

First to File Planning Issues

Some Filing Should Predate March 16, 2013

- First to File is effective for applications filed on or after 3/16/13
 - Looks to effective filing date, so generally will not affect RCE or Applications with earlier claimed priority
 - Broader Prior Art and stricter 1 yr grace period encourages pre-3/16/13 filings for applications that involve a previous publication or have prior art issues
 - 35 U.S.C. 102(b) was rewritten to possibly limit the one year grace period for publications
 - 35 U.S.C. 102(d) was rewritten to remove country restrictions and to relate back to earliest filing dates (not publication dates) to allow more prior art to be applied against applicants
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35 USC § 102 Changes

- **35 U.S.C. 102**
 - Current Law:
 - 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
 - New Law on March 16, 2013:
 - (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 maybe, names another inventor and was effectively filed before the effective filing date of the claimed invention.
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35 USC § 102 Changes

- 35 U.S.C. 102
 - Current Law:
 - (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or
 - New Law on March 16, 2013:
 - (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.
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 - (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.
- But note that the Proposed Examination Guidelines published in the Federal Register (Vol. 77, No. 144, Thursday, July 26, 2012) state:
 - 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.**

35 USC § 102 Changes

- **35 U.S.C. 102**
 - Current Law:
 - (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
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35 USC § 102 Changes

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35 USC § 102 Changes

- **35 U.S.C. 102**
 - **Current Law:**
 - 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 application designated the United States and was published under Article 21(2) of such treaty in the English language; or
 - (f) he did not himself invent the subject matter sought to be patented, or
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35 USC § 102 Changes

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 - ~~(f) he did not himself invent the subject matter sought to be patented, or~~
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35 USC § 102 Changes

- **35 U.S.C. 102**
 - **Current Law:**
 - (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.
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35 USC § 102 Changes

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 - ~~(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.~~
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35 USC § 102 Changes

- 35 U.S.C. 102
 - New Law on March 16, 2013:
 - (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;
 - (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.
 - Again, the Proposed Examination Guidelines published in the Federal Register (Vol. 77, No. 144, Thursday, July 26, 2012) state:
 - 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)(2)(B) does not apply.**
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35 USC § 102 Changes

- **35 U.S.C. 102**
 - New Law on March 16, 2013:
 - (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.
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35 USC § 102 Changes

- **35 U.S.C. 102**
 - New Law on March 16, 2013:
 - (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**.
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Search for Disclosures to File Before 3/16/13

- Develop system to identify disclosures that should be filed to be examined under the pre-March 16, 2013 law.
 - Suggestions for such a system, identify:
 - Disclosures in technical areas that suffer strong competition
 - Disclosures where there was a publication by the inventors (or anything that could be considered a publication)
 - Disclosures that are more than a specific number of months old (e.g., 12, 18, 24 months)
 - Disclosures that are joint development items (to keep the option to use 131 declarations that are available pre-March 16, 2013 in case there are disagreements as to who developed what)
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Filing Applications Sooner After

March 16, 2013

- Special procedure for rushing applications
 - Include a new rating for “fast track” applications that seem at risk for competitor action
 - During Rating of Disclosures, include a rating for “aggressive abandonment” if the value of a fast tracked application later turns out to be questionable
 - Have training systems to teach inventors to perform better searches faster to help identify fast track applications
 - Have disclosure reviews more frequently
 - Combine some steps in the process to reduce the rating decision time
 - Provide financial incentives for faster disclosure and application filing
 - File serial applications (provisional or non-provisional) and abandon all but the last
 - Use PCT more (especially for questionable value apps that may be scheduled for aggressive abandonment)
 - Global searching
 - Faster Examinations
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Filing Applications Sooner After March 16, 2013

- 3M's Form for Aggressive Abandonment Rating

Filing/Abandonment Factors			
Factor	US Filing Rating (0, 1, 3, 9)	Int'l Filing Rating (0,1,3,9)	Key Participants
Claim Strength			R, A, L
Business Potential			R, M
Technical Feasibility			R
Competitive Position			R, M, A, L, BI
Defensive Position			R, M, A, L, BI
Technology Potential			R
Licensing Potential			R, A
Local Patent/Sales Relationship			A, L
Key: R= R&D, A = Attorney, L= Liaison M = Marketing, BI = Business Intelligence			

Absolute Priority World

- The changes to 35 U.S.C. 102 move us closer to the rest of the world with respect to absolute priority
 - It is much more important to file applications before any disclosure (including filing applications before development meetings even w/CDA or NDA)
 - Keep inventor notebooks regarding who developed what and when during any development meetings (even w/ CDA/NDA). This will be helpful in derivation proceedings
 - Make more liberal use of provisional applications
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Thank You!

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Supporting Material

MANUAL OF PATENT EXAMINING PROCEDURE

*[*End Editor's Note: Fees For Patent Services (Sept. 26, 2011)]*

35 U.S.C. 42

(a) All fees for services performed by or materials furnished by the Patent and Trademark Office will be payable to the Director.

(b) All fees paid to the Director and all appropriations for defraying the costs of the activities of the Patent and Trademark Office will be credited to the Patent and Trademark Office Appropriation Account in the Treasury of the United States.

(c) (1) To the extent and in the amounts provided in advance in appropriations Acts, fees authorized in this title or any other Act to be charged or established by the Director shall be collected by and shall, subject to paragraph (3), be available to the Director to carry out the activities of the Patent and Trademark Office.

(2) There is established in the Treasury a Patent and Trademark Fee Reserve Fund. If fee collections by the Patent and Trademark Office for a fiscal year exceed the amount appropriated to the Office for that fiscal year, fees collected in excess of the appropriated amount shall be deposited in the Patent and Trademark Fee Reserve Fund. To the extent and in the amounts provided in appropriations Acts, amounts in the Fund shall be made available until expended only for obligation and expenditure by the Office in accordance with paragraph (3).

(3) (A) Any fees that are collected under sections 41, 42, and 376, and any surcharges on such fees, may only be used for expenses of the Office relating to the processing of patent applications and for other activities, services, and materials relating to patents and to cover a share of the administrative costs of the Office relating to patents.

(B) Any fees that are collected under section 31 of the Trademark Act of 1946, and any surcharges on such fees, may only be used for expenses of the Office relating to the processing of trademark registrations and for other activities, services, and materials relating to trademarks and to cover a share of the administrative costs of the Office relating to trademarks.

(d) The Director may refund any fee paid by mistake or any amount paid in excess of that required.

(e) The Secretary of Commerce shall, on the day each year on which the President submits the annual budget to the Congress, provide to the Committees on the Judiciary of the Senate and the House of Representatives: (1) a list of patent and trademark fee collections by the Patent and Trademark Office during the preceding fiscal year;

(2) a list of activities of the Patent and Trademark Office during the preceding fiscal year which

were supported by patent fee expenditures, trademark fee expenditures, and appropriations;

(3) budget plans for significant programs, projects, and activities of the Office, including out-year funding estimates;

(4) any proposed disposition of surplus fees by the Office; and

(5) such other information as the committees consider necessary.

(Amended Nov. 14, 1975, Public Law 94-131, sec. 4, 89 Stat. 690; Dec. 12, 1980, Public Law 96-517, sec. 3, 94 Stat. 3018; Aug. 27, 1982, Public Law 97-247, sec. 3(g), 96 Stat. 319; Sept. 13, 1982, Public Law 97-258, sec. 3(i), 96 Stat. 1065; subsection (c) amended Dec. 10, 1991, Public Law 102-204, sec. 5(e), 105 Stat. 1640; subsection (c) added Dec. 10, 1991, Public Law 102-204, sec. 4, 105 Stat. 1637; subsection (c) revised Nov. 10, 1998, Public Law 105-358, sec. 4, 112 Stat. 3274; amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-555, 582 (S. 1948 secs. 4205 and 4732(a)(10)(A)); subsection (c) amended Sept. 16, 2011, Leahy-Smith America Invents Act, Public Law 112-29, sec. 22, 125 Stat. 284, effective Oct. 1, 2011.)

PART II — PART II—PATENTABILITY OF INVENTIONS AND GRANT OF PATENTS

CHAPTER 10 — PATENTABILITY OF INVENTIONS

Sec.

25. 100 Definitions.

26. 101 Inventions patentable.

27. 102 Conditions for patentability; novelty and loss of right to patent.

28. 103 Conditions for patentability; non-obvious subject matter.

29. 104 Invention made abroad.

30. 105 Inventions in outer space.

35 U.S.C. 100

When used in this title unless the context otherwise indicates -

(a) The term "invention" means invention or discovery.

(b) The term "process" means process, art, or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material.

(c) The terms "United States" and "this country" mean the United States of America, its territories and possessions.

(d) The word "patentee" includes not only the patentee to whom the patent was issued but also the successors in title to the patentee.

MANUAL OF PATENT EXAMINING PROCEDURE

(e) The term "third-party requester" means a person requesting ex parte reexamination under [section 302](#) or inter partes reexamination under [section 311](#) who is not the patent owner.

(Subsection (e) added Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-567 (S. 1948 sec. 4603).)

*[*Begin Editor's Note: 35 U.S.C. 100 (March 16, 2013)]*

Effective March 16, 2013, 35 U.S.C. 100(e)-(j) will read as follows:

35 U.S.C. 100

When used in this title unless the context otherwise indicates -

(e) The term "third-party requester" means a person requesting ex parte reexamination under [section 302](#) who is not the patent owner.

(f) The term "inventor" means the individual or, if a joint invention, the individuals collectively who invented or discovered the subject matter of the invention.

(g) The terms "joint inventor" and "coinventor" mean any 1 of the individuals who invented or discovered the subject matter of a joint invention.

(h) The term "joint research agreement" means a written contract, grant, or cooperative agreement entered into by 2 or more persons or entities for the performance of experimental, developmental, or research work in the field of the claimed invention.

(i) (1) The term "effective filing date" for a claimed invention in a patent or application for patent means— (A) if subparagraph (B) does not apply, the actual filing date of the patent or the application for the patent containing a claim to the invention; or

(B) the filing date of the earliest application for which the patent or application is entitled, as to such invention, to a right of priority under section 119, 365(a), or 365(b) or to the benefit of an earlier filing date under section 120, 121, or 365(c).

(2) The effective filing date for a claimed invention in an application for reissue or reissued patent shall be determined by deeming the claim to the invention to have been contained in the patent for which reissue was sought.

(j) The term "claimed invention" means the subject matter defined by a claim in a patent or an application for a patent.

(Subsection (c) added Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-567 (S. 1948 sec. 4603); subsection (e) amended and subsections (f) - (j) added Sept. 16, 2011, Leahy-Smith America Invents Act, Public Law 112-29, sec. 3(a), 125 Stat. 284, effective March 16, 2013.)

*[*End Editor's Note: 35 U.S.C. 100 (March 16, 2013)]*

35 U.S.C. 101

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

*[*Begin Editor's Note: Limitation on Issuance of Patents (Sept. 16, 2011)]*

Leahy-Smith America Invents Act, Public Law 112-29, sec. 33, 125 Stat. 284 provides as follows:

(a) LIMITATION.—Notwithstanding any other provision of law, no patent may issue on a claim directed to or encompassing a human organism.

(b) EFFECTIVE DATE.—

(1) IN GENERAL.—Subsection (a) shall apply to any application for patent that is pending on, or filed on or after, the date of the enactment of this Act [Sept. 16, 2011].

(2) PRIOR APPLICATIONS.—Subsection (a) shall not affect the validity of any patent issued on an application to which paragraph (1) does not apply.

*[*End Editor's Note: Limitation on Issuance of Patents (Sept. 16, 2011)]*

35 U.S.C. 102

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

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

(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

(e) the invention was described in — (1) an application for patent, published under [section 122\(b\)](#),

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MANUAL OF PATENT EXAMINING PROCEDURE

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 application designated the United States and was published under [Article 21\(2\)](#) of such treaty in the English language; 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.

(Amended July 28, 1972, Public Law 92-358, sec. 2, 86 Stat. 501; Nov. 14, 1975, Public Law 94-131, sec. 5, 89 Stat. 691; subsection (e) amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-565 (S. 1948 sec. 4505); subsection (g) amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-590 (S. 1948 sec. 4806); subsection (e) amended Nov. 2, 2002, Public Law 107-273, sec. 13205, 116 Stat. 1903.)

[*Begin Editor's Note: Tax Strategies Deemed Within the Prior Art (Sept. 16, 2011)]

Leahy-Smith America Invents Act, Public Law 112-29, sec. 14, 125 Stat. 284 provides as follows:

(a) IN GENERAL.—For purposes of evaluating an invention under section 102 or 103 of title 35, United States Code, any strategy for reducing, avoiding, or deferring tax liability, whether known or unknown at the time of the invention or application for patent, shall be deemed insufficient to differentiate a claimed invention from the prior art.

(b) DEFINITION.—For purposes of this section, the term “tax liability” refers to any liability for a tax under any Federal, State, or local law, or the law of any foreign jurisdiction, including any statute, rule, regulation, or ordinance that levies, imposes, or assesses such tax liability.

(c) EXCLUSIONS.—This section does not apply to that part of an invention that— (1) is a method, apparatus, technology, computer program product, or system, that is used solely for preparing a tax or information return or other tax filing, including one that records, transmits, transfers, or organizes data related to such filing; or

(2) is a method, apparatus, technology, computer program product, or system used solely for financial management, to the extent that it is severable from any tax strategy or does not limit the use of any tax strategy by any taxpayer or tax advisor.

(d) RULE OF CONSTRUCTION.—Nothing in this section shall be construed to imply that other business methods are patentable or that other business method patents are valid.

(e) EFFECTIVE DATE; APPLICABILITY.—This section shall take effect on the date of the enactment of this Act [Sept. 16, 2011] and shall apply to any patent application that is pending on, or filed on or after, that date, and to any patent that is issued on or after that date.]

[*End Editor's Note: Tax Strategies Deemed Within the Prior Art (Sept. 16, 2011)]

[*Begin Editor's Note: 35 U.S.C. 102 (March 16, 2013)]

Effective March 16, 2013, 35 U.S.C. 102 will read as follows, 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 filing date as defined in section 100(i) of title 35, United States Code, that is on or after March 16, 2013 (the effective date described in the Leahy Smith America Invents Act sec. 3(b)); or

(B) a specific reference under section 120, 121, or 365(c) of title 35, United States Code, to any patent or application that contains or contained at any time such a claim. **NOTE:** The provisions of 35 U.S.C. 102(g), 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 this section (Leahy Smith America Invents Act sec. 3) also apply, if such application or patent contains or contained at any time—

(A) a claim to an invention having an effective filing date as defined in section 100(i) of title 35, United States Code, that occurs before March 16, 2013 (the effective date set forth in the Leahy Smith America Invents Act sec. 3); or

(B) a specific reference under section 120, 121, or 365(c) of title 35, United States Code, to any patent or application that contains or contained at any time such a claim.

35 U.S.C. 102

MANUAL OF PATENT EXAMINING PROCEDURE

(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.

(Amended July 28, 1972, Public Law 92-358, sec. 2, 86 Stat. 501; Nov. 14, 1975, Public Law 94-131, sec. 5, 89 Stat. 691; subsection (e) amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-565 (S. 1948 sec. 4505); subsection (g) amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-590 (S. 1948 sec. 4806); subsection (e) amended Nov. 2, 2002, Public Law 107-273, sec. 13205, 116 Stat. 1903; amended Sept. 16, 2011, Leahy-Smith America Invents Act, Public Law 112-29, sec. 3(b), 125 Stat. 284, effective March 16, 2013.)

[*End Editor's Note: 35 U.S.C. 102 (March 16, 2013)]

35 U.S.C. 103

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in [section 102](#) of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

(b) (1) Notwithstanding subsection (a), and upon timely election by the applicant for patent to proceed under this subsection, a biotechnological process using or resulting in a composition of matter that is novel under [section 102](#) and nonobvious under subsection (a) of this section shall be considered nonobvious if—(A) claims to the process and the composition of matter are contained in either the same application for patent or in separate applications having the same effective filing date; and

(B) the composition of matter, and the process at the time it was invented, were owned by the same person or subject to an obligation of assignment to the same person.

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MANUAL OF PATENT EXAMINING PROCEDURE

(2) A patent issued on a process under paragraph (1)-(A) shall also contain the claims to the composition of matter used in or made by that process, or

(B) shall, if such composition of matter is claimed in another patent, be set to expire on the same date as such other patent, notwithstanding [section 154](#).

(3) For purposes of paragraph (1), the term "biotechnological process" means—(A) a process of genetically altering or otherwise inducing a single- or multi-celled organism to—(i) express an exogenous nucleotide sequence,

(ii) inhibit, eliminate, augment, or alter expression of an endogenous nucleotide sequence, or

(iii) express a specific physiological characteristic not naturally associated with said organism;

(B) cell fusion procedures yielding a cell line that expresses a specific protein, such as a monoclonal antibody; and

(C) a method of using a product produced by a process defined by subparagraph (A) or (B), or a combination of subparagraphs (A) and (B).

(c) (1) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of [section 102](#) of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

(2) For purposes of this subsection, subject matter developed by another person 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 if—(A) the claimed invention was made by or on behalf of parties to a joint research agreement that was in effect on or before the date the claimed invention was made;

(B) the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement; and

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

(3) For purposes of paragraph (2), the term "joint research agreement" means 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.

(Amended Nov. 8, 1984, Public Law 98-622, sec. 103, 98 Stat. 3384; Nov. 1, 1995, Public Law 104-41, sec. 1, 109 Stat. 3511; subsection (c) amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-591 (S. 1948 sec. 4807); subsection (c) amended Dec. 10, 2004, Public Law 108-453, sec. 2, 118 Stat. 3596.)

*[*Begin Editor's Note: Tax Strategies Deemed Within the Prior Art (Sept. 16, 2011)]*

Leahy-Smith America Invents Act, Public Law 112-29, sec. 14, 125 Stat. 284 provides as follows:

(a) IN GENERAL.—For purposes of evaluating an invention under section 102 or 103 of title 35, United States Code, any strategy for reducing, avoiding, or deferring tax liability, whether known or unknown at the time of the invention or application for patent, shall be deemed insufficient to differentiate a claimed invention from the prior art.

(b) DEFINITION.—For purposes of this section, the term "tax liability" refers to any liability for a tax under any Federal, State, or local law, or the law of any foreign jurisdiction, including any statute, rule, regulation, or ordinance that levies, imposes, or assesses such tax liability.

(c) EXCLUSIONS.—This section does not apply to that part of an invention that—(1) is a method, apparatus, technology, computer program product, or system, that is used solely for preparing a tax or information return or other tax filing, including one that records, transmits, transfers, or organizes data related to such filing; or

(2) is a method, apparatus, technology, computer program product, or system used solely for financial management, to the extent that it is severable from any tax strategy or does not limit the use of any tax strategy by any taxpayer or tax advisor.

(d) RULE OF CONSTRUCTION.—Nothing in this section shall be construed to imply that other business methods are patentable or that other business method patents are valid.

(e) EFFECTIVE DATE; APPLICABILITY.—This section shall take effect on the date of the enactment of this Act [Sept. 16, 2011] and shall apply to any patent application that is pending on, or filed on or after, that date, and to any patent that is issued on or after that date.]

*[*End Editor's Note: Tax Strategies Deemed Within the Prior Art (Sept. 16, 2011)]*

*[*Begin Editor's Note: 35 U.S.C. 103 (Sept. 16, 2012)]*

Effective Sept. 16, 2012, pursuant to the Leahy-Smith America Invents Act, Public Law 112-29, sec. 20(j), 125 Stat. 284, this section is amended by striking "of this title" each place that term appears.

*[*End Editor's Note: 35 U.S.C. 103 (Sept. 16, 2012)]*

*[*Begin Editor's Note: 35 U.S.C. 103 (March 16, 2013)]*

MANUAL OF PATENT EXAMINING PROCEDURE

Effective March 16, 2013, 35 U.S.C. 103 will read as follows, 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 filing date as defined in section 100(i) of title 35, United States Code, that is on or after March 16, 2013 (the effective date described in the Leahy Smith America Invents Act sec. 3); or

(B) a specific reference under section 120, 121, or 365(c) of title 35, United States Code, to any patent or application that contains or contained at any time such a claim.

35 U.S.C. 103

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.

(Amended Nov. 8, 1984, Public Law 98-622, sec. 103, 98 Stat. 3384; Nov. 1, 1995, Public Law 104-41, sec. 1, 109 Stat. 3511; subsection (c) amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-591 (S. 1948 sec. 4807); subsection (c) amended Dec. 10, 2004, Public Law 108-453, sec. 2, 118 Stat. 3596; amended Sept. 16, 2011, Leahy-Smith America Invents Act, Public Law 112-29, sec. 20(j) (effective Sept. 12, 2012) and 3(c) (effective March 16, 2013), 125 Stat. 284.)

*[*End Editor's Note: 35 U.S.C. 103 (March 16, 2013)]*

35 U.S.C. 104

(a) IN GENERAL.—(1) PROCEEDINGS.—In proceedings in the Patent and Trademark Office, in the courts, and before any other competent authority, an applicant for a patent, or a patentee, may not establish a date of invention by reference to knowledge or use thereof, or other activity with respect thereto, in a foreign country other than a NAFTA country or a WTO member country, except as provided in [sections 119](#) and [365](#) of this title.

(2) RIGHTS.—If an invention was made by a person, civil or military—(A) while domiciled in the United States, and serving in any other country in connection with operations by or on behalf of the United States,

(B) while domiciled in a NAFTA country and serving in another country in connection with operations by or on behalf of that NAFTA country, or

(C) while domiciled in a WTO member country and serving in another country in connection with operations by or on behalf of that WTO member country, that person shall be entitled to the same rights of priority in the United States with respect to such invention as if such invention had been made in the United States, that NAFTA country, or that WTO member country, as the case may be.

(3) USE OF INFORMATION.—To the extent that any information in a NAFTA country or a WTO member country concerning knowledge, use, or other activity relevant to proving or disproving a date of invention has not been made available for use in a proceeding in the Patent and Trademark Office, a court, or any other competent authority to the same extent as such information could be made available in the United States, the Director, court, or such other authority shall draw appropriate inferences, or take other action permitted by statute, rule, or regulation, in favor of the party that requested the information in the proceeding.

(b) DEFINITIONS.—As used in this section—(1) The term "NAFTA country" has the meaning given that term in section 2(4) of the North American Free Trade Agreement Implementation Act; and

(2) The term "WTO member country" has the meaning given that term in section 2(10) of the Uruguay Round Agreements Act.

(Amended Jan. 2, 1975, Public Law 93-596, sec. 1, 88 Stat. 1949; Nov. 14, 1975, Public Law 94-131, sec. 6, 89 Stat. 691; Nov. 8, 1984, Public Law 98-622, sec. 403(a), 98 Stat. 3392; Dec. 8, 1993, Public Law 103-182, sec. 331, 107 Stat. 2113; Dec. 8, 1994, Public Law 103-465, sec. 531(a), 108 Stat. 4982; Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 sec. 4732(a)(10)(A)).)

*[*Begin Editor's Note: 35 U.S.C. 104 (Sept. 16, 2012)]*

Effective Sept. 16, 2012, pursuant to the Leahy-Smith America Invents Act, Public Law 112-29, sec. 20(j), 125 Stat. 284, this section is amended by striking "of this title" each place that term appears.

*[*End Editor's Note: 35 U.S.C. 104 (Sept. 16, 2012)]*

*[*Begin Editor's Note: 35 U.S.C. 104 (March 16, 2013)]*

Effective March 16, 2013, 35 U.S.C. 104 is repealed by the Leahy-Smith America Invents Act, Public Law 112-29, sec. 3(d), 125 Stat. 284.

Supporting Material

rejection is based was by a party who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor; (2) the subject matter disclosed had been publicly disclosed by a party who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor before the disclosure of the subject matter on which the rejection is based; or (3) the subject matter disclosed had been publicly disclosed by a party who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor before the date the subject matter in the patent or patent application publication on which the rejection is based was effectively filed.

Proposed 37 CFR 1.130(a)(2) thus provides for an affidavit or declaration to establish that the named inventor or joint inventor is the inventor of the disclosed subject matter, and that the subject matter was communicated by the inventor or a joint inventor to another who disclosed it. Such an affidavit or declaration must show that the inventor or a joint inventor is the inventor of the subject matter of the disclosure (in accordance with proposed 37 CFR 1.130(d)), and indicate the communication of the subject matter by the inventor or a joint inventor to another who disclosed the subject matter. Thus, an applicant may benefit from the earlier disclosure by another during the grace period, if the applicant can establish that the inventor or a joint inventor is the actual inventor of the subject matter of the disclosure and that the subject matter was obtained directly or indirectly from the inventor or a joint inventor. Specifically, the applicant must show that a named inventor actually invented the subject matter of the disclosure.³⁹ The applicant must also show a communication of the subject matter of the disclosure sufficient to enable one of ordinary skill in the art to make the subject matter of the claimed invention.⁴⁰ Any documentation which provides evidence of the communication of the subject matter by the inventor or a joint inventor to the entity that earlier disclosed the subject matter should accompany the affidavit or declaration. This is similar to the current process for disqualifying a publication as being derived from the inventor discussed in MPEP §§ 715.01(c) II and 2137.

³⁹ *In re Fociss*, 408 F.2d 1396, 1407 (CCPA 1969).
⁴⁰ *Gambro Lundin AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 1577 (Fed. Cir. 1997).

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

The AIA in 35 U.S.C. 102(b)(1)(B) provides additional exceptions to the prior art provisions of 35 U.S.C. 102(a)(1). These exceptions disqualify a disclosure that occurs after a public disclosure by the inventor, joint inventor, or another who obtained the subject matter directly or indirectly from the inventor or joint inventor. The provisions of 35 U.S.C. 102(b)(1)(B) indicate that a disclosure which would otherwise qualify as prior art under 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) after a public disclosure of the subject matter of the disclosure which would otherwise qualify as prior art under 35 U.S.C. 102(a)(1) by the inventor or a joint inventor or another who obtained the subject matter directly or indirectly from the inventor or a joint inventor.

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 * * *

"41 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.

Grace period intervening disclosure exception: Under this exception, potential prior art under 35 U.S.C. 102(a)(1) is not prior art if the patent, printed publication, public use, sale, or other means of public availability was made: (1) One year or less before the effective filing date of the claimed invention; and (2) after a "grace period non-inventor disclosure" as those terms have been discussed previously.

An affidavit or declaration under 37 CFR 1.130(a)(1) could be used to establish that the subject matter disclosed had been publicly disclosed by the inventor or a joint inventor before

⁴¹ 35 U.S.C. 102(b)(1)(B).

the disclosure of the subject matter on which the rejection is based. Such an affidavit or declaration under 37 CFR 1.130(a)(1) must establish that the subject matter disclosed in the cited prior art had been publicly disclosed by the inventor or a joint inventor before the disclosure of the subject matter on which the rejection is based.

Specifically, the inventor or joint inventor must establish the date and content of their earlier public disclosure. If the earlier disclosure was a printed publication, the affidavit or declaration must be accompanied by a copy of the printed publication. 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.

Alternatively, as discussed previously, an affidavit or declaration under 37 CFR 1.130(a)(2) could establish that the subject matter disclosed had been publicly disclosed by a party who obtained the subject matter directly or indirectly from the inventor or a joint inventor before the disclosure of the subject matter on which the rejection is based. Such an affidavit or declaration under 37 CFR 1.130(a)(2) must establish 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 or a joint inventor before the disclosure of the subject matter on which the rejection is based. The affidavit or declaration must specifically show that the inventor or a joint inventor is the inventor of the subject matter of the earlier public disclosure and indicate the communication of the subject matter to another who disclosed the subject matter. As discussed previously, this is similar to the current process for disqualifying a publication as being derived from the inventor discussed in MPEP section 2137.

Such an affidavit or declaration under 37 CFR 1.130(a)(2) must also establish the date and content of the earlier public disclosure which was made by another who obtained the subject matter directly or indirectly from the inventor or joint inventor. If the earlier disclosure was a printed publication, the affidavit or declaration must be accompanied by a copy of the printed publication. 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

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, rather than only as of its earliest United States benefit date.

Requirement of "names another inventor": To qualify as prior art under 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" provision of 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 35 U.S.C. 102(a)(2) unless an exception in AIA 35 U.S.C. 102(b)(2) is applicable.

2. Prior Art Exception Under 35 U.S.C. 102(b)(2)(A) to 35 U.S.C. 102(a)(2)

Under 35 U.S.C. 102(b)(2)(A), certain disclosures will not be considered prior art under 35 U.S.C. 102(a)(2) if the disclosure of the subject matter on which the rejection is based was made by another who obtained the subject matter directly or indirectly from the inventor or a joint inventor.

Non-inventor disclosure exception: 35 U.S.C. 102(b)(2)(A) provides that a disclosure which would otherwise qualify as prior art under 35 U.S.C. 102(a)(2) is not prior art if the disclosure was made by another who obtained the subject matter directly or indirectly from the inventor or a joint inventor. This means that if the disclosure of the subject matter upon which the rejection is based is by another who obtained the subject matter from the inventor or joint inventor, then the inventor could provide an affidavit or declaration to establish that the inventor or joint inventor is the inventor of the subject matter of the disclosure and that such subject matter was communicated to the other entity. Thus, an applicant may

benefit from the earlier disclosure by another during the grace period, if the applicant can establish that the inventor or a joint inventor is the actual inventor of the subject matter of the disclosure and that the subject matter was obtained directly or indirectly from the inventor or a joint inventor.

As discussed previously, proposed 37 CFR 1.130(a)(2) provides for an affidavit or declaration to establish that the named inventor or joint inventor is the inventor of the disclosed subject matter, and that the subject matter was communicated by the inventor or a joint inventor to another who disclosed it. Such an affidavit or declaration must show that the inventor or a joint inventor is the inventor of the subject matter of the disclosure and indicate the communication of the subject matter by the inventor or a joint inventor to another who disclosed the subject matter. Specifically, the inventor must show that a named inventor actually invented the subject matter of the disclosure.⁴² The inventor must also show a communication of the subject matter of the disclosure sufficient to enable one of ordinary skill in the art to make the subject matter of the claimed invention.⁴³ Any documentation which provides evidence of the communication of the subject matter by the inventor or a joint inventor to the entity that earlier disclosed the subject matter should accompany the affidavit or declaration. This is similar to the current process for disqualifying a publication as being derived from the inventor discussed in MPEP § 2137.

In circumstances where the claims of the cited prior art, which names another inventor and is a U.S. patent, or U.S. patent application publication, and the claims of the application under examination are directed to the same or substantially the same invention, the Office may require an applicant to file a petition for derivation proceeding pursuant to 37 CFR 41.401 et seq. of this title.

3. Prior Art Exception Under 35 U.S.C. 102(b)(2)(B) to 35 U.S.C. 102(a)(2)

35 U.S.C. 102(b)(2)(B) provides another exception to the prior art provisions of 35 U.S.C. 102(a)(2). Specifically, 35 U.S.C. 102(b)(2)(B) indicates that certain disclosures are not prior art if the disclosure of the subject matter of the claimed invention to be disqualified was made after a disclosure of the subject matter by the inventor or a joint inventor or after a disclosure of

the subject matter by another who obtained the subject matter directly or indirectly from the inventor or joint inventor. In other words, an inventor, joint inventor, or someone who obtained the subject matter directly or indirectly from the inventor or joint inventor, disclosed the subject matter before the disclosure of the subject matter on which the rejection is based.

As discussed previously with respect to 35 U.S.C. 102(b)(1)(B), the exception in 35 U.S.C. 102(b)(2)(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 or obvious insubstantial changes, or only trivial or obvious variations, the exception under 35 U.S.C. 102(b)(2)(B) does not apply.

Intervening disclosure: Under this exception, potential prior art under 35 U.S.C. 102(a)(2) is not prior art if the U.S. patent, U.S. patent application publication, or WIPO published application was effectively filed after the subject matter was first disclosed by the inventor, a joint inventor, or another who obtained it directly or indirectly from the inventor or joint inventor.

As discussed previously, an affidavit or declaration under 37 CFR 1.130(a)(1) could be used to establish that the subject matter disclosed in the cited patent or published application to be disqualified had been publicly disclosed by the inventor or a joint inventor before the date the subject matter in the patent or published application to be disqualified was made after a disclosure of the subject matter by the inventor or joint inventor.

Specifically, the inventor or joint inventor must establish the date and content of their earlier public disclosure. If the earlier disclosure was a printed publication, the affidavit or declaration must be accompanied by a copy of the printed publication. 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.

Alternatively, also as discussed previously, an affidavit or declaration under 37 CFR 1.130(a)(2) could establish that the subject matter

⁴² *In re Fociss*, 408 F.2d 1396, 1407 (CCPA 1969).
⁴³ *Gambro Lundin AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 1577 (Fed. Cir. 1997).

⁴⁴ 35 U.S.C. 102(b)(2)(B).