Interpreting Section 102: Prior Art, Exceptions, and More…

Mike Farn, Fenwick & West LLP
Bradley Baugh, North Weber & Baugh LLP

Rev. Dec. 12, 2013

Disclaimer

- The information provided is not legal advice and should not be construed as such.
- Please see your attorney if you require legal advice.

Agenda

- **Review of AIA 35 U.S.C. 102**
  - **When do AIA rules apply to an application?**
  - **Statutory Framework Overview**
- Prior Public Disclosure Prior Art: 102(a)(1) and (b)(1)
- Patent Prior Art: 102(a)(2) and (b)(2)

When does the AIA apply?

Rule: AIA 102 applies to any patent asset for which, at any time, at least one claim has a priority date on or after March 16, 2013 (or which claims priority to an AIA patent asset).

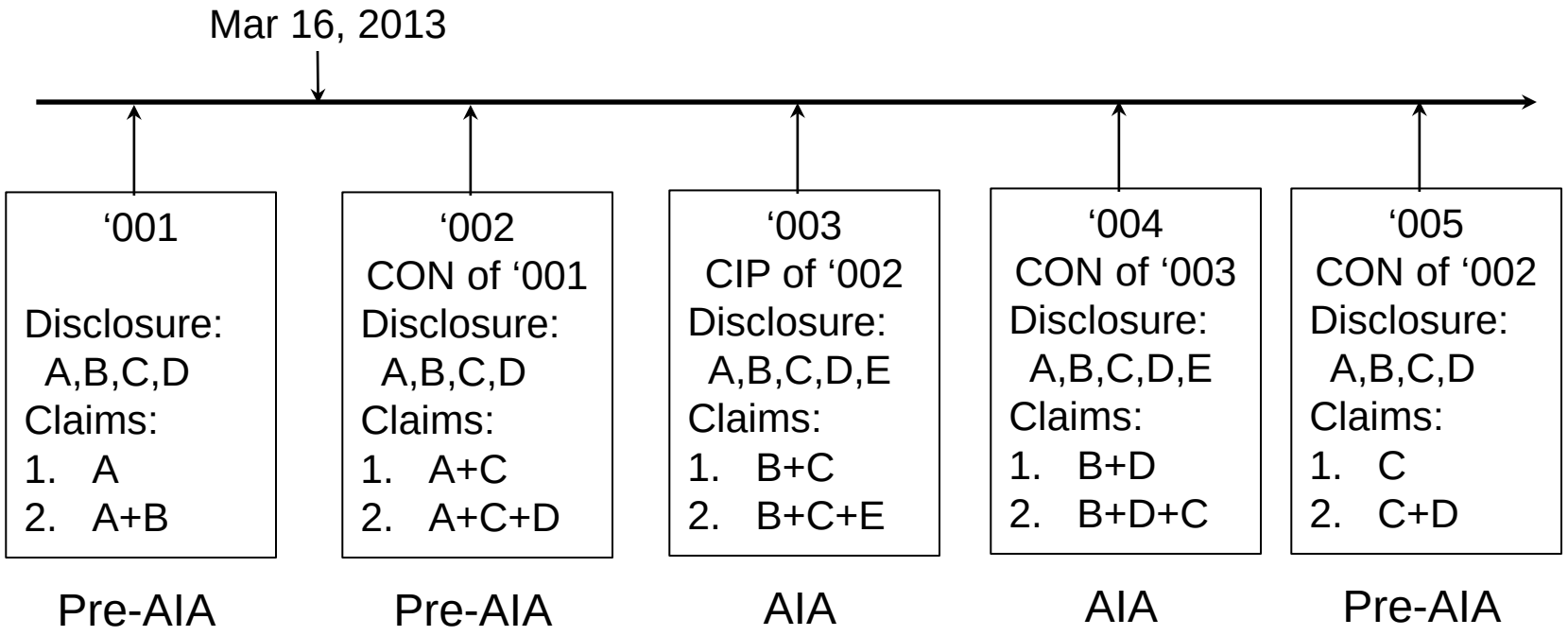
". . . the amendments made by this section shall take effect [on March 16, 2013], and shall apply to any application for patent, and to any patent issuing thereon, that contains or contained at any time-

(A) a claim to a claimed invention that has an effective date . . . that is on or after [March 16, 2013]; or

(B) a specific reference under section 120, 121, or 365(c) . . . to any patent or application that contains or contained at any time such a claim."

AIA sec 3(n)(1)

When does the AIA apply?



Statutory framework (source: http://www.uspto.gov/aia_implementation/FITF_card.pdf)

(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; 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.

(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.

(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—

(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.

(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.

Statutory framework (source: http://www.uspto.gov/aia_implementation/FITF_card.pdf)

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

Potential Areas of Ambiguity

- The significant change to 35 U.S.C. 102 resulted in new terms/phrases and possibly different meanings for previous terms/phrases.
- “The [Patent] Office appreciates that the courts may ultimately address questions concerning the meaning of AIA 35 U.S.C. 102 and 103.” Examination Guidelines (2/14/13), 78 Fed. Reg. 11061.
- Presented herein are some of the potentially ambiguous terms/phrases.

Agenda

- Review of AIA 35 U.S.C. 102
- **Prior Public Disclosure Prior Art: 102(a)(1) and (b)(1)**
- Patent Prior Art: 102(a)(2) and (b)(2)

Public Disclosure Prior Art: 102(a)(1) and (b)(1)

(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; or

(2) …

(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.

(2) …

… in public use …

Q: Is a "secret use" prior art?

A: Under pre-AIA 102, "public use" by the inventor included (1) uses that were accessible to the public, and (2) uses that were for commercial exploitation.

- Analysis depends on nature of public access to the invention, confidentiality obligations imposed upon observers, commercial exploitation and circumstances surrounding the use.
- It is a public use, if used by a third party without limitations, restrictions or confidentiality obligations.

Under AIA 102, "public use" includes only uses that are accessible to the public.

- "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." p 11075 of Examination Guidelines (2/14/13).

… on sale …

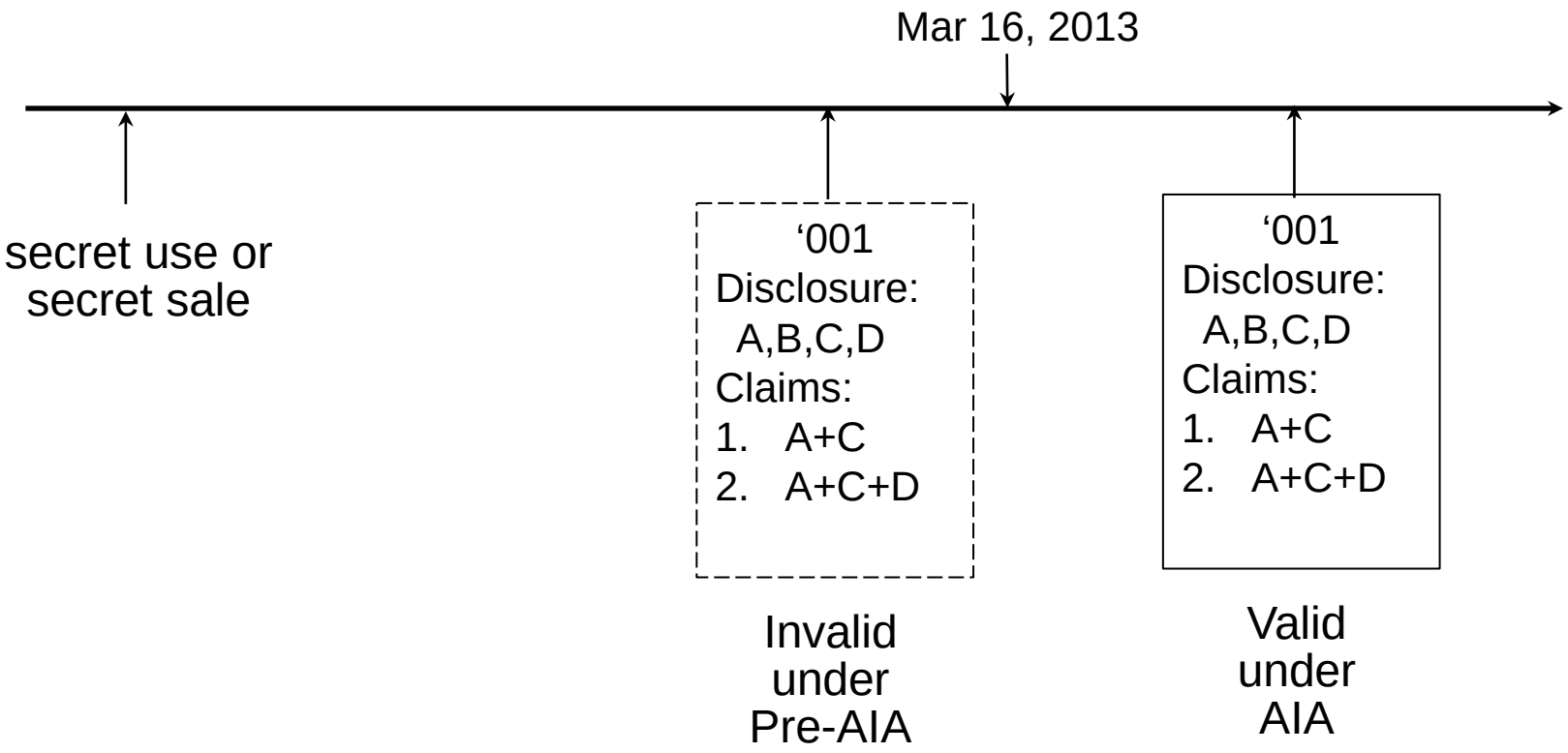
Q: Is a “secret sale” prior art?

A: Under pre-AIA 102, “on-sale” included secret sales.

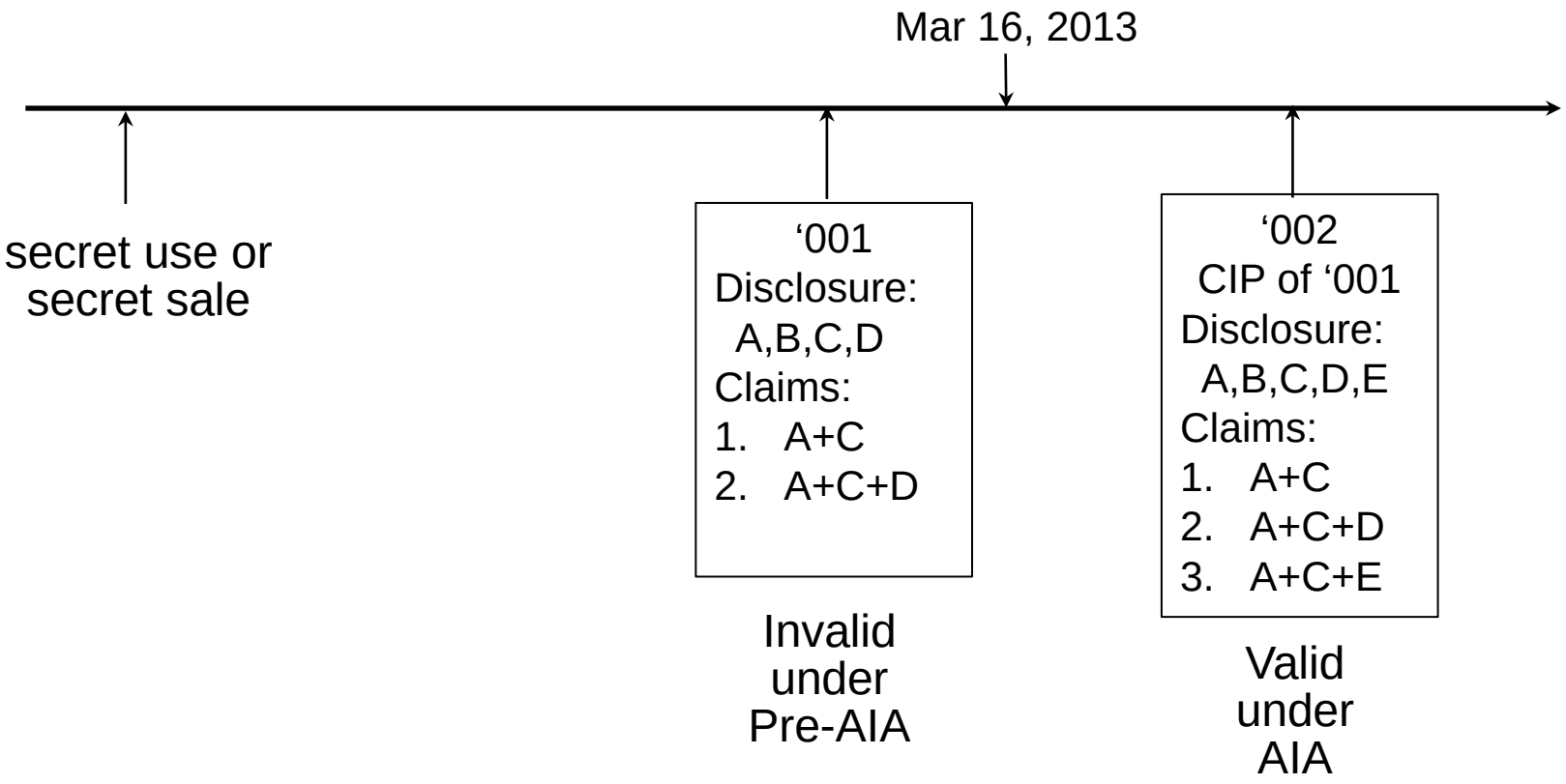
Under AIA 102, a secret sale is not prior art.

- “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.” p 11075 of Examination Guidelines (2/14/13).

… in public use … on sale …



… in public use … on sale …



… otherwise available to the public …

Q: What counts as "available to the public"?

A: It is a catch-all that turns on whether the claimed invention is made sufficiently available to the public, regardless of the mode of disclosure.

- "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 35 U.S.C. 102(a)(1), provided that the claimed invention is made sufficiently available to the public." p 11075 of Examination Guidelines (2/14/13).

102(b)(1) 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.

Agenda

- Review of AIA 35 U.S.C. 102
- Prior Public Disclosure Prior Art: 102(a)(1) and (b)(1)
- **Patent Prior Art: 102(a)(2) and (b)(2)**

Patent Prior Art: 102(a)(2) and (b)(2)

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

(1) …

(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) …

(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.

Patent Prior Art: 102(a)(2)

35 U.S.C. 102(a)(2) precludes a patent if a claimed invention was described in a:

- U.S. Patent;
- U.S. Patent Application Publication; or
- WIPO publication of PCT Applications designating the U.S.
  - Does not need to be published in English
  - Does not need to enter national stage in U.S.

that names another inventor and was effectively filed before the effective filing date of the claimed invention

… names another inventor …

Q: What does “names another inventor” mean?

A: Names Another Inventor = Any difference in inventive entity between the 102(a)(2) prior art patent document and the application under examination

Application Inventors:		Ref. 1 Inventors:		Ref. 2 Inventors:
A		A		A
B	≠	B	≠	B
C		C		C
D		D		
		E		

Ref. 1 & Ref. 2 would be 102(a)(2) prior art unless an exception under 102(b)(2) applies

Patent Prior Art: 102(a)(2)

35 U.S.C. 102(a)(2) precludes a patent if a claimed invention was described in a:

- U.S. Patent;
- U.S. Patent Application Publication; or
- WIPO publication of PCT Applications designating the U.S.
  - Does not need to be published in English
  - Does not need to enter national stage in U.S.

that names another inventor and was effectively filed before the effective filing date of the claimed invention

… effective filing date …

Q: What is the definition of "effective filing date"?

A: Defined in 35 U.S.C. 100(i)(1):

Effective Filing Date for a claimed invention is the earlier of:

- (A) the actual filing date … ; or
- (B) the filing date of the earliest application for which the patent or application is entitled to a right of foreign priority or domestic benefit as to the claimed invention

… effectively filed …

Q: What is the meaning of "effectively filed"?

A: Explained in 35 U.S.C. 102(d):

- Date that a U.S. or PCT patent document being applied as a prior art reference is effectively filed is the earlier of:
  - the actual filing date of the patent or published application; or
  - the filing date of the earliest application to which the U.S. patent or published application is "entitled to claim" a right of foreign priority or domestic benefit which describes the subject matter

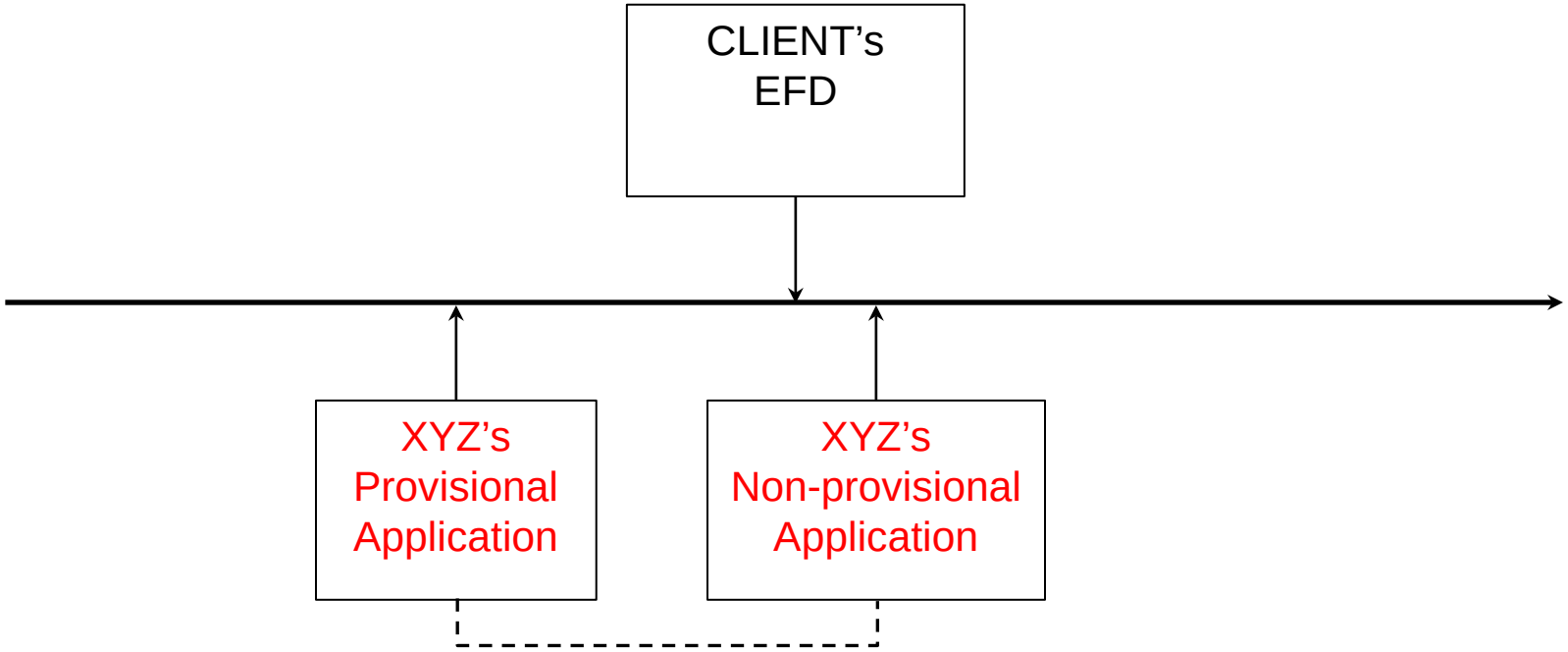
- Note:
  - Can rely on foreign priority date (eliminates *Hilmer* doctrine)
  - "entitled to claim" = 35 U.S.C. 112(a) enablement not required (see next slide) (see Examination Guidelines, 78 Fed. Reg. 11059, 11078 (2/14/13) ("AIA 35 USC 102(d) does not require that this description meet the requirements of 35 USC 112(a)")).

… entitled to claim … vs. … entitled to …

- Priority / Benefit requirements:
  - Ministerial
    - (1) Containing a priority or benefit claim to the prior-filed application
    - (2) being filed within the applicable filing period requirement (copending with or within twelve months of the earlier filing, as applicable)
    - (3) having a common inventor or being by the same applicant
  - (4) Enabling disclosure
- ‘‘entitled to claim’’ = fulfilling the ministerial requirements
- ‘‘entitled to’’ = fulfilling the all the requirements

See Examination Guidelines, 78 Fed. Reg. 11059, 11078 (2/14/13).

Example

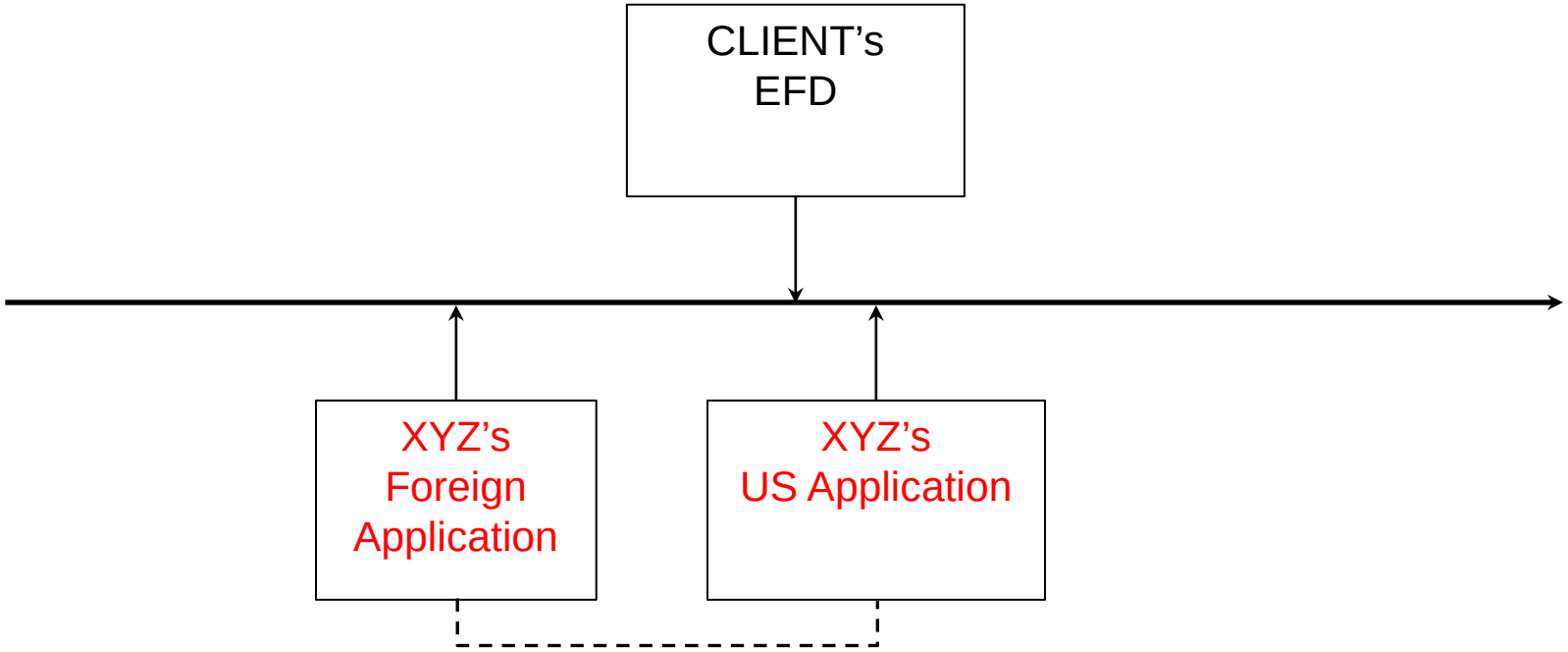


35 U.S.C. 102(d):

- The filing date of the earliest application to which the U.S. patent or published application is "entitled to claim" a right of foreign priority or domestic benefit **which describes the subject matter**

*Prior case law and practices likely to remain the same.

Example – Not perfected foreign priority



USPTO has indicated 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

102(b)(2) Exceptions

- A disclosure shall not be prior art to a claimed invention under subsection (a)(2) if:
  - (A) [**Disclosure Obtained from Inventor**] — the subject matter disclosed was obtained directly or indirectly from the inventor or a joint inventor;
  - (B) [**Intervening Disclosure by Third Parties**] — 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) [**Commonly Owned Disclosure**] — 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.

… disclosure …

Q: Does “disclosure” include all the activities in 102(a)(1) and (a)(2)?

A:

- “Disclosure” is not defined in the AIA.
- The term “disclosure” appears in AIA 35 U.S.C. 102(b)(1) and (b)(2), and each section states 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.
- Thus, the USPTO 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)
- See Examination Guidelines, 78 Fed. Reg. 11059, 11075 (2/14/13).

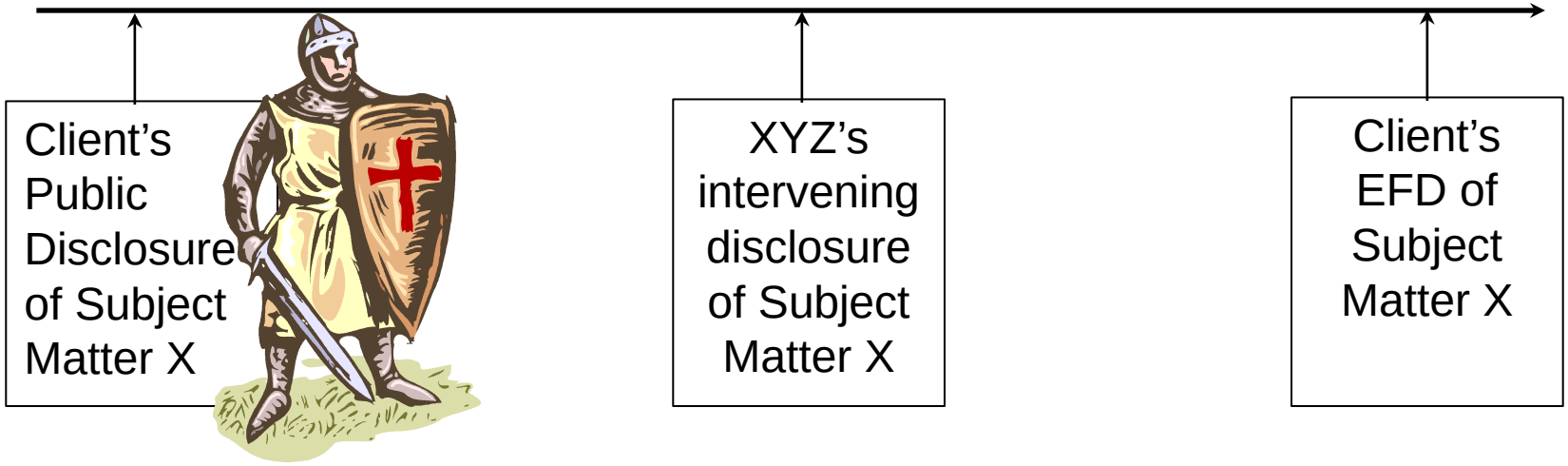
… disclosure …

- Thus, the scope of "disclosure" in 102(b)(1) and 102(b)(2) will be different because these sections correspond to different definitions of prior art as set forth in 102(a)(1) and 102(a)(2), respectively.

102(b)(1) "disclosures"	102(b)(2) "disclosures"
-patents -printed publications (including published applications and patents) -in public use -on sale -otherwise available to the public	-U.S. Patent -Published U.S. Patent Application -Published PCT Application designating the US

102(b)(1)(B) & 102(b)(2)(B) -- Shielding

When the 102(b)(1)(B) exception or 102(b)(2)(B) exception applies, the inventor's prior public disclosure of subject matter X shields the claimed invention from a prior art rejection based on the third party's intervening disclosure of subject matter X



… publicly disclosed …

Q: How is "publicly disclosed" defined for 102(b)(1)(B) and 102(b)(2)(B)?

A: "Publicly Disclosed" is not defined in the AIA.

- Limited discussion of what is meant by "publicly disclosed" in the **Final Rules** and the **Examination Guidelines**:
  - "Whether a 'disclosure' is a 'public disclosure' such that it constitutes prior art under 102(a)(1) is a case-by-case analysis which is governed by the case law discussed in MPEP § § 2126-2128."
  - Examination Guidelines, 78 Fed. Reg. 11059, 11068 (2/14/13).
- Prior case law likely to be instructive.

… subject matter disclosed …

Q: What is the meaning of "subject matter disclosed" relative to the prior disclosure for 102(b)(1)(B) and (b)(2)(B)?

A: USPTO admits that the legislative history is unclear, but it is taking the position that "subject matter disclosed" in the prior disclosure must be the **SAME** as that which was later publicly disclosed:

> 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… . **These examination guidelines maintain the identical subject matter interpretation** of AIA 35 U.S.C. 102(b)(1)(B) and 102(b)(2)(B).

Examination Guidelines, 78 Fed. Reg. 11059, 11061 (2/14/13) (emphasis added).

… subject matter disclosed …

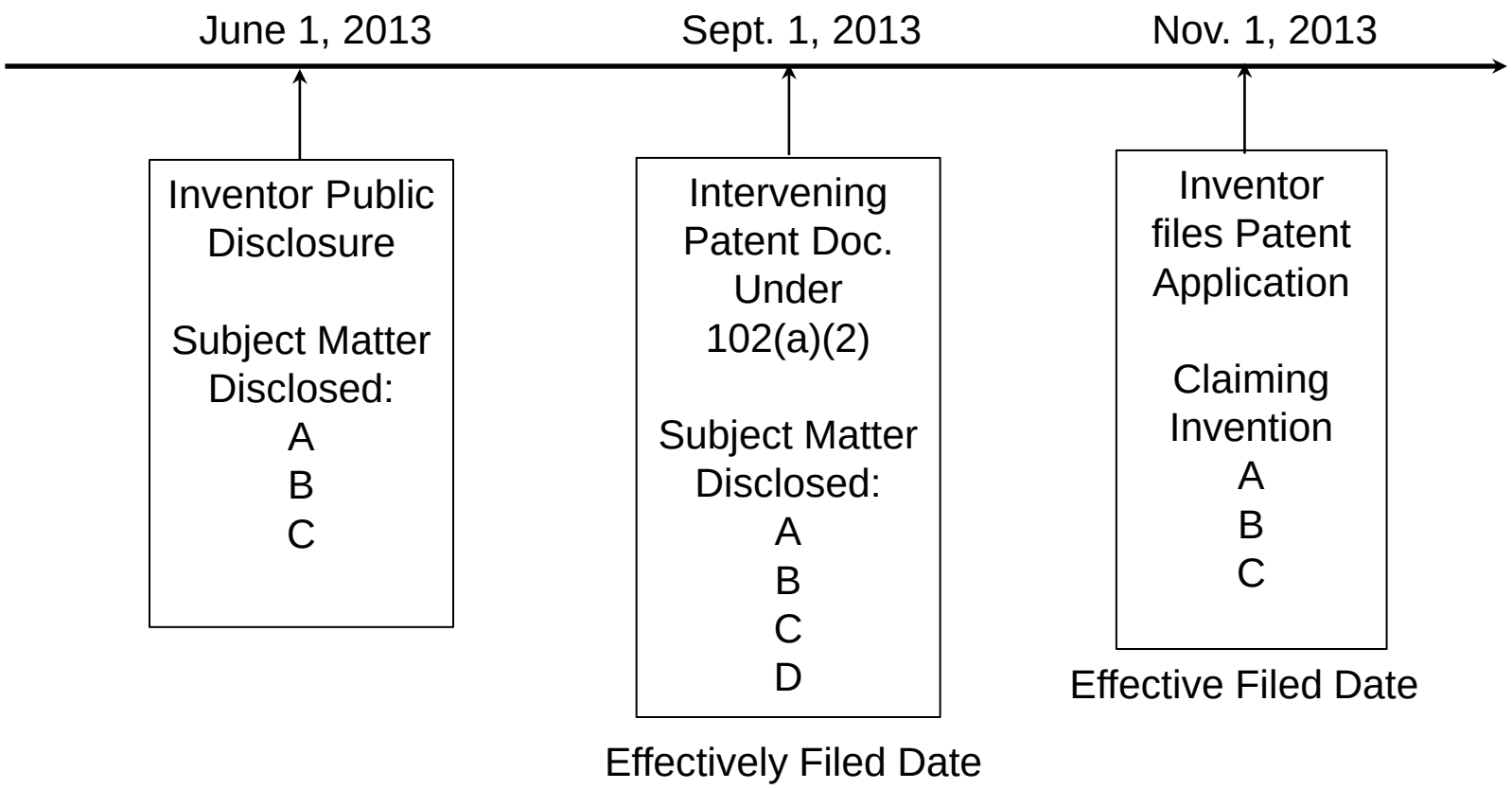
- No requirement that the mode of disclosure be the same as the mode of disclosure of the intervening disclosure

- No requirement that the disclosure be a verbatim or *ipsissimis verbis* disclosure of the intervening disclosure.

- Also, 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.

See Examination Guidelines, 78 Fed. Reg. 11059, 11061 (2/14/13).

EXAMPLE: … subject matter disclosed …



Only element D of the intervening patent document is available as prior art under AIA 35 U.S.C. 102(a)(2)

102(b)(2)(C) Exceptions – Commonly Owned

- Akin to pre-AIA 35 U.S.C. 103(c), however:
  - it applies to both novelty and obviousness, whereas pre-AIA 103(c) disqualified art only for obviousness
  - Different timing – "… not later than the effective filing date of the claimed invention…"
    - Pre-AIA required common ownership as of date that the claimed invention was made
    - Under AIA: Can an entity buy its way around 102(b)(2) prior art?
- Applies only as an exception to 102(a)(2) patent documents!
- Joint Research Agreement (JRA)—see 102(c) for conditions that must be satisfied to be deemed as having been owned by the same person or subject to an obligation of assignment to the same person

“Deemed” Commonly Owned for a JRA

- Three conditions for 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 1 or more parties to a JRA that was in effect on or before the effective filing date of the claimed invention;
  - the claimed invention was made as a result of activities undertaken within the scope of the JRA; and
  - the application for the claimed invention names, or is amended to name, the parties to the JRA.

Thank you!!

Bradley Baugh

North Weber & Baugh LLP

650.353.3783

bbaugh@northweber.com

Mike Farn

Fenwick & West LLP

650.335.7823

mfarn@fenwick.com