

America Invents Act (AIA) – Pre-issuance Submission - Potential Prior Art

On September 16, 2011, the Leahy-Smith America Invents Act commonly referred to as "AIA" was enacted into law (P.L. 112-29). President Barack Obama signed the AIA, which represented more than eight years of considerable effort to modernize the U.S. patent system. The law represents the most significant change to the U.S. patent system since 1952. The U.S. patent system went from "First to Invent" to "First Inventor to File" regime among other changes. Thus, the law ushered a new era in the U.S. patent system. The law implements policies long overdue. For example, during the House floor debate, reference was made to issues affecting the patent system, e.g., "[a] major contributing factor to the problem of abusive patent litigation is the issuance of ambiguous or poor quality patents," "an overburdened and lethargic patent system.....," "quality patents should be issued in the first place..." As a result, amendments aimed at strengthening the patent examination process were instituted. One such amendment is the "pre-issuance submission." The text reads as follows: "Any third party may submit any publication of potential relevance to a patent application...." The examiner determines whether or not the prior art can be used to reject an application. This device provides an avenue "to educate the reviewer" about the existence of potential *relevant prior art* that may be used in the examination process. Hopefully, such public interaction with the patent system will eventually lead to quality patents being issued. Potential Prior Art is identified pursuant to 35 U.S.C. §102(a). There are only two subsections of the AIA that identify potential prior art namely, 102(a)(1); and 102(a)(2). 35 U.S.C. §102(a)(1) is for **public disclosures** that have a public availability date before the effective filing date of the claimed invention; and 35 U.S.C. §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. The availability of a disclosure as prior art under 102(a)(1) or 102(a)(2) depends upon the effective filing date of the claimed invention. The AIA provides that a foreign priority date can be the *effective filing date* of a claimed invention. The foreign priority date is treated as the *effective filing date* of the claimed invention if: (1) 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 the application was not originally filed in English. There are exceptions to above-identified relevant prior art. These exceptions are defined by 35 U.S.C. §102(b)(1) and 35 U.S.C. §102(b)(2). The inventor is afforded a grace period for disclosures made before the application was filed and a third party is also afforded a grace period for intervening disclosure. Other exceptions include disclosure obtained from an inventor, intervening disclosure by third party and commonly owned disclosures.

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