

America Invents Act (AIA) First Inventor to File (FITF)

Effective March 16, 2013



Overview Training

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AIA Training Plan

- Overview Training: Identifying if your application is subject to the new AIA FITF provisions and introducing the FITF statutory framework (mid-March 2013)
 - Introductory Video: Provides background for Overview Training
 - Live Training
 - Follow-up Video: Statutory review and additional illustrations
- Comprehensive training (June/July 2013)
- Just-in-time training: available as needed (March through July 2013)

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Goals of Overview Training

- **Introductory Video:** Provides background for Live Training
- **Live Training**
 - Be able to identify if an application is subject to the FITF provisions in the AIA
 - Provide familiarity with the FITF statutory framework
- **Follow-up Video:** Illustrates practical applications


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AIA Indicator



First Goal of Today's Training


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How to Know if an Application is Subject to AIA (FITF)

- Examiners can locate whether an application is subject to the AIA (FITF) via:
 - an AIA indicator in eDAN and/or
 - an AIA indicator in PALM
- Examiners should rely on the indicators in either eDAN or PALM

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How to Know if an Application is Subject to AIA (FITF)

- eDAN will label an application in the docket view as:
 - AIA (FITF) column: Yes or No
- eDAN will label an application in the application view as:
 - AIA (First Inventor To File): Yes or No
- PALM will label an application on the Application Information page as:
 - AIA (First Inventor To File): Yes or No

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AIA Indicator: eDAN Docket View

Docket Management: Joe Examiner 01/31/2013 10:29:27 - Regular New - 28 days

Refresh Last Refreshed: 01/30/2013 16:26:29

Regular New (19) Amendments (1) Continuing New (4) Spl Prgms New (1) Spl Law New (0) Expedited (0) Special Am

Oldest New = 12/pppppp M... 28 Ceiling Days = 56

Category	App #	AIA (FITF)	Filing D.	FAOM	INTER	ALW	ABN	Oldes	St	Class	Subcl	Class/Su	Title
1 Regular	12/xxxx,xxx	No	02/03/2009	1.25	1.5	2.0	0.75		30	715	255.000	715/255.000	Widget
2 Regular	12/zzz,zzz	No	01/31/2009	1.25	1.5	2.0	0.75		30	715	234.000	715/234.000	Widget
3 Regular	12/yyy,yyy	No	01/31/2009	1.25	1.5	2.0	0.75		30	715	229.000	715/229.000	Widget
4 Regular	13/bbb,bbb	Yes	04/23/2013	1.25	1.5	2.0	0.75		30	715	205.000	715/205.000	Widget

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AIA Indicator: eDAN Application View

TOC - 12/xxxx,xxx - Al Lowance - Fiber Optic Mouse Trap

App # 12/xxxx,xxx Close App Refresh Refreshed: 02/11/2013 13:04:51

Hide Details... **AIA (First Inventor To File): No** Show: Active

Inventor: Bill Johnson Examiner: Al Lowance
Filing Date: 12/01/2009 Class/Subclass: 370/390.000

PROSECUTION (21)	Incoming (10)	Outgoing (6)	IDS (1)	Fees	Petitions	Bib	Annos (4)	All (21)	Messages (0)
Ima	Status	Doc Code	Document Type	Date	P	Annotations			
1		7 SPEC	Specification	12/01/2009	39				
2		7 CLM	Claims	12/01/2009	6				
3		7 ABST	Abstract	12/01/2009	1				
4		7 NTC PUB	Notice of Publication	09/30/2010	1				
5		7 PD FILED.E	Priority Documents electronically retrieved by USPTO from a particip...	02/09/2010	41				
6		7 APP FILE.REC	Filing Receipt	01/25/2010	3				
7		7 PEFR	Applicant Response to Pre-Exam Formalities Notice	01/14/2010	1				
8		7 OATH	Oath or Declaration filed	01/14/2010	3				
9		7 WFEE	Fee Worksheet (PTO-06)	01/14/2010	2				
10		7 N417	Status Letter Mailed to Applicant	01/14/2010	2				
11		7 NTC.MISS.PRT	Notice to File Missing Parts	12/17/2009	2				

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AIA Indicator: eDAN Application View

TOC - 13/xxx,xxx - Reggie Jection - Cloaking Machine

App. # 13/xxx,xxx Close App Refresh Refreshed: 02/11/2013 13:04:51

AIA (First Inventor To File): Yes

Inventor: Joe Smith Examiner: Reggie Jection
Filing Date: 04/23/2013 Class/Subclass: 370/390.000

Imq	Status	Doc. Code	Document Type	Date	P...	Annotations
1		7 SPEC	Specification	04/23/2013	39	
2		7 CLM	Claims	04/23/2013	6	
3		7 ABST	Abstract	04/23/2013	1	
4		7 NTC PUB	Notice of Publication	04/23/2013	1	
5		7 PD FILED E	Priority Documents electronically retrieved by USPTO from a participati...	04/23/2013	41	
6		7 APP FILE REC	Filing Receipt	04/23/2013	3	

AIA Indicator: PALM Application Information

Application Number Information

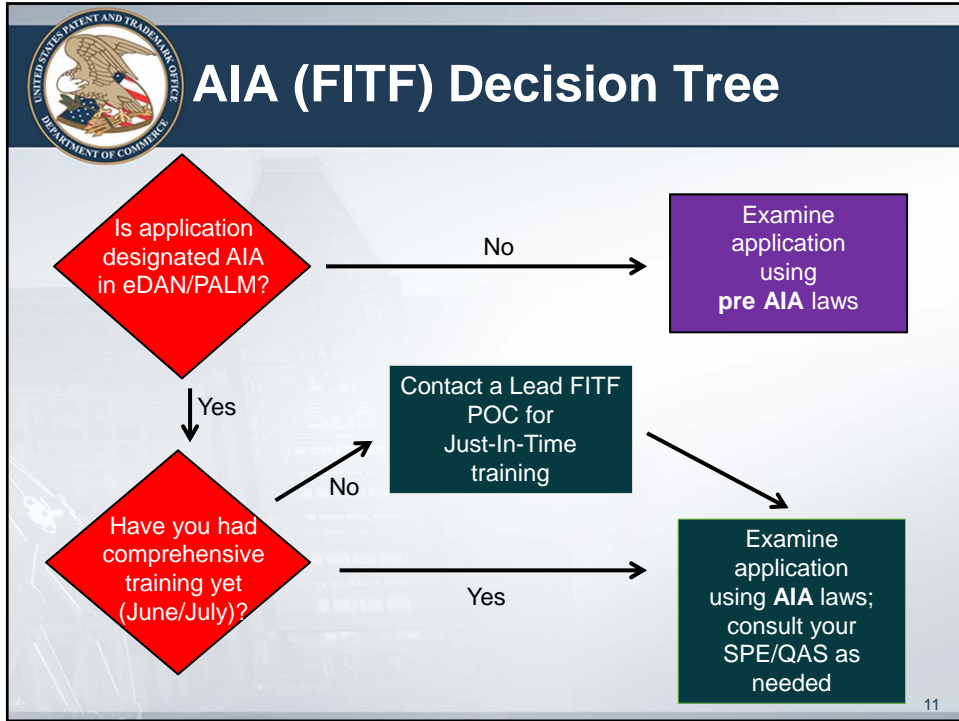
Application Number: 13/xxx,xxx [Assignments](#)
Filing or 371(c) Date: 06/26/2013 [eDan](#)
Effective Date: 05/02/2013
Application Received: 05/02/2013
Pat. Num./Pub. Num.: xxx/xxxxxxx
Issue Date: 00/00/0000
Date of Abandonment: 00/00/0000
Attorney Docket Number: ABCDEF
Status: 30 /DOCKETED NEW CASE - READY FOR EXAMINATION
Confirmation Number:
Title of Invention: Widget with Gears

AIA (First Inventor to File): Yes
Examiner Number: 100,000 - Sam Smith
Group Art Unit: 3700
Class/Subclass: 555/333
Lost Case: NO
Interference Number:
Unmatched Petition: NO
L&R Code: Secrecy Code:1
Third Level Review: NO
Oral Hearing: NO


IFW Madras
Waiting for Response Desc.
[Prior Art Filed](#)
[Prior Art Filed](#)
Secrecy Order: NO
Status Date: 12/26/2013

Bar Code	PALM Location	Location Date	Charge to Loc	Charge to Name	Employee Name
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Appln Info Contents Petition Info Atty/Agent Info Continuity Data Foreign Data Inventors Address Fees Post Info




AIA (FITF) Statutory Framework Under 35 U.S.C. 102



Second Goal of Today's Training


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Pre-AIA v. AIA

- Pre-AIA: first to invent (FTI)
- AIA: first inventor to file (FITF)

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“Effective Filing Date” under AIA

- Effective filing date of the claimed invention in an application is the earlier of:
 - the actual filing date of the application;
- OR
- the filing date to which the application is entitled to a right of **foreign priority** or domestic benefit as to such claimed invention

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Illustration 1: Effective Filing Date



July 1, 2013


**Taylor files
Japanese patent
application
disclosing X**

July 1, 2014

**Taylor files a
nonprovisional patent application
claiming X with a foreign priority
claim to the Japanese application**

- Effective filing date for Taylor’s invention X is July 1, 2013, which is the filing date of the **foreign priority** application


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AIA Impact on 35 U.S.C. 102

Pre-AIA 35 U.S.C. 102 A person shall be entitled to a patent unless—	AIA 35 U.S.C. 102 Concordance
(a) the invention was known or used by others in this country, or patented or described in a printed publication in this country or in a foreign country, before the invention thereof by the applicant for patent, or	102(a)(1)
(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, more than one year prior to the date of the application for patent in the United States, or	102(a)(2)
(c) He has abandoned the invention	No corresponding provision
(d) The invention was first patented or described in a printed publication in a foreign country by the applicant or his legal representative, or in an application for a patent filed by the applicant or his legal representative in the United States, or	No corresponding provision
(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 the English language, or	102(a)(2)
(f) He did not invent the invention	101 and 115
(g) (1) during the course of an experiment or research, or (2) before such time as the invention was abandoned, suppressed, or otherwise made available to the public	No corresponding provision

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AIA Statute Excerpt

§ 102. Conditions for patentability; novelty


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

- (1) the claimed invention was patented, described in a printed publication, or in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention; or
- (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.

(b) **EXCEPTIONS.**—

- (1) **DISCLOSURES MADE 1 YEAR OR LESS BEFORE THE EFFECTIVE FILING DATE OF THE CLAIMED INVENTION.**—A disclosure made 1 year or less before the effective filing date of a claimed invention shall not be prior art to the claimed invention under subsection (a)(1) if—
 - (A) the disclosure was made by the inventor or joint inventor or by another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor; or
 - (B) the subject matter disclosed had, before such disclosure, been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor.
- (2) **DISCLOSURES APPEARING IN APPLICATIONS AND PATENTS.**— A disclosure shall not be prior art to a claimed invention under subsection (a)(2) if—
 - (A) the subject matter disclosed was obtained directly or indirectly from the inventor or a joint inventor;
 - (B) the subject matter disclosed had, before such subject matter was effectively filed under subsection (a)(2), been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor; or
 - (C) the subject matter disclosed and the claimed invention, not later than the effective filing date of the claimed invention, were owned by the same person or subject to an obligation of assignment to the same person.

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AIA Statute Excerpt

§ 102. Conditions for patentability; novelty


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

- (1) the claimed invention was patented, described in a printed publication, or in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention; or
- (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.

(b) **EXCEPTIONS.**—

- (1) **DISCLOSURES MADE 1 YEAR OR LESS BEFORE THE EFFECTIVE FILING DATE OF THE CLAIMED INVENTION.**—A disclosure made 1 year or less before the effective filing date of a claimed invention shall not be prior art to the claimed invention under subsection (a)(1) if—
 - (A) the disclosure was made by the inventor or joint inventor or by another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor; or
 - (B) the subject matter disclosed had, before such disclosure, been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor.
- (2) **DISCLOSURES APPEARING IN APPLICATIONS AND PATENTS.**— A disclosure shall not be prior art to a claimed invention under subsection (a)(2) if—
 - (A) the subject matter disclosed was obtained directly or indirectly from the inventor or a joint inventor;
 - (B) the subject matter disclosed had, before such subject matter was effectively filed under subsection (a)(2), been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor; or
 - (C) the subject matter disclosed and the claimed invention, not later than the effective filing date of the claimed invention, were owned by the same person or subject to an obligation of assignment to the same person.


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AIA Statutory Framework

Prior Art 35 U.S.C. 102(a) (Basis for Rejection)	Exceptions 35 U.S.C. 102(b) (Not Basis for Rejection)	
102(a)(1) Disclosure with Prior Public Availability Date	102(b)(1)	(A) Grace Period Disclosure by Inventor or Obtained from Inventor
		(B) Grace Period Intervening Disclosure by Third Party
102(a)(2) U.S. Patent, U.S. Patent Application, and PCT Application with Prior Filing Date	102(b)(2)	(A) Disclosure Obtained from Inventor
		(B) Intervening Disclosure by Third Party
		(C) Commonly Owned Disclosure


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AIA Statutory Framework

Prior Art 35 U.S.C. 102(a) (Basis for Rejection)	Exceptions 35 U.S.C. 102(b) (Not Basis for Rejection)	
102(a)(1) Disclosure with Prior Public Availability Date	102(b)(1)	(A) Grace Period Disclosure by Inventor or Obtained from Inventor
		(B) Grace Period Intervening Disclosure by Third Party
102(a)(2) U.S. Patent, U.S. Patent Application, and PCT Application with Prior Filing Date	102(b)(2)	(A) Disclosure Obtained from Inventor
		(B) Intervening Disclosure by Third Party
		(C) Commonly Owned Disclosures


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AIA Statutory Framework

Prior Art 35 U.S.C. 102(a) (Basis for Rejection)	Exceptions 35 U.S.C. 102(b) (Not Basis for Rejection)	
102(a)(1) Disclosure with Prior Public Availability Date	102(b)(1)	(A) Grace Period Disclosure by Inventor or Obtained from Inventor
		(B) Grace Period Intervening Disclosure by Third Party
102(a)(2) U.S. Patent, U.S. Patent Application, and PCT Application with Prior Filing Date	102(b)(2)	(A) Disclosure Obtained from Inventor
		(B) Intervening Disclosure by Third Party
		(C) Commonly Owned Disclosures


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AIA Statutory Framework

Prior Art 35 U.S.C. 102(a) (Basis for Rejection)	Exceptions 35 U.S.C. 102(b) (Not Basis for Rejection)	
102(a)(1) Disclosure with Prior Public Availability Date	102(b)(1)	(A) Grace Period Disclosure by Inventor or Obtained from Inventor
		(B) Grace Period Intervening Disclosure by Third Party
102(a)(2) U.S. Patent, U.S. Patent Application, and PCT Application with Prior Filing Date	102(b)(2)	(A) Disclosure Obtained from Inventor
		(B) Intervening Disclosure by Third Party
		(C) Commonly Owned Disclosures


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AIA Statutory Framework

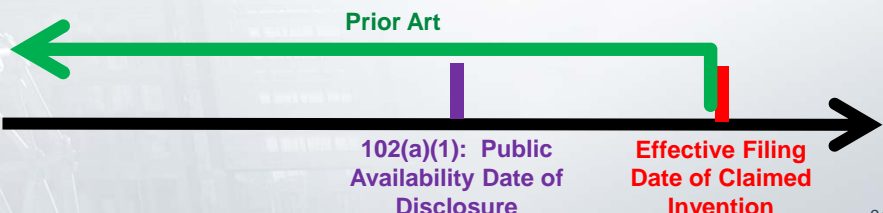
Prior Art 35 U.S.C. 102(a) (Basis for Rejection)	Exceptions 35 U.S.C. 102(b) (Not Basis for Rejection)	
102(a)(1) Disclosure with Prior Public Availability Date	102(b)(1)	(A) Grace Period Disclosure by Inventor or Obtained from Inventor
		(B) Grace Period Intervening Disclosure by Third Party
102(a)(2) U.S. Patent, U.S. Patent Application, and PCT Application with Prior Filing Date	102(b)(2)	(A) Disclosure Obtained from Inventor
		(B) Intervening Disclosure by Third Party
		(C) Commonly Owned Disclosures

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35 U.S.C. 102(a)(1): Disclosure with Prior Public Availability Date

- Precludes a patent if a claimed invention was, before the effective filing date of the claimed invention:
 - Patented;
 - Described in a Printed Publication;
 - **In Public Use**;
 - **On Sale**; or
 - Otherwise Available to the Public



← Prior Art
102(a)(1): Public Availability Date of Disclosure Effective Filing Date of Claimed Invention


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In Public Use or On Sale

- AIA does not include the pre-AIA geographic limitation; use or sale may occur anywhere in the world
- AIA does not include the pre-AIA use of secret sales as prior art

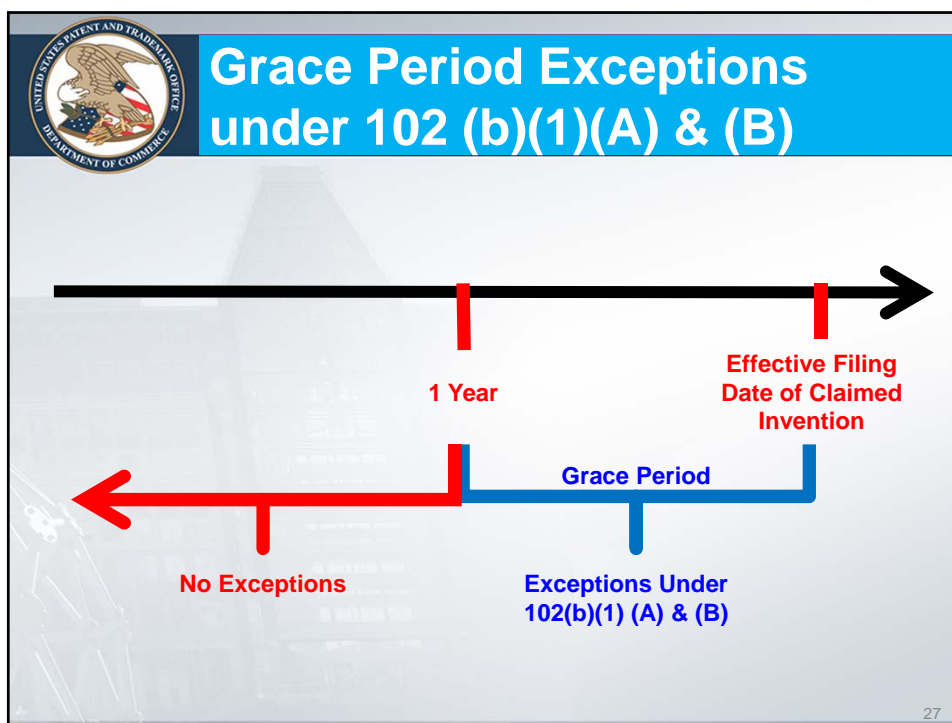
25



35 U.S.C. 102(b)(1): Grace Period Exceptions

- Grace period = one-year time period before the effective filing date of the claimed invention
- There are two exceptions for disclosures made during the grace period

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35 U.S.C. 102(b)(1)(A): Exception for Grace Period Disclosure by Inventor or Obtained from Inventor

- First exception for prior art disclosures under 35 U.S.C. 102(a)(1) found in 35 U.S.C. 102(b)(1)(A)
- A disclosure made one year or less before the effective filing date of the claimed invention shall not be prior art under 35 U.S.C. 102(a)(1) if the disclosure was by:
 - the inventor or joint inventor; or
 - another who obtained the subject matter directly or indirectly from the inventor or joint inventor

In the top left corner of the slide, there is a circular logo for the United States Patent and Trademark Office, Department of Commerce.

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 **Illustration 2:
Exception in 102(b)(1)(A)**

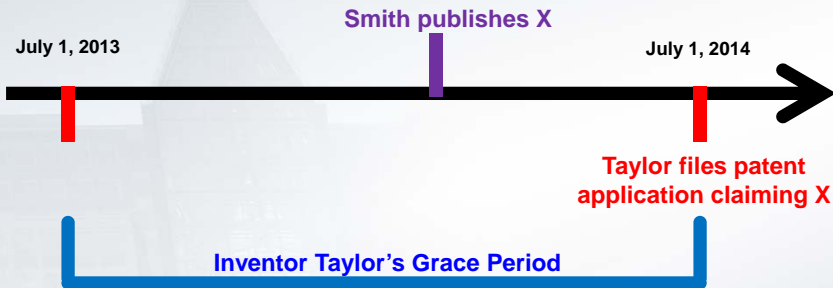


The diagram shows a horizontal timeline starting at July 1, 2013 and ending at July 1, 2014. A red vertical line marks the start of the timeline. A second red vertical line is positioned between July 1, 2013 and July 1, 2014, labeled "Taylor publishes X". A third red vertical line is at July 1, 2014, labeled "Taylor files patent application claiming X". A blue bracket below the timeline spans from the start to the July 1, 2014 mark, labeled "Inventor Taylor's Grace Period".

- Taylor's publication is not available as prior art because of the exception under 102(b)(1)(A) for a grace period disclosure by an inventor

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 **Illustration 3:
Exception in 102(b)(1)(A)**



The diagram shows a horizontal timeline starting at July 1, 2013 and ending at July 1, 2014. A red vertical line marks the start of the timeline. A purple vertical line is positioned between July 1, 2013 and July 1, 2014, labeled "Smith publishes X". A red vertical line is at July 1, 2014, labeled "Taylor files patent application claiming X". A blue bracket below the timeline spans from the start to the July 1, 2014 mark, labeled "Inventor Taylor's Grace Period".

- Smith's publication is prior art under 102(a)(1) because it does not fall within any exception in 102(b)(1)
- But if Smith obtained subject matter X from Taylor then it falls into the 102(b)(1)(A) exception as a grace period disclosure obtained from the inventor


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35 U.S.C. 102(b)(1)(B): Exception for Grace Period Intervening Disclosure by Third Party

- Second exception for prior art disclosures under 35 U.S.C. 102(a)(1) (prior public disclosures) found in 35 U.S.C. 102(b)(1)(B)
- A disclosure made one year or less before the effective filing date of the claimed invention shall not be prior art under 35 U.S.C. 102(a)(1) if:
 - **the subject matter** disclosed was, before such disclosure, publicly disclosed by:
 - the inventor or joint inventor; or
 - another who obtained the subject matter directly or indirectly from the inventor or joint inventor


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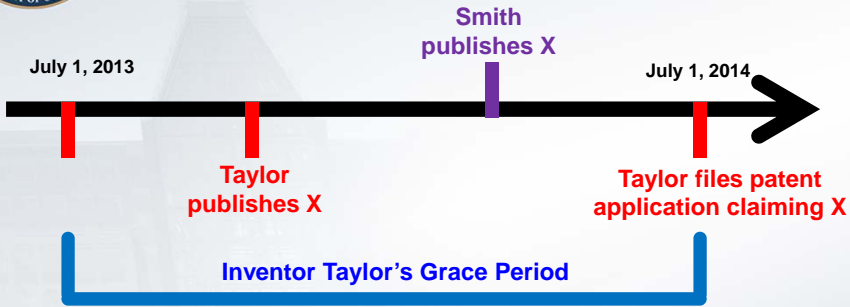


“The Subject Matter”

- The subject matter in an intervening disclosure must be the same as the subject matter previously publicly disclosed by the inventor
- There is no requirement:
 - that the mode of disclosure by inventor and the intervening disclosure be the same; or
 - for a verbatim or word-for-word disclosure

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 **Illustration 4:
Exception in 102(b)(1)(B)**



July 1, 2013

Taylor publishes X

Smith publishes X


July 1, 2014

Taylor files patent application claiming X

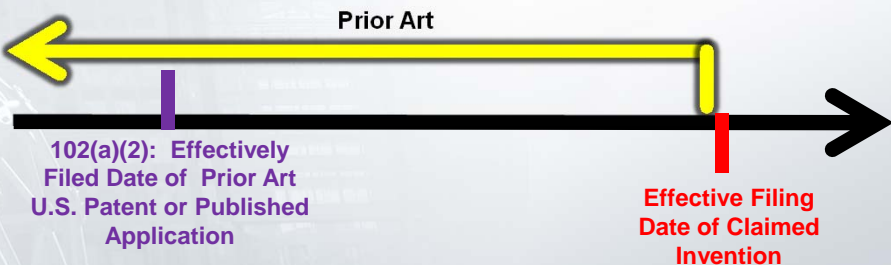
Inventor Taylor's Grace Period

- Smith's publication is not prior art because of the exception under 102(b)(1)(B) for a grace period intervening disclosure by a third party
- Taylor's publication is not prior art because of the exception under 102(b)(1)(A) for a grace period disclosure by the inventor

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 **35 U.S.C. 102(a)(2): U.S. Patent, U.S. Patent Application, and PCT Application with Prior Filing Date**

- Precludes a patent if a claimed invention was described in a:
 - U.S. Patent;
 - Published U.S. Patent Application; or
 - Published PCT Applicationthat names another inventor and was **effectively filed** before the effective filing date of the claimed invention




Prior Art

102(a)(2): Effectively Filed Date of Prior Art U.S. Patent or Published Application

Effective Filing Date of Claimed Invention

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“Effectively Filed” Date of Prior Art Under AIA Section 102(a)(2)

- Effective prior art date of subject matter in U.S. patents and published applications under AIA 35 U.S.C. 102(a)(2) is the earlier of:
 - the actual filing date of the U.S. patent or published application
- or
- the filing date of the earliest application to which the U.S. patent or published application is entitled to claim a right of **foreign priority** or domestic benefit which describes the subject matter

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Illustration 5: Effectively Filed Prior Art Reference Under AIA 102(a)(2)

The diagram shows a horizontal timeline with an arrow pointing right. Three vertical purple bars mark specific dates:

- April 1, 2011: Smith files Japanese patent application disclosing X
- April 1, 2012: Smith files U.S. patent application claiming X with a foreign priority claim to the Japanese application
- October 4, 2012: Smith's patent application publishes

- Smith's prior art patent application publication was effectively filed on April 1, 2011, which is the filing date of the foreign priority application
- Crediting the foreign priority date for the effective filing date of a reference is **only** done when you are examining an AIA application.

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35 U.S.C. 102(b)(2)(A): Exception for Disclosure Obtained from Inventor

- First exception for prior art under 35 U.S.C. 102(a)(2) found in 35 U.S.C. 102(b)(2)(A)
- A disclosure in an application or patent shall not be prior art under 35 U.S.C. 102(a)(2) if:
 - the disclosure was by another who obtained the subject matter directly or indirectly from the inventor or joint inventor

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Illustration 6: Exception in 102(b)(2)(A)


Smith files patent application disclosing X
April 1, 2014

Taylor files patent application claiming X
July 1, 2014

Smith's application publishes
October 1, 2015


- Smith's patent application publication is not prior art if Smith obtained X from Inventor Taylor because of the exception under 102(b)(2)(A) for a disclosure obtained from the inventor

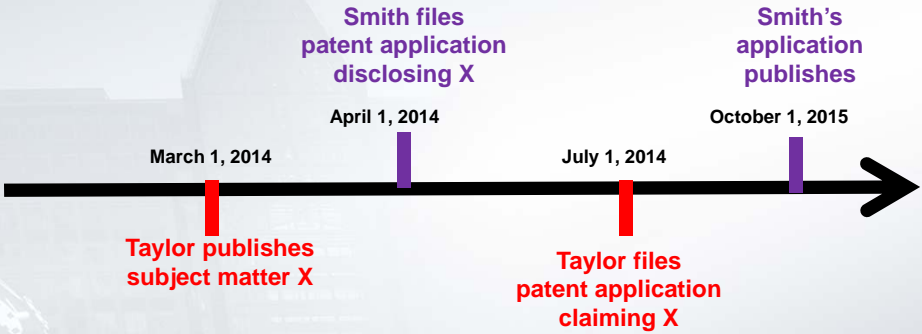
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 **35 U.S.C. 102(b)(2)(B): Exception for Intervening Disclosure by Third Party**

- Second exception for prior art under 35 U.S.C. 102(a)(2) found in U.S.C. 102(b)(2)(B)
- A disclosure in an application or patent shall not be prior art under 35 U.S.C. 102(a)(2) if:
 - the subject matter disclosed was, before such subject matter was effectively filed, publicly disclosed by:
 - the inventor or joint inventor; or
 - another who obtained the subject matter directly or indirectly from the inventor or joint inventor

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 **Illustration 7: Exception in 102(b)(2)(B)**

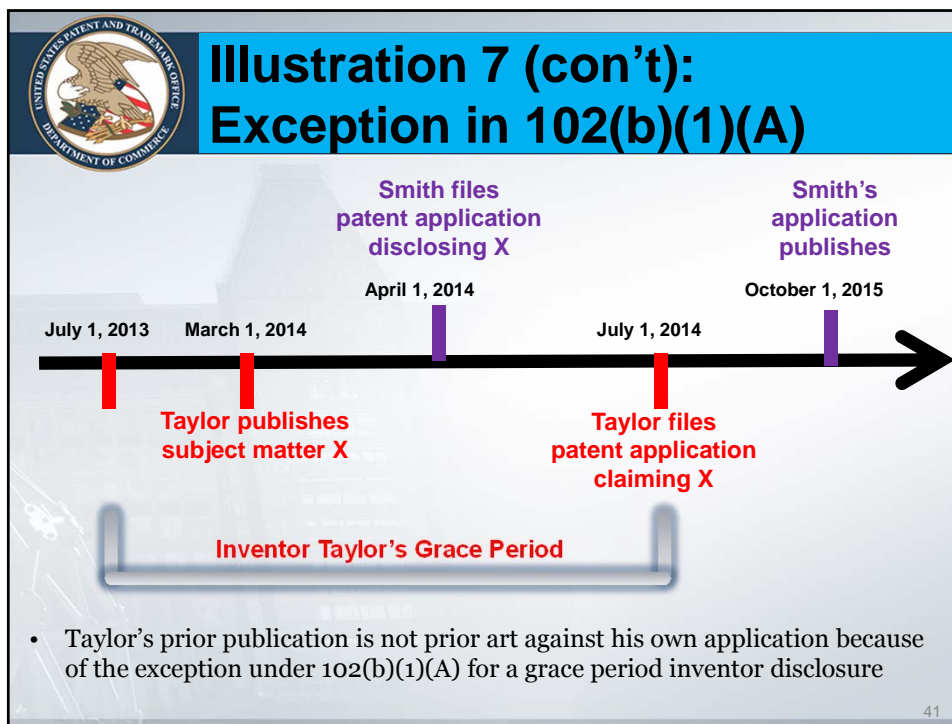


Timeline events:

- March 1, 2014: Taylor publishes subject matter X
- April 1, 2014: Smith files patent application disclosing X
- July 1, 2014: Taylor files patent application claiming X
- October 1, 2015: Smith's application publishes

- Smith's patent application publication is not prior art against Taylor's application because of the exception under 102(b)(2)(B) for an intervening disclosure by a third party

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35 U.S.C. 102(b)(2)(C): Commonly Owned Disclosure Exception

- Third exception for prior art under 35 U.S.C. 102(a)(2) found in 35 U.S.C. 102(b)(2)(C)
- A disclosure in an application or patent shall not be prior art under 35 U.S.C. 102(a)(2) if:
 - the subject matter and the claimed invention were commonly owned or subject to an obligation of assignment to the same person not later than the effective filing date of the claimed invention
- Resembles pre-AIA 35 U.S.C. 103(c)
 - AIA disqualifies 35 U.S.C. 102(a)(2) type prior art for both novelty and obviousness, whereas the pre-AIA 35 U.S.C. 103(c) applied only to obviousness

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Illustration 8: Exception in 102(b)(2)(C)

Timeline illustrating the exception in 102(b)(2)(C) for a commonly owned disclosure:

- February 1, 2014: Taylor invents X and assigns to Company Z
- March 1, 2014: Smith invents X and assigns to Company Z
- April 1, 2014: Smith files patent application disclosing X
- July 1, 2014: Taylor files patent application claiming X

- Smith's patent application publication is not prior art because of the exception under 102(b)(2)(C) for a commonly owned disclosure


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For Questions...

- Intranet link:
<http://ptoweb.uspto.gov/patents/fitf>
- Questions:
FITF_examiner_questions@uspto.gov
- Lead FITF Points of Contact


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Lead FITF Points of Contact

Contact	Business Unit
Cassandra Spyrou	TC 2600 & 2800
Chris Grant	TC 2100, 2400, & OPT
Tom Hughes	TC 3600, 3700, & CRU
Kathleen Bragdon	TC 1600, 1700 & 2900
Gerald Leffers	OPQA/ TC 1600, 1700 & 2900
Steve Saras	OPQA/ TC 2600 & 2800
MaryBeth Jones	OPQA/ TC 3600, 3700, & CRU

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Time Code and Follow-up Video

- Watch the Follow-up Video before April 20, 2013
- Turn in your attendance cards with your name and Art Unit
- Time code = **ATRAIN 0118 090101**

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Thank You!



Questions?