March 16, 2013 date**
- **File more detailed provisional applications related to already pending provisional before March 16, 2013 (or convert them if necessary)**
- **After March 16, 2013**
  - **file any application as early as possible (written description and enablement)**
  - **file otherwise marginal applications**

# Conclusion

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**Questions?**

**Thank you for your  
attention.**