AIA 102

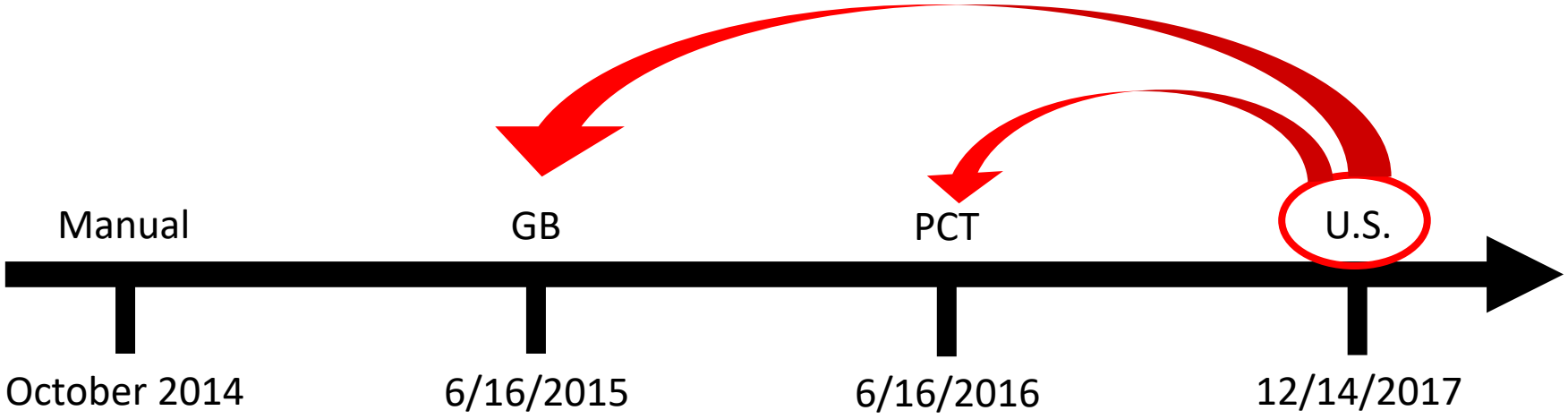
A Macro-level View of the Structure of 102

February 9th, 2023

Robert Scotti

Klarquist

Example Timeline of U.S. Application



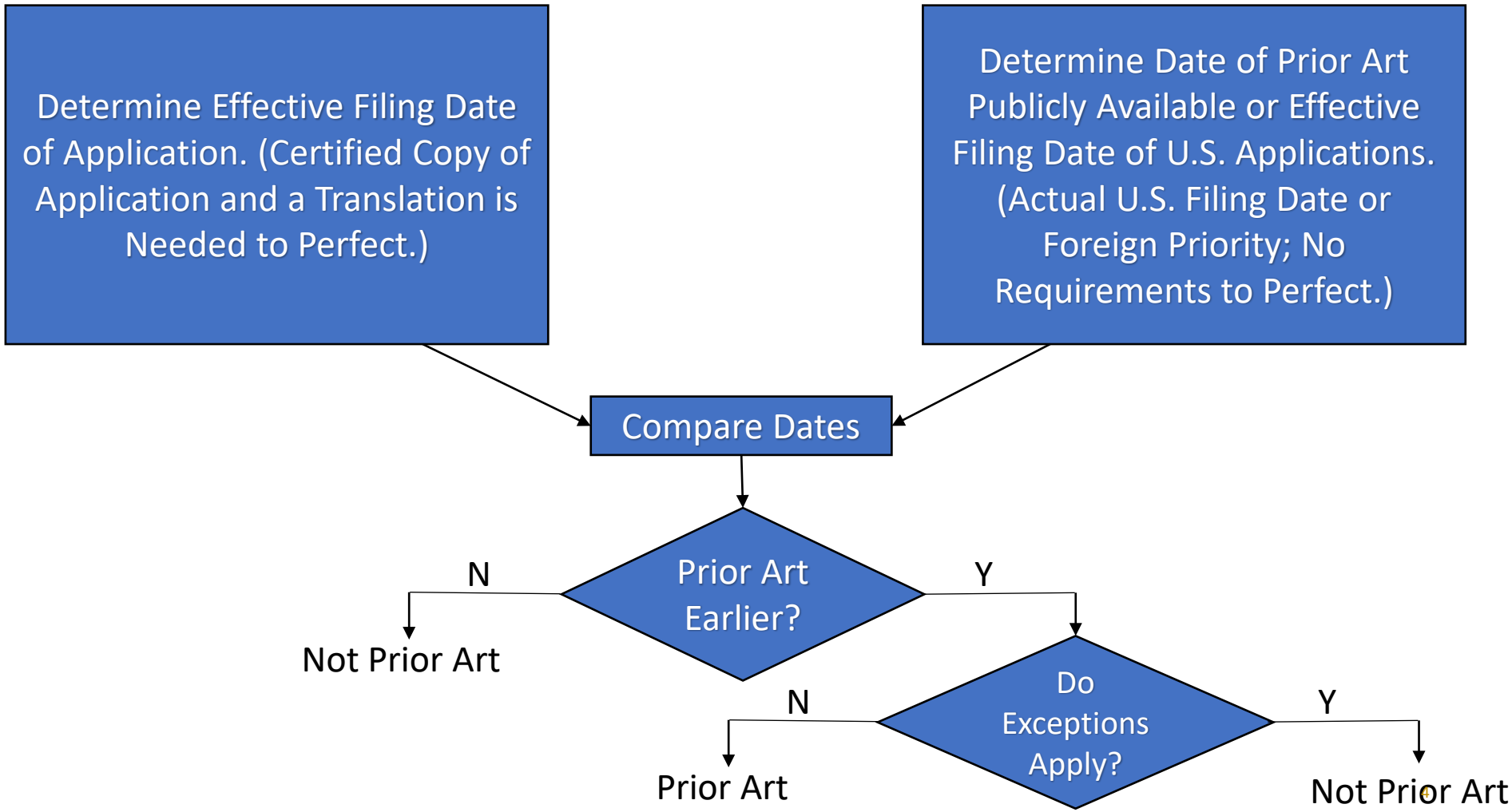
Office Action Example

10. Claim(s) 1-15 is/are rejected under 35 U.S.C. 102(a)(2) as being anticipated by "All nRF51 Series Reference Manual," Nordic Semiconductor, October 2014, pp. 1-174.

The applied reference has a common assignee with the instant application. Based upon the earlier effectively filed date of the reference, it constitutes prior art under 35 U.S.C. 102(a)(2). This rejection under 35 U.S.C. 102(a)(2) might be overcome by: (1) a showing under 37 CFR 1.130(a) that the subject matter disclosed in the reference was obtained directly or indirectly from the inventor or a joint inventor of this application and is thus not prior art in accordance with 35 U.S.C. 102(b)(2)(A); (2) a showing under 37 CFR 1.130(b) of a prior public disclosure under 35 U.S.C. 102(b)(2)(B) if the same invention is not being claimed; or (3) a statement pursuant to 35 U.S.C. 102(b)(2)(C) establishing that, not later than the effective filing date of the claimed invention, the subject matter disclosed in the reference and the claimed invention were either owned by the same person or subject to an obligation of assignment to the same person or subject to a joint research agreement.

Is Examiner Correct?

High-Level 102 Flowchart



Prior Art Identified in 35 U.S.C. 102(a)(1) and 102(a)(2)

Only two subsections of the AIA identify prior art:

- **102(a)(1)** for a prior public disclosure (or prior sale by applicant), regardless of how the disclosure was made, as of the date it was available to the public; and

- **102(a)(2)** for a U.S. patent, U.S. patent application publication (PGPub), or WIPO published PCT (international) application, as of the date its subject matter was effectively filed.

The availability of a disclosure as prior art under 102(a)(1) or 102(a)(2) depends upon the effective filing date of the claimed invention.

AIA Statutory Framework

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

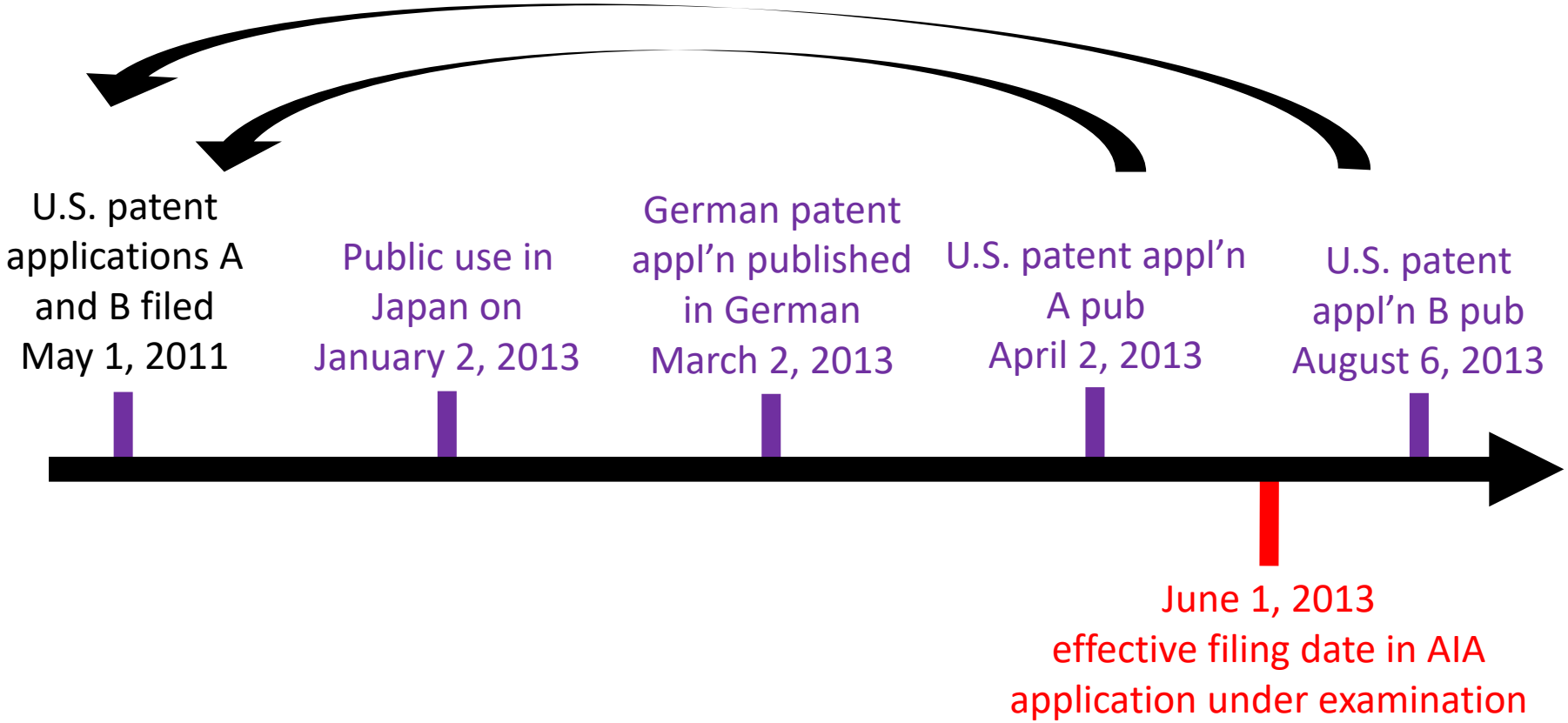
35 U.S.C. 102(a)(1)

§ 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

Illustration B:
Identifying 102(a)(1) Prior Art



Question: Which of these disclosures could **potentially** be applied as prior art in a rejection under section 102(a)(1) against an application claiming an invention with an effective filing date of June 1, 2013?

Public Use

Very fact specific– See patentdefenses.klarquist.com

For public use consider the following:

1) the nature of the activity that occurred in the public
2) public access to information
3) whether there was an obligation of confidentiality.

A clinical trial is not public use as long as the inventor maintains control and keeps it confidential. However, a posting on a clinical-trials government website is prior art.

On-sale Bar By Applicant

Two-pronged test of offer for sale by the inventor (In re Pfaff, Supreme Court 1998):

1) A commercial offer for sale;

A commercial offer for sale is one that bears the general hallmarks of a sale pursuit to the UCC. The Medicines Co. (Fed. Circuit 7/11/16)

The sale need not be consummated. (Merck & Cie (Fed. Cir. 5/13/16))

2) The invention is ready for patenting

a) proof of reduction to practice; or

b) drawings or other descriptions were sufficient to allow one skilled in the art to practice the invention.

Putting a Method on Sale by Applicant

To place a method on sale:

1) Make a commercial offer to perform the method;

2) Perform the claimed method for future compensation; or

3) Offer a product made by the method (D.L. Auld (Fed. Cir. 8/15/83))

Experimental Sale or Use by Applicant

A patent applicant can make offers and uses for experimental purposes and it does not start the public use grace period.

Look at overall circumstances to determine the purpose of the use was for experimentation to bring the invention to perfection.

Loss of control of the invention is a factor. Was there an obligation for confidentiality.

There is no experimental use for third parties.

European Prior Art

European law focuses on public availability of information. There is no separate commercial use analysis. There is no grace period.

Information as to the composition and internal structure of a prior sold product is made available if direct and unambiguous access to such information is possible by means of known analytical techniques which were available for use by a skilled person.

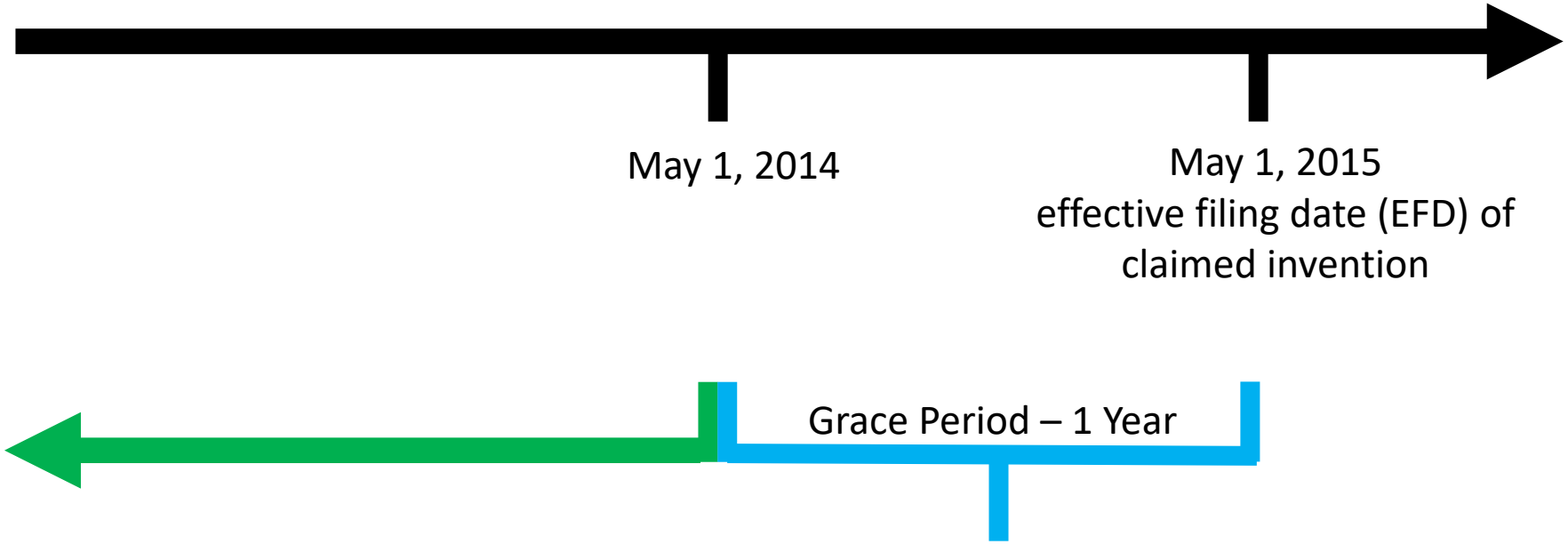
Exceptions to Prior Art under 35 U.S.C. 102(a)(1)

• Even though a disclosure of subject matter falls within the scope of 102(a)(1), it may not be used in a prior art rejection if one of the exceptions stated in 102(b)(1) applies.

• The two exceptions are stated in 102(b)(1)(A) and 102(b)(1)(B), and involve potential prior art disclosures made within the grace period, which is the one-year period preceding the effective filing date of the claimed invention.

REMEMBER: The 102(b)(1) exceptions apply to 102(a)(1) prior art!

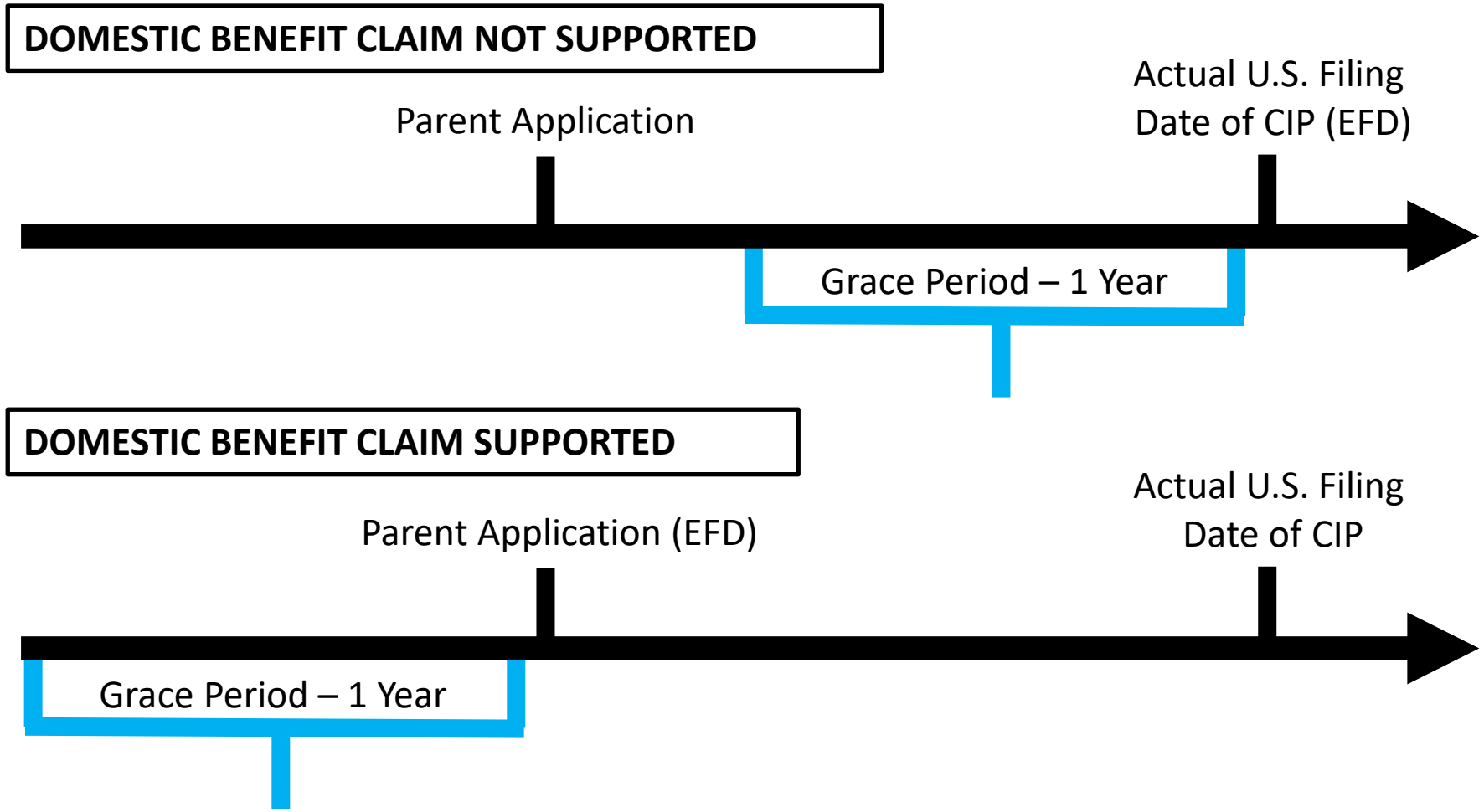
No Exceptions for 102(a)(1) Disclosures Made Before the Grace Period



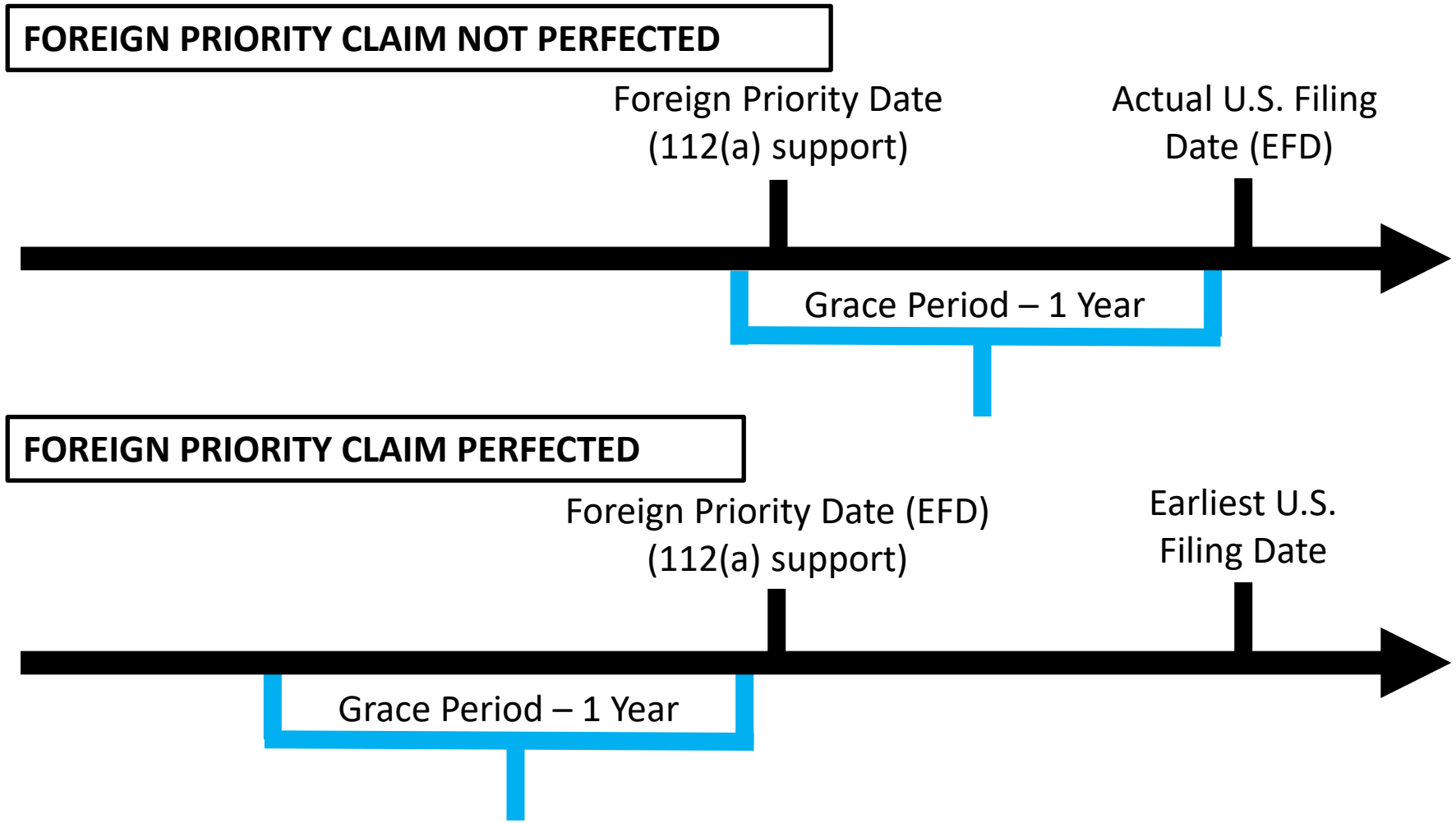
NO EXCEPTIONS for disclosures made **before** May 1, 2014 (best prior art dates)

POSSIBLE EXCEPTIONS under 102(b)(1)(A) & 102(b)(1)(B) for disclosures made **on or after** May 1, 2014 but before May 1, 2015

Support in Prior Domestic Application Impacts the Effective Filing Date (EFD) and the Grace Period



Support and Perfecting Foreign Priority Impact Both the Effective Filing Date (EFD) and the Grace Period



35 U.S.C. 102(b)(1)(A) Exception to 102(a)(1) Prior Art: Inventor-Originated Disclosures

(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—

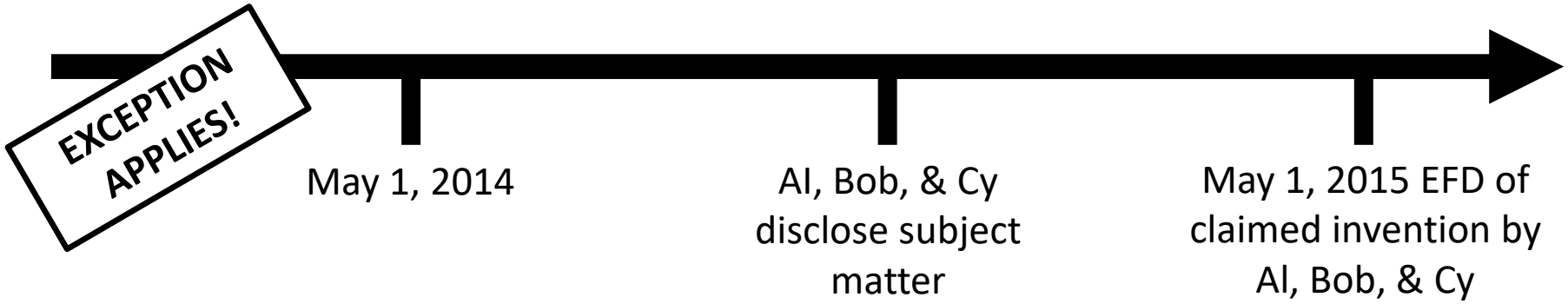
(A) the disclosure was made by the inventor or joint inventor or by another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor

35 U.S.C. 102(b)(1)(A) Exception to 102(a)(1): Inventor-Originated Disclosure During Grace Period

For this exception to apply to a disclosure, the disclosure must be:

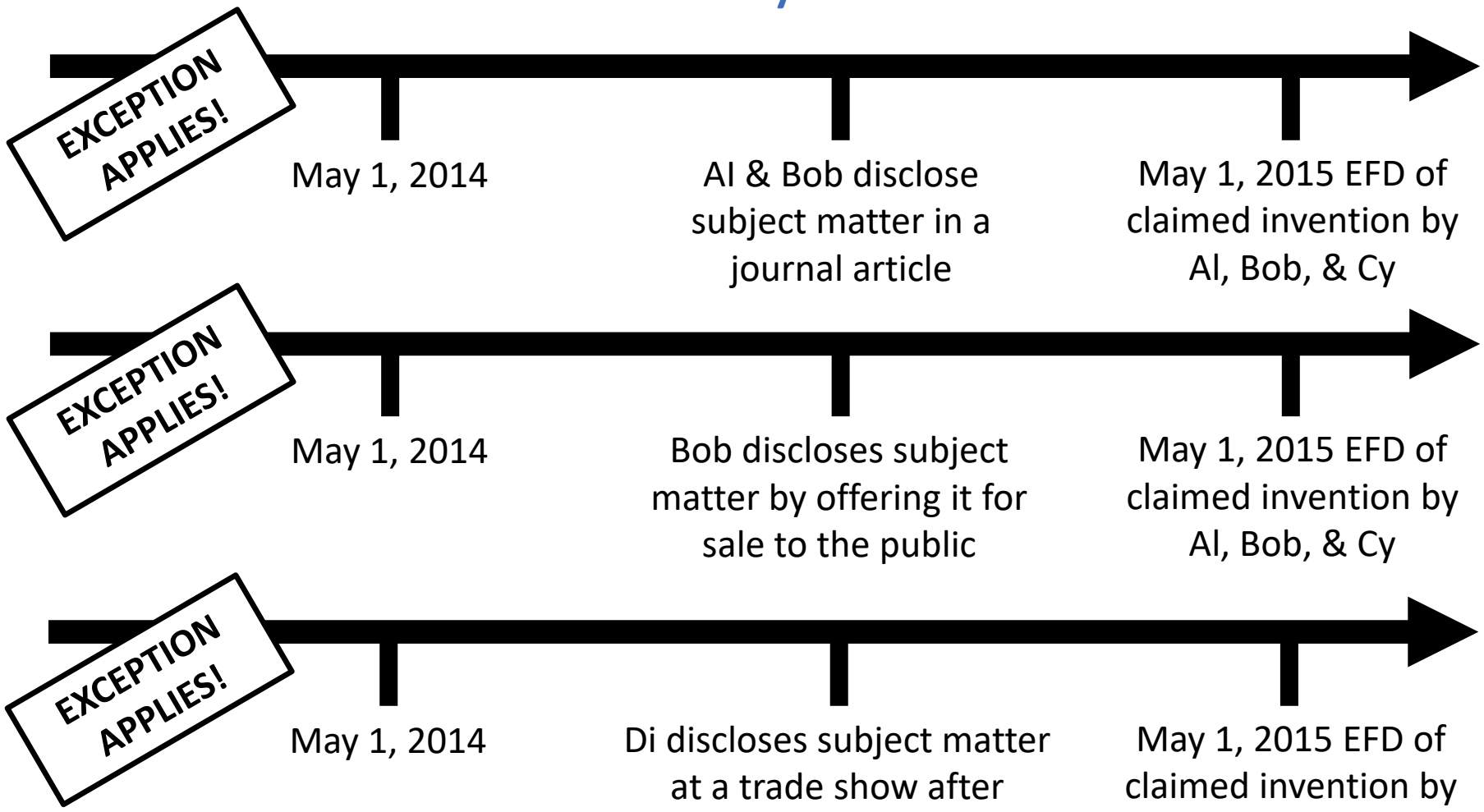
- within the grace period and
- an "inventor-originated disclosure" that is made by
  - the inventive entity ("the inventor"),
  - one or more joint inventors, or
  - "another" who obtained the disclosed subject matter from the inventor or a joint inventor either directly or indirectly.

102(b)(1)(A) Exception Applies to a Grace Period Disclosure by the Inventor

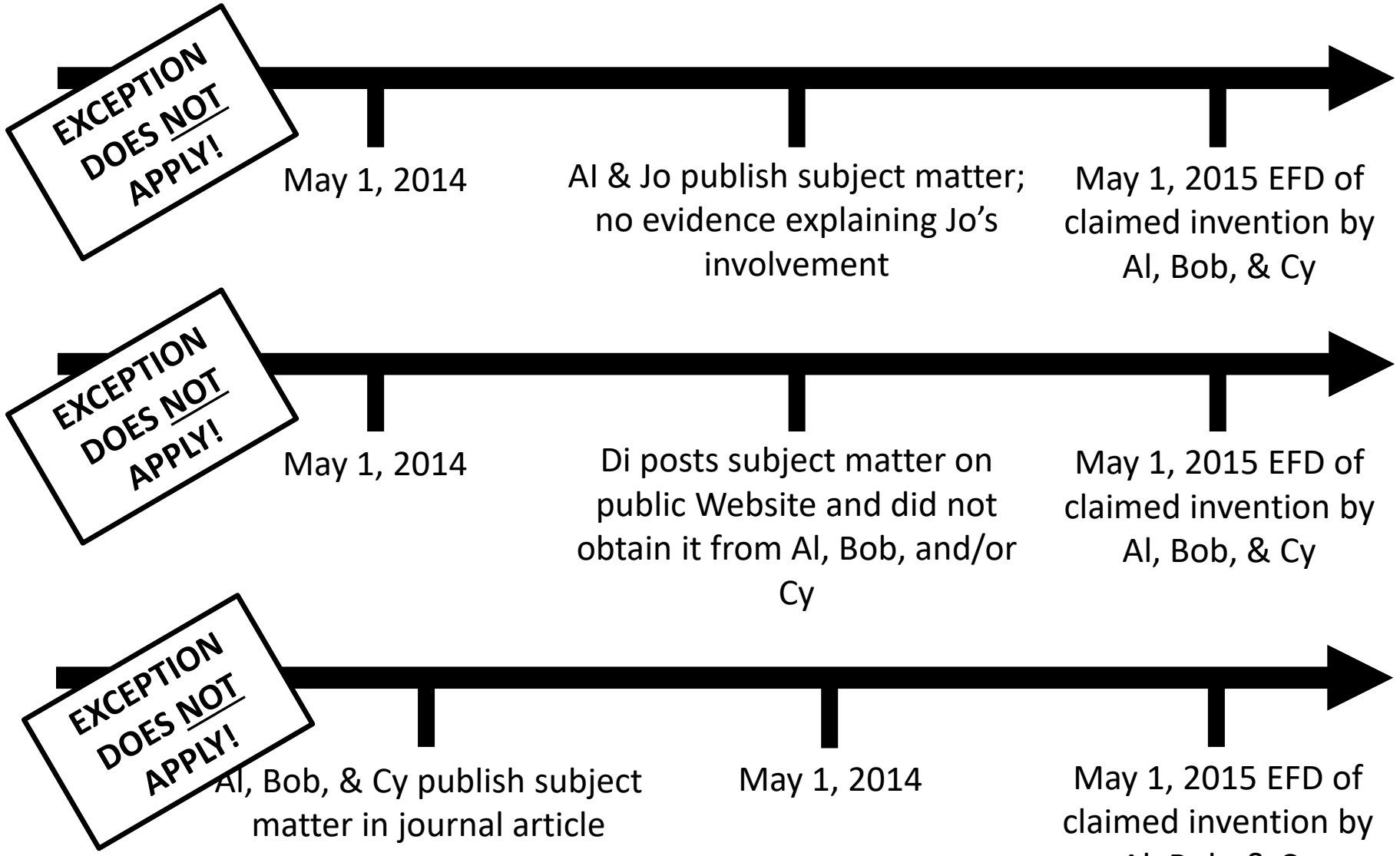


Even though the disclosure of Al, Bob, and Cy meets the requirements of 102(a)(1), it is not prior art to the claimed invention because the 102(b)(1)(A) exception applies.

102(b)(1)(A) Exception Applies to a Grace Period Disclosure by the Inventor



102(b)(1)(A) Exception DOES NOT Apply



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

(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—

. . . .

(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.

35 U.S.C. 102(b)(1)(B) Exception to 102(a)(1) Prior Art: Inventor-Originated Disclosure Prior to Third Party Disclosure

For this exception to apply to a third party's disclosure of subject matter X:

- the third party's disclosure must have been made during the claimed invention's grace period,
- an inventor-originated disclosure must have been made prior to the third party's disclosure, and
- both must have disclosed subject matter X.

Disclosures by Others: Important Distinction Between "Another" and "Third Party" in the Exceptions

"another"

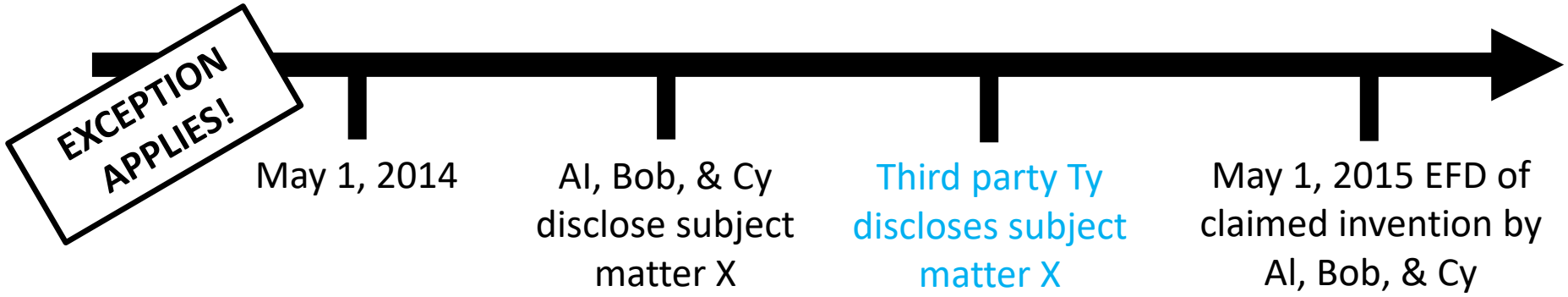
someone who disclosed subject matter that was obtained directly or indirectly from one or more members of the inventive entity

"third party" (applies to 102(b)(1)(B) and 102(b)(2)(B))

someone who disclosed subject matter but did **not** obtain it, directly or indirectly, from a member of the inventive entity

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

Inventor-Originated Disclosure Prior to Third Party Disclosure



Even though the disclosure of Ty meets the requirements of 102(a)(1), it is not prior art to the claimed invention because the 102(b)(1)(B) exception applies.

Note: The disclosure of Al, Bob, and Cy is also not prior art because a different exception – 102(b)(1)(A) – applies.

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

Inventor-Originated Disclosure Prior to Third Party Disclosure (cont.)

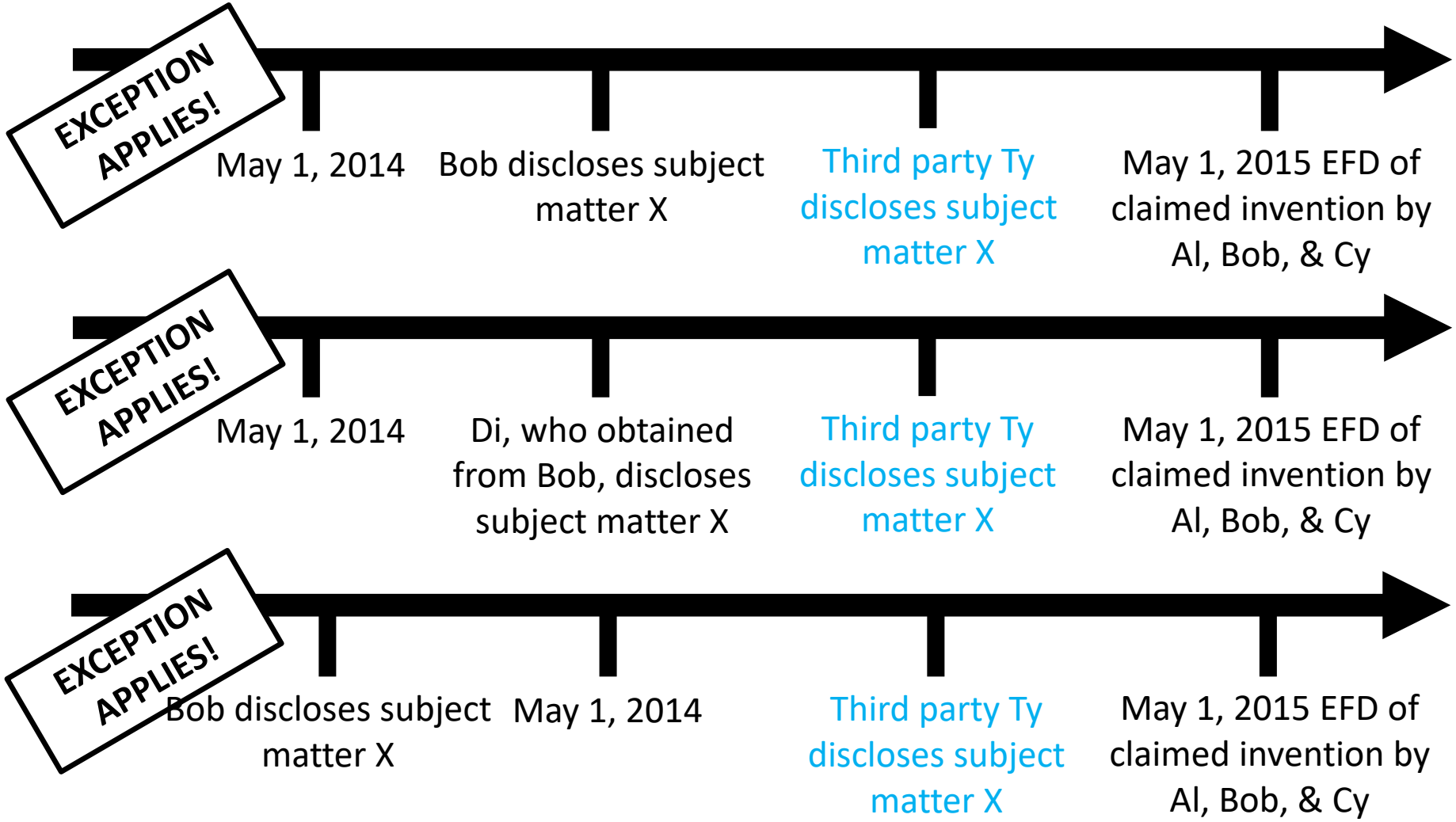
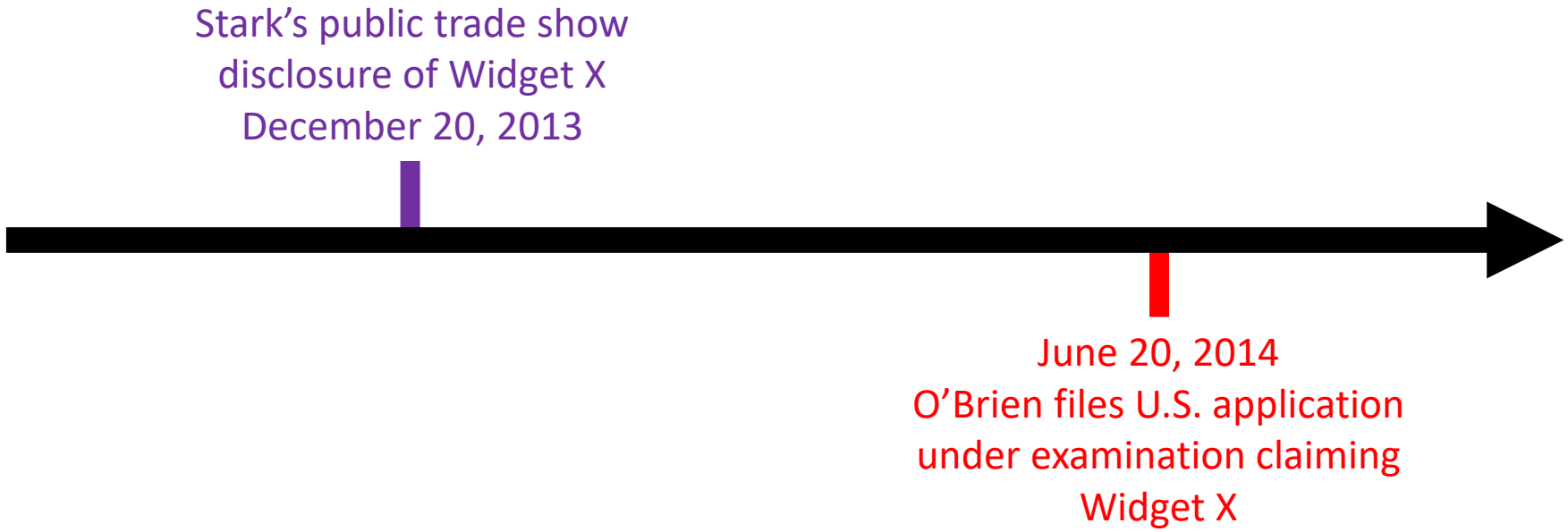


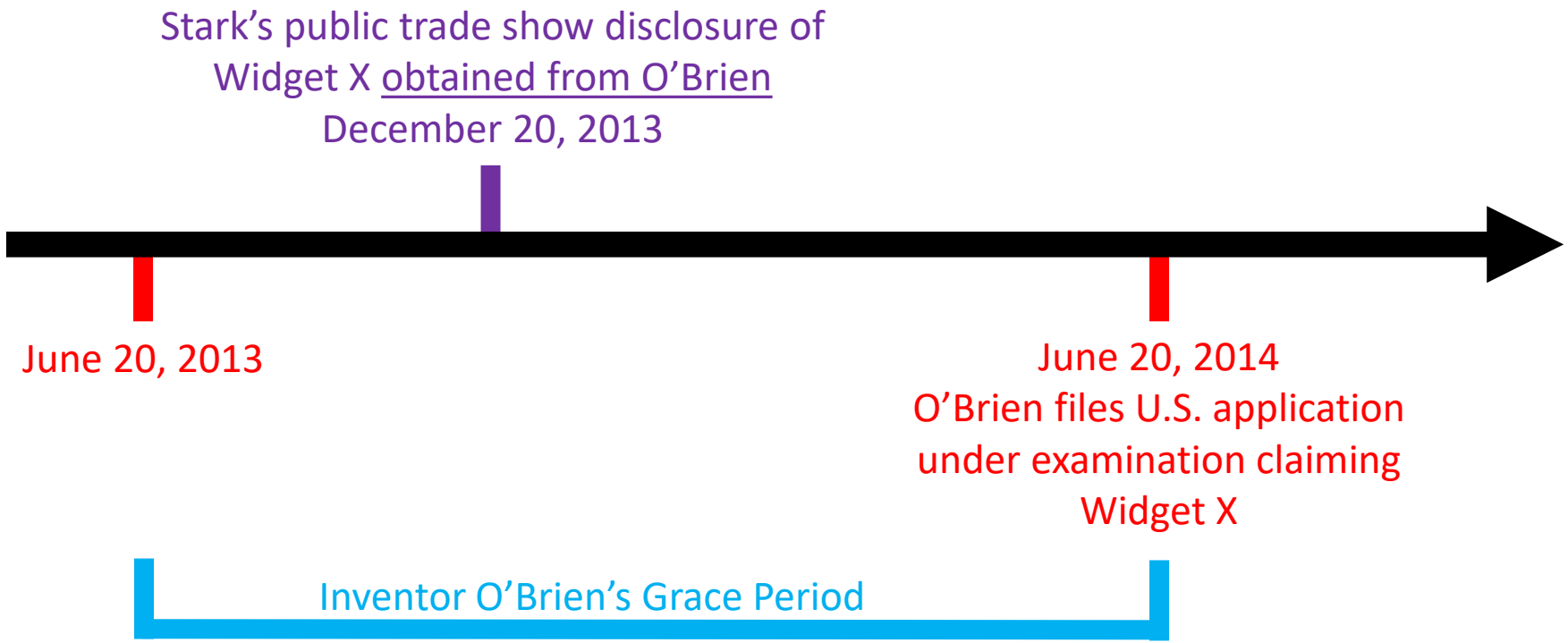
Illustration C:
Should a 102(a)(1) Rejection be Made?



Question: Is Stark's public trade show disclosure prior art under section 102(a)(1)?

Answer: Yes, Stark's public trade show disclosure is prior art under section 102(a)(1) because it falls within the "otherwise available to the public" category and is prior to O'Brien's effective filing date

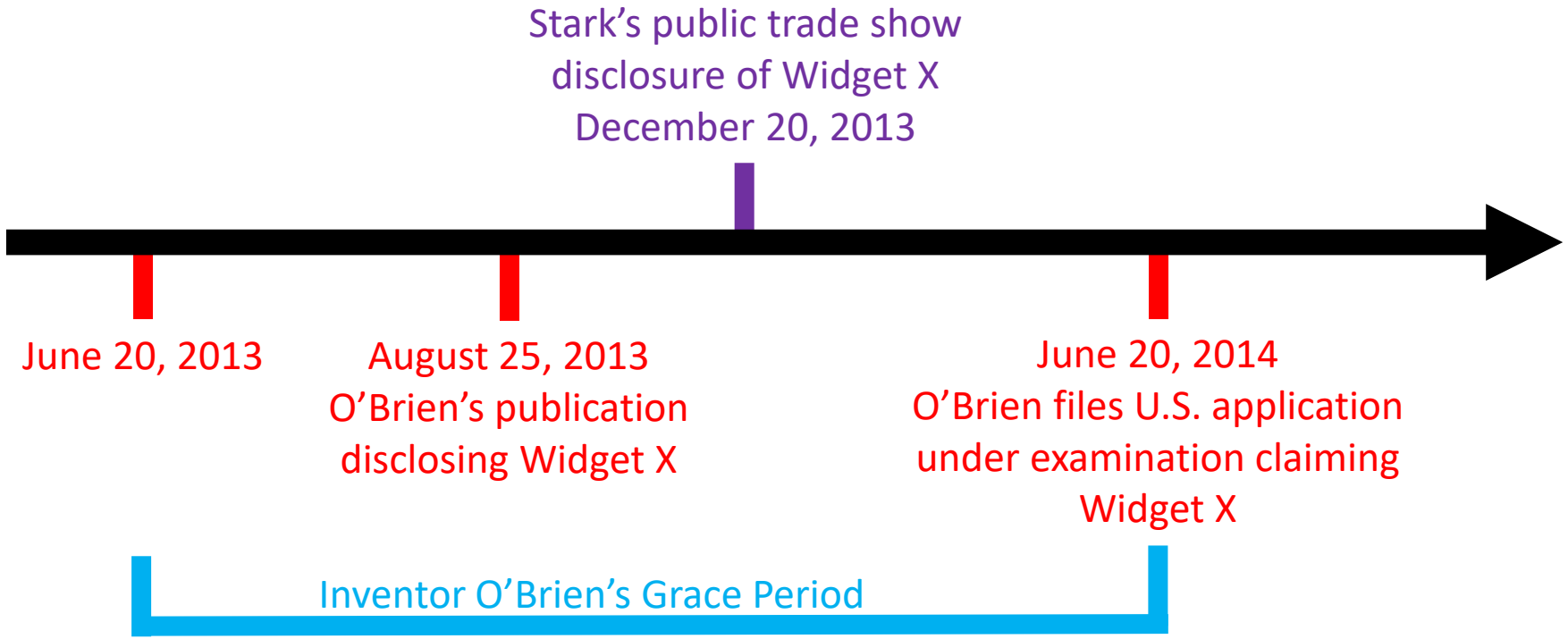
Illustration C:
Should a 102(a)(1) Rejection be Made?



Question: Is Stark's public trade show disclosure prior art under section 102(a)(1)?

Answer: No. Because Stark obtained Widget X from O'Brien, Stark's disclosure is not prior art under section 102(a)(1) in view of the exception under section 102(b)(1)(A).

Illustration C:
Should a 102(a)(1) Rejection be Made?



Question: Is Stark's public trade show disclosure prior art under section 102(a)(1)?

Answer: No. Stark's public trade show disclosure of Widget X is not prior art under section 102(a)(1) in view of the exception under section 102(b)(1)(B) because of O'Brien's August 25, 2013, prior disclosure of Widget X.

“The Subject Matter Disclosed” under 102(b)(1)(B)

OBVIOUS ≠ SAME SUBJECT MATTER

Even if an intervening disclosure by a third party is obvious over an inventor-originated prior public disclosure, this is **not** a disclosure of the same subject matter and the 102(b)(1)(B) exception does not apply.

102(b)(1)(B) "Shielding" Only Eliminates "the Same Subject Matter" as Prior Art under 102(a)(1)

IMPORTANT!

- Only that portion of the third party's intervening disclosure that was previously in an inventor-originated disclosure (i.e., "the same subject matter") is unavailable as prior art when the 102(b)(1)(B) exception applies.

- Any portion of the third party's intervening disclosure that was not part of the previous inventor-originated disclosure is still available for use in a prior art rejection. In other words, the claimed invention is not shielded from that portion of the third party’s disclosure.

35 U.S.C. 102(a)(2)

§ 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 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.

35 U.S.C. 102(a)(2): U.S. Patent Documents and the Statutory Language

document type	statutory language
U.S. patent	"a patent issued under section 151"
U.S. patent application publication (PGPub)	"application for patent" that is "published . . . under section 122(b)"
WIPO published PCT (international) applications that designate the United States	"application for patent" that is "deemed published under section 122(b)" (see 35 U.S.C. 374)

CAUTION: 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 may be printed publication prior art under 102(a)(1).

Only Published U.S. Patent Documents Can Be Applied Under 102(a)(2)

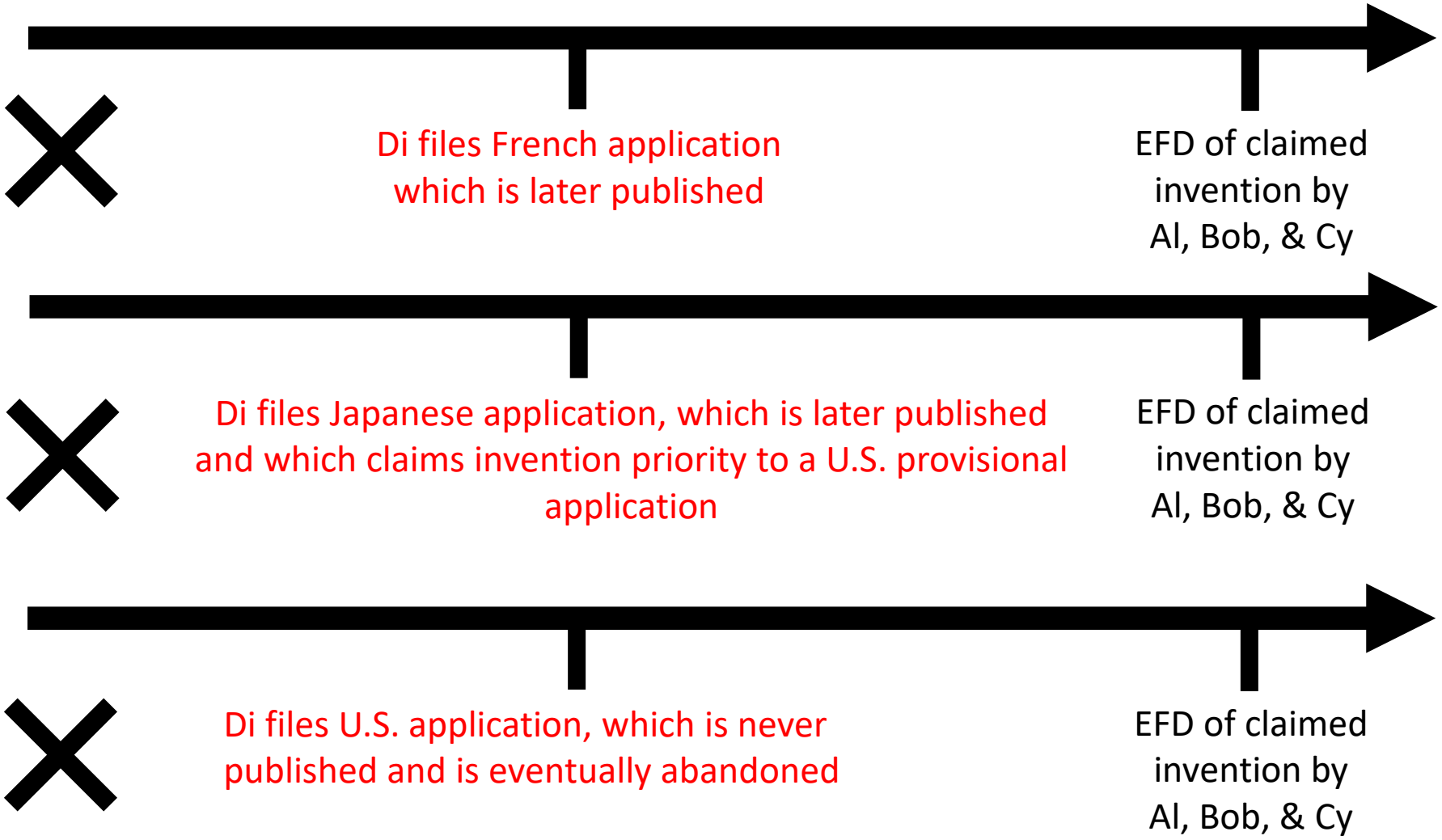
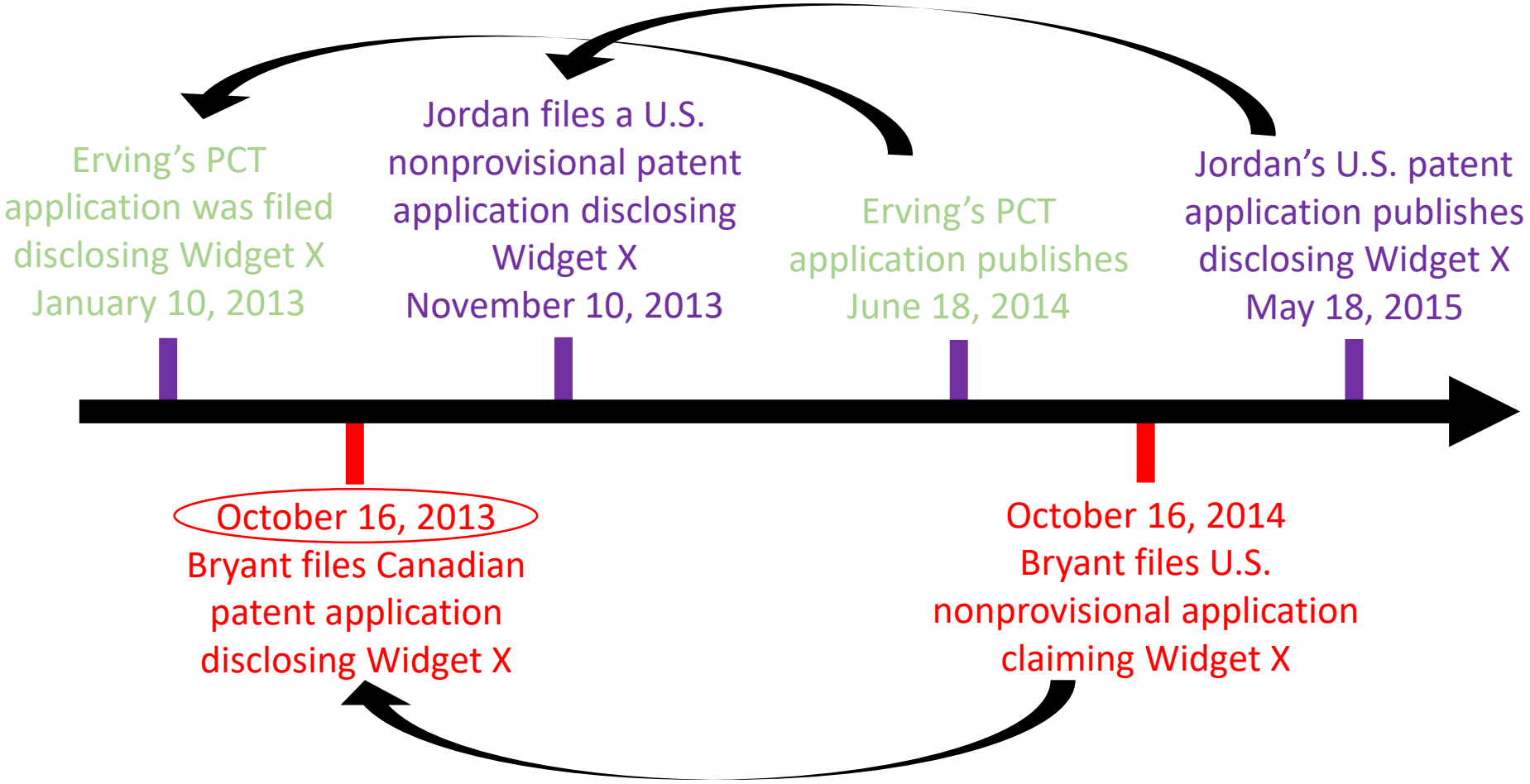


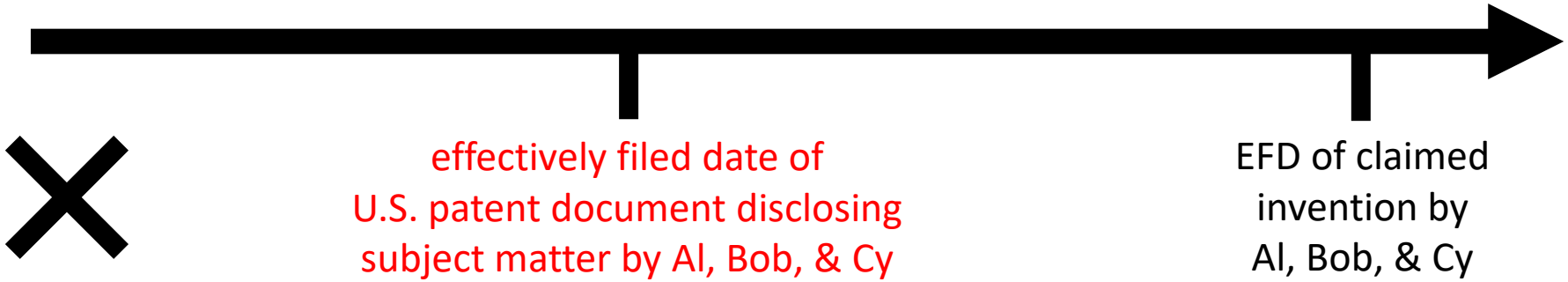
Illustration D:
Identifying 35 U.S.C. 102(a)(2) Prior Art



Question: Could Erving or Jordan's patent application publication be applied in a rejection under section 102(a)(2)?

35 U.S.C 102(a)(2) Documents Must Name "Another Inventor"

Under 102(a)(2), a disclosure in a U.S. patent document, including a WIPO published PCT (international) application, is <u>not prior art</u> unless the document names "another inventor" (i.e., a different inventive entity).



Because both inventive entities are the same in this illustration, the U.S. patent document <u>cannot</u> be prior art under 102(a)(2).

Exceptions to Prior Art under 35 U.S.C. 102(a)(2)

- Even though a 102(a)(2) reference describes the claimed invention, the reference may not be used in a prior art rejection if one of the exceptions stated in 102(b)(2) applies.

- The three exceptions are stated in 102(b)(2)(A), 102(b)(2)(B), and 102(b)(2)(C). Unlike the 102(b)(1) exceptions that apply to 102(a)(1) disclosures, the 102(b)(2) exceptions do not involve the one-year grace period.

REMEMBER: The 102(b)(2) exceptions apply to 102(a)(2) prior art!

35 U.S.C. 102(b)(2)(A) Exception to 102(a)(2) Prior Art: Subject Matter Disclosed Was Obtained from Inventor

(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—

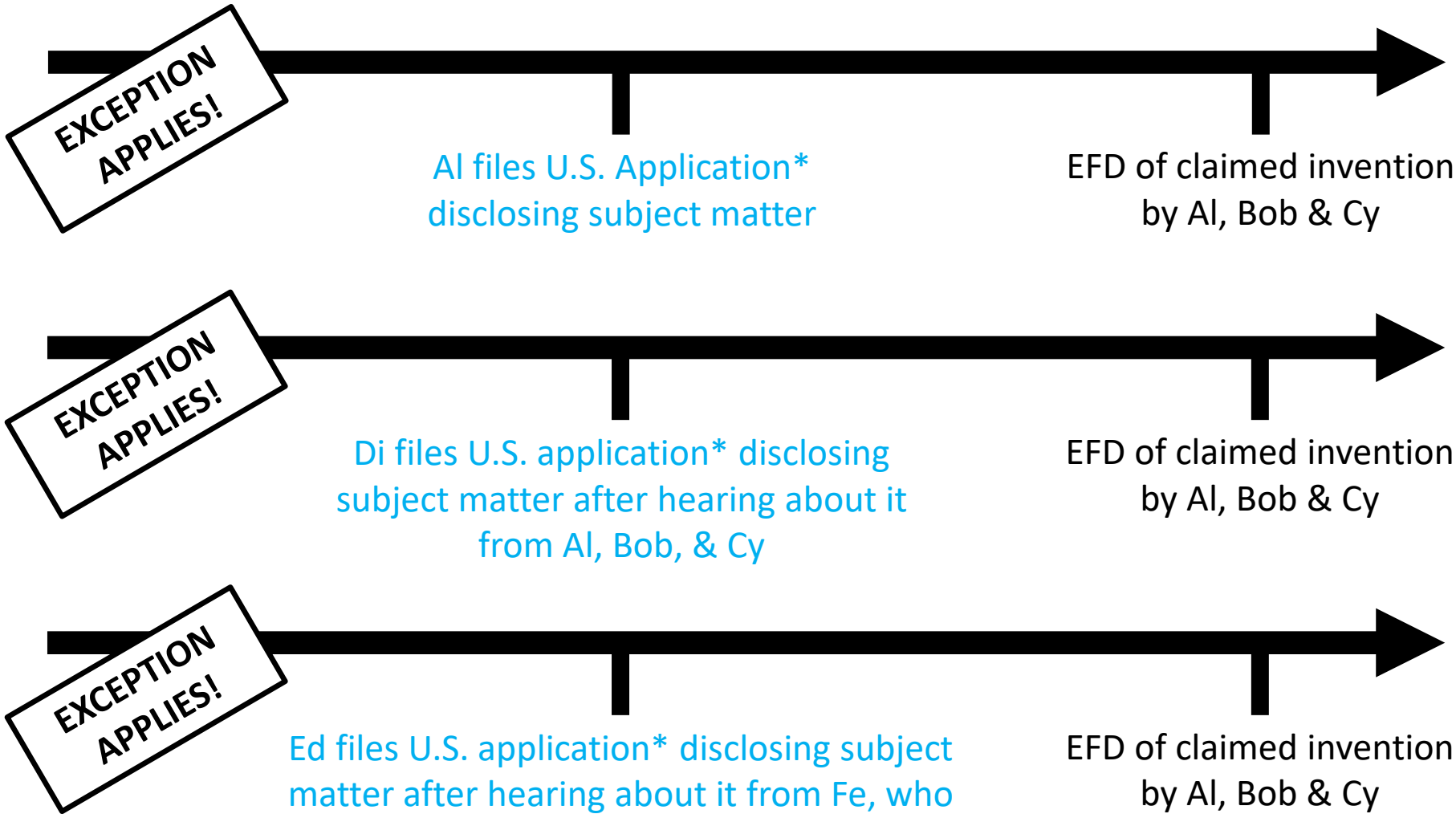
(A) the subject matter disclosed was obtained directly or indirectly from the inventor or a joint inventor

102(b)(2)(A) Exception to 102(a)(2) Prior Art

- Under the 102(b)(2)(A) exception, a 102(a)(2) reference is not prior art as of the effectively filed date if "the subject matter disclosed" was obtained from one or more members of the inventive entity, either directly or indirectly.

- This is similar to the exception in 102(b)(1)(A).

102(b)(2)(A) Exception Applies



* The U.S. application has been published

35 U.S.C. 102(b)(2)(B) Exception to 102(a)(2) Prior Art: Subject Matter In a Previous Inventor-Originated Disclosure

(2) DISCLOSURES APPEARING IN APPLICATIONS AND PATENTS.—A disclosure shall not be prior art to a claimed invention under subsection (a)(2) if—

. . . .

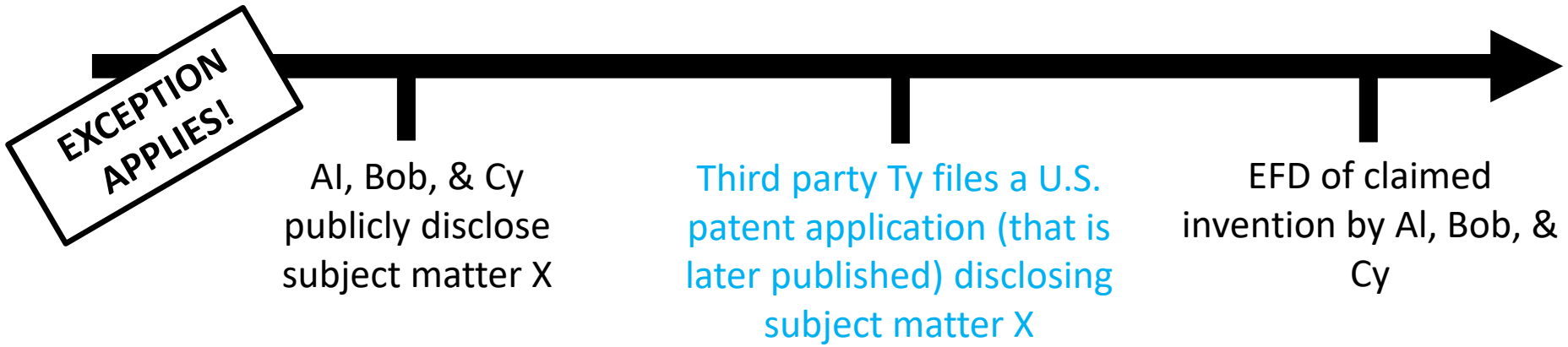
(B) the subject matter disclosed had, before such subject matter was effectively filed under subsection (a)(2), been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor

Applying the 102(b)(2)(B) Exception

For this exception to apply to a third party's U.S. patent document disclosing subject matter X:

- the third party's U.S. patent document must have been effectively filed before the effective filing date of the claimed invention,
- an inventor-originated disclosure must have been made prior to the third party's effectively filed date, and
- both must have disclosed subject matter X.

Applying the 102(b)(2)(B) Exception



Even though the application of Ty meets the requirements of 102(a)(2), it is not prior art to the claimed invention because the 102(b)(2)(B) exception applies.

The public disclosure of Al, Bob, and Cy may or may not be prior art; the 102(b)(1)(A) exception would apply to that disclosure if it were made within the grace period.

35 U.S.C. 102(b)(2)(C) Exception to 102(a)(2) Prior Art: Common Ownership

(2) DISCLOSURES APPEARING IN APPLICATIONS AND PATENTS.—A disclosure shall not be prior art to a claimed invention under subsection (a)(2) if—

. . . .

(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.

IMPORTANT: The common ownership exception does <u>not</u> apply to public disclosures under 102(a)(1).

35 U.S.C. 102(b)(2)(C) Exception to 102(a)(2) Prior Art: Common Ownership (cont.)

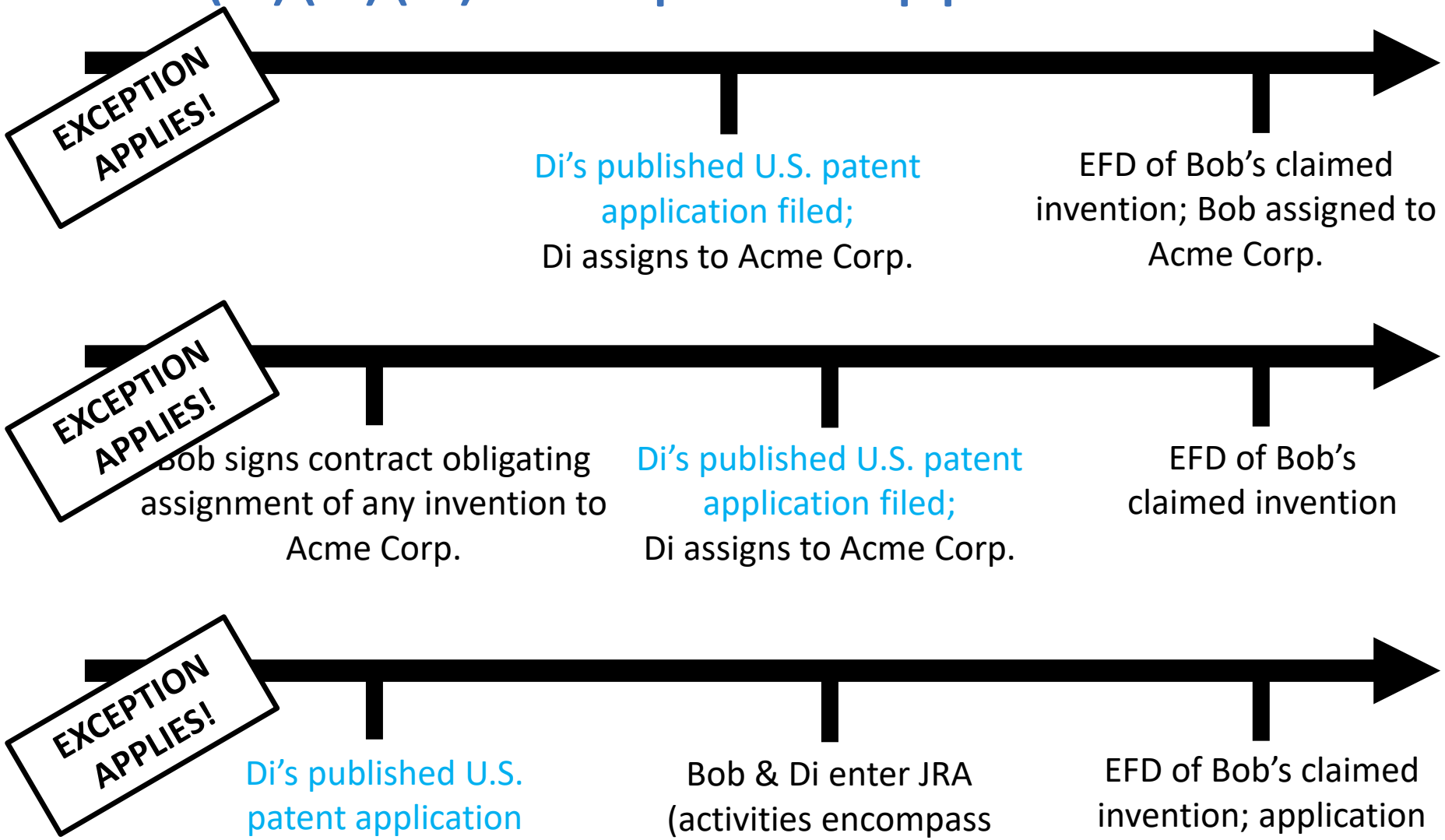
For the 102(b)(2)(C) exception to apply, the subject matter of the potential 102(a)(2) reference and the claimed invention in the application under examination must have been:

- owned by the same person,
- subject to an obligation of assignment to the same person, or
- deemed to have been owned by or subject to an obligation of assignment to the same person

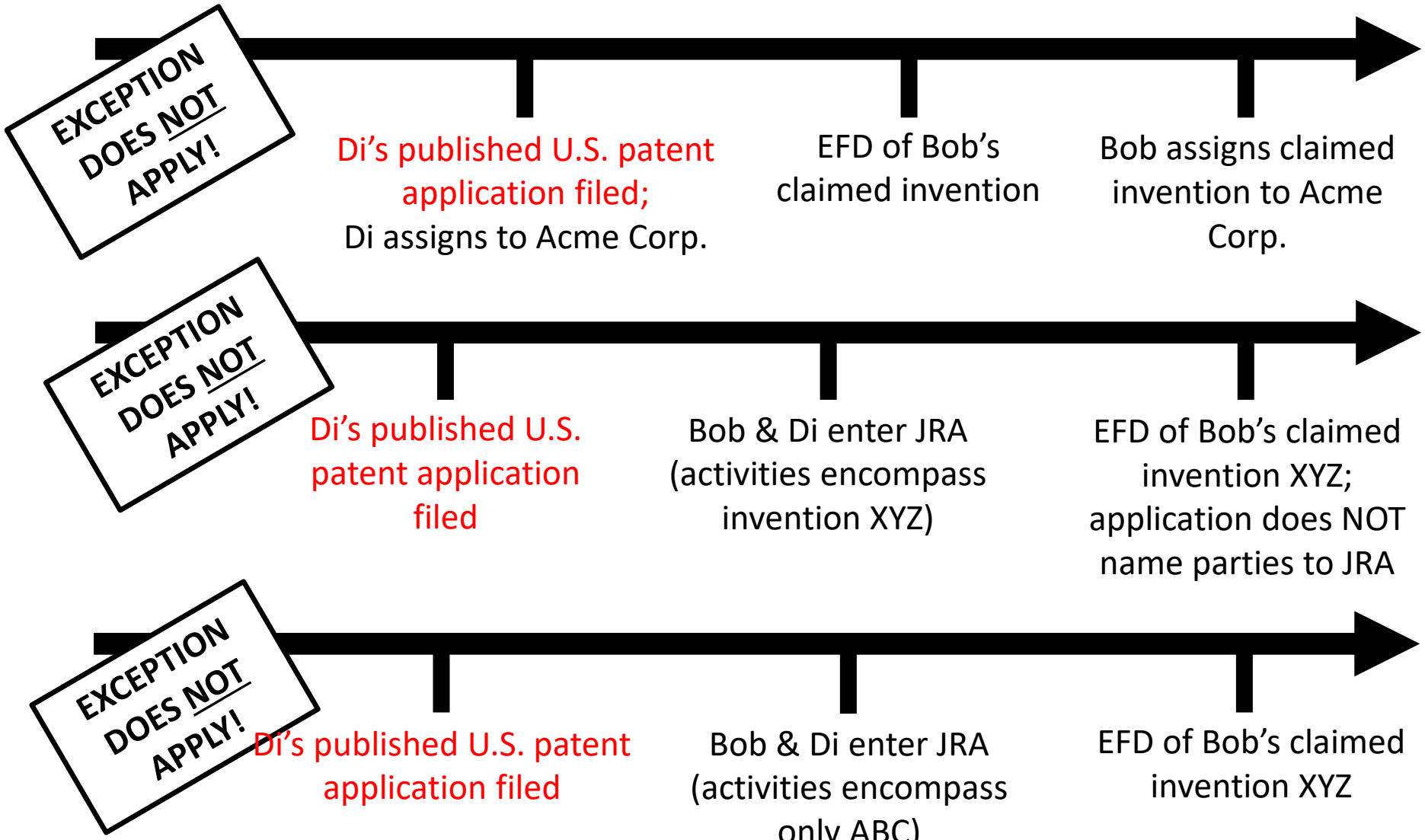
not later than the effective filing date of the claimed invention.

If this exception applies, a U.S. patent document cannot be used as 102(a)(2) prior art as of its effectively filed date, but it may still be used as 102(a)(1) prior art as of its publication or patent date.

102(b)(2)(C) Exception Applies



102(b)(2)(C) Exception DOES NOT Apply



Common Ownership Exception: AIA vs. pre-AIA Comparison

The 102(b)(2)(C) exception is similar to pre-AIA 103(c), but with some important differences:

- The AIA common ownership exception applies to anticipation as well as obviousness rejections, whereas the pre-AIA 103(c) exception applies only to obviousness rejections in which the prior art qualifies only under pre-AIA 102(e), (f), or (g).

- Under the AIA, common ownership must exist no later than the effective filing date of the claimed invention. By contrast, pre-AIA 103(c) requires common ownership as of the date that the claimed invention was made.

- Under both pre-AIA and AIA practice, a statement is sufficient and a declaration is not needed to establish common ownership.

Questions?

Klarquist

Thank You

Klarquist