

# America Invents Act Exceptions to Prior Art

Robert W. Bahr  
Deputy Commissioner  
for Patent Examination Policy

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## 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

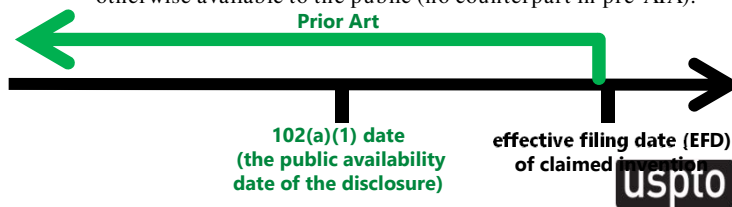
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### 35 U.S.C. 102(a)(1): Disclosures Having a Prior Public Availability Date

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).



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

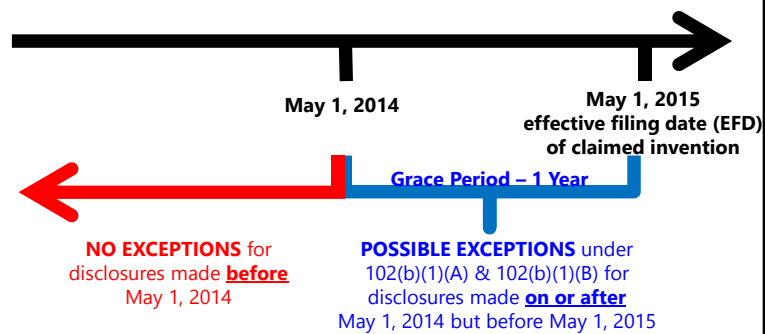
- Even though a disclosure of subject matter falls within the scope of 102(a)(1), it may not be used in a prior art rejection if one of the exceptions stated in 102(b)(1) applies.
- The two exceptions are stated in 102(b)(1)(A) and 102(b)(1)(B), and involve potential prior art disclosures made within 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!**



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



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First appeared as part of the conference materials for the

12<sup>th</sup> Annual Advanced Patent Law Institute session

"The New Section 102"