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Sent: Wednesday, September 14, 2011 4:23 PM
To: Gongola, Janet
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Subject: 102(b)(1)(B)

Janet:

I was wondering if we could get your help to clear up an issue that is apparently causing quite a bit of early confusion in the patent practitioner community.

Specifically, Section I.C of the AIA Potential Items for Patents dated 7/22/2011 contains the following item on page 1:

C. (1) 35 U.S.C. 102(a)(2)/(b):
a. Another application/patent was "effectively filed before the effective filing date of the claimed invention," 35 U.S.C. 102(a)(2)/ 35 U.S.C. 102(d) relating thereto, and
b. the 1 yr grace period exceptions in 35 U.S.C. 102(b) (to 35 U.S.C. 102(a)) limited to disclosures by an inventor or another who obtained it from the inventor. (The common ownership exception of 35 U.S.C. 102(b)(2)(C) is treated in D below).

We have received communications from several practitioners who are asserting that this statement is being seen as some kind of confirmation that the Patent Office position is that all of new 102(b) exceptions will be limited to "disclosures by an inventor or another who obtained it from the inventor." As indicated by both Sens. Leahy and Kyle in the legislative history, that interpretation is not a complete and accurate representation of the new 102(b) exceptions and is leading many to mistakenly conclude that the grace period exceptions of new 102(b) are weaker than the existing law, when the reality is that the new 102(b) grace period is actually stronger.

Is it possible for the Office to update the AIA Potential Items for Patents on the USPTO Website to correct this issue so that practitioners will appreciate that there are two kinds of exceptions to publicly available art: namely, (A) the inventor's own work for the entire 1 year period, and (B) any other publications by/for the inventor or by independent third parties, but only for the period between a public disclosure by/for the inventor and the inventor's filing date so long as that period is less than 1 year.

Set out below is a posting I made on this issue this morning on the PatentlyO blog and some relevant quotes from the legislative history that support making this correction.

Thanks

Brad

This legislation has always been represented as providing the inventor with a one-year grace period for any public disclosures or prior art activity so long as such disclosures or prior art activity originated with the inventor.
David, Judith_IP has the grace period correct when she points to Sen. Leahy's comments. Sen. Kyle made similar comments. 6 is wrong in saying that there is no more grace period. Your statement is correct, but only describes half of the grace periods applied to publicly available art - new 102(a)(1).
To make the statutory analysis of the grace period for publicly available art easier, let's take new 102(b)(1) and focus just on the inventor, ignoring the joint inventor and derived from language. As the language on joint inventor and derived from is essentially identical in new 102(b)(1)(A) and (B), this simplification is equivalent to the associative law of statutory construction. So, applying this simplification in order to demonstrate how there are really two kinds of grace

periods for publicly available art, not just one, the simplified version would read:

`(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
`(B) the subject matter disclosed had, before such disclosure, been publicly disclosed by the inventor.

To avoid construing subsection (B) as being duplicative of section (A) as (A) will have always occurred before (B) if these acts are limited solely to acts of the inventor, then these two subsections should be interpretted as referring to different acts. But what you see by reducing the side issue (joint and derived disclosures) is that there is a timing difference in the statutory language between these two subsections:

`(A) the disclosure was made by the inventor; (inventor disclosures are exempt for entire 1 year grace period) or
`(B) the subject matter disclosed had, before such disclosure, been publicly disclosed by the inventor. (other disclosures are exempt only for that portion of 1 year grace period that is after inventor disclosure, i.e. between the inventor disclosure and the inventor patent filing)

Because any subsequent inventor disclosure in the "gap" period between the initial inventor disclosure and the inventor patent filing that is defined by subsection (B) is is already excepted under the entire 1 year grace period for inventor publications that is defined by subsection (A), Congress in it's statutory language for subsection (B) is defining something else other than the inventor's own acts that are to be covered by the in-between gap part of the grace period defined by subsection (B).

Plainly, this statutory construction makes clear that subsection (B) is intended to apply to more than just the work of the inventor. In addition, because the language about joint/derived disclosure is essentially identical between subsection (A) and subsection (B), the difference between the two subsections can't be attributed to that common language. What this simplification analysis demonstrates is that, consistent with the comments of Sens. Leahy and Kyle, the grace period defined by new 102(1)(B)(2) is directed to publications of third parties, including third parties who independently developed the subject matter in question.
Effectively, new subsection (B) replaces "reactive" swearing behind in old 102(a) to establish an earlier date of invention with a new "proactive" swearing in front of in the new 102(b)(1)(B) by requiring the inventor to do their "swearing" in advance in the form of "publishing ahead."
“New section 102(b) preserves the grace period, ensuring that during the year prior to filing, an invention will not be rendered unpatentable based on any of the inventor's own disclosures, or any disclosure made by any party after the inventor has disclosed his invention to the public.”
http://www.congress.gov/cgi-lis/cpquery/R?cp112:FLD010:@1(hr098)
Senator Kyl says in the Legislative History: "Under new section 102(b)(1)(B), once the U.S. inventor discloses his invention, no subsequent prior art can defeat the invention. The U.S. inventor does not need to prove that the third party disclosures following his own disclosures are derived from him."

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