Tuesday, December 20, 2016 / Volume 108 / Number 243

THE DAILY RECORD

WESTERN NEW YORK'S SOURCE FOR LAW, REAL ESTATE, FINANCE AND GENERAL INTELLIGENCE SINCE 1908

IP FRONTIERS

A primer on prior art

I know that the rules on what constitutes prior art can be as boring as month-old fruit cake. However, it is important for inventors to have a general knowledge, and for patent professionals to have a detailed knowledge, of those prior art rules. This article will concentrate on prior art law under the Leahy-Smith America Invents Act (herein the "AIA"), and will point out some of the significant differences relative to prior art governed by pre-AIA patent law. The goal of this article is to provide a basic overview of the AIA rules and is not intended to be comprehensive.

The AIA shifted the focal point of what constitutes prior art from the "date of invention" to the "effective filing date" of a claimed invention. The AIA patent law applies to any application containing at least one claim having a filing date of March 16, 2013 or later.

Under both AIA and pre-AIA patent law, prior art is defined in 35 United States Code (herein the "USC") section 102. Pre-AIA patent law included seven sub-sections defining various conditions for patentability under 35 USC 102 (a) – (g). AIA patent law redefined the conditions for patentability under the new sections of:

- 35 USC 102 (a) (1) plus associated exceptions detailed in 35 USC 102 (b) (1); and
- 35 USC 102(a) (2) plus associated exceptions detailed in 35 USC 102 (b) (2).

We will examine the new sections 102 (a) (1) & (2) plus their associated exceptions sequentially.

35 USC 102 (a) (1): Public Disclosures, Made Anywhere or In Any Language

Section 102 (a) (1) basically states that any document or activity (collectively known as disclosures) is prior art relative to a claimed invention if the disclosure was made publicly available before the effective filing date (herein the "EFD") of that claimed invention. This is regardless of how the public disclosure was made, where in the world it was made or in what language it was made. This new definition of prior art under the AIA removes any geographic and language restrictions imposed by pre-AIA law and, therefore, greatly expands the scope of prior art.

By STEPHEN P. SCUDERI
Daily Record Columnist

A public disclosure can be patented (in the U.S. or any foreign country), described in a printed publication (in any language or in any country), in public use (anywhere in the world), on public sale (in any country) or otherwise available to the public. Moreover, the term "otherwise available to the public" is a catchall phrase that has no counterpart in pre-AIA law. Therefore, for example, an oral presentation at a scientific meeting in China, given in Chinese, can theoretically be 102 (a) (1) prior art against a U.S. patent application, if the date of the presentation can be established to be before the EFD of the U.S. patent application.

35 USC 102 (b) (1): Exceptions to Public Disclosures As Prior Art

Even though a public disclosure of a claimed invention falls within the scope of section 102 (a) (1), it may not be used as prior art if the public disclosure also falls within the scope of one of the two categories of exceptions stated in 35 USC 102 (b) (1). Broadly, those exceptions include disclosures made public within one year or less (the grace period) before the EFD of a claimed invention that are either:

- inventor-originated disclosures (i.e., disclosures by the inventor or obtained from the inventor either directly or indirectly) as described in 35 USC 102 (b) (1) (A); or
- intervening third-party disclosures (i.e., disclosures made by a third party that did not obtain the invention from the inventor either directly or indirectly) made after an inventor-originated disclosure as described in 35 USC 102 (b) (1) (B).

It is important to note that under the AIA, an EFD for a claimed invention is defined in 35 USC 100 (i), which takes into account both foreign priority and domestic benefit dates. By contrast, under pre-AIA law, foreign priority dates could not be taken into account for a U.S. claimed invention.

Accordingly, as an example of a 102 (b) (1) (A) exception having a foreign priority date as its EFD, a U.S. patent application may be filed on March 1, 2016 and have a foreign priority claim to a German patent filed on March 1, 2015 in which that German patent describes the claimed invention in the German language. As such, under section 102 (b) (1) (A), any inventor-originated disclosure (that is, any public disclosure by any of the inventors, or by anyone who obtained the invention directly or indirectly from the inventors) would not be prior art under 35 USC 102 (a) (1) if made on or after March 1, 2014. This is because the one-year grace period

Continued on next page

Continued from previous page

is measured from the foreign priority date (the EFD) of March 1, 2015.

As an example of a 102 (b) (1) (B) exception, a U.S. patent application may be filed on March 1, 2016 and have an EFD of that same date. As such, under section 102 (b) (1) (B), if there was an invention originated disclosure on March 1, 2015 and an intervening third party disclosed the claimed invention on April 1, 2015, the third party's disclosure would not be prior art under 102 (a) (1). Note also that in this example, the inventor-originated disclosure is also not prior art under section 102 (a) (1) because it is within the one-year grace period. However, if the inventor-originated disclosure were made on Feb. 28, 2015, the inventor-originated disclosure would be prior art under 102 (a) (1) because the inventor-originated disclosure falls outside of the grace period.

35 USC 102 (a) (2): US Patent Documents, a Subset of Public Disclosures

Section 102 (a) (2) pertains to a subset of 102 (a) (1) public disclosures known collectively as U.S. patent documents. More specifically, U.S. patent documents include:

- issued U.S. patents;
- published U.S. patent applications; and
- WIPO published PCT (international) applications that designated the United States.

Since public disclosures under 102 (a) (1) also include U.S. patent documents, such U.S. patent documents may be applied as 102 (a) (1) prior art references as of their publication dates. However, under 102 (a) (2), U.S. patent documents may also be applied as 102 (a) (2) prior art references as of their effectively filed dates.

The "effectively filed date" for subject matter used in a 102 (a) (2) reference is similar to an EFD for a claimed invention and is defined in 35 USC 102 (d) as the earlier of:

- the actual filing date of the U.S. patent or published U.S. or WIPO application, or
- the filing date of the earliest application to which the U.S. patent or published U.S. or WIPO application is entitled to claim a right of foreign priority or domestic benefit which describes the subject matter.

35 USC 102 (b) (2): Exceptions to US Patent Documents As Prior Art

Even though a public disclosure of a claimed invention falls within the scope of 102 (a) (2) (i.e., is a U.S. patent document), it may not be used as a 102 (a) (2) prior art reference if the public disclosure also falls within the scope of one of the three exceptions stated in 35 USC 102 (b) (2). Broadly, those exceptions include:

- disclosures by another obtained from the inventor (directly or indirectly) as described in 35 USC 102 (b) (2) (A);
- intervening third-party disclosures that were effectively filed before the EFD of the claimed invention, but after an inventor-originated disclosure as described in 35 USC 102 (b) (2) (B); or
- the disclosure and the claimed invention are commonly owned, or under an obligation to be commonly owned, by the same person no later than the EFD of the claimed invention as described in 35 USC 102 (b) (2) (C).

It is important to note that if any U.S. patent documents cannot be used as 102 (a) (2) prior art as of their effectively filed date because they fall under one of the 102 (b) (2) (A), (B) or (C) exceptions listed above, they still may be used as 102 (a) (1) prior art for public disclosures as of their publication or patent date.

Conclusion

The scope of AIA prior art is defined in 35 USC 102. Under 102 (a) (1), any public disclosure may be a prior art reference as of the date it becomes publically available. Under 102 (a) (2), any U.S. patent document may be a prior art reference as of its effectively filed date. Under 102 (b), both public disclosures and U.S. patent documents are limited as prior art references by certain exceptions.

This article is only a basic overview and is not intended to be comprehensive. Inventors should be generally aware of what could potentially be a prior art reference, but should rely on patent professionals for an accurate determination of how any such potential prior art reference applies to their invention.

Stephen P. Scuderi is an associate with the Intellectual Property Law Firm of Heslin Rothenberg Farley & Mesiti P.C. He can be reached at (518) 452-5600 or at stephen.scuderi@hrfmlaw.com.