

## THE POST-AIA SECTION 102

- **Basic framework**
  - First-inventor-to-file wins unless second filer:
    - Was first to publicly disclose during one-year grace period; or
    - Shows “derivation” or “abandonment”
  - Certain prior art disclosures result in bar (loss of right)
    - Immediately; or
    - After one-year grace period
- **Prior art — new § 102(a)**
  - Includes all publicly available material before filing date — § 102(a)(1)
    - Patented
    - Described in a printed publication
    - Public use
    - On sale
    - Otherwise available to the public
      - Latent issue: Are private sales/offers “on sale” events?
    - Another inventor’s patent application that is published or results in issued patent — § 102(a)(2)
      - Grace period **not applicable**
      - Excluded from prior art if derived from or previously disclosed by inventor, or co-owned — § 102(b)(2))
  - Excludes third-party secret public use/on-sale events
  - No geographic restrictions
  - No Rule 131 affidavits (“swearing behind”)
- **One year grace period — new § 102(b)(1)**
  - Applies to:
    - The inventor’s own “disclosures” (“public disclosures” in **bold**)
      - **Printed publications/otherwise made available**
      - **Informing public use/on-sale events**
      - Non-informing and secret public use/on-sale events
    - Third-party “disclosures” that occur after “**public** disclosure” by the inventor
      - Printed publications/otherwise made available
      - Third party non-secret public use/on-sale events
      - “Disclosing behind”
  - Legislative history: “New section 102(b) preserves the grace period, ensuring that during the year prior to filing, an invention will not be rendered unpatentable based on
    - any of the inventor’s own disclosures, or
    - any disclosure made by any party after the inventor has disclosed his invention to the public.” — Committee Report 112-98, at 73

**POST-AIA SECTION 102 HYPOTHETICALS**

1. Pam publishes in *Make* magazine on March 1, 2013 material claimed by Jim in an application filed on March 15, 2013. Is Jim's application valid?
2. Pam publishes in *Make* magazine on March 1, 2013 material claimed by Jim in an application filed on April 15, 2013. Is Jim's application valid?
3. Jim publishes in *Make* magazine on April 1, 2013 material claimed by Jim in an application filed on April 15, 2013. Is Jim's application valid?
4. On July 4, 2013, Jim enters into a confidential sales agreement with Office Staples to sell units of his invention. Can Jim still obtain a patent on his invention?
5. Same as 4, but in addition, Pam obtained a prototype of Jim's product from Office Staples and publishes an enabling description of Jim's invention in *Make* magazine on June 1, 2013. Can Jim still obtain a patent on his invention?
6. On July 4, 2013, Dwight enters into a confidential sales agreement with Office Staples to sell units of Jim's invention. Can Jim still obtain a patent on his invention?
7. On June 10, 2013, Phyllis invents a chemical in Canada. On September 8, 2013, Angela independently invents the same chemical in North Carolina, and on September 22, 2013, she describes it at a seminar at UNC. Can Phyllis still obtain a patent on her invention?
8. Michael invents a circuit in the United States in April 2013. He tries to earn development money by privately offering the circuit for sale in Pennsylvania in June and July 2013, but fails to get any orders. He files in August 2014. Can Michael still obtain a patent?
9. Michael invents a circuit in the United States in April 2013. He tries to earn development money by publicly offering the patent rights for sale in Mexico in June and July 2013, but fails to get any orders. He files in August 2014. Can Michael still obtain a patent?
10. Stanley invents a chemical in the United States in May 2013. He publicly offers it for sale in New York on June 15, 2013. On December 15, 2013, he files in Canada, disclosing and claiming the chemical. On December 1, 2014, Stanley files in the United States, disclosing and claiming the chemical and properly asserting the benefit of his Canadian filing date under § 119. Can Stanley obtain a valid U.S. patent?