From: Simon Booth [e-mail address redacted]
Sent: Friday, September 16, 2011 3:16 PM
To: aia_implementation
Subject: Patents – Request for Clarification of a “Disclosure” under 35 U.S.C. § 102(b)(1)

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September 16, 2011

VIA EMAIL

ATTN: Hiram Bernstein, Senior Legal Advisor
Office of Patent Legal Administration
U.S. Patent and Trademark Office

Re: Patents – Request for Clarification of a “Disclosure” under 35 U.S.C. § 102(b)(1)

Dear Mr. Bernstein:

I am writing to inquire regarding the implementation of the America Invents Act, which was signed by President Obama on September 16, 2011. As you are aware, the America Invents Act significantly changes current patent law and I am writing to inquire about the implementation to further advise my clients.

Under the new 35 U.S.C. § 102(a)(1), prior art is a patent, a printed publication, a public use, or a sale or offer for sale before the effective filing date of the claimed invention. There are no qualifiers in this subsection. Thus, the prior art acts apply to anybody including the applicants. However, 35 U.S.C. § 102(b)(1) provides an exception to prior art under 35 U.S.C. § 102(a)(1). Generally, a “disclosure made 1 year or less before the effective filing date of a claimed invention” by an inventor is not prior art under subsection 102(a)(1).

Because subsection (b)(1) uses the plain language of a “disclosure” and subsection (a)(1) lists four specific prior art acts, the statute is not clear what prior art act a disclosure under subsection (b)(1) pertains to. For instance, the plain language of a disclosure may not apply to a public use or a sale, thereby making a public sale or sale an absolute statutory bar consistent with other major patent systems. It would seem that, if Congress wanted to include each four specific acts under subsection (a)(1) to be deemed a disclosure under subsection (b)(1), there would be explicit language in the statute for clarity. In fact, a disclusure under subsection (b)(2) is expressly referenced to as prior art under subsection (a)(2).

The lack of definition of a disclosure under subsection (b)(1) is problematic because the congressional record emphasizes harmonizing U.S. patent laws to be more consistent with other major patent systems. If a disclosure under susbsection (b)(1) would pertain to all prior art acts listed under subsection (a)(1), then the America Invents Act does not achieve the intended goal of harmonization with the exception of determining the filing date. Other ambiguous dates that could be prior art or a disclosure under subsection (b)(1) would still be relevant in litigation and administrative proceedings, directly in contrast with other major patent systems.

Given that a disclosure under subsection (b)(1) is not clearly defined, I would greatly appreciate the U.S. Patent and Trademark Office’s interpretation of this term to advise clients regarding the rule changes.

If you have any questions, concerns, or would like to discuss this matter in more detail, please feel free to contact me at your earliest convenience.

Very truly yours,

Simon Booth *

Reg. No. 58, 582

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Dated: September 16, 2011

*Admitted to bar other than D.C. Practice limited to matter and proceedings before the federal courts and agencies.