

Patent Reform: First Inventor To File Provision



Presented By:

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For Strafford Webinar

November 15, 2011

LEGISLATION TIMELINE

2006



S. 3318



2005



H.R. 2795



2001 - 2004



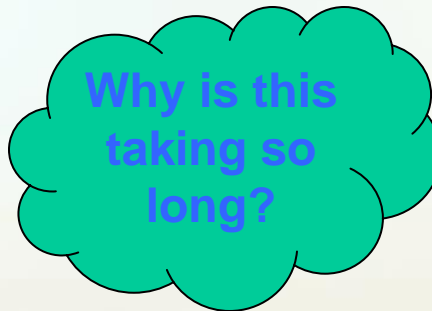
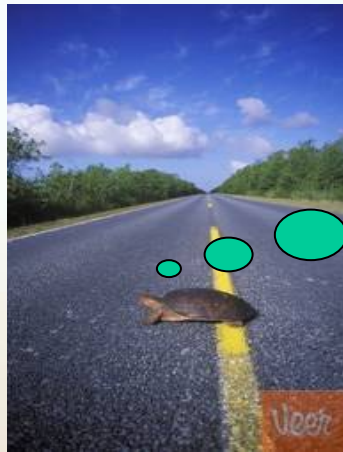
Senate Hearings / FTC / NAS

SPIVAK

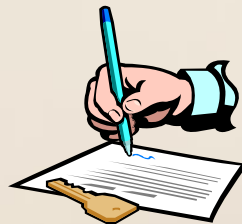
2007



H.R. 1908



September 16, 2011



2007



S. 1145



H.R. 1249

March, 17 2009



S. 610

June 23, 2011

March 3, 2009



S. 515

March 2, 2011



S.23 MA

April 2, 2009



S. 515 MA #1

March 5, 2010



S. 515 MA #2

LEGISLATIVE INITIATIVES

PROSECUTION:

- First Inventor To File (§ 3)
- Best Mode (§ 15)
- Priority Examination (§ 25)
- Assignee Filing (§ 4)
- Third Party Submissions (§ 8)

- USPTO Changes
 - Fee Setting (§ 11)
 - Funding (§ 22)
 - Satellite Offices (§ 23)

POST GRANT PROCEEDINGS:

- Post-Grant Review (§ 6)
- Inter Partes Review (§ 6)
- Supplemental Examination (§ 12)
- Transitional Program for Business Method Patents (§ 18)

LITIGATION:

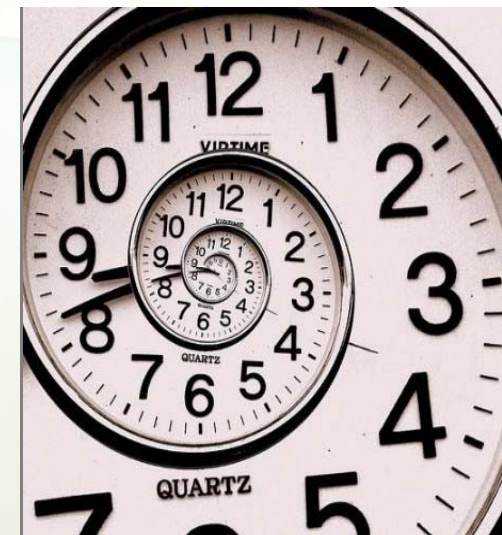
- Prior User Rights (§ 5)
- Marking (§ 16)
- Advice of Counsel (§ 17)

OUTLINE

- 1) Prosecution**
- 2) Post Grant**
- 3) Litigation**

All the questions raised by the America Invents Act will not be answered this year

- ◆ Current law was written in 1952
 - ◆ *Hazeltine Research, Inc. v. Brenner* (Sup. Ct. 1965) (Applying 102(e) prior art to obviousness analysis)
 - ◆ *In re Hilmer* (CCPA 1966) (denying prior art effect under 102(e) to a foreign priority date)
 - ◆ *Pfaff v. Wells Electronics*. (Sup. Ct. 1998), (a reduction to practice is not required for a 102(b) "on sale" bar)



PROSECUTION

First Inventor to File

Towards Global Harmony?

First-to-Invent
(US)

First-to-File
(Rest of the World)



Global Harmony

First Inventor to File

Not Real Global Harmony

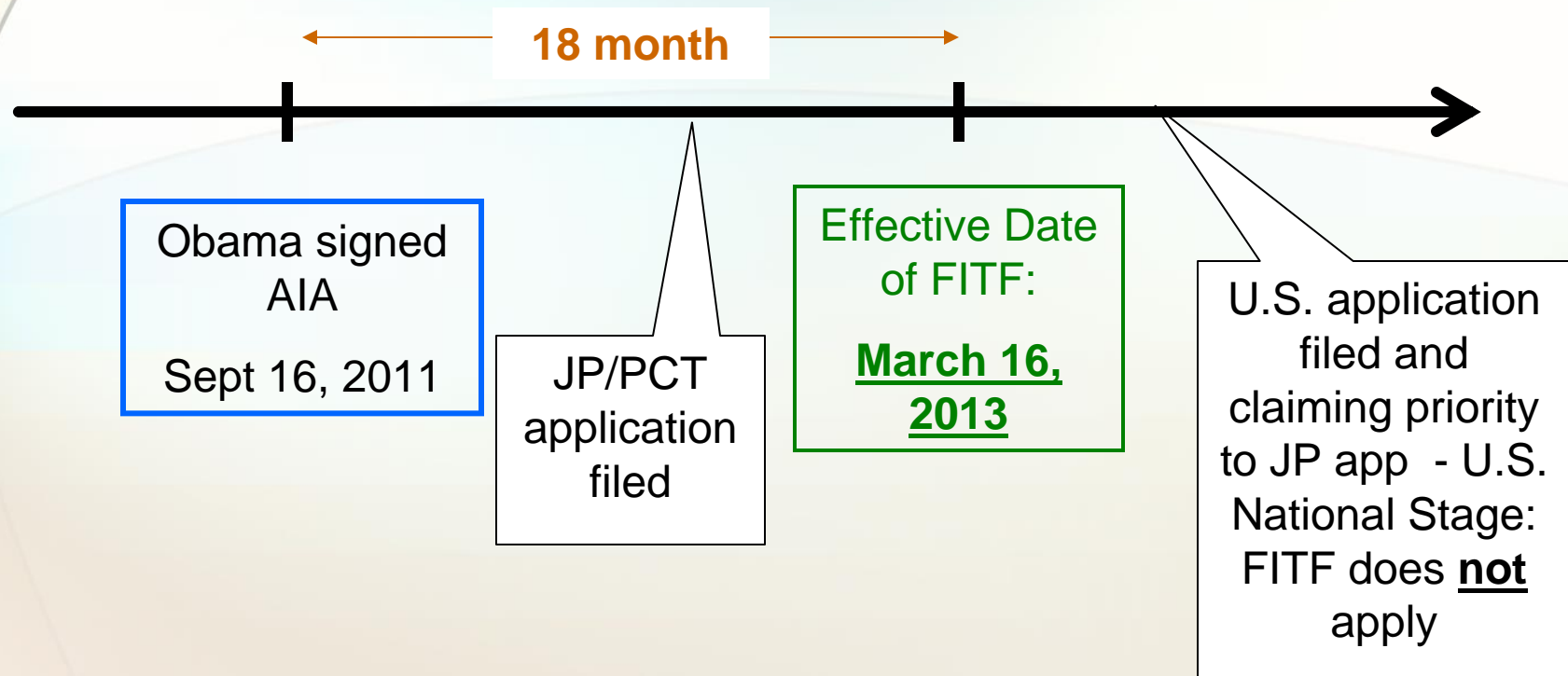
**First-to-Invent
(US)**
(Patents with
effective filing date
prior to March 2013)

**First-Inventor
to-File
(US)**
(Patents with
effective filing date
after to March 2013)

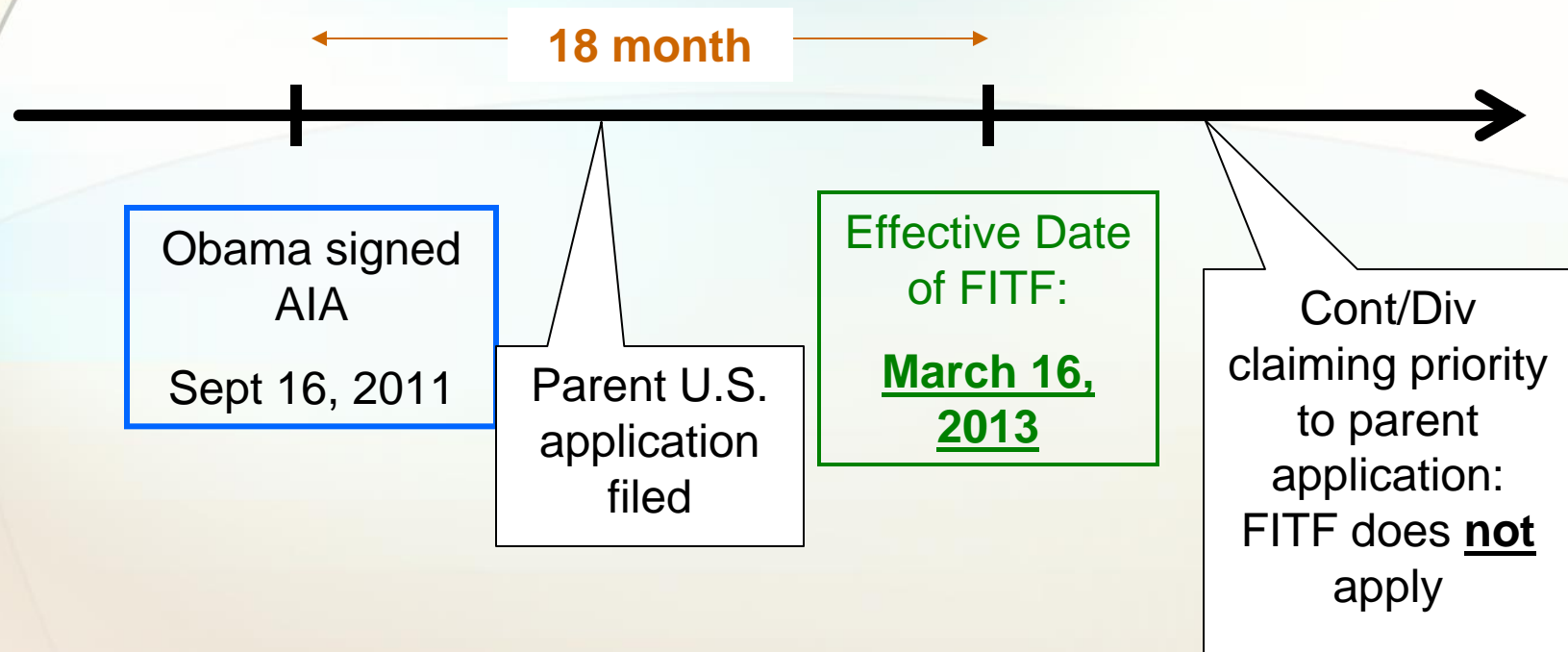
**First-to-File
(Rest of the World)**

**The Leahy Smith
America Invents Act
presents a unique
“first to file” system**

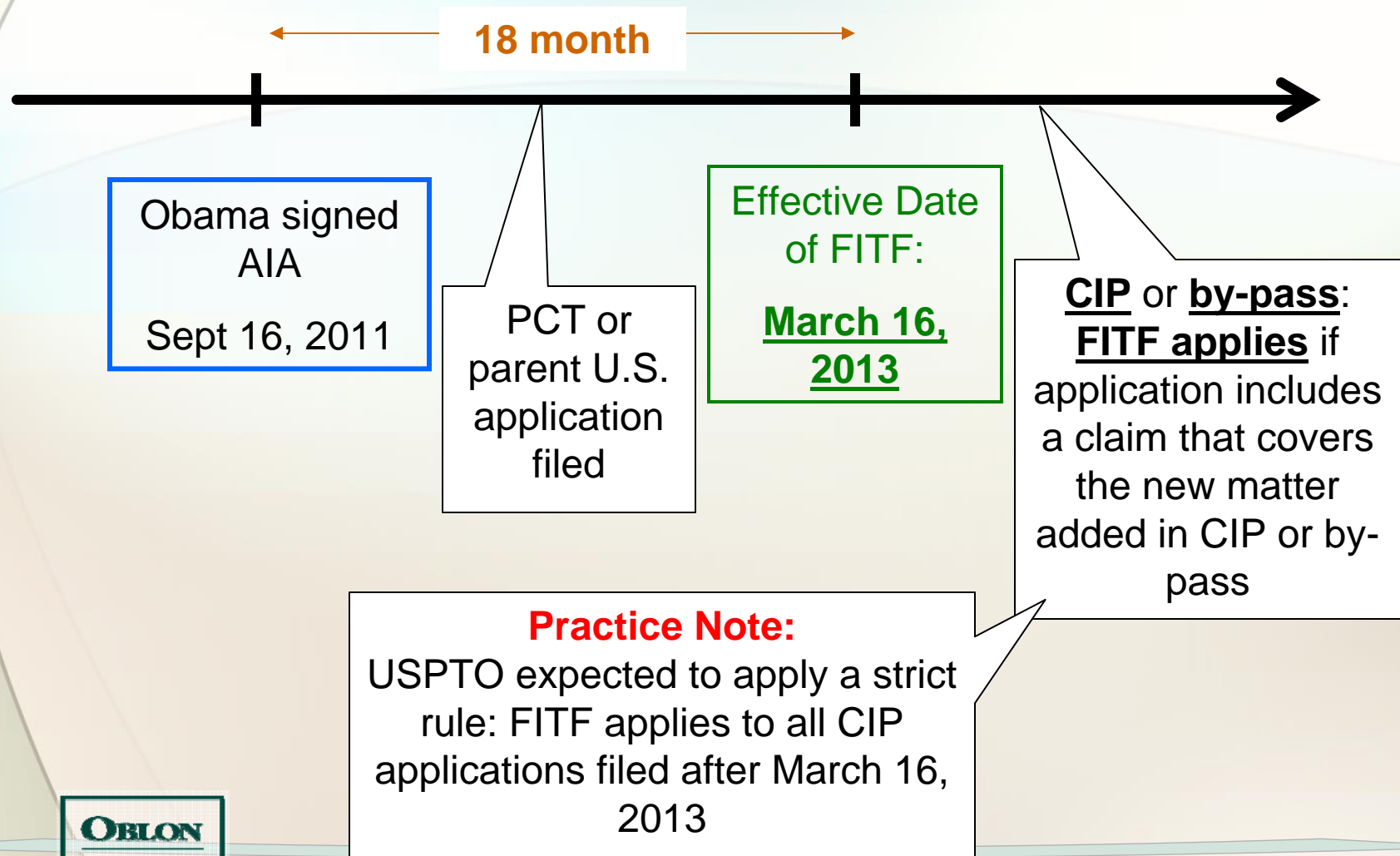
First Inventor To File: Effective Date



First Inventor To File: Effective Date



First Inventor To File: Effective Date



First Inventor To File

§ 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

First Inventor To File

§ 102. Conditions for patentability: novelty

(a) **NOVELTY; PRIOR ART**
to a patent unless—

(1) the claimed invention was not
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

Practice Notes:

Includes foreign priority date and
provisional application filing date.
May require English translation of
priority document.

131 Declarations to show an earlier
date of invention will no longer be
available

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§ 102. Conditions for patentability; novelty

(a) NOVELTY
to a patent

Practice Note:
The publication does not need to be actually “printed”. The publication can be published on any medium, such as electronic

shall be entitled

(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

Practice Notes:
1) Anywhere in the World!
2) By anyone (not limited to “others”)

§ 102. Condi

(a) NOVELTY; to a patent

Open questions:

- 1) Does “public use” include a secret commercial use of the claimed invention by the inventor – i.e., is *Metallizing Engineering Co. v. Kenyon Bearing & Auto Parts Co.*, 153 F.2d 516 (2d Cir. 1946) and the jurisprudence relying on that case overruled)?
- 2) Does “on sale” include non-public offers for sales (private, confidential) by applicant?
- 3) **Practice note:** It may be safer to assume that the answer is “yes” until CAFC address these issues

(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

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§ 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

Practice Note:

Probably includes **oral presentations** at conferences by anyone

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§ 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.

Practice Note:

This provision only applies to **U.S.** patents **U.S.** published applications, and published PCT applications that designate the U.S.

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§ 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.

Practice Notes:

This provision applies to published PCT applications that designate the U.S. (see 35 USC 374).

No more language requirement: can file PCT in language other than English and create prior art under 102(a)(2)

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§ 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.

Practice Note:

U.S. patents, **U.S.** published applications, and published PCT applications designating the U.S. become prior art as of their earliest filing dates, including foreign priority (The *Hilmer* Doctrine is repealed). See new 102(d).

No need to file provisional applications for foreign applicants

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§ 102. Conditions for patentability; novelty

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

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Practice Note:

U.S. patents, U.S. published applications, and published PCT applications designating the U.S. become prior art as of their earliest filing dates for both novelty and non-obviousness

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§ 102. Conditions for patentability; novelty (cont'd)

(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; 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.

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§ 102. Conditions for patentability; novelty (cont'd)

(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; or

(B) the subject matter disclosed was disclosed by the inventor or joint inventor, or another who obtained the subject matter disclosed from the inventor or a joint inventor, but only if the disclosure was not publicly disclosed by the inventor or joint inventor, or another who obtained the subject matter disclosed from the inventor or a joint inventor, before the effective filing date of the claimed invention.

Practice Note:

International grace period: one year prior to foreign priority

disclosure, been publicly disclosed by another who obtained the subject matter disclosed from the inventor or a joint inventor, before the effective filing date of the claimed invention.

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§ 102. Conditions

Practice Note:
“personal grace period” (cont’d)

(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; 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.

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§ 102. Conditions for patentability; novelty (cont'd)

(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—

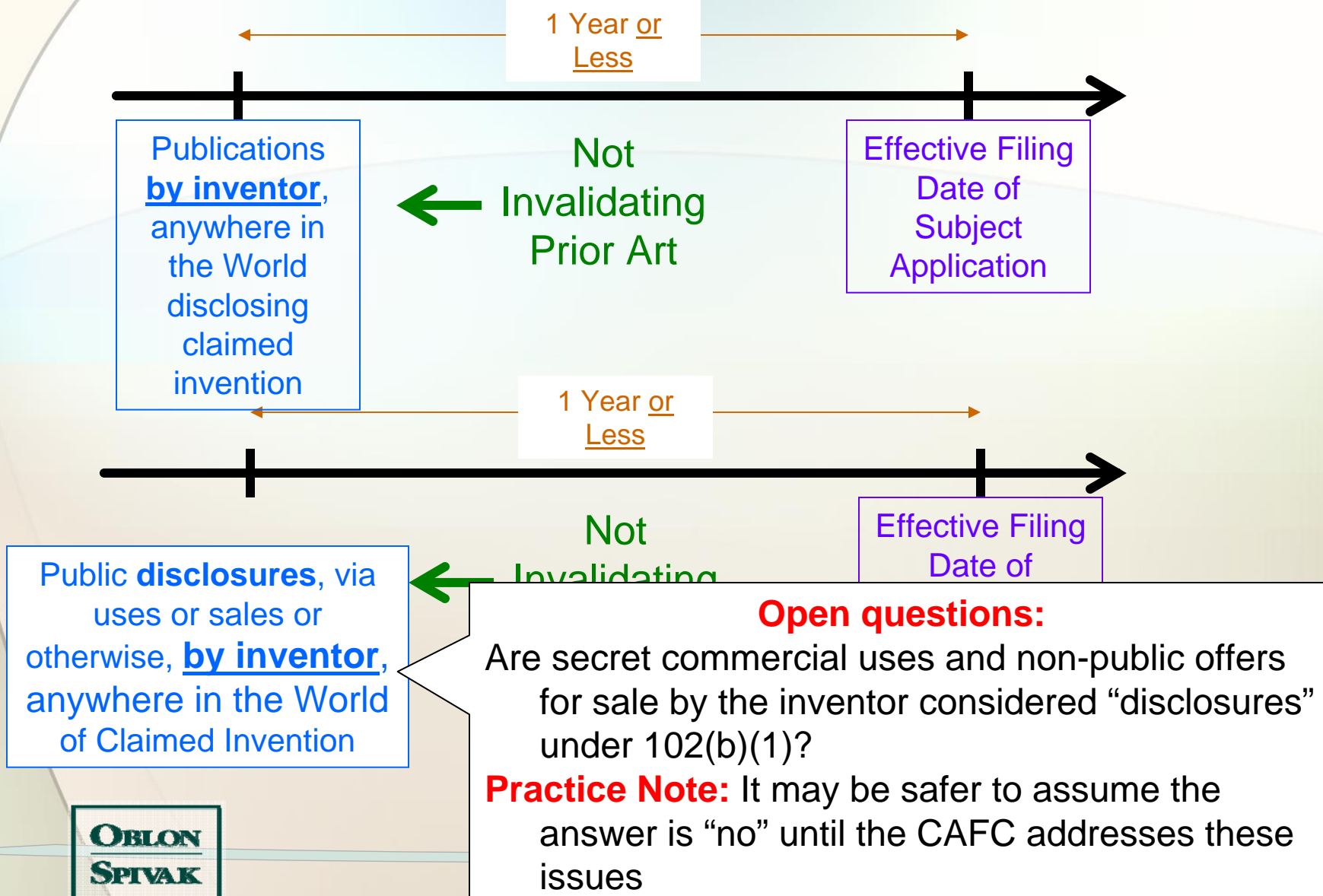
- (A) the disclosure was made by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor; or
- (B) the subject matter disclosed had, before such disclosure, been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor.

Practice Note:

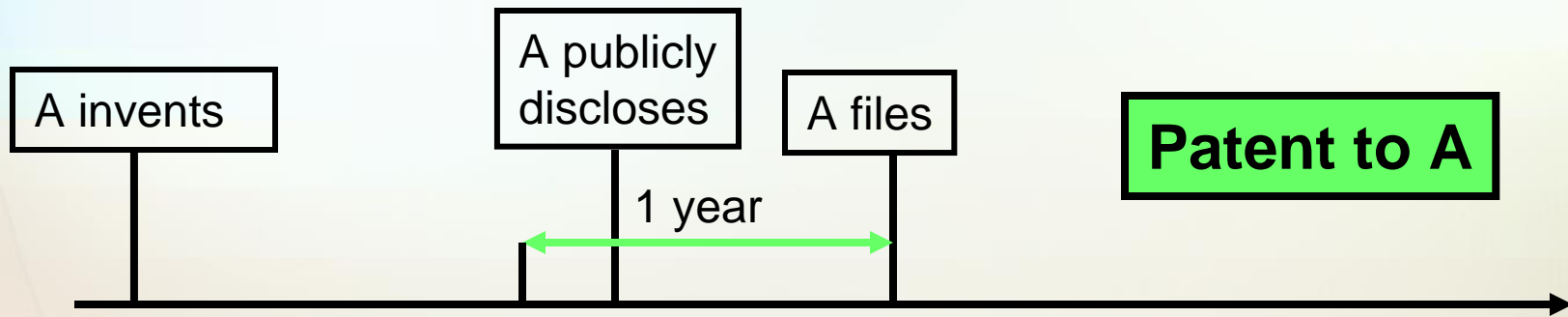
“First to disclose” system

First Inventor To File

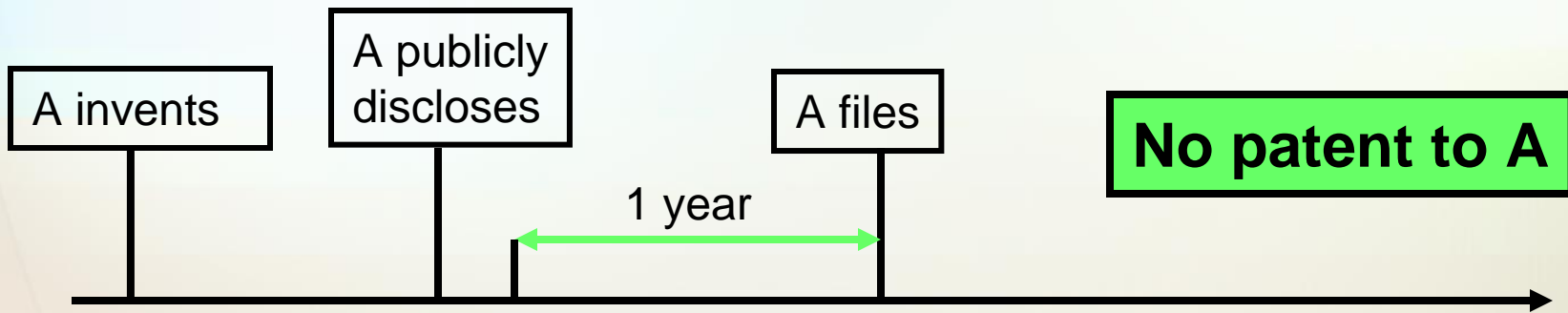
102(b)(1)(A): Personal grace period



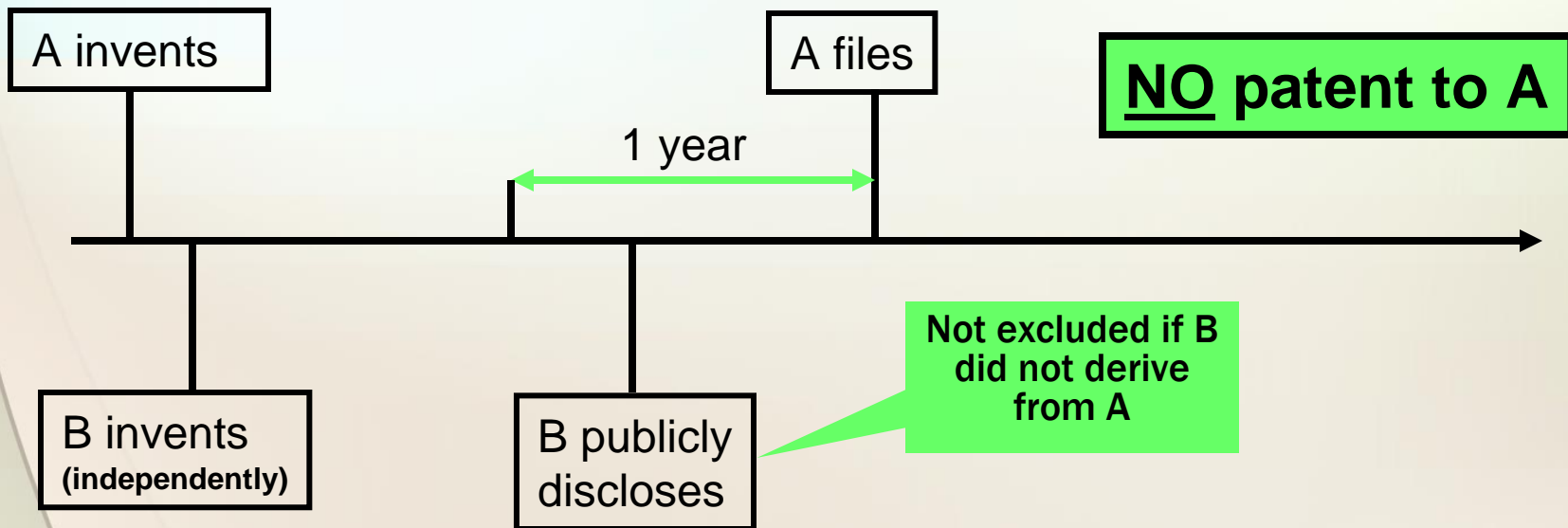
Example 102(b)(1)(A)



Example 102(b)(1)(A)

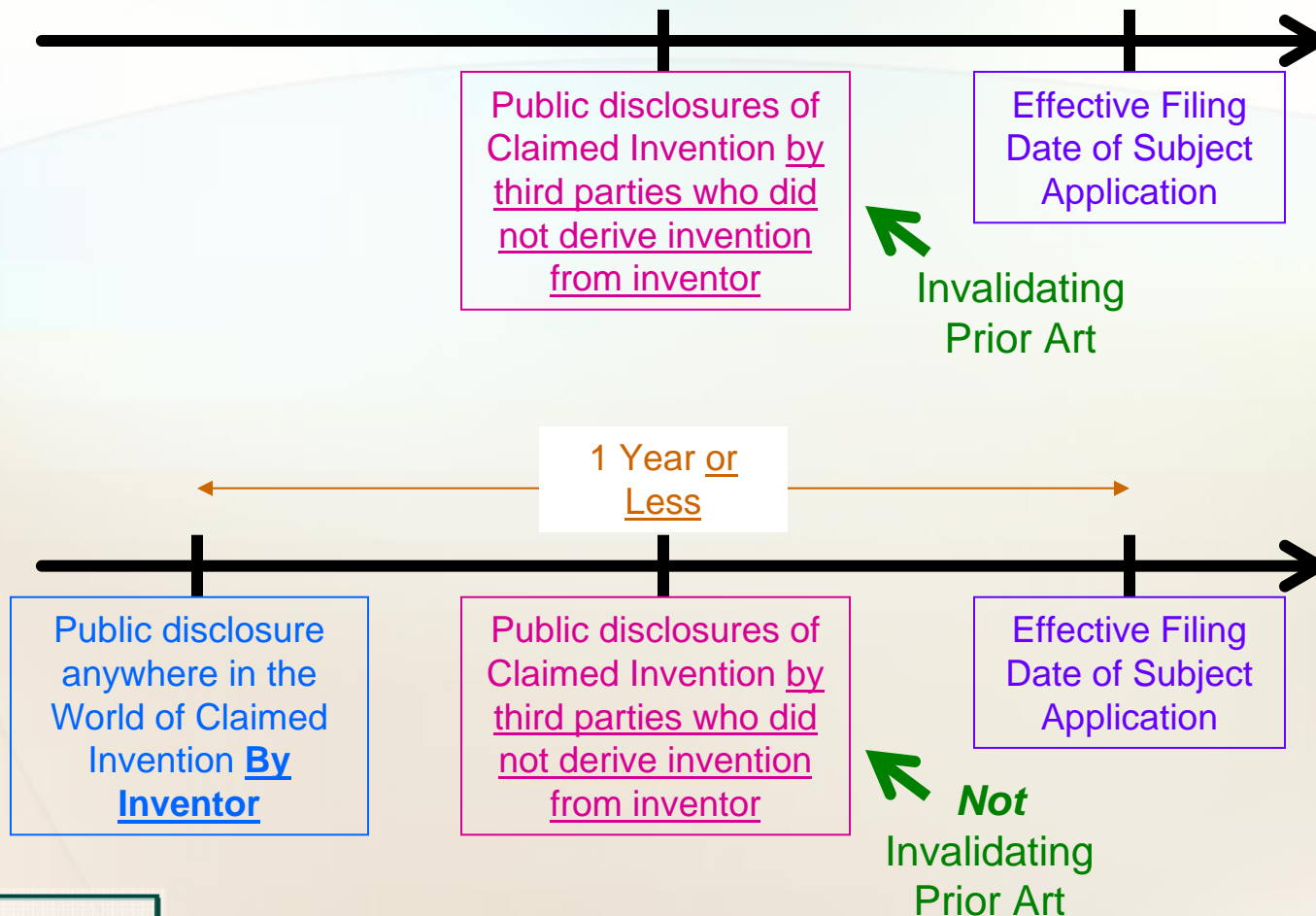


Example 102(b)(1)(A)

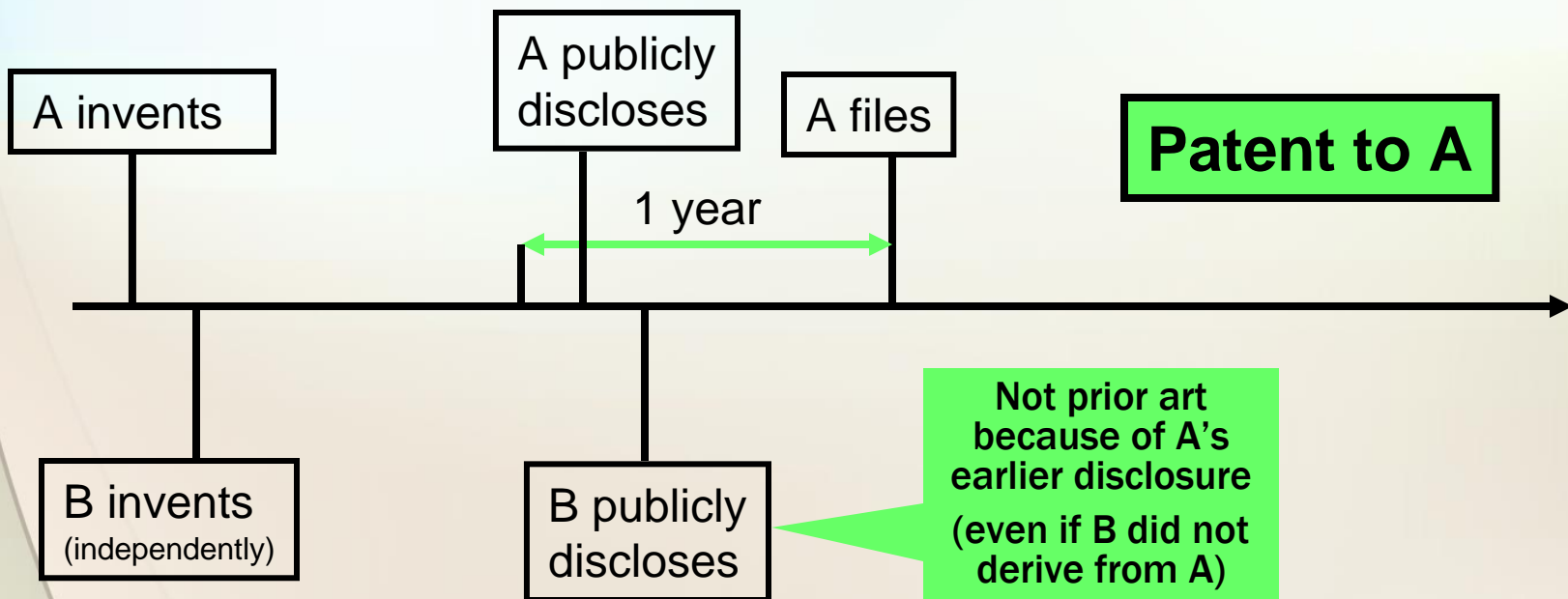


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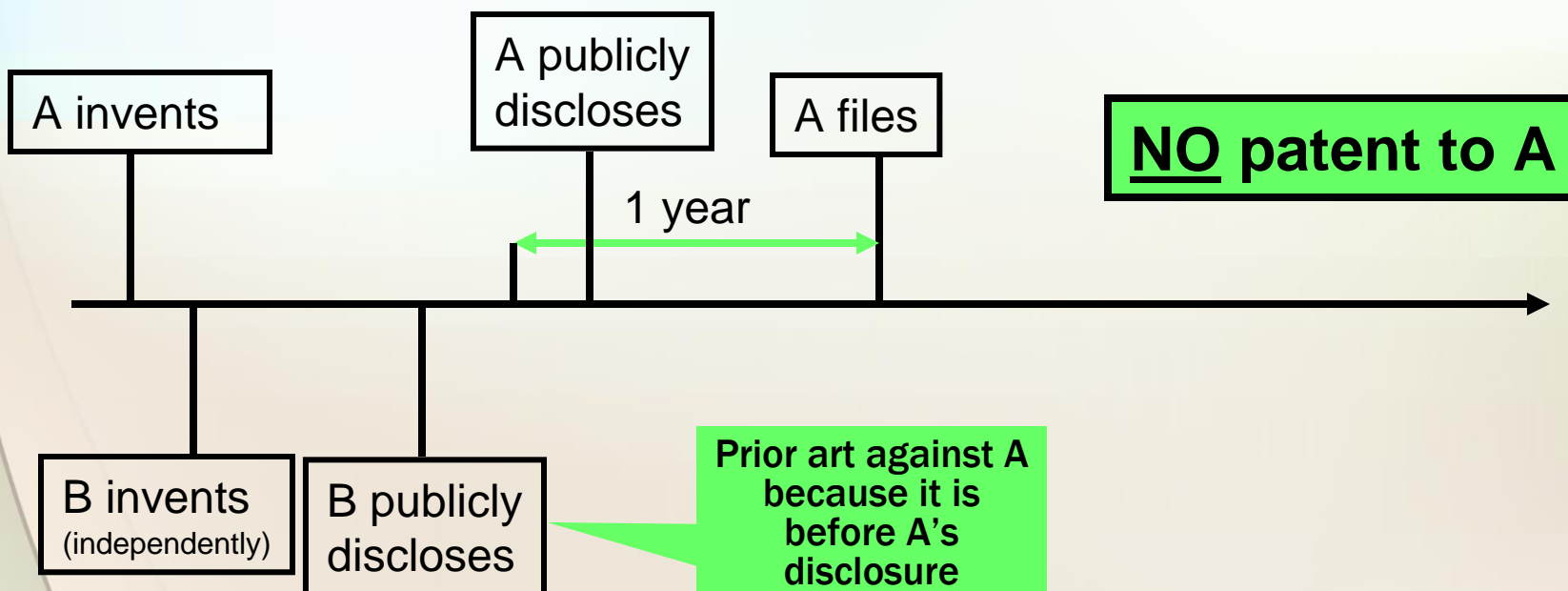
102(b)(1)(B): First-to-Publish system



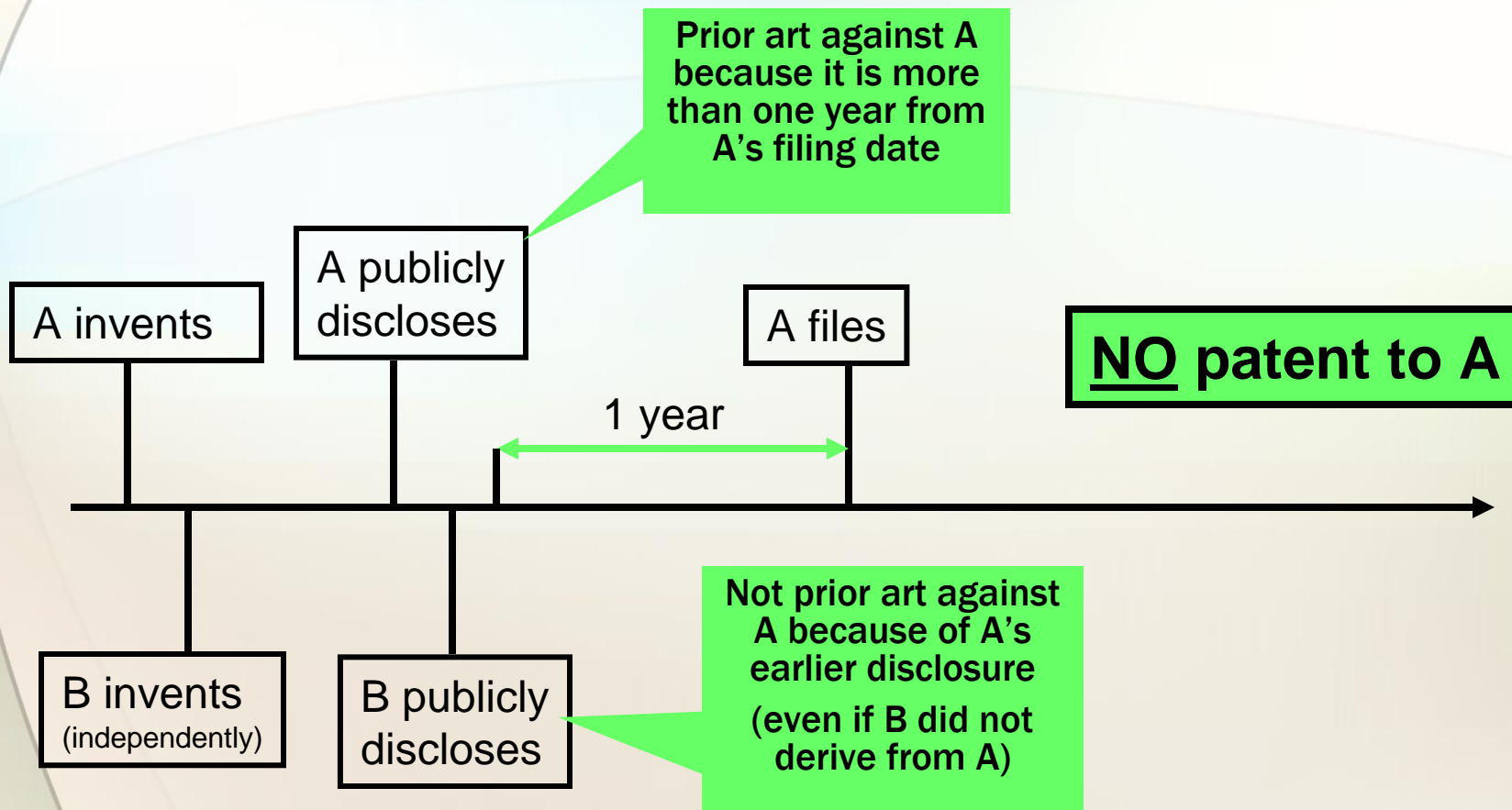
Example 102(b)(1)(B)



Example 102(b)(1)(B)



Example 102(b)(1)(B)



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§ 102. Conditions for patentability; novelty (con

Practice Note:
No one year requirement

(b) EXCEPTIONS (cont'd).—

(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;
- (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; 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.

First Invent

U.S. patents, U.S. published applications, and published PCT applications by others designating the U.S. become prior art as of their earliest filing dates

§ 102. Conditions for patentability; novelty (con

(b) EXCEPTIONS (cont'd).—

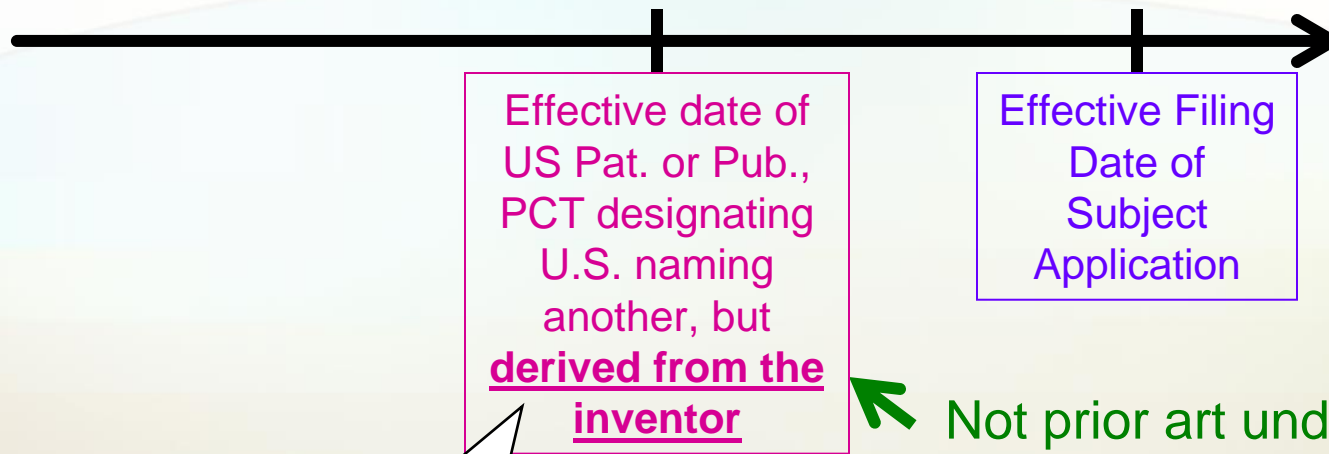
(2) DISCLOSURES APPEARING IN APPLICATIONS AND PATENTS.—A disclosure **shall not be prior art** to a claimed invention under **subsection (a)(2)** if—

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

(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; 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.

First Inventor To File 102(b)(2)(A)



Not prior art under 102(a)(2) as of effective filing date –

But, prior art as of publication date under 102(a)(1), if published more than a year before filing

Practice Note:

May have to file a declaration to establish derivation

Example 102(b)(2)(A)

X and Y are obvious over each other

Not prior art against A&B because A is joint inventor of A&B

Patent to A

A invents X

A files

A app. published

A & B invent Y

A & B file

Patent to A&B

Example 102(b)(2)(A)

X and Y are obvious over each other

Not prior art against A&B because A is joint inventor of A&B

Not prior art against A&B if within one year of A&B filing date (102(b)(1)(A))

A invents X

A files

A app. published

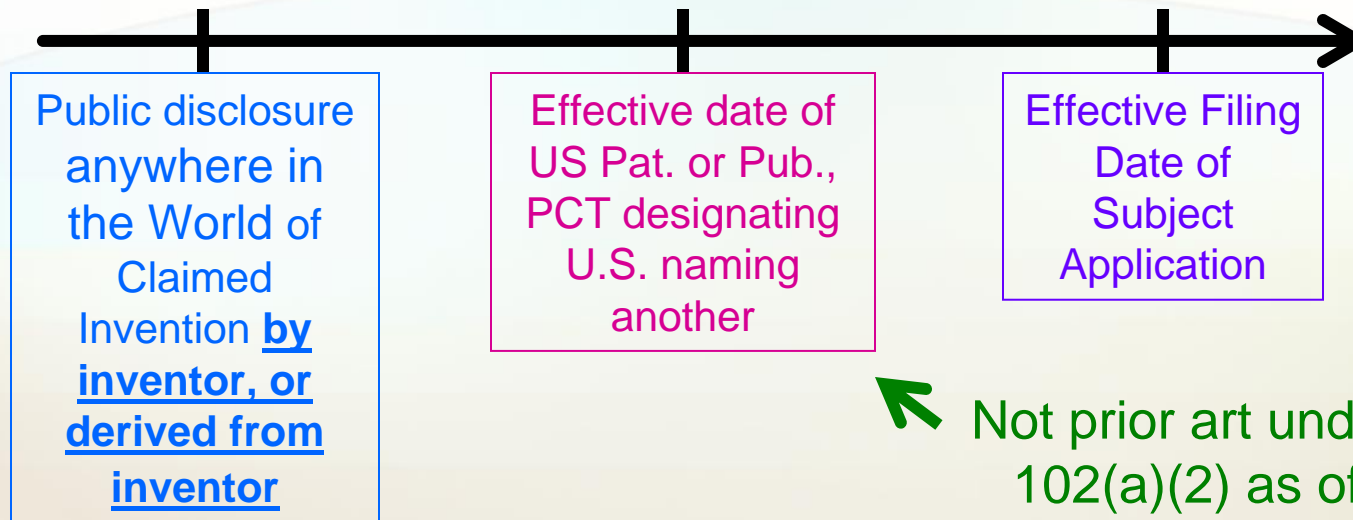
Patent to A

A & B invent Y

A & B file

Patent to A&B

First Inventor To File 102(b)(2)(B)



↖ Not prior art under 102(a)(2) as of effective filing date –
But, prior art as of publication date under 102(a)(1), if published more than a year before filing

Example 102(b)(2)(B)

X and Y are obvious over each other

Not prior art against B&C if within one year of B&C filing date (102(b)(1)(A))

Not prior art against B&C because of B&C's earlier disclosure

No patent to A

A invents X

A files

A app. published

B & C invent Y

B&C publicly disclose

B&C file

Patent to B&C

Prior art against A



First Inventor To File 102(b)(2)(C)



Effective date of US Pat. or Pub., PCT designating U.S. naming another, owned by same person or under obligation to assign to same person, or subject to a joint research agreement with inventor's company

Effective Filing Date of Subject Application

Not prior art under 102(a)(2) as of effective filing date –

But, prior art as of publication date under 102(a)(1)

Example 102(b)(2)(C)

X and Y are obvious over each other

Not prior art against B&C if X and Y were owned by same person

Patent to A

A invents X

A files

A app. published

B & C invent Y

B&C file

Patent to B&C

FTI v. FITF v. FTF

FTI: patent to A

A invents X
+ ARP

A files

FITF: NO patent to A

1 year

FITF: Patent to B

B invents X
(independently of A)

B publicly
Discloses
(no derivation from A)

1 year

B files

FTF: patent to nobody

Review of Practical Recommendations

- ◆ If any public disclosure of the invention is made before filing, file within one year
 - ◆ Even if mere oral presentation
- ◆ No more *Hilmer*
 - ◆ No need for foreign applicants file provisional applications
 - ◆ No need to file PCT applications in English
- ◆ Personal grace period via early disclosure
 - ◆ Can protect the applicant from disclosures by others in the US; and
 - ◆ Can hurt the applicant with respect to the novelty requirement of other countries
- ◆ Until the open questions regarding “public use” and “on sale” are answered by the CAFC
 - ◆ Don’t commercially use, nor offer for sale, the invention before filing a patent application
 - ◆ Even if commercial use and sale are confidential/secret
 - ◆ Even if commercial use and sale are outside U.S.

THANK YOU

If you have any questions or comments
you can send them to skunin@oblon.com.

