

Fitch Even IP Alert: USPTO Announces Final Rules and Examination Guidelines to Implement the Final Phase of the America Invents Act

As reported in previous Fitch Even IP Alerts, the final provisions of the Leahy-Smith America Invents Act (AIA) will go into effect on March 16, 2013. Under these provisions, the U.S. patent system is changing from a “first-to-invent” system to a so-called “first-to-file” system. Accordingly, the first inventor to *file* a patent application will normally prevail over a second inventor who filed later in time, regardless of which inventor was first to invent. Any patent applications filed before March 16, 2013, will fall under the current law, while those filed on or after March 16 that do not properly claim priority to an application filed before that date will fall under the new law.

The U.S. Patent and Trademark Office (USPTO) recently published its [Final Rules](#) to implement this final phase of the AIA and associated [Examination Guidelines](#) for patent examiners. Among other rules and guidelines, the new USPTO rules cover the following:

- The scope and application of prior art rejections under AIA Section 102
- New requirements and timelines for providing certified copies of foreign priority applications
- Declarations or affidavits for establishing a grace-period inventor or grace-period inventor-originated disclosure to disqualify certain prior art under AIA Section 102(b)
- The requirement for a “Statement” from applicants in “transition applications,” which are applications filed on or after March 16 but that claim priority to a pre-March 16 application

SCOPE OF PRIOR ART

Consistent with the AIA, the USPTO’s new rules reflect that the categories of prior art documents and prior art activities in Section 102(a)(1) include the following:

- Issued patents
- Printed publications
- Non-patent printed publications,
- Public use
- Sales
- Evidence that the claimed inventions was available to the public

Significantly, the USPTO takes the position that the new language “otherwise available to the public” in AIA Section 102(a)(1) generally means that *all* types of 102(a)(1) prior art—including public uses and prior sales—must be available to the public in order to qualify as prior art. The USPTO states that this rule should simplify patent examination, because the patentability focus

will be on whether the prior art was publically available and not on what “category” the prior art falls into. The USPTO’s interpretation appears to disqualify certain types of disclosure and sale activity as prior art if not reasonably available to the public. This view will likely be addressed by the courts in future litigation.

In addition, certain U.S. patent documents qualify as prior art under Section 102(a)(2). Under this section, U.S. patents, U.S. patent publications, and PCT publications that designate the U.S. are effective as prior art as of the earliest effective filing date anywhere in the world if they name another inventor not named in the application under examination. This change eliminates the former *Hilmer* rule under which patent documents were prior art only as of their earliest effective U.S. filing date.

Section 102(b) enumerates certain exceptions to prior art. These exceptions operate to disqualify certain prior art based on disclosures tied to an inventor or based on certain commonly owned applications. The USPTO terms the disclosure-based exceptions as “Grace Period Inventor Disclosures” or “Grace Period Inventor-Originated Disclosures.” These disclosure-based exceptions are triggered from a public disclosure tied to the inventor that describes the claimed invention. If such public disclosure took place within a year of the effective filing date of the U.S. application, then the disclosure is disqualified as prior art.

Significantly, a public disclosure by the applicant or based on the applicant’s disclosure that was made within one year prior to the application filing date also operates to disqualify any intervening third-party prior art. The USPTO provides a number of examples of how it interprets the AIA in this regard. Again, the USPTO’s views are subject to future court review.

Consistent with the above, the Examination Guidelines direct the examiners not to apply any public disclosure as prior art if it is apparent from the face of the disclosure that it

- (1) was one year or less from the effective filing date of the claimed invention;
- (2) names the inventor or joint inventor as an author or inventor of the disclosure; and
- (3) does not name additional persons as authors.

If these conditions do not apply, the public disclosure may still fall within the prior art exceptions of AIA Section 102(b), but the USPTO takes the position that the exception in such case would not be apparent from the document itself. In such cases, the USPTO provides procedures for a declaration or affidavit (discussed in more detail below) to establish why the public disclosure would disqualify itself or any intervening reference as prior art.

The Examination Guidelines explain some important qualifications of these grace-period invoking disclosures. For example,

- An inventor or inventor-originated public disclosure need not be a verbatim disclosure of any intervening prior art to disqualify it.

- The USPTO has taken the position that if the inventor-based disclosure only describes a genus, then such disclosure will not disqualify any later third-party reference to a species. This position is somewhat controversial and is likely to be the subject of a future court challenge.
- Public disclosures that take place more than one year before the earliest effective filing date will not be subject to this exception.
- The disclosure by the inventor or that originated from the inventor need not be in the same mode as any intervening prior art. For example, if an inventor discloses his claimed invention at a trade show, then such disclosure would disqualify a later journal article.

The Examination Guidelines acknowledge that AIA Section 102(b)(2)(C) disqualifies subject matter disclosed in a U.S. patent, U.S. patent publication, or a PCT publication as being prior art as of its earliest filing date if the claimed invention and reference were commonly owned. This exception applies not only to potential rejections for obviousness (as in pre-AIA law), but also to rejections for novelty. The Examination Guidelines caution, however, that commonly owned references may still be considered for other purposes—; for example, as prior art for double patenting rejections, as evidence of a prior use or disclosure, or as prior art as a publication under 102(a)(1).

AFFIDAVIT OR DECLARATION FOR A GRACE-PERIOD EXCEPTION

The USPTO has also set rules at 37 C.F.R. § 1.130 and Examination Guidelines for declarations and affidavits to establish the inventor disclosure or inventor-originated disclosure to disqualify prior art under AIA 102(b) when the disclosure itself is not apparent on its face as to its applicability. Among other things, a Section 130 declaration or affidavit enables an applicant

- to provide evidence that a public disclosure within one year of the earliest filing date of a U.S. application was made by the inventor or was obtained directly or indirectly from the inventor; and
- to furnish facts that a public disclosure within one year of the earliest filing date of U.S. application was before an intervening third-party disclosure and from the inventor or obtained from the inventor. In this case, the declaration must identify the date of the disclosure.

In these declarations or affidavits, if the public disclosure of interest was a printed publication, it must be attached. If the disclosure was not printed, the affidavit or declaration must describe the disclosure with sufficient detail so that the patent examiner can determine what was disclosed.

TRANSITIONAL APPLICATIONS

The USPTO describes a so-called “transitional application” as one that is filed on or after March 16, 2013, and that claims priority to an application (provisional, foreign, or PCT) that was

filed before March 16, 2013. Under these circumstances, either pre-AIA law or AIA law will apply, depending on the support for the claims.

The USPTO rules specify that the applicant must determine whether AIA or pre-AIA law applies to the transitional application. More specifically, applicants are required to make a “Statement” in any non-provisional application filed on or after March 16 that claims the benefit of a provisional, a foreign, or a PCT application filed prior to March 16 and contains or contained at any time a claim subject to AIA law. This Statement will direct the patent examiner to use AIA law when examining the transitional application. The USPTO includes that the Statement may be made by someone who is bound by the duty of disclosure in the application.

No Statement is needed if

- applicant reasonably believes based on known information that the application does not have a claim, or ever had a claim, having a priority date after March 15 (which means the application should be examined under pre-AIA law);
- new matter is included in an application filed after March 15, but that new matter is not claimed in the transitional application (which again means the application should be examined under pre-AIA law); or
- the application is not a so-called transitional application because it only claims priority to applications filed after March 15, 2013.

Thus, an applicant’s silence, i.e., non-submission of a Statement, will mean that any transitional application will be examined under pre-AIA law. Failure to make the Statement or making an incorrect Statement may have adverse consequences on the examination of the application and later enforceability of the application.

Statements are required by the later of

- four months from the actual filing of the transitional application;
- four months from the date of entry into the national stage of the transitional application;
- sixteen months from the filing date of the prior filed application before March 16; or
- the date of presentment of the first claim having an effective filing date after March 15.

These dates are not extendable.

CERTIFIED COPIES OF FOREIGN PRIORITY DOCUMENTS

In 37 C.F.R. § 1.55, the USPTO also set rules and timelines for providing certified copies of priority documents to the USPTO. Copies of certified documents must be provided by the later of

- four months from the actual filing; or
- sixteen months from the priority application.

These deadlines are not extendable, but a petition can be filed for priority claims that are unintentionally delayed.

The applicant is not required to provide a certified copy of a priority document if the priority application was in a foreign IP office participating with the USPTO in a bilateral or multilateral priority exchange agreement, so long as the USPTO actually receives the certified copy within the time limits designated above. But it is still the applicant's responsibility to make sure that the USPTO receives the certified copy within the designated time frames, whether or not the priority document is expected to be provided separately.

The new rules also provide a mechanism for applicants to provide an "interim copy" of the priority document by the deadline. If an interim copy is provided to the USPTO, then the certified copy need only be provided prior to grant of the U.S. application.

The Final Rules and Examination Guidelines are quite extensive, and this alert only highlights a few of the new requirements of the AIA. Should you have any further questions, we recommend you contact your Fitch Even attorney or Fitch Even partner [Jeffrey A. Chelstrom](#), the author of this alert.

A free Fitch Even CLE webinar, "**American Invents Act First-to-File Changes: What Happens Now?**," will be presented by Jeffrey A. Chelstrom on February 27. To read more and register, please visit our [Webinars page](#). After February 27, a recording of the webinar will be available for viewing, also accessible through our Webinars page.

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