



**Kaplan Breyer Schwarz & Ottesen, LLP**

Intellectual Property Attorneys

## **First-Inventor-to-File Under AIA**

- **NJIPLA Electronics, Telecom and Software Patent Practice Update**
- **24 January 2013**

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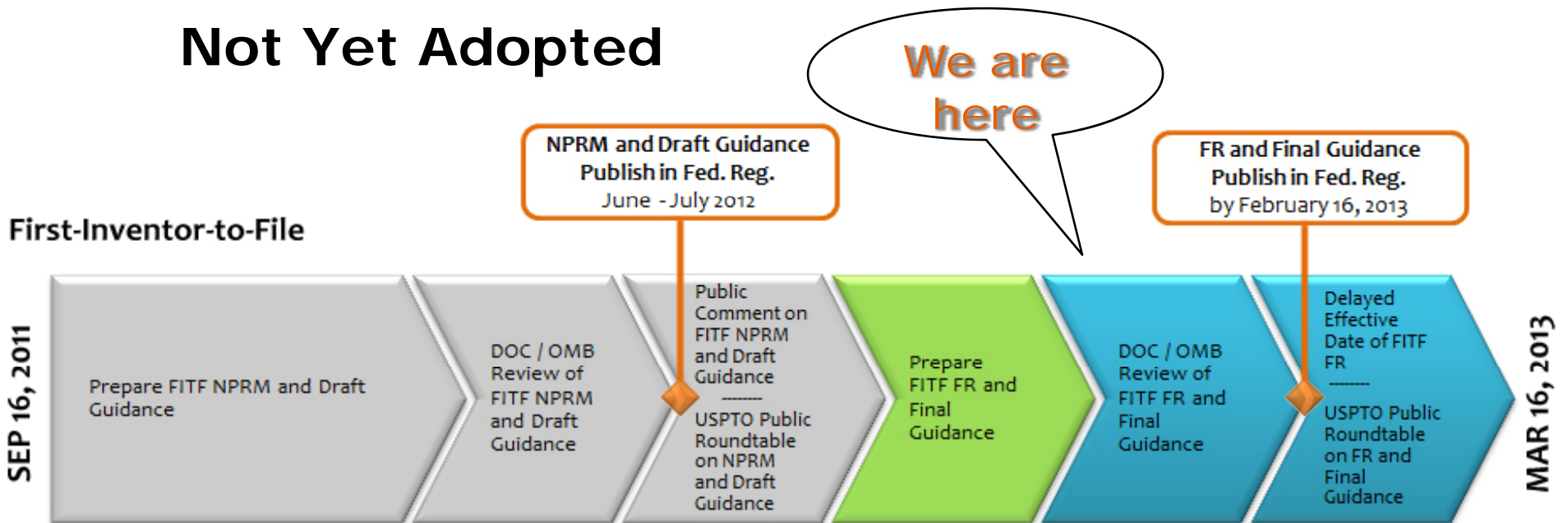
# First Inventor to File

- **America Invents Act enacted: September 16, 2011**
- **First Inventor to File effective date: March 16, 2013**
- **Primarily in AIA 35 U.S.C. 102**
- **Today's talk**
  - **Statute highlights**
  - **What to look for in the final rules/exam. guidelines**
- **Reference: proposed guidelines, race scenarios, and USPTO resources**



## USPTO Status

- Final Rules and Examination Guidelines Not Yet Adopted



Source: [http://www.uspto.gov/aia\\_implementation/first-inventor-to-file-lg.jpg](http://www.uspto.gov/aia_implementation/first-inventor-to-file-lg.jpg)



# AIA 35 U.S.C. § 100

## AIA DEFINITIONS

(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).

➤ *Includes int'l apps. designating US b/o foreign app.*



## **FITF: 3/16/13**

- **Effective filing date governs**
- **Pre-3/16/13 filed applications remain under current law, as well as continuations and divisionals of pre-AIA applications, and non-provisionals claiming pre-AIA priority/benefit**
- **Only inventions with an effective filing date of 3/16/13 or later fall under AIA FITF, e.g., continuation-in-part**
  - ***Proposed rules:*** Applicant indication of “AIA claims” when claiming priority/benefit to a pre-3/16/13 application (proposed 37 C.F.R. §§ 1.55(a)(4), 1.78(a)(3), & 1.78(c)(2))



# AIA 35 U.S.C. § 102(a)(1)

## CURRENT

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

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

## AIA

§102 Conditions for patentability; novelty

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

-

(1) the claimed invention was patented, described in a printed publication or in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention; or

➤ *Anywhere*



# AIA 35 U.S.C. § 102(a)(1)

## CURRENT

§102 [continued]

(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

## AIA (again)

§102 Conditions for patentability; novelty

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

-

(1) the claimed invention was patented, described in a printed publication or in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention; or

➤ *Anywhere*

➤ *Public sale vs. secret sale?*

➤ *Otherwise available?*



## **AIA § 102(b)(1) Exceptions to (a)(1)**

(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.

➤ *"Disclosure" undefined in AIA*

➤ *Grace period for inventor-made/derived disclosures – but see proposed examination guidelines for overcoming another's p.a.*

➤ *37 C.F.R. § 1.130 (proposed): applicant affidavit*





## Current 35 U.S.C. § 102(c) & (d)

**CURRENT**

**AIA**

§102 [continued]

(c) he has abandoned the invention, or

➤ *Not in AIA*

(d) the invention was first patented . . . 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



# AIA 35 U.S.C. § 102(a)(2)

## CURRENT

### §102 [continued]

- (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 [for PCT]; or

## AIA

### §102 Conditions for patentability; novelty

- (a) NOVELTY; PRIOR ART. – A person shall be entitled to a patent unless
  - . . . .
  - (2) the claimed invention was described in a patent issued under section 151, or in an application for patent published . . . under section 122(b), in which the patent or application . . . names another inventor and was effectively filed before the effective filing date of the claimed invention.

➤ See also AIA § 102(d)



## **AIA § 102(b)(2) Exceptions to (a)(2)**

**(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; *"inventor-derived disclosures"***

**(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; *"intervening disclosures"***

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. *"commonly-owned disclosures"***

**➤ *37 C.F.R. § 1.130 (proposed): applicant affidavit re "disclosure"***



# AIA "Inventor"

## CURRENT

§102 [continued]

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

## AIA

➤ *Not in AIA as such, but see § 100 Definitions:*

(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.

➤ *Derivation proceedings also available*



# Interference → Derivation

## CURRENT

§102 [continued]

- (g) (1) during the course of an interference . . . , another inventor involved therein establishes . . . 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 . . . who had not abandoned, suppressed, or concealed it.

## AIA

➤ *Interferences not in AIA*



## **AIA § 102(c) & (d)**

(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 . . . .

(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.



# AIA First Inventor to File

- **Global considerations – activities & some foreign apps**
- **Not the same as “first-to-file”**
  - Earlier “disclosures” by inventor per § 102(b) exceptions can disqualify prior art, but how close must a “disclosure” be to the prior art?
  - Inventors should retain evidence of “disclosure” for the affidavit under 37 C.F.R. § 1.130 (proposed) or for derivation proceedings
  - We are currently in the 12-month “disclosure” grace period
- **File early and often – probably more provisionals**
- **File first, then disclose**
  - EPC law bars patents on previous disclosures/sales
  - Some other countries’ grace periods, if any, are less than a year



## **Final Rules: What to Look For**

- **Definition of “disclosure”**
  - **Inventor’s earlier “disclosure” versus another’s prior art**
  - **37 C.F.R. § 1.130 affidavit**
- **Non-public sales – are they a bar?**
- **What “otherwise available to the public” activity might be considered a bar?**
- **Applicant indication of “post-AIA” matter when claiming priority/benefit to a pre-3/16/13 app.**
  - **What effect on failure to indicate?**
  - **Identical provisional and non-provisional**
- ***See slides below for proposed examination guidelines***





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## **More on First Inventor to File**

- **“Disclosure” Undefined in AIA**
- **How Close to the Disclosure?**
- **Public Sale or Any Sale?**
- **Race to the Patent Office Scenarios**
- **USPTO Resources**



# **“Disclosure” Undefined in AIA**

## **USPTO Proposed Examination Guidelines:**

*The meaning of “disclosure”:* **[T]he Office is treating the term “disclosure” as a generic expression intended to encompass the documents and activities enumerated in 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).

Footnote 15: . . . *H.R. Rep. No. 112–98, at 43 (2011)* (indicating that **the grace period provision of 35 U.S.C. 102(b) would apply to all patent applicant actions during the grace period that would create prior art under 35 U.S.C. 102(a)**).

77 Fed. Reg. 43763-64 (July 26, 2012).

➤ ***Protect inventor from self & derivers***



## Inventor's Disclosure over Another's Prior Art?

### USPTO Proposed Examination Guidelines:

[T]he 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.**

77 Fed. Reg. 43767 (July 26, 2012)

➤ ***High threshold for inventor to overcome others' prior art***



## Public Sale or Any Sale?

### USPTO Proposed Examination Guidelines:

The language of AIA 35 U.S.C. 102(a)(1) does not expressly state whether a sale must be “sufficiently” public to preclude the grant of a patent on the claimed invention.<sup>29</sup>

Footnote 29 : AIA 35 U.S.C. 102(a)(1) uses the same term (“on sale”) as pre-AIA 35 U.S.C. 102(b). . . . The legislative history of the AIA indicates that the inclusion of this clause in AIA 35 U.S.C. 102(a)(1) should be viewed as indicating that AIA 35 U.S.C. 102(a)(1) does not cover non-public uses or nonpublic offers for sale. . . . .

77 Fed. Reg. 43765 (July 26, 2012)



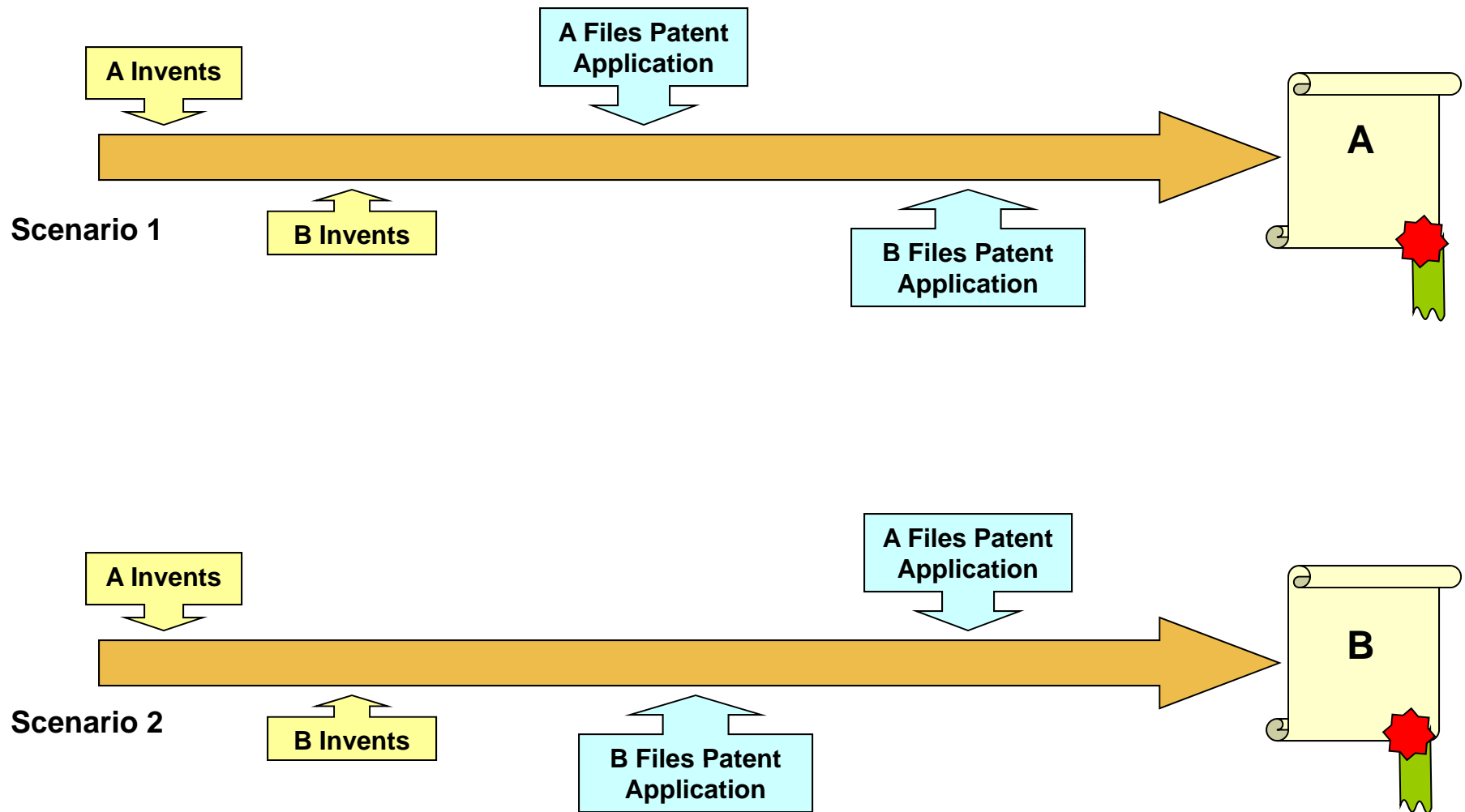
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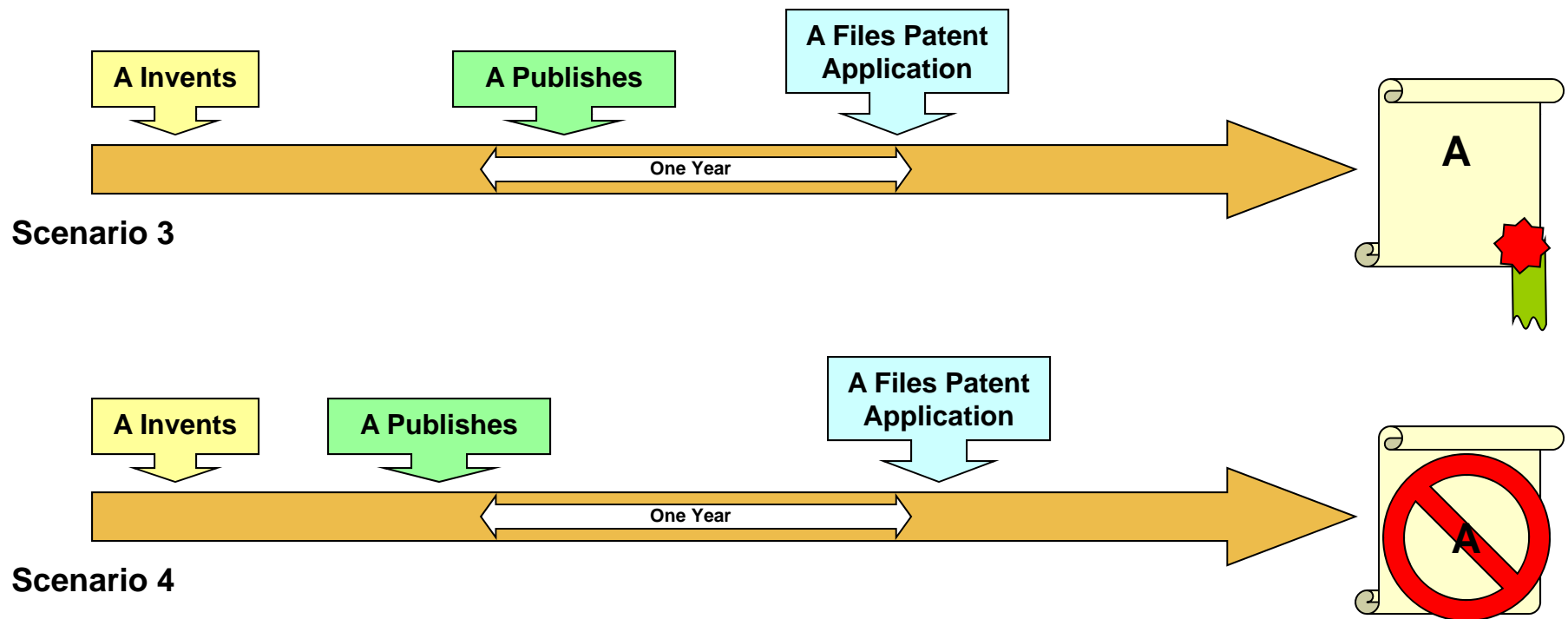
# Race to the Patent Office

- **Illustrative Scenarios**

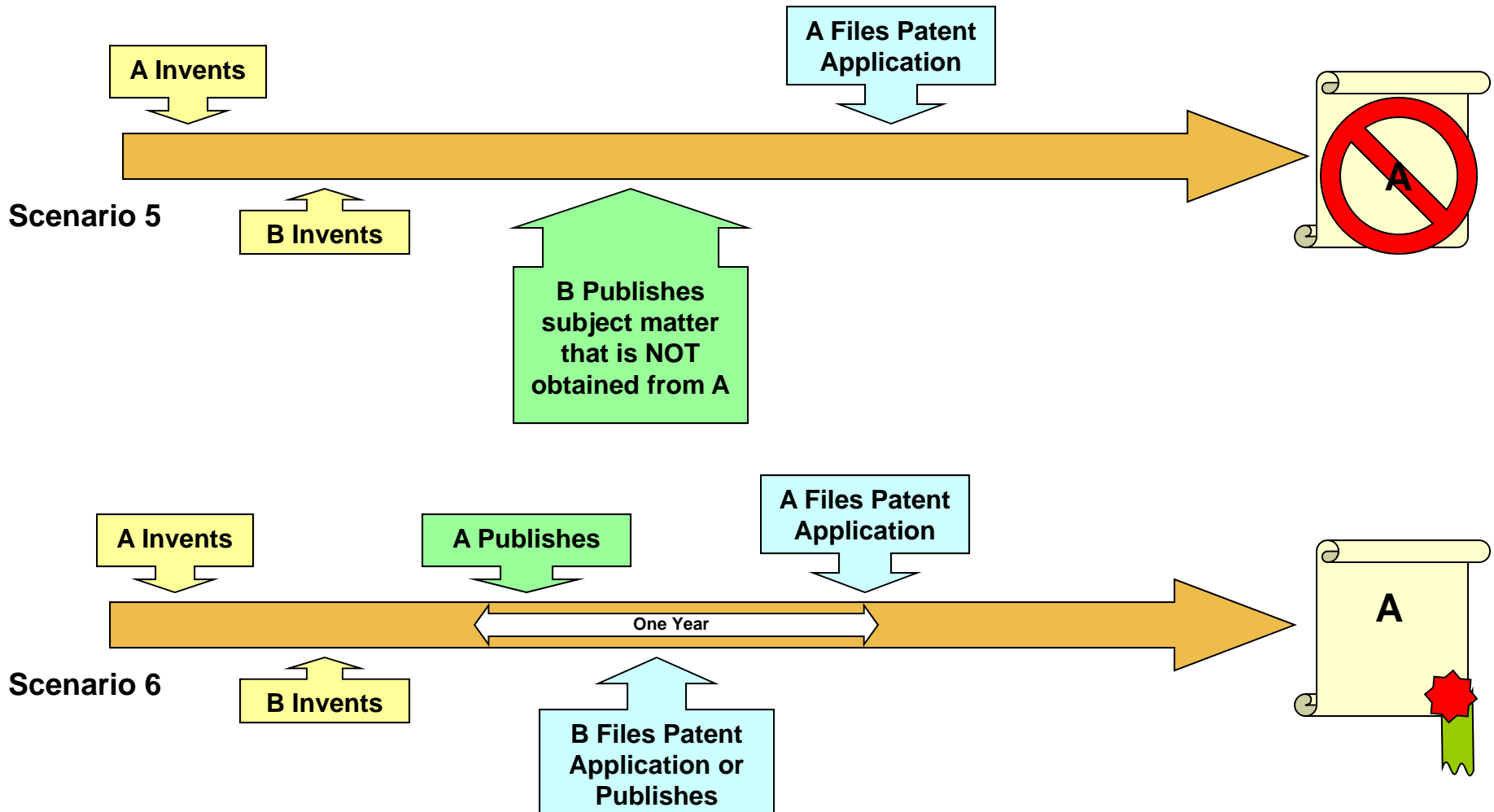
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# 1-Year Grace Period For Inventor's Prior Disclosure

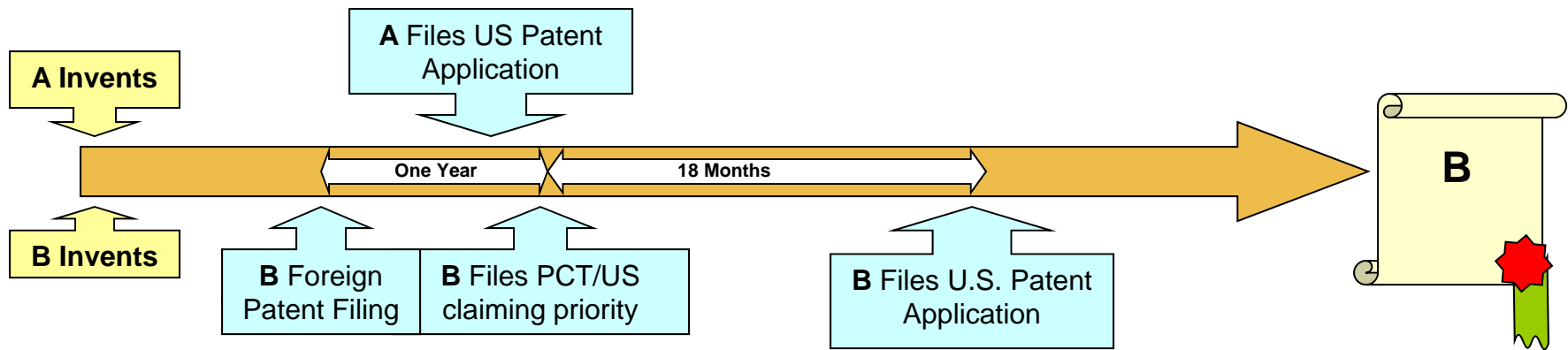


# Earlier Publication

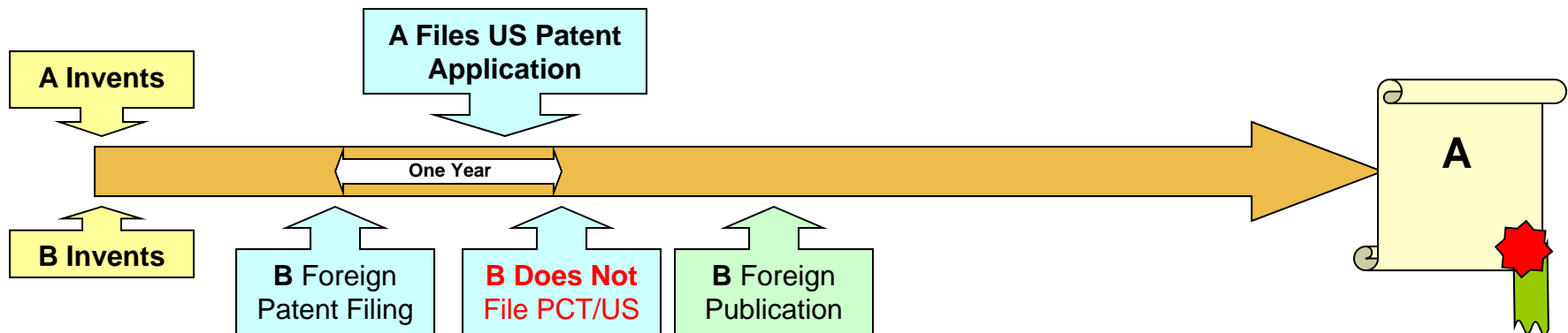




# Foreign Priority

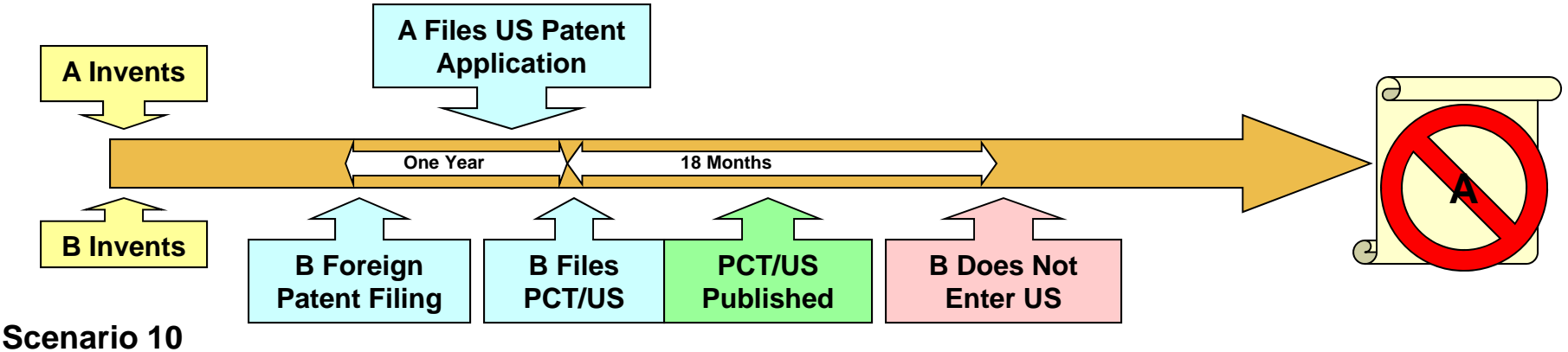
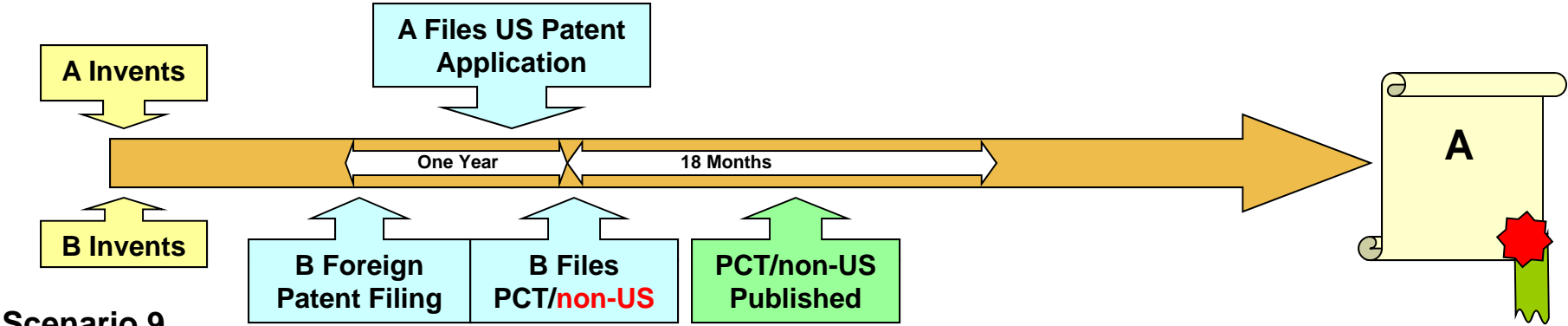


Scenario 7



Scenario 8

# Foreign Priority





# USPTO Resources

- **Proposed Rules :**

[http://www.uspto.gov/aia\\_implementation/first-inventor-to-file\\_proposed\\_rules.pdf](http://www.uspto.gov/aia_implementation/first-inventor-to-file_proposed_rules.pdf)

- **Proposed examination guidelines:**

[http://www.uspto.gov/aia\\_implementation/first-inventor-to-file\\_proposed\\_examination\\_guidelines.pdf](http://www.uspto.gov/aia_implementation/first-inventor-to-file_proposed_examination_guidelines.pdf)

- **First-Inventor-to-File web page:**

[http://www.uspto.gov/aia\\_implementation/patents.jsp#heading-10](http://www.uspto.gov/aia_implementation/patents.jsp#heading-10)



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## More USPTO Resources

- **Roundtable presentation:**

[http://www.uspto.gov/aia\\_implementation/120906-fittf-roundtable.pdf](http://www.uspto.gov/aia_implementation/120906-fittf-roundtable.pdf)

- **Legislative history:**

[http://www.uspto.gov/aia\\_implementation/resources.jsp](http://www.uspto.gov/aia_implementation/resources.jsp)