

America Invents Act Exceptions to Prior Art

Robert W. Bahr
Deputy Commissioner
for Patent Examination Policy

12th Annual Advanced Patent Law Institute
March 9-10, 2017



Overview

- 102(a)(1) prior art and exceptions (within one year)
 - Inventor-originated disclosure
 - Prior public disclosure
- 102(a)(2) prior art and exceptions (no one year limit)
 - Inventor-originated disclosure
 - Prior public disclosure
 - Common ownership
- Establishing that an exception applies
 - Rule 130 declarations
 - Rule 77(b)(6) statements



35 U.S.C. 102(a)(1)

§ 102. Conditions for patentability; novelty

(a) NOVELTY; PRIOR ART.—A person shall be entitled to a patent unless—

(1) 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

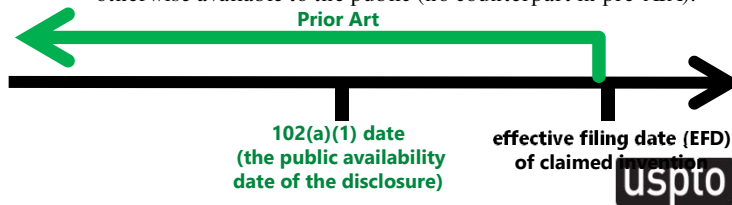


3

35 U.S.C. 102(a)(1): Disclosures Having a Prior Public Availability Date

102(a)(1) precludes a patent if a claimed invention was, before the effective filing date of the claimed invention:

- patented (no change from pre-AIA);
- described in a printed publication (no change from pre-AIA);
- in public use (some change from pre-AIA);
- on sale (some change from pre-AIA); or
- otherwise available to the public (no counterpart in pre-AIA).



4

Exceptions to Prior Art under 35 U.S.C. 102(a)(1)

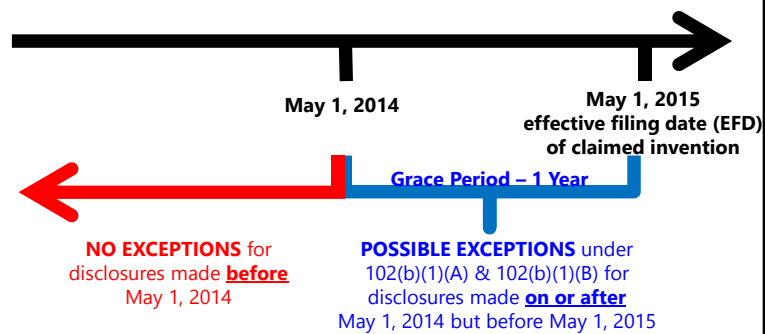
- Even though a disclosure of subject matter falls within the scope of 102(a)(1), it may not be used in a prior art rejection if one of the exceptions stated in 102(b)(1) applies.
- The two exceptions are stated in 102(b)(1)(A) and 102(b)(1)(B), and involve potential prior art disclosures made within the grace period, which is the one-year period preceding the effective filing date of the claimed invention.

REMEMBER: The 102(b)(1) exceptions apply to 102(a)(1) prior art!



5

No Exceptions for 102(a)(1) Disclosures Made Before the Grace Period



6

Find the full text of this and thousands of other resources from leading experts in dozens of legal practice areas in the [UT Law CLE eLibrary \(utcle.org/elibrary\)](http://utcle.org/elibrary)

Title search: America Invents Act Exceptions to Prior Art

Also available as part of the eCourse

[2017 Advanced Patent Law \(USPTO\) eConference](#)

First appeared as part of the conference materials for the

12th Annual Advanced Patent Law Institute session

"The New Section 102"