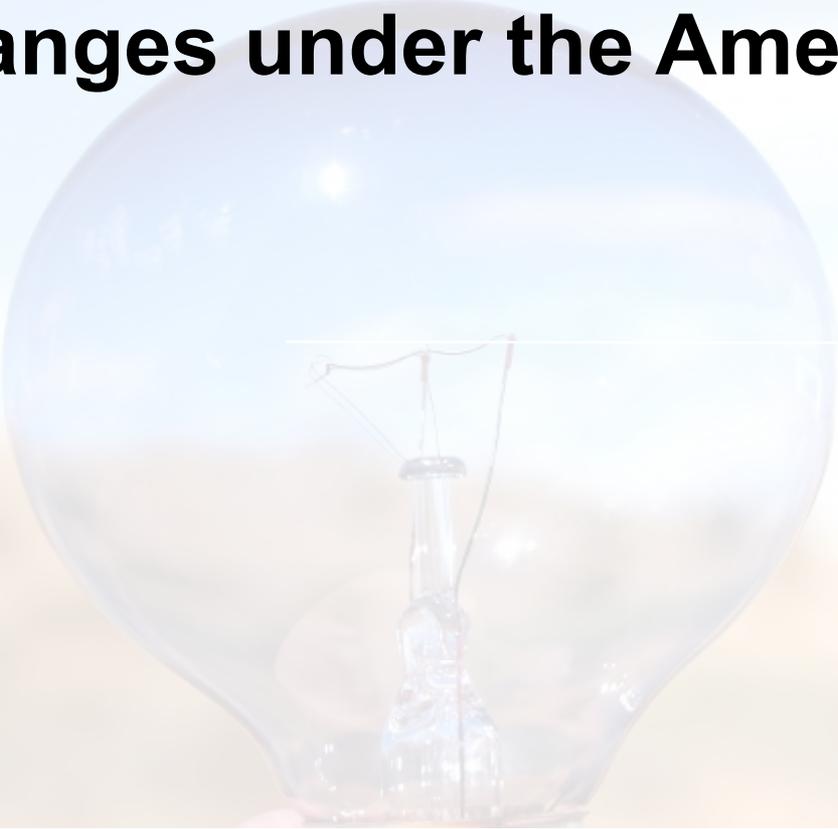


Prior Art under New §102: Changes under the America Invents Act



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New §102

- America Invents Act replaces §102 in its entirety
- Changes to prior art under new §102 apply to any patent or patent application filed after **March 16, 2013**
- **Major Change:** Critical date for determining prior art is the filing date (or priority date) of claimed invention, rather than the date of invention

Things to watch out for under new law

- Geographical restrictions have been removed on the following categories of prior art:
 - Printed publications
 - Public use
 - On-sale activity
 - Known or used by others (maybe - depends whether this is included in new otherwise available to the public language)
- “Known or used by others” language removed and replaced by new language, “otherwise available to the public”
 - Congress did not clearly define what this language means
 - Possible catch-all for prior art
- No longer restricted to published patents or applications
 - * May not know all prior art before filing!

Things to watch out for under new law

- §104 Eliminated: Date of invention no longer matters, so date of invention in WTO or NAFTA countries is also irrelevant
- Abandonment provision removed (but common law may still provide basis for patent invalidity)
- §102(d) removed, which removes the 12 month maximum length for priority
- New statute's emphasis on public accessibility constituting prior art may change limits of what constitutes experimental use (e.g. *City of Elizabeth v. American Nicholson Pavement*)

Things to watch out for under new law

- Be careful with using §102(b)(2)(C) exception to prior art:
 - Exempts patents and patent applications under 102(a)(2) BUT if a prior application published or issued before the effective filing date of the claimed invention, it still constitutes prior art under 102(a)(1)

§102(b)(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.

One Year Grace Period

- One year grace period from date of first disclosure
- Grace period does not apply to any third parties that did not obtain the information from inventor or joint inventor
 - 3rd party cannot swear behind another's disclosure
- Receive protection from subsequent disclosures during grace period
- Disclosures must be public to receive grace period
 - BE CAREFUL: Public publication eliminates ability to receive patent in many foreign jurisdictions

One Year Grace Period

- Definition of “disclosure” is left open by Congress and will need to be worked out by courts
- Grace period only allows priority for subject matter that was publicly disclosed
- Probably better to file patent application before disclosure, even if only a provisional

Additional Suggestions

- Time matters!
 - Examine any invention disclosure and patent application filing processes and eliminate unnecessary delays
- Track and Record Disclosures
 - Keep careful records of any pre-filing disclosures by an inventor or anyone in contact with the inventor. Record the date of disclosures and preserve any details and documentation of disclosures
 - Keep records for duration of patent in case of litigation
- Finalize assignments and other agreements before filing
 - Includes assignments, employment agreements, contractor agreements and joint research agreements, in order to preserve §102(c) benefits
- Specify filing rights in joint research contracts to provide alternative remedy other than patent law

Questions or Comments?

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