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# Section 102 and Prior Art: Navigating the Expanded Scope of Prior Art and AIA Exceptions

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TUESDAY, JULY 23, 2019

1pm Eastern | 12pm Central | 11am Mountain | 10am Pacific

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Today's faculty features:

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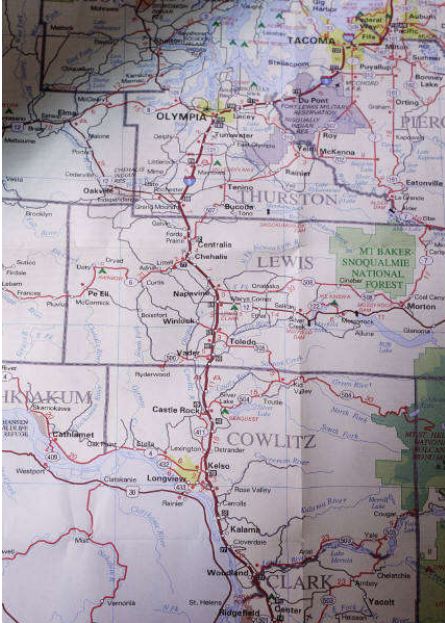
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# Outline

- I. Section 102 under the AIA
  - A. Definition of prior art
  - B. "Secret" prior art
  - C. Effectively filed requirements
  - D. Interplay with pre-AIA applications
  
- II. FITF USPTO examination guidelines
  
- III. Choice of law issues
  
- IV. Recent AIA 102 decisions
  
- V. District court and Federal Circuit AIA 102 decisions
  
- VI. Best practices for identifying and dealing with prior art



**“effective filing date”** is the key  
to navigating the roadmap of  
the AIA and the applicability of  
pre-AIA §102,  
AIA §102,  
or  
AIA §102 + pre-AIA §102(g)!

*Pre-AIA §102 and §103:*

Could apply to certain patents until at least through March 15, 2034!

*applies when all claims have EFD before 3/16/13*

## Pre-AIA §102(a)–(g)

- seven subsections
  - §102(a): known or used by others; §102 (b): statutory bar—sale, offer for sale, patented, published by anyone; §102 (c): abandoned; §102 (d): first patented elsewhere; §102(e): prior patents & published applications of others; §102(f): derivation; §102(g): first to invent;
- combination of both the “novelty” requirement and a set of “loss of right” to patent provisions; no clear delineation between the two, or so it is argued by some.

## Pre-AIA §103

- three subsections
  - (a) non-obviousness requirement from 1952 Patent Act;
  - (b) amendments in light of Biotechnology Process Patent Act of 1995; and
  - (c) provisions relating to commonly assigned patents and patents developed pursuant to Joint Research Agreements.



*ALA §102 Definition of Prior Art*

*applies when all claims have EFD after 3/15/13*



(a)(1): A public disclosure ANYWHERE in the world before the EFD of the claimed invention; OR



(a)(2): Patent filing disclosures (in the U.S. or PCT designating the U.S.) that later become public, that name another inventor, and were effectively filed before the EFD of the claimed invention.

- b) Exceptions from prior art
- c) Expands exceptions subject to CREATE Act (joint research agreements/mergers); and
- d) new definition of “effectively filed” for 102(a)(2) (sort of like old 102(e))

# *AIA §102 Prior Art*

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- ▶ No geographic and language restrictions on prior art.
- ▶ An overarching premise of “public accessibility.”
- ▶ What is prior art under the new law, **absent a *Nomiy*-type admission**, must either form
  - a § 102(a)(1) public disclosure – something made “available to the public” in the new words found in AIA §102(a)(1); or
  - an “effectively filed” AIA § 102(a)(2) patent filing disclosure. Effectively filed AIA § 102(a)(2) art requires that ultimately at least one of the following three documents publish (“special publications”):
    - a U.S. patent;
    - a U.S. patent application, or
    - a U.S.-designating PCT application.

*Note: “Office does not view the AIA as changing the status quo with respect to the use of admissions as prior art.” Examination Guidelines pp. 11064 and 11075.*

## *How Do You Know Which Applies?*

- ▶ **AIA SEC. 3(n)(1)** Except as otherwise provided in this section, the amendments made by this section shall take effect upon the expiration of the 18-month period beginning on the date of the enactment of this Act, **[March 16, 2013]** and shall **apply to any application for patent** ...that contains or contained **at any time**:
  - A. a claim to a claimed invention that has an effective filing date **as defined in section 100(i)** ..., that is **on or after the effective date** described in this paragraph **[March 16, 2013]**; or
  - B. a specific reference under §§ 120, 121, 365(c) to any patent or application that **contains or contained at any time** such claim. **[antecedent for “such claim” has to be sub.para. (A)?]**

## *How Do You Know Which Applies? (con't)*

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- ▶ SEC. 3(n)(2): The **provisions of sections 102(g), 135, and 291** of title 35, United States Code, as in effect on **[March 15, 2013]**, **shall apply to each claim** of an application for patent, and any patent issued thereon, for which the amendments made by this section also apply, if such application or patent **contains or contained at any time**—
  - (A) a claim to an invention having an EFD as defined in section 100(i) of title 35, United States Code, that occurs **before [March 16, 2013]**; or
  - (B) a specific reference under section 120, 121, or 365(c) of title 35, United States Code, to any patent or application that contains or contained at any time **such a claim**.

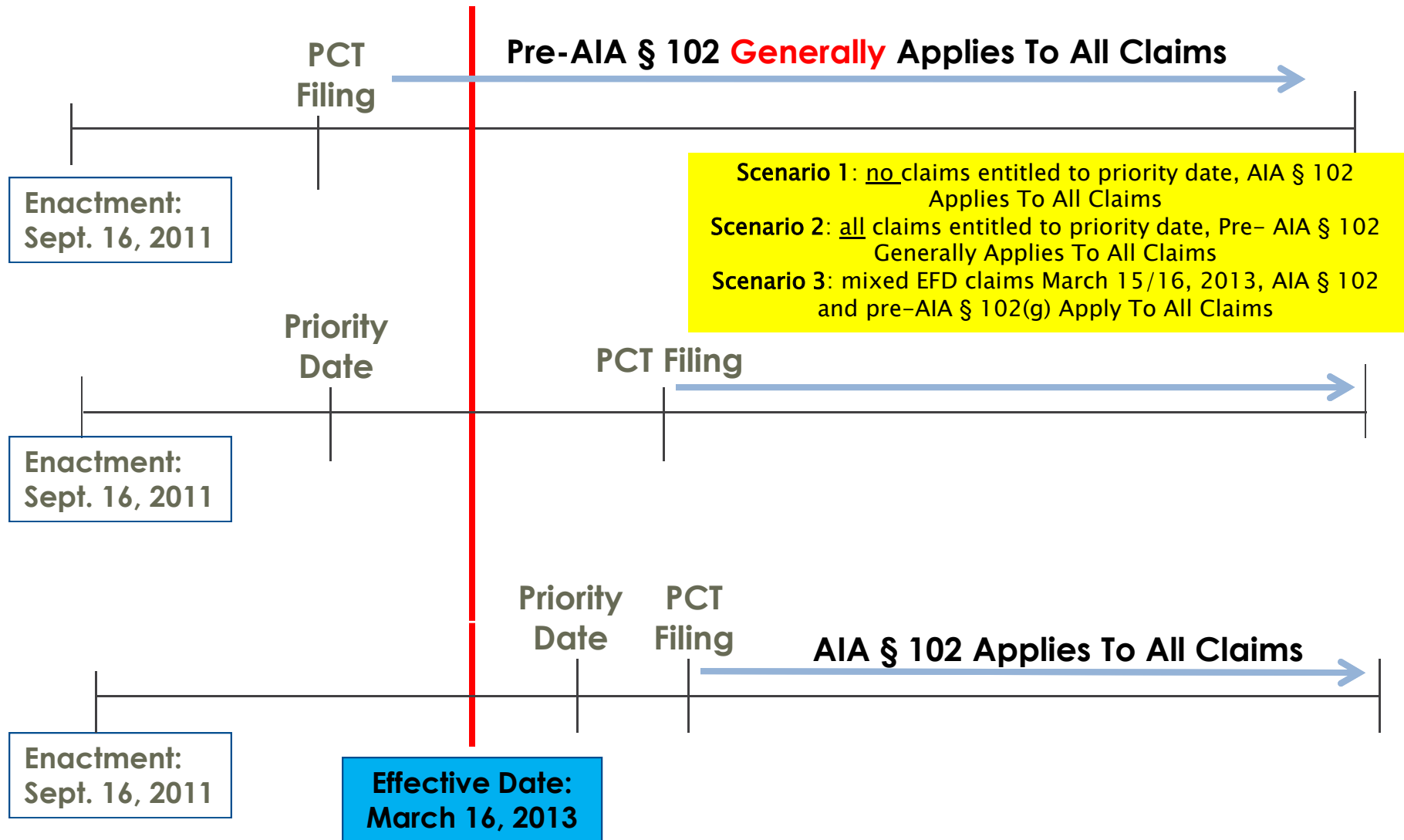
*FITF Examination Guidelines:  
SEC. 3(n)(2)*

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“section 3(n)(2) does indicate that the provisions of 35 U.S.C. 102(g), 135, and 291 as in effect on March 15, 2013, shall apply to “each claim” of an application for patent, and not simply the claim or claims having an EFD that occurs before March 16, 2013, if the condition specified in section 3(n)(2) occurs. Therefore, “each claim” of an application presenting a claim to a claimed invention that has an effective filing date before March 16, 2013, but also presenting claims to a claimed invention that has an effective filing date on or after March 16, 2013, is subject to AIA 35 U.S.C. 102 and 103 and is also subject to the provisions of 35 U.S.C. 102(g), 135, and 291 as in effect on March 15, 2013.”

*See pp. 11069, 11072 of Examination Guidelines (2/14/13)*

# Straddling March 15/16, 2013



## *SEC. 3(n)(2): the Jedi Master Mixer!*

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- ▶ Some may seek out SEC.3(n)(2), owing to advantages of AIA.
  - liberalization of the CREATE ACT and common ownership in 102(c); and
  - possible elimination of pre-AIA statutory bars that are not AIA prior art!!!
  
- ▶ Lab notebooks maybe even more important than before!

# *JMM's*

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Create JMM based on pre-AIA application by filing a CIP with at least one claim having an EFD after March 15, 2013.

- “Old” subject matter keeps its effective pre-AIA filing date but is pulled into the AIA and cannot escape § 102(g) prior art under 3(n)(2). But in assessing effect of § 102(g) art for all claims in the mixed AIA/pre AIA application, **date of invention, and thus antedating, is relevant given the language of §102(g)!**
- **And all claims in the application receive benefits of AIA, such as first-inventor-to-file, the expansive Create Act and common ownership, and fewer § 102 alphabet soup requirements.**

Remember, don't foot fault into AIA by presenting a PCT preliminary amendment in which at least one claim is not entitled to priority to the PCT.

- Might be good to enter the US national stage of PCT on day 1 and then present a preliminary amendment on day 2 and thus avoid any unwanted foot fault into AIA.



# *Footfault Into AIA §102*

- *US Endodontics, LLC v. Gold Standard Instruments, LLC*, PGR2015-00019
  - PTAB: Instituted PGR over Patent Owner’s argument that claims not eligible for PGR because of priority date benefit.
    - Accepted Petitioner’s arguments that claims not supported by priority document and therefore only entitled to actual filing date.
    - Claims eligible for PGR
      - “a patent that issues from an application filed after March 16, 2013, that claims priority to an application filed before March 16, 2013,3 is available for post-grant review ‘if the patent contains . . . at least one claim that was not disclosed in compliance with the written description and enablement requirements of § 112(a) in the earlier application for which the benefit of an earlier filing date prior to March 16, *Inguran, LLC v. Premium Genetics (UK) Ltd.*, Case PGR2015-00017, slip op. 11 (PTAB Dec. 22, 2015) (Paper 8).”
      - Initial burden on petitioner:
        - “a petitioner seeking post-grant review carries the burden to show that the patent is subject to the first-inventor-to-file provisions of the AIA and, therefore, eligible for post-grant review[.]”

*35 U.S.C. § 102(a)(1) –  
DEFINES PRIOR ART UNDER AIA*

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§ 102 Conditions for patentability (a) NOVELTY; PRIOR ART *(teaching edits added)*

A person shall be entitled to a patent **unless**—

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

## 35 U.S.C. § 102(a)(2)

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§ 102 Conditions for patentability (a) NOVELTY; PRIOR ART (with teaching edits)

A person shall be entitled to a patent **unless**— ...

(2) the **claimed invention** was described in a **[US] patent** issued under **section 151 [US patent]**, or in an **application for [US or PCT application designating the US ( § 374)] patent published or deemed published under section 122(b) [US application or PCT application designating the US]**, in which the **[US] patent or [US or PCT designating the US] application**, as the case may be, **names another inventor and was *effectively filed before the EFD of the claimed invention.***

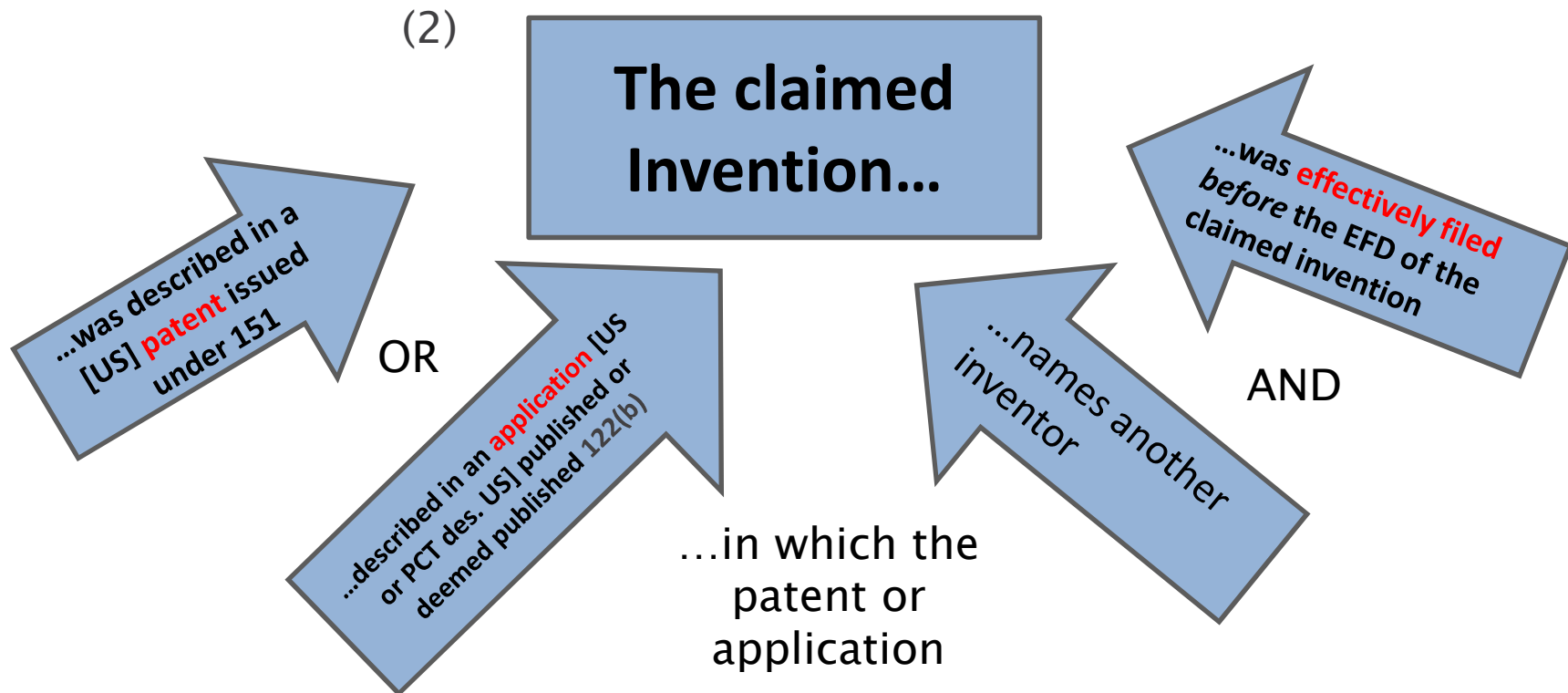
*See AIA § 102(d) : “effectively filed” can be earliest foreign priority document.*

*§ 102(a)(2) somewhat like old § 102(e); effectively filed before effective filing date but not disclosed before effective filing date, otherwise would be under § 102(a)(1).*

# 35 U.S.C. § 102(a)(2): “Effectively Filed”

§ 102 Conditions for patentability (a) NOVELTY; PRIOR ART

A person shall be entitled to a patent **unless**...



# §102(a)(2) - §122(b) - §374

## *Enablement for Effectively Filed?*

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- ▶ The published PCT designating the US is deemed published under §122(b) and hence triggers the application of §102(a)(2) as of the date the PCT was effectively filed
  - "effectively filed" is defined in §102(d)
- ▶ That date can be a foreign priority or domestic benefit date as long as the PCT is entitled to **claim the right** of priority/benefit, which some are interpreting as whether or not the PCT is **actually entitled** to benefit.
- ▶ **Enablement:** But enactors argue that there need be *no enablement as of the priority/benefit date* of the subject matter described for the date of the priority/benefit application to be the date "effectively filed."
  - **USPTO agreed.**

## *FITF Examination Guidelines: “Entitled to” and “Entitled to Claim”*

“The AIA draws a distinction between actually being **entitled to** priority to, or the benefit of, a prior-filed application in the definition of effective filing date of a claimed invention in AIA 35 U.S.C. 100(i)(1)(B), and merely being **entitled to claim priority to**, or the benefit of, a prior-filed application in the definition of effectively filed in AIA 35 U.S.C. 102(d).”

Entitled to  
priority/benefit of  
prior-filed app

Definition of effective filing date (EFD)

**V.**

Merely entitled to  
*claim*  
priority/benefit of  
prior-filed app

Definition of effectively filed

*See pp. 11078 of Examination Guidelines (2/14/13).*

*FITF Examination Guidelines:  
“Entitled to” and “Entitled to Claim”*

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“As a result of this distinction, **the question of whether a patent or published application is actually entitled to priority or benefit with respect to any of its claims is not at issue in determining the date the patent or published application was “effectively filed” for prior art purposes.** Thus, as was the case even prior to the AIA, there is no need to evaluate whether any claim of a U.S. patent, U.S. patent application publication, or WIPO published application is actually entitled to priority or benefit under 35 U.S.C. 119, 120, 121, or 365 when applying such a document as prior art.”

*See pp. 11078 of Examination Guidelines (2/14/13).*

# PTAB Agrees

- *Dr. Reddy's Labs. S.A. v. Invidior UK Ltd.*, IPR2019-00329, Paper 21 (P.T.A.B. June 3, 2019)
  - Patent Owner: U.S. 9,687,454 (“the ’454 patent”), filed on Jan. 6, 2016, claims priority to U.S. App. 12/537,571, filed on Aug. 7, 2009, and published on February 10, 2011 (“Myers”).
    - Claim recited “about 40 wt % to about 60 wt %”.
  - Petitioner: one short paragraph in the specification describing “at least 25%” and “at least 50%” was the only description of the claimed ranges.
    - The short description with open-ended ranges in the ’571 application could not provide “blaze marks” to direct a POSA to the [recited] closed ranges.
- PTAB: challenged claims were not entitled to the priority date of Myers in the priority chain due to lack of written description support, therefore Myers was anticipating prior art.
  - Myers shared an identical specification with the challenged patent.
  - Specific experimental data in Table 1 allowed POSA to back-calculate amounts of 48.2% and 56.8%, within the claimed ranges; not enough for priority but sufficient for anticipation.
  - “there [i]s a difference between compliance with the requirements of 35 U.S.C. § 112 and assessing the earliest priority date for a claim.” *SAP America, Inc. v. Pi-Net Int’l, Inc.*, No. IPR2014-00414, Paper 11, at 13 (P.T.A.B. Aug. 18, 2014).

For more discussion of this case, see Ward, et al, “Double the Trouble: Lack of Priority Opens the Door to Unpatentability in an IPR Proceeding,” (Finnegan Prosecution blog, July 11, 2019), <https://www.finnegan.com/en/insights/blogs/prosecution-first/double-the-trouble-lack-of-priority-opens-the-door-to-unpatentability-in-an-ipr-proceeding.html>



*More “Effectively Filed” for US patents and US/PCT-designating US applications (§102(a)(2)): §102(d)*

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- ▶ **§102(d) PATENTS AND PUBLISHED APPLICATIONS EFFECTIVE AS PRIOR ART.**
  - For purposes of determining **whether a patent or application for patent is prior art to a claimed invention** under subsection (a)(2), such patent or application shall be considered to have been **effectively filed**, with respect to any subject matter **described** in the **[US]** patent or **[US or PCT designating the US]** application—
    - “(2) if the patent or application for patent is **entitled** to **claim** a right of priority under section 119, 365(a), or 365(b), or **[entitled]** to **claim** the benefit of an earlier filing date under section 120, 121, or 365(c), based upon 1 or more prior filed applications for patent, as of the filing date of the earliest such application that **describes** the subject matter.” **[“entitlement” trumps “describes”– therefore enablement is required?]**
    - “(1) if paragraph (2) does not apply, as of the actual filing date of the patent or the application for patent”

*More “Effectively Filed” for US patents and US/PCT-designating US applications (§102(a)(2)): §102(d)*

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▶ **§102(d) PATENTS AND PUBLISHED APPLICATIONS EFFECTIVE AS PRIOR ART.**

- Earlier–Filed but Later–Published US patents and US/PCT–designating US applications.
- Following publication, disclosure has retroactive availability as prior art as of the date effectively filed for novelty and obviousness purposes.
- *Somewhat like old §102(e) **but cannot be antedated by earlier invention.***
- *Available as prior art for **novelty** and **obviousness** purposes.*

## *“Effectively Filed” v. EFD*

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Generally, the “EFD” is the actual patent application filing date in the case of a still-pending application, unless the claimed invention is entitled to priority/benefit of an earlier patent filing.

EFD has nothing to do with §102(a)(2) but rather with assessing the validity/patentability of a claimed invention in view of §§ 102(a)(1) and (2).

- **Effectively filed** *has everything to do with* §102(a)(2) as prior art.

## *‘Effectively Filed’ v. EFD*

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This entitlement to priority/benefit exists where

**(1) a claim for priority/benefit is made, and**

(2) the earlier patent filing contains written description and enablement support of the claimed invention, as the AIA expressly removed the requirement of disclosing the best mode in an earlier application for the purposes of showing entitlement to priority/benefit.

**Best Mode:** *Note that the best mode requirement still exists at least for all US nonprovisional patent filings because it remains in 35 U.S.C. 112(a).*

## *Hilmer Doctrine Abolished by §102(d)*

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*Hilmer* Doctrine evidenced bias of U.S. law against inventions originating outside the U.S.

- Based on two U.S. litigations (*Hilmer I* and *II*) that held that the foreign right of priority of a U.S. patent does not provide a prior art effect under § 102(e) as of that foreign priority date, nor does inventive work outside the U.S. have a prior art effect under § 102(g). Rather, one needed a U.S. filing date to have a prior art effect.

## *Hilmer Doctrine Abolished by §102(d)*

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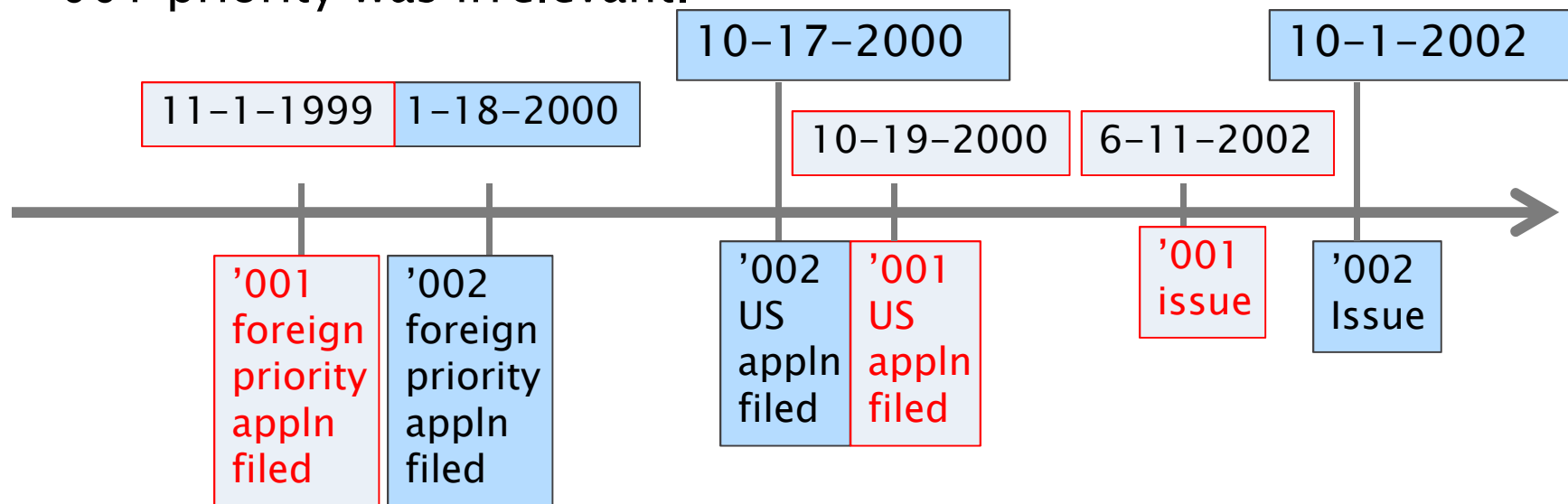
Now, under AIA, a foreign priority date can be used offensively as prior art under AIA's 35 U.S.C. §102(a)(2) against the patent claims of others, as long as the subject matter in one of the three special publications was at least described in a foreign priority document which was “effectively filed” relative to the relevant subject matter. (See 35 U.S.C. §102(a)(2) and §102(d)).

“AIA 35 U.S.C. 102(d) eliminates the Hilmer doctrine. The “Hilmer doctrine” as discussed in MPEP § 2136.03 remains applicable to pre-AIA applications because AIA 35 U.S.C. 102(d) does not apply to pre-AIA applications.”

*See pp. 11064 of Examination Guidelines (2/14/13).*

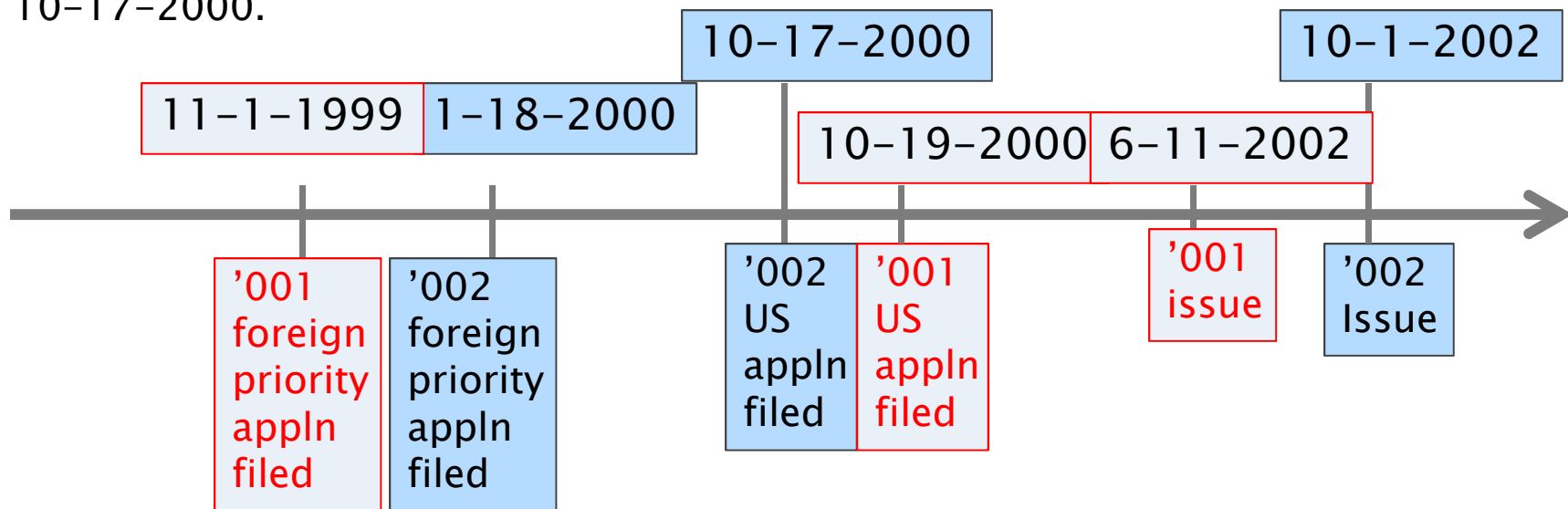
## *Hypothetical on '001 and '002 Patents: Pre-AIA*

- Pre-AIA, the '001 US application because of *Hilmer*, was not §102(e)/103 prior art against the claims of the '002 patent because '001 priority was irrelevant.



# *Hypothetical on '001 and '002 Patents: AIA - Possible Game Changer*

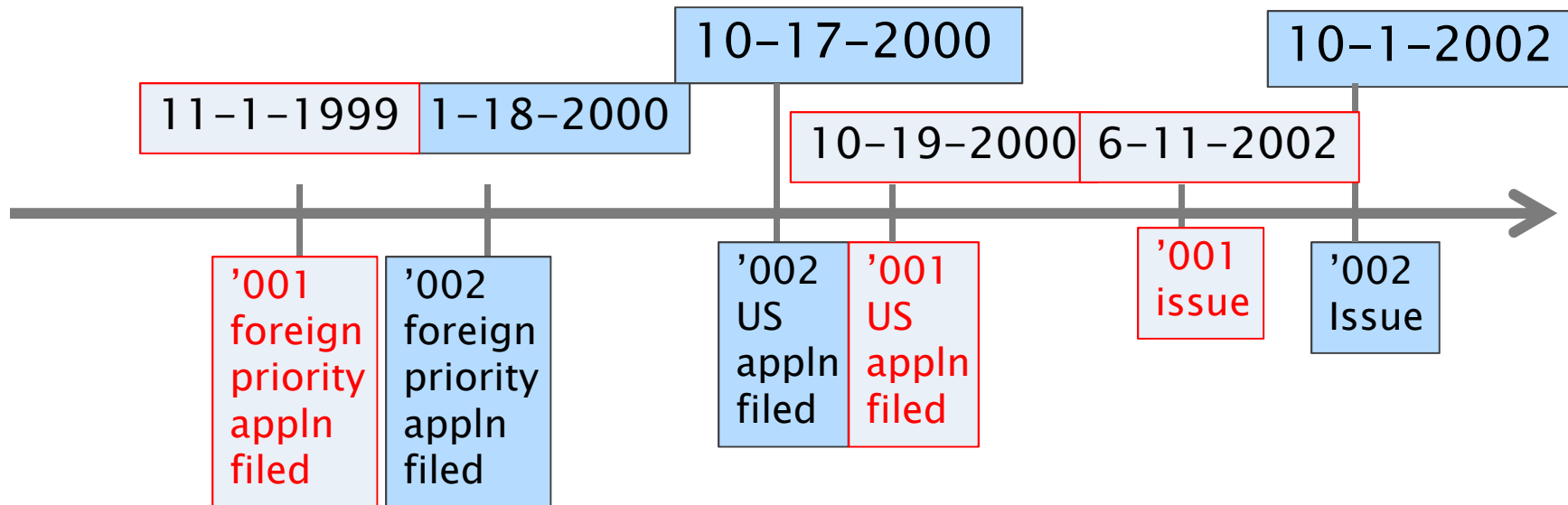
- If the '001 patent was “effectively filed” (relevant disclosure of '001 patent at least described in the '001 foreign application) on 11-1-1999, then the '001 patent is §102(a)(2) prior art as of 11-1-1999 against the claims of the '002 patent, whether the effective filing date of the relevant claims of the '002 patent is 1-18-2000 or 10-17-2000.





## *Hypothetical on '001 and '002 Patents: AIA - Is it a Game Changer?*

*Is there a §102(b)(2) exception to remove the '001 §102(a)(2) prior art against the '002 patent claims? Whatever the effective filing date of the '002 claim, §102(b)(2) could apply to remove the §102(a)(2) '001 prior art if the requirements of either §102(b)(2)(A) or §102(b)(2)(B) can be met.*



# Impact of § 102(d)(2) – Prior Art Date ★

Following publication, disclosure has retroactive availability as prior art as of the date effectively filed for novelty and obviousness purposes.

Prior art date



U.S. Prov.  
Appl.

U.S. Appl.  
Non-Prov.

Pub.  
Appl.

English

USPAT

Prior art date



CN

PCT  
(des.  
U.S.)

Pub.  
PCT  
Appl.

Chinese

USPAT

Prior art date



FR

PCT  
(des. U.S.)

Pub.  
PCT  
Appl.

French

USPAT

- NO geographical or language distinction
- Entitlement to claim priority/benefit of US Prov App., CN app., and FR app.
- Important date is when “effectively filed” not when published.
- Hilmer doctrine abolished.

*Are There AIA Exceptions to  
What Is Considered Prior Art? YES*

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- ▶ Prior art disclosures are removed from consideration IF the exception applies.
- ▶ 2 exceptions apply to §102(a)(1) global prior public disclosures (§102(b)(1)(A) and (B))
- ▶ 3 exceptions apply to §102(a)(2) patent-filing disclosures (§102(b)(2)(A) to (C))

*ALA 35 U.S.C. § 102(b) – Defines Exceptions to Prior Art And Those Exceptions Curtail § 103 Art*

“grace period”

§102 (b)(1) 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—

ANY-  
WHERE  
IN THE  
WORLD



(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 [**independently?**] **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.

*FITF Examination Guidelines:  
Grace Period Disclosure*

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“When the Office can readily ascertain by examination of inventorship and authorship that a certain disclosure falls under AIA 35 U.S.C. 102(b)(1)(A), the Office will not apply such a document in a prior art rejection.”

*See pp. 11064 of Examination Guidelines (2/14/13).  
See slides on Rule 130 declarations, infra.*

# *FITF Examination Guidelines: Grace Period Disclosure*

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“Alternatively, when there are additional named individuals on a prior art publication as compared to the inventors named on a patent application, it is incumbent upon the applicant to provide a satisfactory showing that the additional named authors did not contribute to the claimed subject matter.”

*See pp. 11064 of Examination Guidelines (2/14/13).  
See slides on Rule 130 declarations, infra.*

# *ALA §102(b)(1)(A)*

12 Months

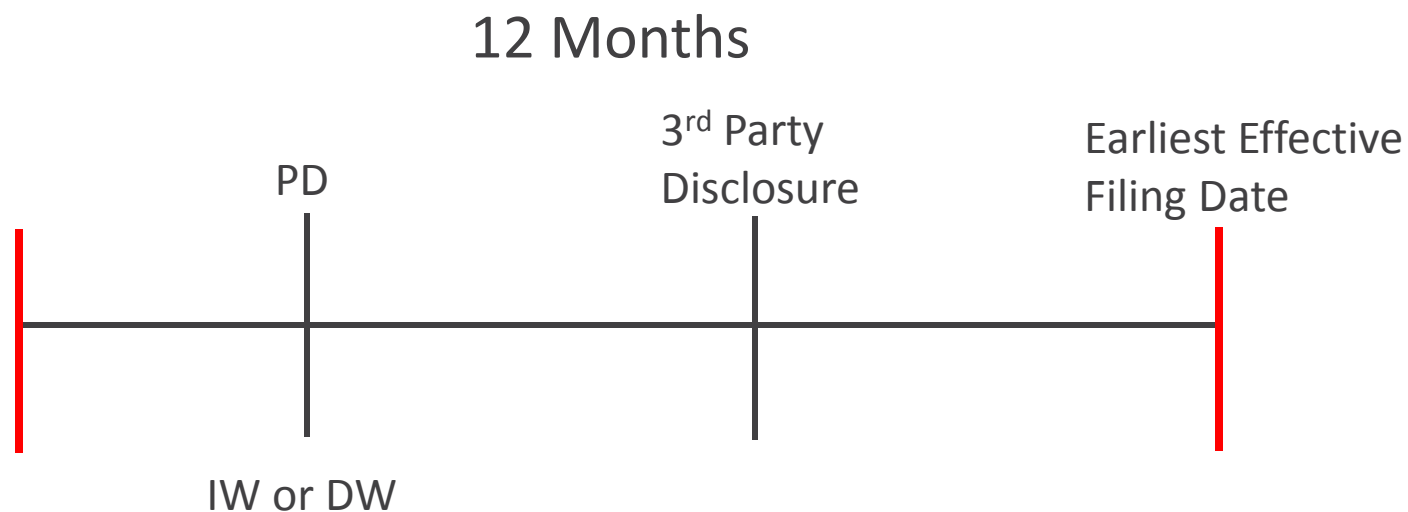


PD = public disclosure

IW = inventor's own work

DW = work derived from inventor(s)

# *ALA §102(b)(1)(B)*



PD = public disclosure

IW = inventor's own work

DW = work derived from inventor(s)



# ALA §102(b) (con't)

**No “grace period”**

## §102 (b)(2) EXCEPTIONS – ...



(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.

## *FITF Examination Guidelines §102(b)(2) Example*

- ▶ “if the inventor or a joint inventor had publicly disclosed elements A, B, and C, and a subsequent intervening U.S. patent, U.S. patent application publication, or WIPO published application discloses elements A, B, C, and D, then only element D of the intervening U.S. patent, U.S. patent application publication, or WIPO published application is available as prior art under AIA 35 U.S.C. 102(a)(2).”
- ▶ Must mean all requirements met for a § 102(b)(2) exception.

*See pp. 11077 of Examination Guidelines (2/14/13).*

# *ALA §102(b)(2)(A)*

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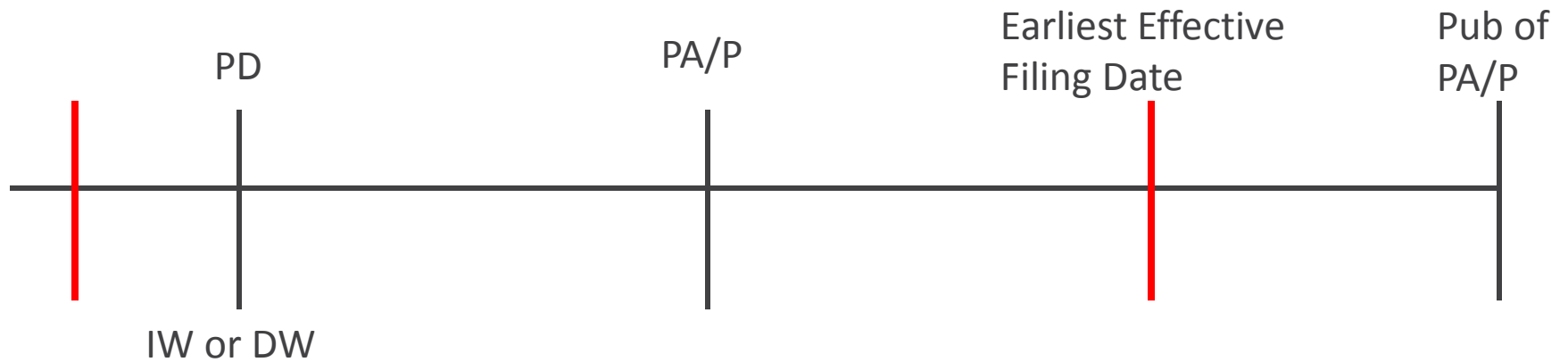
PA/P = filing of published application or patent

Pub of PA/P = publishing of patent or earlier filed application

IW = inventor's own work

DW = work derived from inventor(s)

# *ALA §102(b)(2)(B)*



PD = public disclosure

PA/P = filing of published application or patent

Pub of PA/P = publishing of patent or earlier filed application

IW = inventor's own work

DW = work derived from inventor(s)

*Exception ONLY Good For  
Exact Subject Matter Described*

§102(b)(1) Exception ONLY for the same subject matter earlier disclosed; “related” subject matter could still be used against the patentee under AIA §103 and MIGHT even preclude the claimed invention from being patentable at all because of §103 !!! What if inventor discloses X and the disclosee discloses X and Y?

*See USPTO Examination Guidelines 78 Fed.Reg. 11,061 (Feb. 14, 2013)*

The same argument regarding disclosed vs. related subject matter is also made regarding §102(b)(2), which is the exception to §102(a)(2).

*FITF USPTO Examiner Guidelines:  
“Same” Required for §102(b)(1)(B) and §102(b)(2)(B)*

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“The Office also indicated in the proposed examination guidelines that the subject matter in the prior disclosure being relied upon under AIA 35 U.S.C. 102(a) must be the same ‘subject matter’ as the subject matter previously publicly disclosed by the inventor for the exceptions in AIA 35 U.S.C. 102(b)(1)(B) and 102(b)(2)(B) to apply... . **These examination guidelines maintain the identical subject matter interpretation of AIA 35 U.S.C. 102(b)(1)(B) and 102(b)(2)(B).**”

*See pp. 11061 of Examination Guidelines (2/14/13).*

*FITF USPTO Examiner Guidelines:  
“Same” Required for §102(b)(1)(B) and §102(b)(2)(B)*

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- No requirement that the mode of disclosure be the same;
- No requirement that the disclosure be a verbatim or *ipsissimis verbis* disclosure of the intervening disclosure.
- “[I]f subject matter of the intervening disclosure is simply a more general description of the subject matter previously publicly disclosed by the inventor or a joint inventor, the exception in AIA 35 U.S.C. 102(b)(1)(B) applies to such subject matter of the intervening disclosure.”

*See pp. 11061 of Examination Guidelines (2/14/13).*

## *FITF Examination Guidelines: “Same”*

- ▶ “Therefore, the single instance of the phrase “the subject matter” in subparagraph (B) of each of AIA 35 U.S.C. 102(b)(1) and 102(b)(2) cannot reasonably be interpreted as including variations within its ambit.”
- ▶ “The absence of the “substantially” modifier or similar terminology in subparagraph (B) of each of AIA 35 U.S.C. 102(b)(1) and 102(b)(2) further supports the conclusion that this provision does not contemplate variation in subject matter.”
- ▶ “The more expansive alternative interpretations of the subparagraph (B) provision, however, are not supported by the language of the subparagraph (B) provision.”

*See pp. 11066 of Examination Guidelines (2/14/13).*



# *AIA §102(b)(2)(C)*

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## §102 (b)(2) EXCEPTIONS - ...

Common ownership under 102(b)(2)(C) applies only as an exception to 102(a)(2).

For policy reasons, it is not an exception to 102(a)(1)!!!!!!

Can't remove from the public by common ownership what is already in the public domain.

PTO agrees.

***No "grace period"***

*Note: §102(f)/103?*

*FITF Examination Guidelines:*

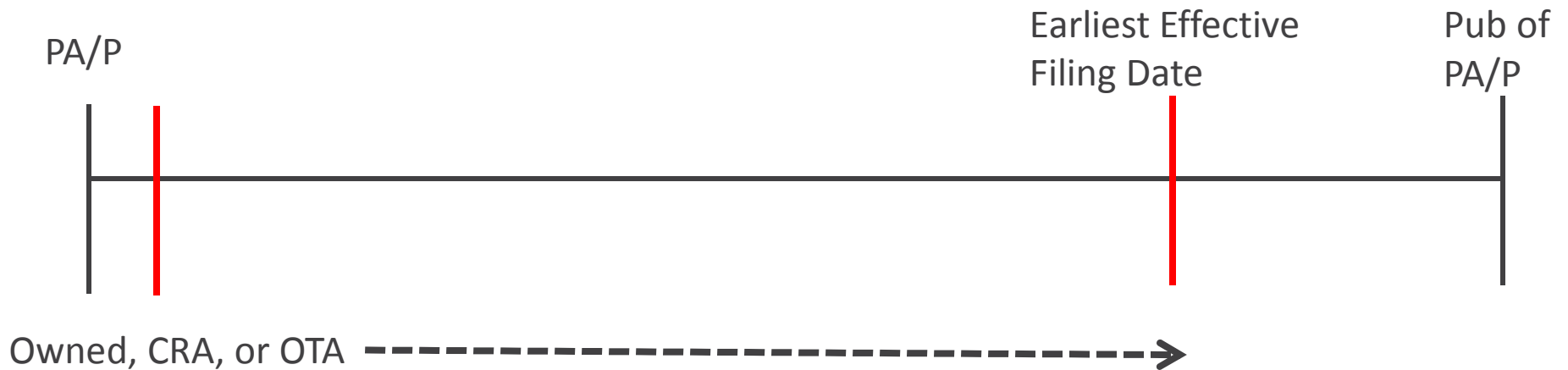
*§102(b)(2)(C) is Exception to § 102(a)(2) Only and Applies to Novelty and Nonobviousness*

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“AIA 35 U.S.C. 102(b)(2)(C) provides that certain prior patents and published patent applications of co-workers and collaborators are not prior art either for purposes of determining novelty (35 U.S.C. 102) or nonobviousness (35 U.S.C. 103). **This exception, however, applies only to prior art under AIA 35 U.S.C. 102(a)(2)**, namely, U.S. patents, U.S. patent application publications, or WIPO published applications effectively filed, but not published, before the effective filing date of the claimed invention. **This exception does not apply to prior art that is available under 35 U.S.C. 102(a)(1)....** A prior disclosure, as defined in AIA 35 U.S.C. 102(a)(1), by a co-worker or collaborator is prior art under AIA 35 U.S.C. 102(a)(1) **unless it falls within an exception under AIA 35 U.S.C. 102(b)(1)**, regardless of whether the subject matter of the prior disclosure and the claimed invention was commonly owned not later than the effective filing date of the claimed invention.”

*See pp. 11072 of Examination Guidelines (2/14/13).*

# AIA §102(b)(2)(C)



PA/P = filing of published application or patent

Pub of PA/P = publishing of patent or earlier filed application

OTA = obligation to assign to same entity

CRA = common research agreement

*FITF Final Rules*  
*How Do You Show “Commonly Owned” Or*  
*JRA Under §102(b)(2)(C) ?*

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To show common ownership or JRA to come under the §102(b)(2)(C) exception to §102(a)(2) prior art, the **patent owner/applicant files a statement to that effect.**

- 37 C.F.R. § 1.104 and Examination Guidelines pp. 11080

Duty of disclosure and use of Rule 105 by the USPTO to obtain more information if necessary may provide sufficient safeguards.

Take care regarding factual representations.

*FITF Examination Guidelines:  
Don't Remove ODP or Non-enablement With  
§102(b)(2)(C)*

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§102(b)(2)(C) exception does not remove a §102(a)(1) prior art, OR a double-patenting rejection, or a lack of enablement rejection – a “document need not qualify as prior art to be applied in the context of double patenting or enablement.”

*See pp. 11080 of Examination Guidelines (2/14/13).*

## *Note Re Inherency*

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AIA provides only two kinds of prior art, §102(a)(1) and (2), which relate to public accessibility and patent filings.

That which is inherent is not publicly accessible.

No inherent anticipation under AIA?

- At least based on §102(a)(1).
- Maybe some inherency could exist in a patent filing under §102(a)(2)?

# *FITF Final Rules*

## *Offer to License*

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“Offer to license” under pre-AIA 35 U.S.C. §102(b) applicable under AIA 35 U.S.C. § 102(a)(1); “AIA did not amend 35 U.S.C. 102 to change the treatment of the prior art effect of an offer for license.”

Under AIA §102(a)(1)?

- USPTO position that may be prior art if offer to license made invention available to the public, BUT Supreme Court’s decision in *Helsinn* indicates offer to license may be prior art if makes existence of offer available to the public.

*Disclosure Sounds Important – Maybe I Should Just Do That and Forget About Filing Patent Applications? FORGET THAT IDEA; File before or after but file!*



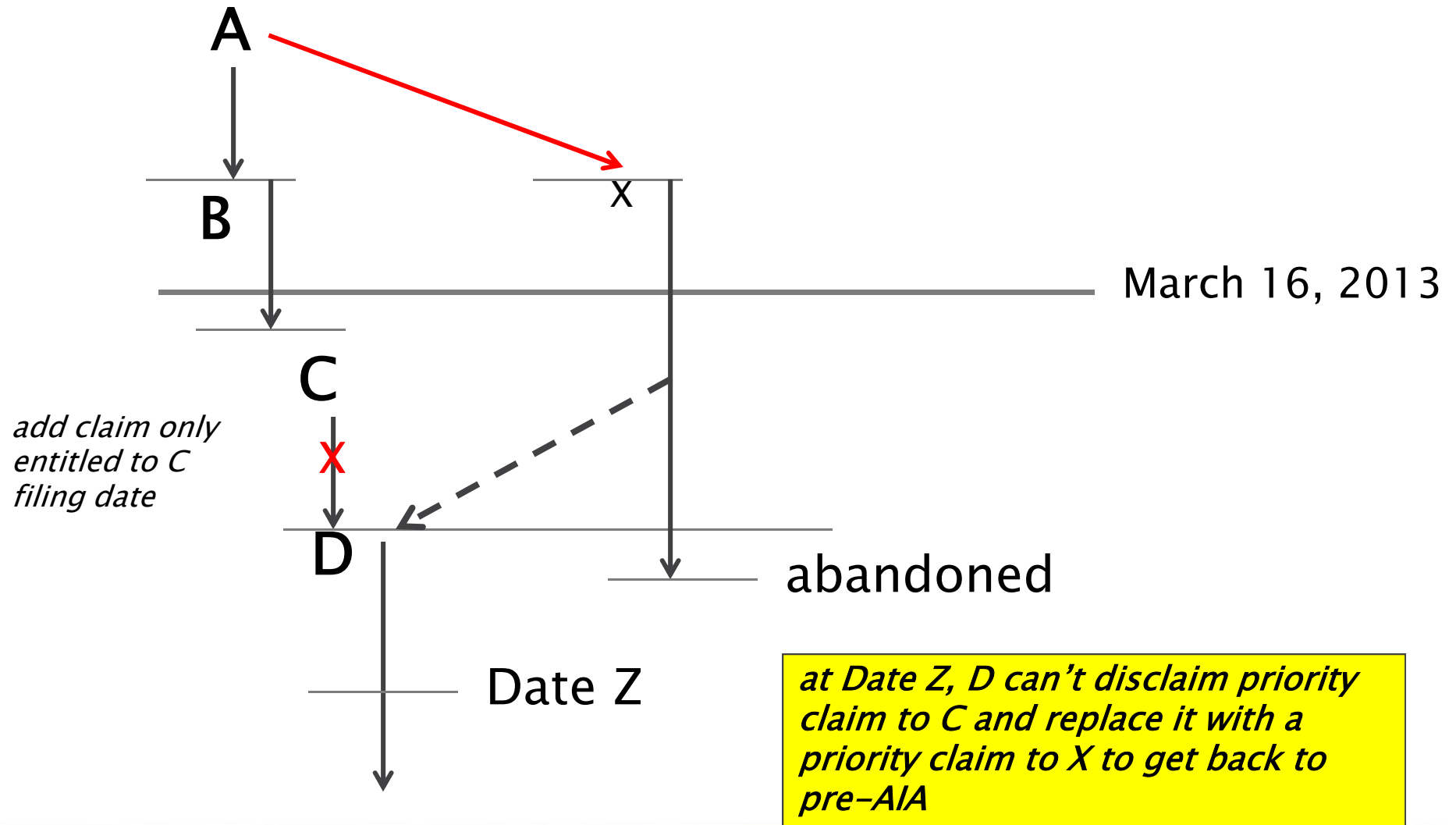
AIA: Publishing is not a substitute for filing to obtain strong patent position on the invention. An inventor who has publicly disclosed should file a patent application promptly or better yet, before disclosure.

AIA: “Subject matter disclosed” only covers anticipatory subject matter (Same), not obvious variants.

***Substituting a patent filing with an effective filing date with a public disclosure cannot produce a better outcome pre-AIA or AIA and in certain situations will produce a worse outcome.***



# Can You Change or Correct Claim to Priority?



## *CREATE Act Now In* §102(c)

### • § 102(c) COMMON OWNERSHIP UNDER JOINT RESEARCH AGREEMENTS.—

• **Subject matter disclosed and a claimed invention** shall be deemed to have been owned by the same person or subject to an obligation of assignment to the same person in applying the provisions of subsection (b)(2)(C) if—

- 1) the subject matter disclosed **was developed** and the **claimed invention was made by, or on behalf of, 1 or more parties** to a joint research agreement that was in effect on or before the effective filing date of the claimed invention;
- 2) the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement; and
- 3) the application for patent for the claimed invention discloses or is amended to disclose the names of the parties to the joint research agreement.

## *CREATE Act Now In §102(c)*

- §102(c) COMMON OWNERSHIP UNDER JOINT RESEARCH AGREEMENTS.
- May allow inventor to proactively take care of potential §102(a)(2) or §§ 102(a)(2) /103 problem with JRA.
- Does not allow use of JRA to overcome §§102(a)(1)/103 problem.

## *Example: Game Changer*

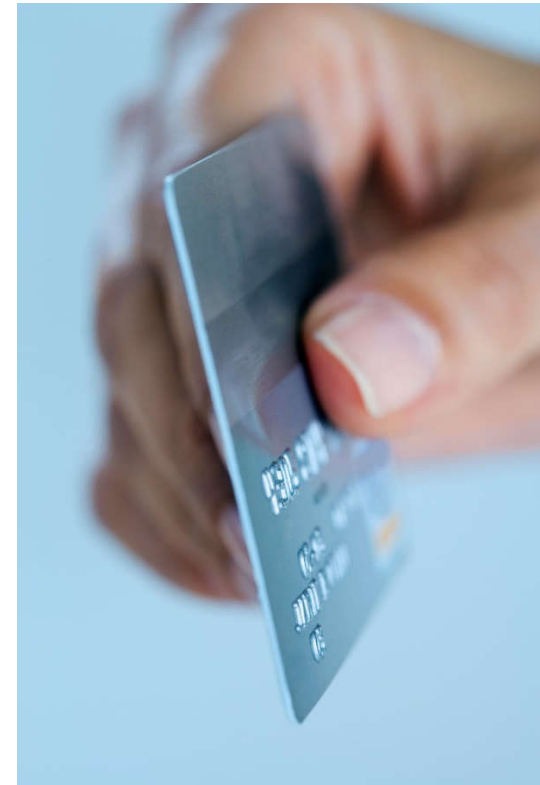
- University X has sought a narrow patent filing on new compounds A and B.
- Company Y is about to file a broad patent on a genus of compounds on which it has been working for which compounds A and B fall within the genus.
- If, before Company Y files for a patent it concludes a JRA that has within its scope the discovery, synthesis, and testing of compounds within the broad genus, then the JRA applies to Company Y's subsequent patent filing and the anticipatory patent filing of University X is removed as prior art.

## *Example: Game Changer*

- Under the pre-AIA CREATE Act, this type of protection for University X and Company Y would have been unavailable because **the pre-AIA version did not protect against the loss of novelty, only obviousness, and would not have applied since the generic invention had already been made as of the date of the JRA.**

# *Can You Eliminate Prior Art Under The New Statute By Buying It?*

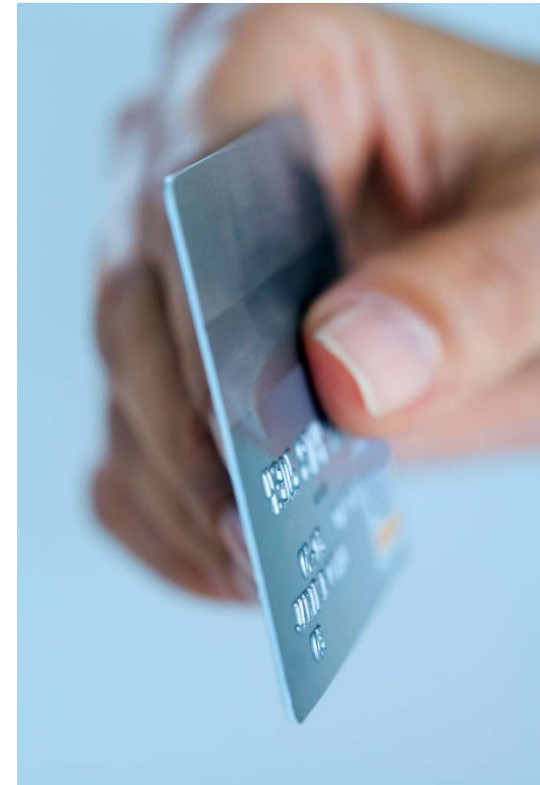
- ▶ § 102(c) says it shall be deemed to be owned by the same person or subject to an obligation of assignment if the subject matter claimed was developed under a JRA **before the effective filing date of the claimed invention**. *See also* §102(b)(2)(c) (common ownership exception to §102(a)(2)) and § 102(c) allows folding JRA into §102(b)(2)(C)



# *Can You Eliminate Prior Art Under The New Statute By Buying It?*

*Big change!! Old law was “at the time the invention was made”*

Buying prior art works only as exception to §102(a)(2) not as any exception to §102(a)(1). See §102(b)(2)(C).



*Under AIA, May End Up That Inventor Does Not Get Patent Even If First To File*

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New “35 U.S.C. 102 and 103, which do not always result in the first inventor to file an application being entitled to a patent (e.g., AIA 35 U.S.C. 102(a)(1) precludes an inventor who is the first person to file an application for patent, but who published an article describing the claimed invention more than one year before the application was filed, from being entitled to a patent).”

*See pp. 11070 of Examination Guidelines (2/14/13).*



## *Choice of Law Applies on Application-by-Application Basis*

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### Pre-AIA law:

- EFD of a claimed invention is determined on a claim-by-claim basis, not application-by-application.

### AIA law:

- Retains the principle that different claims in the same application may be entitled to different EFDs.

*See Examination Guidelines, 78 Fed.Reg. 11,073 (Feb. 14, 2013)*

*Choice of Law Applies on  
Application-by-Application Basis*

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- ▶ Prior art is applied on a claim-by-claim basis.
- ▶ BUT whether pre-AIA §102 or AIA §102 apply is on an application-by-application basis.

*See Examination Guidelines, 78 Fed.Reg. 11,073 (Feb. 14, 2013)*

*Choice of Law Is Critical To Determine if  
pre-AIA or AIA § 102 Applies*

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“Because the changes to 35 U.S.C. 102 and 103 in the AIA apply only to specific applications filed on or after March 16, 2013, determining the effective filing date of a claimed invention for purposes of applying AIA 35 U.S.C. 102 and 103 provisions or pre-AIA 35 U.S.C. 102 and 103 provisions is **critical**.”

*See pp. 11083 of Examination Guidelines (2/14/13)*

# Interview Getting EFD's Corrected

Date of Interview: 11 July 2013.

Type:  Telephonic  Video Conference  
 Personal [copy given to:  applicant  applicant's representative]

Exhibit shown or demonstration conducted:  Yes  No.  
If Yes, brief description: \_\_\_\_\_.

Issues Discussed  101  112  102  103  Others  
(For each of the checked box(es) above, please describe below the issue and detailed description of the discussion)

Claim(s) discussed: n/a.

Identification of prior art discussed: n/a.

## Substance of Interview

(For each issue discussed, provide a detailed description and indicate if agreement was reached. Some topics may include: identification or clarification of a reference or a portion thereof, claim interpretation, proposed amendments, arguments of any applied references etc...)

Applicant called the undersigned to inquire about the notice received, mailed on 7/12/2013, in which the Office stated that the AIA status of the instant application was being changed to "No".

Applicant explained that this assessment was incorrect because the instant application was filed as a CIP on 5/23/2013, designated as a CIP in the ADS and designated as an AIA application in the ADS.

The undersigned agreed with Applicant's assessment and has reset the AIA status to being AIA "Yes". The instant application will be examined as an AIA application.

No further action is required by Applicant.

## *‘Printed Publication’*

- A.R.M., Inc. v. Cottingham Agencies Ltd, IPR2014-00671, Paper 10 (P.T.A.B. Oct. 3, 2014)
  - Petition denied because no proof carnival ride was a "printed publication" and no proof of date.
- Actavis, Inc. v. Research Corporation Technologies, Inc., IPR2014-01126
  - Asserted reference was a university thesis.
  - PTAB: Denied ground based on asserted reference.
    - Insufficient evidence that the thesis was a “printed publication” under § 102(b).
- Oxford Nanopore Tech. Ltd. v. Univ. of Washington, IPR2014-00512, Paper 12 (P.T.A.B. Sept. 15, 2014)
  - Asserted references were grant applications, which became public through Freedom of Information Act (FOIA) requests.
  - PTAB: Petition denied because Petitioner did not establish public availability prior to FOIA request.

# *‘Printed Publication’*

- IBG LLC v. Trading Tech. Int’l, Inc., CBM2015-00181, Paper 138 (P.T.A.B. March 3, 2017)
  - Asserted reference was Tokyo Stock Exchange manual.
  - PTAB: Manual qualified as prior art.
    - Distributed to participants in the Tokyo Stock Exchange and was “more than a user manual for how to trade on the Tokyo Stock Exchange, but also includes how to electronically connect to the Tokyo Stock Exchange.”
    - Made accessible to “interested members of the relevant public.”
    - “Patent Owner’s argument that there is no evidence that anyone actually received a copy of TSE is misplaced. The proponent of a document need not show that particular members of the interested public actually received the information.... Rather, **accessibility goes to the issue of whether persons interested and ordinarily skilled in the subject matter could obtain the information if they wanted to.**”

*Failure To Show Reference Was  
“Printed Publication” Basis For IPR Petition Denial*

- Coalition For Affordable Drugs (ADROCA) LLC v. Acorda Therapeutics, Inc., IPR2015-00720, Paper 15 (P.T.A.B. Aug. 24, 2015)
  - Reference at issue: posters
  - PTAB: Petition denied.
    - “submission of an IDS does not constitute an admission that a cited reference is material prior art”
    - “We are not persuaded that Petitioner has made a threshold showing that the posters were sufficiently publicly accessible to qualify as a “printed publication” under §102(b).”

# *PTAB Overturned by CAFC*

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- GoPro, Inc. v. Contour IP Holding, LLC, IPR2015-01078, IPR2015-01080
  - Patents claims POV video camera wirelessly connected to remote control viewfinder.
    - Sept. 13, 2010 is earliest claimed priority date.
  - GoPro Catalog disclosed POV video camera wirelessly connected to remote control viewfinder.
    - July 23–27, 2009 Tucker Rocky Dealer Show with 150 vendors, 1,000 attendees, “hundreds” of GoPro Catalog copies distributed, but not open to general public and no evidence that a POSITA in POV cameras actually received the GoPro Catalog.
  - PTAB: not a printed publication.
  - On appeal, CAFC: is a printed publication.
    - Broader interpretation of “publicly accessible”; “*relevant public*,” not “general public” and no requirement that anyone actually received the reference.
    - A POSITA exercising *reasonable diligence* would have been able to seek out the GoPro Catalog.
    - Several public accessibility factors (no single one is dispositive):
      - target audience expertise
      - nature of conference
      - restrictions on public disclosure
      - expectations of confidentiality
      - expectations of sharing information



# *Precedential Opinion Panel May Help Clarify*

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- *Hulu, LLC v. Sound View Innovation, LLC*, IPR2018-01039
  - Challenged claims have filing date of Oct. 17, 1995.
  - Asserted reference is textbook with a copyright date of 1990.
    - Another version of the textbook has a copyright date of 1991 as shown by a date stamp.
    - Library declaration to support “public availability” of 1991 version.
  - PTAB: Petitioner has not shown reference publicly available as a printed publication prior to Oct. 17, 1995.
    - No evidence that the 1991 version is same as the asserted reference (the 1990 version);
    - Unclear which was printed later;
    - Declaration does not address actual reference relied upon.
  - Request for Precedential Review Panel granted.
    - “What is required for a petitioner to establish that an asserted reference qualifies as “printed publication” at the institution stage?”
    - Oral hearing was June 18, 2019.

# *Provisional Cannot Be §102(e) Knock Out Reference*

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## Sequenom, Inc. v. The Board Of Trustees Of The Leland Stanford Junior University, IPR2014-00337, Paper 11 (P.T.A.B. July 6, 2014)

- Every asserted ground of unpatentability in the Petition relied on Lo I.
  - Petitioner: Lo I “is a provisional U.S. patent application that is prior art to the ’415 patent under §§ 102(e)/103(a) as of its filing date for all it discloses.”
- PTAB: Petition denied.
  - **Lo I does not qualify as prior art under §102(e).**
  - Two types of documents may be relied upon under §102(e) to show that claims are unpatentable, “(1) an application for patent, published under section 122(b), . . . or (2) a patent granted on an application for patent.”
- As a provisional application filed under §111(b), Lo I is not a patent nor an application for patent published under section 122(b).
  - §122(b) states expressly that “[a]n application shall not be published if that application is . . . (iii) a provisional application filed under section 111(b) of this title.”

# *Attack Priority Claim*

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If Petitioner, attack priority claim of challenged claims to broaden scope of available prior art.

- Butamax™ Advanced Biofuels LLC v. Gevo, Inc., IPR2013-00539, Paper 33 (PTAB March 3, 2015)

If Patent Owner, attack priority claim of reference to remove as prior art reference.

- Globus Medical, Inc. v. Depuy Synthes Products, LLC, IPR2015-00099, Paper 15 (PTAB May 1, 2015)

## *Federal Circuit Agrees Burden On Petitioner To Show Prior Art Entitled To Date Asserted*

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Dynamic Drinkware, LLC v. National Graphics, Inc., 2015 WL 5166366 (Fed. Cir. Sept. 4, 2015)

- Claims survived IPR.
- Petitioner appealed.
- FC: Affirmed PTAB.
  - Petitioner had burden to prove that prior art patent was entitled to filing date of its provisional application;
  - Substantial evidence supported PTAB's determination that prior art patent did not relate back to its provisional application.
    - “A provisional application's effectiveness as prior art depends on its written description support for the claims of the issued patent of which it was a provisional. Dynamic did not make that showing.”

*Another Way to Attack Asserted Prior Art Reference: Show Claim Limitation As Construed Not Present In Reference*

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Lupin Ltd. v. Janssen Sciences Ireland UC, IPR2015-01030, Paper 17 (P.T.A.B. Oct. 16, 2015)

- Petitioner argued for a claim construction of a limitation broader than plain and ordinary meaning.
- Patent Owner argued for narrower construction based on the title, abstract, summary of the invention and elsewhere in the specification.
- PTAB: Adopted Patent Owner’s proposed construction as the BRI, resulting in removal of reference.
  - Reference did not disclose claim limitation as construed.
    - Not persuaded “that [a POSITA[ noting the darunavir structure disclosed in Table 1 of Ghosh 1998” would have ‘envisage[d] only a limited number of fixed integer hydrates,’ as Petitioner contends, especially when Ghosh 1998 does not mention hydrates.”

# *Claim Limitation Not Present In Asserted Reference*

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Torrent Pharms. Ltd. v. Merck Frosst Canada & Co., IPR2014–00559, Paper 8 (P.T.A.B. Oct. 1, 2014).

- Challenged compound claim.
- Petitioner argued that the prior art disclosed each and every limitation of the challenged claims.
- PTAB: Petition denied.
  - “Petitioner’s argument runs afoul of well-settled law on anticipation. ...Fenton...does not show the specific combination as illustrated in the challenged claim 1, but only demonstrates classes of possible substituents at various positions. ...Fenton does teach certain subclasses of substituents as preferred; but the scope and content of these subclasses are not so specific as to be deemed a disclosure of the claimed combination. In particular, Fenton does not present so short and selective a list of these subclasses that a person of ordinary skill would, as Petitioner asserts, “at once envisage” the claimed compound. ...In sum, Petitioner has not shown Fenton discloses all of the limitations of claim 1 ‘arranged or combined in the same way as in the claim.’”

# *Missing Limitation Means No Anticipation*

Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co. Ltd., 851 F.3d 1270 (Fed. Cir. 2017)

- Challenged claims required a “scaled torque demand” to be able to calculate an ‘IQr demand’.” The “IQr demand” was not defined expressly in the specification.
- PTAB: Claims unpatentable as anticipated.
  - Reference’s disclosure of “the set of  $lu^*$ ,  $lv^*$ , and  $lw^*$  is an IQdr demand[.]”
  - “a reference can anticipate a claim even if it ‘d[oes] not expressly spell out’ all the limitations arranged or combined as in the claim, if a person of skill in the art, reading the reference, would ‘at once envisage’ the claimed arrangement or combination.”
- FC: Reversed.
  - The reference disclosed “three separate phase currents in the stationary frame of reference, rather than an IQdr demand[.]”
  - “*Kennametal* does not permit the Board to fill in missing limitations simply because a skilled artisan would immediately envision them.”

## *“Sufficient Precision And Detail”*

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### Wasica Finance GmbH v. Continental Automotive Systems, Inc., 853 F.3d 1272 (Fed. Cir. 2017)

- Claim limitation: “constant frequency”
- Reference disclosed a “common” working frequency.
- PTAB: Instituted claim not unpatentable for anticipation.
  - Because the reference could use constant or nonconstant frequencies, it was “ambiguous as to whether it disclose[d]” the recited limitation.
  - Reference’s disclosure of a genus (“any modulation scheme”), “did not disclose with sufficient particularity” the species recited in the instituted claim (“constant-frequency modulation scheme”).
  - “no evidence supporting the legal theory that a POSITA would “at once envisage” the claimed species from the ambiguous disclosure.
- FC: Affirmed.
  - “a single reference” must “describe the claimed invention *with sufficient precision and detail* to establish that the subject matter existed in the prior art.”



## *“At Once Envisage”*

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Blue Calypso, LLC v. Groupon, Inc., 815 F.3d 1331 (Fed. Cir. 2016)

- PTAB: all instituted claims unpatentable, many for anticipation.
- FC:
  - PTAB understood the reference to “explicitly contemplate[] the combination of the disclosed functionalities.” This understanding was supported by expert testimony.
  - Agreed with the PTAB that, “given Paul’s discussion of combining features disclosed therein, a skilled artisan would ‘at once envisage’ the combination of two of the disclosed tools...to arrive at the system claimed in the Blue Calypso Patents.”

## *Theories of Anticipation: Inherency, “At Once Envisage”*

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- Inherency
- ‘the issue of anticipation turns on whether [a disclosed] genus was of such a defined and limited class that one of ordinary skill in the art could ‘at once envisage’ each member of the genus.’ *Wm. Wrigley Jr. Co. v. Cadbury Adams USA LLC*, 683 F.3d 1356, 1361 (Fed.Cir.2012).”
- But remember, “picking and choosing” is not appropriate because the standard for anticipation is supposed to be “as arranged in the claim.”
  - See *Impax Laboratories, Inc. v. Aventis Pharmaceuticals Inc.*, 545 F.3d 1312 (Fed. Cir. 2008) and *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359 (Fed. Cir. 2008).

## *On-sale Bar of Pre-ALA 35 U.S.C. §102(b)*

- Medicines Co. v. Hospira Inc., (Medicines I), 827 F.3d 1363 (Fed. Cir. 2016) (en banc) and (Medicines II), 881 F.3d 1347 (Fed. Cir. 2018)
  - Opinion of July 2, 2015: claims invalid because on-sale bar triggered when TMC hired supplier to prepare three batches of bivalirudin using the eventually patented method more than a year before filing patent applications.
  - Vacated, appeal reinstated.
    - (a) Do the circumstances presented here constitute a commercial sale under the on-sale bar of 35 U.S.C. §102(b)?
      - (i) Was there a sale for the purposes of §102(b) despite the absence of a transfer of title?
      - (ii) Was the sale commercial in nature for the purposes of §102(b) or an experimental use?
    - (b) Should this court overrule or revise the principle in Special Devices, Inc. v. OEA, Inc., 270 F.3d 1353 (Fed.Cir.2001), that there is no “supplier exception” to the on-sale bar of 35 U.S.C. § 102(b)?

## *On-sale Bar of Pre-ALA 35 U.S.C. §102(b)*

- *On rehearing, en banc*
  - FC: Unanimously overturned earlier panel decision finding an on-sale bar.
    - “We conclude that, to be ‘on sale’ under § 102(b), a product must be the subject of a commercial sale or offer for sale, and that a commercial sale is one that bears the general hallmarks of a sale pursuant to Section 2-106 of the Uniform Commercial Code. We conclude, moreover, that no such invalidating commercial sale occurred in this case. We, therefore, affirm the district court's judgment that the transactions at issue did not render the asserted claims ...invalid under § 102(b).”
    - Distinguished Hamilton Beach

## *On-sale Bar of Pre-ALA 35 U.S.C. §102(b)*

- *On rehearing, en banc* (con't)
  - FC:
    - No “commercial sale” of patented product under Pfaff.
      - “the mere **sale of manufacturing services** by a contract manufacturer to an inventor to create embodiments of a patented product for the inventor **does not constitute a ‘commercial sale’ of the invention.**”
      - “‘stockpiling’” by the purchaser of manufacturing services is not improper commercialization under §102(b).”
        - “mere preparations for commercial sales are not themselves ‘commercial sales’ or ‘commercial offers for sale’ under the on-sale bar.”
      - “commercial benefit—even to both parties in a transaction—is not enough to trigger the on-sale bar of §102(b); the transaction must be one in which the product is ‘on sale’ in the sense that it is ‘commercially marketed.’”
        - “the inventor maintained control of the invention.”

## *On-sale Bar of Pre-ALA 35 U.S.C. §102(b)*

- *On rehearing, TMC (con't)*
  - FC: Still no “supplier exception.”
    - “We still do not recognize a blanket ‘supplier exception’ to what would otherwise constitute a commercial sale as we have characterized it today. While the fact that a transaction is between a supplier and inventor is an important indicator that the transaction is not a commercial sale, understood as such in the commercial marketplace, it is not alone determinative. ...The focus must be on the commercial character of the transaction, not solely on the identity of the participants.”

## *On-sale Bar of Pre-ALA 35 U.S.C. §102(b)*

- On appeal after remand
  - DC: no infringement and distribution agreement was not an invalidating “offer for sale.”
    - Distribution agreement was only agreement to be distributor, not an offer to sell the product.
  - FC: Affirm no infringement and remand for determination of on-sale bar.
    - Distribution agreement was agreement to sell and purchase the product.
    - Title changed upon receipt at the distribution center.
    - All the necessary terms and conditions to constitute a commercial offer for sale.
    - No “supplier exception.”
    - Remand to determine if Distribution agreement covered patented product.

## *Pre-ALA § 102: “Ready For Patenting”*

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### Fully operational prototype

- *IGT v. Global Gaming Technology, Inc.*, 1999 U.S. App. LEXIS 13336 (Fed. Cir. 1999)(unpublished)

### Complete conception

- *Robotic Vision Systems, Inc. v. View Engineering, Inc.*, 249 F.3d 1307, 1311 (Fed. Cir. 2001)

### Could satisfy § 112

- *Space Systems/Loral, Inc. v. Lockheed Martin Corp.*, 271 F.3d 1076 (Fed. Cir. 2001)

### Sufficient grasp of the invention

- *STX, LLC v. Brine, Inc.*, 211 F.3d 588 (Fed. Cir. 2000)



## *‘Ready For Patenting’*

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Barry v. Medtronic, 914 F.3d 1310 (Fed. Cir. 2019)  
(TARANTO, Moore, Prost)(Dissenting opinion filed by Prost)

- Barry’s patents contained method and system claims.
- Barry performed three surgeries using his inventions on Aug. 4, Aug. 5, and Oct. 14, 2003.
  - Charged for those surgeries without mentioning to the patients that the device and methods were experimental.
  - Follow-up appointments between Aug. 2003 and Jan. 2004.
- Barry filed a U.S. patent application on December 30, 2004
- Critical date for 35 U.S.C. §102(b) therefore was deemed to be December 30, 2003.
- **Issue: Was Dr. Barry's invention in public use or on sale before December 30, 2003? If so, were the public use and sale bars negated by experimental use?**

# *‘Ready For Patenting’*

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## Barry v. Medtronic (con’t)

- DC: No public use or sale.
- **FC: Affirmed (2-1).**
  - the **invention was not ready for patenting prior to the critical date**, eliminating both the public use and on sale bars, and up to the critical date, there was only experimental use.
  - “the timing of knowledge that the invention will ‘work for its intended purpose’ is important to both experimental use and readiness for patenting,”
  - “‘intended purpose’ need not be stated in claim limitations that define the claim scope.”
  - Majority: substantial evidence supported the conclusion that **Barry did not know his invention would work for its intended purpose until January 2004, after completion and follow up of the August and October 2003 surgeries.**

For more discussion of this case, see Burgy et al, "Gunfights at the Deeply Divided Federal Circuit OK Corral Over 'Ready for Patenting,' Useful for the Intended Purpose, and Experimental Use" (Finnegan Prosecution blog Jan. 31, 2019)

## *PTAB and On-sale*

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- *Remember: public use or on-sale bar not legitimate basis for IPR:*
- 35 U.S.C. § 311. Inter partes review
  - \* \* \*
  - (b) SCOPE.—A petitioner in an inter partes review may request to cancel as unpatentable 1 or more claims of a patent only on a ground that could be raised under section 102 or 103 and **only on the basis of prior art consisting of patents or printed publications.**

## *‘By Another’ Under §102(e)*

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Duncan Parking Tech., Inc. v. IPS Group, Inc., 914 F.3d 1347  
(Fed. Cir. 2019)

- ‘310 patent listed King plus 3 engineers as inventors.
- ‘054 patent listed King and Schwarz as inventors.
- ‘054 patent asserted as anticipatory reference against the ‘310 patent.
  - Key disclosure was Fig. 8.
- **Issue: Was Schwarz a joint inventor of the anticipatory disclosure of the ‘054 patent, rendering that portion of the ‘054 patent §102(e) prior art against the ‘310 patent?**

# *“By Another” Under §102(e)*

## Duncan Parking (con’t)

- FC: the PTAB erred in concluding that the ’054 patent did not anticipate the ’310 patent.
  - Test for determining “by another” for the purposes of § 102(e):
    - 1) determine what portions of the reference patent were relied on as prior art to anticipate the claim limitations at issue,
    - 2) evaluate the degree to which those portions were conceived “by another,” and
    - 3) decide whether that other person’s contribution is significant enough, when measured against the full anticipating disclosure, to render him a joint inventor of the applied portions of the reference patent.
  - The anticipating disclosure of the ’054 patent is “by another” (both King and Schwarz) for the purposes of § 102(e). Schwarz conceived of disclosure of Fig. 8, and that disclosure “was significant in light of the invention as a whole.”

**For joint inventorship, a co-inventor does not need to contribute to all the limitations in any one claim.**

IPR2017-01879

For more discussion of this case, see Burgy, et al, "Back to the Bread and Butter, Unraveling, in Appeals from PTAB and a District Court, How Inventorship Affects a § 102(e) Analysis, Why the Doctrine of Equivalents Does Not Apply, and Reversing a “Too-Narrow” Claim Construction," (Finnegan Prosecution blog Feb. 4, 2019 )

## *More ‘By Another’ Under §102(e)*

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- *Sanofi-Aventis U.S., LLC et al. v. Immunex Corp.*, IPR2017-01879
  - Sanofi filed IPR petition challenging U.S. 8,679,487.
  - PTAB instituted on one anticipation ground, US 2002/0002132 (the ‘132 publication) under 35 U.S.C. §102(e).
  - PTAB FWD: Petitioner failed to establish anticipation by a preponderance of the evidence.
    - The ‘132 publication was not “by another,” and therefore did not qualify as a prior art reference against the ‘487 patent.
      - the “portions of the ‘132 Publication relied upon for anticipation represent[ed] the work of the ‘487 patent inventors.”
      - the activity of another person not named on the ‘487 patent was “a technician for carrying out [] instructions, and not a joint inventor.”
      - Patent Owner, by declarations and corroborating evidence, satisfied its burden of production to show that the ‘132 publication was not §102(e) prior art.

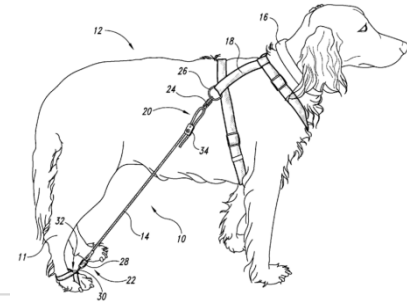
For more discussion of this case, see Holtman, et al, "The Plight of U.S. Pat. No. 8,679,487 at PTAB; if Two Arrows Miss the Mark, Launch a Third" (Finnegan Prosecution blog, Feb. 19, 2019)

## More §102(e)

- *Sanofi-Aventis U.S., LLC et al. v. Immunex Corp.*, IPR2017-01129
  - Sanofi filed IPR petition challenging U.S. 8,679,487
  - Asserted §102(e) anticipation reference a U.S. patent publication (“the Pub”), was supported by two expert declarations.
  - Was the '487 patent was entitled to a priority date earlier than the Pub’s publication date?
- PTAB: No, petition denied.
  - Sanofi did not establish a reasonable likelihood of showing lack of entitlement to the relevant priority date.
    - Petition failed to address the Office’s prior determination of priority during prosecution,
    - Petition presented an ambiguous position as to whether 35 U.S.C. § 112(6) applied to the construction of “antibody”, and
    - Petitioner’s expert failed to consider the full scope of the disclosure regarding the issues of written description and enablement.

For more discussion of this case, see Holtman, et al, "The Plight of U.S. Pat. No. 8,679,487 at PTAB; if Two Arrows Miss the Mark, Launch a Third" (Finnegan Prosecution blog, Feb. 19, 2019)

# 35 U.S.C. §102(f)



*In re VerHoef*, 888 F.3d 1362 (Fed. Cir. 2018)

- Initial patent application named VerHoef and Lamb as joint inventors.
  - Lamb supplied the idea of a figure eight loop that engages the dog's toes, which was an express claim limitation.
- Abandoned patent application and VerHoef filed identical application naming VerHoef as sole inventor. (Lamb did too).
- PTAB: Affirmed examiner rejection of claims as unpatentable under §102(f).
- FC: Affirmed.
  - VerHoef did not solely invent the claimed subject matter on which he asserted sole inventorship; Lamb was a joint inventor.
  - Joint inventors do not need to contribute equally, but “Lamb contributed the idea of the figure eight loop and ... the figure eight loop is an essential feature of the invention not insignificant in quality or well-known in the art.”
  - “This case presents the ‘rare situation,’ or at least an uncommon one, where the [documentation] make clear that [VerHoef] did not himself solely invent the subject matter sought to be patented, as those materials establish that Lamb was a joint inventor improperly omitted from the application.”



## *Practice Tips Re §102*

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Determine which law/prior art should have been applied by USPTO by analyzing EFD of all claims.

- AIA
- Pre-AIA
- Transitional (JMM): AIA plus part of pre-AIA

Determine whether the correct law was applied by USPTO.

Determine the outcome under the application of the correct law.

## *Practice Tips Re §102*

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Showing experimental use to negate public use or on sale argument is a very fact-intensive inquiry.

- Try to record the development path of the invention as it is happening and articulate the “intended purpose” of the invention with specificity in the claims and/or specification.

Watch out for inventorship issues, whether pre-AIA or AIA law applies.

- Good record-keeping, whether electronic or paper, remains key.
- Try to get inventorship correct before a patent issues.
- May need to revisit if claims are amended during prosecution.

# *Minimizing The Risk Of Patent Ineligibility Or Invalidation*

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- Be mindful of statutory bar dates and to try and closely coordinate commercial and patenting efforts.
  - Avoid any on-sale activity or other conduct that would preclude patent protection.
  - Develop internal system to try to file patent applications as soon as possible.
  - Limit publicity if possible.
  - Communicate frequently with commercial teams and carefully monitor terms.
- Take corrective action.
  - Utilize 102 (b) (1) exceptions if they are available.

## *Strategies For Avoiding/ Overcoming §102 Rejection*

- “Picking and choosing” insufficient – reference must show elements “as arranged in the claim.”
- Impermissible use of extrinsic evidence to fill in gaps of reference.
- Show reference is not enabling.
- Genus doesn’t disclose species with sufficient specificity.
  - A POSITA could not “immediately envisage.”
- Reference does not “necessarily and inevitably” result in claimed invention.
- Show reference was not publicly accessible.



# Thank you.

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