

New Definition of Prior Art (Part 1)

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The AIA extensively reforms U.S. patent law, and in doing so, replaces the current first-to-invent system with a first-inventor-to-file system. The first-inventor-to-file system, and along with it, an entirely new definition of prior art contained in 35 USC §102, will apply to any patent application having an effective filing date on or after March 16, 2013. In a three part series, we will address the new definition prior art, the exceptions to the new definition of prior art, and what this means for patentees.

The Pre-AIA U.S. Patent System

To best understand the effects of this change, a brief description of the U.S. patent system prior to enactment of the AIA is helpful.

- Sometimes, two parties conceive of the same invention at about the same time. Prior to the AIA, the U.S. would grant a patent to the party who first conceived of the invention (that is, the first inventor), rather than the first party to file a patent application. In order to determine which party first conceived of the invention and other relevant facts (such as when the invention was diligently

reduced to practice, and whether the invention was concealed, suppressed or abandoned by a party), the U.S. Patent Office would conduct a proceeding known as an interference. Interference proceedings, however, are expensive and time consuming, and until an interference proceeding is completed, there is uncertainty as to who actually owns the patent rights. Moreover, most other countries in the world abide by a first-to-file system where the patent rights are granted to the first party to file a patent application, regardless of whether they were the first inventor.

- The U.S. patent system also provided a one year grace period following the sale or public disclosure of an invention to file a U.S. patent application. A reference that was published prior to, but within a year of the filing date of a patent application could be removed as prior art by showing that the inventor conceived of the invention prior to the reference's publication date. This was known as "ante-dating" a reference. Such a reference could also be removed as prior art upon a showing that it was the inventor's own work.

- The pre-AIA system provided certain advantages to priority applications filed in the U.S. rather than in other countries. U.S. patents were considered prior art to other U.S. patents as of their earliest effective U.S. filing date. (This is often referred to as “secret prior art” or “§102(e) prior art.”) However, pre-AIA, U.S. patents were not considered prior art as of the filing date of their *foreign* priority documents (this was known as the Hilmer doctrine). Additionally, foreign priority documents filed during the one year grace period were not sufficient to prevent an earlier disclosure from being prior art.

The U.S. Patent System under AIA

The AIA moves to harmonize the U.S. patent system with that of the rest of the world by changing to a first-inventor-to-file system and by eliminating the Hilmer doctrine.

Since the AIA eliminates the first-to-invent system, issues of conception, diligence and reduction to practice will no longer be applicable to patentability, and ante-dating a reference to overcome prior art will no longer be available. Issues of abandonment, suppression and concealment of an invention will also become moot.

In moving to a first-inventor-to-file system, the AIA redefines what is prior art, including:

- The new §102 abolishes the distinction between foreign and domestic prior art. Specifically, prior art under the AIA includes both U.S. and foreign activities that are “in public use, on sale, or otherwise available to the public.” Previously, public use and on sale activities were only prior art if they occurred in the U.S.
- Published U.S. patent applications and U.S. patents are considered prior art as of their earliest effective filing date, irrespective of whether the earliest filing date is that of a U.S. or foreign priority document (thus, eliminating the Hilmer doctrine).
- The new one year grace period provided by the AIA (which will be discussed in detail in a subsequent Blank Rome AIA Alert) applies to both U.S. and foreign priority documents.
- The new §102 replaces the phrase “known or used by others,” with the phrase “otherwise available to the public.” This phrase may expand the types of prior art available.

In addition to the new one year grace period provided by the AIA, the AIA also introduces additional new exceptions to the definition of prior art, which we will address in the next *AIA Update*.

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