

# Prior Art Under 35 U.S.C. §102(e) An Update

## EFFECT OF H.R. 2215

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The recently passed H.R. 2215<sup>1</sup> has important ramifications for 102(e) dates of, particularly, patents issuing from foreign priority applications. 35 U.S.C. §102(e) applies to published patent applications or patents that are filed before but issue after the filing date of an application and disclose but do not claim the subject matter claimed in said application. H.R. 2215 addresses the U.S. Patent and Trademark Office's (U.S.P.T.O.'s) interpretation of 35 U.S.C. §102(e) as amended by the American Inventor's Protection Act of 1999<sup>2</sup> (AIPA). In order to understand the significance of the amendments enacted by H.R. 2215, this article will (1) summarize pre-AIPA and post-AIPA 102(e) and related 35 U.S.C. §374 provisions, (2) discuss the effect of H.R. 2215 on the 102(e) date of a pending application or issued patent and (3) provide practice tips regarding means for obtaining earliest possible 102(e) dates.

### PRE-AIPA 35 U.S.C. §102(e) AND §374

Prior to the effective date of November 29, 2000 of the AIPA, 35 U.S.C. §102(e) and §374 read as follows:

#### Pre-AIPA 102(e)<sup>3</sup>

A person shall be entitled to a patent unless-

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of (1), (2), and (4) of section 371( c) of this title before the invention thereof by applicant for patent.

#### Pre-AIPA 374<sup>4</sup>

The publication under the treaty of an international application shall confer no rights and shall have no effect under this title other than that of a printed publication.

An issued patent with a foreign priority date was prior art for 35 U.S.C. §102(e) purposes only as of when it was actually filed in the United States. If the U.S. application was filed as a national stage application under 35 U.S.C. §371, the 102(e) date was the date when all requirements were fulfilled. These requirements include submission of the application<sup>5</sup>, fee and signed and dated Declaration and Power of Attorney<sup>6</sup>. For example, if X filed a priority application in the U.K. on January 2, 1996, a PCT application on January 2 1997, entered the national phase on July 1, 1998, submitted the executed Declaration and Power of Attorney on September 1, 1998; the 102(e) date would not be until September 1, 1998.

Published International applications before the enactment of AIPA were only considered to be prior art as of the date of publication<sup>7</sup>. Therefore, these published applications would only be prior art under 35 U.S.C. §102(a) or 102(b). They were not considered to be any different from any other publications.

### 35 U.S.C. §102(e) AND §374 UNDER AIPA

Significant amendments to 35 U.S.C. §§102(e) and 374 were made by the AIPA and were effective as of November 29, 2000<sup>8</sup>: 35 U.S.C. 102(e)(1) and 374 provided a new category of prior art under 35 U.S.C. §102(e), patent application publications. Additionally, 35 U.S.C. §102(e)(2) under the AIPA stated<sup>9</sup>

A person shall be entitled to a patent unless the invention was described in.....

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

The U.S. Patent and Trademark Office interpreted 35 U.S.C. §102(e)(2) to apply only to international applications designating the U.S. or non-provisional U.S. applications filed on or after November 29, 2000<sup>10</sup>. Furthermore, it was the U.S. P.T.O.'s position that neither pre or post-AIPA 35 U.S.C. §102(e) would apply to patents issuing from foreign priority applications and/or interna-

tional applications filed prior to November 29, 2000 where the national stage was entered under 35 U.S.C. §371 after November 29, 2000<sup>11</sup>. Therefore, international applications filed prior to November 29, 2000 and entering the national stage in the U.S. on or after November 29, 2000, would not be entitled to a 102(e) date since pre-AIPA 102(e) was considered not to apply.

### H.R. 2215 AND ITS CONSEQUENCES

The Intellectual Property and High Technology Technical Amendments Act of 2001 was introduced in the Senate on February 13, 2001<sup>12</sup>. It has been speculated that this bill may have resulted from the U.S.P.T.O.'s interpretation of 35 U.S.C. §102(e) as amended by the AIPA.<sup>13</sup> The Technical Amendments Act did pass the Senate but was ultimately incorporated into H.R. 2215<sup>14</sup>. H.R. 2215 revises 35 U.S.C. §§102(e) and 374 as follows<sup>15</sup>:

#### 102(e) as Amended by H.R. 2215

A person shall be entitled to a patent unless the invention was described in

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent,

except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language

#### 35 U.S.C. §374 as Amended by H.R. 2215

The publication under the treaty defined in section 351(a) of this title, of an international application designating the United States shall be deemed a publication under section 122(b), except as provided in sections 102(e) and 154(d) of this title.

Under 35 U.S.C. §§102(e)(1) and 374, two types of publications are included: (1) U.S. publication of patent applications filed by another in the United States which are published under 35 U.S.C. §122(b) and (2) publication of international applications that were filed by another, designated the U.S. and published in the English language.

Section 4508 of H.R. 2215 provides that the revisions to 35 U.S.C. §§102(e) and 374 are completely retroactive except for patents or publications based on international (e.g., PCT)

applications filed prior to November 29, 2000<sup>16</sup>. Therefore, the provisions of H.R. 2215 applies to all applications being examined and all patents under reexamination deriving from non-provisional U.S. applications or international applications filed on or after November 29, 2000. If such an international application was filed before November 29, 2000, then pre-AIPA 35 U.S.C. 102(e) applies<sup>17</sup>.

The table below provides a comparison of pre and post-AIPA 102(e) dates in view of H.R. 2215<sup>18</sup>.

## SUMMARY

As a consequence of H.R. 2215, an international application filed on or after November 29, 2000 is available as a possible prior art reference under 35 U.S.C. 102(e)(1) as long as it designates the U.S. and is published in English. Such publications would be considered to be prior art as of their earliest effective U.S. filing date. For example, if A filed a U.S. provisional application on January 2, 2001, then a PCT application January 2, 2002, which designated the U.S. and was published on July 14, 2002, A's

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application would be prior art as of January 2, 2001.

Pre-AIPA 102(e) applies to all international applications filed before November 29, 2000 even if a U.S. national stage application was filed under 35 U.S.C. §371 (e.g., on 30 month date). The 102(e) date in such circumstances would be the date that all requirements were met under 35 U.S.C. §371. In

International applications filed prior to November 29, 2000 even where the first priority application was a provisional application, the applicant **would not** be able to claim the date of filing of the provisional application unless a regular U.S. utility application was filed on the convention date.

In view of H.R. 2215 revisions to 35 U.S.C. §102(e), an applicant should always file either U.S. provisional or non-provisional priority applications. Furthermore, any subsequent international (PCT) applications should be published in English. These actions should afford the applicant with the earliest possible 102(e) date. **IPT**

### **Comparison of Pre and Post-AIPA 35 U.S.C. §102 (e) Dates of Prior Art References**

Type of Reference	Pre- AIPA § 102(e) Prior Art Dates-non-provisional U.S. or international applications filed prior to 11/29/00	Current § 102(e) Prior Art Dates-non-provisional U.S. or international applications filed on or after 11/29/00
U.S. publication of non-provisional U.S. application	None – applications were not published	Effective filing date, including any international filing date or U.S. provisional application filing date
U.S. publication of U.S. national stage application	None – applications were not published	International filing date or any earlier effective filing date, e.g., provisional application date if published in English
WIPO publication of international application	None - publication existed but no provision in Pre-AIPA §102(e) to use as prior art; only art as of date of publication under 35 U.S.C. §102(a) or (b)	International filing date or any earlier effective filing date, e.g., provisional application date if subsequent international application designates U.S. and published in English
U.S. patent from U.S. patent application	Effective U.S. filing date	Effective filing date, including any international filing date or U.S. provisional application filing date
U.S. patent from foreign priority application, subsequent international application and national stage application in U.S. (35 U.S.C. §371)	§ 371(c)(1),(2)&(4) fulfillment date-after filing national stage application, submission of Declaration and Power of Attorney and Fee	International filing date if application is published in English
U.S. patent from U.S. provisional application, subsequent international application and national stage application in U.S. (35 U.S.C. §371)	§ 371(c)(1),(2)&(4) fulfillment date-after filing national stage application, submission of Declaration and Power of Attorney and Fee	Effective filing date-U.S. provisional application date (if enabling disclosure and adequate written description provided in provisional application)

## ENDNOTES

1. 21st Century Department of Justice Appropriations Authorization Act of 2002, Pub. L. No. 107-273, 116 Stat. 1758 (2002).
2. American Inventors Protection Act of 1999 (AIPA) (Pub. L. No. 106-113, 113 Stat. 1501 (1999)).
3. 35 U.S.C. §102(e) (1999) (citations omitted), amended by 35 U.S.C. 102 (2002).
4. 35 U.S.C. §374 (1999) (citations omitted), amended by 35 U.S.C. 102 (2002).
5. 35 U.S.C. §371(a)-application may be transmitted by International Bureau.
6. 35 U.S.C. §371(c)(4) and (d) (1999).
7. 35 U.S.C. §102 (1999).
8. Pub. L. No. 106-113 (1999).
9. 35 U.S.C. §102(e) (2001).
10. Manual of Patent Examining Procedure (MPEP), 8th Ed., Sections 1895.01 and 2136 et seq.(August 2001).
11. Id.
12. Intellectual Property and High Technology Technical Amendments Act of 2001, S. 320, 107th Cong. §4505 (2001).
13. See Robert Henry, "Technical" Amendments to 35 U.S.C. §102(e): Another Instance of the Doctrine of Unintended Consequences?", 9 IP Today 8 (2002)
14. See H.R. REP. No. 107-18 (2002) for further commentary.
15. Section 4505 of Pub. L. No. 107-273 (2002)
16. Section 4508 of Pub. L. 107-213 (2002)
17. Id.
18. For further discussion and examples see "Examination Guidelines for 35 U.S.C. §102(e), as amended by AIPA of 1999, and further amended by the Intellectual Property and High Technology Technical Amendments Act of 2002 and 35 U.S.C. §102(g)", downloadable from [www.uspto.gov](http://www.uspto.gov).