THE UNITED STATES PATENT SYSTEM – THE CHANGE IS COMING! – PART III

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As mentioned in my previous articles, the America Invents Act (AIA) will move the United States Patent System from a first-to-invent system to a first-to-file system on March 16, 2013. Under the current system, an inventor has a 1 year grace period to file a patent application after the inventor discloses his or her invention to the public. Fortunately, for many inventors, the AIA preserves the one year grace period. More specifically, the grace period is preserved under 35 U.S.C. 102(b)(1)(A) which states: "*[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*."

In addition to providing a grace period for an inventor's disclosures, Congress also revised 35 U.S.C. 102 with language that appears to bar some third party disclosures from qualifying as prior art. More specifically, 35 U.S.C. 102(b)(1)(B) states: "*[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 ...if ...the subject matter disclosed had, before such disclosure, been publicly disclosed by the inventor.* "

Clearly, 35 U.S.C. 102(b)(1)(B) provides an incentive for inventors to disclose their inventions as quickly as possible since the disclosed subject matter may remove a third party's disclosure of the same invention. However, the scope of protection provided by 35 U.S.C. 102(b)(1)(B) is unclear and has been hotly debated since the passage of the AIA. For example, does 35 U.S.C. 102(b)(1)(B) protect only the subject matter disclosed by the inventor or does the protection extend to obvious variants thereof?

On July 26, 2012, the United States Patent and Trademark Office (USPTO) published their proposed rules relating to 35 U.S.C. 102(b)(1)(B). According to the USPTO, the scope of protection offered by 35 U.S.C. 102(b)(1)(B) is extremely limited. More specifically, the proposed rules state:

> [t]he exception in 35 U.S.C. 102(b)(1)(B) applies if the "'subject matter' disclosed [in the prior art disclosure] had, before such [prior art]

> disclosure, been publicly disclosed by the inventor or a joint inventor * * * ." [41] Thus, the exception in 35 U.S.C. 102(b)(1)(B) requires that the subject matter in the prior disclosure being relied upon under 35 U.S.C. 102(a) be the ***same*** "subject matter" as the subject matter publicly disclosed by the inventor before such prior art disclosure for the exception in 35 U.S.C. 102(b)(1)(B) to apply. ***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***.

Thus, according to the proposed rules, even insubstantial differences between an inventor's disclosure and a third party's disclosure may be enough to prevent the inventor from using 35 U.S.C. 102(b)(1)(B) to disqualify the third party's disclosure from the prior art. Thus, while 35 U.S.C. 102(b)(1)(B) does provide an inventor some protection, it appears the protection is rather limited.

In light of the USPTO's proposed rules, businesses should think carefully about disclosing their inventions before filing a patent application since such disclosures may provide only limited protection in the United States. Furthermore, as indicated in my earlier articles, disclosing an invention prior to filing a patent application may ruin an inventor's chance of obtaining a patent outside of the United States.

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