Neifeld IP Law, PC

Brief Summary of "Examination Guidelines for Implementing the First Inventor To File Provisions of the Leahy-Smith America Invents Act" 78 FR 11059

FOR: NEIFELD IP LAW, PC

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SUMMARY

- This presentation contains the salient points from the Guidelines, in the form of quotes from the Guidelines.
- Significant points are emphasized by larger font size, bold, and/or italics

CONTENT OF DISCLOSURE

"The Office also indicated in the proposed examination guidelines that the subject matter in the prior disclosure being relied upon under AIA 35 U.S.C. 102(a) must be the **same "subject matter" as the subject matter previously publicly disclosed by the inventor** for the exceptions in AIA 35 U.S.C. 102(b)(1)(B) and 102(b)(2)(B) to apply, and 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. ... These examination guidelines **maintain the identical subject matter Interpretation of AIA 35 U.S.C. 102(b)(1)(B) and 102(b)(2)(B)."**

MODE OF DISCLOSURE

"These examination guidelines also clarify, in response to the public comment, that there is no requirement that the mode of disclosure by an inventor or joint inventor be the same as the mode of disclosure of an intervening disclosure (e.g., inventor discloses his invention at a trade show and the intervening disclosure is in a peer-reviewed journal)."

NEED NOT BE VERBATIM

"Additionally, there is no requirement that the disclosure by the inventor or a joint inventor be a verbatim or *ipsissimis verbis* disclosure of an intervening disclosure in order for the exception based on a previous public disclosure of subject matter by the inventor or a joint inventor to apply."

MORE GENERAL DESCRIPTION

"These guidelines also clarify that the exception applies to subject matter of the intervening disclosure that is simply a more general description of the subject matter previously publicly disclosed by the inventor or a joint inventor."

SECRET SALE OR USE

"The starting point for construction of a statute is the language of the statute itself. A patent is precluded under AIA 35 U.S.C. 102(a)(1) if "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."

SECRET SALE OR USE

"These examination guidelines indicate that the Office views the "or otherwise available to the public" residual clause of the AIA's 35 U.S.C. 102(a)(1) as indicating that secret sale or use activity does not qualify as prior art. These examination guidelines also indicate that an activity (such as a sale, offer for sale, or other commercial activity) is secret (non-public) if, for example, it is among individuals having an obligation of confidentiality to the inventor."

OFFERS FOR LICENSE

"The U.S. Court of Appeals for the Federal Circuit (Federal Circuit) has held that 'a 'license' that merely grants rights under a patent cannot per se trigger the application of the on-sale bar,' and that '[a]n offer to enter into a license under a patent for future sale of the invention covered by the patent when and if it has been developed * * * is not an offer to sell the patented invention that constitutes an on-sale bar.'"

OFFERS FOR LICENSE

"The case law distinguishing between offers for sale and offers for license under pre-AIA 35 U.S.C. 102(b) is equally applicable under AIA 35 U.S.C. 102(a)(1) as the AIA did not amend 35 U.S.C. 102 to change the treatment of the prior art effect of an offer for license."

ENABLEMENT AND "USE" OR "SALE"

"The case law provides that the enablement inquiry is applicable to the question of whether a claimed invention is described in a patent, published patent application, or printed publication, but is not applicable to the question of whether a claimed invention is ''in public use'' or ''on sale.'' The Office does not view the AIA as changing this principle of pre-AIA case law."

ENABLEMENT AND "USE" OR "SALE"

"The case law provides that the enablement inquiry is applicable to the question of whether a claimed invention is described in a patent, published patent application, or printed publication, but is not applicable to the question of whether a claimed invention is ''in public use'' or ''on sale.'' 12 The Office does not view the AIA as changing this principle of pre-AIA case law."

EXPERIMENTAL USE

"Neither the AIA nor its legislative history expressly addresses whether the experimental use exception applies to a public use under AIA 35 U.S.C. 102(a)(1), or to a use that makes the invention available to the public under the residual clause of AIA 35 U.S.C. 102(a)(1). Because this doctrine arises infrequently before the Office, and is case-specific when it does arise, the Office will approach this issue when it arises on the facts presented."

102(a)(1) "PUBLICLY AVAILABLE"

"The Federal Circuit recently reiterated that the ultimate question is whether the material was ''available to the extent that persons interested and ordinarily skilled in the subject matter or art[,] exercising reasonable diligence, can locate it.'"

WIPO PUBLICATIONS

"Under AIA 35 U.S.C. 102(a)(2), a person shall be entitled to a patent unless the claimed invention was described in an application for patent that was published or "deemed published" pursuant to 35 U.S.C. 122(b). In accordance with 35 U.S.C. 374, the WIPO publication of a PCT international application designating the United States is deemed a publication under 35 U.S.C. 122(b)."

HILMER DOCTRINE

"The "*Hilmer doctrine" as* discussed in MPEP § 2136.03 remains applicable to pre-AIA applications because AIA 35 U.S.C. 102(d) does not apply to pre-AIA applications."

("Under the "*Hilmer* doctrine," the foreign priority date of a U.S. patent (or U.S. patent application publication) may not be relied upon in determining the date that the U.S. patent (or U.S. patent application publication) is effective as prior art under pre-AIA 35 U.S.C. 102(e).")

ENABLEMENT AND ADMISSIONS UNCHANGED

"The Office does not view the AIA as changing the pre-AIA enablement requirement for prior art references."

"The Office included a discussion of admissions as prior art in the examination guidelines simply to indicate that the Office does not view the AIA as changing the status quo with respect to the use of admissions as prior art."

130 DECLARATION SHOWING

"An affidavit or declaration under 37 CFR 1.130(a) or (b) need not demonstrate that the disclosure by the inventor, a joint inventor, or another who obtained the subject matter disclosed directly or indirectly from an inventor or a joint inventor was an ''enabling'' disclosure of the subject matter within the meaning of 35 U.S.C. 112(a)."

130 DECLARATION SHOWING

"The Office has revised the guidance on the grace period inventor originated disclosure exception to indicate that what is required, within one year prior to the effective filing date, is communication of the subject matter by the inventor or a joint inventor prior to its disclosure by a noninventor. The level of communication in the inventor's or joint inventor's disclosure **need not be sufficient to teach one of ordinary skill how to make and use** so as to comply with 35 U.S.C. 112(a)."

AIA 3(n)(2) APPLICABILITY

"While the "shall apply to" language of [AIA] sections 3(n)(1) and 3(n)(2) is not parallel, section 3(n)(2) does indicate that the provisions of 35 U.S.C. 102(g), 135, and 291 as in effect on March 15, 2013, ***shall apply to "each claim" of an application for patent, and not simply the claim or claims having an effective filing date that occurs before March 16, 2013***, if the condition specified in section 3(n)(2) occurs."

AIA 3(n)(2) APPLICABILITY

"Therefore, 'each claim' of an application presenting a claim to a claimed invention that has an effective filing date before March 16, 2013, but also presenting claims to a claimed invention that has an effective filing date on or after March 16, 2013, is subject to AIA 35 U.S.C. 102 and 103 and is also subject to the provisions of 35 U.S.C. 102(g), 135, and 291 as in effect on March 15, 2013."

PLANT PATENTS

"35 U.S.C. 161 provides that the provisions of 35 U.S.C. relating to patents for inventions shall apply to patents for plants, except as otherwise provided. There is nothing in section 3 of the AIA that provides for an exception for plant applications and patents with respect to any of the provisions of AIA 35 U.S.C. 102 and 103. Thus, the provisions of AIA 35 U.S.C. 102 and 103 (including the one year grace period in AIA 35 U.S.C. 102(b)(1)(A) for inventor disclosures) are applicable to plant applications and patents."

THANK YOU!
QUESTIONS

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