

IP Client Alert #3

America Invents Act: What is prior art?

Previously

Patents and publications were available as prior art from anywhere in the world, and knowledge, public use and sales were available as prior art only from activities in the United States.

Under the AIA

Patents, publications, public use, sales before the filing date are prior art. Sec. 102(a)(1) and (2). *Effective for applications filed on or after 9/16/2012.*

Exception: a publication or disclosure by the inventor or joint inventor made within the year before the filing date is not prior art. Sec. 102(b)(1)(A) *Effective for applications filed on or after 9/16/2012.*

Exception: A "same inventor" patent or application (#1) is not prior art against a later filed claimed invention (#2) having the same inventor or joint inventor if the inventor or joint inventor had already publicly disclosed the subject matter (of #1) before the filing date of the (#1) patent or application. Sec. 102(b)(2)(B) *Effective for applications filed on or after 9/16/2012.*

Exception: A patent or published application (#1) is not prior art against (#2) a claimed invention if they were commonly owned at the time of filing. Sec. 102(b)(2)(C). *Effective for applications filed on or after 3/16/2013.*

The definition of commonly owned includes subject matter and claimed inventions that were developed under a joint research agreement, where the agreement was in effect at the time of filing, the claimed invention was made as a result of the agreement, and the application is amended to state the names of the parties to the joint research agreement. Sec. 102(c). *Effective for applications filed on or after 3/16/2013.*

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