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Sent: Thursday, September 29, 2011 11:51 AM
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Subject: USC 102(b)(1)(B)

USPTO,

I would recommend that the above-cited section regarding the “grace period” under AIA be interpreted to mean any later disclosure of the same subject matter, made subsequent to the first disclosure of that subject matter, even if the later disclosure was done independently and not obtained or derived from the inventor who made the first disclosure, would not be prior art to the claimed invention of that inventor. Here is the statutory text with my comments in square brackets:

“(1) DISCLOSURES MADE 1 YEAR OR LESS BEFORE THE EFFECTIVE FILING DATE OF THE CLAIMED INVENTION- A disclosure [not necessarily the first or only disclosure, hereinafter “disclosure X”] 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 [disclosure X] was made by the inventor or joint inventor or by another who obtained the subject matter disclosed [in disclosure X] directly or indirectly from the inventor or a joint inventor; or

(B) the subject matter disclosed [in disclosure X] had, before such disclosure [disclosure X], been publicly disclosed [in a separate, earlier disclosure, hereinafter “disclosure Y”] by the inventor or a joint inventor or another who obtained the subject matter disclosed [in disclosure Y] directly or indirectly from the inventor or a joint inventor.” (USC 102(b)(1) - emphasis added).

The foregoing interpretation is also consistent with the Legislative History of AIA. In particular, please consider the following statement by Senator Kyl (R-AZ):

“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.”

More specifically, I would endorse the following interpretation as articulated by Jeffrey Lefstin, Ph.D., Professor of Law at the University of California Hastings College of the Law:

“The simplest approach would be that inventor disclosure immunizes any claim that encompasses the inventor’s disclosure. Under this approach, prior art appearing subsequent to the preclusive disclosure cannot be asserted against a claim reading on the preclusive disclosure. That immunity could either be extended to dependent claims that do not themselves read on the preclusive disclosure (thereby permitting the inventor to claim species disclosed by third parties), or restricted to claims that directly read upon the preclusive disclosure (thereby prohibiting the inventor to claim species disclosed by a third party).[I would favor extending the immunity to dependent claims, since the disclosure of genus subject matter inherently comprises all species subject matter within it]

The claim-focused approach permits us to use our existing framework for assessing novelty under § 102, because the only inquiry would be inclusion of the preclusive disclosure in a later claim. In addition, because in the strong form of the approach preclusive scope does not depend on the content of the later third-party disclosure, it eliminates the possibility of strategic disclosures by third parties and the disputes likely to ensue over whether the third-party’s disclosure was derived from the inventor’s.

The claim-focused approach is not the most faithful to the statutory text, because new § 102(b) defines the prior art exclusion by the subject matter disclosed by the inventor, not by a claim encompassing the inventor’s disclosure. Nonetheless, this interpretation would be attractive to a court seeking a straightforward analysis, or a court seeking to temper Leahy-Smith’s impact on the prior art regime.”

I believe that the foregoing claim-based approach is appropriate given the statutory language which states that the disclosure “shall not be prior art to the claimed invention” (USC 102(b)(1) - emphasis added).

Thank you,

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