FIRST TO FILE PATENT DRAFTING: A Practitioner's Guide

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Case Law Last Updated May 16, 2016
This version: May 25, 2016
FirstToFilePatentDraftingMay26.pdf

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SUMMARY OF CONTENTS

§ 2[a][6][C] State of the Art as of the Filing Date

A prime difference between the one year grace period under the 1952 Patent Act and the *Leahy Smith America Invents Act* is that the one year grace period in the 1952 law exempted all third party disclosures of the invention subsequent to the date of invention by the applicant *as part of the definition of prior art by excluding such third party disclosures*, whereas there is no general exclusion from the definition of prior art in the *Leahy Smith America Invents Act* but, instead, there is a separate grace period provision exempting only *certain* acts. Additionally, the wording of Section 103 of the *Leahy Smith America Invents Act* sets forth a definition for nonobviousness that is keyed to the "state of the art" as of the *filing date* and not the *invention date.* Both differences provide critical distinctions as to third party subject matter divulged during the one year grace period as to subject matter *different from* the claimed invention.

Under the 1952 Patent Act, otherwise prior art disclosures of third parties during the one year grace period were *excluded as prior art* under Section 102 and, as prior art for nonobviousness under Section 103 incorporates by reference the definition of prior art in Section 102, such otherwise prior art disclosures received a blanket prior art grace period exemption under Section 103.

Thus, under the 1952 Patent Act, third party prior art events within the one year grace period did not apply if they occurred after the applicant's *date of invention*: "A person shall be entitled to a patent unless — the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, *before the invention thereof by the applicant* for patent[.]" 35 USC §102(a)(1952 Patent Act)(emphasis added)

But, under the *Leahy Smith America Invents Act*, the parallel provision to Section 102(a) of the 1952 Patent Act makes *no* grace period exemption: "A person shall be entitled to a patent unless —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[.]" 35 USC § 102(a)(1)(Leahy Smith America Invents Act).

The grace period in the *Leahy Smith America Invents Act* is found in 35 USC § 102(b)(1)(B):

"*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 [35 USC § 102](a)(1)] if — 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." (emphasis added).

(A similar grace period exemption is provided in 35 USC § 102(b)(2) to exempt prior filed but later published disclosures in a third party's patent application.)

Thus, one may question based upon the statutory wording whether there is any room for a "grace period" for subject matter *different from* the claimed invention which, as part of the state of the art, renders the claimed invention *obvious.*

Based upon the statutory wording of the *Leahy Smith America Invents Act*, there are two *independent* reasons to question whether the grace period applies to a third party disclosure of an *obvious variant* of the claimed invention between the inventor's first prior art divulgation and his filing date.

First, under the PTO guidance, the literal wording of the grace period statute only applies to a disclosure of the *same invention* and not an obvious variant. *See* § 2[a][6][C][i], *Grace Period does not Literally Apply to Obvious Variants*.

Second, there is no indication in the legislative history that the "state of the art" to measure obviousness under 35 USC § 103 has anything to do with the grace period, given the statutory statement that obviousness is measured by the state of the art as of "the effective filing date of the claimed invention*." See* § 2[a][6][C][ii], *Grace Period does not Apply to the "State of the Art"*.

A narrow interpretation of the grace period has been endorsed by the respected scholar, Professor Janice Mueller, in her treatise. § 2[a][6][C][iii], *Professor Mueller's Interpretation of the New Law.*

To understand why the grace period should not be relied upon, consider the following situations:

In the first instance, the new grace period under its literal wording does *not* exempt a third party publication of an *obvious variant* of the invention in the interval between the first dissemination of the information by the inventor and the

inventor's filing of his patent application. *See* § 2[a][6][C][i], *Grace Period does not Literally Apply to Obvious Variants.*

Secondly, but perhaps even more important, the state of the art is measured as of the *filing date.* The "state of the art" determination is critical to determine whether an invention is obvious under 35 USC § 103, as opposed to old law where the state of the art was measured as of the *invention date. See* § 2[a][6][C][ii], *Grace Period does Not Apply to the "State of the Art"*:

Consider, for example, the situation where the inventor files his patent application *after* a scientific conference where he explains his invention. Under the law prior to 2011, the invention may well be nonobvious based upon the state of the art as of the date of *invention* (the standard under the old law). After the scientific conference the knowledge of the state of the art may have increased dramatically because of the inventor's disclosure at the conference so that, *as of the subsequent filing date,* the state of the art now renders the invention obvious. *Id.*

The scholarship of Professor Janice Mueller supports the view that the *date* to measure state of the art may be critical to nonobviousness. *See* § 2[a][6][C][iii], *Professor Mueller's Interpretation of the New Law*.

§ 2[a][6][C][i] Grace Period does not Literally Apply to Obvious Variants

It is, of course, a given that under the *Leahy Smith America Invents Act* that the *identical* disclosure of the *same invention* before the applicant's filing date by the inventor or a third party subsequent to the inventor's publication may be excused as prior art under the limited grace period .

But, as advocated by Robert A. Armitage (and adopted in the PTO guidance) if there is a disclosure of *different* subject matter that is derived from the inventor, this *different* subject matter may *not* be excused under the grace period. This matter has yet to be resolved in any Federal Circuit test case.

The literal wording of the statute supports the Armitage view that the grace period does *not* apply to exempt a third party's disclosure of an *obvious variation* of the invention. The Patent Office says is that a third party publication of an *obvious variant* of the claimed invention is prior art against the subsequent filing of the first inventor's patent application: *The grace period does not apply to anything other than a disclosure of the same invention*: "A *disclosure *** of a claimed invention* shall not be prior art to the claimed invention [as having been 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] if *** the *subject matter disclosed* had, before such disclosure, been publicly disclosed by *** another who obtained the subject matter disclosed *** from the inventor ***." 35 USC § 102(b)(1)(B)(integrating in brackets text from 35 USC § 102(a)(1))(emphasis added).

§ 2[a][6][C][ii] Grace Period does not Apply to the "State of the Art"

The grace period under the *Leahy Smith America Invents Act* does *not* apply to the grace period between the inventor's first disclosure and the effective filing date of the application. Thus, for example, if the inventor makes the invention on Year (1), and publishes his invention at Year (2) and then under the one year grace period files his patent application at Year (3), obviousness is judged based upon the state of the art at Year (3), and neither the date of the invention at Year (1) nor the first publication of the invention at Year (2). The state of the art may have vastly changed at the filing date in Year (3) vis a vis either of the earlier dates of invention in Year (1) or the date of the grace period-exempt publication in Year (2). Indeed, given the publication of the invention in Year (2), it would be most suprising if the result is anything other than an enhanced knowledge of the state of the art which could render a once nonobvious invention obvious because of the higher level of knowledge of the state of the art.

Thus, as time passes, the state of the art may evolve to the point that later disclosures make an invention obvious which, prior to such later disclosures, would have been nonobvious. The date to determine the state of the art under the *Leahy Smith America Invents Act* has been move forward to the later *effective filing date* as opposed to the 1952 Patent Act which measures the state of the art as from the often much earlier date of invention. Thus, under the *new* standard of the *Leahy Smith America Invents Act* for determining nonobviousness of a claimed invention, the legal test under 35 USC § 103 is whether –

"the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious ***before the effective filing date of the claimed invention*** to a person having ordinary skill in the art to which the claimed invention pertains."

This replaces the original statutory test for nonobviousness introduced in the 1952 Patent Act which, under its most recent statement before the new law, was found in 35 USC § 103(a) that asks whether –

"the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious ***at the time the invention was made*** to a person having ordinary skill in the art to which said subject matter pertains."

Under the new wording of Section 103, one may question whether there is any possibility or room for a grace period for such *different* subject matter, given that the state of the prior art is measured today as of the *filing date* and not the date of the applicant's *invention*: Thus, is there any "grace period" that remains under the *Leahy Smith America Invents Act* as to the body of prior art literature available before the filing date which cumulatively establishes the "state of the art" for determining nonobviousness under 35 USC § 103?

§ 2[a][6][C][iii] Professor Mueller's Interpretation of the New Law

Professor Janice Mueller points out the traditional view that "[c]ourts should interpret the meaning of terms in patent claims as those terms would have been understood by a hypothetical person of ordinary skill in the art as of the effective filing date of the patent in question." Janice M. Mueller, MUELLER ON PATENT LAW, Vol. 2, § 15.04[I] (Wolters Kluwer 2016)(footnote omitted). In her footnote, the issue under the new law is stated:

"The watershed *en banc Phillips* decision *** held that the temporal perspective for assessing the words in a patent claim is their ordinary and customary meaning to a person having ordinary skill in the art in question "at the time of the invention, i.e., as of the effective filing date of the patent application." *Phillips v. AWH Corp.,* 415 F.3d 1303, 1313 (Fed. Cir. 2005) (*en banc*).

"This pre-America Invents Act of 2011 (AIA) statement apparently referred to the concept of a *prima facie* invention date based on construing the patent application's filing date as the invention's constructive reduction to practice date. [citation omitted]. The *Phillips en banc* decision did not explain the correct time frame for claim interpretation when the inventor could backdate her invention date from the filing date to her earlier conception date or actual reduction to practice date (assuming that the difference in dates would be material to the meaning of disputed claim terms).

"For post-AIA applications, the concept of "invention date" is largely irrelevant, so the application's 'effective filing date' controls."

Id. § 15.04[I] n.170.1.

§ 2[b] Global "Public Use" and "On Sale" Prior Art

An extremely important aspect of the *Leahy Smith America Invents Act* of 2011 is that an offer of sale of the invention *anywhere in the world* constitutes "prior art" against the inventor. Similarly, any "public use" anywhere in the world also creates such "prior art".

The statutory basis for this expanded prior art definition is found in 35 USC § 102(a)(1):

"A person shall be entitled to a patent unless… 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[.]" 35 USC § 102(a)(1)

. Historically, the United States had excluded from the state of the prior art any *foreign* "public use" or "on sale" activity. This exemption has shielded the Asian or European patent applicant from the patent-defeating effect of its own commercialization activities following "home country" patent priority filings and prior to the actual United States filing date.

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