



# **AMERICA INVENTS ACT**

## IMPLEMENTATION

# **FITF Overview and Tips on Responding to Prior Art Rejections**

**Biotechnology/Chemical/Pharmaceutical  
Customer Partnership Meeting  
United States Patent and Trademark Office  
April 16, 2014**

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Office of Patent Legal Administration**

# Overview

- Review of first-inventor-to-file (FITF) statutory framework
- Sample FITF scenarios with audience polling



# Potential Prior Art Is Identified in 35 U.S.C. 102(a)(1) and 102(a)(2)

Only two subsections of the AIA identify potential prior art:

- **102(a)(1)** is for **public disclosures** that have a public availability date *before the effective filing date* of the claimed invention under examination.
- **102(a)(2)** is for issued or published **U.S. patent documents** that are by another and that have an effectively filed date that is *before the effective filing date* of the claimed invention under examination.



# Effective Filing Date under the AIA

- The availability of a disclosure as prior art under 102(a)(1) or 102(a)(2) depends upon the effective filing date (EFD) of the claimed invention.
- Unlike pre-AIA law, the AIA provides that a foreign priority date can be the effective filing date of a claimed invention.
- **During examination, the foreign priority date is treated as the effective filing date of the claimed invention IF**
  - the foreign application supports the claimed invention under 112(a), AND
  - the applicant has perfected the right of priority by providing:
    - a certified copy of the priority application, and
    - a translation of the priority application (if not in English).



# AlA Statutory Framework

<b>Prior Art</b> <b>35 U.S.C. 102(a)</b> <b>(Basis for Rejection)</b>	<b>Exceptions</b> <b>35 U.S.C. 102(b)</b> <b>(Not Basis for Rejection)</b>	
<b>102(a)(1)</b> Disclosure with Prior Public Availability Date	<b>102(b)(1)</b>	<b>(A)</b> Grace Period Disclosure by Inventor or Obtained from Inventor
		<b>(B)</b> Grace Period Intervening Disclosure by Third Party
<b>102(a)(2)</b> U.S. Patent, Published U.S. Patent Application, and Published PCT Application with Prior Filing Date	<b>102(b)(2)</b>	<b>(A)</b> Disclosure Obtained from Inventor
		<b>(B)</b> Intervening Disclosure by Third Party
		<b>(C)</b> Commonly Owned Disclosures

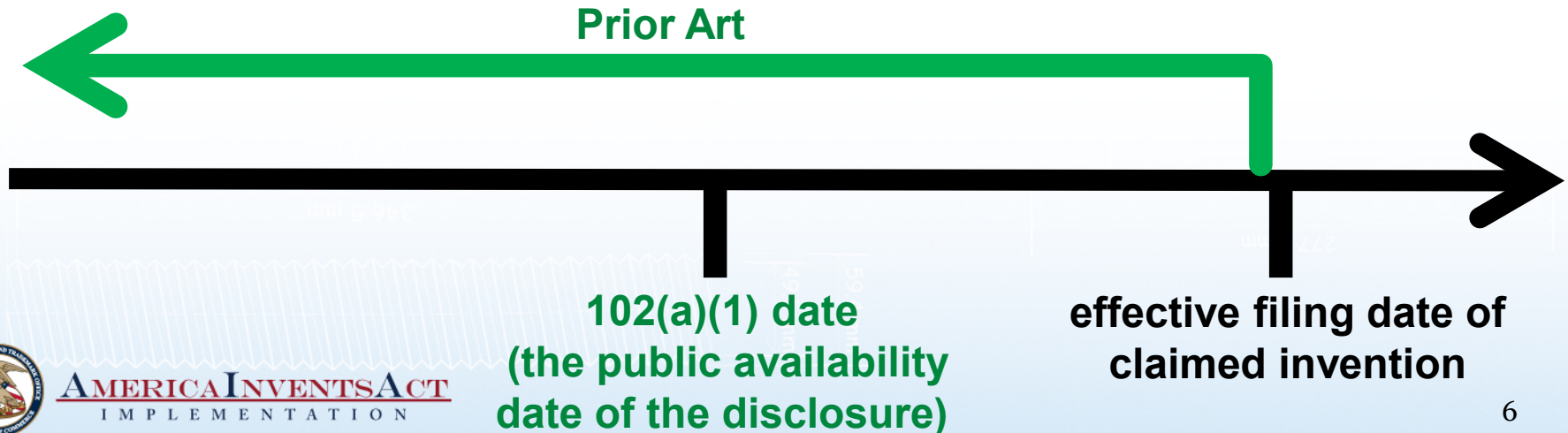


## 35 U.S.C. 102(a)(1):

# Public Disclosure with Public Availability Date before the Effective Filing Date of the Claimed Invention

102(a)(1) potential prior art includes **public disclosures** that have a public availability date before the effective filing date of the claimed invention and are:

- patented;
- described in a printed publication;
- in public use;
- on sale; or
- otherwise available to the public.



# 102(b)(1)(A) Exception to Potential Prior Art under 35 U.S.C. 102(a)(1)

For the 102(b)(1)(A) exception to apply to a public disclosure under 102(a)(1), the public disclosure must be:

- within the grace period and
- an "inventor-originated disclosure" (i.e., the subject matter in the public disclosure must be attributable to the inventor, one or more co-inventors, or another who obtained the subject matter directly or indirectly from the inventor or a co-inventor).



# 102(b)(1)(B) Exception to Potential Prior Art under 35 U.S.C. 102(a)(1)

For the 102(b)(1)(B) exception to apply to a third party's disclosure under 102(a)(1):

- the third party's disclosure must have been made during the grace period of the claimed invention,
- an inventor-originated disclosure (i.e., shielding disclosure) must have been made prior to the third party's disclosure, and
- both the third party's disclosure and the inventor-originated disclosure must have disclosed the same subject matter.





# Recognizing a 102(b)(1)(A) or 102(b)(1)(B) Exception to a Potential 102(a)(1) Reference

An exception under 102(b)(1)(A) or 102(b)(1)(B) may apply when:

- the authorship/inventorship of the potential reference disclosure only includes one or more joint inventor(s) or the entire inventive entity of the application under examination, or
- there is an appropriate affidavit or declaration under 37 CFR 1.130(a) (attribution) or 1.130(b) (prior public disclosure), or
- the specification of the application under examination identifies the potential prior art disclosure as having been made by or having originated from one or more members of the inventive entity, in accordance with 37 CFR 1.77(b)(6).

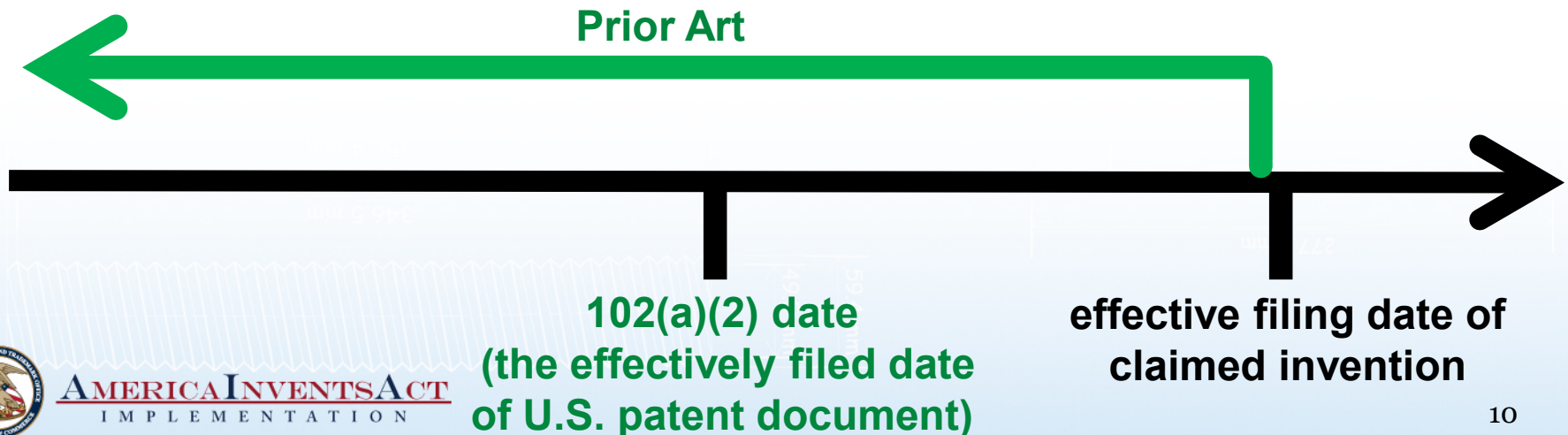


## 35 U.S.C. 102(a)(2):

# U.S. Patent Documents with Effectively Filed Date before Effective Filing Date of the Claimed Invention

102(a)(2) potential prior art includes issued or published U.S. patent documents that name another inventor and have an effectively filed date before the effective filing date of the claimed invention:

- U.S. Patent;
- U.S. Patent Application Publication; or
- WIPO published PCT (international) application that designates the United States



# 102(b)(2)(A) Exception to Potential Prior Art under 35 U.S.C. 102(a)(2)

For the 102(b)(2)(A) exception to apply to a potential prior art U.S. patent document, the U.S. patent document must:

- disclose subject matter that was obtained from one or more members of the inventive entity, either directly or indirectly.



# 102(b)(2)(B) Exception to Potential Prior Art under 35 U.S.C. 102(a)(2)

For the 102(b)(2)(B) exception to apply to a third party's potential prior art U.S. patent document:

- the third party's U.S. patent document must have been effectively filed before the effective filing date of the claimed invention,
- an inventor-originated disclosure (i.e., shielding disclosure) must have been made prior to the effectively filed date of the third party's U.S. patent document, and
- both the third party's U.S. patent document and the inventor-originated disclosure must have disclosed the same subject matter.



# Recognizing a 102(b)(2)(A) or 102(b)(2)(B) Exception to a Potential 102(a)(2) Reference

An exception under 102(b)(2)(A) or 102(b)(2)(B) may apply when:

- the inventive entity of the disclosure only includes one or more joint inventor(s), *but not the entire inventive entity*, of the application under examination, or
- there is an appropriate affidavit or declaration under 37 CFR 1.130(a) (attribution) or 1.130(b) (prior public disclosure), or
- the specification of the application under examination identifies the potential prior art disclosure as having been made by or having originated from one or more members of the inventive entity, in accordance with 37 CFR 1.77(b)(6).



# 102(b)(2)(C) Exception to Potential Prior Art under 35 U.S.C. 102(a)(2)

For the 102(b)(2)(C) exception to apply, the subject matter of the U.S. patent document and the claimed invention in the application under examination must have been:

- owned by the same person,
- subject to an obligation of assignment to the same person, or
- deemed to have been owned by or subject to an obligation of assignment to the same person, in view of a joint research agreement,

not later than the effective filing date of the claimed invention.



# Recognizing a 102(b)(2)(C) Exception to a Potential 102(a)(2) Reference

- A statement on the record that either common ownership in accordance with 102(b)(2)(C) or a joint research agreement (JRA) in accordance with 102(c) were in place may be made.
- A declaration or affidavit is not necessary.
- In the case of a JRA, the application must name or be amended to name the parties to the JRA.



# Test Your Knowledge!

We will be using Poll Everywhere ([pollev.com/uspto4](http://pollev.com/uspto4)) to challenge the audience with questions during the presentation.

Your participation is voluntary.





# Polling Notes

- We will do audience polling for questions on slides with a **red title bar**.
- Answers will be accepted through **Poll Everywhere** ([pollev.com/uspto4](http://pollev.com/uspto4)):
  - Text message (cell phone) or
  - Web page (cell phone's Internet browser or computer)
- Real-time display of your answers
- Let's Practice!



# Polling Introductory Question

**Introductory Question – YES OR NO?** Have you received an Office action on the merits in an AIA (FITF) application?

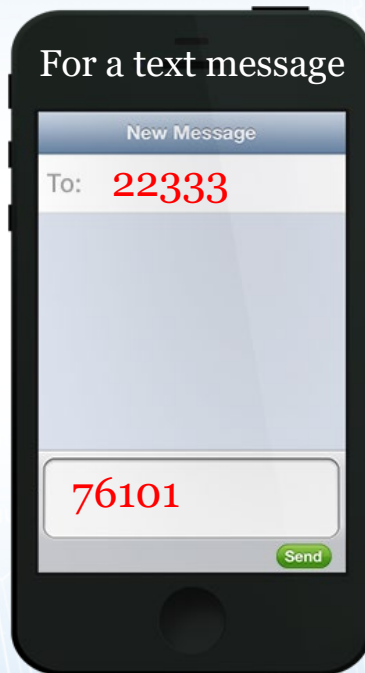
- If texting from your phone, send a text message to **phone number 22333** and use the code that corresponds to your answer as the body of your text message.
  - Codes will differ question-to-question and will be displayed on the current polling slide as, for example:
    - 76101 for **Yes**
    - 76102 for **No**
    - 76103 for **I Don't Know**
- If using the Internet, go to **pollev.com/uspto4** from any browser:
  - Select the appropriate radio button for your answer and submit



# Polling Introductory Question

**Introductory Question – YES OR NO?** Have you received an Office action on the merits in an AIA (FITF) application?

**76101 for Yes**  
**76102 for No**  
**76103 for I Don't Know**



Select appropriate radio button for your answer

# Polling Introductory Question

**Introductory Question – YES OR NO?** Have you received an Office action on the merits in an AIA (FITF) application?



# FITF Scenarios

Consider the following first-inventor-to-file examination scenarios and choose the best answer.

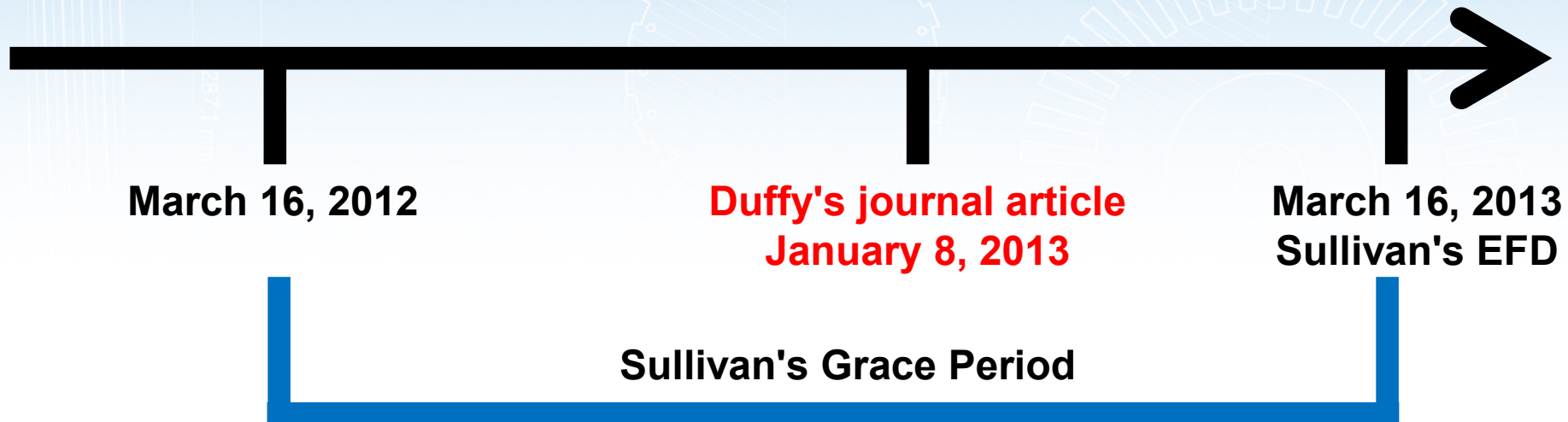


# Scenario 1. Traversing a Rejection under 35 U.S.C. 102(a)(1)

- On March 16, 2013, Sullivan files a nonprovisional utility patent application at the USPTO.
- Sullivan does not assert any foreign priority or domestic benefit under 35 U.S.C. 119, 120, 121, or 365.
- The patent examiner rejects all of the claims as anticipated under 35 U.S.C. 102(a)(1) by a journal article to Duffy, which became available to the public on January 8, 2013.



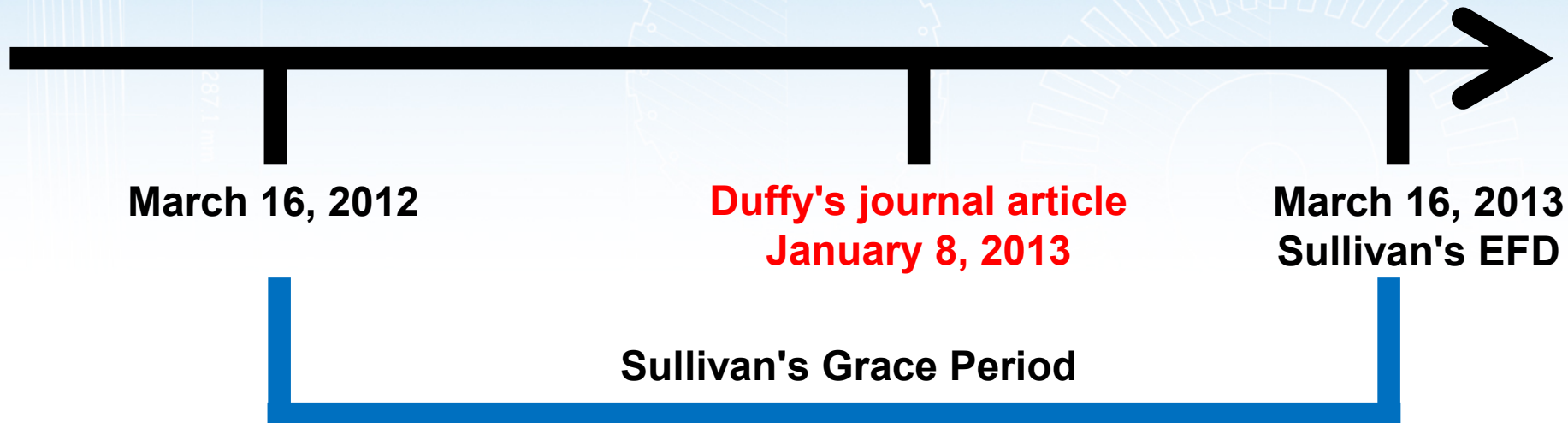
# Scenario 1. Traversing a Rejection under 35 U.S.C. 102(a)(1)



How could Sullivan properly traverse the examiner's 102(a)(1) rejection over Duffy?



# Scenario 1. Traversing a Rejection under 35 U.S.C. 102(a)(1)

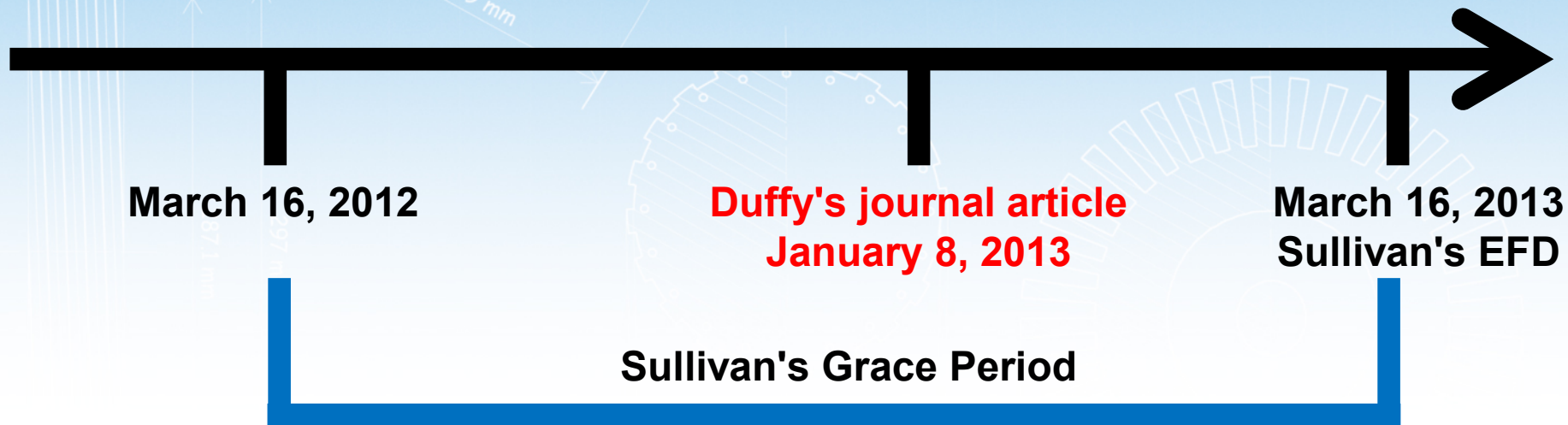


**Q1.1** – TRUE OR FALSE? Sullivan could properly traverse by arguing that the Duffy article is not prior art under 102(a)(1) because it became available to the public during Sullivan's one-year grace period.





# Scenario 1. Traversing a Rejection under 35 U.S.C. 102(a)(1)



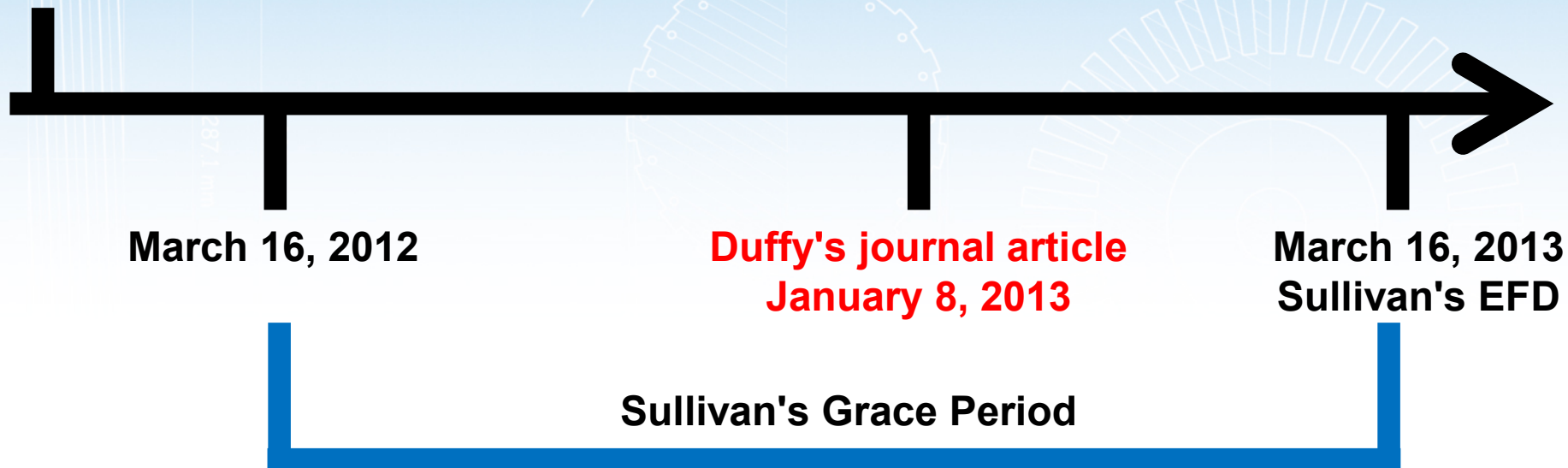
**A1.1 – FALSE.** The subject matter of the Duffy article did not originate with Sullivan, so 102(b)(1)(A) does not apply. Likewise, Sullivan (or another who got the information from him) did not disclose the subject matter within the year prior to his filing date and before the Duffy article, so 102(b)(1)(B) also does not apply.



# Scenario 1. Traversing a Rejection under 35 U.S.C. 102(a)(1)

December 13, 2011

Sullivan's invention date



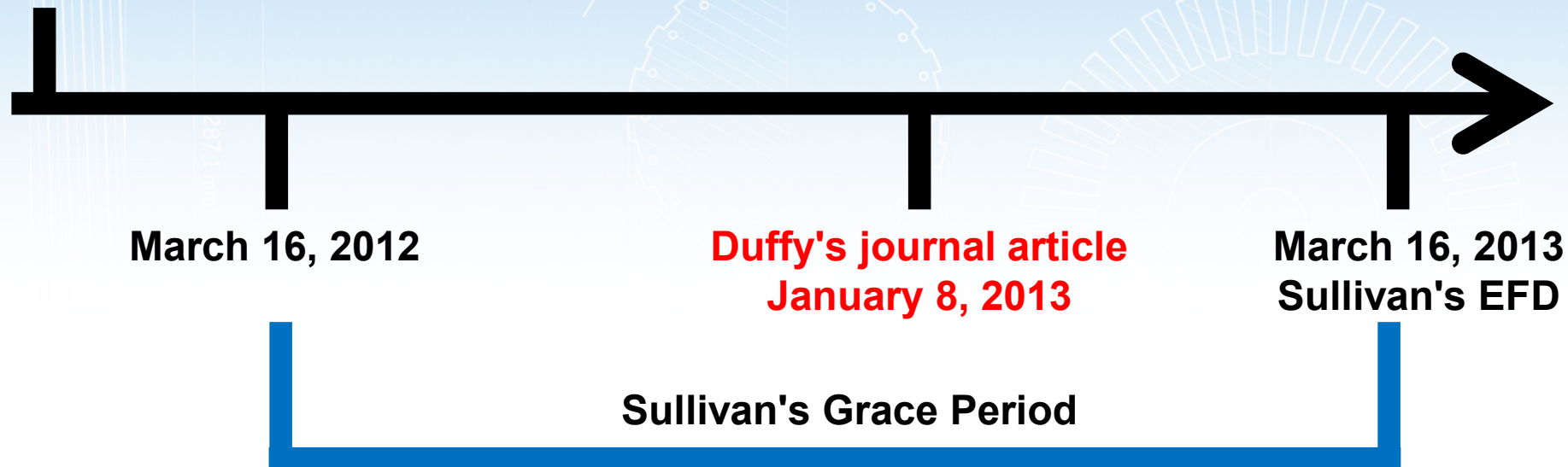
**Q1.2** – TRUE OR FALSE? Sullivan could properly traverse the rejection by presenting a declaration under 37 CFR 1.131 establishing that Sullivan's invention date was December 13, 2011.



# Scenario 1. Traversing a Rejection under 35 U.S.C. 102(a)(1)

December 13, 2011

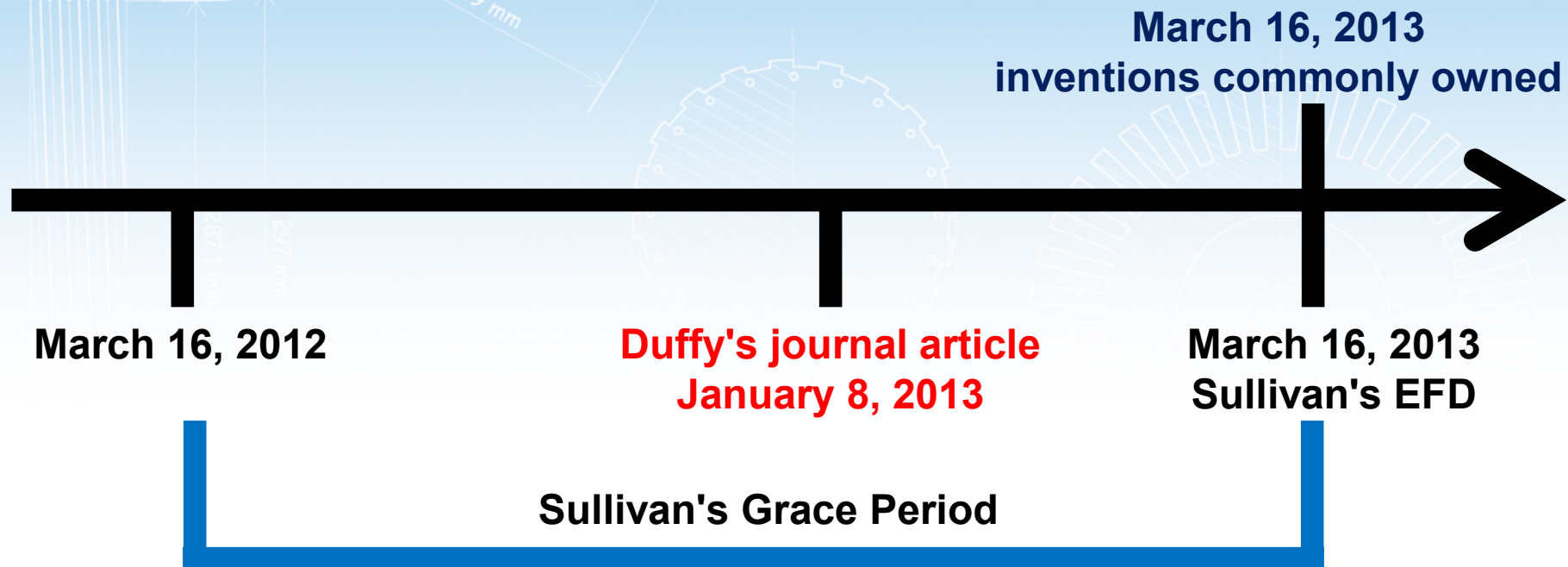
Sullivan's invention date



**A1.2 – FALSE.** Because the AIA is a first-inventor-to-file system rather than a first-to-invent system, an applicant cannot overcome a reference by showing an earlier date of invention.



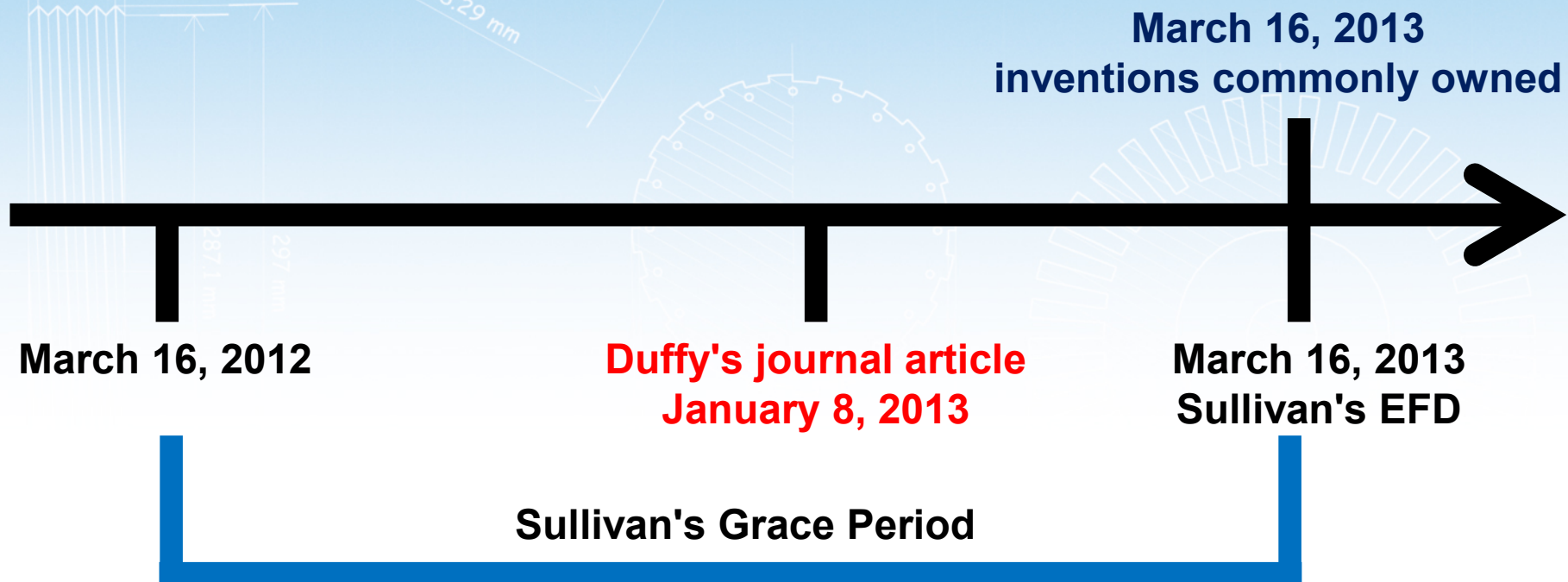
# Scenario 1. Traversing a Rejection under 35 U.S.C. 102(a)(1)



**Q1.3** – TRUE OR FALSE? Sullivan could properly traverse by presenting a statement under 35 U.S.C. 102(b)(2)(C) that the invention described in the Duffy article and the Sullivan application were commonly owned on March 16, 2013.



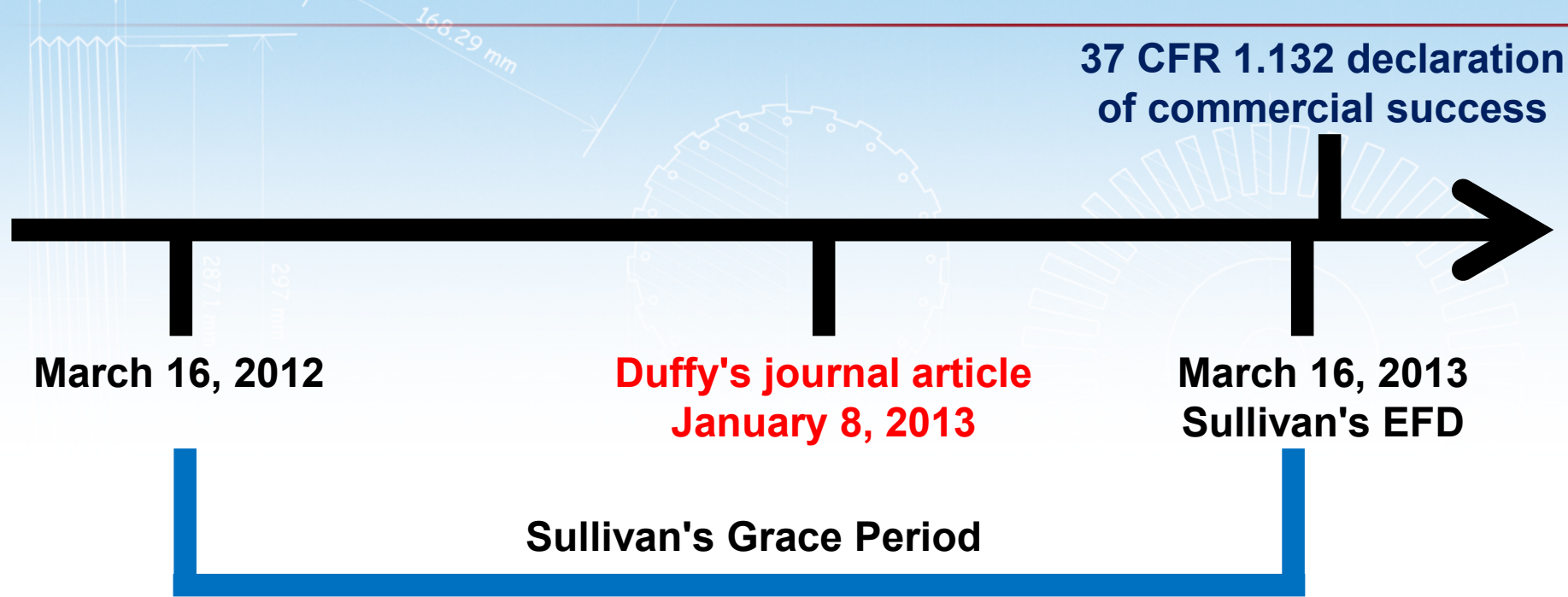
# Scenario 1. Traversing a Rejection under 35 U.S.C. 102(a)(1)



**A1.3 – FALSE.** The rejection was made under 102(a)(1), and the common ownership exception of 102(b)(2)(C) only applies to rejections made under 102(a)(2). Therefore, even though Sullivan can establish common ownership as of his effective filing date, the traversal is unavailing.



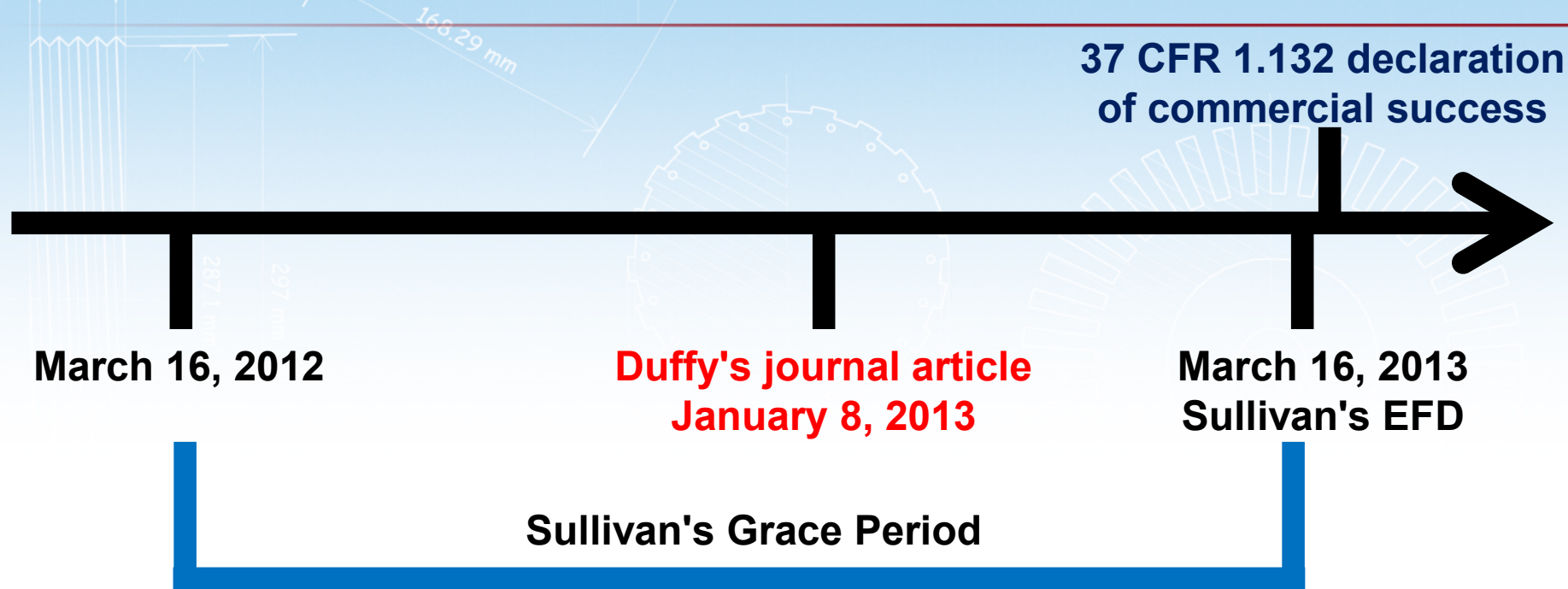
# Scenario 1. Traversing a Rejection under 35 U.S.C. 102(a)(1)



**Q1.4 – TRUE OR FALSE?** Sullivan could properly traverse by submitting a 37 CFR 1.132 declaration about the commercial success of his invention, including sales figures as well as market share, and establishing a nexus between the claimed invention and the commercial success.



# Scenario 1. Traversing a Rejection under 35 U.S.C. 102(a)(1)



**A1.4 – FALSE.** A declaration to establish so-called "secondary considerations" such as commercial success may be used to traverse an obviousness rejection, but not an anticipation rejection. This applies to both AIA and pre-AIA applications.



## Scenario 2. Traversing a Rejection under 35 U.S.C. 102(a)(2)

- Dolan filed his patent application on December 16, 2013. The application contains one claim directed to widget X.
- Dolan exhibited his invention at a trade show on December 30, 2012.
- The examiner locates a U.S. patent application publication disclosing widget X to Flanagan. The application was filed on October 16, 2013 and published on April 23, 2015.





# Scenario 2. Traversing a Rejection under 35 U.S.C. 102(a)(2)



Dolan's attorney receives an Office action rejecting the claim under 35 U.S.C. 102(a)(2) over Flanagan's patent application publication. How could she properly respond to the Office action?



# Polling Scenario 2. Traversing a Rejection under 35 U.S.C. 102(a)(2)



**Q2.1** – TRUE OR FALSE? Dolan's attorney can submit a declaration under 37 CFR 1.130(a) to establish that the subject matter disclosed in Flanagan's application was invented by Dolan, and that Flanagan obtained it directly or indirectly from him.

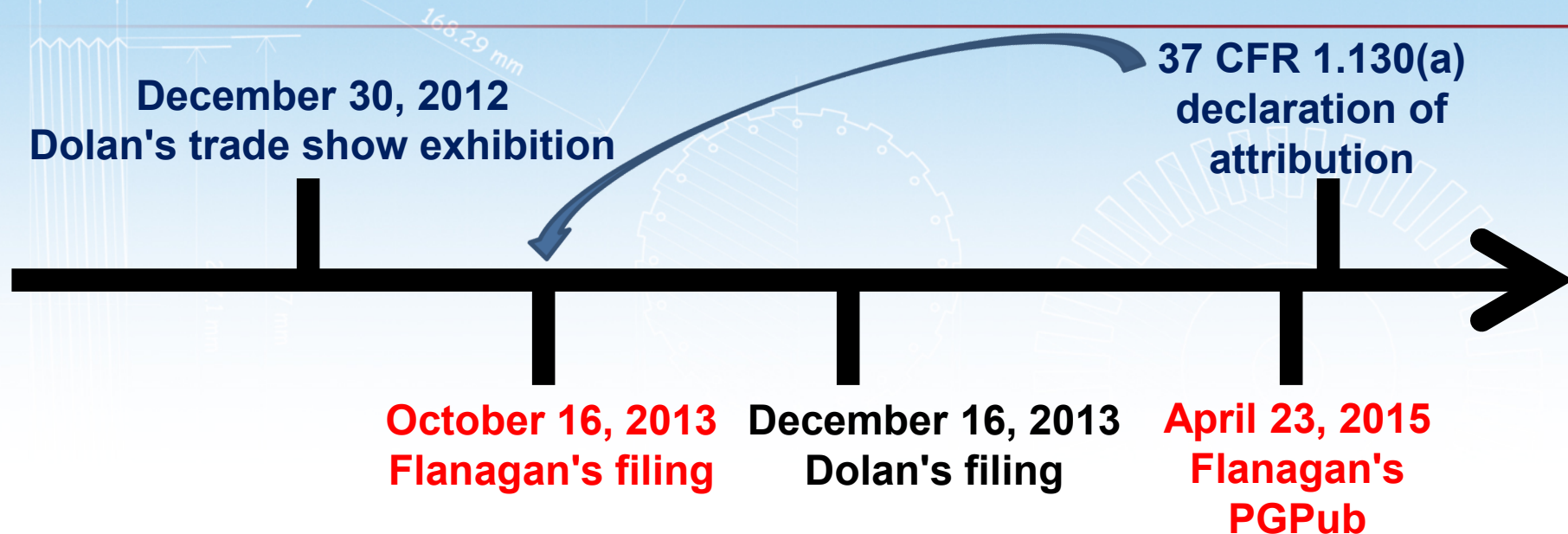


# Polling Scenario 2. Traversing a Rejection under 35 U.S.C. 102(a)(2)

**Q2.1** – TRUE OR FALSE? Dolan's attorney can submit a declaration under 37 CFR 1.130(a) to establish that the subject matter disclosed in Flanagan's application was invented by Dolan, and that Flanagan obtained it directly or indirectly from him.



# Polling Scenario 2. Traversing a Rejection under 35 U.S.C. 102(a)(2)



**Q2.1** – TRUE OR FALSE? Dolan's attorney can submit a declaration under 37 CFR 1.130(a) to establish that the subject matter disclosed in Flanagan's application was invented by Dolan, and that Flanagan obtained it directly or indirectly from him.



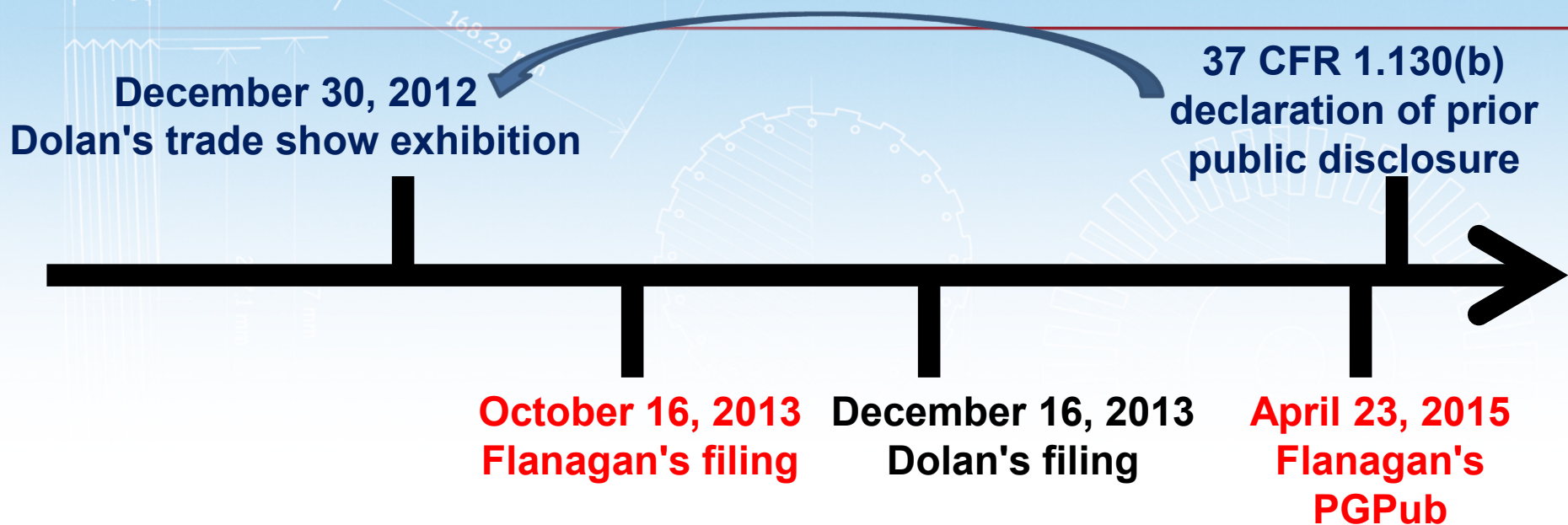
# Scenario 2. Traversing a Rejection under 35 U.S.C. 102(a)(2)



**Q2.2 – TRUE OR FALSE?** Dolan's attorney can properly traverse the rejection by submitting a declaration under 37 CFR 1.130(b) to establish that Dolan had publicly disclosed the widget before the date that Flanagan's application was effectively filed.



# Scenario 2. Traversing a Rejection under 35 U.S.C. 102(a)(2)



**A2.2** – TRUE. Dolan can invoke the 35 U.S.C. 102(b)(2)(B) exception by submitting a declaration under 37 CFR 1.130(b) to show that he had publicly disclosed the invention before Flanagan's patent application publication was effectively filed.

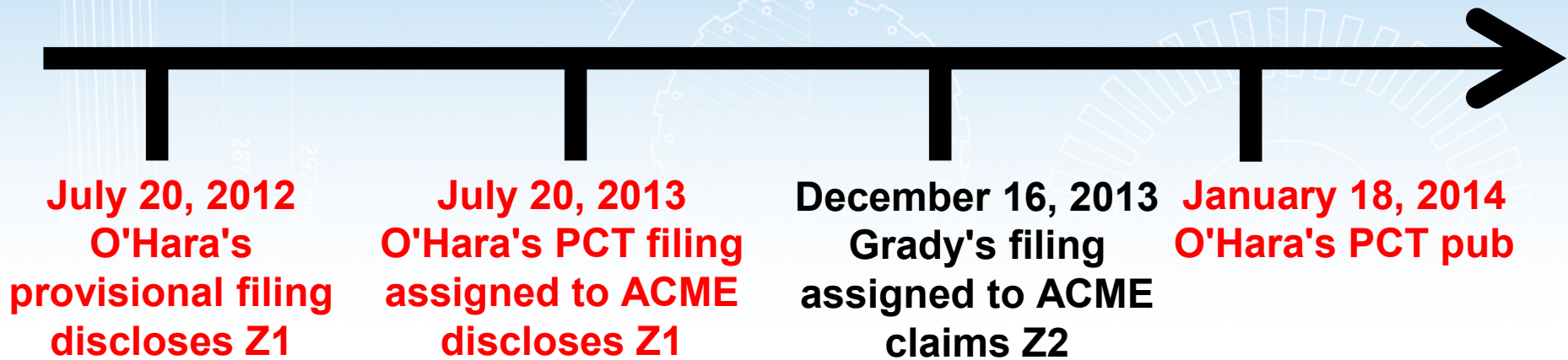


# Scenario 3. Relying on the Common Ownership Exception under 35 U.S.C. 102(b)(2)(C)

- Grady filed a patent application, assigned to ACME Corp., on December 16, 2013. His application contains one claim directed to method Z2.
- The examiner found a PCT application publication by O'Hara, published on January 18, 2014, assigned to ACME Corp., which disclosed method Z1. The PCT application designated the United States and was filed on July 20, 2013. It claimed benefit of a provisional application filed on July 20, 2012, which also disclosed method Z1.
- Z2 is obvious over Z1. The examiner issues an Office action rejecting Grady's claim under 35 U.S.C. 103 as obvious over O'Hara's published PCT application.



# Scenario 3. Relying on the Common Ownership Exception under 35 U.S.C. 102(b)(2)(C)

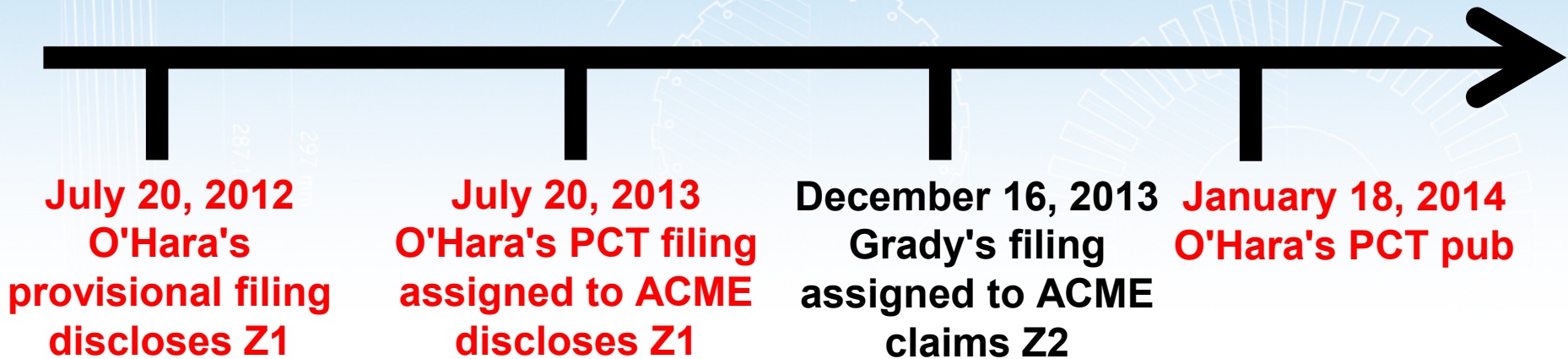


Consider whether Grady's attorney may invoke the common ownership exception to establish that the O'Hara publication is not prior art to Grady's claimed invention.





# Polling Scenario 3. Relying on the Common Ownership Exception under 35 U.S.C. 102(b)(2)(C)



**Q3.1** – TRUE OR FALSE? Grady's attorney may not invoke the common ownership exception because O'Hara's PCT publication was effectively filed on July 20, 2012, which is more than one year before Grady's effective filing date.

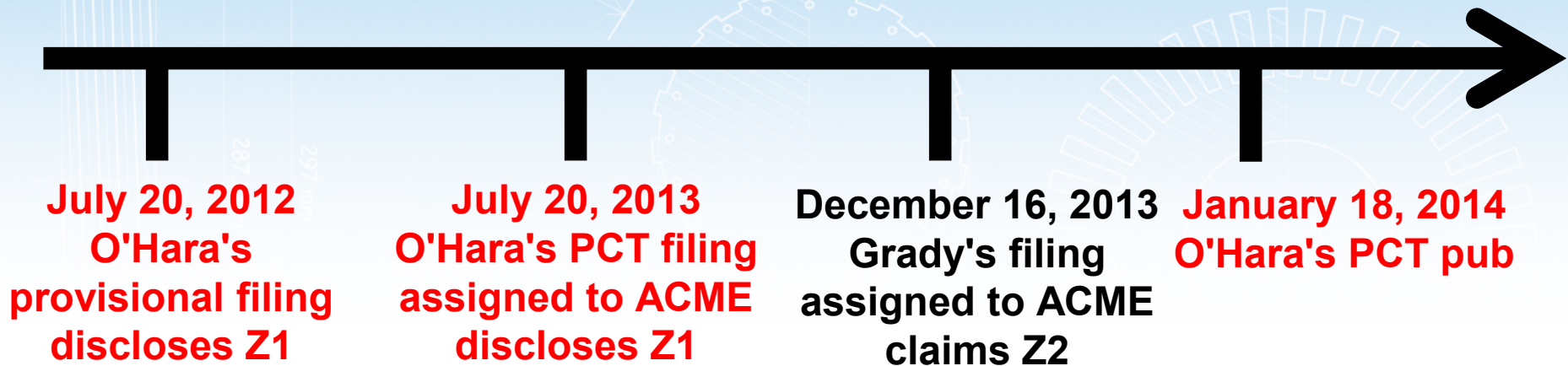


# Polling Scenario 3. Relying on the Common Ownership Exception under 35 U.S.C. 102(b)(2)(C)

**Q3.1** – TRUE OR FALSE? Grady's attorney may not invoke the common ownership exception because O'Hara's PCT publication was effectively filed on July 20, 2012, which is more than one year before Grady's effective filing date.



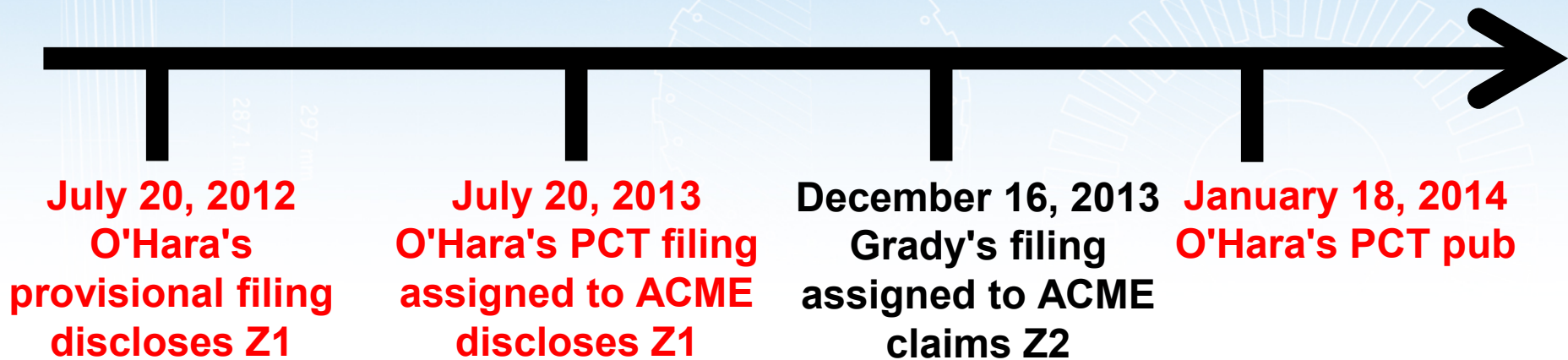
# Polling Scenario 3. Relying on the Common Ownership Exception under 35 U.S.C. 102(b)(2)(C)



**A3.1 – FALSE.** Under 102(a)(2), O'Hara's PCT publication may be prior art as of July 20, 2012, the date it was effectively filed. However, the 102(b)(2)(A), 102(b)(2)(B), and 102(b)(2)(C) exceptions, which apply to 102(a)(2) disclosures, are not limited to disclosures during Grady's one-year grace period. Thus, Grady may invoke the common ownership exception of 102(b)(2)(C).



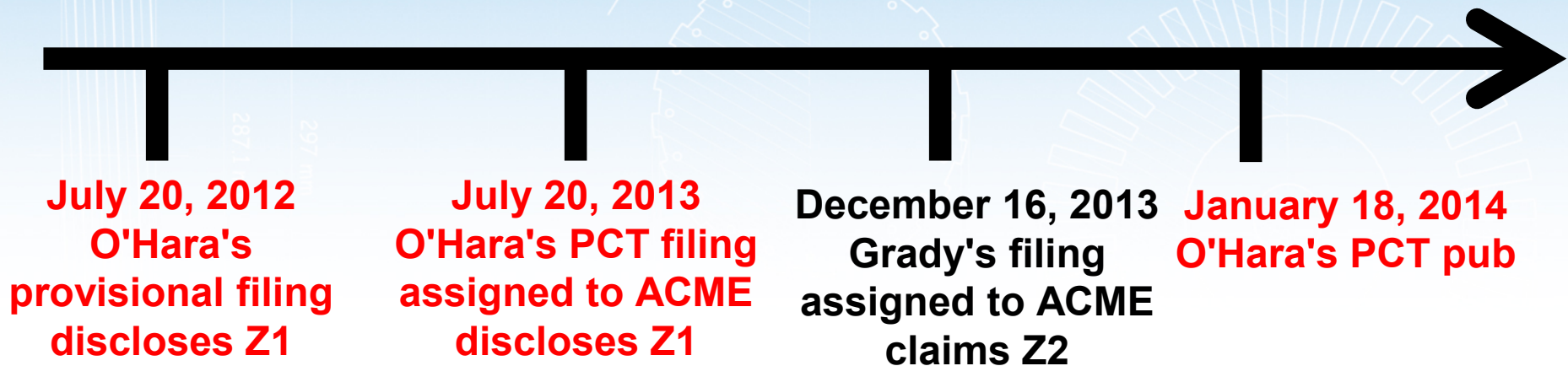
# Scenario 3. Relying on the Common Ownership Exception under 35 U.S.C. 102(b)(2)(C)



**Q3.2** – TRUE OR FALSE? Although Grady's attorney may invoke the common ownership exception to overcome the examiner's obviousness rejection, he could not have done so if the examiner had made an anticipation rejection.



# Scenario 3. Relying on the Common Ownership Exception under 35 U.S.C. 102(b)(2)(C)

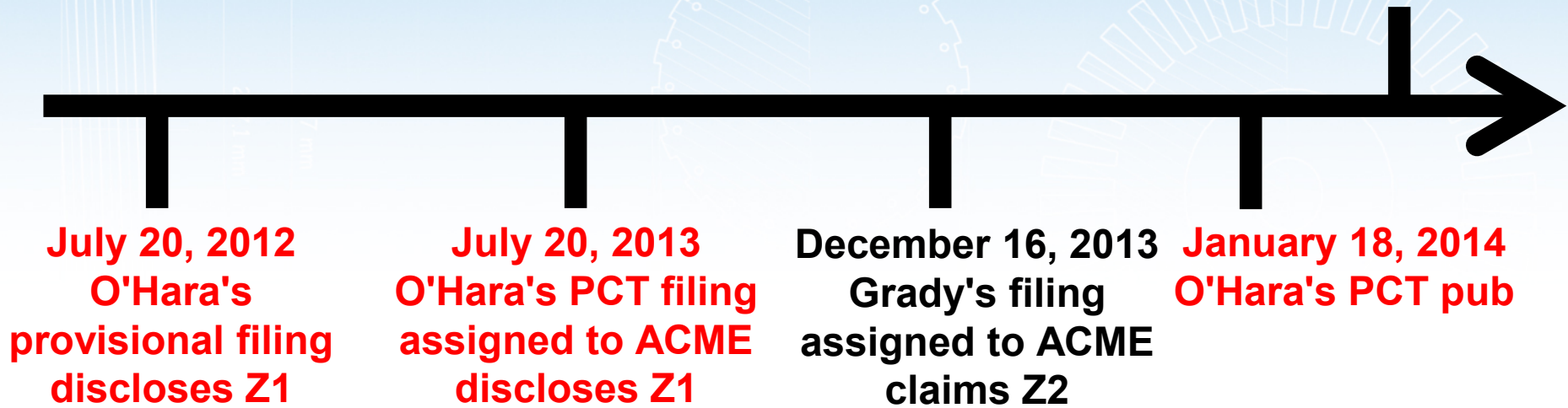


**Q3.2 – FALSE.** Unlike the pre-AIA 103(c) common ownership exception which applies only to obviousness rejections, the 102(b)(2)(C) exception under the AIA may be invoked to overcome both obviousness and anticipation rejections.



# Scenario 3. Relying on the Common Ownership Exception under 35 U.S.C. 102(b)(2)(C)

statement that on December 16, 2013,  
Z1 and Z2 were commonly owned

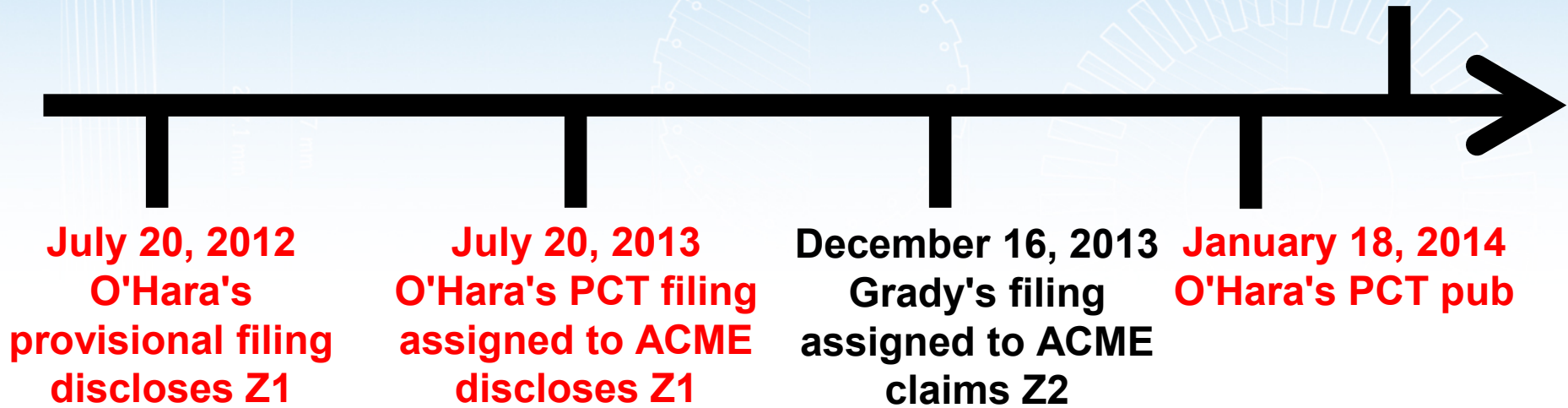


**Q3.3** – TRUE OR FALSE? If Grady's attorney provides a statement that Grady's claimed method Z2 and O'Hara's disclosed method Z1 were commonly owned as of December 16, 2013, he can expect the examiner to withdraw the rejection.



# Scenario 3. Relying on the Common Ownership Exception under 35 U.S.C. 102(b)(2)(C)

statement that on December 16, 2013,  
Z1 and Z2 were commonly owned



**A3.3 – TRUE.** A statement that Grady's claimed method Z2 and O'Hara's disclosed method Z1 were commonly owned as of Grady's effective filing date is sufficient. A declaration is not needed.



# Scenario 3A. Relying on the Common Ownership Exception under 35 U.S.C. 102(b)(2)(C)

- Grady filed a patent application, assigned to ACME Corp., on December 16, 2013. His application contains one claim directed to method Z2.
- The examiner found a PCT application publication by O'Hara, published on January 18, 2014, assigned to ~~ACME~~ **APEX** Corp., which disclosed method Z1. The PCT application designated the United States and was filed on July 20, 2013. It claimed benefit of a provisional application filed on July 20, 2012, which also disclosed method Z1.
- Z2 is obvious over Z1. The examiner issues an Office action rejecting Grady's claim under 35 U.S.C. 103 as obvious over O'Hara's published PCT application.





# Scenario 3A. Relying on the Common Ownership Exception under 35 U.S.C. 102(b)(2)(C)

JRA statement and amendment to the specification



**July 20, 2012**  
O'Hara's provisional filing discloses Z1

**July 20, 2013**  
O'Hara's PCT filing assigned to APEX discloses Z1

**December 16, 2013**  
Grady's filing assigned to ACME claims Z2

**January 18, 2014**  
O'Hara's PCT pub

**Q3.4 – TRUE OR FALSE?** If Grady's attorney provides a statement that ACME and APEX were parties to a joint research agreement (JRA) in effect on or before December 16, 2013, and that Grady's claimed method Z2 resulted from activities within the scope of the JRA, then he can expect the examiner to withdraw the rejection as long as he amends the specification to disclose the names of the parties to the JRA.



# Scenario 3A. Relying on the Common Ownership Exception under 35 U.S.C. 102(b)(2)(C)

JRA statement and amendment to the specification



**July 20, 2012**  
O'Hara's provisional filing discloses Z1

**July 20, 2013**  
O'Hara's PCT filing assigned to APEX discloses Z1

**December 16, 2013**  
Grady's filing assigned to ACME claims Z2

**January 18, 2014**  
O'Hara's PCT pub

**A3.4 – TRUE.** An appropriate JRA statement by Grady's attorney is sufficient to overcome an anticipation or obviousness rejection based on a 102(a)(2) disclosure, provided that the specification names or is amended to name the parties to the JRA. A declaration is not needed.



# Scenario 4. Traversing a Rejection under 35 U.S.C. 102(a)(1) or 102(a)(2)

- On May 1, 2014, Kelly files a nonprovisional patent application at the USPTO claiming invention X.
- Kelly asserts a foreign priority claim under 35 U.S.C. 119(a)-(d) based on his Australian application filed May 1, 2013. He submits a certified copy of the English-language Australian application to the USPTO. The Australian application provides support under 35 U.S.C. 112(a) for invention X.
- The examiner rejects Kelly's claims as anticipated under 35 U.S.C. 102(a)(1) and 102(a)(2) by a U.S. patent application publication to O'Brien dated January 8, 2013, based on an application filed on July 8, 2011. O'Brien's application discloses invention X. There are no other rejections of record, and the examiner is not aware of any other relevant art.



# Polling Scenario 4. Traversing a Rejection under 35 U.S.C. 102(a)(1) or 102(a)(2)

December 20, 2012  
Kelly's public disclosure  
of invention X

July 8, 2011

O'Brien's US filing;  
invention X disclosed

January 8, 2013

O'Brien's US PGPub;  
invention X disclosed

May 1, 2013

Kelly's AU filing;  
invention X has  
112(a) support

May 1, 2014

Kelly's US filing;  
invention X  
claimed

**Q4.1 – TRUE OR FALSE?** If Kelly submits a declaration under 37 CFR 1.130(b) showing that he had publicly disclosed invention X on December 20, 2012, he should expect allowance of his claims if there are no other issues that impact patentability.



# Polling Scenario 4. Traversing a Rejection under 35 U.S.C. 102(a)(1) or 102(a)(2)

**Q4.1** – TRUE OR FALSE? If Kelly submits a declaration under 37 CFR 1.130(b) showing that he had publicly disclosed invention X on December 20, 2012, he should expect allowance of his claims if there are no other issues that impact patentability.



# Polling Scenario 4. Traversing a Rejection under 35 U.S.C. 102(a)(1) or 102(a)(2)

December 20, 2012  
Kelly's public disclosure  
of invention X



July 8, 2011

O'Brien's US filing;  
invention X disclosed

January 8, 2013

O'Brien's US PGPub;  
invention X disclosed

May 1, 2013

Kelly's AU filing;  
invention X has  
112(a) support

May 1, 2014

Kelly's US filing;  
invention X  
claimed

**A4.1 – FALSE.** Kelly's declaration establishes that O'Brien's PGPub is not 102(a)(1) art as of its publication date, but O'Brien's PGPub is still 102(a)(2) art as of the date that it was effectively filed.



# Scenario 4. Traversing a Rejection under 35 U.S.C. 102(a)(1) or 102(a)(2)

June 25, 2011

Kelly's public disclosure of invention X

July 8, 2011

O'Brien's US filing; invention X disclosed

January 8, 2013

O'Brien's US PGPub; invention X disclosed

May 1, 2013

Kelly's AU filing; invention X has 112(a) support

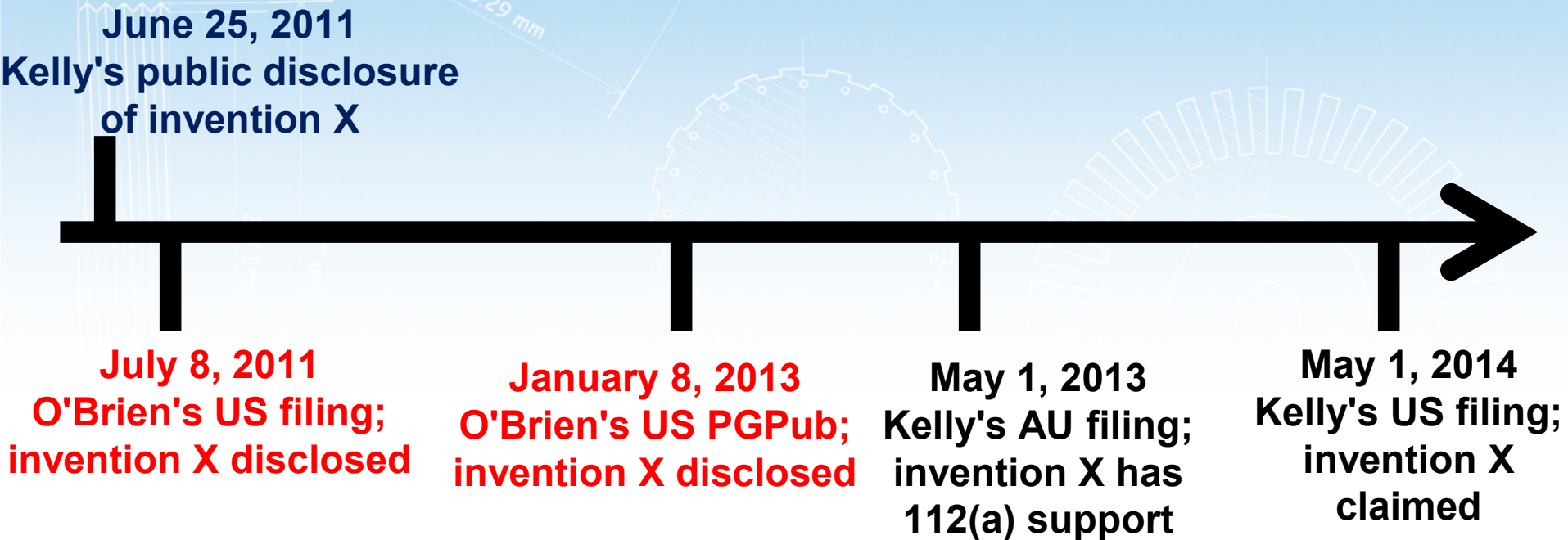
May 1, 2014

Kelly's US filing; invention X claimed

**Q4.2 – TRUE OR FALSE?** If Kelly submits a declaration under 37 CFR 1.130(b) showing that he had publicly disclosed invention X on June 25, 2011, he should expect allowance of his claims if there are no other issues that impact patentability.



# Scenario 4. Traversing a Rejection under 35 U.S.C. 102(a)(1) or 102(a)(2)



**A4.2 – FALSE.** Although Kelly's declaration under 37 CFR 1.130(b) is sufficient to establish that O'Brien's PGPub is not prior art under either 102(a)(1) or 102(a)(2), Kelly's prior public disclosure is itself 102(a)(1) prior art to Kelly's claimed invention.



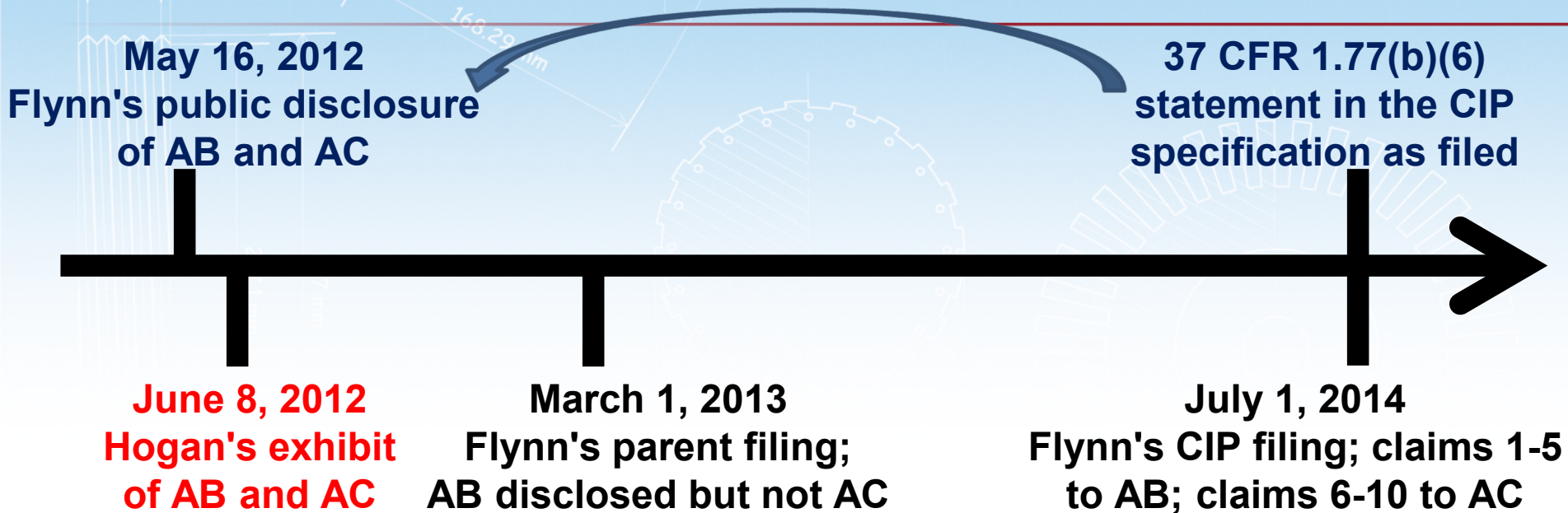


# Scenario 5. Traversing a Rejection under 35 U.S.C. 102(a)(1)

- On July 1, 2014, Flynn files a CIP of his earlier nonprovisional patent application filed March 1, 2013.
- Claims 1-5 to invention AB were supported in the March 1, 2013 parent application. Claims 6-10 to invention AC were newly added in the July 1, 2014 CIP, and were not supported in the parent application.
- The examiner rejects all of Flynn's claims as anticipated by a June 8, 2012 trade show exhibit by Hogan which included inventions AB and AC.



# Polling Scenario 5. Traversing a Rejection under 35 U.S.C. 102(a)(1)



**Q5.1** – TRUE OR FALSE? If Flynn responds by pointing out a statement under 37 CFR 1.77(b)(6) in the specification as filed, which asserts that he had publicly disclosed AB and AC on May 16, 2012, he should expect the examiner to withdraw the rejection of claims 1-5 over the Hogan exhibit.

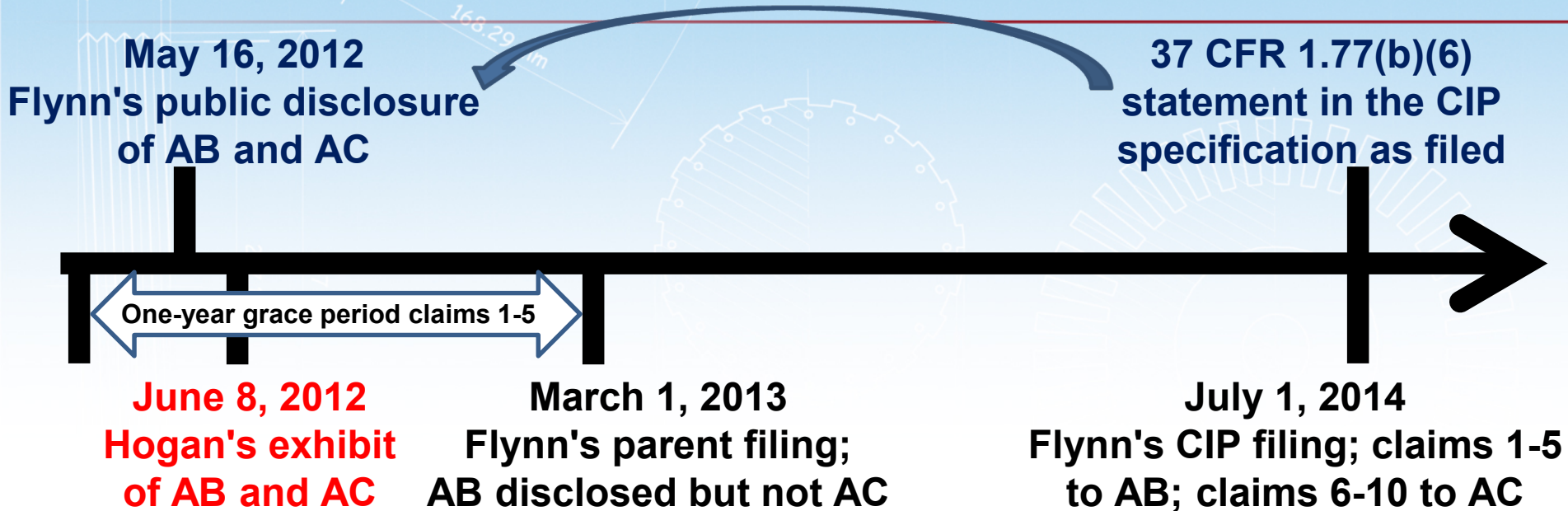


# Polling Scenario 5. Traversing a Rejection under 35 U.S.C. 102(a)(1)

**Q5.1** – TRUE OR FALSE? If Flynn responds by pointing out a statement under 37 CFR 1.77(b)(6) in the specification as filed, which asserts that he had publicly disclosed AB and AC on May 16, 2012, he should expect the examiner to withdraw the rejection of claims 1-5 over the Hogan exhibit.



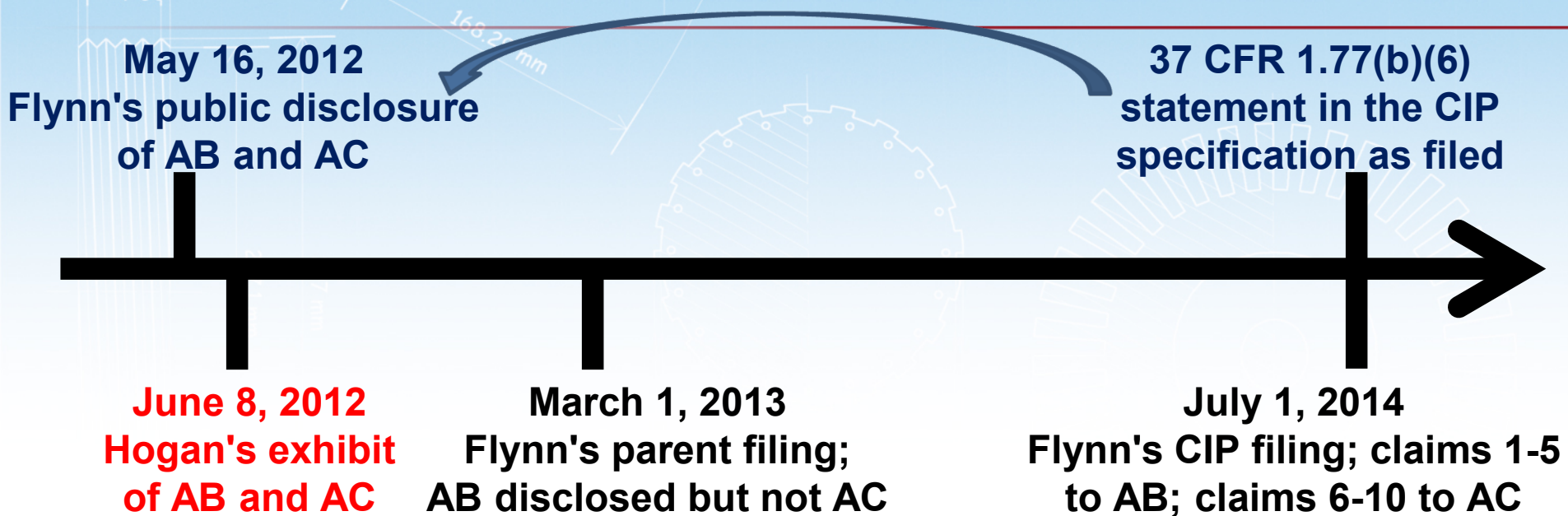
# Polling Scenario 5. Traversing a Rejection under 35 U.S.C. 102(a)(1)



**A5.1 – TRUE.** All claims in the CIP are examined under FITF, but the effective filing date of claims 1-5 is March 1, 2013. Hogan's exhibit is a 102(a)(1) disclosure within the grace period for claims 1-5. Therefore the rejection can be overcome by relying on a 1.77(b)(6) statement present upon filing to invoke the 102(b)(1)(B) exception.

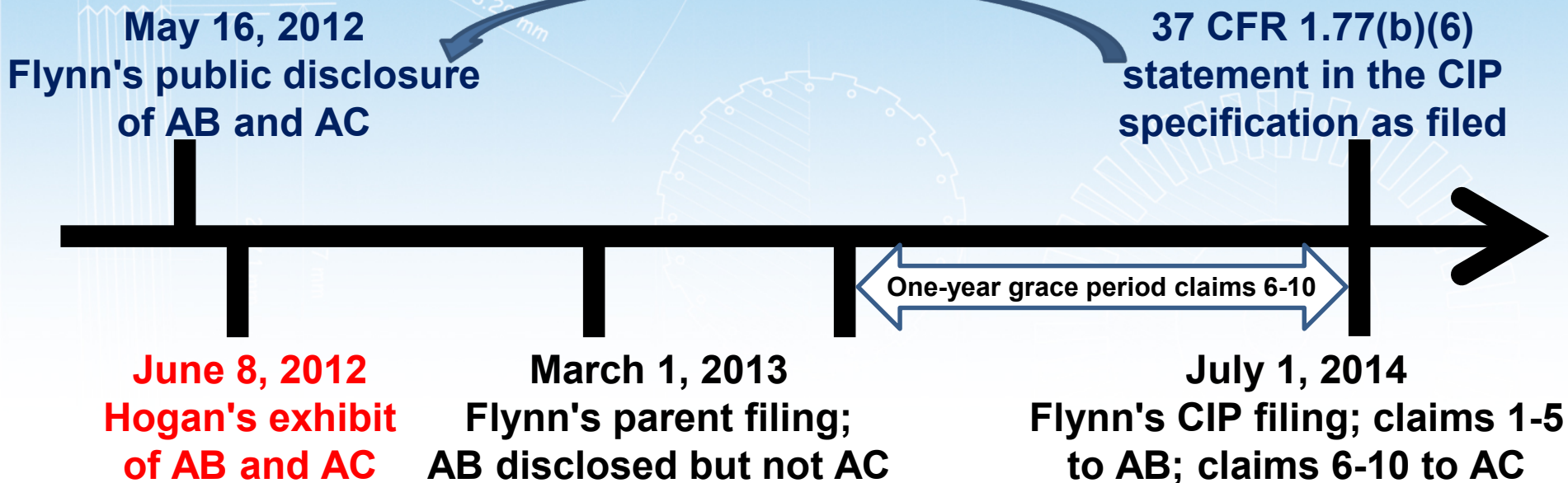


# Scenario 5. Traversing a Rejection under 35 U.S.C. 102(a)(1)



**Q5.2** – TRUE OR FALSE? If Flynn responds to the rejection by pointing out a statement under 37 CFR 1.77(b)(6) in the specification as filed, which asserts that he had publicly disclosed AB and AC on May 16, 2012, he should expect the rejection of claims 6-10 to be withdrawn.

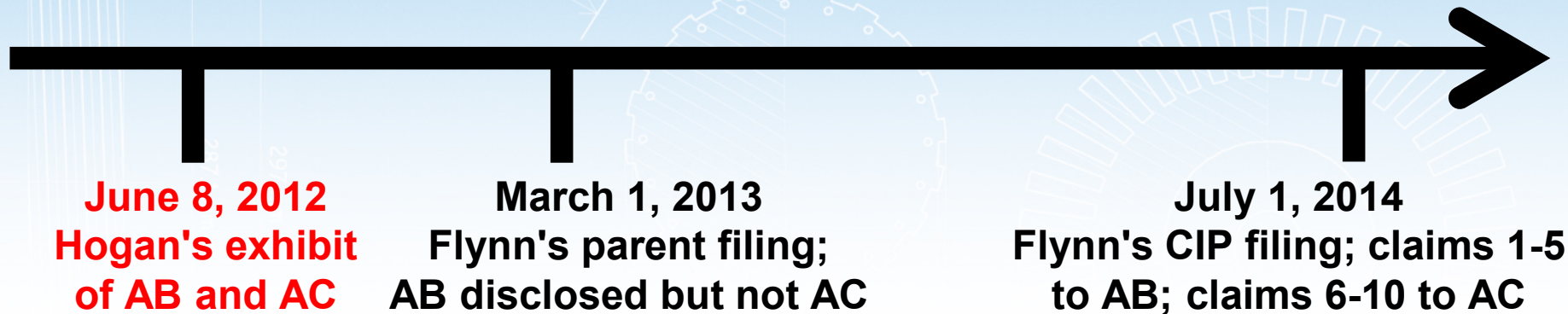
# Scenario 5. Traversing a Rejection under 35 U.S.C. 102(a)(1)



**A5.2 – FALSE.** All claims in the CIP are examined under FITF, but the effective filing date of claims 6-10 is July 1, 2014. Hogan's exhibit is a 102(a)(1) disclosure outside the grace period for claims 6-10. Therefore the rejection cannot be overcome by invoking the 102(b)(1)(B) exception via a 1.77(b)(6) statement. Furthermore, Flynn's disclosure is itself prior art to claims 6-10.



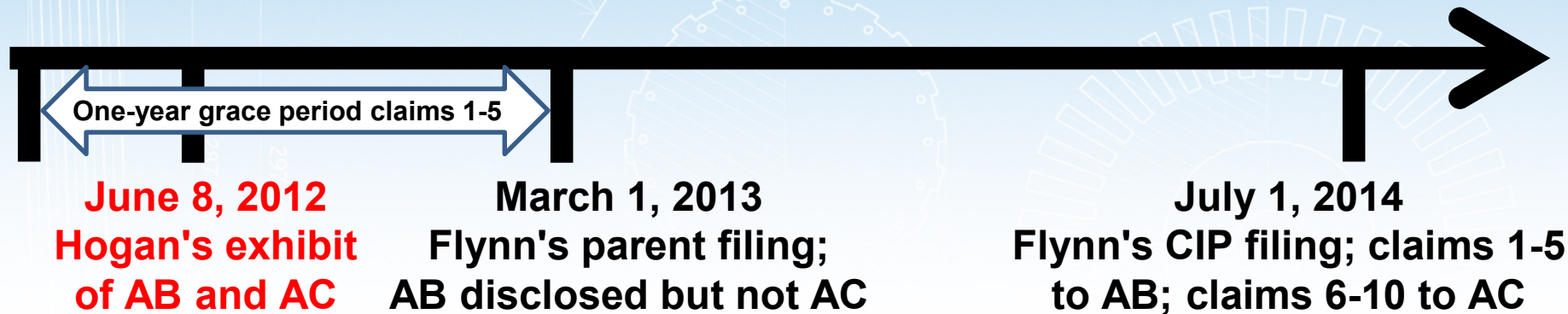
# Scenario 5. Traversing a Rejection under 35 U.S.C. 102(a)(1)



**Q5.3** – TRUE OR FALSE? If Flynn responds to the rejection by submitting a declaration under 37 CFR 1.130(a) establishing that inventions AB and AC were his own work, and that Hogan obtained them from him, Flynn should expect the rejection of claims 1-5 to AB over Hogan to be withdrawn.



# Scenario 5. Traversing a Rejection under 35 U.S.C. 102(a)(1)

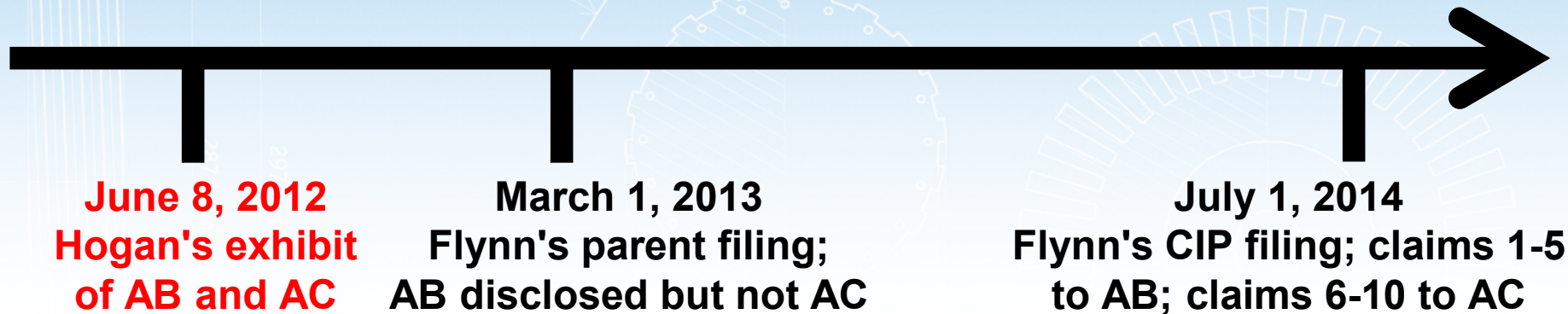


**A5.3 – TRUE.** All claims in the CIP are examined under FITF, but the effective filing date of claims 1-5 is March 1, 2013. Hogan's exhibit is a 102(a)(1) disclosure within the grace period for claims 1-5. Therefore the rejection can be overcome by using a 130(a) declaration (attribution) to invoke the 102(b)(1)(A) exception.





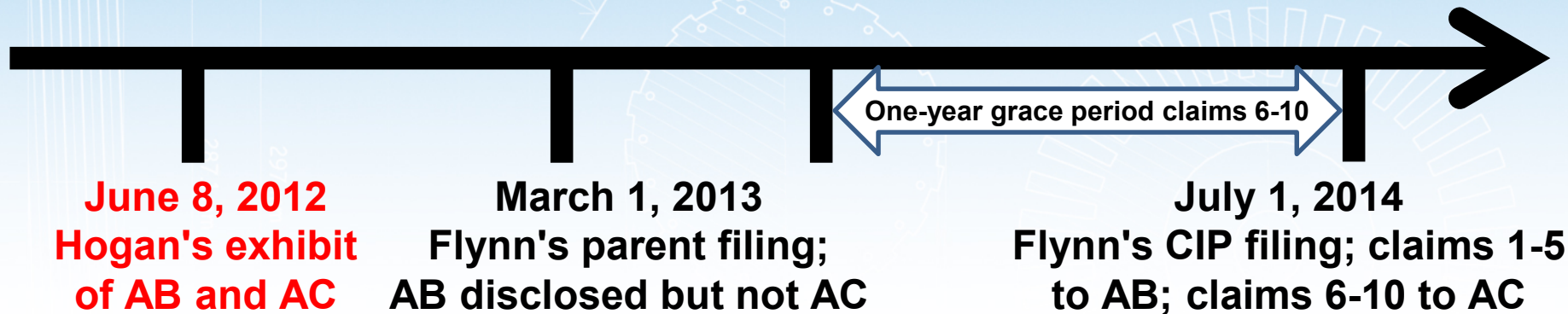
# Scenario 5. Traversing a Rejection under 35 U.S.C. 102(a)(1)



**Q5.4 – TRUE OR FALSE?** If Flynn responds to the rejection by submitting a declaration under 37 CFR 1.130(a) establishing that inventions AB and AC were his own work, and that Hogan obtained inventions AB and AC from him, he should expect the examiner to withdraw the rejection of claims 6-10 to AC over Hogan.



# Scenario 5. Traversing a Rejection under 35 U.S.C. 102(a)(1)



**A5.4 – FALSE.** All claims in the CIP are examined under FITF, but the effective filing date of claims 6-10 is July 1, 2014. Hogan's exhibit is a 102(a)(1) disclosure outside the grace period for claims 6-10. Therefore the rejection cannot be overcome by invoking the 102(b)(1)(A) exception via a 130(a) declaration.





# **AMERICA INVENTS ACT**

## IMPLEMENTATION

**Thank you for your attention!**

**For more information:**

- **See the FITF materials at [http://www.uspto.gov/aia\\_implementation/patents.jsp#heading-10](http://www.uspto.gov/aia_implementation/patents.jsp#heading-10)**
- **Call 1-855-HELP-AIA**
- **E-mail [HelpAIA@uspto.gov](mailto:HelpAIA@uspto.gov)**