Patent Law

- Module F
- postAIA Novelty

PostAIA: First to File, or, First to Publish to bar others, in §102

35 U.S.C. § 102. Conditions for patentability; novelty

(a) Novelty; Prior Art.-A person shall be entitled to a patent unless—
[there are novelty-defeating events]
(b) Exceptions.
[novelty-defeating disclosures were by the patent applicant (or someone who derived from her) and the applicant filed within a year from the date of the disclosure]
. . .

35 U.S.C. § 103. Conditions for patentability; non-obvious subject matter

A patent for a claimed invention may not be obtained, *notwithstanding that the claimed invention is not identically disclosed as set forth in section 102*, if [the claim is obvious]. [emphasis added]

PostAIA – Novelty versus Priority

	Novelty	Priority
First to File Attribute	Being the first to file does not guarantee that an applicant will obtain the patent. Novelty considers the impact of disclosers, not just filers. Novelty defeating events from § 102(a) {patents; publications; public uses; sales; otherwise available} that are public disclosures in the sense of § 102(b) immediately defeat novelty for all but the person who made the disclosure (or if another obtained the subject matter from such person and publically disclosed it).	When no novelty defeating event exists as described immediately to the left, the first to file will obtain priority among multiple persons filing for the claimed invention. In this scenario, in a race among independent inventors, the first to file wins the "race to the patent office" and owns the patent should it ultimately issue.
First to Publish Attribute	The first to publish characteristic gives (arguably) a strong and a weak grace period, one year in length in either case. The strong grace period is described immediately to the right. It is strong because anyone else who files will be blocked by a novelty defeating event. The weak grace period derives from: the word "disclosure" in § 102(b)(1)(A) as contrasted with "public disclosure" elsewhere in § 102(b); in light of case law interpreting pre-AIA public use and on sale events; and arguments from the structural interplay of post-AIA sections 102(a) and 102(b). Under "public use," the pre-AIA case law treated commercially beneficial secret uses of a later claimed invention as a barring event (if before the critical date) for that commercializing user who later files. The weak grace period is the year that the commercializing user (arguably) has under the AIA to file. It is weak because a public disclosure by another will cut off the weak grace period.	When a public discloser of a novelty defeating event desires to do so, she "wins" the priority race because she has blocked others, so long as she files within one year of her public disclosure. See, in part, § 102(b)(1)(B).

PostAIA - §102

35 U.S.C. § 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; or

(2) the claimed invention was described in a patent issued under section 151, or in an application for patent published or deemed published under section 122(b), in which the patent or application, as the case may be, names another inventor and was effectively filed before the effective filing date of the claimed invention.

(b) 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—

(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 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.

(2) Disclosures appearing in applications and patents.-A disclosure shall not be prior art to the 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.

PostAIA - §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—
. . . [the three conditions for an effective joint research agreement are omitted here] . . .

(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 patent or application—
. . . [describing that the actual filing date applies if the application claims priority from no other parent/ancestor application, or otherwise that an effective filing date applies from qualifying parent/ancestor application(s)] . . .

Somewhat ironically (given the importance of this change), postAIA §102 does not explicitly set forth a first-inventor-to-file standard. Rather, the first-inventor-to-file standard is implicit in the language of post-AIA §102(a)(2).

Janice M. Mueller, Patent Law, 242 (Aspen 4th Ed. 2013) (emphasis added)

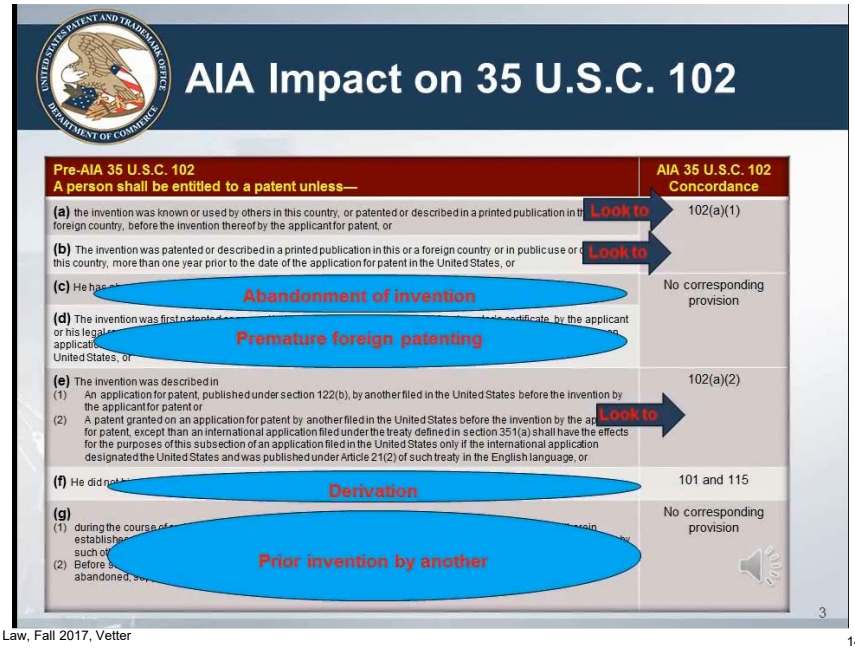
PostAIA - §102

Although Congress's stated intent of "provid[ing] inventors with greater certainty regarding the scope of protection" provided by patents is laudable, it is not clear that the AIA will actually achieve this goal. ***The post-AIA version of 35 U.S.C. §102, for example, is just as complicated and riddled with ambiguity (if not more so) than its preAIA counterpart.*** The Byzantine wording of post-AIA § 102 stands in sharp contrast to the straightforward manner in which other countries define patentable novelty (viz., the European Patent Convention's streamlined Article 54).

Moreover, although Congress speaks of promoting harmonization between the U.S. patent system and foreign patent systems, it is not clear that the AIA achieves this goal either. As described below, §3 of the AIA did not implement a European-style system of first to file with absolute novelty. Rather, the post-AIA version of §102 puts into place a unique hybrid system that preserves many aspects of the preAIA grace period found in 35 U.S. C. §102(b) (2006). Rather than a true first-to-file system, the AIA created what is better described (at least in some circumstances) as a "first inventor to disclose" system.

Janice M. Mueller, Patent Law, 238 (Aspen 4th Ed. 2013) (emphasis added)

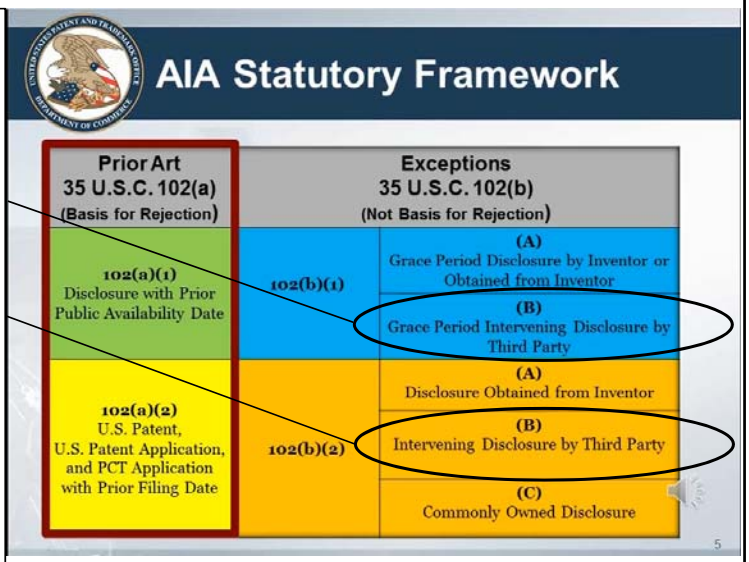
preAIA §102 compared to AIA §102



AIA §102 framework

The intervening TP disclosure is eliminated as prior art if the inventor or a deriver makes a public disclosure (call this the "inventor public disclosure" – IPD) before the intervening TP disclosure (the PTO calls this the "intervening grace period disclosure" - IGPD)

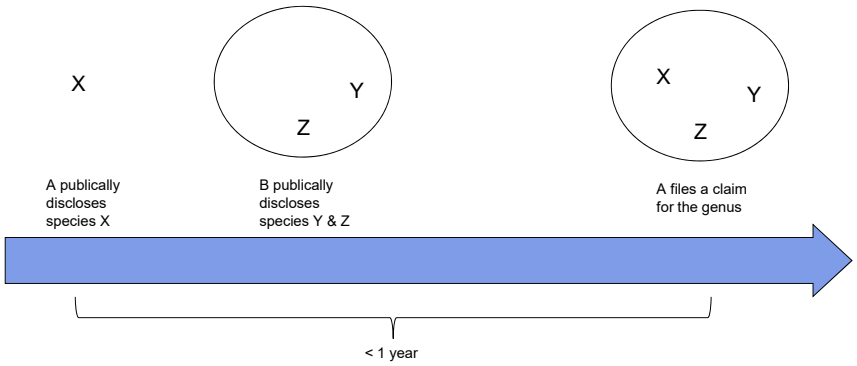
What effect when IGPD discloses more, and that more is obvious variants of the IPD?



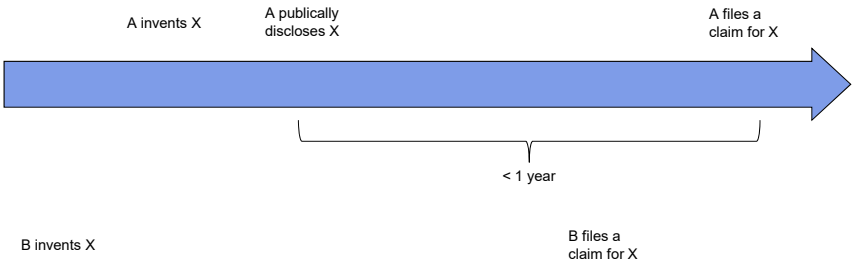
postAIA §102

- Some statutory construction issues in section 102
  - Does the Metallizing doctrine continue?
  - "Grace period" types
  - The scope of the effect of a public disclosure under §102(b)(1)(B)

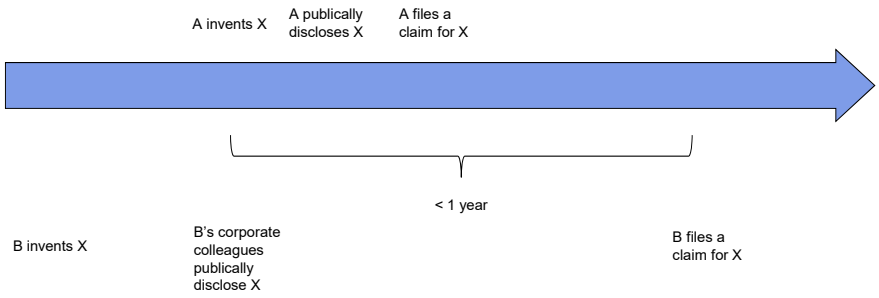
- Hypo for effect of intervening grace period public disclosure for obvious variants
  - Assume in the diagram below that Y & Z are obvious variants of X



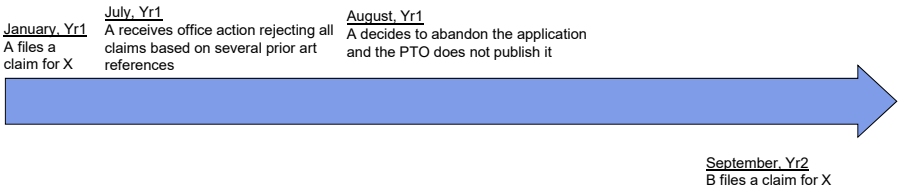
PostAIA - §102 – second to invent, second to file



PostAIA - §102 – disclosure by "another"

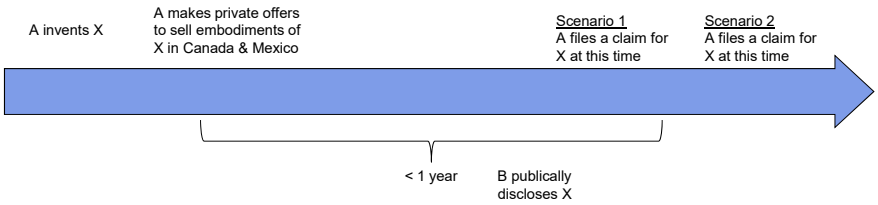


PostAIA - §102(a)(2) "non-scenario"



PostAIA - §102 – weak grace period subject to cutoff

Scenario 1
§102(b)(1)(A) "disclosure" – if meaning of "disclosure" includes private activity or secret activity with commercial benefit – then events such as "on sale" or "public use" start a one year "weak grace period" for the event initiator.
It is "weak" because someone else's public disclosure will, under §102(b)(1)(B), eliminate the inventor/event-initiator's ability to file successfully



Scenario 2
§102(b)(1)(A) "disclosure" – if private activity or secret activity with commercial benefit is not activity that will be counted as "on sale" or "public use" under the AIA, then A could successfully file at the time indicated in Scenario 2 if B had not publically disclosed X.

Helsinn v. Teva (Fed. Cir. 2017)

- '219 patent governed by post-AIA law
- Claim covers formulation of palonosetron at the 0.25 mg dose to combat CINV – chemotherapy induced nausea and vomiting
- Helsinn contracts with MGI about two years before the critical date for MGI to make the formulation
  - The redacted agreement is made public in a securities filing
- District court
  - On-sale bar must be for a public disclosure of the details of the invention, the "ready for patenting" enabling information (a CRtoP)
  - The invention was not ready for patenting
- Federal Circuit
  - Discussion of the legislative history and attempts by Helsinn to use it to argue that the postAIA on-sale bar is of lesser scope because it only includes public events – a public sale with public disclosure of invention details
  - Legislative history of the public use bar versus the on-sale bar
  - This situation is covered by the postAIA on-sale bar: public disclosure of sale even when invention details are kept secret
  - The invention was ready for parenting – it was an ARtoP