

October 5, 2012

The Honorable David J. Kappos
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office
United States Patent and Trademark Office
600 Dulany Street
Alexandria, VA 22314

Via email: fitf_rules@uspto.gov
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Re: Comments on:

**“Changes to Implement the First Inventor to File
Provisions of the Leahy-Smith America Invents Act”
77 Fed. Reg. 43742 (July 26, 2012)**

**“Examination Guidelines for Implementing the First Inventor to File
Provisions of the Leahy-Smith America Invents Act”
77 Fed. Reg. 43759 (July 26, 2012)**

Dear Under Secretary Kappos:

The American Intellectual Property Law Association (AIPLA) is pleased to have the opportunity to present its views with respect to the United States Patent and Trademark Office (“Office”) Notice of Proposed Rulemaking entitled “Changes To Implement the First Inventor to File Provisions of the Leahy-Smith American Invents Act,” as published in the July 26, 2012 issue of the *Federal Register*, 77 Fed. Reg. 43742 (“Notice”), and in response to the Request for Comments on the “Examination Guidelines for Implementing the First Inventor to File Provisions of the Leahy-Smith America Invents Act,” as published in the July 26, 2012 issue of the *Federal Register*, 77 Fed. Reg. 43759 (“Request”).

AIPLA is a national bar association with approximately 14,000 members who are primarily lawyers in private and corporate practice and government service and in the academic community. AIPLA represents a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, copyright, and unfair competition law. Our members represent both owners and users of intellectual property.

Implementation of the new first-inventor-to-file standard in the law will require extensive revisions to the USPTO rules, policies, procedures, and practices. AIPLA appreciates the opportunity to provide support and guidance, and in that spirit offers the following observations and suggestions on specific portions of the proposed rules and guidelines.

General Comments

The Leahy-Smith America Invents Act (“AIA”) is a substantive and historical step in the harmonization of patent law in the global intellectual property system, in that it adopts a “First-Inventor-to-File” (“FITF”) system with a grace period for an inventor’s own disclosures or those derived from the inventor for 12 months before the applicant’s effective filing date. This is the culmination of almost 30 years of discussion in the United States and in international negotiations on substantive patent harmonization. AIPLA has been closely observing these discussions, and we see the AIA as a solid basis for even more substantial progress in the development of the international patent system. AIPLA commends the United States Congress and the Office for their foresight and initiative in moving the U.S. ahead of its international trading partners in achieving a modernized global-level patent system. We hope that the United States will continue its leadership in the international discussions to make the global system, at long last, a reality.

Given that this is a significant change in both law and practice, AIPLA believes that the development of the Final Rules and guidance to implement FITF should balance the practical implications and burdens on the Office and the applicant, as well as maintain a close and careful watch on any relevant public interest. In addition, AIPLA recalls the well-settled judicial parameters that have been set with respect to USPTO substantive rulemaking, and believes that these should be kept in mind with respect to AIA implementation, and applied diligently.

On a practical level, AIPLA commends the Office for the extraordinary efforts it has made in paving the way for the transition from a first-to-invent system to a first-inventor-to-file system. While those efforts have largely been successful in meeting the needs of both patent owners and patent practitioners, AIPLA has a number of concerns and suggestions on the detail level for making the transition to the new system, and the new system itself, even more user-friendly.

As a first overarching comment, we acknowledge that the changes are necessarily complicated. We also note that potentially different conclusions on patentability can result, depending on whether the claim set is examined under the AIA, or the pre-AIA, version of §§102 and 103. Thus, the effects of having one’s patent application unexpectedly examined under one system rather than the other can have dire consequences. AIPLA requests that the Office provide as much explanation and as many examples as possible to help practitioners avoid potential significant mistakes that could lead to loss or diminution of patent rights. In its pre-Notice submission of comments on implementation of the first-inventor-to-file system, filed on March 28, 2012, AIPLA presented a number of examples and fact patterns that it believed the Office should consider and comment on how they would be handled. An augmented list of fact patterns is included in the latter part of this letter, for consideration and elucidation by the Office.

Proposed Rules

Priority Document

The Notice proposes amending Section 1.55(a)(2) to require that the claim for priority and a certified copy of the foreign priority application be filed within the later of 4 months from the actual filing date or 16 months from the filing date of the prior foreign application. This raises a number of issues.

First, early filing of a priority document is not required by the AIA. A priority document is needed by the Office for two things: (1) examination (if intervening art exists), and (2) the public record for subsequent evaluation of adequacy of support in the priority document in those situations in which the published application is being utilized as prior art against other applications as of its priority date. For examination of the application, the Office can readily obtain most priority documents through IP5 exchange agreements/mechanisms, and thus it does not need the applicant to provide the priority document. In a few situations, the priority document may not be available through the IP5, but even then the priority document would only be needed for examination, should there be intervening prior art.

Second, the forfeiture of an application if the certified copy of the priority document is not received by the USPTO within the four-month time limit may be problematic, since the actual delivery to the USPTO of the certified copy is not within the control of the applicant. The applicant only has control of the timing of submission of a request for a certified copy, but not over the time it takes for the Office of first filing to process that request. While Section 1.55(d)(1)(iii) purports to allow filing “at such later time as may be set by the Office,” no specific later time is identified in (d)(1)(i), and Section 1.55 time frames are not extendable. Remedy via a petition is available only for unintentional delay in making a claim for priority, and is not available for late submission of the certified copy.

AIPLA proposes to revise the timing for submission of the certified copy of a priority document. We suggest requiring an applicant to request that the other patent office provide a copy to the Office within 4 months from the actual filing date or 16 months from the priority date, and requiring an actual certified copy of the priority document on payment of the issue fee, or after receipt of the Notice of Allowance and prior to payment of the issue fee. If (1) the priority document has not been provided to the Office at the time of examination, (2) the Office cannot obtain the document through the IP5 exchange systems, and (3) the Office discovers intervening art, any rejection can be made by the patent office using the application’s actual U.S. filing date, on the implicit assumption that there is no support in the priority document for the subject matter in the application. In any case the certified copy of the priority document must be provided to the Office no later than the payment of the issue fee.

Statements of “New Matter” or “New Claim”

Sections 1.55(a)(4) and 1.78(a)(3) require that if there is a non-provisional application filed on or after March 16, 2013 that claims the benefit of the filing date of a foreign application or provisional application filed prior to March 16, 2013, and either 1) contains a claim that has an effective filing date on or after March 16, 2013, or 2) does not contain a claim that has an effective filing date on or after March 16, 2013, but discloses subject matter not also disclosed in the foreign or provisional application, the applicant must provide a statement to that effect within the later of 4 months from the actual filing date or 16 months from the priority date.

AIPLA opposes this requirement. Requiring an applicant to make a statement whether “new matter” or a “new claim” has been added to an application at such an early stage in prosecution is an unprecedented burden on the applicant, with potentially severe negative consequences for both the applicant and the applicant’s representative. The only reasonable circumstance in which this could be required is where intervening prior art is discovered.

In particular, such a requirement is an unfair shifting of a burden that properly belongs on the Office. The proper burden remains on the Examiner to establish the grounds for any rejection; the determination of the date of priority in evaluating the applicability of any prior art is a responsibility of the Office. Shifting that burden to the applicant and the applicant's representative could conflict with a practitioner's ethical obligation to zealously advocate for her client, by requiring an admission with potential substantive consequences at an unripe time. It also could expose the practitioner herself to an unjustifiable increase in potential for liability.

As already mentioned, the determination of which version of the law applies is most pertinent in the case where intervening prior art is discovered during the transitional period. This is analogous to the current situation with respect to determining the right of priority. In these instances, factual inquiry can best be made through the judicious application of 35 U.S.C §112, first paragraph, enablement, and written description analyses as currently used to establish if new matter is present. Where appropriate, a request for information under 37 C.F.R. §105 could be used if the Office requires additional information after its initial review. In instances where an applicant's actions necessitate a change from the applicability of pre-AIA to AIA law (or vice-versa), it may be appropriate to make a second action final.

Statements Used Against Other Applicants

AIPLA requests an explanation of how the Office would utilize statements made in a declaration under 37 CFR §1.130 against another applicant. See 77 Fed. Reg. at 43750, bottom of col. 2. In addition, although these declarations will be part of the patent application file history, it would be helpful to know whether the Office will provide a way for the examiners and public to easily search for the content of the declarations as a whole rather than having to review individual file histories. There could be timing issues involved during the prosecution of two separate applications. For example, it could be difficult to utilize the details from such declarations filed for one application when examining another application, prior to publication of the application in which the declaration had been made.

Examination Guidelines

Differences Between First-to-Invent (FTI) and First-Inventor-to-File (FITF) Examination

Given the significant differences between the application of §§102 and 103 under current law as compared to §§102 and 103 under the AIA, it is important to provide as much clarity to the examiners and applicants as to which law applies during the examination of a particular application. To assist in highlighting which law the Office believes is applicable, it may be helpful beginning on March 16, 2013 for Office Actions to include a paragraph that clearly identifies whether the Office is examining the patent application at issue under the AIA versions of §§102 (including the applicability of pre-AIA §102(g) to any claim) and 103, or under the pre-AIA versions of §§102 and 103, and the reason for that determination. See Request, 77 Fed. Reg. at 43762, col. 3.

The Request, 77 Fed. Reg. at 43762, col. 2, states that "the new provisions apply to any patent that contains or contained at any time: (1) A claimed invention that has an effective filing date on or after March 16, 2013...." The Request, 77 Fed. Reg., paragraph bridging pages 43772-43773, also states that AIA §§102 and 103 apply to any patent application "that contains or contained at

any time a claimed invention having an effective filing date that is on or after March 16, 2013,” and that this applies “even if the remaining claimed inventions all have an effective filing date before March 16, 2013, and even if the claimed invention having an effective filing date on or after March 16, 2013 is canceled.”

In some cases, the inclusion of a claim determined by the Office to have an effective filing date after March 16, 2013, might be inadvertent. For example, it might be a mistake or an applicant may genuinely believe support for the claim(s) exists in the application. The forfeiture of examination under pre-AIA statutes is a serious outcome that may lead to a loss of patent rights.

AIPLA recommends adoption of procedures to prevent such results. For example, in transition applications (i.e., those filed on or after March 16, 2013, but claiming benefit to an application filed before March 16, 2013), amendments after examination of an application under pre-AIA protocols should not be entered as a matter of right until reviewed for new matter. If the examiner identifies a new matter issue in a claim, a Request for Information under 37 CFR §1.105 could be sent, giving the applicant 30 days to identify the specific support in the application and priority application for the disputed claim(s). During the 30-day period, the applicant could request an interview and be granted the interview with the examiner, a SPE, and/or an ombudsman or Quality Assurance Specialist (QAS) to resolve the issue. If the material is deemed to be new matter, applicant can then decide to: (1) keep the claims and have the application examined under the FITF provisions of the AIA, or (2) file a C-I-P application with disputed claims to continue prosecuting, and possibly appealing to the Patent Trial and Appeal Board (PTAB), to resolve the question of whether or not the claims are entitled to the earlier pre-AIA filing date.

Grace Period: Standard of “Same Subject Matter” for Exceptions

The Request, at 77 Fed. Reg. at 43767, col. 2 and 43769, col. 3, states that the exceptions in 35 U.S.C. §102(b)(1)(B) and (2)(B) “require[] 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” to apply (emphasis added). The Request goes on to say that the exceptions do not apply “[e]ven 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...*” (Emphasis added)

The Office’s imposition of a standard of “insubstantial changes” and “only trivial or obvious variations” would mean that the exceptions provided under 35 U.S.C. §102(b)(1)(B) or (2)(B) would very rarely apply because complete identity between the public disclosure by the applicant and the intervening prior art disclosure is highly unlikely. These provisions are designed to apply where the third party is a third party who independently invented the technology. It is extremely unlikely that a separate inventor’s independent disclosure would not exhibit insubstantial changes, or more than trivial or obvious variations. Thus, the Office’s interpretation would undercut the intent of Congress in adopting these provisions, and would render them virtually useless.

Conceivably the Office believes that these provisions are intended for a third party that somehow obtained the technology from the applicant (perhaps from the applicant's prior disclosure) and published it in order to circumvent the applicant's rights. However, this circumstance is already covered by AIA §102(b)(1)(A) and (2)(A) ("the disclosure was made by ... another who obtained the subject matter disclosed directly or indirectly from the inventor"). The Office's interpretation would render those provisions mere surplusage, violating the rule of statutory construction that Congress does not use unnecessary words. See *United States v. Menasche*, 348 U.S. 528, 538-39 (1955) ("It is our duty 'to give effect, if possible, to every clause and word of a statute.'" (quoting *Montclair v. Ramsdell*, 107 U.S. 147, 152 (1883))).

On the other hand, the Office may be thinking that §102(b)(1)(B) and (2)(B) provide an accelerated and easy means for the applicant to avoid the prior art effect of a third party's publication which was taken directly from the applicant's earlier disclosure. However, this "protection" is undercut by the fact that the third party need only make trivial or insubstantial changes to his later publication, in order to avoid application of the provision. This would permit a third party to re-publish the public disclosure of the applicant, and to include some small variation in their publication, thus preventing the applicant from utilizing the grace period exception to remove the third party's publication as prior art. If this is what the Office has in mind, it again would defeat the purpose of these provisions and render them useless.

Thus, AIPLA believes that the position proposed by the Office is not supported by a reasonable reading of the statute. AIPLA also believes that the Office's proposal is not supported by the legislative history of the AIA, and that it is in fact contrary to the clear legislative intent.

For example, the following excerpt from a floor speech by Senator Kyl shows that "trivial or obvious variations" were intended to be permitted when applying prior art:

Once inventors have published on their work--or have made it available to the public using any other means--their competitors should not be able to run off to the USPTO and seek patents on the work that the inventor has already publicly disclosed. The same goes for permitting a competitor to belatedly seek a patent on *a trivial or obvious variation* of what the inventor had earlier disclosed publicly. This common-sense truth should apply even if competitors can lay claim to having themselves done the same work, but elected to keep secret the work that other inventors have publicly disclosed.

In a word, a competitor seeking a patent on what such an inventor has already published can be thought of as being akin to interloping.

157 Cong. Rec. S1208-S1209 (March 3, 2011) (emphasis added).

In other words, under the new first-inventor-to-file system (as opposed to the first-to-invent system) a publication by an inventor should, and does, prevent a third party from obtaining a patent on that invention, even if the patent claims trivial or obvious variations. This is the necessary result of applying the patentability provisions of the statute, in particular, 35 U.S.C. §103.

The Office seems to have concluded that, since Congress only used the “trivial or obvious variations” language in the above context, it intended that such changes not be permitted in other contexts, including the pre-publication exception under §102(b)(1)(B) and (2)(B). However, additional comments made by Senator Kyl state that §102(b)(1)(B) and (2)(B) created a protection for early publication, preserving patent rights for whoever first publically disclosed the invention.

[I]f the inventor discloses his invention, a subsequently filed application by another will not constitute prior art against the inventor’s later-filed application for patent in the United States, even if the other filer did not obtain the subject matter from the first-disclosing inventor.... In other words, under the regime of the two subparagraph (B)s, an inventor’s disclosure of his invention to the public not only invalidates anyone else’s subsequently filed application, but ***no one else’s subsequent disclosure or filing of an application during the 1-year grace period will constitute prior art against that inventor’s application.*** The bill thus effectively creates a “first to publish” rule that guarantees patent rights in the United States to whoever discloses the invention to the public first.

157 Cong. Rec. S1369 (March 8, 2011) (emphasis added).

The proposed Office interpretation of §102(b)(1)(B) and (2)(B) would completely undermine the intent of Congress, as expressed by Senator Kyl (see above) that “no one else’s subsequent disclosure or filing of an application during the 1-year grace period will constitute prior art against that inventor’s application.” The Office can point to no other legislative history justifying its drastic deviation from the express intent of the statute itself.

AIPLA suggests that the Office resolve these issues by interpreting the phrase “subject matter” to mean that material from the third-party disclosure which the Office has identified to justify the rejection. Currently one need only show that the applicant had prior possession of at least as much as is disclosed in the prior art as relied on by the examiner in the rejection, in order to antedate a reference under 37 CFR §1.131. We suggest that a similar principle should apply to the exceptions under 35 U.S.C. §102(b)(1)(B) and (2)(B).

To illustrate: under §102(b)(2)(B), if an intervening reference shows A+B+C and the applicant is only claiming A+B, and the Office is relying upon the A+B portion of the disclosure in the intervening reference to support the rejection, the applicant should be permitted to use the exception based on showing earlier disclosure of the “subject matter” of A+B. Similarly, under §102(b)(2)(C), the applicant should be permitted to show that the “subject matter” A+B disclosed in a reference was commonly owned or under an obligation to assign not later than the effective filing date of the claimed invention, even when A+B+C is being claimed, and thus would not qualify as Section 103 prior art with respect to the claim.

AIPLA suggests deletion of the portions of the proposed guidelines referring to “insubstantial changes” and “trivial or obvious variations.” Consideration of whether or not earlier public disclosure by an applicant is adequate to provide the grace period exception should be similar to current evaluation of sufficiency of showings in a lab notebook, for example, as included in a declaration under §1.131.

Public Availability and “On Sale”

Concerning the Office’s request for comment on the extent to which public availability plays a role with respect to “on sale” prior art defined in 35 U.S.C. §102(a)(1), AIPLA believes that an offer for sale needs to be public to qualify as “on sale” prior art under §102(a)(1). As noted in footnote 29 of the proposed Guidelines, AIA §102(a)(1), unlike pre-AIA 35 U.S.C. §102(b), contains the residual clause “or otherwise available to the public.” This is a major policy change achieved by the new legislation, which would further the goal of increasing objectivity in the identification of prior art.

Further, as noted in footnote 29, the legislative history of the AIA indicates that the inclusion of this clause in §102(a)(1) should be viewed as indicating that §102(a)(1) does not cover non-public uses or non-public offers for sale. AIPLA believes that such an interpretation reflects the clear intent of Congress. See Remarks of Senator Kyl, Congressional Record, September 6, 2012, page S5320, center column. It is also consistent with the broad goal of global harmonization under a first-inventor-to-file system.

In addition, the effect of adding the words ‘or otherwise available to the public’ is confirmed by judicial construction of this phraseology where the courts have consistently found that when the words “or otherwise” or “or other” are used as a modifier at the end of a string of clauses, they restrict the meaning of the preceding clauses.

Finally, AIPLA believes that maintaining the current interpretation that a sale need not be available to the public would present practical difficulties that may not be able to be overcome. As already mentioned, the ability to find such activities during prior art searches is doubtful. This would pose significant burdens on patent holders in the context of challenges to the patent during post-grant proceedings.

Translation of Priority Documents

The Request, 77 Fed. Reg. at 43768, col. 2, makes a distinction between actually being entitled to priority to, or the benefit of, a prior-filed application, and merely being entitled to claim priority to, or the benefit of, a prior-filed application. It does not make clear, however, how the Office will apply prior art which claims the benefit of a foreign application which may not be in the English language. The burden to establish a proper basis for a rejection remains with the Office. In other words, it is the examiner’s burden to establish that the foreign priority application that is the subject of the priority claim actually supports the subject matter in the U.S. published application or U.S. patent that is being relied upon to establish a prima facie rejection of claims in another U.S. application having an effective filing date prior to the U.S. published application or patent relied upon, but later than the foreign priority application.

To the extent possible, the Office should utilize machine translations to identify subject matter in a priority document that is being relied upon to support a rejection. The applicant may provide a certified translation to prove that a machine translation is inaccurate and that the purported support does not exist.

REFERENCE TRAINING MATERIALS

It would be helpful if the guidance materials address specific fact patterns that applicants and examiners are likely to encounter. The following is a non-exhaustive list of exemplary fact patterns to consider. They have been designed to highlight different fact patterns that might arise in determining the applicability of various provisions of the AIA.

In particular, it would be useful to establish reference training materials with specific fact patterns such as those presented below to help understand which version of 35 USC §102 (pre- or post-AIA) applies and how different factual situations affect patentability determinations. Answers to the questions for the fact patterns presented below might be impacted by use of the patent prosecution highway (PPH), and other forms of accelerated examination. Clarification of any such impact is also requested.

For the purposes of the fact patterns presented below, the following abbreviations are used to designate the type of application:

- P – Provisional application
- NP – Regular (non-provisional) U.S. patent application
- CON - Continuation under 35 U.S.C. §120
- DIV – Divisional application filed under 35 U.S.C. §121
- CIP – Continuation-in-part application filed under 35 U.S.C. §121
- PCT – International application filed under the PCT
- 371 – National stage of a PCT filed in the U.S.
- FOR – Foreign patent filing priority document
- DIS – Disclosure by inventive entity or another as specified
- Prior Art – Prior Art used in a rejection under 35 U.S.C. §102(a) or §103

The training materials should, where appropriate, be developed to include sufficient details regarding what is claimed and what was published, since differences (i.e., whether they are identical or different) can affect the outcome.

Fact Patterns

For each of the fact patterns where the patent application is examined on or after March 16, 2013, answers to the following questions would be useful:

- A. What is the presumptive effective filing date/prior art date for examination purposes?**
- B. What law applies (i.e., pre/post AIA 35 U.S.C. §102), and what subsection(s) of the selected law might apply (including the applicability of pre-AIA §102(g) to any claim where post AIA 35 U.S.C. §102 applies)?**

(The following is one suggested format for the training materials. In these exemplars, fact patterns are numbered consecutively. The graphic timelines show the application type above the line and the application's actual filing date below the line. The Office would insert the **answer** in the blank space appearing in the tables below and add explanations as desired.)

Fact Pattern #1: Establishment of *prima facie* filing date

- “Y” files a NP application on 3/16/2012:



Answer:

A.	The presumptive filing date for the claims in this application is _____.
B.	Prior art that qualifies under _____ (<i>pre- or post- AIA</i>) applies to the claims in this application.

Fact Pattern #2: Establishment of *prima facie* filing date

- “Y” files a NP application on 3/16/2013:



Answer:

A.	The presumptive filing date for the claims in this application is _____.
B.	Prior art that qualifies under _____ (<i>pre- or post- AIA?</i>) applies to the claims in this application.

Fact Pattern #3: Continuing application

- “Y” files a CON application under 35 U.S.C. §120 on 3/16/13 claiming priority to an earlier filed NP application filed on 10/7/11. The claims and disclosure are identical in both the CON and NP.



Answer:

A.	The presumptive filing date for the claims in the CON application is _____.
	The presumptive filing date for the claims in the NP application is _____.
B.	Prior art that qualifies under _____ (<i>pre- or post- AIA</i>) applies to the claims in the CON application.
	Prior art that qualifies under _____ (<i>pre- or post- AIA</i>) applies to the claims in the NP application.

Variations

- a. At least one as-filed claim in the CON has been changed, but the Descriptions are the same in both the CON and NP.
- b. The as-filed claims in the CON and NP are identical but the text of the Description has been changed.
 - i. The change to the Description **does not affect** compliance with 35 U.S.C. §112 (i.e. the claims in the CON are fully supported by the NP’s Description).
 - ii. The change to the Description **affects** compliance with 35 U.S.C. §112 (i.e. the claims in the CON are **not** fully supported by the NP’s Description).
 - iii. Do the answers change if claims are **added or amended** after the CON’s actual filing date?

Fact Pattern #4: Continuing application

- “Y” files a CON application under 35 U.S.C. §120 on 3/16/13 claiming priority to an earlier filed NP application filed on 10/7/11. **A new claim is added in the CON that is withdrawn by the examiner via restriction.**



Answer:

A.	The presumptive filing date for the claims in the CON application is _____.
	The presumptive filing date for the claims in the NP application is _____.
B.	Prior art that qualifies under _____ (<i>pre- or post- AIA</i>) applies to the claims in the CON application.
	Prior art that qualifies under _____ (<i>pre- or post- AIA</i>) applies to the claims in the NP application.

Variations

- a. The as-filed claims in the CON **being examined after restriction** are the same as in NP.
- b. At least one as-filed claim in the CON is new as compared to any claim in NP, but any new claim(s) is withdrawn by the examiner via restriction. The change to the Description **does not affect** compliance with 35 U.S.C. §112 (i.e. the claims in the CON are fully supported by the NP’s Description).
- c. At least one as-filed claim in the CON is new as compared to any claim in NP, but any new claim(s) is withdrawn by the examiner via restriction. The change to the Description **affects** compliance with 35 U.S.C. §112 (i.e. the claims in the CON are **not** fully supported by the NP’s Description).
 - i. Does the determination of applicable law (pre-/post-AIA) change if at least one as-filed claim in the CON application under examination is found to lack 35 U.S.C. §112 support, even though that claim is withdrawn?
 - ii. Does the answer in (c) change if claims are further added or amended after the CON’s actual filing date?

Fact Pattern #5: CIP Application

- “Y” files a CIP application under 35 U.S.C. §120 on 3/16/13 claiming priority to an earlier filed NP application filed on 10/17/11:



Answer:

A.	The presumptive filing date for the claims in the CIP application is _____.
	The presumptive filing date for the claims in the NP application is _____.
B.	Prior art that qualifies under _____ (<i>pre- or post- AIA</i>) applies to the claims in the CIP application.
	Prior art that qualifies under _____ (<i>pre- or post- AIA</i>) applies to the claims in the NP application.

Variations:

- a. The CIP has an amended Description. The as-filed CIP claims are the **same** as those in the NP. The change to the Description **does not affect** compliance with 35 U.S.C. §112 (i.e. the claims in the CIP are fully supported by the NP’s Description).
- b. The CIP has an amended Description. The as-filed CIP claims are the **same** as those in the NP. The change to the Description **affects** compliance with 35 U.S.C. §112 (i.e. the claims in the CIP are **not** fully supported by the NP’s Description).

- c. The CIP has an amended Description. The as-filed CIP claims include **at least one additional/amended claim** as compared to the NP, but also maintains at least one claim as it was filed in the NP. The change to the Description **does not affect** compliance with 35 U.S.C. §112 (i.e. the claims in the CIP are fully supported by the NP’s Description).
- d. The CIP has an amended description. The as-filed CIP claims include **at least one additional/amended claim** as compared to the NP, but also maintains at least one claim as it was filed in the NP. The change to the Description **affects** compliance with 35 U.S.C. §112 (i.e. the claims in the CIP are **not** fully supported by the NP’s Description).
- e. The CIP has an amended description. The as-filed CIP claims are **new claims** as compared to the NP. These amendments do not create any substantive issues under 35 U.S.C. §112.
- f. The CIP has an amended description. The as-filed CIP claims are new claims as compared to the NP. The change to the Description **affects** compliance with 35 U.S.C. §112 (i.e. the claims in the CIP are **not** fully supported by the NP’s Description).

Fact Pattern #6: Effective Filing date that relies upon a provisional application

- “Y” files a NP application on 3/16/2013 claiming priority to a P application filed on 3/16/2012:



Answer:

A.	The presumptive filing date for the claims in the NP application is _____.
B.	Prior art that qualifies under _____ (<i>pre- or post- AIA</i>) applies to the claims in the NP application.

Variations:

- a. The NP Description and claims are **identical** to those in the P.
- b. The NP Description is identical to that in the P. At least one claim has been **added** as compared to the P (or the P was filed without claims).
- c. The NP Description has been changed relative to that in the P. At least one claim has been **added** as compared to the P (or the P was filed without claims). The change to the Description **does not affect** compliance with 35 U.S.C. §112 (i.e. the claims in the NP are fully supported by the P’s Description).
- d. The NP Description has been changed relative to that in the P. At least one claim has been **added** as compared to the P (or the P was filed without claims). The

change to the Description **affects** compliance with 35 U.S.C. §112 (i.e. the claims in the NP are **not** fully supported by the P’s Description).

- e. The NP has an **amended description**. The as-filed NP claims are the same as those in the P (or the P was filed without claims). The change to the Description **does not affect** compliance with 35 U.S.C. §112 (i.e. the claims in the NP are fully supported by the P’s Description).
- f. The NP has an **amended description**. The as-filed NP claims include at least one additional/amended claim but also maintains at least one claim in the earlier filed P (or the P was filed without claims). The change to the Description **affects** compliance with 35 U.S.C. §112 (i.e. the claims in the NP are **not** fully supported by the P’s Description).
- g. The NP has an **amended description** that creates issues under 35 U.S.C. §112. The as-filed NP claims were not present in the earlier filed.

Fact Pattern #7: Patent Cooperation Treaty (PCT)/International Application

- “Y” files an international application under the PCT on 3/16/2013 and the examiner is preparing an international Search Report or Written Opinion:

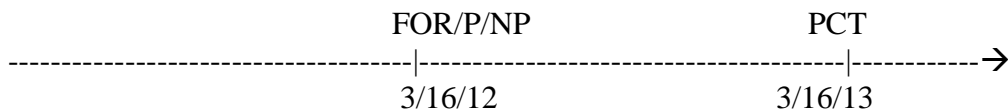


Answer:

A.	The presumptive filing date for the claims in the PCT application is _____.
B.	Prior art that qualifies under _____ (<i>pre- or post- AIA</i>) applies to the claims in the PCT application.

Fact Pattern #8: PCT with priority claim

- “Y” files an international application under the PCT on 3/16/2013 claiming priority to a FOR/P/NP application filed on 3/16/2012, and the Examiner is preparing an International Search Report or Written Opinion:



Answer:

A.	The presumptive filing date for the claims in the PCT application is _____.
B.	Prior art that qualifies under _____ (<i>pre- or post- AIA</i>) applies to the claims in the PCT application.

Variations

- a. Claims and description in the PCT are the same as in the parent document (FOR/P/NP).
- b. The PCT has an **amended Description**. The as-filed PCT claims are the same as those in the parent document (FOR/P/NP). The amended Description does **not** create any substantive written description issues under PCT Rule 5 (i.e. the claims **are fully supported** by the Description in the FOR/P/NP).
- c. The PCT has an **amended Description**. The as-filed PCT claims are the same as those in the earlier filed parent document (FOR/P/NP). The amended Description **creates** substantive written description issues under PCT Rule 5 (i.e. the claims are **not** supported by the Description in the FOR/P/NP).
- d. The PCT has an **amended Description**. The as-filed PCT claims include at least one additional/amended claim from that in the earlier filed priority document (FOR/P/NP). The amended Description does **not** create any substantive written description issues under PCT Rule 5 (i.e. the claims **are fully supported** by the Description in the FOR/P/NP).
- e. The PCT has an **amended Description**. The as-filed PCT claims include at least one additional/amended claim from that in the parent document (FOR/P/NP). The amended Description **creates** substantive written description issues under PCT Rule 5 (i.e. the claims are **not** supported by the Description in the FOR/P/NP).

Fact Pattern #9: National Stage Filing under 35 U.S.C. §371

- “Y” files an international application under the PCT on 11/4/2011 and enters the U.S. national stage under 35 U.S.C. §371 on 3/16/2013:

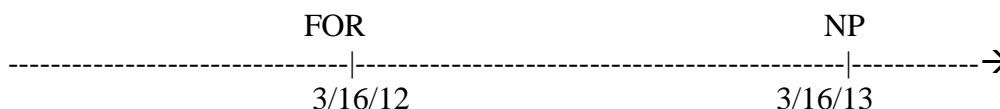


Answer:

A.	The presumptive filing date for the claims in the 371 application is _____.
B.	Prior art that qualifies under _____ (<i>pre- or post- AIA</i>) applies to the claims in the 371 application.

Fact Pattern #10: Foreign Priority

- “Y” files a NP application on 3/16/2013 claiming priority to a FOR patent application filed in a Paris Convention country on 3/16/2012:



Answer:

A.	The presumptive filing date for the claims in the NP application is _____.
B.	Prior art that qualifies under _____ (<i>pre- or post- AIA</i>) applies to the claims in the NP application.

Variations:

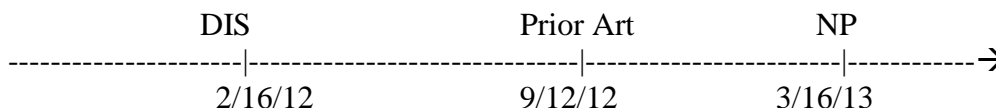
- a. Claims and Description in the NP are the **same** as in the FOR priority document.
- b. The NP has an **amended Description**. The as-filed NP claims are the same as those in the FOR priority document. The change to the Description **does not affect** compliance with 35 U.S.C. §112 (i.e. the claims in the NP are **fully** supported by the **FOR**'s Description).
- c. The NP has an **amended Description**. The as-filed NP claims are the same as those in the FOR priority document. The change to the Description **affects** compliance with 35 U.S.C. §112 (i.e. the claims in the NP are **not** fully supported by the **FOR**'s Description).
- d. The NP has an **amended Description**. The as-filed NP claims include one or more additional/amended claims and at least one claim present in the FOR priority document. The change to the Description **does not affect** compliance with 35 U.S.C. §112 (i.e. the claims in the NP are **fully** supported by the **FOR**'s Description).
- e. The NP has an **amended Description**. The as-filed NP claims include at least one additional/amended claim that vary from those in the FOR priority document. The change to the Description **affects** compliance with 35 U.S.C. §112 (i.e. the claims in the NP are **not** fully supported by the **FOR**'s Description).
- f. The NP has an **amended description** but **no** substantive *subject matter* additions affecting compliance with 35 U.S.C. §112. The as-filed NP claims are **identical** to those in the **FOR** priority document.

NOTE: Fact Patterns 11-14 address prior disclosures by applicant and add the following questions:

- C. Is applicant's disclosure sufficient to disqualify the prior art cited in the fact pattern (Y/N)?
- D. If the answer to (C) is 'no,' why not?

Fact Pattern #11: Applicant response, prior disclosure

- "Y" files a NP application on 3/16/2013 and a rejection has been made using prior art dated 9/12/2012. In response to the rejection, "Y" asserts that the inventor(s) made a disclosure (DIS) on 2/16/2012 and an exception under 35 U.S.C. §102(b)(1)(B) and/or (2)(B) applies that disqualifies the Prior Art:

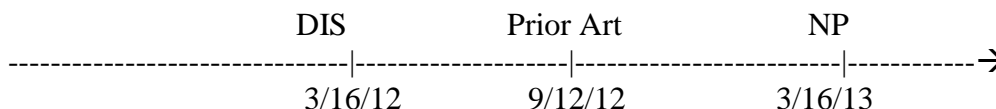


Answer:

A.	The presumptive filing date for the claims in the NP application is _____.
B.	Prior art that qualifies under _____ (<i>pre- or post- AIA</i>) applies to the claims in the NP application.
C.	Is applicant’s disclosure sufficient to disqualify the prior art cited in the fact pattern (Y/N)?
D.	If the answer to C is ‘no,’ why not?

Fact Pattern #12: Applicant response, prior disclosure

- “Y” files a NP application on 3/16/2013 and a rejection has been made using prior art dated 9/12/2012. In response to the rejection, “Y” asserts that the inventor(s) made a disclosure (DIS) on 3/16/2012 and an exception under 35 U.S.C. §102(b)(1)(B) and/or (2)(B) applies that disqualifies the Prior Art:

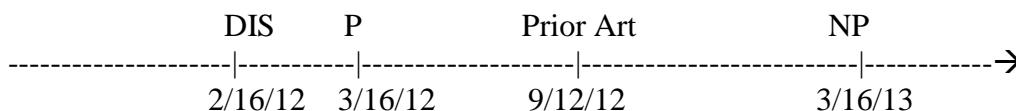


Answer:

A.	The presumptive filing date for the claims in the NP application is _____.
B.	Prior art that qualifies under _____ (<i>pre- or post- AIA</i>) applies to the claims in the NP application.
C.	Is applicant’s disclosure sufficient to disqualify the prior art cited in the fact pattern (Y/N)?
D.	If the answer to C is ‘no,’ why not?

Fact Pattern #13: Applicant response, prior disclosure before priority date

- “Y” files a NP application on 3/16/2013 claiming priority to a P filed on 3/16/12. A rejection has been made using prior art dated 9/12/2012. In response to the rejection, “Y” asserts that the inventor(s) made a disclosure (DIS) on 2/16/2012 and asserts an exception under 35 U.S.C. §102(b)(1)(B) and/or (2)(B) applies that disqualifies the Prior Art:

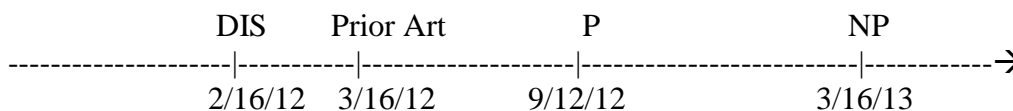


Answer:

A.	The presumptive filing date for the claims in the NP application is _____.
B.	Prior art that qualifies under _____ (<i>pre- or post- AIA</i>) applies to the claims in the NP application.
C.	Is applicant’s disclosure sufficient to disqualify the prior art cited in the fact pattern (Y/N)?
D.	If the answer to C is ‘no,’ why not?

Fact Pattern #14: Applicant response, prior disclosure before priority date

- “Y” files a NP application on 3/16/2013 claiming priority to a P filed on 9/12/12. A rejection has been made using prior art dated 3/12/2012. In response to the rejection, “Y” asserts that the inventor(s) made a disclosure (DIS) on 2/16/2012 and asserts an exception under 35 U.S.C. §102(b)(1)(B) and/or (2)(B) applies that disqualifies the Prior Art:



Answer:

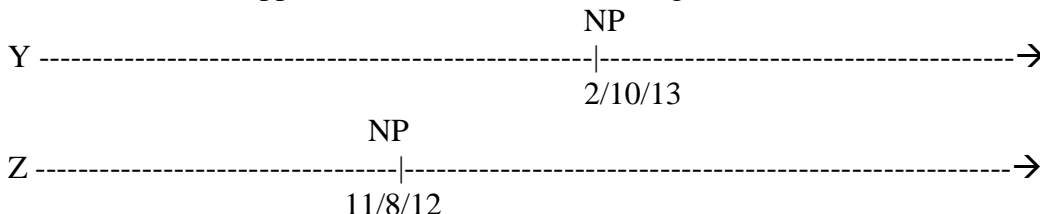
A.	The presumptive filing date for the claims in the NP application is _____.
B.	Prior art that qualifies under _____ (<i>pre- or post- AIA</i>) applies to the claims in the NP application.
C.	Is applicant’s disclosure sufficient to disqualify the prior art cited in the fact pattern (Y/N)?
D.	If the answer to C is ‘no,’ why not?

NOTE: Fact Patterns 15-23 address conflicting patent applications and add the following questions:

- E. What sections of 35 U.S.C. §102 apply?**
- F. Which party (A or B) has the *prima facie* priority to a patent?**
- G. Would interference, derivation, or other proceedings apply?**
- H. If “A’s” and “B’s” applications are commonly owned or subject to obligation of assignment on or before the effective filing date of both applications, do the answers to any of questions change (Y/N)? If yes, how?**

Fact Pattern #15: Pre-AIA filings

- “Y” files a NP application on 2/10/2013 claiming invention I
- “Z” files a NP application on 11/8/2012 claiming invention I

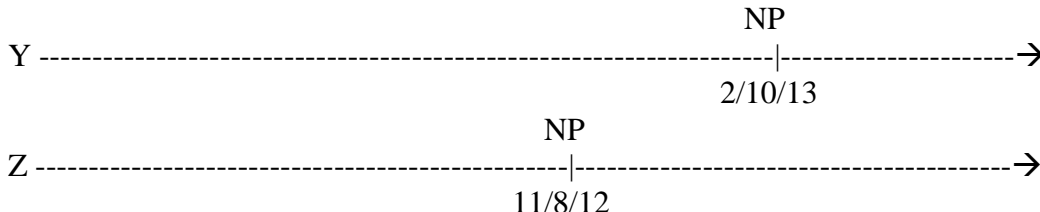


Answer:

A.	The presumptive filing date for the claims in the <u>Y</u> 's NP application is _____.
	The presumptive filing date for the claims in the <u>Z</u> 's NP application is _____.
B.	Prior art that qualifies under _____ (<i>pre- or post- AIA</i>) applies to the claims in <u>Y</u> 's NP application.
	Prior art that qualifies under _____ (<i>pre- or post- AIA</i>) applies to the claims in <u>Z</u> 's NP application.
E.	What sections of 35 U.S.C. §102 apply to Y's application? _____
	What sections of 35 U.S.C. §102 apply to Z's application? _____
F.	Which Party (Y or Z) has the <i>prima facie</i> priority to a patent?
G.	Would interference, derivation, or other proceedings apply?
H.	If “Y’s” and “Z’s” applications are commonly owned or subject to obligation of assignment on or before the effective filing date of both applications, do the answers to any of questions change (Y/N)? If yes, how?

Fact Pattern #16: Pre-AIA filings

- “Y” files a NP application on 2/10/2013 claiming invention I
- “Z” files a NP application on 11/8/2012 disclosing but not claiming invention I

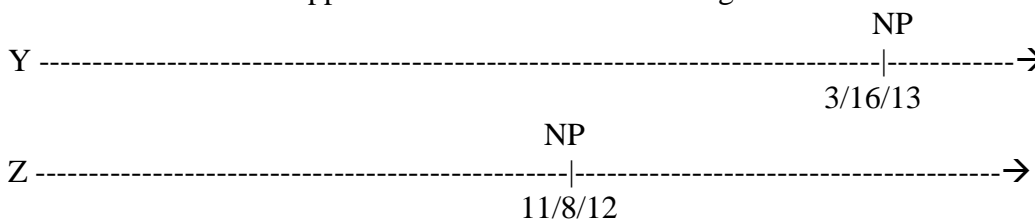


Answer:

A.	The presumptive filing date for the claims in the <u>Y</u> 's NP application is _____.
	The presumptive filing date for the claims in the <u>Z</u> 's NP application is _____.
B.	Prior art that qualifies under _____ (<i>pre- or post- AIA</i>) applies to the claims in <u>Y</u> 's NP application.
	Prior art that qualifies under _____ (<i>pre- or post- AIA</i>) applies to the claims in <u>Z</u> 's NP application.
E.	What sections of 35 U.S.C. §102 apply to Y's application? _____
	What sections of 35 U.S.C. §102 apply to Z's application? _____
F.	Which Party (Y or Z) has the <i>prima facie</i> priority to a patent?
G.	Would interference, derivation, or other proceedings apply?
H.	If "Y's" and "Z's" applications are commonly owned or subject to obligation of assignment on or before the effective filing date of both applications, do the answers to any of questions change (Y/N)? If yes, how?

Fact Pattern #17: Pre- and Post- AIA filings

- "Y" files a NP application on 3/16/2013 claiming invention I
- "Z" files a NP application on 11/8/2012 claiming invention I

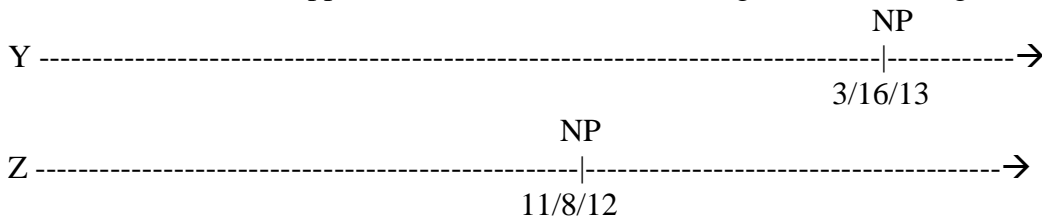


Answer:

A.	The presumptive filing date for the claims in the <u>Y</u> 's NP application is _____.
	The presumptive filing date for the claims in the <u>Z</u> 's NP application is _____.
B.	Prior art that qualifies under _____ (<i>pre- or post- AIA</i>) applies to the claims in <u>Y</u> 's NP application.
	Prior art that qualifies under _____ (<i>pre- or post- AIA</i>) applies to the claims in <u>Z</u> 's NP application.
E.	What sections of 35 U.S.C. §102 apply to Y's application? _____
	What sections of 35 U.S.C. §102 apply to Z's application? _____
F.	Which Party (Y or Z) has the <i>prima facie</i> priority to a patent?
G.	Would interference, derivation, or other proceedings apply?
H.	If "Y's" and "Z's" applications are commonly owned or subject to obligation of assignment on or before the effective filing date of both applications, do the answers to any of questions change (Y/N)? If yes, how?

Fact Pattern #18: Pre- and Post- AIA filings

- “Y” files a NP application on 3/16/2013 claiming invention I
- “Z” files a NP application on 11/8/2012 disclosing but not claiming invention I



Answer:

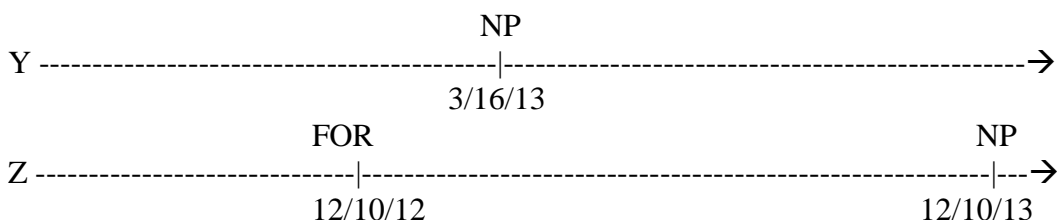
A.	The presumptive filing date for the claims in the Y’s NP application is _____.
	The presumptive filing date for the claims in the Z’s NP application is _____.
B.	Prior art that qualifies under _____ (pre- or post- AIA) applies to the claims in Y’s NP application.
	Prior art that qualifies under _____ (pre- or post- AIA) applies to the claims in Z’s NP application.
E.	What sections of 35 U.S.C. §102 apply to Y’s application? _____
	What sections of 35 U.S.C. §102 apply to Z’s application? _____
F.	Which Party (Y or Z) has the prima facie priority to a patent?
G.	Would interference, derivation, or other proceedings apply?
H.	If “Y’s” and “Z’s” applications are commonly owned or subject to obligation of assignment on or before the effective filing date of both applications, do the answers to any of questions change (Y/N)? If yes, how?

Fact Pattern #19: Common assignment/ownership

- Do the answers to Scenarios 15-19 above change if both “Y’s” and “Z’s” applications are commonly owned or subject to obligation of assignment on or before the effective filing date of both applications?

Fact Pattern #20: Post-AIA filings with Pre-AIA priority

- “Y” files a NP application on 3/16/2013 claiming invention I
- “Z” files a NP application on 12/10/2013 claiming priority to a foreign (FOR) patent application filed under the Paris Convention on 12/10/2012. Invention I is claimed in “Z’s” NP.



Answer:

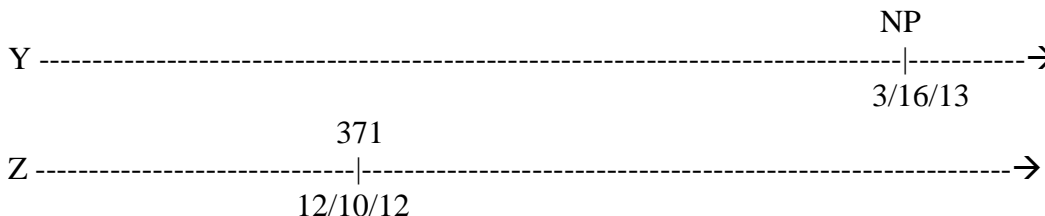
A.	The presumptive filing date for the claims in the Y's NP application is _____.
	The presumptive filing date for the claims in the Z's NP application is _____.
B.	Prior art that qualifies under _____ (pre- or post- AIA) applies to the claims in Y's NP application.
	Prior art that qualifies under _____ (pre- or post- AIA) applies to the claims in Z's NP application.
E.	What sections of 35 U.S.C. §102 apply to Y's application? _____
	What sections of 35 U.S.C. §102 apply to Z's application? _____
F.	Which Party (Y or Z) has the prima facie priority to a patent?
G.	Would interference, derivation, or other proceedings apply?
H.	If "Y's" and "Z's" applications are commonly owned or subject to obligation of assignment on or before the effective filing date of both applications, do the answers to any of questions change (Y/N)? If yes, how?

Variations:

- a. The "Z" NP has an amended Description. The change to the Description **does not affect** compliance with 35 U.S.C. §112 (i.e. the claims in the NP are fully supported by the **FOR's** Description). The as-filed claims in "Z's" NP are the same as those in the "Z's" **FOR** priority document.
- b. The "Z" NP has an amended Description. The change to the Description **affects** compliance with 35 U.S.C. §112 (i.e. the claims in the NP are **not** supported by the **FOR's** Description that creates issues under 35 U.S.C. §112). The as-filed claims in "Z's" NP are identical to those in "B's" **FOR** priority document.
- c. The "Z" NP has an amended Description. The change to the Description **affects** compliance with 35 U.S.C. §112 (i.e. the claims in the NP are **not** supported by the **FOR's** Description). The as-filed claims in "Z's" NP include at least one additional/amended claim and at least one claim present in the **FOR** priority document.
- d. The "Z" NP has an amended description that creates issues under 35 U.S.C. §112. The as-filed NP claims were **not** present in the **FOR** priority document.

Fact Pattern #21: Post-AIA filings with Pre-AIA priority—International Application

- “Y” files a Non-Provisional (NP) application on 3/16/2013 claiming invention I
- “Z” enters the national stage of a international application under 35 U.S.C. §371 application filed on 12/10/2012 continuing to claim invention I

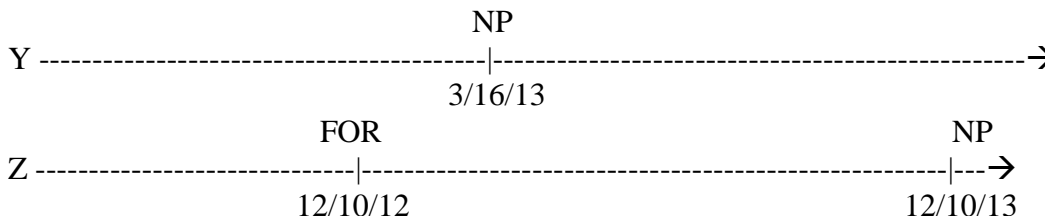


Answer:

A.	The presumptive filing date for the claims in the Y’s NP application is _____.
	The presumptive filing date for the claims in the Z’s NP application is _____.
B.	Prior art that qualifies under _____ (pre- or post- AIA) applies to the claims in Y’s NP application.
	Prior art that qualifies under _____ (pre- or post- AIA) applies to the claims in Z’s NP application.
E.	What sections of 35 U.S.C. §102 apply to Y’s application? _____
	What sections of 35 U.S.C. §102 apply to Z’s application? _____
F.	Which Party (Y or Z) has the prima facie priority to a patent?
G.	Would interference, derivation, or other proceedings apply?
H.	If “Y’s” and “Z’s” applications are commonly owned or subject to obligation of assignment on or before the effective filing date of both applications, do the answers to any of questions change (Y/N)? If yes, how?

Fact Pattern #22: Post-AIA filings with Pre-AIA priority

- “Y” files a Non-Provisional (NP) application on 3/16/2013 claiming invention I
- “Z” files a Non-Provisional (NP) application on 12/10/2013 claiming priority to a foreign (FOR) patent application filed under the Paris Convention on 12/10/2012. Invention I is claimed in “Z’s” NP.



Answer:

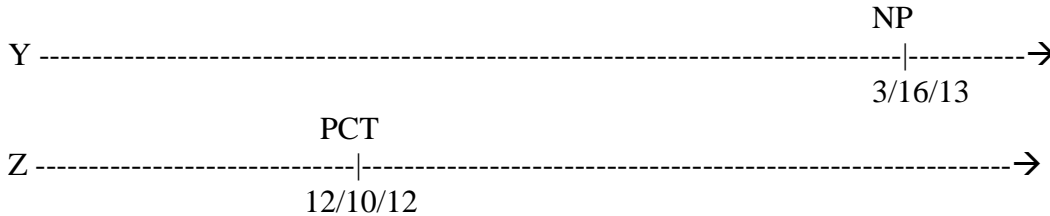
A.	The presumptive filing date for the claims in the Y's NP application is _____.
	The presumptive filing date for the claims in the Z's NP application is _____.
B.	Prior art that qualifies under _____ (pre- or post- AIA) applies to the claims in Y's NP application.
	Prior art that qualifies under _____ (pre- or post- AIA) applies to the claims in Z's NP application.
E.	What sections of 35 U.S.C. §102 apply to Y's application? _____
	What sections of 35 U.S.C. §102 apply to Z's application? _____
F.	Which Party (Y or Z) has the prima facie priority to a patent?
G.	Would interference, derivation, or other proceedings apply?
H.	If "Y's" and "Z's" applications are commonly owned or subject to obligation of assignment on or before the effective filing date of both applications, do the answers to any of questions change (Y/N)? If yes, how?

Variations:

- a. The "Z" NP has an amended Description. The change to the Description **does not affect** compliance with 35 U.S.C. §112 (i.e. the claims in the NP are fully supported by the FOR's Description). The as-filed claims in "Z's" NP are the same as those in the "Z's" FOR priority document.
- b. The "Z" NP has an amended Description. The change to the Description **affects** compliance with 35 U.S.C. §112 (i.e. the claims in the NP are **not** supported by the FOR's Description). The as-filed claims in "Z's" NP are the same as those in the "Z's" FOR priority document.
- c. The "Z" NP has an amended Description. The change to the Description **affects** compliance with 35 U.S.C. §112 (i.e. the claims in the NP are **not** supported by the FOR's Description). The as-filed NP claims include at least one additional/amended claim and at least one claim present in "Z's" FOR priority document.
- d. The "Z" NP has an amended Description. The change to the Description **affects** compliance with 35 U.S.C. §112 (i.e. the claims in the NP are **not** supported by the FOR's Description). The as-filed NP claims include at least one additional/amended claim and at least one claim present in "Z's" FOR priority document. The as-filed NP claims were not present in the FOR priority document.

Fact Pattern #23: Post-AIA filings with Pre-AIA priority—International Application

- “Y” files a Non-Provisional (NP) application on 3/16/2013 claiming invention I
- “Z” enters the national stage of a international application under 35 U.S.C. §371 application filed on 12/10/2012 continuing to claim invention I



Answer:

A.	The presumptive filing date for the claims in the Y’s NP application is _____.
	The presumptive filing date for the claims in the Z’s NP application is _____.
B.	Prior art that qualifies under _____ (pre- or post- AIA) applies to the claims in Y’s NP application.
	Prior art that qualifies under _____ (pre- or post- AIA) applies to the claims in Z’s NP application.
E.	What sections of 35 U.S.C. §102 apply to Y’s application? _____
	What sections of 35 U.S.C. §102 apply to Z’s application? _____
F.	Which Party (Y or Z) has the prima facie priority to a patent?
G.	Would interference, derivation, or other proceedings apply?
H.	If “Y’s” and “Z’s” applications are commonly owned or subject to obligation of assignment on or before the effective filing date of both applications, do the answers to any of questions change (Y/N)? If yes, how?

Thank you for providing AIPLA the opportunity to comment on this important initiative. We look forward to further discussions with the USPTO in finding solutions and defining programs to maintain and enhance the USPTO’s mission.

Sincerely,

William G. Barber
 AIPLA President