FIRST INVENTOR TO FILE
What We Still Don't Know and How It Could Affect Your Clients

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35 U.S.C. Section 102(b)(1)

- **Rule §102(a)(1)**: ***(Public)* disclosures** that have a *(public)* availability date before the *effective filing date* of the claimed invention under examination.
- **Exception §102(b)(1)**:

  a) One year grace period disclosure by an inventor or another who obtained *subject matter* from an inventor; or

  b) One year grace period disclosure of *subject matter* by a third party after public disclosure of the *subject matter* by an inventor or one who obtained *subject matter* from an inventor.

35 U.S.C. Section 102(b)(2)

- **Rule §102(a)(2)**: **U.S. patents and published applications** by others that have an *effective filing date* before the *effective filing date* of the claimed invention under examination.
- **Exception §102(b)(2)**:

  a) Subject matter of filing by another was obtained from an inventor; or

  b) Filing of *subject matter* by another occurred after public disclosure of the *subject matter* by an inventor or another who obtained *subject matter* from an inventor; or

  c) The *subject matter* disclosed and the claimed invention were commonly owned applications.

35 U.S.C. Section 102(b)

- It is dangerous to rely on the new one-year grace period or base a patent strategy on publishing before filing.
- What does “subject matter” mean?

Possible Interpretations of "The Subject Matter"

- Narrow interpretation: Within the grace period, a third party's disclosure that is different from the inventor's prior disclosure in even a trivial or insubstantial way can be used as prior art against the inventor.
- Intermediate interpretation: Within the grace period, a third party's disclosure need not be verbatim to inventor's prior disclosure for the third party disclosure to be avoided as prior art. Exception applies if third party's disclosure is more general than inventor's disclosure.

Possible Interpretations of "The Subject Matter"

- Broad interpretation: Within grace period, third party's disclosure is not prior art if the differences with the inventor's prior disclosure are obvious.
- Broadest interpretation: Within the grace period, no third party disclosure after the inventor's disclosure can be prior art against the inventor.

Title search: First Inventor to File: What We Still Don’t Know and How It Could Affect Your Clients

Also available as part of the eCourse
The New Section 102

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