



## **America Invents Act: Patent Search Recommendations**

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## **America Invents Act: Patent Search Recommendations**

### **Introduction**

Patent searching following full implementation of the America Invents Act (AIA) necessitates some adjustments regarding patent search strategies. The effective date for the first-inventor-to-file provisions of AIA was Saturday, March 16, 2013. The purpose of this document is to summarize post AIA patent search strategy recommendations based on patent search type.

### **Patentability Searches**

Conducting a patentability search in support of an AIA patent application is simple from a prior art date perspective. Every potentially relevant published patent document should be considered by the searcher. In other words, no end date restriction is necessary when developing a patentability search strategy as all patents and patent application publications published before the filing date of the patent application under development are prior art excluding the exceptions defined under AIA USC § 102(b)(1) and (2).

### **Clearance Searches**

Clearance searches are sometimes defined using different terms including non-infringement, freedom-to-operate, and freedom-to-practice, but from a searcher's perspective the corresponding search strategies are relatively simple from a prior art date perspective. The full implementation of AIA should not be a significant factor with respect to clearance search work. The end date associated with a fielded search, where the search is limited by publication date range, is almost always the current date. The start (publication) date of the fielded search is guided by the client's preference for including both expired and/or abandoned prior art or for limiting the relevant references to only active prior art. A searcher performing a clearance search will typically not question the validity of any potentially relevant patent document when preparing the product clearance search report as corresponding invalidity investigations are typically requested based on further evaluation of the search results.

### **Invalidity Searches - Background**

US patent law and US PTO rule changes associated with AIA have become important factors with respect to future invalidity searches. A patent searcher assigned to an invalidity investigation is placed in a similar position to that of a patent examiner responsible for prosecuting a post AIA patent application or an issued patent, stemming from an AIA patent application or transition<sup>i</sup> patent application. The searcher may be supporting a petition for (AIA) Post-Grant Review, (AIA) Inter Partes Review, (AIA) Transitional Program for Covered Business Method Patents, or Ex parte Reexamination or possibly a request for (AIA) Supplemental Examination.

When operating in the pre AIA world, the patent examiner conducted a prior art search based on the application's effective filing date<sup>ii</sup>. The patent examiner compared the identified prior art to the claims of the patent application with respect to pre AIA 35 USC § 102(b), (e), and (a), in that order<sup>iii</sup>, prior to any comparison to the remaining sections of pre AIA USC § 102 and/or § 103.

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### Invalidity Searches - AIA USC § 102(a)(1)

A patent examiner evaluating a post AIA patent application, which includes transition applications, will follow a search procedure similar to that applied to pre AIA applications with respect to AIA USC § 102(a); however, some subtle differences between AIA USC § 102(a)(1) and pre AIA 35 USC § 102(a) will dictate the examiner's selection of prior art. Examiners will contrast the pre AIA 35 USC § 102(a) limitations related to inventive entity and "others" in comparison to AIA "inventor or a joint inventor" limitation as applied to post AIA 35 USC § 102(a)(1). With regard to pre AIA 35 USC § 102(a), MPEP 2132 clearly defines the term "others" as follows:

"The term "others" in 35 U.S.C. 102(a) refers to any entity which is different from the inventive entity. The entity need only differ by one person to be "by others." <sup>iv</sup>

By comparison, AIA 35 USC § 102(a)(1) broadens the earlier limitation to include both the inventor as well as a joint inventor when defining AIA 35 USC § 102(b)(1)(A) exceptions. The current examination guidelines describe the selection of AIA 35 USC § 102(b)(1)(A) exceptions as follows<sup>v</sup>:

"Office personnel will not apply a disclosure as prior art under AIA 35 U.S.C. 102(a)(1) if it is apparent from the disclosure itself that it is by the inventor or a joint inventor. Specifically, Office personnel will not apply a disclosure as prior art under AIA 35 U.S.C. 102(a)(1) if the disclosure:

- (1) was made one year or less before the effective filing date of the claimed invention;
- (2) names the inventor or a joint inventor as an author or an inventor; and
- (3) does not name additional persons as authors on a printed publication or inventors on a patent.

This means that in circumstances where an **application names additional persons as inventors** relative to the persons named as authors in the publication (e.g., the **application names as inventors A, B, and C**, and the **publication names as authors A and B**), and the **publication is one year or less before the effective filing date**, it is apparent that the disclosure is a grace period inventor disclosure, and the publication would **not be treated as prior art** under AIA 35 U.S.C. 102(a)(1)."

From a patent searcher's perspective, a detailed comparison of inventors identified in potentially eligible patent document prior art versus the patent document subject to an invalidity investigation may be better left to the counsel responsible for associated legal opinion work. This bulletin recommends that the person responsible for an invalidity search report all AIA 35 U.S.C. 102(a)(1) potentially eligible patent references, from a publication date and subject matter perspective, and also report any concerns regarding potential AIA 35 USC § 102(b)(1)(A) or 35 USC § 102(b)(1)(B) exceptions. Counsel can evaluate possible AIA 35 USC § 102(b)(1) exceptions during the post search phase of the invalidity study.

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### Invalidity Searches - AIA USC § 102(a)(2)

A patent examiner evaluating an AIA patent application, which includes transition applications, will likely modify his or her prior art search strategies when identifying post AIA 35 USC § 102(a)(2) references as compared to previous pre AIA 35 USC § 102(e) references. Previous pre AIA 35 USC § 102(e) restrictions did not permit the use of foreign priority dates. In fact, special “DO NOT consider foreign priority claims” footnote reminders are included on each of the 35 USC § 102(e) flow charts found in chapter 700 of the MPEP<sup>vi</sup>. In addition, pre AIA 35 USC § 102(e) restricted eligible PCT applications to: (1) filing dates on or after November 29, 2000; (2) PCT applications which published in English and; (3) PCT applications which designated the US. AIA 35 USC § 102(a)(2) has eliminated the foreign priority date restriction for US patents, US published patent applications and PCT applications that have designated the US. With regard to the last remaining PCT application restriction, as of January 1, 2004, the mere filing of a PCT request constitutes the designation of all Contracting States<sup>vii</sup>. Not only have the international filing date (November 29, 2000) and English language publication requirements been eliminated, but the PCT application does not have to enter the US national stage<sup>viii</sup> to be eligible as AIA 35 USC § 102(a)(2) prior art. In practical terms, this means the vast majority of PCT applications filed after January 1, 2004 should be considered as AIA 35 USC § 102(a)(2) potential prior art based on the subject matter combined with the earliest priority date. One of the most important AIA facts to remember is that AIA 35 USC § 102(a)(2) is based on the effective filing date of the a US patent, US patent application, or PCT application where AIA defines the effective filing date as follows:

“The AIA defines the term “effective filing date” for a claimed invention in a patent or application for patent (other than a reissue application or reissued patent) as the earliest of: (1) The actual filing date of the patent or the application for the patent containing the claimed invention; or (2) the filing date of the earliest application for which the patent or application is entitled, as to such invention, to a right of priority or the benefit of an earlier filing date under 35 U.S.C. 119, 120, 121, or 365.”<sup>ix</sup>

Patent searcher’s responsible for invalidity studies associated with AIA patents, including transition applications, should tailor search strategies to capture relevant AIA 35 USC § 102(a)(2) references. This bulletin recommends restricting the patent collections associated with the AIA 35 USC § 102(a)(2) portion of an invalidity study to US granted patents, US published patent applications, and PCT published patent applications. Since AIA 35 USC § 102(d) lifts the restriction on foreign priority claims for AIA 35 USC § 102(a)(2) rejections, as compared to pre AIA 35 USC § 102(e), searchers should consider utilizing the earliest priority date field, if available, in their patent search system of choice to define the search query date range.

Patent searchers should also be mindful of the AIA “common ownership” provision, which is defined as the AIA 35 USC § 102(b)(2)(C) exception. The current examination guidelines provide the following warning<sup>x</sup>:

“The consequence of this distinction is that a published application or an issued patent that falls under the common ownership exception of AIA 35 U.S.C. 102(b)(2)(C) may not be applied in either an anticipation or an obviousness rejection.”

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This bulletin recommends that the searcher report all AIA 35 U.S.C. 102(a)(2) potentially eligible patent references, from a publication date and subject matter perspective, and also report any concerns regarding potential AIA 35 USC § 102(b)(2)(A) through(C) exceptions. Counsel can evaluate possible AIA 35 USC § 102(b)(2) exceptions during the post search phase of the invalidity study.

### Invalidity Searches - AIA USC § 102(a)(2) Examples

	Prior Art Reference	1 <sup>st</sup> priority reference*	2 <sup>nd</sup> (Earlier) priority reference*
Scenario 1	✓US Reference	None	None
Scenario 2	US Reference	✓US Priority Reference	None
Scenario 3	US Reference	US Priority Reference	✓US Priority Reference
Scenario 4	US Reference	✓Foreign Priority Reference	None
Scenario 5	US Reference	Foreign Priority Reference	✓Foreign Priority Reference
Scenario 6	US Reference	✓PCT Priority Reference US Designated Did not enter US National Stage	None
Scenario 7	US Reference	PCT Priority Reference US Designated Entered US National Stage	✓Foreign Priority Filing Date
Scenario 8	US Reference	PCT Priority Reference US Designated Did not enter US National Stage	✓Foreign Priority Filing Date
Scenario 9	Foreign Reference		
Scenario 10	Foreign Reference	Foreign Reference	
Scenario 11	Foreign Reference	Foreign Reference	Foreign Reference

✓Earliest AIA 35 USC § 102(a)(2) Effective Filing Date (EFD)

\* Priority reference perfected under 35 USC § 119(a)-(d), 119(e), 120, 121, or 365

<sup>i</sup> pp 11024 to 11059 of Federal Register / Vol. 78, No. 31 / Thursday, February 14, 2013 / Rules and Regulations

<sup>ii</sup> US PTO MPEP 706.02 Rejection on Prior Art [R-9] VI. DETERMINING THE EFFECTIVE FILINGDATE OF THE APPLICATION, p 700-21

<sup>iii</sup> US PTO MPEP 706.02(a) Rejections Under 35 U.S.C. 102(a), (b), or (e); Printed Publication or Patent [R-3] II. DETERMINING WHETHER TO APPLY 35U.S.C. 102(a), (b), or (e), pp 700-22 to 700-24

<sup>iv</sup> US PTO MPEP 2132 35 U.S.C. 102(a) III. "BY OTHERS" "Others" Means Any Combination of Authors or Inventors Different Than the Inventive Entity p 2100-74

<sup>v</sup> pp 11076 Federal Register / Vol. 78, No. 31 / Thursday, February 14, 2013 / Rules and Regulations

<sup>vi</sup> US PTO MPEP 706.02(f)(1) Examination Guidelines for Applying References Under 35 U.S.C. 102(e) [R-5] II. EXAMPLES pp700-35 and 700-36

<sup>vii</sup> US PTO MPEP 1817.01 Designation of States in International Applications Having an International Filing Date On or After January 1, 2004 [R-5] PCT Rule 4 The Request (Contents) p 1800-17

<sup>viii</sup> pp 11071 Federal Register /Vol. 78, No. 31 /Thursday, February 14, 2013 /Rules and Regulations

<sup>ix</sup> pp 11073 of Federal Register /Vol. 78, No. 31 /Thursday, February 14, 2013 /Rules and Regulations

<sup>x</sup> pp 11080 Federal Register / Vol. 78, No. 31 / Thursday, February 14, 2013 / Rules and Regulations