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### **BUSINESSEUROPE COMMENTS TO PROPOSED GUIDELINES FOR THE IMPLEMENTATION OF THE AMERICA INVENTS ACT (AIA)**

The implementation guidelines published on 16 July 2012 by the US Patent and Trademark Office (USPTO) state in the summary section that the America Invents Act (AIA) amends US patent law to convert the US patent system from a “first-to-invent” system to a “first-inventor-to-file” system.

There is no question that the AIA achieves major strides towards harmonisation of US law with worldwide standards. In particular, the AIA removes the reference to the date of invention and eliminates interference proceedings as well as the ability to “swear behind” a reference published less than 1 year before filing by relying on an earlier date of invention. In addition, it moves towards a concept of absolute novelty by eliminating the limitation to US territory regarding the applicability of “public use” and “on sale” activities as prior art. Finally, it eliminates the *Hilmer* doctrine, thus making US patent applications claiming a foreign Convention priority effective as prior art as of their priority date.

However, the AIA keeps to the US traditional focus on the inventive process and the consideration given to pre-filing activity and the concern that only the “true inventor” of an invention should be entitled to patent protection. This is expressed by the choice of the term “first-inventor-to-file system”, which marks the intent to distinguish the AIA system from the first-to-file system.

This is implemented in the AIA by the extensive grace period provisions of Article 102(b)(1) which, in addition to immunizing the applicant against the prior disclosures of the inventor or of a joint inventor made during the grace period, enable an applicant to disqualify as prior art a third party disclosure made during the grace period if the disclosure was made by another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor, or if the subject matter disclosed had, before such disclosure, been publicly disclosed by the inventor or a joint inventor, or by another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor.

The latter provision can be seen as the counterpart in the AIA for the ability to “swear behind” a reference provided under the current law, with the prior disclosure by the inventor (or by a third party having obtained the subject matter of the invention from the inventor) somehow used as a proxy for the date of invention.

Articles 102(b)(2)(A) and (B) contain equivalent provisions for disclosures appearing in third party patent applications.

These provisions raise substantial interpretation issues and from the USPTO’s perspective entail the procedural difficulty of determining the prior art status of third party disclosures in an *ex parte* context. The proposed guidelines provide the following answers:



1. In articles 102(b)(1)(A) and 102(b)(2)(A) excluding from the prior art third party disclosures “obtained directly or indirectly from the inventor”, a major question is the meaning of “obtained” and “subject matter disclosed”. The proposed guidelines require from the applicant an affidavit or declaration showing that the subject matter has been invented by the inventor of the application, and that the subject matter has been *communicated* to the third party. Moreover, the proposed guidelines require that such communication be sufficient to enable one skilled in the art to make the subject matter. The proposed guidelines set forth the requirements as follows:

*Specifically, the applicant must show that a named inventor actually invented the subject matter of the disclosure. The applicant must also show a communication on the subject matter of the disclosure sufficient to enable one of ordinary skill in the art to make the subject matter of the claimed invention. Any documentation which provides evidence of the communication of the subject matter by the inventor or a joint inventor to the entity that earlier disclosed the subject matter should accompany the affidavit or declaration.*

BUSINESSEUROPE considers that the proposed guidelines define a reasonable procedure, since it only requires from the applicant documentation normally in the applicant’s possession.

2. In articles 102(b)(1)(B) and 102(b)(2)(B) excluding from the prior art third party disclosures if the same subject matter has been previously disclosed by the inventor, or by a third party having obtained the subject matter from the inventor, the interpretation of “the same subject matter” has far-reaching implications.

The ability of an applicant to disqualify a third party disclosure by relying on its earlier disclosure can be explained within the “first-inventor-to-file” approach by the following argument. Once the invention has been disclosed by the inventor, it is publicly available and any third party can subsequently make a disclosure on the subject matter of the inventor’s disclosure, without acknowledging that such disclosure was derived from the inventor’s first disclosure. In the context of the “first-inventor-to-file” system, a third party disclosure should not be prior art if it is derived from the inventor’s earlier disclosure. This, however, may be impossible to determine in the context of *ex parte* proceedings. The provision of the AIA implicitly relies on the presumption that any subsequent third party disclosure is derived from the inventor’s first disclosure.

This provision, however, carries the risk of creating a “first-to-publish” system of overly broad scope in which a truly independent third party disclosure would be treated as a disclosure derived from a disclosure by the inventor, merely because it occurs after the inventor’s disclosure. This could be considered inconsistent with the “first-inventor-to-file” concept put forward in the AIA. This would also be contrary to the objective of harmonisation stated in the preamble of the AIA, since a “first-to-publish” system would be all the more different from the first-to-file system which is the worldwide standard as its scope would be broader.

A key issue here is the scope of interpretation given to the term “same subject matter” used in the AIA provision. We believe that the broader the scope, the higher the risk of



creating an overly broad “first-to-publish” system. BUSINESSEUROPE welcomes the strict interpretation of the proposed guidelines in this respect, since it reduces the above-mentioned risk. The proposed guidelines require that the subject matter in the third party disclosure be identical with that of the inventor’s disclosure. They read as follows:

*Even if the only differences between the subject matter in the prior art disclosure that is relied upon under 35 U.S.C. 102(a) and the subject matter publicly disclosed by the inventor before such prior art disclosure are mere insubstantial changes, or only trivial or obvious variations, the exception under 35 U.S.C. 102(b)(1)(B) does not apply.*

This interpretation is supported by the following argument. The presumption that a third party disclosure has been derived from a prior disclosure by the inventor appears justified only if it has exactly the same subject matter as the prior disclosure by the inventor. It would not be if there are differences. It provides examiners with an objective test which can be used in *ex parte* proceedings.

The wording of the proposed guidelines is the same in respect of 35 U.S.C. 102(b)(2)(B) which relate to subject matter disclosed in a patent or patent application.

In light of the above-mentioned, BUSINESSEUROPE is of the view that the proposed guidelines should be approved.

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