

Strategies For Applications Being Currently Written In View of AIA Final Examination Guidelines

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AIA Statutory Framework

(Slide Prepared by USPTO)

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

Prior Art Statute

- **35 U.S.C. 102**
- (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.

Exceptions to Prior Art Statute

- 102(b)(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.

Exceptions to Prior Art Statute

- 102(b)(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.

Burden of Unpatentability Still Rests on the Office

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

What is AIA Prior Art?

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

Pre-AIA vs. AIA

- No requirement of “by others” in the AIA. A key difference between pre-AIA 35 U.S.C. 102(a) and AIA 35 U.S.C. 102(a)(1) is the requirement in pre-AIA 35 U.S.C. 102(a) that the prior art relied on was “by others.” Under AIA 35 U.S.C. 102(a)(1), there is no requirement that the prior art relied upon be by others.
- Under the AIA, the availability of a disclosure as prior art is measured from the “effective filing date” of the claimed invention no matter where that filing occurred.
- The AIA adopts a global view of prior art disclosures and thus does not require that a public use or sale activity be “in this country” to be a prior art activity.
- Finally, a catch-all “otherwise available to the public” category of prior art is added by the AIA.

102(a)(2): US Patents Only

- "a patent issued under section 151"; a US Patent.
- "application for patent" that is "published . . . under section 122(b)"; U.S. patent application publication (PGPub).
- "application for patent" that is "deemed published under section 122(b)" (see 35 U.S.C. 374); WIPO published PCT (international) applications that designate the United States.
 - A WIPO published PCT application must have designated the United States in order to be 102(a)(2) prior art. PCT applications filed on or after January 1, 2004 automatically designate the United States.
 - There is no requirement that the WIPO published PCT application have been filed on or after November 29, 2000, or have been published in English. This is a distinction from pre-AIA 102(e).
- This means that foreign patent documents (for example, JP or GB patents or published applications) cannot be prior art as of their filing date under 102(a)(2). However, they are printed publication prior art under 102(a)(1).

102(a)(2) “Names Another Inventor”

- 102(a)(2) allows the filing date of a patent application to be used so long as that patent application “names another inventor.” To the contrary, 102(a)(1) would look to the publication date if the exact same inventors are named.
- Thus, to qualify as a patent or patent publication prior art under AIA 35 U.S.C. 102(a)(2), the prior art U.S. patent, U.S. patent application publication, or WIPO published application must “name[s] another inventor.”
- **Only one inventor needs to be different for the inventive entities to be different.**
- This means that if there is **any** difference in inventive entity between the prior art U.S. patent, U.S. patent application publication, or WIPO published application and the application under examination or patent under reexamination, the U.S. patent, U.S. patent application publication, or WIPO published application satisfies the “names another inventor” requirement of AIA 35 U.S.C. 102(a)(2).

Description of Prior Art

“Public Use”

- Under **pre-AIA 35 U.S.C. 102(b)** an invention is “in public use” only if such public use occurred “in this country.”
- Under **AIA 35 U.S.C. 102(a)(1)**, there is no geographic limitation on where prior public use or public availability occurs.
- **Public use** under AIA 35 U.S.C. 102(a)(1) is limited to those uses that are available to the public. The public use provision of AIA 35 U.S.C. 102(a)(1) thus has the same substantive scope, with respect to uses by either the inventor or a third party, as public uses under pre-AIA 35 U.S.C. 102(b) and by unrelated third parties or uses by others under pre-AIA 35 U.S.C. 102(a).
- Furthermore, a public use would need to occur before the effective filing date of the claimed invention to constitute prior art under AIA 35 U.S.C. 102(a)(1).

Description of Prior Art “On Sale”

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

Description of Prior Art “Otherwise Available”

- The AIA 35 U.S.C. 102(a)(1) provides a “catch-all” provision, which defines a new additional category of potential prior art not provided for in pre-AIA 35 U.S.C. 102 with the phrase “or otherwise available to the public.”
- This “catch-all” provision permits decision makers to focus on whether the disclosure was “available to the public,” rather than on the means by which the claimed invention became available to the public or on whether a disclosure constitutes a “printed publication” or falls within another category of prior art as defined in AIA 35 U.S.C. 102(a)(1).

Description of Prior Art “Otherwise Available”

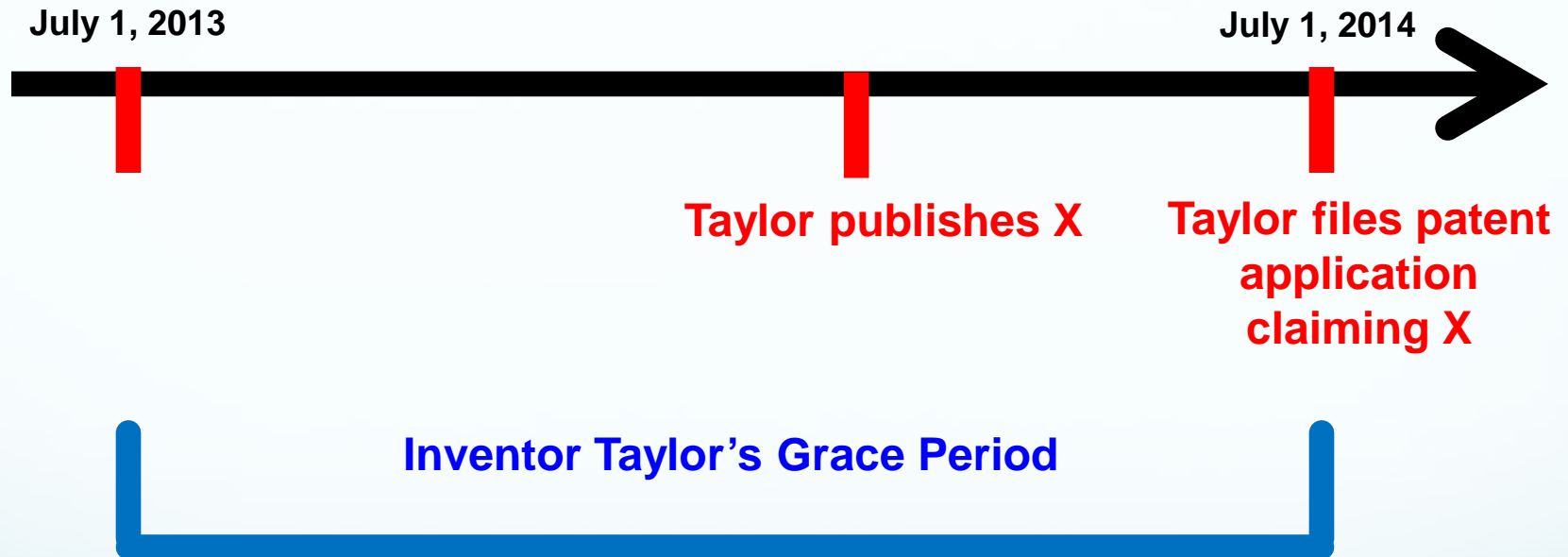
- Examples listed in the Examination Guidelines include student thesis, a poster display, information disseminated at a scientific meeting, subject matter in a laid-open patent application, a document electronically posted on the Internet, or a commercial transaction that does not constitute a sale under the Uniform Commercial Code.
- 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”

102(b) “Disclosure” Exceptions

- The AIA does not define the term “disclosure,” and AIA 35 U.S.C. 102(a) does not use the term “disclosure.”
- The Final Examination Rules state that the Office is treating the term “disclosure” as a generic expression intended to encompass the documents and activities enumerated in AIA 35 U.S.C. 102(a) (i.e., being patented, described in a printed publication, in public use, on sale, or otherwise available to the public, or being described in a U.S. patent, U.S. patent application publication, or WIPO published application).
- However, there is no statutory or legal precedent for this position, and the “exceptions” to prior art under 102(b) may not actually be as projected until a court actually rules on what the term “disclosure” means.
- Therefore, it is advisable to file all applications as quickly as possible to avoid undesirable consequences if the term “disclosure” in 102(b) is not considered to be a generic expression intended to encompass the documents and activities enumerated in AIA 35 U.S.C. 102(a).

Example 1: Exception in 102(b)(1)(A) (Slide

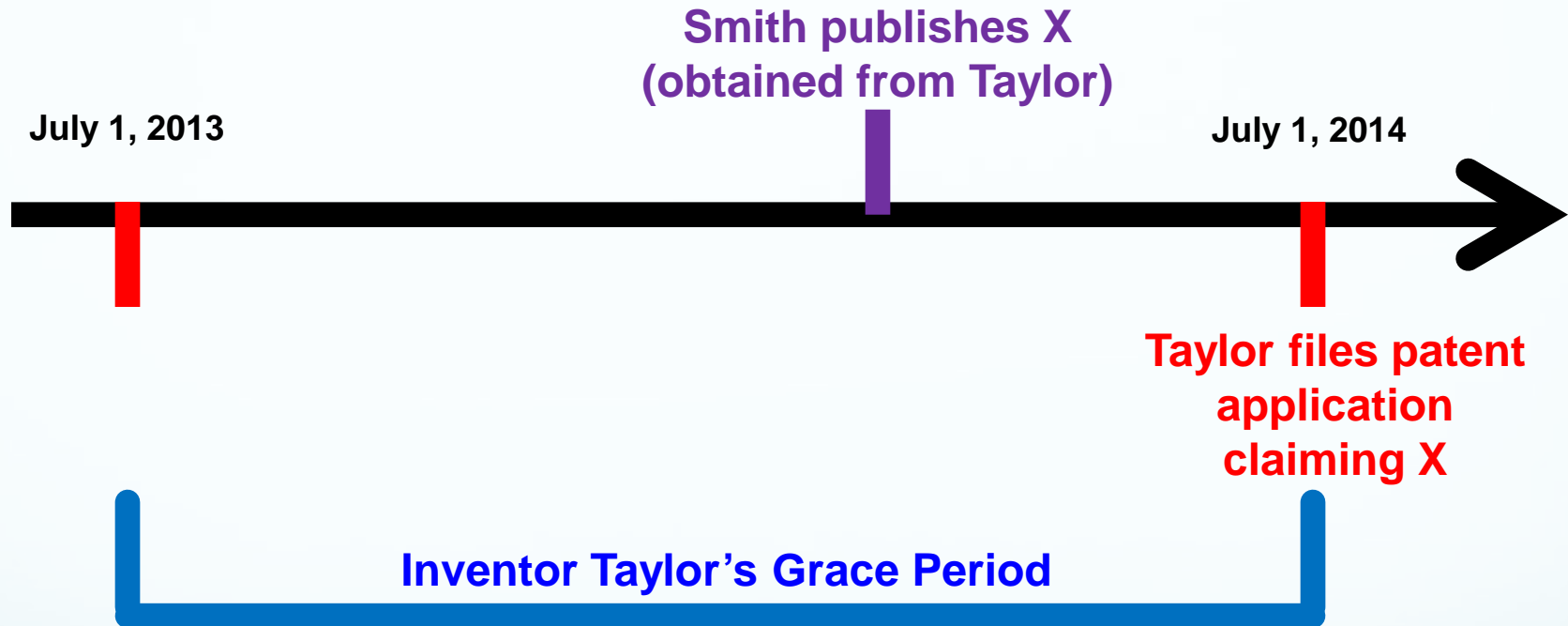
Prepared by USPTO)



- Taylor's publication is not available as prior art against Taylor's application because of the exception under 102(b)(1)(A) for a grace period disclosure by an inventor.

Example 2: Exception in 102(b)(1)(A) (Slide

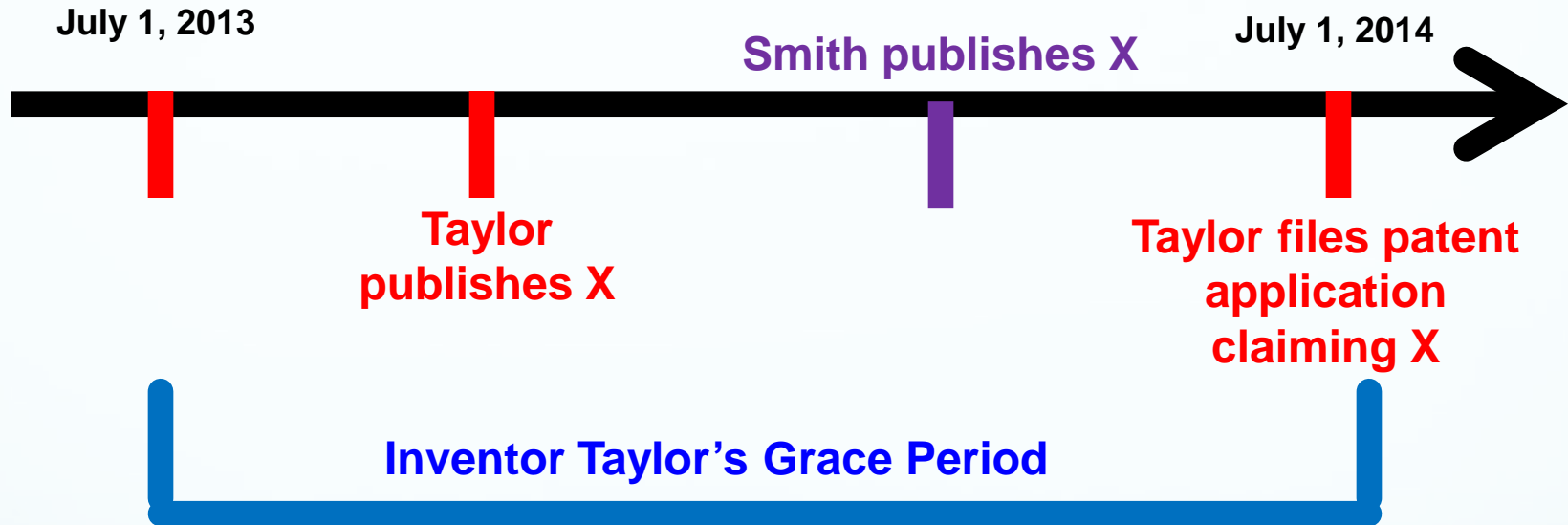
Prepared by USPTO)



- If Smith obtained subject matter X from Taylor, then it falls into the 102(b)(1)(A) exception as a grace period disclosure obtained from the inventor, and is not prior art to Taylor.

Example 3: Exception in 102(b)(1)(B)

(Slide Prepared by USPTO)



- Taylor's publication is not prior art because of the exception under 102(b)(1)(A) for a grace period disclosure by the inventor.
- Smith's publication is not prior art because of the exception under 102(b)(1)(B) for a grace period intervening disclosure by a third party.

Example 4: Exception in 102(b)(2)(A)

(Slide Prepared by USPTO)

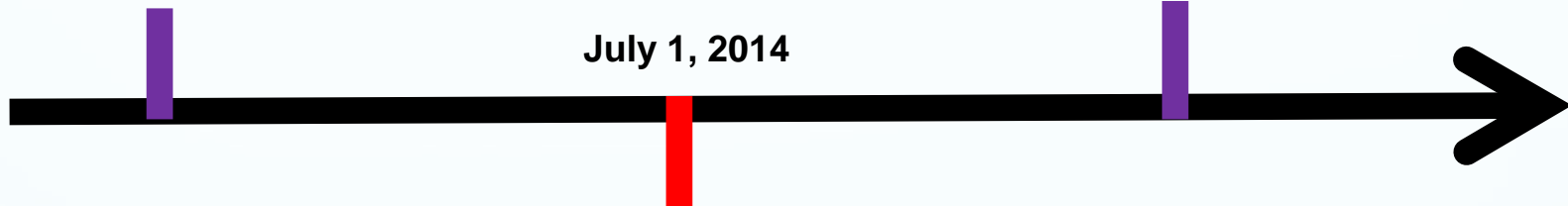
Smith files patent application disclosing X (obtained from Taylor)

April 1, 2014

July 1, 2014

Smith's application publishes

October 1, 2015

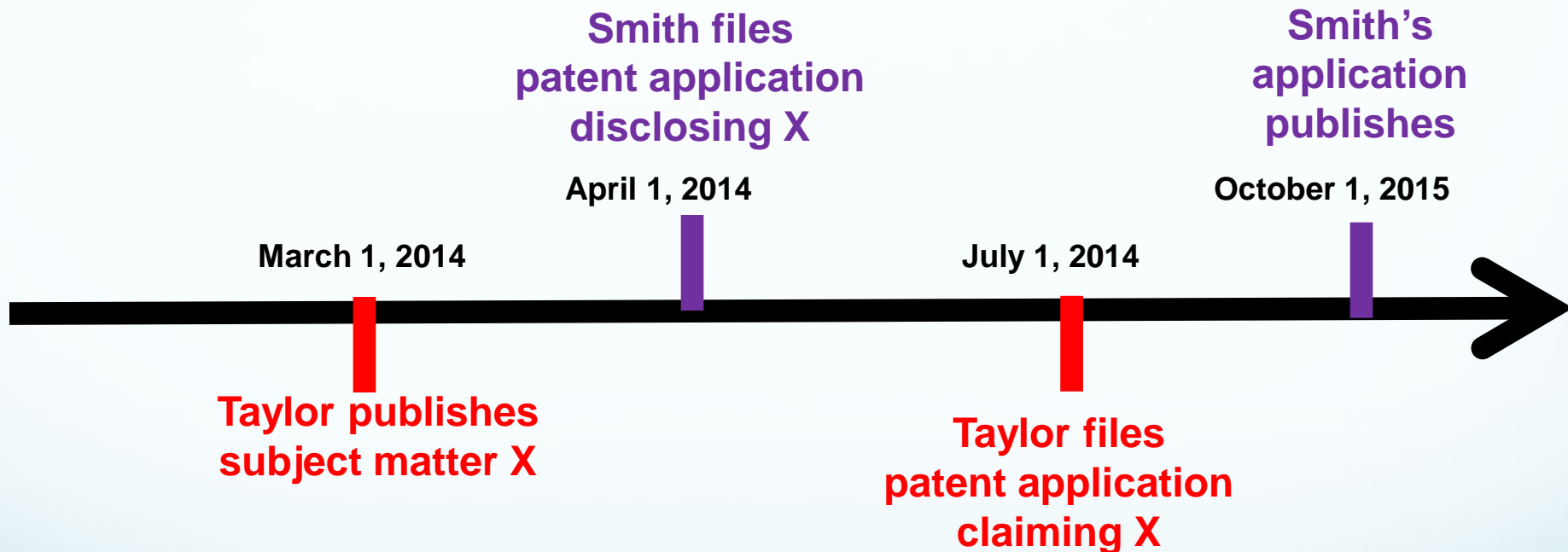


Taylor files patent application claiming X

- Smith's patent application publication is not prior art against Taylor's application because Smith obtained X from Taylor, 102(b)(2)(A).

Example 5: Exception in 102(b)(2)(B) (Slide

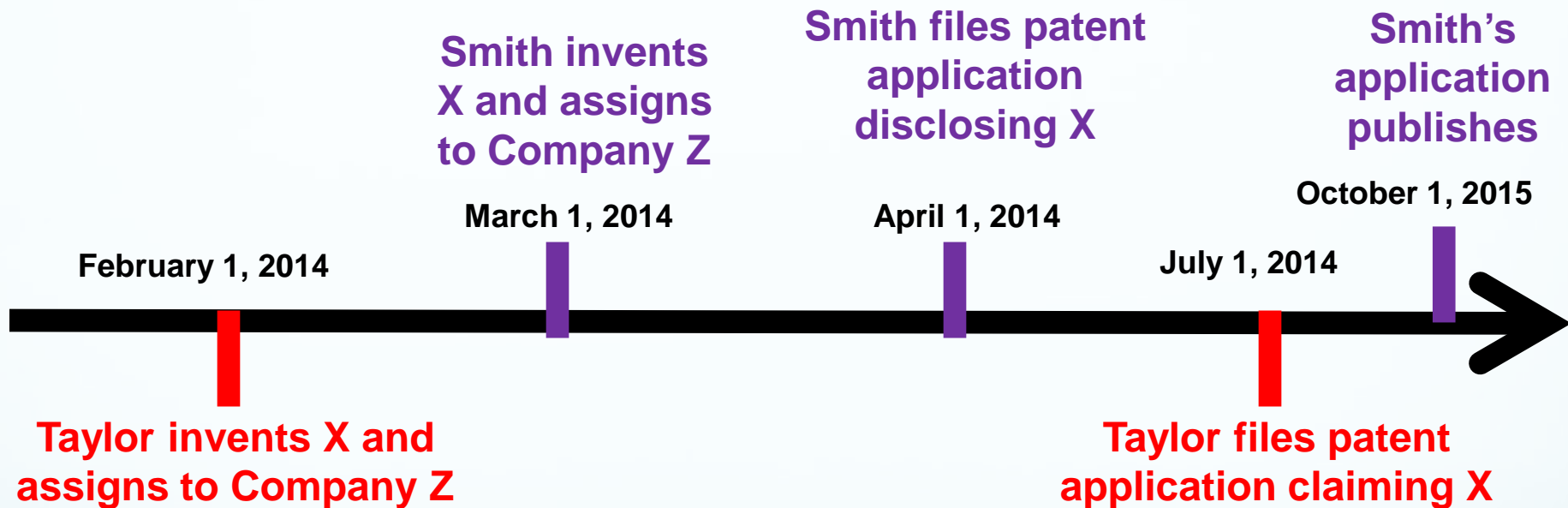
Prepared by USPTO)



- Smith's patent application publication is not prior art against Taylor's application because of the exception under 102(b)(2)(B) for an intervening disclosure by a third party.

Example 6: Exception in 102(b)(2)(C)

(Slide Prepared by USPTO)



- Smith's patent application publication is not prior art because of the exception under 102(b)(2)(C) for a commonly owned disclosure.
- There is no requirement that Smith's and Taylor's subject matter be the same in order for the common ownership exception to apply.

Guidelines on The 102(b)(1) Prior Art Exceptions

- The one-year grace period in AIA 35 U.S.C. 102(b)(1) is measured from the filing date of the earliest U.S. or foreign patent application to which a proper benefit or priority claim as to such invention has been asserted in the patent or application.
- To the contrary, the pre-AIA one-year grace period in pre-AIA 35 U.S.C. 102(b) is measured from only the filing date of the earliest application filed in the United States (directly or through the PCT).

102(b)(1) vs. 102(b)(2)

- 102(b)(2)(A) and (B) exceptions use the same logic as 102(b)(1)(A) and (B) regarding another “who obtained the subject matter” from the inventors and similarly applies the prior art exceptions.
- In both cases affidavits and declarations can be used during prosecution to show that the subject matter was obtained from the inventor (Rule 1.130)
- Note that affidavits and declarations are not available where the Office considers that a derivation proceeding is the correct vehicle for resolving the issue.

Guidelines on The 102(b)(1) Prior Art Exceptions

- In circumstances where an application names additional persons as inventors relative to the persons named as authors in the publication (e.g., the application names as inventors A, B, and C, and the publication names as authors A and B), and the publication is one year or less before the effective filing date, it is apparent that the disclosure is a grace period inventor disclosure, and the publication would not be treated as prior art under AIA 35 U.S.C. 102(a)(1).
- If, however, the application names fewer inventors than a publication (e.g., the application names as inventors A and B, and the publication names as authors A, B and C), it would not be readily apparent from the publication that it is by the inventor or a joint inventor and the publication would be treated as prior art under AIA 35 U.S.C. 102(a)(1).

Prior Art Exceptions

Intervening Disclosures

- For example, the inventor or a joint inventor had publicly disclosed elements A, B, and C, and a subsequent intervening grace period disclosure discloses elements A, B, C, and D, then only element D of the intervening grace period disclosure is available as prior art under AIA 35 U.S.C. 102(a)(1).
- In addition, if subject matter of an intervening grace period disclosure is simply a more general description of the subject matter previously publicly disclosed by the inventor or a joint inventor, the exception in AIA 35 U.S.C. 102(b)(1)(B) applies to such subject matter of the intervening grace period disclosure.

Prior Art Exceptions

Intervening Disclosures

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

Prior Art Exceptions

Intervening Disclosures

- Finally, AIA 35 U.S.C. 102(b)(1)(B) does not discuss “the claimed invention” with respect to either the subject matter disclosed by the inventor or a joint inventor, or the subject matter of the subsequent intervening grace period disclosure.
- Thus, a determination of whether the exception in AIA 35 U.S.C. 102(b)(1)(B) is applicable to subject matter in an intervening grace period disclosure does not involve a comparison of the subject matter of the claimed invention to either the subject matter disclosed by the inventor or a joint inventor, or to the subject matter of the subsequent intervening grace period disclosure.
- Therefore, the analysis is made on the disclosures, not the claims.

Intervening Disclosures and “Insubstantial Changes”

- One issue that had raised concern with the **proposed guidelines** was the statement that the exceptions in AIA 35 U.S.C. 102(b)(1)(B) and 102(b)(2)(B) do not apply even if the only differences between the subject matter in the prior art disclosure that is relied upon under AIA 35 U.S.C. 102(a) and the subject matter previously publicly disclosed by the inventor are mere insubstantial changes, or only trivial or obvious variations. See *Examination Guidelines for Implementing the First Inventor To File Provisions of the Leahy-Smith America Invents Act*, 77 FR at 43767 and 43769.
- The examination guidelines maintain the identical subject matter interpretation of AIA 35 U.S.C. 102(b)(1)(B) and 102(b)(2)(B). However, these examination guidelines also clarify that there is no requirement that the mode of disclosure by an inventor or joint inventor (e.g., publication, public use, sale activity) be the same as the mode of disclosure of the intervening disclosure, and also does **not require that the disclosure by the inventor or a joint inventor be a verbatim or *ipsissimis verbis* disclosure of the intervening disclosure.**
- In addition, these examination guidelines also clarify that if subject matter of the intervening disclosure is simply a more general description of the subject matter previously publicly disclosed by the inventor or a joint inventor, the exception in AIA 35 U.S.C. 102(b)(1)(B) applies to such subject matter of the intervening disclosure.

Commonly Assigned Patent Applications Under 102(b)(2)(C)

- 102(b)(2)(C) excepts commonly assigned patent applications from 102(a)(2). Again, 102(a)(2) looks to filing dates of patents.
- Therefore, only 102(a)(1) will apply to commonly assigned patent applications restricting their prior art date to their first publication date (not their first filing date).
- Further, the one-year grace period under 102(b)(1) could be used in combination with 102(b)(2)(C) for a commonly assigned patent or patent publication to add the one-year grace period to the publication date, if that previous commonly assigned application was obtained from the inventor.
- For example, if the inventors are the same on a commonly assigned application, the patent publication would only be prior art one year after the first publication date.

Commonly Assigned Patent Applications Under 102(b)(2)(C)

- Consider Non-Publication Requests for commonly assigned patents to take full advantage of 102(b)(2)(C).
- Since 102(b)(2)(C) excepts all commonly assigned patent applications until publication, if they do not publish until issuance, they will be excepted longer than if they publish at 18 months.
- If an applicant filed a non-publication request and later decides to file a counterpart foreign or international application in another country, the applicant can rescind the non-publication.

Commonly Assigned Patent Applications Under 102(b)(2)(C)

- 37 C.F.R. 1.213 Non-publication request. (a) If the invention disclosed in an application has not been and will not be the subject of an application filed in another country, or under a multilateral international agreement, that requires publication of applications eighteen months after filing, the application will not be published under 35 U.S.C. 122(b) and § 1.211 provided:
 - (1) A request (non-publication request) is submitted with the application upon filing;
 - (2) The request states in a conspicuous manner that the application is not to be published under 35 U.S.C. 122(b);
 - (3) The request contains a certification that the invention disclosed in the application has not been and will not be the subject of an application filed in another country, or under a multilateral international agreement, that requires publication at eighteen months after filing; and
 - (4) The request is signed in compliance with § 1.33(b).

Commonly Assigned Patent Applications Under 102(b)(2)(C)

- If applicant filed a non-publication request and later decides to file a counterpart foreign or international application in another country, or under a multilateral agreement, that requires eighteen-month publication, applicant must either:
 - (1) rescind the non-publication request before filing such foreign or international application; or
 - (2) notify the Office of such filing no later than 45 days after the filing date of the counterpart foreign or international application. See MPEP §§ 1123 and 1124.
- The applicant must have an affirmative intent not to file a counterpart application, and not just the absence of any intent or plan concerning the filing of any counterpart application that would be subject to eighteen-month publication. MPEP § 1122

Commonly Assigned Patent Applications Under 102(b)(2)(C)

- Even if the U.S. patent or U.S. published application is not prior art under AIA 35 U.S.C. 102 or 103 as a result of AIA 35 U.S.C. 102(b)(2)(C), a double patenting rejection (either statutory under 35 U.S.C. 101 or non-statutory, sometimes called obviousness-type) may still be made on the basis of the U.S. patent or U.S. patent application publication.
- A patent or published application that does not qualify as prior art as a result of AIA 35 U.S.C. 102(b)(2)(C) may be cited, in appropriate situations, to indicate the state of the art when making a lack of enablement rejection under 35 U.S.C. 112(a).

102(b)(2)(C) Broader Than Pre-AIA 103(c)

- If the provisions of AIA 35 U.S.C. 102(b)(2)(C) are met, a patent or patent publication that might otherwise qualify as prior art under AIA 35 U.S.C. 102(a)(2) is not available as prior art under either AIA 35 U.S.C. 102 or 103.
- To the contrary, under pre-AIA 35 U.S.C. 103(c), such is prior art pre-AIA 35 U.S.C. 102, even if the conditions of pre-AIA 35 U.S.C. 103(c) are met.

Joint Research Agreement Statute

- 102(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.

Earliest Filing Date Statute

- 102(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.

102(d) Earliest Filing Date

Hilmer doctrine

- The AIA eliminates the so-called *Hilmer* doctrine.
- Under the *Hilmer* doctrine, pre-AIA 35 U.S.C. 102(e) limited the effective filing date for U.S. patents (and published applications) as prior art to their earliest U.S. filing date.
- In contrast, AIA 35 U.S.C. 102(d) provides that if the U.S. patent, U.S. patent application publication, or WIPO published application claims priority to one or more prior-filed foreign or international applications under 35 U.S.C. 119 or 365, the patent or published application was effectively filed on the filing date of the earliest such application that describes the subject matter.

102(d) Earliest Filing Date

- 35 U.S.C. 102(d) looks to the earliest filing date just “if the patent or application for patent is entitled to claim a right of priority,” not if it actually did claim priority.
- Thus, the AIA only requires merely being entitled to claim priority to, or the benefit of, a prior-filed application in the definition.
- Therefore, if the subject matter relied upon is described in the application to which there is a priority or benefit claim, a U.S. patent, a U.S. patent application publication, or WIPO published application is effective as prior art as of the filing date of the earliest such application, regardless of where filed.

Obviousness Statute

- 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.

35 U.S.C. 103

- The most significant difference between the AIA 35 U.S.C. 103 and pre- AIA 35 U.S.C. 103(a) is that AIA 35 U.S.C. 103 determines obviousness as of the effective filing date of the claimed invention, rather than as of the time that the claimed invention was made.
- Next, AIA 35 U.S.C. 103 differs from that of pre-AIA 35 U.S.C. 103 in that AIA 35 U.S.C. 103 requires consideration of “the differences between the claimed invention and the prior art,” while pre-AIA 35 U.S.C. 103 refers to “the differences between the subject matter sought to be patented and the prior art.” However, the Final Rules state that this difference in terminology does not indicate the need for any difference in approach to the question of obviousness.

Certified Copy of Foreign Priority Application

- To take advantage of the new definition of “effective filing date” which includes a foreign filing date, applicant must:
 - claim foreign priority within the later of:
 - 4 months from the actual filing date of the application; or
 - 16 months from the filing date of the foreign priority applicationand
 - include the foreign priority in an application data sheet (ADS).
- See Rule 1.55(a), (b), (d), and (e).
- Foreign priority claimed is waived if omitted from the ADS.
- Unintentionally delayed claim may be accepted by petition.

Certified Copy of Foreign Priority Application

- The time period for filing a certified copy of a foreign priority application. In response to public comments stating that the USPTO should consider alternative means of ensuring that a copy of any priority application is available, the USPTO is requiring in the final rule that the requirement to file a certified copy of any foreign priority application by the date that is the later of four months from the US application filing date or 16 months from the foreign priority application filing date **does not apply** if either:
 - the foreign application was filed in a foreign intellectual property office participating with the USPTO in a bilateral or multilateral priority document exchange agreement (participating foreign intellectual property office); or
 - a copy of the foreign application was filed in an application subsequently filed in a participating foreign intellectual property office that permits the USPTO to obtain such a copy, and the applicant timely requests in a separate document that the USPTO retrieve such copy from the participating intellectual property office.

Transitional Applications

- Statements identifying transitional applications are required for nonprovisional applications claiming priority to or the benefit of an application filed before March 16, 2013 (see Rule 1.55(j), 1.78(a)(6), or 1.78(c)(6)).
- In the final rule, the USPTO provides that a statement is only required if a transition application contains (or contained at any time) a claim to a claimed invention that has an effective filing date on or after March 16, 2013.

AIA Applied to Entire Application

- As under pre-AIA law, the effective filing date of a claimed invention is determined on a claim-by-claim basis and not an application-by-application basis. That is, the principle that different claims in the same application may be entitled to different effective filing dates vis-a`-vis the prior art remains unchanged by the AIA.
- However, it is important to note that although prior art is applied on a claim-by-claim basis, the determination of whether pre-AIA 35 U.S.C. 102 and 103 or AIA 35 U.S.C. 102 and 103 apply is made on an application-by-application basis.
- The specific rule is: that the AIA 35 U.S.C. 102 and 103 apply to any patent application that contains or contained at any time a claim to a claimed invention that has an effective filing date that is on or after March 16, 2013.
- Pair and Office Communications will indicate if the application is being examined under AIA.

Summarized Strategies For Applications Being Currently Written

- Consider all items as potential prior art regardless of date or form, because anything can be used to show the invention was available to the public before the filing date. No geographic limits, no “by another” requirements, post-filing date items can show that the invention was available to the public before the filing date, etc. (102(a)(1)).
- When writing non-commonly assigned applications within the 18-months before publication period of a previously filed application, try to name the exact same inventors if that previous application would cause prior art problems. Do so because when looking back to the filing dates of patents and patent publications, only one inventor needs to be different for the inventive entities to be different and for the patent or patent publication to be prior art (102(a)(2)).
- If the inventors cannot be made the same, later arguments can be made under 102(b)(2) that the patent or patent publication was obtained from the inventor.

Summarized Strategies For Applications Being Currently Written

- Try to file closely related, commonly assigned applications before the 18-month publication date of previous applications. Commonly assigned prior patent applications that have not yet published will only be prior art as of their publication date, and not their effective filing date (102(b)(2)(C)).
- Prepare declarations and affidavits showing that the author of the other publication obtained the subject matter from the inventor to take advantage of 102(b) (preferably when drafting the application, even if they are never used).
- For example, the one-year grace period prior art exception under 102(b)(1) could be used in combination with 102(b)(2)(C) for commonly assigned patents or patent publications to add the one-year grace period to the publication date of the patent or patent publication, if that previous commonly assigned application was obtained from the inventor.

Summarized Strategies For Applications Being Currently Written

- If a paper or other disclosure is published within 1 year before filing, it is preferable that all authors of that disclosure be inventors (adjust claims accordingly). There can be more inventors than just the authors, but at least all authors should be inventors so that 102(b)(1) can be used for the one-year exception to 102(a)(1).
- If it is not possible to name all authors as inventors, prepare declarations showing that the publication obtained the subject matter from the inventor (again, preferably when drafting the application).

Summarized Strategies For Applications Being Currently Written

- Try to file all applications as quickly as possible to avoid undesirable consequences if the term “disclosure” in 102(b) is not considered to be all encompassing of every item listed in 102(a).
- Similarly, file as quickly as possible after an inventor disclosure in case the “insubstantial changes” of an intervening disclosure are interpreted by a court to be more narrow than the Patent Office proposes.
- Keep inventor notebooks to later prove who was the true source of the invention and when they were to take advantage of the 102(b) exceptions.

Summarized Strategies For Applications Being Currently Written

- Consider Non-Publication Requests for commonly assigned patents to take full advantage of 102(b)(2)(C). Since 102(b)(2)(C) excepts all commonly assigned patent applications until publication, if they do not publish until issuance, they will be excepted longer than if they publish at 18 months.
- The applicant can rescind the non-publication later, if they decide to file a counterpart foreign or international application.

If There is Time . . .

- Some terminology and slides from the Patent Office

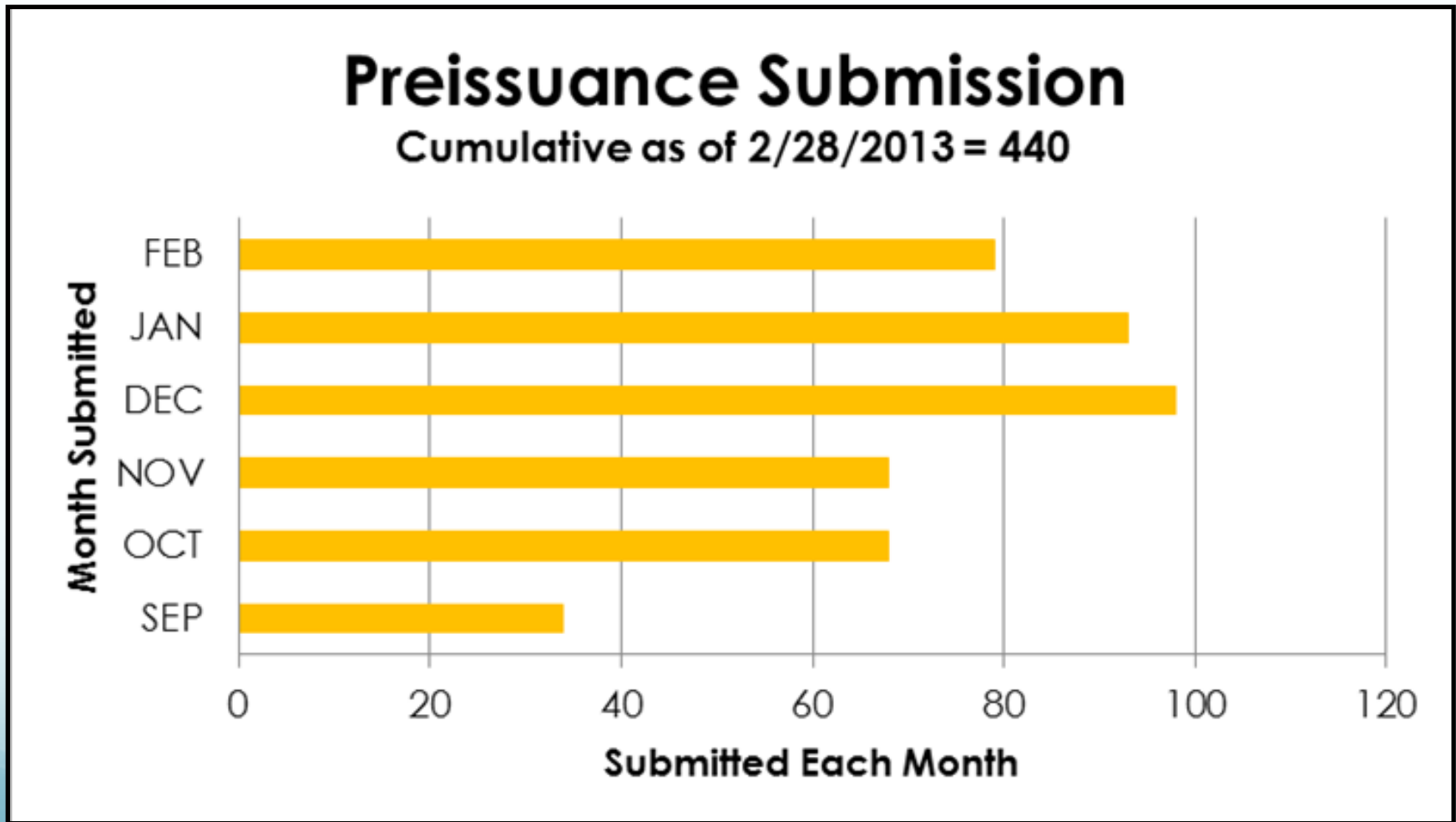
Terminology Reminder

- **AIA:** America Invents Act (Public Law 112–29)
- **Derivation Proceedings:** A derivation proceeding is a new trial proceeding conducted at the Board. An applicant may institute a derivation proceeding only within 1 year of the first publication of a claim to an invention that is the same or substantially the same as an earlier application's claim (for post 3-16-13 AIA applications).
- **Inter Partes Review (IPR):** Inter partes review replaces inter partes reexamination as an avenue for a third party's patentability challenge. Ex parte reexamination remains unchanged.
- **Post-Grant Review (PGR):** A person who is not the patent owner and has not previously filed a civil action can request review on or prior to the date that is 9 months after the grant of a patent or issuance of a reissue patent. With limited exceptions, applies only those patents issuing from post 3-16-13 AIA applications.
- **Preissuance Submission:** Submission of prior art in a patent application by a third party (35 U.S.C. 122(e)).
- **Prioritized Examination:** The application will be accorded special status during prosecution before the patent examiner
- **Supplemental Examination:** Issued patent owner request to reconsider or correct information (35 U.S.C. 257). The Patent Owner can submit missing art and have it considered, so long as no lawsuits (inequitable conduct) have been started.
- **Covered Business Method Review:** Request to determine whether there is patentable subject matter in covered business patents claiming activities that are financial in nature, incidental to a financial activity or complementary to a financial activity and not a technological innovation. A covered business method review may be requested except during the period in which a petition for post-grant review could be filed, e.g., 9 months after the issuance of a patent.

Preissuance Submissions

(Data from Sept 16, 2012 to Feb 28, 2013)

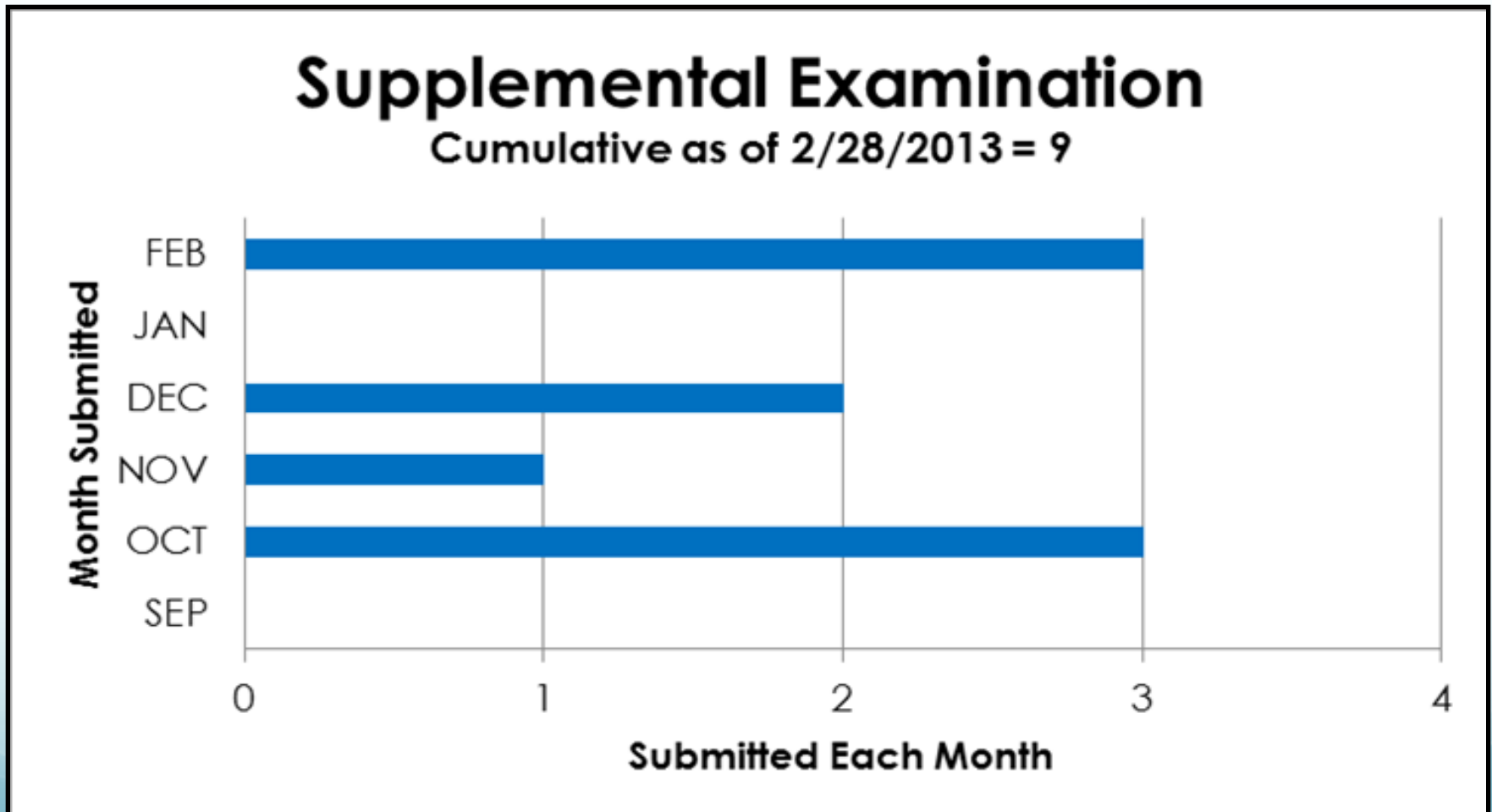
http://www.uspto.gov/aia_implementation/statistics.jsp



Supplemental Examination

(Data from Sept 16, 2012 to Feb 28, 2013)

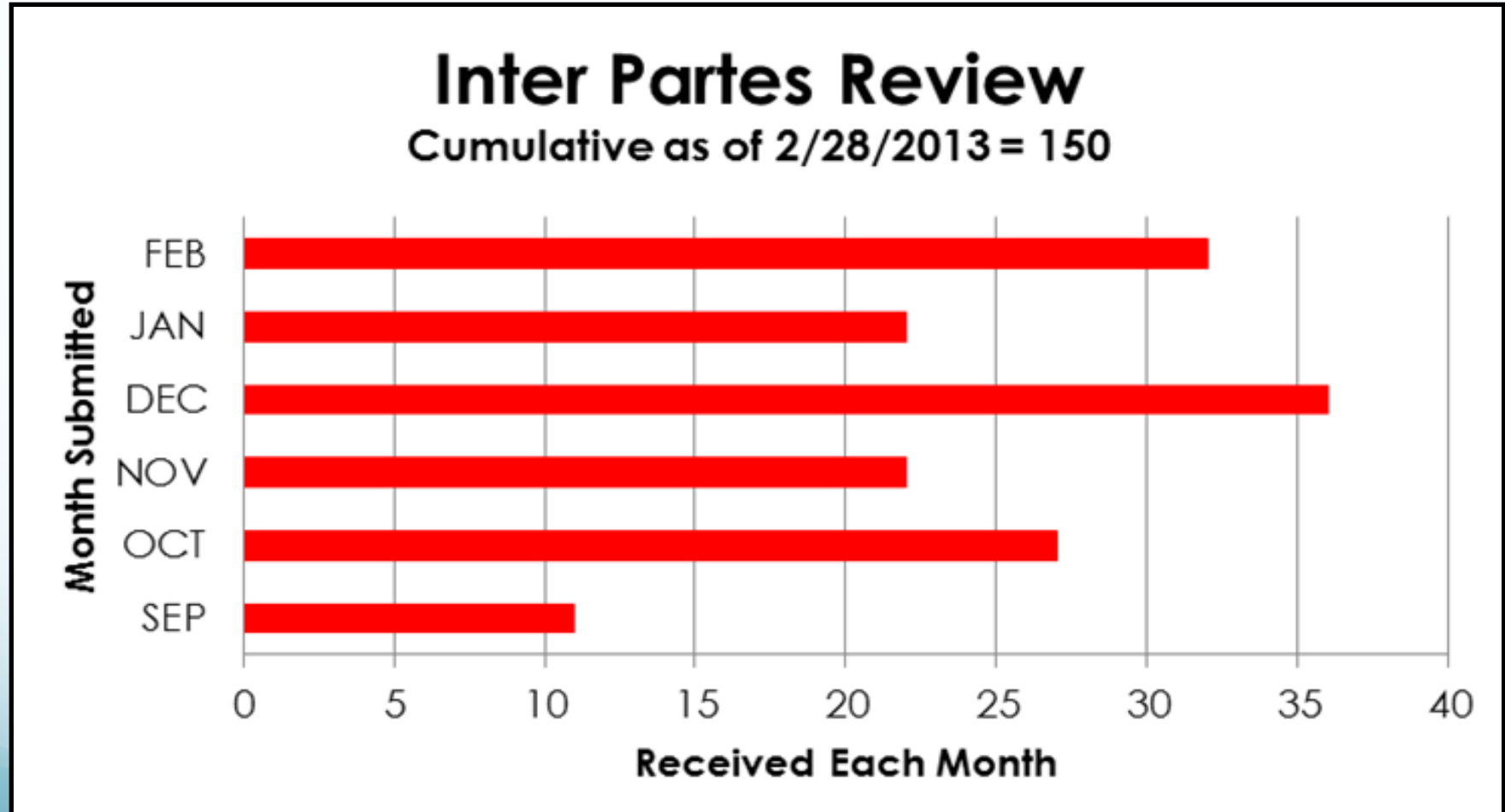
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Inter Partes Review

(Data from Sept 16, 2012 to Feb 28, 2013)

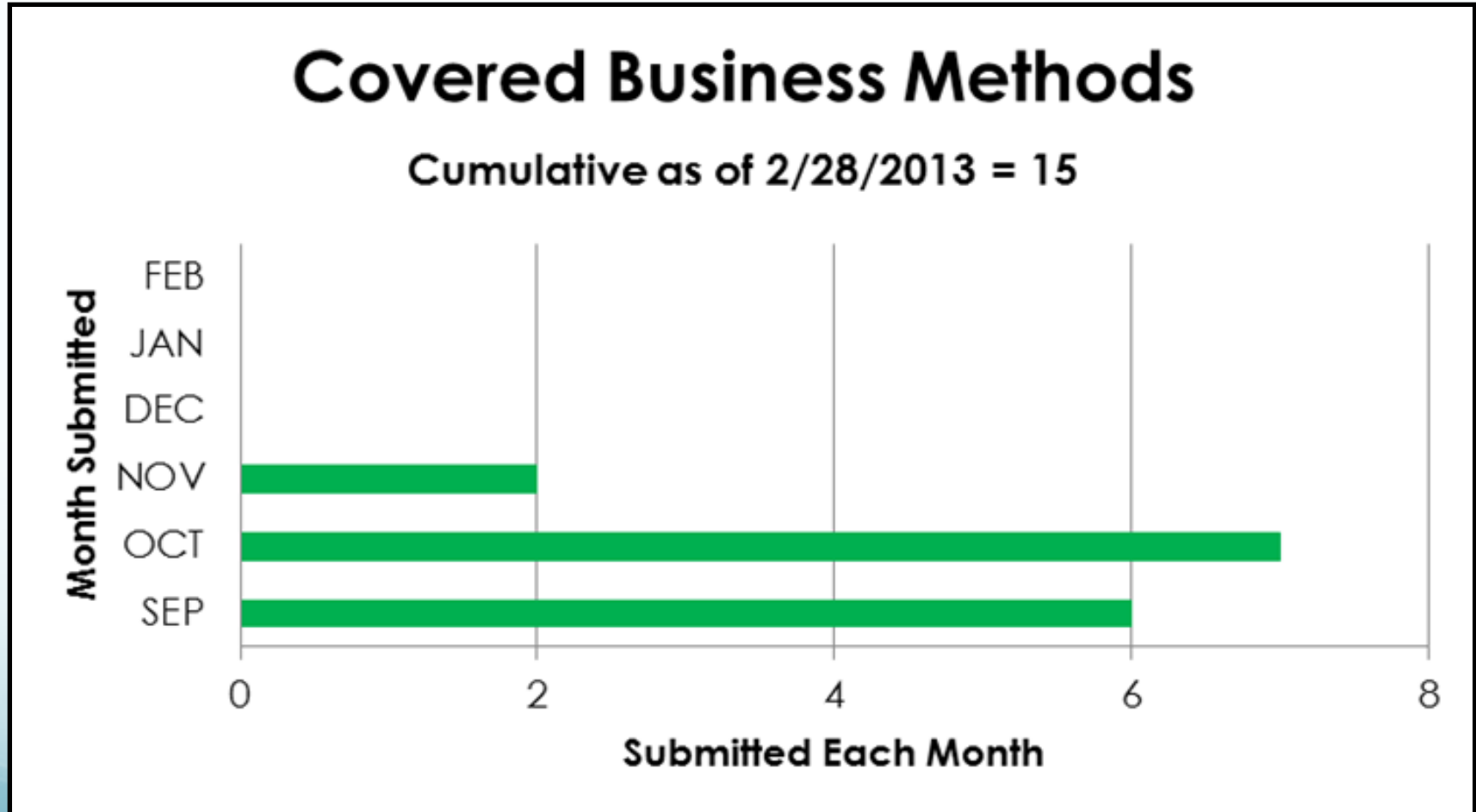
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Covered Business Method Review

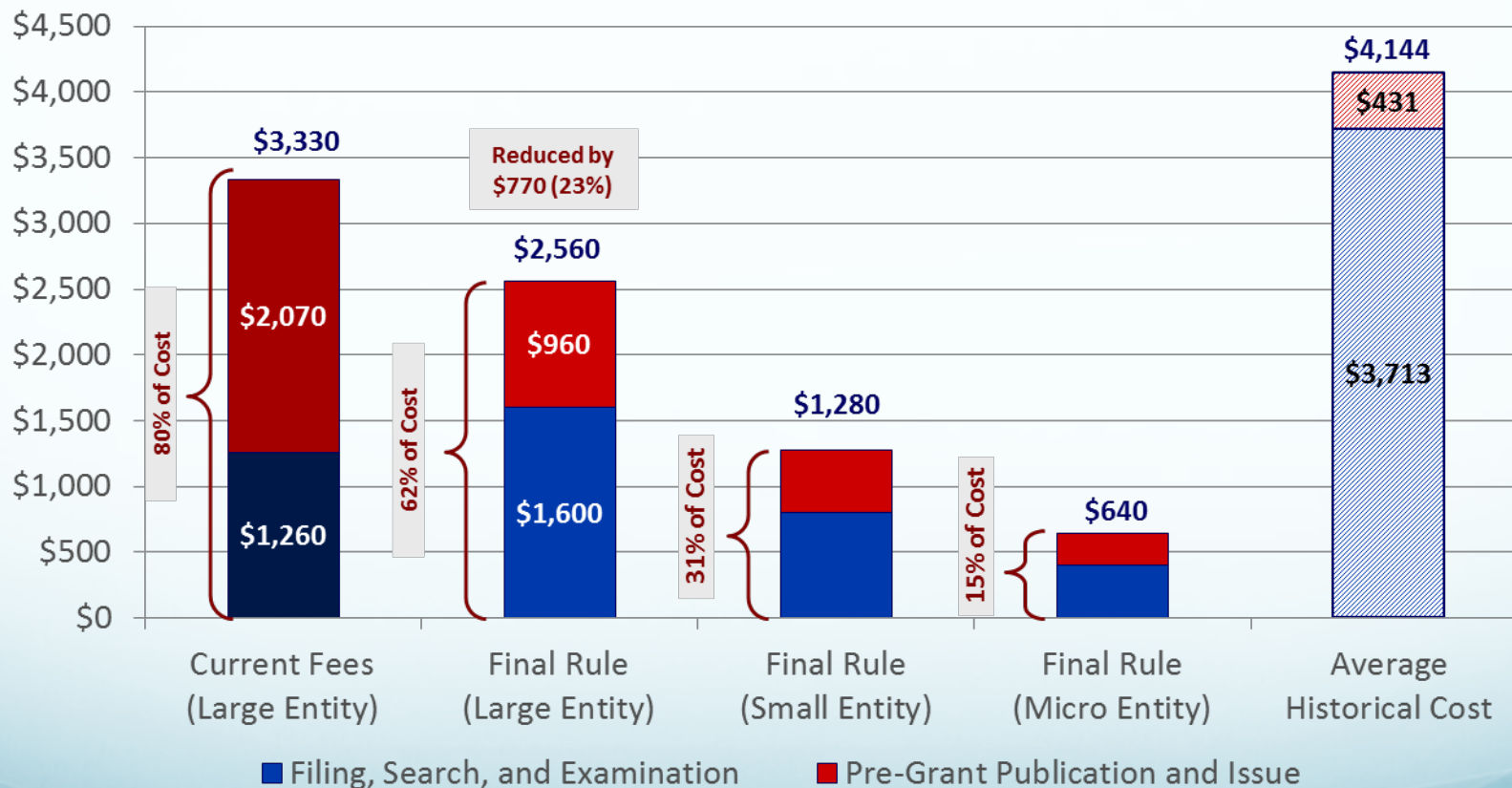
(Data from Sept 16, 2012 to Feb 28, 2103)

http://www.uspto.gov/aia_implementation/statistics.jsp



Comparison of the Final Fee Schedule to Current Fees

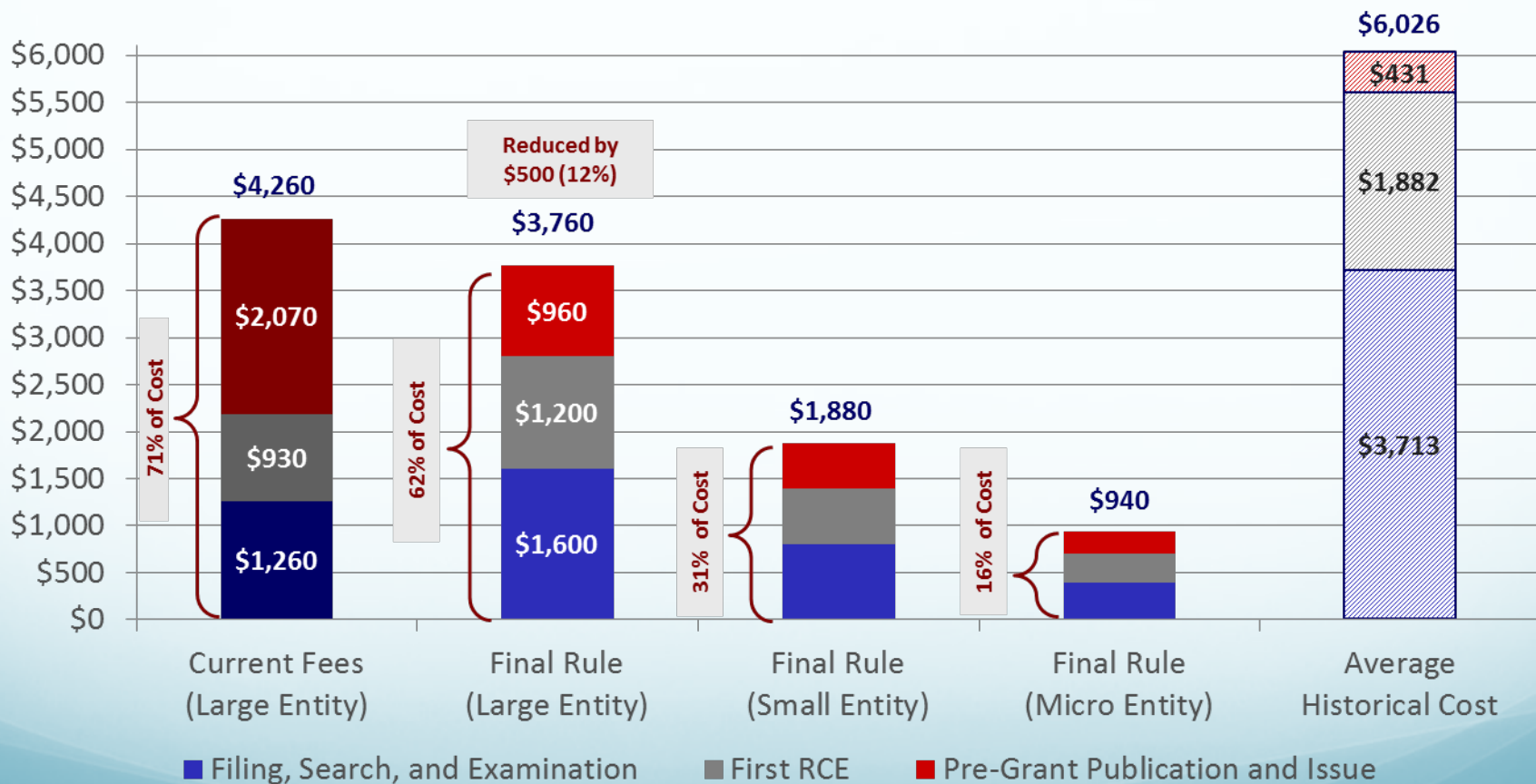
From Filing through Issue



Note: In each scenario, from the Current to the final fee structure, the fees paid could also increase by (a) \$170 for each independent claim in excess of 3; (b) \$18 for total claims in excess of 20; and (c) \$320 for each multiple dependent claim.

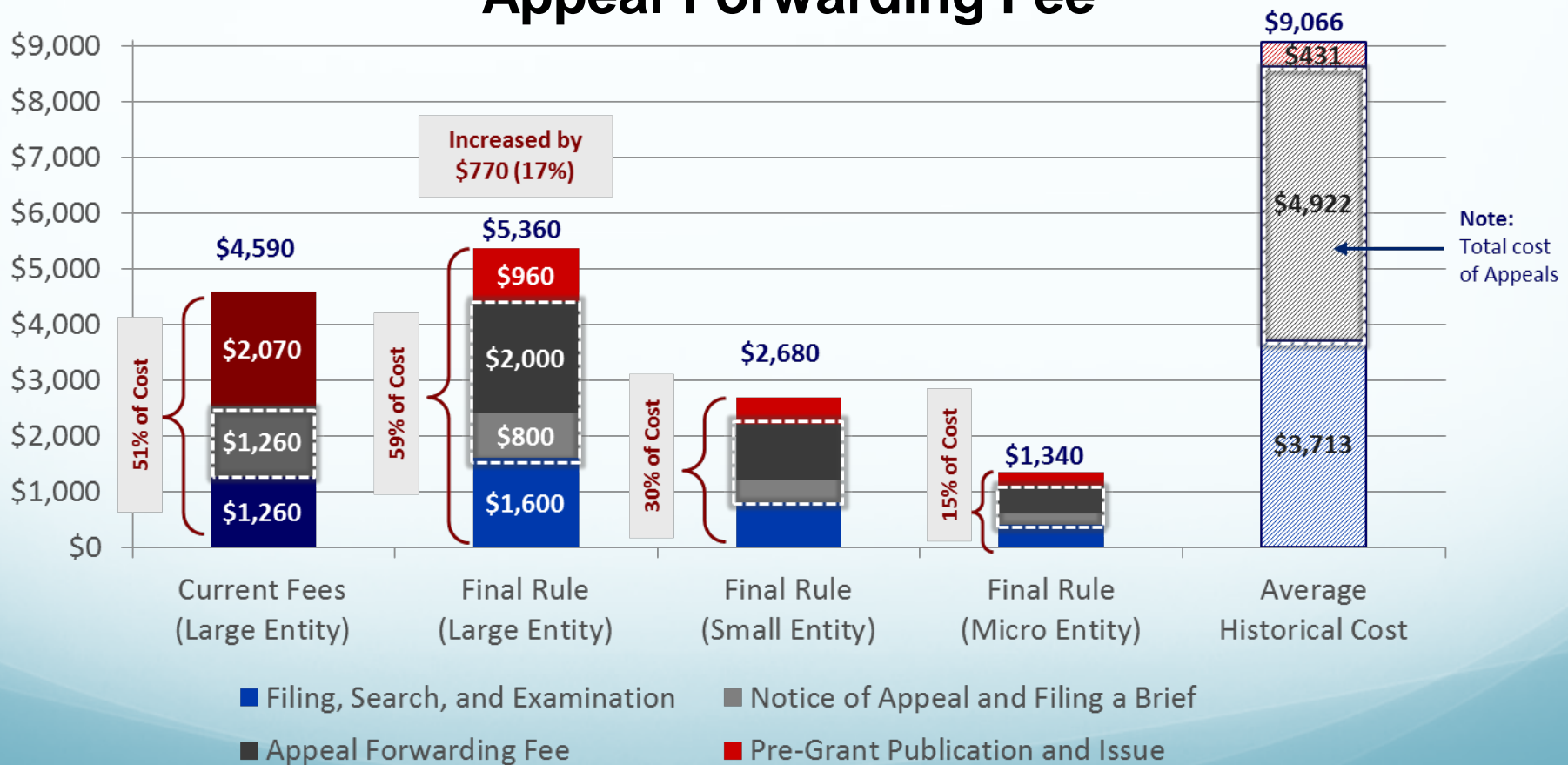
Comparison of the Final Fee Schedule to Current Fees

From Filing through Issue, with One RCE



Comparison of the Final Fee Schedule to Current Fees

From Filing through Issue, with a Notice of Appeal and Appeal Forwarding Fee



Inter Partes Review Fee Changes

Description	Current Fee	NPRM Proposal	Final Rule
IPR – up to 20 claims	\$27,200	<i>See Below</i>	<i>See Below</i>
IPR Request – up to 20 claims	<i>See Above</i>	\$9,000	\$9,000
IPR Post Institution – up to 15 claims	<i>See Above</i>	\$14,000	\$14,000
IPR per claim > 20 claims	\$600	<i>See Below</i>	<i>See Below</i>
IPR Request per claim > 20 claims	<i>See Above</i>	\$200	\$200
IPR Post Institution per claim > 15 claims	<i>See Above</i>	\$400	\$400

Post Grant Review/Covered Business Methods Fee Changes

Description	Current Fee	NPRM Proposal	Final Rule
PGR/CBM – up to 20 claims	\$35,800	<i>See Below</i>	<i>See Below</i>
PGR/CBM Request – up to 20 claims	<i>See Above</i>	\$12,000	\$12,000
PGR/CBM Post Institution – up to 15 claims	<i>See Above</i>	\$18,000	\$18,000
PGR/CBM per claim > 20 claims	\$800	<i>See Below</i>	<i>See Below</i>
PGR/CBM Request per claim > 20 claims	<i>See Above</i>	\$250	\$250
PGR/CBM Post Institution per claim > 15 claims	<i>See Above</i>	\$550	\$550

The End!

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