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Patent Eligibility,
Prior Art and
Obviousness 2019:
Current Trends in
Sections 101, 102, and 103

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Prior Art—Putting Together Old and New 102

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“NEW” vs. “OLD” 102

The objective of this paper is to eliminate concern on your part about the need to know old and new law for the duration of your career. You do. But, this will not be as hard as you think. The “old” law is now down to being used in the **examination** of pre-March 16, 2013 PTO filings, and “transitional” continuations and divisionals thereof with an effective filing date before March 16, 2013 - **but, it will also be used for the next 30 years, at least, in evaluating the patentability of those patents issued from a pre-AIA law original examination, reissue, reexam or IPR.** And, do not forget about the “transitional cases” wherein you could have a mixture of old and new as the applicable law because of one or more newly added claims. Hence, the law of “prior art” must now necessarily look forward and backward at the same time from the “effective AIA date” of March 16, 2013.

THE “OLD” LAW

Firstly, do not read the law, i.e., the statute, when you want to know or remember something about it. At least do not read it until you have finished re-reading this paper. Oddly, the law (old or new) is not very readable or understandable until you have some background and context. So, read this and **then** read the law.

The sections of 35 USC 102 in effect until March 16, 2013, were derived from two centuries of Supreme Court precedent that followed from Thomas Jefferson’s original Patent Act in 1793. The bulk of the “old” (“first to invent”) law was enacted in 1952 and tweaked little since then.

The new law takes a new approach and does not rely on past decisions or thoughtfulness and has, as yet, no or few decisions (i.e., *Helsinn*) that give us any context. So, where the old law has many anecdotes and cases to help us comprehend the intent and objectives of the law, the new law has virtually or almost none. So, be prepared for a fairly literal approach to the new law by the PTO. It will be formulaic and derived, more or less, from the literal wording of the statute itself. The old law, as noted, has a big chunk of the MPEP in Chapter 2100 devoted to explaining nuance, etc. The new law is subject to first impression, and has its own smaller chunk in Chapter 2100.

The Courts and CAFC will take a much more expansive approach to what the new law means. We already have at least one decision that completely contradicts the PTO view of the world. Expect more as the years role past. And, if the past is any guide, it may take a decade or two for the S.Ct. to weigh in. (It spanned from 1952 until 1966 when the S.Ct.

first considered newly written 35 USC 103!) The one good thing about the new law is that it borrows several words and phrases from the old. This was done purposefully so that new ground would not be made at every turn. Some aspects though, and some sentiments, have been wholly discarded. Now, onto the old!

The old 102 can be broken down as follows: old 102(a)-(g) each reflect a single “sentiment” that is then fleshed out (in the wording of the statute) into acts and limitations:

102(a) – Fairness -You cannot get a patent on something someone else provably invented first. The proof accepted by the PTO is published documents or patents (from anywhere around the world), or that the invention was already known or used by others (in the US only), before your date of invention.

102(b) – Public Notice and Policy - Once an invention has entered the “public domain” by the inventor’s or another’s action, the inventor has a one-year grace period within which to decide whether to file a patent application. If the one-year deadline comes and goes, the inventor(s) is (are) barred from filing. Public domain is defined as published documents or patents (from anywhere), or public use or sale (in the US only).

102(c) – Reasonableness - You cannot patent something that you, personally, have publicly stated you have given up on.

102(d) – Negative Pressure – Bring Innovation to the US - You may begin the patent process outside the US in a foreign country, but once a year has come and gone from the foreign filing date, you are at risk of being barred from filing in the US if the foreign patent issues.

102(e) – Fairness – Round 2 - You cannot patent something someone else invented first (akin to 102(a)) if proof of the prior invention can be found in a previously filed and now issued, or published, US application that has a US filing date before your date of invention. (This sentiment also applies to published PCT applications filed on/after 11/29/00 that designate the US and publish in English.)

102(f) – No Theft - You can only patent what you invented; you may **not** patent the work of another.

102(g) – Fairness – Round 3 - The USPTO only gives out one patent for each invention. If more than one inventor claims the same invention, the PTO will conduct an “interference” to decide who truly invented first and will award the patent to that inventor.

Once you have understood the foregoing, go read the actual wording of the old statute; written by giants in the patent realm circa 1952: Giles Rich (at that time, President of the NY Patent Law Association) and Pasquale J. Federico (Chief Clerk at the USPTO, i.e., head of the Board of Appeals).

Aren't you glad we explained the foregoing in ordinary English first? Sure you are.

ONTO THE NEW

The new 102 is simpler and prizes certainty over “fairness.” The overarching goal of the new 102 is that the first inventor to file is the one who should end up with the patent. The filing process may begin in any country as long as it ends in an issued or published US application. Other patents and other publications may occur along the way in foreign countries, and those documents are accounted for in the new law as they were in the old, they are prior art as of their day of issuance or publication. End of story. It is the prior art effect of US patents, US published applications, and published PCTs that changed, along with the world wide playing field for acts like sale, and use, etc.

New 102 is divided into 102(a) – Prior Art; 102(b) – Exceptions to Prior Art under 102(a), including common ownership; 102(c) – definitions of common ownership under Joint Research Agreements; and 102(d) – definitions of “effective filing date” for prior art qualifying under 102(a)(2). That's it.

Prior Art

102(a)(1) – You cannot file a patent application on something that is already provably in the “public domain” before you first file in a patent office anywhere. The proof can be in the form of patents, printed publications, public use or sale, or otherwise in the “public domain,” all from **anywhere** in the world. So, a prior public disclosure, regardless of how the disclosure was made, as of the date that it was publicly accessible, is a bar.

102(a)(2) – You cannot file a patent application on something someone else filed on before you filed. But here the evidence is limited to prior filings only in the form of a previously filed published or issued US application (or its PCT equivalent), with the prior art date set as the earliest effective filed date (foreign or domestic) of that patented or published US application (or PCT).

Exceptions to Prior Art – It Gets Personal

Exceptions to 102(a)(1):

102(b)(1)(A) – A disclosure made by the inventor, or a person who obtained the disclosure from the inventor, within one year of [i.e., within one year **prior to**] the filing date does not qualify as prior art.

102(b)(1)(B) – Likewise, if the subject matter of a third party’s disclosure, made within one year prior to filing, was made public by the inventor, or someone who obtained it from the inventor, before the third-party’s disclosure thereof, the third party disclosure can none-the-less be disqualified as prior art.

Exceptions to 102(a)(2) disclosures in **prior-filed published or issued US applications**:

102(b)(2)(A) – A disclosure in a **prior-filed, published or issued, US application** is not prior art if the subject matter was obtained, directly or indirectly, from the inventor.

102(b)(2)(B) – Likewise, subject matter disclosed in the **prior third-party-filed, published or issued US application**, is not prior art if that same subject matter was first publicly disclosed, before the effective filing date of the third-party reference, by the inventor or another who had obtained the subject matter, directly or indirectly, from the inventor. This necessarily has a one year limitation inasmuch as if the inventor or third party relied on a pre-dating disclosure that occurred more than one before filing, that disclosure itself would be 102(a)(1) prior art and not subject to any exception!

102(b)(2)(C) – Likewise, if the subject matter disclosed, and the claimed invention, in the prior-filed, published or issued US application, were commonly owned (or under an obligation of assignment) by the owner of the application currently being examined before the effective filing date thereof, it would be disqualified as prior art.

Note: The exceptions under 102(b) are personal to the applicant(s) and do not waive or exclude third-party disclosures as prior art except in very narrow circumstances. If it were any other way, the result would undermine the first-to-file objective of the new law. The “grace period” is a quirk of the US patent system that has been held over from the old law, in most respects. The general notion is: if I “publish” my invention, one way or another, I have one year to decide whether to file a patent application on my disclosure. **No intervening disclosure inside the one year period can stop my filing at least as to exactly what I**

published or disclosed. Inside the one year period, you are inside the “grace period” exceptions of new 102(b). If I do not publish, it is a race to the patent office. Hence, some filers will decide to publish (if they must) first and then file some sort of application on or in advance of the one year anniversary of the day that they published. Given that intervening third party non-identical prior art cannot be disqualified, this “publish first approach” may be foolhardy.

Defining Common Ownership under a Joint Research Agreement:

Joint ownership under a Joint Research Agreement exists if:

102(c)(1) – the claimed invention was made by parties to the agreement and the agreement was in effect before the effective filing date, and

102(c)(2) – the invention resulted from activities within the scope of the agreement, and

102(c)(3) – the application discloses the names of the parties to the agreement.

Defining the Effectively Filed Date of published or issued US applications:

102(d)(1) – The effectively filed date is the actual filing date of the application, unless

102(d)(2) – there is a claim for priority or benefit, then the earliest priority or benefit date is the effectively filed date.

See? Simple. Now go read the wording of the actual statute. It is almost unintelligible.

Here is a handy chart that sets forth;

the types of **prior art** defined in section 102(a)(1) along with its **exceptions** under 102(b)(1), and

the types of **prior art** defined in section 102(a)(2) along with its **exceptions** under 102(b)(2):

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

Sections 102(a)(1) and 102(a)(2) are the only 2 sections of 102 of the AIA that define prior art.

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

Unlike pre-AIA law, the AIA provides that a **foreign priority date can be the effective filing date** of a claimed invention. **The foreign priority date is the effective filing date of the claimed invention IF**

- the foreign application supports the claimed invention under 112(a), AND
- the applicant has perfected the right of priority by providing a certified copy of the priority application, and a translation of the priority application (if not in English).

Just as under pre-AIA law, determining the effective filing date of the claimed invention is a claim-by-claim analysis. So, different claims in the same application may have different effective filing dates.

102(a)(1) prior art: precludes a patent if a claimed invention was, before the effective filing date of the claimed invention: patented; described in a printed publication; in public use; on sale; or otherwise available to the public.

“Patented” under 102(a)(1) refers to: an (issued) U.S. patent, and an (issued) foreign patent in any language. This is not a change from pre-AIA law. “Printed publication” under 102(a)(1) may include: U.S.

patent application publications and WIPO published PCT (international) applications, foreign patent documents (patents and published applications), journal articles, technical manuals, magazines, newspapers, and books, poster presentations and handouts at scientific meetings, advertising, material posted on Internet Websites.

Important facts about a “printed publication” under 102(a)(1): A printed publication is prior art as of the date that it is **publicly accessible**. The printed publication may be in any language. This is not a change from pre-AIA law.

“Otherwise available to the public” is a new catch-all provision of 102(a)(1) that has no counterpart in pre-AIA law. For example: an oral presentation at a scientific meeting, a demonstration at a trade show, a lecture or speech, a statement made on a radio talk show, a YouTube video, Web site, or other on-line material (this type of disclosure may also qualify as a printed publication under AIA and pre-AIA law).

Exceptions to 102(a)(1) prior art: 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 two types of exceptions stated in 102(b)(1) applies. The two types of 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. **The two types of exceptions are set forth in 102(b)(1)(a) and 102(b)(1)(b) - and they apply to 102(a)(1) prior art!**

102(b)(1) sets forth the EXCEPTIONS to 102(a)(1) prior art:

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 102(a)(1) if:

102(b)(1)(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.

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)(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.

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. "[A]nother" is defined as someone who disclosed subject matter that was obtained directly or indirectly from one or more members of the inventive entity; "third party" is someone who disclosed subject matter but did **not** obtain it, directly or indirectly, from a member of the inventive entity. **When the 102(b)(1)(B) exception applies, the inventor's prior public disclosure of subject matter X acts to "shield" the claimed invention from a prior art rejection based on the third party's intervening disclosure of subject matter X. Although the same "subject matter" must be disclosed, there is no requirement that the inventor-originated disclosure and the third party's intervening disclosure be made in the same manner; or that the two disclosures be made using identical words, figures, tables, or other forms of expression. 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.**

Note: 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.

102(a)(2) prior art: precludes a patent if 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**. Coupled with the definitions given in 102(d) (see below) – this section 102(a)(2) establishes prior art that is analogous to prior art that was defined in the pre-AIA sections 102(e)(1) and 102(e)(2) – with

the major change being that foreign priority filing dates may now be the effective filing date.

NOTE: 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). They may, however, be printed publication prior art under 102(a)(1).

Only U.S. patent documents can be applied under 102(a)(2). A WIPO published PCT application must have designated the U.S. 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 as was required in pre-AIA 102(e).

Under 102(a)(2), a disclosure in a U.S. patent document, including a WIPO published PCT (international) application, is not prior art unless the document names “**another inventor**” (i.e., a **different inventive entity**). 102(a)(2) precludes a patent if, before the effective filing date of a claimed invention, the claimed invention was described in a U.S. Patent, a U.S. Patent Application Publication, or a WIPO published PCT (international) application that designated the United States, that names a different inventive entity and was effectively filed before the effective filing date of the claimed invention.

102(d), entitled PATENTS AND PUBLISHED APPLICATIONS EFFECTIVE AS PRIOR ART, sets forth the definition of the effectively filed (prior art) date of U.S. patents and published applications.

For purposes of determining whether a patent or application for patent is prior art to a claimed invention under 102(a)(2), such patent or application shall be considered 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**.

Bottom line: A U.S. patent document may be applied as prior art as of its **effectively filed date, which now includes a foreign priority date**. This is a major change from the pre-AIA 102(e). 35

U.S.C 102(d) is NOT, however, the basis for a prior art rejection; it would be 102(a)(2).

To rely on an effectively filed date that is earlier than the actual filing date of a potential 102(a)(2) reference: the U.S. patent document must claim **priority to, or benefit of**, the prior **foreign or domestic** application AND the prior (foreign or domestic) application must describe the subject matter being relied upon. Priority to a prior foreign application need NOT have been perfected to rely on the **effectively filed date** of a 102(a)(2) reference in a rejection.

There are three exceptions to 102(a)(2) prior art: 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 3 **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 three 102(b)(2) exceptions do not involve the one-year grace period. Point of emphasis: The three 102(b)(2) exceptions apply to 102(a)(2) prior art!**

The **three** exceptions under 102(b)(2):

102(b)(2) - DISCLOSURES APPEARING IN APPLICATIONS AND PATENTS. A disclosure shall not be prior art to a claimed invention under 102(a)(2) if -

- the 102(b)(2)(A) Exception - the subject matter disclosed was obtained directly or indirectly from the inventor or a joint inventor. 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).
- the 102(b)(2)(B) Exception - the subject matter disclosed had, before such subject matter was effectively filed under 102(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. 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.
- the 102(b)(2)(C) exception - 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 not apply to public disclosures under 102(a)(1).** 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.

A definition is set forth in 102(c) of 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.

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 (102) as well as obviousness (103) rejections, whereas the pre-AIA 103(c) exception applies only to obviousness (103) 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.

An applicant may overcome or avoid a rejection under 102(a)(1) or 102(a)(2) by filing a **declaration** under 37 CFR 1.130. Declarations under 37 CFR 1.130 are used to invoke an **exception**.

A declaration of **attribution**, showing that the disclosure is the inventor's work, may be made under Rule 130(a) to invoke the exception applicable under 102(b)(1)(A) and under 102(b)(2)(A).

A declaration of **prior public disclosure**, showing that the 3rd party's disclosure was preceded by an inventor-originated disclosure of the subject matter, may be made under Rule 130(b) to invoke the exception applicable under 102(b)(1)(B) and under 102(b)(2)(B).

An applicant may **not** rely on a declaration under 130(a) or 130(b) to establish an exception to prior art when the disclosure was publicly available **before** the grace period. This is because 102(b)(1) requires that a disclosure under 102(a)(1) is not subject to an exception if it is made more than 1 year before the effective filing date of the claimed invention, i.e., before the grace period.

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