# Patent Prosecution Strategies and Practice Tips In View Of The America Invents Act (AIA)

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The America Invents Act (“AIA”)\(^1\) made significant changes to the U.S. patent law, which present new challenges and dilemmas to inventors and companies that seek to protect their innovation by obtaining patents in the United States. Any application filed on or after March 13, 2013 is subject to new §102 and §103, unless it fits within an exception defined by the AIA. The AIA significantly changed substantive U.S. patent law in several aspects, including the scope of prior art, grace period, and prior art dates for patents and published patent applications. This paper discusses the major changes made by the AIA, as well as strategic considerations for preparing and prosecuting patent applications in view of these changes.

In Part I, this paper addresses several major changes made by the AIA that may impact patent prosecution, including changes of the U.S. patent system from “first-to-invent” to “first-inventor-to-file,” redefinition of prior art and grace period, and modified prior art dates for patents and patent application publications. In Part II, this paper explains in detail the new AIA 35 U.S.C. §§102 and 103. In Parts III-V, this paper discusses when the AIA will apply, as well as practical considerations when filing and prosecuting a patent application in view of the AIA and United States Patent and Trademark Office (USPTO) procedures. This paper also briefly discusses other considerations relating to patent prosecution, including pre-issuance citations by third parties, post-issuance submissions of patent owner statements, supplemental examination, and patent term adjustment.

I. MAJOR CHANGES IN SUBSTANTIVE LAW MADE BY THE AIA

A. The change from first-to-invent to first-inventor-to-file

The AIA changed the U.S. patent system from a “first-to-invent” system under the old patent law to a “first-inventor-to-file” system, which essentially requires absolute novelty, subject to a limited grace period. Prior art is defined by AIA 35 U.S.C. 102(a), which precludes issuance of a patent (1) where the claimed invention was patented, described in a printed publication, or in public use, on sale, or otherwise available to the public before its effective filing date; or (2) where the claimed invention was described in a U.S. patent, U.S. published Application, or PCT published Application that names another and was effectively filed before the effective filing of the claimed invention.

Certain prior art can be overcome due to the exceptions provided in the AIA 102(b). For example, the exceptions in 35 U.S.C. §102(b)(1) provide that a disclosure made one year or less before the effective filing date of a claimed invention shall not be prior art to the claimed invention under 35 U.S.C. §102(a) 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

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\(^1\) On January 14, 2013, the AIA Technical corrections act was signed into law, which enacted various corrections to the AIA and Title 35 of the United States Code, including (i) amending 35 U.S.C. § 311(c) to remove the nine-month waiting period for inter partes review of patents that are not subject to Section 3(n)(1) of the AIA, (ii) clarifying in 35 U.S.C. § 135(a) that a petition for derivation must be filed within one year of the earlier patent’s grant or within one year from publication of the earlier application, whichever is earlier, (iii) setting the deadline in 35 U.S.C. § 115(f) for filing an inventor’s oath or declaration to “no later than the date on which the issue fee for the patent is paid” and (iv) amending 35 U.S.C. § 154(b) to calculate patent term adjustment of international applications from “the date of commencement of the national stage under Section 371 in an international application” and not the date of completion of requirements under Section 371.
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. Also, “A disclosure in a U.S. patent, U.S. patent application publications, or WIPO-published applications by someone who obtained the subject matter directly or indirectly from the inventor or joint inventor would not be considered prior art.” See 78 FR 11059.

In addition, pre-AIA §102(c) relating to abandonment and §102(f) relating to “did not himself invent” are removed. Further, pre-AIA §102(g) relating to interferences has been replaced with a provision for proving derivation.

B. Grace period

The AIA provides limited, personal protection against prior art disclosures made in the one-year grace period prior to the effective filing date of the claimed invention. Pre-AIA patent law statute allowed a one-year grace period for an inventor to file a patent application despite certain events relative to a disclosure or use. For example, under pre-AIA law, an applicant could antedate or “swear behind” certain grace period prior art disclosures by making a showing under 37 CFR §1.131 that the applicant invented the claimed subject matter prior to the effective date of the prior art disclosure. AIA 35 U.S.C. §102(a)(1) and (a)(2), however, make no mention of the date of the invention, but determines whether a disclosure or event would be prior art based on whether the disclosure was made or the event occurred “before the effective filing date of the claimed invention.”

Under AIA, the grace period is confined to disclosures made by the actual inventor or made by another who obtained the subject matter from the inventor. As such, disclosures by others are not covered by the grace period and are prior art, unless they are subsequent to a public disclosure of the subject matter by an inventor, joint inventor, or another who obtained the subject matter disclosed directly or indirectly from the inventor or joint inventor, or unless the entity who made the intervening disclosure obtained the subject matter from an inventor or joint inventor.

Furthermore, not all intervening grace period disclosures are disqualified as prior art. Depending on the scope of the subject matter of the intervening grace period disclosure compared with that of the subject matter of the earlier public disclosure by the inventor or a joint inventor, part or all of the intervening grace period disclosure may be available as prior art. For example, where the inventor had publicly disclosed a genus, and a subsequent intervening grace period disclosure by another discloses a species that falls within the genus, the intervening grace period disclosure of the species would be available as prior art. See Federal Register, Vol. 78, No. 31, 11059, 11077. Further discussions and illustrations with respect to whether the subject matter disclosed in an intervening grace period disclosure should be excluded as prior art are provided in section II.

C. Prior art dates for patents and patent application publications

Under the pre-AIA §102(e), a patent or published application was prior art as of its actual U.S. filing date or an earlier U.S. priority date to which it is entitled. The AIA removed the
distinction between a U.S. priority date and a foreign priority date in considering whether the priority date could be used as the prior art date for patents and patent application publications. Under AIA 35 U.S.C. §102(d), if the patent or published application is entitled to a foreign priority date or an earlier filing date, then the patent or published application is prior art as of the earliest filing date (including foreign priority date) to which it is entitled.

The AIA also removes the prior requirement of § 102(e) that the patent document have been published in the English language as a condition to qualify as prior art. Under pre-AIA §102(e), a published PCT international application is treated as a U.S. patent application publication only if the international application was filed on or after November 29, 2000, designates the United States, and published in the English language. Under AIA 35 U.S.C. §102(d), however, a published PCT international application is treated as a U.S. patent application publication if it designates the United States, regardless of its international filing date or whether it is published in the English language.

D. Other changes made by the AIA

In addition to the changes discussed above, the AIA also infused the following changes to the U.S. patent law.

The AIA removed the requirement of having no deceptive intent for correction of inventorship from 35 U.S.C. sections 116 (correction of inventors in application) and 256 (correction of named inventor). The changes to inventorship can now be made without any statement that the errors in naming inventors arose “without deceptive intent”.

Although the best mode requirement is retained by the AIA, failure to satisfy the best mode requirement is not a basis to invalidate an issued patent in federal court. Best mode cannot be raised in a post-grant review, either.

With respect to specific subject matter, the AIA prohibits patents on human “organisms.” Also, AIA places limits on the patentability of tax strategy inventions, declaring that the tax strategy portions of the claims are prior art.

The AIA provides certain novel procedures to improve the speed and quality of patent examination at the USPTO. For example, the prioritized examination program authorized under the AIA allows expedited examination of patent applications for a fee of $4,800. In addition, the AIA permits pre-issue submissions of potentially relevant prior art by third parties, as well as post-issue submissions of certain patent owner statements regarding the scope of a claim. Also, a patent owner may request a supplemental examination for any information believed to be relevant to the patent.

In order to benefit small entities and individual inventors, the AIA creates a new category of applicants, i.e., micro-entities, which are entitled to large fee reductions. The AIA also calls for various programs and studies designed to assist individual inventors and small businesses in seeking patent protection.
II. THE NEW AIA 35 U.S.C. §§102 and 103

A. AIA 35 U.S.C. §102


AIA 35 U.S.C. §102(a)(1) precludes grant of a patent on a claimed invention if 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. AIA removed the requirement of pre-AIA 35 U.S.C. §102 that public use and on sale be “in this country” to be qualified as prior art. Therefore, under AIA 35 U.S.C. §102(a)(1), both public use and on sale can be in a foreign country.

AIA 35 U.S.C. §102(b)(1) sets out exceptions to the categories of prior art defined in AIA 35 U.S.C. §102(a)(1). Specifically, AIA 35 U.S.C. §102(b)(1) provides that a disclosure shall not be prior art to the claimed invention under AIA U.S.C. §102(a)(1) if the disclosure was made one year or less before the effective filing date of a claimed invention; and (i) 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 (35 U.S.C. §102(b)(1)(A)), or (ii) the disclosure was made after the subject matter has 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 (35 U.S.C. §102(b)(1)(B); intervening disclosure). Under the AIA, if an inventor discloses a compound X in a journal article and files a patent application within one year of her disclosure, the disclosure in the journal article is not prior art (Fig. 1). Even if a third party discloses the same compound X subsequent to the inventor’s initial disclosure but before the inventor files the patent application, the third party’s disclosure does not qualify as prior art due to the exceptions of AIA 35 U.S.C. §102(b)(1)(B).
AIA 35 U.S.C. §102(a)(2) states that no patent shall be issued if, before the effective filing date of the claimed invention, the claimed invention was described in a U.S. patent, U.S. published Application, or PCT published Application that “names another” and was “effectively filed” before the effective filing date of the claimed invention. AIA 35 U.S.C. §102(d) provides that patents and patent applications are considered to be “effectively filed” as of either (1) the actual filing date if (2) does not apply; or (2) the date to which the patent or application for patent is entitled to claim a right of priority or benefit under section 119, 120, 121, or 365 which describes the subject matter.

For purpose of determining the date as of which a U.S. patent, U.S. patent application, or WIPO published application is considered to be effectively filed, one does not need to evaluate whether any claim of the patent or published patent application is actually entitled to priority or benefit under section 119, 120, 121, or 365. Rather, a U.S. patent, U.S. patent application, or WIPO published PCT application is “entitled to claim” priority to or the benefit of a prior-filed application if it (1) contains a priority or benefit claim to the prior-filed application; (2) was filed within the applicable filing period requirement (copending with or within twelve months of the earlier filing, as applicable); and (3) has a common inventor with or the same applicant as the prior-filed application.

Under the AIA, patents and patent applications can be effectively filed as of the filing date of the earliest foreign or international applications, regardless of where filed, to which there is a priority or benefit claim. This represents a change from pre-AIA 35 U.S.C. §102(e), which limited the effective filing date for U.S. patents and published applications as prior art to their earliest U.S. filing date. Furthermore, under AIA 35 U.S.C. §102(d), WIPO publication of PCT applications that designate the U.S. are treated as U.S. patent application publications for prior art purposes regardless of their international filing date, whether they are published in English, or whether they entered U.S. national stage. This differs from pre-AIA §102(e), which treats a WIPO published PCT application as a U.S. published patent application only if the PCT application was filed on or after November 29, 2000, designated the U.S., and published in the English language.

AIA 35 U.S.C. §102(b)(2) sets out exceptions to the prior art provisions of AIA 35 U.S.C. §102(a)(2). AIA 35 U.S.C. §102(b)(2)(A) prevents the use of the inventor’s own work as prior art where the inventor’s own work is disclosed in a U.S. patent, U.S. patent application, or WIPO published application by another who obtained the subject matter directly or indirectly from the inventor or joint inventor. For example, the inventor disclosed compound X in a public presentation in a scientific meeting, a third party competitor who heard the inventor’s presentation filed a patent application disclosing compound X one month after the scientific meeting, which patent application was published, and the inventor files a U.S. patent application claiming compound X six months after the scientific meeting, then the competitor’s U.S. published patent application does not qualify as prior art under AIA 35 U.S.C. §102(a)(2) due to the exceptions of AIA 35 U.S.C. §102(b)(2)(A). See Fig. 2.
AIA 35 U.S.C. §102(b)(2)(B) provides that a disclosure that would otherwise qualify as prior art under 35 U.S.C. §102(a)(2) may be disqualified as prior art if the subject matter disclosed had, before such subject matter was effectively filed, 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. Thus, a third party’s patent or published patent application that was filed before the effective filing date of the claimed invention but after the inventor publicly disclosed the subject matter in the third party’s patent or published patent application, would be disqualified as prior art due to the provisions of AIA 35 U.S.C. §102(b)(2)(B). The prior public disclosure of the subject matter by the inventor, a joint inventor, or another who obtained the subject matter directly or indirectly from the inventor or joint inventor must itself be a public disclosure within the one-year grace period from the effective filing date of the claimed invention. If a prior public disclosure by the inventor or which originated with the inventor is not within the grace period of AIA 35 U.S.C. §102(b)(1), it would qualify as prior art under AIA 35 U.S.C. §102(a)(1), and could not be disqualified under AIA 35 U.S.C. §102(b)(1).

AIA 35 U.S.C. §102(b)(2)(C) provides another exception to the prior art provisions of AIA 35 U.S.C. §102(a)(2). This exception disqualifies a disclosure 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. AIA 35 U.S.C. §102(b)(2)(C) is different from pre-AIA 103(c) in that a patent or published application that satisfies the requirement of §102(b)(2)(C) may not be applied in either an anticipation rejection or an obviousness rejection while prior art that fall within pre-AIA 103(c) can still be used in an anticipation rejection.

AIA 35 U.S.C. §102(c) provides that the common ownership requirement is deemed to be met in applying the provisions of AIA 35 U.S.C. §102(b)(2)(C) if: (1) The subject matter disclosed was developed and the claimed invention was made by, or on behalf of, one 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 patent application for the claimed invention discloses or is amended to disclose the names of the parties to the joint research agreement.
The exception of 35 U.S.C. §102(b)(2)(C) only applies to disclosures that would fall within the provisions of 35 U.S.C. §102(a)(2), i.e., U.S. patents, U.S. patent application publications, and PCT application publications that was effectively filed but not published before the effective filing date of the claimed invention. If such patents or patent application publications were published before the effective filing date of the claimed invention, they would qualify as prior art under AIA 35 U.S.C. §102(a)(1) to which the exception of 35 U.S.C. §102(b)(2)(C) would not apply. In addition, a U.S. patent or U.S. patent application publication that is disqualified as prior art due to 35 U.S.C. §102(b)(2)(C) may still be used in a double patenting rejection. See Federal Register, Vol. 78, issue 31, 11059, 11080. Also, such a U.S. patent or patent application publication may be used in a lack of enablement rejection to show the state of the art. Id.

B. Intervening Disclosures during the Grace Period

Under AIA 35 U.S.C. §102(b), where the subject matter of a disclosure made one year or less prior to the effective filing date of the claimed invention (grace period intervening disclosure) had been previously disclosed in a public disclosure by an inventor, joint inventor, or another who obtained the subject matter disclosed directly or indirectly from the inventor or joint inventor, the disclosure would not be considered as prior art even though it would otherwise fall within the prior art provisions of AIA 35 U.S.C. §102(a). For example, AIA 35 U.S.C. §102(b)(1)(B) provides that a disclosure shall not be prior art to the claimed invention under AIA U.S.C. §102(a)(1) if the disclosure was made one year or less before the effective filing date of a claimed invention; and the disclosure was made after the subject matter has 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. AIA 35 U.S.C. §102(b)(2)(B) provides that a U.S. patent, U.S. patent application publication, or WIPO application publication by another that would otherwise qualify as prior art under 35 U.S.C. §102(a)(2) may be disqualified as prior art if the subject matter disclosed had, before such subject matter was effectively filed, 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. This subsection discusses and illustrates in further detail issues relating to grace period intervening disclosures.

Subject matter in the prior disclosure being relied upon under AIA 35 U.S.C. 102(a) must be the same “subject matter” as the subject matter previously publicly disclosed by the inventor for the exceptions to apply. See 78 FR 11059. However, for a grace period intervening disclosure to be disqualified as prior art due to the exceptions of AIA 35 U.S.C. §102(b)(1)(B) or §102(b)(2)(B), there is no requirement that the grace period intervening disclosure use the same mode or manner of disclosure (e.g., publication, public use, sale activity) as the earlier public disclosure 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. See 78 FR 11059. Neither is there a requirement that the earlier disclosure be a verbatim or ipsissimus verbis disclosure of the intervening disclosure. For example, where the earlier public disclosure by the inventor was a public presentation in a conference and the grace period intervening disclosure is a U.S. patent by a third party that discloses, although using different words, the same subject matter as
disclosed in the earlier public presentation, the U.S. patent by the third party would be disqualified as prior art due to the provisions of §102(b)(2)(B).

Note that the determination of whether an intervening grace period disclosure is available as prior art does not involve comparison of the subject matter of the claimed invention to either the subject matter of the grace period intervening disclosure, or to the subject matter of the earlier public disclosure by the inventor, a joint inventor, or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor. Rather, the correct inquiry would compare the subject matter of the intervening grace period disclosure to the subject matter of the earlier public disclosure.

The USPTO guidelines indicate that depending on the scope of the subject matter of the intervening grace period disclosure compared with that of the subject matter of the earlier public disclosure, part or all of the intervening grace period disclosure may be available as prior art. If subject matter of the intervening disclosure is simply a more general description of the subject matter previously publicly disclosed by the inventor or a joint inventor, the exception in AIA 35 U.S.C. 102(b)(1)(B) applies to such subject matter of the intervening disclosure. See 78 FR 11059. For example, the subject matter of an intervening disclosure that is not disclosed in the earlier public inventor disclosure or inventor-originated disclosure by another would be available as prior art. The following examples illustrate how the USPTO would treat intervening grace period disclosures for prior art purposes under various circumstances.

The USPTO guidelines state that:

These examination guidelines also clarify, in response to the public comment, that there is no requirement that the mode of disclosure by an inventor or joint inventor be the same as the mode of disclosure of an intervening disclosure (e.g., inventor discloses his invention at a trade show and the intervening disclosure is in a peer-reviewed journal). Additionally, there is no requirement that the disclosure by the inventor or a joint inventor be a verbatim or ipsissimis verbis disclosure of an intervening disclosure in order for the exception based on a previous public disclosure of subject matter by the inventor or a joint inventor to apply. These guidelines also clarify that the exception applies to subject matter of the intervening disclosure that is simply a more general description of the subject matter previously publicly disclosed by the inventor or a joint inventor.

See FR 78 FR 11059, summary.

Example 1: The inventor had publicly disclosed elements A, B, and C, and a subsequent intervening grace period disclosure discloses A, B, C, and D. Only element D of the intervening grace period disclosure would be available as prior art (see Fig. 3).
Example 2: The inventor had publicly disclosed a species, a subsequent intervening grace period disclosure discloses a genus, and then the inventor files a patent application claiming the species. The intervening grace period disclosure of the genus is NOT available as prior art (see Fig. 4).

Example 3: The inventor had publicly disclosed a genus, a subsequent intervening grace period disclosure discloses a species, and then the inventor files a patent application claiming both the genus and the species. The intervening grace period disclosure of the species would be available as prior art (see Fig. 5).
Example 4: The inventor had publicly disclosed a species X, a subsequent intervening grace period disclosure discloses a different species Y, and then the inventor files a patent application claiming species X and species Y. The intervening grace period disclosure of the species Y would be available as prior art (see Fig. 6).

As a practice tip, it seems that reliance on the grace period should be avoided in general. First, both before and after the AIA, it should be kept in mind that often such publications prior to the filing date of an application would destroy the opportunity for a patent in countries that require absolute novelty. Secondly, if a third party makes a subsequent disclosure based on a variation or an improvement to the initial disclosure, there is the risk that the invention can be rendered unpatentable. As such, it is important to minimize public disclosure by inventors and other employees, prior to application filing. Some companies may wish to implement policies where a patent application must be filed prior to the publication of journal articles, materials at conferences, white papers, etc.

C. AIA 35 U.S.C. §103

AIA 35 U.S.C. §103 is a single paragraph, having removed the provisions to section (b) relating to certain biotechnology processes, which was rarely used, and section (c) was removed from 35 U.S.C. §103, because the provisions relating to the common ownership exception are now covered by 35 U.S.C. §102. As a result of this change, under the AIA, a patent or published application that satisfies the requirement of §102(b)(2)(C) may not be applied in either an anticipation rejection or an obviousness rejection. This broadens the common ownership exception, because prior art that falls within pre-AIA 103(c) can still be used in an anticipation rejection (although not in obviousness rejections). Also, to claim the common ownership must be at time of filing under the AIA, versus at the time of invention under pre-AIA.
D. Comparison between pre-AIA and AIA §102 and §103

Some of the changes between pre-AIA and AIA are briefly summarized in the following table:

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<th>Statute pre-AIA</th>
<th>Statute under the AIA</th>
<th>Notes</th>
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<tbody>
<tr>
<td><strong>35 U.S.C. §102 (pre-AIA)</strong></td>
<td><strong>35 U.S.C. §102</strong></td>
<td>• The “effective filing date” matters under the AIA, not the invention date (except as evidence for derivation and grace period). Applicants can no longer “swear behind” based on invention date to disqualify a reference.</td>
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<tr>
<td>(a) the invention was known or used by others in this country. or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country.</td>
<td>(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 (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.</td>
<td>• Public uses and on-sale activities in a foreign country can now be used as prior art.</td>
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<td>• Secret sale or use activity does not qualify as prior art. “An activity (such as a sale, offer for sale, or other commercial activity) is secret (non-public) if, for example, it is among individuals having an obligation of confidentiality to the inventor.” See 78 FR 11059.</td>
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<td>• Foreign priority filing dates of a U.S. patent application can now be the effective filing date of the reference. The Hilmer doctrine is eliminated.</td>
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<td>more than one year prior to the date of the application for patent in the United States, or</td>
<td>(b) EXCEPTIONS.—</td>
<td>NOTE: according to 77 FR 43763, since the AIA does not define the term “disclosure,” the USPTO “is treating the term ‘disclosure’ as a generic expression intended to encompass the documents and activities enumerated in 35 U.S.C. §102(a) (i.e., being patented, described in a</td>
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<td>Statute pre-AIA</td>
<td>Statute under the AIA</td>
<td>Notes</td>
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<td>(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—</td>
<td>• If disclosure was made by an inventor, file an affidavit. See 37 CFR 1.130(a). • If the disclosure was made by a party that obtained the subject matter from the inventor, the affidavit must “identify the subject matter publicly disclosed and provide the date such subject matter was 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”.... See 37 CFR 1.130(b).</td>
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<td>(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 <strong>publicly</strong> 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.</td>
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<td>(2) DISCLOSURES APPEARING IN APPLICATIONS AND PATENTS.—A disclosure shall not be prior art to a claimed invention under subsection (a)(2) if—</td>
<td>NOTE: <strong>common ownership</strong> exception was applicable to obviousness pre-AIA (35 USC 103(c)), but now applies to novelty as well, and now relates to the “effective filing date” not the date of invention.</td>
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<td>(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</td>
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<td><strong>printed publication, in public use, on sale, or otherwise available to the public, or being described in a U.S. patent, U.S. patent application publication, or WIPO published application).</strong></td>
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<td><strong>NOTE:</strong> the one-year grace period does not apply to publications by others.</td>
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<td>Statute pre-AIA</td>
<td>Statute under the AIA</td>
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<td>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.</td>
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<td>(c) he has abandoned the invention, or</td>
<td>ELIMINATED</td>
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<td>(d) the invention was first patented or caused to be patented, or was the subject of an inventor’s certificate, by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application for patent or inventor’s certificate filed more than twelve months before the filing of the application in the United States, or</td>
<td>See 35 U.S.C. §102 (a)</td>
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<td>(e) the invention was described in — (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in</td>
<td>See 35 U.S.C. §102 (a)</td>
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<td>Statute pre-AIA</td>
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<td>(f) he did not himself invent the subject matter sought to be patented, or</td>
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<td>(g) (1) during the course of an interference conducted under section 135 or section 291, another inventor involved therein establishes, to the extent permitted in section 104, that before such person’s invention thereof the invention was made by such other inventor and not abandoned, suppressed, or concealed, or (2) before such person’s invention thereof, the invention was made in this country by another inventor who had not abandoned, suppressed, or concealed it. In determining priority of invention under this subsection, there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.</td>
<td>INTERFERENCES ELIMINATED under AIA. §102 (g) applies to some transitional applications. See Derivation Proceedings under New 35 USC §135.</td>
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<td>(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.</td>
<td>A patent for a claimed invention may not be obtained, notwithstanding that the claimed invention is not identically disclosed as set forth in section 102, if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains. Patentability shall not be negatived by the manner in which the invention was made.</td>
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<td>Statute pre-AIA</td>
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<td>(b) [biotechnology]</td>
<td>ELIMINATED</td>
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<td>(c) (1) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person…</td>
<td>See AIA 35 U.S.C. §102(b)(2)(C).</td>
<td>AIA 35 U.S.C. §102(b)(2)(C) is different from pre-AIA 103(c) in that a patent or published application that satisfies the requirement of §102(b)(2)(C) may not be applied in either an anticipation rejection or an obviousness rejection while prior art that fall within pre-AIA 103(c) can still be used in an anticipation rejection. If such patents or patent application publications were published before the effective filing date of the claimed invention, they would qualify as prior art under AIA 35 U.S.C. §102(a)(1) to which the exception of 35 U.S.C. §102(b)(2)(C) would not apply. In addition, a U.S. patent or U.S. patent application publication that is disqualified as prior art due to 35 U.S.C. §102(b)(2)(C) may still be used in a double patenting rejection. See Federal Register, Vol. 78, issue 31, 11059, 11080. Also, such a U.S. patent or patent application publication may be used in a lack of enablement rejection to show the state of the art. Id.</td>
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III. PRE-FILING CONSIDERATIONS

A. Determination of whether AIA 35 U.S.C. §102 and §103 would apply

The PTO Guidelines considers the following categories: (A) applications filed before March 16, 2013, (B) Applications filed on or after March 16, 2013 and (C) applications subject to the AIA, but also containing a claimed invention having an effective filing date before March 16, 2013. See 78 FR 11059.

However, AIA 35 U.S.C. §102 and §103 would apply to all applications that contain, or contained at any time, a claim to a claimed invention that has an effective filing date that is on or after March 16, 2013; or claim the benefit of a US nonprovisional or international application that contains, or contained at any time, a claim to a claimed invention having an effective filing date on or after March 16, 2013. Even if the claim to a claimed invention that has an effective filing date that is on or after March 16, 2013 is subsequently cancelled, the application will still be treated as an AIA application, to which the AIA U.S.C. §102 and §103 would apply. According to AIA Section 3(n), the effective date is defined as:

(1) IN GENERAL- Except as otherwise provided in this section, the amendments made by this section shall take effect upon the expiration of the 18-month period beginning on the date of the enactment of this Act, and shall apply to any application for patent, and to any patent issuing thereon, that contains or contained at any time—

(A) a claim to a claimed invention that has an effective filing date as defined in section 100(i) of title 35, United States Code, that is on or after the effective date described in this paragraph; or

(B) a specific reference under section 120, 121, or 365(c) of title 35, United States Code, to any patent or application that contains or contained at any time such a claim.

See also 35 U.S.C. § 100(i), which states that:

(i) (1) The term "effective filing date" for a claimed invention in a patent or application for patent means— (A) if subparagraph (B) does not apply, the actual filing date of the patent or the application for the patent containing a claim to the invention; or

(B) the filing date of the earliest application for which the patent or application is entitled, as to such invention, to a right of priority under section 119, 365(a), or 365(b) or to the benefit of an earlier filing date under section 120, 121, or 365(c)...

AIA 35 U.S.C. §102 and §103 generally do not apply if new matter added in a continuation-in-part application (CIP) is not claimed unless it cures a 112(a) problem in the parent. In addition, AIA applies if a CIP includes a claim that contains or relies on the new matter added in the CIP.

Even if application is subject to AIA, note that pre-AIA 35 U.S.C. 102(g) also applies to every claim in the application if it: (1) contains or contained at any time a claimed invention having an effective filing date that occurs before March 16, 2013; or (2) is ever designated as a
continuation, divisional, or continuation-in-part of an application that contains or contained at any time a claimed invention that has an effective filing date that occurs before March 16, 2013. See 78 FR 11059. Pre-AIA 35 U.S.C. 102(g) also applies to any patent resulting from an application to which pre-AIA 35 U.S.C. 102(g) applied. See id.

As will be discussed below, because the AIA expands the scope of prior art and provides only limited grace period protection, care should be taken when drafting claims if the applicant does not wish to turn a pre-AIA application into an AIA application. For example, when preparing a preliminary amendment at the time of filing an application that claims the priority to or benefit of a prior application with an effective filing date prior to March 16, 2013, the applicant should ensure that all claims in the preliminary amendment are described in the prior application in a manner that satisfies 35 U.S.C. 112 so that AIA §102 and §103 would not apply.

B. Applicant Statement in Transition Applications

Under the patent rules revised to implement the changes made by the AIA, applicants are required to file an application statement in certain patent applications containing a claimed invention having an effective filing date on or after March 16, 2013. Specifically, if a nonprovisional application filed on or after March 16, 2013 claims the benefit of or priority to the filing date of an earlier U.S., foreign, or international application that was filed prior to March 16, 2013 and contains or contained at any time a claimed invention having an effective filing date on or after March 16, 2013, the applicant must provide a statement to that effect. See 37 C.F.R. 1.55 and 1.78.

The required statement must be made within the later of: (a) 4 months from the actual filing date of the later filed application; (b) 4 months from the date of entering the US national phase; or (c) 16 months from the filing date of the prior-filed application. If a claim having an effective filing date on or after March 16, 2013 is presented after the later of the time periods above, the statement must be made when presenting the claim. 37 C.F.R. §1.55.

C. Comparison of potential advantages between pre-AIA and AIA

The AIA tends to expand the scope of what may be considered to be prior art. On the other hand, the AIA might in some circumstances provide certain advantages to an applicant, depending on the fact pattern.

For example, some advantages of pre-AIA include the ability to rely on the date of invention. There may be instances where an applicant must rely on date of invention to prevail. For example, this might be the case in the pharmaceutical industry, where there can be a delay from time of making an invention to filing, which might be caused by the need to obtain in vivo or in vitro data to establish utility, for example. Also, although the AIA has a limited grace period, it is personal to the inventor. In other words, under the AIA, it is no longer possible to swear behind certain old 102 (a) prior art. Furthermore, a pre-AIA regime may allow the applicant to avoid certain rejections due to expanded prior art, since under the AIA it is now possible to base rejections on prior use or sale of the invention abroad, and where foreign patent
applications by others may be prior art as of their foreign filing date (rather than their US filing dates).

Under the AIA, the number of PCT applications that qualify as prior art has expanded because under pre-AIA §102(e), a published PCT international application was treated as a U.S. patent application publication only if the international application was filed on or after November 29, 2000, designated the United States, and was published in the English language. Under AIA 35 U.S.C. §102(d), however, a published PCT international application is treated as a U.S. patent application publication if it designates the United States, regardless of its international filing date or whether it is published in the English language.

Moreover, there appears to be an expanded set of prior art under the AIA, due to the catchall phrase “otherwise available to the public,” which appears to cover oral disclosures, such as a public presentation. Another advantage of the pre-AIA regime is that the applicant can avoid certain validity challenges (such as post grant review). Finally, the general lack of case law on AIA creates uncertainty for the applicant.

On the other hand, the AIA might provide advantages to certain applicants. For example, the common-ownership exception has been expanded. Under AIA 103(c), a patent or published application that satisfies the requirement of §102(b)(2)(C) may not be applied in either an anticipation rejection or an obviousness rejection. Under the pre-AIA 103(c), prior art that falls within this exception could still be used in an anticipation rejection. In addition, the common-ownership exception applies when there is ownership at time of filing under AIA, versus at the time of invention under pre-AIA.

Secondly, under the AIA, secret prior art may no longer apply. The PTO Guidelines indicate that “on sale” under AIA section 102 (a)(1) means a “public” sale. “The Office views the ‘or otherwise available to the public’ residual clause of the AIA’s 35 U.S.C. 102(a)(1) as indicating that secret sale or use activity does not qualify as prior art.”

Pre-AIA 102(g) stated that a patent would not be granted if “…before such person’s invention thereof, the invention was made in this country by another inventor who had not abandoned, suppressed, or concealed it…” Since pre-AIA 102(g) no longer applies, this limits challenges from prior independent inventors.

Finally, if an application contains a foreign priority claim, the effective filing date may be up to a year earlier (thus removing up to a year of prior art), which can be an advantage to certain applicants.

Depending upon which regime best suits the fact pattern, it may be necessary to take precautions not to inadvertently transition from one to the other.

D. The Race to the Patent Office

Under the new first-inventor-to file regime, the patent right is generally awarded to the first inventor to file absent derivation from an earlier inventor who files a patent application. Furthermore, disclosures by others are not covered by the grace period protection unless they are
subsequent to a public disclosure of the subject matter by the inventor or joint inventor or another who obtained the subject matter disclosed from the inventor or joint inventor, or unless the entity who made the intervening disclosure obtained the subject matter from an inventor or joint inventor. Therefore, applicants should file patent applications as early as possible.

In theory, the AIA will impact inventors and companies by requiring them to get their applications on file as quickly as possible. As such, companies should consider ways to streamline their application drafting and filing procedure. At the same time, companies should educate their scientists, inventors and managers to work with their patent attorney or patent department, so that the company can continuously and actively monitor and identify potential inventions for patenting. Indeed, it may be advantageous to file more frequently, taking particular advantage of provisional applications.

At the same time, there is an increased burden on inventors and companies to analyze and file applications in a timely and efficient manner. During the time that a company keeps an invention confidential while deciding whether or not to file for patent protection, it is vulnerable to the risk that a competitor may file or disclose the subject matter first, resulting in loss of patent protection. As such, it might make sense to develop streamlined programs within an organization for not only identifying potential applications, but also preparing and filing these according to a streamlined and frequent protocol.

Provisional applications can be helpful for establishing an early filing date. However, provisional applications should be carefully prepared so that the provisional application would provide written description and enablement needed to establish the earlier effective filing date for the claims in a later-filed non-provisional application. A non-provisional application based on a provisional application only gets the benefit of the provisional filing date if the provisional application describes the claimed invention in a manner that satisfies the written description and enablement requirement of 35 U.S.C. 112, first paragraph. Ideally, when filing a provisional application, the applicant understands what will be claimed in the non-provisional application and includes working examples and experimental data to provide an enabling disclosure of the claimed invention. Applicants may also consider filing multiple provisional applications as the subject matter of an invention further develops and more experimental data becomes available over time.

Under certain circumstances, being the first to publish may prevent a competitor from obtaining a patent on the disclosed subject matter. However, publication before filing a patent application may be harmful. For example, an inventor could disclose subject matter and, before the inventor files a patent application related to the disclosure, a third party may disclose an improvement on the subject matter disclosed by the inventor. Now, the third party’s disclosure can be prior art for an obviousness rejection against the subsequent patent application of the inventor. Furthermore, if an applicant desires to seek patent protection in foreign countries, prior public disclosure of subject matter may preclude the applicant from obtaining patents in the foreign countries. Therefore, under the AIA, the best practice often is to file patent applications prior to any public disclosure.
Not only should applicants not publicly disclose subject matter before filing a patent application, applicants should also be careful to not disclose or publish information regarding the research and development projects in progress to avoid prompting others to file a patent application or publish subject matter that could be used as prior art against the inventor’s subsequently filed patent application. In this regard, inventors should monitor the activities and publications of competitors and collaborators and should have a system set up for rapid filing of provisional applications when necessary.

In addition, inventors should maintain records (e.g., lab notebook, etc.), that show the independent development of the invention as evidence against derivation proceedings before the USPTO or in a civil litigation. It is recommended that inventors maintain good notebooks for the additional reason that if it is necessary to invoke the grace period for non-inventor disclosure exception, that it will be necessary to not only “identify the subject matter publicly disclosed” but also to “provide the date such subject matter was 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.” See 37 CFR 1.130(b). Thus, a properly-documented laboratory notebook, as well as a good record of any disclosures (noting the audience and/or recipients) will be valuable.

Further, it is a good practice to develop systems for identifying which applications are pre-AIA, AIA and mixed, keeping track of when each additional disclosure was added.

IV. CONSIDERATIONS DURING PATENT PROSECUTION

This section discusses the USPTO procedures and strategic considerations relating to prosecution of U.S. patent applications under the AIA.

A. Claim Amendments

If a pre-AIA application is amended during prosecution to contain a claim to a claimed invention having an effective filing date on or after March 16, 2013, the application becomes an AIA application. AIA 35 U.S.C. §102 and §103 would apply to the application even if the claim to a claimed invention having an effective filing date on or after March 16, 2013 is subsequently cancelled. This could mean, for example, that a parent application relying upon the pre-AIA

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2 If the new sections of the AIA apply to any claim of a patent application, then the AIA will apply to all the claims of the patent application. See section 3(n)(1)(A) of the AIA, which states in part that:

(n) Effective Date-

(1) IN GENERAL- Except as otherwise provided in this section, the amendments made by this section shall take effect upon the expiration of the 18-month period beginning on the date of the enactment of this Act, and shall apply to any application for patent, and to any patent issuing thereon, that contains or contained at any time--

(A) a claim to a claimed invention that has an effective filing date as defined in section 100(i) of title 35, United States Code, that is on or after the effective date described in this paragraph; or
one year grace period may now be considered unpatentable under the AIA rules. Furthermore, there is the risk that third-party prior art (by someone that was not the “first to invent”) might now render the application unpatentable under the AIA rules.

Therefore, when considering amending the claims during patent application prosecution, e.g., when responding to a prior art rejection, applicants should carefully review the present application and prior applications, to which the present application claims priority to or benefit of, to see whether the amended claim would have an effective filing date on or after March 16, 2013. If as a result of the claim amendment, a pre-AIA application becomes an AIA application, additional prior art may become available under the AIA provisions.

An amendment, other than a preliminary amendment filed on the same day as such application, seeking to add a claim directed to new matter would not change the application from a pre-AIA application into an AIA application. In these cases, the claim directed to new matter would normally get a rejection for failure to comply with the requirements of 35 U.S.C. §112.

B. Affidavits or declarations under 37 CFR §1.130

AIA 35 U.S.C. §102(b) provides exceptions to certain disclosures that would otherwise fall within the prior art provisions of AIA 35 U.S.C. §102(a). During prosecution of a patent application, the applicant should consider using an affidavit or declaration under 37 CFR §1.130 to establish that a disclosure that was not made more than one year prior to the effective filing date of the claimed invention, is not prior art under AIA 35 U.S.C. §102(a) due to an exception in AIA 35 U.S.C. §102(b).

Three categories of affidavits or declarations under 37 CFR §1.130 are discussed below.

Affidavit or declaration showing that the disclosure was an inventor disclosure

An affidavit or declaration of attribution under 37 CFR §1.130(a) may be used to show that the disclosure was made by the inventor or a joint inventor. The affidavit or declaration of attribution that include (a) an unequivocal statement from the inventor that he/she invented the subject matter of the disclosure; and (b) a reasonable explanation of the presence of additional authors would normally be acceptable to the United States Patent and Trademark Office, in the absence of evidence to the contrary. Where there is evidence to the contrary, a mere statement without any accompanying reasonable explanation regarding the presence of authors other than the inventor or joint inventor may not be sufficient.

Affidavit or declaration showing that the disclosure is subsequent to a prior public disclosure by the inventor or joint inventor

An affidavit or declaration of prior public disclosure under 37 CFR 1.130(b) may be used to show that the subject matter disclosed had been publicly disclosed by the inventor or a joint inventor before the disclosure or effective filing date of the subject matter on which the rejection was based. The affidavit or declaration used for this purpose must identify the subject matter

(B) a specific reference under section 120, 121, or 365(c) of title 35, United States Code, to any patent or application that contains or contained at any time such a claim.
publicly disclosed and establish the date and content of the earlier public disclosure. If the earlier public disclosure was a printed publication, the affidavit or declaration must be accompanied by a copy of the printed publication. If the earlier public disclosure was not a printed publication, the affidavit or declaration must describe the earlier disclosure with sufficient detail and particularity to determine that the earlier disclosure is a public disclosure of the subject matter.

The disclosure at issue does not need to have the same mode of disclosure or use the same words as the earlier public disclosure. For example, the intervening disclosure may be published in a scientific journal, while the prior public disclosure by the inventor or joint inventor may be made in a blog post on the internet. The differences in manner of disclosure or the words used would not prevent the use of an affidavit or declaration under 37 CFR 1.130 to disqualify the intervening disclosure as prior art.

Affidavit or declaration showing that the disclosure was made, or that the subject matter had been previously publicly disclosed, by another who obtained the subject matter directly or indirectly from the inventor or a joint inventor

AIA 35 U.S.C. §102(b)(1)(A), §102(b)(1)(B), §102(b)(2)(A), and §102(b)(2)(B) provide that a grace period disclosure that was made, or that the subject matter had been previously publicly disclosed, by another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor is not prior art. An affidavit or declaration under 37 CFR §1.130(a) or 37 CFR §1.130(b) may be used to show that the disclosure was made, or that the subject matter had been previously publicly disclosed, by another who obtained the subject matter directly or indirectly from the inventor or a joint inventor. The applicant need to establish that the subject matter disclosed originated from the inventor or a joint inventor and that the inventor or a joint inventor communicated subject matter to the party who made the disclosure. Any evidence of the communication of the subject matter by the inventor or a joint inventor to the party who made the disclosure should accompany the affidavit or declaration.

C. Excluding disclosures as prior art based on common ownership

During patent prosecution, an applicant should consider whether an AIA §102(a)(2) disclosure, upon which a rejection under AIA 35 U.S.C. §102 or §103 is based, may be excluded due to the common ownership exception of AIA 35 U.S.C. §102(b)(2)(C). Generally, it will be sufficient to establish that 35 U.S.C. §102(b)(2)(C) applies if the applicant or the applicant’s representative of record makes a clear and conspicuous statement asserting that the subject matter disclosed and the claimed invention “were owned by the same person or subject to an obligation of assignment to the same person” not later than the effective filing date of the claimed invention. Corroborating evidence, such as records of assignments, will not be required in the absence of independent evidence that raises doubt as to the veracity of the statement. As discussed in section II, the common ownership exception of AIA 35 U.S.C. §102(b)(2)(C) is applicable if the conditions of AIA 35 U.S.C. §102(c) are met.

D. Certified copy of any foreign priority application
Under the new patent Rules, which applies to any application filed under 35 U.S.C. §111 or 363 on or after March 16, 2013, certified copy of any foreign priority application must be filed within the later of 4 months from the actual filing date or 16 months from the filing date of the prior foreign application. 37 C.F.R. §1.55(d).

E. Best mode

The best mode requirement is retained by the AIA, but violation of this requirement cannot be raised in post-grant review or federal court proceedings to invalidate a patent. Because the AIA did not eliminate or change the best mode requirement of 35 U.S.C. §112, which still requires that patent applicants disclose the best mode of practicing their invention in patent applications submitted to the USPTO, applicants should continue to disclose the best mode in their patent applications to avoid rejections under 35 U.S.C. §112.

F. Prioritized Examination

Applicants who seek to obtain a patent within a short period of time should consider the prioritized examination program provided by the AIA to expedite examination of patent applications. The stated goal by the USPTO is to reach a final disposition of the application in 12 months.

The prioritized examination program grants special status until (1) notice of allowance or final Office Action issued; (2) applicant files a petition for extension of time, a request for suspension of action, a notice of appeal, or an RCE; (3) the application is amended to contain more than 4 independent or 30 total claims, or a multiple dependent claim; or (4) the application is abandoned.

All nonprovisional utility and plant patent applications filed on or after September 26, 2011 are eligible for participating in the prioritized examination program. However, reissue applications or reexaminations and national stage applications under § 371 are not eligible. Further, the USPTO may not accept in any fiscal year more than 10,000 requests for prioritization.

To take advantage of the prioritized examination program, the application must be complete upon filing as defined by 37 CFR 1.51(b), including a specification with one or more claims, an oath or declaration, and drawings, and must contain no more than 4 independent claims or 30 total claims, and no multiple dependent claims. Also, a certification and request for prioritized examination must be filed at the time of filing and a prioritized examination fee of $4800.00 must be paid.

G. Micro-entities are entitled to large fee reductions.
The AIA establishes a new “micro-entity” fee status. Applicants that qualify for the micro-entity status can take advantage of the 75 percent micro-entity status discount. AIA 35 U.S.C. 123(a) provides that “micro entity” status may be established where an applicant makes a certification that the applicant: (1) qualifies as a small entity; (2) has not been named as an inventor on more than four previously filed U.S. non-provisional patent applications; (3) did not, in the calendar year preceding the calendar year in which the applicable fee is being paid, have a gross income exceeding three times the median household income for that preceding calendar year, as most recently reported by the Bureau of the Census; and (4) has not assigned, granted, or conveyed, and is not under an obligation to assign, grant, or convey, a license or other ownership interest in the application concerned to an entity that, in the calendar year preceding the calendar year in which the applicable fee is being paid, had a gross income exceeding three times the median household income for that preceding calendar year, as most recently reported by the Bureau of the Census. AIA 35 U.S.C. 123(d) provides an additional basis for establishing the micro-entity status for applicants who certify that (1) the applicant’s employer, from which the applicant obtains the majority of the applicant’s income, is an institution of higher education; or (2) the applicant has or is under an obligation to assign or license the ownership interest in the particular application to such an institution of higher education.

Unlike the procedures with respect to small entity status, an applicant must determine and establish whether the micro-entity status applies for each payment. This may result in significant legal cost. Furthermore, paying a USPTO fee at the micro-entity level where it later turns out that the applicant did not qualify for the micro-entity status can raise issues such as inequitable conduct and fraud, which could undermine the patent’s validity. Therefore, applicants should consider whether the fee reduction associated with claiming a micro-entity status would be offset with the legal costs and risks involved. Under certain circumstances, it may be advantageous to simply establish small entity status.

V. OTHER CONSIDERATIONS

The rules provide for the filing of a certificate of micro entity status once during the pendency of a patent application and patent, and the payment of micro entity fees can be made so long as micro entity status applies when the fee is paid. 35 U.S.C. §123(a) defines a “micro entity” as

an applicant who makes a certification that the applicant: (1) qualifies as a small entity as defined in 37 CFR 1.27; (2) has not been named as an inventor on more than four previously filed patent applications, other than applications filed in another country, provisional applications under 35 U.S.C. 111(b), or international applications for which the basic national fee under 35 U.S.C. 41(a) was not paid; (3) did not, in the calendar year preceding the calendar year in which the applicable fee is being paid, have a gross income, as defined in section 61(a) of the Internal Revenue Code of 1986 (26 U.S.C. 61(a)), exceeding three times the median household income for that preceding calendar year, as most recently reported by the Bureau of the Census; and (4) has not assigned, granted, or conveyed, and is not under an obligation by contract or law to assign, grant, or convey, a license or other ownership interest in the application concerned to an entity that, in the calendar year preceding the calendar year in which the applicable fee is being paid, had a gross income, as defined in section 61(a) of the Internal Revenue Code of 1986, exceeding three times the median household income for that preceding calendar year, as most recently reported by the Bureau of the Census. See 125 Stat. at 318.
This section briefly discusses other considerations relevant to prosecution of patent applications in view of the changes in the U.S. patent law made by the AIA. Specifically, we address here pre-issuance citations by third parties, post-issuance submissions of patent owner statements, supplemental examination, and patent term adjustment.

A. Pre-issuance citations by third parties

AIA 35 U.S.C. §122(e) permits pre-issuance submissions by third parties before a Notice of Allowance, or the later of 6 months after first publication or the date of a first final rejection. AIA 35 U.S.C. §122(e) applies to all patent applications, whenever filed. Only patent, published patent applications, or other printed publications of potential relevance to the patent application examination can be submitted. In addition, the submission must include a concise description of the asserted relevance of each submitted document and a statement affirming that the submission was made in compliance with AIA 35 U.S.C. §122(e).

A submission that is in compliance with AIA 35 U.S.C. §122(e) may be included in the record of the patent application. Thus, if the third party submission is unsuccessful in preventing the application to issue as a patent, the prior art submitted and made of record would strengthen the patent in that it will be much more difficult to rely on the same documents to invalidate the patent later. Furthermore, because there is no active participation in the prosecution, the prior art submitted may not get the attention of the examiner that it deserves, which would increase the likelihood of unsuccessful submission. Therefore, although a third party submission may be used under certain circumstances as a weapon to defeat a competitor’s efforts to obtain a patent, an applicant should carefully weigh the above-discussed disadvantages against the benefits that would result from the third party submission.

In light of the possibility that a competitor may be monitoring and submitting pre-issuance citations of prior art, inventors and companies should consider the advantages of conducting a thorough prior art search prior to filing, which should include foreign prior art.

B. Post-issuance submissions of patent owner statements

Under AIA 35 U.S.C. §301, anyone can cite patent owner statements filed in a federal court proceeding or the USPTO where the patent owner took a position on the scope of any claim of a patent. In addition to the patent owner statements, the party shall also submit any other documents, pleadings, or evidence from the proceeding in which the statement was filed that addresses the written statement. Upon request, the patent owner statements can be submitted anonymously.

The USPTO can use the patent owner statements and additional information submitted only for purpose of determining the meaning of a patent claim in re-examination, inter partes review and post grant review proceedings. The patent owner can also submit a written statement explaining the differences between the claims and any prior art submitted under 35 U.S.C. §301(a)(1).
C. Supplemental Examination

The AIA provides a novel mechanism, *i.e.*, supplemental examination, for applicants to correct certain errors made during the examination of a patent application after a patent issues. A patent owner can request supplemental examination for any information believed to be relevant to the patent. The Director will determine within 3 months whether the request presents a substantial new question of patentability. If a substantial new question of patentability is found, re-examination commences. Otherwise, the USPTO will conclude the review and issue a certificate indicating that the information presented in the request does not raise a substantial new question of patentability.

Supplemental examination allows review of any information that may otherwise have been a basis for raising inequitable conduct issues in a patent litigation. The AIA indicates that a patent cannot be held unenforceable for failure-to-disclose (or mis-disclose) information during an original examination where the information is considered in a subsequent supplemental examination. For example, an applicant may shield the patent from invalidity attack based on inequitable conduct by submitting in supplemental examination material prior art that were known to a patent applicant but left out during the initial examination. Therefore, it would be desirable to set up a system to review whether all relevant prior art was submitted to the USPTO once a patent issues and to request supplemental examination if necessary.

D. Patent term adjustment

The new patent rules revised to implement the provisions of the AIA contain several changes relating to patent term adjustment. Under the new rule, the USPTO will tell applicants the amount of patent term adjustment they are entitled to when the patent issues, not when a Notice of Allowance is sent as under the old rule. Applicants have a two-month period to request that the USPTO reconsider its patent term adjustment calculation. The new rule makes available, for the first time, an extension for an additional five months upon request.

If an applicant disagrees with the PTO’s final calculation of patent term adjustment, the applicant has 180 days to file a suit in district court. Under the new rule, the 180-day period starts running on the date that the patent office rules on a request for reconsideration. Under the old rule, the 180-day period started running on the grant date of the patent.

Previously, a different calculation method for patent term adjustment was used for international applications, which could lead to shorter terms for these applications. Now, international applications filed in the U.S. under the Patent Cooperation Treaty will be treated, for the first time under the new rule, the same way as applications that originate in the U.S. in terms of patent term adjustment.