

**From:** James Mason

**Sent:** Wednesday, October 03, 2012 9:14 PM

**To:** fitf\_rules

**Cc:** Till, Mary; Fonda, Kathleen

**Subject:** Comments to proposed rules 37 CFR Part 1: Changes To Implement the First Inventor To File Provisions of the Leahy-Smith America Invents Act

Dear Mary C. Till and Kathleen Kahler Fonda:

I am requesting reconsideration and clarification of the interpretation of the rules provided under sections of 102(b)(1)(A) and 102(b)(1)(B) in the proposed rules. These are modified versions of old 102(a) and 102(b) in the context of removing prior art of the inventors own public disclosures and public disclosures of others. New 102(b)(1)(A) and 102(b)(1)(B) should be interpreted with the current language in the context of the operation of old 102 to prevent substantial disruption of the rights of inventors. A more detailed analysis is provided below.

### **The inventor's own disclosures in light of the claimed subject matter in light of old and new Section 102**

By applying a combination of old 102(a) and 102(b), one could remove as prior art the public disclosure of the inventor by providing evidence to the Patent Office that the disclosure was the inventor's own disclosure made less than one year than the effective filing date. The removal of an inventor's publication as prior art does not require that the publication and the claim be identical subject matter. The proposed new ruled under new 102(b)(1)(A) appears to be substantially similar and consistent with this interpretation. However, clarification is requested.

### **The disclosure of another in light of the claimed subject matter in light of old and new section 102**

By applying a combination of old 102(a) and 102(b), one could remove as prior art the public disclosure of another made less than one year than the effective filing date by providing corroborated evidence to the Patent Office that the inventor conceived of the subject matter of the claimed invention prior to the disclosure. Under the old 102, the inventor could submit evidence of prior invention that was secret evidence, e.g., a dated lab notebook, or publically available evidence, e.g., a journal publication, as long as the evidence showed the inventor conceived of the claimed subject matter.

New 102(b)(1)(B) is a modification of old 102. One is still able to show prior invention of the claimed invention with evidence of the inventor's own publicly available disclosures. However, secret evidence of invention by the Patent Applicant is not sufficient. The new rules provide that 102(b)(1)(B) will not apply if the publication or intervening publication by another is not identical to the claimed subject matter such as an obvious variants. We request reconsideration of this rule. **Whether the disclosure of another is identical or an obvious variant is irrelevant.** The proper relevant inquiry is whether the public

disclosure of the inventor contains subject matter supporting claimed invention. The Patent Applicant's disclosure may contain subject matter that is identical to the claimed matter or the subject matter may be a species supporting a generically claimed invention. As long as the public disclosure of the inventor supports the claimed subject matter, then the later disclosure of another is irrelevant as it is not prior art. Reconsideration of the current rules is requested.

Kind Regards,

James C. Mason, M.S., J.D.  
Partner  
Yamauchi & Mason LLC  
60 Tufts Street, Suite 17  
Somerville, MA, 02145  
Tel. 617-959-1991  
[james.mason@yamaip.com](mailto:james.mason@yamaip.com)