

# AIPLA

*American Intellectual Property Law Association*

## **The AIA “New” Grace Period System and How to Treat “Transition Applications”**

**AIA First-to-File Filing Strategy, USPTO Rules & Guidelines**

**Ron Harris**

America Invents Act Presentation Sponsored by:  
JPAA and AIPLA IP Practice in Japan Committee

April 9 (Tokyo) & 12 (Osaka), 2013

# Effective Filing Date

---

- The effective filing date is defined under amended 35 U.S.C. § 100(i)(1) as the earliest priority date for a claimed invention or the actual filing date if there is no priority claim to an earlier application.
  - From earlier-filed applications abroad
  - From parent applications in the US
- Inventors can no longer use an earlier invention date to anti-date (swear behind) other's earlier-filed inventions
- Pre-AIA § 102 defined some types of prior art as related to the application filing date and some related to the date of invention.
- AIA § 102 eliminates this distinction, instead defining prior art exclusively in terms of the effective filing date.

# Securing Effective Filing Date

- Starting 3/16/2013 claim priority in ADS, and
- Submit, by greater of filing +4 mths. or priority + 16 mths.:
  - Certified application (***file with foreign-RO PCT application***), or
  - \*\*Automatic request to “Priority Document Exchange Agreement Office” (JPO, EPO, KIPO, IB) - (by USPTO via ADS claim), or
  - \*\*Request and authorization for (free) copy of the application, if filed in non-participating country but held by “Agreement Office” that permits USPTO access to it, or
  - \*Applicant-made, foreign language<sup>1</sup> application PDF marked “Interim Copy” & cover sheet<sup>\*\*\*</sup>, (+ petition/fee if filed later)
- Before issuance Applicant must ensure USPTO receives:
  - “Agreement Office” copy, or
  - Certified document from Applicant (preferably by issue fee payment [else priority not on patent face -> cert. of correction])

\*\* Not available for design applications

\* Not for accelerated Track I examination, interference, derivation, to overcome reference, if required by examiner (PPH is likely OK)

<sup>1</sup> Not for interference, derivation, to overcome reference, required by examine

<sup>\*\*\*</sup> App. No., Country or Patent Office, Filing Date, Trans. Verification Statement

## Broader Definition of Prior Art

---

- *AIA 102(a) allows 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 [an issued U.S. patent], or in [any published U.S. patent application or any published PCT application designating the U.S.], 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.

## More Prior Art (1)

---

- Under the old statute, an offer for sale, sale, or public use in a foreign country, unlike in the U.S., could not be used as prior art unless it appeared in a publication.
- AIA § 102(a)(1) abolishes this distinction by removing geographic limitations from what constitutes prior art
- Prior art will typically include...
  - All art that publicly exists prior to the filing date, other than disclosures by the inventor within 1 year of filing.
  - All foreign filings (regardless of whether (1) filed in the US as PCT or under 111a (non-prov.) or 111b (provisional), or (2) what language) are prior art of their date of filing. (No longer need to file a US provisional to get 102b protections and 102e prior art status).

## More Prior Art (2)

---

- AIA also revises 35 U.S.C. § 103, the obviousness section of the patent statute, to change the date on which to assess the obviousness of an invention from "the time the invention was made" to "before the effective filing date of the claimed invention."

## More Prior Art Than EPC

---

- Under AIA § 102(a)(2), prior art patents and published applications can be used for both novelty and obviousness analyses.
- Published PCT applications fall within the scope of AIA § 102(a)(2) provided that the U.S. has been designated, irrespective of whether or not the application has validly entered the U.S. national phase.
- In Europe the prior art under Article 54(3) EPC is available only if the application has validly entered the EPO regional phase, and then for novelty purposes only.

# Exceptions: 1-Year AIA Grace Period

---

- § 102(b)(1) exempts from § 102(a)(1) any disclosure from an inventor, a joint inventor, or another who obtained the disclosed subject matter from the inventor or joint inventor—provided such disclosure occurs within one year before a claim's effective filing date.
- § 102(b)(2) exempts from § 102(a)(2) disclosures appearing in published applications and patents if:
  - the subject matter was obtained from the inventor or a joint inventor;
  - the subject matter had been publicly disclosed by the inventor, joint inventor, or another who obtained the disclosed subject matter from the inventor or joint inventor (before effective filing of prior art); or
  - the subject matter disclosed in the published application or patent and the claimed invention were owned by or subject to an obligation of assignment to the same person, (ownership/obligation not later than the effective filing date of the currently claimed invention).

# The USPTO “Non-Grace” Period

---

- Grace period exception covers only “identical”\* disclosures
  - “the subject matter disclosed” (“TSMD”) means identical subject matter, not obvious variations.
- To overcome such reference, 1.130 Declaration that:
  - Cited reference was disclosed (or earlier disclosed) by inventor, joint inventor, or another who obtained “TSMD” DOIFTI\*\*.
    - Must ID what subject matter, and when it was disclosed, and include such publication if it was printed, or “sufficient detail to determine what was disclosed” if not.
  - Not effective if applicant contends subject matter was derived [derivation: available only within 1 yr. of pub.; destroys rights]
  - 1.132 still used for applicant attribution declaration in pre-AIA cases (treated as such regardless of declaration title)
  - Unlike 1.131, statement by inventor may be sufficient
  - Can be used against 102(a)(2) prior-filed later-published application references filed > a year before application filing date

\* Even though need not be word-for-word; different mode OK (trade show vs. journal article) & more general disclosure OK.

\*\* “directly or indirectly from the inventor”

## Private Sales & Secret Commercial Uses

---

- Under pre-AIA precedent, offers-for-sale and sales in the U.S. need not be public or (at all) enabling to invalidate a claim under 35 U.S.C. § 102(b), even if kept secret until after the critical date.
- US secret sales and US secret commercial uses prior art under pre-AIA law.
- However, new § 102(a)(1) states that a person shall be entitled to a patent unless the claimed invention was "in public use, on sale, or *otherwise available to the public.*"
- If "available to the public" read to modify "on sale," so that private sales and offer-for-sales, and secret commercial uses no longer construed as prior art (despite purely "non-geographic" AIA definition).

## USPTO Position

---

- In Feb. 14, 2013 Guidelines, USPTO reads “otherwise available to the public” as modifying “on sale,” so that it does not consider private sales and offer-for-sales as prior art in the first place.
- USPTO Guidelines take no position on how to treat public experimental use exception (currently exception to on-sale bar: (1) a commercial sale and (2) “ready for patenting”).

# Which Law Applies, AIA or Pre-AIA?

---

- AIA rules affect any application or patent that contains or contained at any time "a claim to a claimed invention" having an effective filing date on or after March 16, 2013, + any application/patent claiming benefit of an application that contains or contained at any time such claim.
- New principles will go into effect for some applications with filing date on or after March 16, 2013.
- Old principles will remain in effect for all applications with claims having an effective filing date before 3/16/13
  - **EXCEPT** where it contains or ever contained a claim having an effective filing date after March 15, 2013, or claimed the benefit of such an application.
- The new laws will apply to applications having even a single claim with an effective filing date on or after March 16, 2013, even if that claim is later cancelled.

# Transition Filing Strategy

---

- Consider maintaining a clear line of distinction between applications having all claims with effective filing date before or after 3/16/13 – avoid hybrid application.
- Particular challenge where priority/benefit applications filed before 3/16/13 and non-provisional/CIP/PCT (US) filed after 3/16/13 – practitioners informed of consequences may not be involved with preparation of these applications/claims.
- Make sure every claim presented in application filed after 3/16/13 is consistent with your strategy.

## Choose Best Law (1)

---

- Pre-AIA: application gets benefits of establishing an earlier date of invention, avoids expanded definitions of prior art under FITF, relies on 50+ years of case law development
- AIA: If RTP was very close to filing in Japan, perhaps new law is better for Japanese inventors! (if so also file purely “AIA” application - CIP that claims new embodiment OR does not claim benefit of pre 3/16/2013 application) with similar, but different, claims to avoid 101 double patenting
  - Hedges against varying degrees of uncertainty under current and new law

## Choose Best Law (2)

---

- Hybrid application containing claims having an effective filing date before 3/16/13 and at least one claim having an effective filing date after 3/15/13 may be desirable.
- Consider situation where claims in previous (pre 3/16/13) application are arguably rendered un-patentable by events that are prior art under current law (*e.g.*, secret commercial sale; § 103(c) not applicable), but arguably would not be prior art under AIA principles.
- Consider filing CIP after 3/15/13 adding a claim to an embodiment having a effective filing date on or after 3/16/13; CIP application examined under AIA principles/prior art, but still subject to pre-AIA § § 102(g), 135, 291 provisions.

## Straddling 3/16/2013

---

- If at least one claim in the later-filed U.S. application is not entitled to the priority date, then the entire application will be subject to the first-inventor-to-file law, even if that claim or claims are later cancelled.
  - BUT, pre-AIA 102(g), 135, 291 shall apply to each claim of application/patent for which AIA 102 applies if application contains or contained at any time, a claim having an effective filing date prior to 3/16/13, or claimed the benefit of such application (3(n)[2])
- Even if all claims presented in a U.S. application filed on or after March 16, 2013 are identical to claims presented in a priority application filed before March 16, 2013, the U.S. application could be subject to the AIA first-to-file definition.
- To be entitled to a priority date as its effective U.S. filing date, the priority application must comply with the written description and enablement requirements of 35 U.S.C § 112, first paragraph.
- Generic language in an application does not automatically satisfy the written description requirement.

# Straddling 3/16/2013 at USPTO

---

- Statement (admission) that there is [at least one] claim with an effective filing date after 3/15/2013, within the later of:
  - 4 mths. of filing date,
  - 4 mths. of national stage entry
  - 16 mths. of priority date,
  - the presentation date of a first claim that has an effective filing date after 3/15/2013.
- Not required if applicant “reasonably believes on basis of information already known to [1.56 duty-to-disclose persons],” application never had a post-3/15/2013-claim.
  - Does not require Applicant to identify any particular claim
  - Raises specter of inequitable conduct (in addition to AIA prior art definition)
  - Office may issue 1.105 request if Applicant takes conflicting positions on whether an application contains post-3/15/2013 effective date claim
- No statement of pre-AIA effective date required

## Q: To Admit AIA or Not?

---

- “Close call” (and EPO “proof-of-concept”) claims:
  - Applicants want narrow pre-AIA prior art definition
  - But need to avoid inequitable conduct
- To preserve its (and its children’s) **pre-AIA** status, PCT (because designated a US application) should not ever require/claim post-3/15 embodiments.
- And, too costly and difficult to determine whether ANY one of the many persons under a Rule 1.56 duty to disclose would possess a document or knowledge making it *unreasonable* to withhold an AIA admission statement.
- How can you file an ambitious “borderline” claim without sacrificing pre-AIA possibility?...

## A: Dual “AIA” & “Pre-AIA” CONs

---

- “Pre-AIA-narrow-claim” PCT application with more data/embodiments as usual, including descriptions of various scope (1. **overly ambitious**, 2. usually ambitious (e.g., for EPO), 3. narrow), BUT NOT CLAIMING 1 or 2.
  - Art. 19 & 34 amend ONLY using pre-3/16 disclosure (~22nd mth.)
- “AIA-broad-claim” 1<sup>st</sup> CON/CIP after ISR at ~21-24 months (well before 30<sup>th</sup> mth.), claiming all of 1-3 and providing ADS statement that AT LEAST one of 1-3 falls under AIA (b/c 1 claimed, not admitting that 2 is AIA! 😊)
- At 30 mths., “pre-AIA” 2<sup>nd</sup> CON (claim 3 and/or 2). (Broaden PCT claims for EPO entry).
- No inequitable conduct (but AIA) for 1<sup>st</sup> version of claim 2
- Pre-AIA (but maybe (later in time!😊) inequitable conduct charge against 2<sup>nd</sup> version of (borderline) claim 2

# Principal Benefits

---

- Not requiring § 112, ¶ 1 & 1.56 case-by-case analysis
  - costs more predictable for in-house budgeting (US assoc. & benrishi fees could vary wildly to determine whether to file AIA admission b/c of many Rule 56 people implicated by PTO Rules (inequitable conduct threat).
- Gives pre-AIA definition and avoids inequitable conduct for “borderline” claims (even if courts extend inequitable conduct downstream poisoning to non-children; here it occurs, if at all, later in time).
- Broader claims more likely to be issued first, so no statutory double patenting threat. Can file terminal disclaimer for later filed narrower claims, or even avoid it altogether if narrow claims inventive over genus.

# Thanks for your attention! Questions?

---



**Ron Harris**  
**The Harris Firm**  
**922 N STREET, NW, SUITE 101**  
**WASHINGTON, DC • 20001**  
**T: 202-470-0126**  
**F: 202-478-2725**  
[www.harrisfirm.net](http://www.harrisfirm.net)

[ron@harrispatents.com](mailto:ron@harrispatents.com)

**Ron Harris**  
**The Harris Firm**