

## **Examination Guidelines for 35 U.S.C. § 102(e)(2), as amended by the American Inventors Protection Act of 1999**

This notice sets forth the interpretation by the United States Patent and Trademark Office (USPTO or Office) of 35 U.S.C. § 102(e)(2), as amended the American Inventors Protection Act of 1999 (AIPA). Pub. L. 106-113, 113 Stat. 1501 (1999). Specifically, this notice provides guidance to patent examiners and the public as to why the filing date of an application being examined is important and when United States **patents** are available as prior art. Further, this notice provides examples of common situations that will arise. At this time, the Office is not providing guidance as to its interpretation of new prior art treatment of application publications under § 102(e)(1). Such guidance will be provided in a future Official Gazette notice.

### SUMMARY:

First, the AIPA establishes when the amendments to § 102(e) are effective. According to the AIPA, the new criteria for determining patentability under post-AIPA § 102(e) will apply to applications: (a) filed on or after November 29, 2000, or (b) that have been voluntarily published. Thus, the revised patentability defeating provisions of post-AIPA § 102(e) are only prospective in nature. The criteria for determining patentability under pre-AIPA § 102(e) will apply to applications filed before November 29, 2000, and not voluntarily published pursuant to 35 U.S.C. § 122(b). As a result, the filing date of the application being examined is a factor in determining which version of § 102(e) applies, *i.e.*, pre-AIPA § 102(e) or post-AIPA § 102(e).

Second, paragraph (e) of 35 U.S.C. § 102 was amended by the AIPA to eliminate the reference to fulfillment of the 35 U.S.C. § 371(c)(1), (2) and (4) requirements. As a result, United States **patents** issued directly from International Applications will no longer be available as prior art under post-AIPA § 102(e)(2) as of the date the requirements of § 371 (c)(1), (2) and (4) have been satisfied. Post-AIPA § 102(e)(2) also precludes the use of the international filing date as a United States filing date for purposes of determining the earliest effective prior art date of a patent. Thus, under the AIPA, United States **patents** issued directly from International Applications do not have a “§ 102(e)(2)” date.

As illustrated in the examples, the effective prior art dates for **patents** being applied as references under pre and post-AIPA § 102(e) are the same except for **patents** issued directly from International Applications having fulfilled the National Stage requirements or from continuing applications of International Applications having fulfilled the National Stage requirements.

DISCUSSION: Sections I –VI below set forth the USPTO’s examination procedures for the amendments to 35 U.S.C. § 102(e) made by the AIPA.

### **I) Statutory Language of 35 U.S.C. § 102(e):**

*Pre-AIPA § 102(e): For Applications Filed before November 29, 2000 which are not Voluntarily Published:*

“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 paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by applicant for patent, or”.

*Post-AIPA § 102(e): For Applications Filed on or after November 29, 2000, and Applications Filed prior to November 29, 2000 which are Voluntarily Published:*

A person shall be entitled to a patent unless-

(e) 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, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; 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 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); or

## **II) Impact of Statutory Changes and Effective Date of the Changes**

Paragraph (e) of 35 U.S.C. § 102 was amended by the AIPA. What U.S. **patents** are available as prior art under this subsection has been modified as post-AIPA § 102(e)(2) no longer recognizes the date of fulfillment of the 35 U.S.C. § 371(c)(1), (2) and (4) requirements for prior art purposes. Post-AIPA § 102(e)(2) also precludes the use of the international filing date as a United States filing date for purposes of determining the earliest effective prior art date of a patent. Thus, under post-AIPA § 102(e)(2), **patents** issued directly from the National Stage of International Applications are not available as prior art since they have no § 102(e)(2) date at all.

Paragraph (e) of 35 U.S.C. § 102 was also amended to establish the criteria for when publications of U.S. patent applications and International Applications may be available as prior art (post-AIPA § 102(e)(1)) as of their earliest effective filing dates. While a patent issued from an International Application may not be available as prior art under post-AIPA § 102(e)(2), the same disclosure in the form of an application publication may

be available prior art under post-AIPA § 102(e)(1) as of the international filing date. Guidance on post-AIPA § 102(e)(1) will be provided in a future Official Gazette notice.

The AIPA establishes when the amendments to § 102(e) must be applied during the examination process. First, the AIPA sets forth that the amendments to § 102(e) apply to all applications filed under 35 U.S.C. § 111 that were filed on or after November 29, 2000 and all applications complying with 35 U.S.C. § 371 that resulted from International Applications filed on or after November 29, 2000. See § 4508 of the AIPA. Second, the AIPA provides that the amendments to § 102(e) also apply to any application that is voluntarily published. See the second sentence of § 4508 of the AIPA. Because § 102(e) is “applied” to the claims of an application during examination to determine patentability, post-AIPA § 102(e) is only used to determine the prior art dates of United States patents or patent application publications when examining the above noted classes of applications.

Accordingly, any application filed before November 29, 2000 that is not voluntarily published is subject to pre-AIPA § 102(e). Therefore, pre-AIPA § 102(e) is used to determine the prior art dates of United States patents when examining such applications.

### **III) Applications Subject to Post-AIPA § 102(e)(2)**

All applications filed on or after November 29, 2000 (including International Applications filed on or after November 29, 2000 that have fulfilled the National Stage requirements) and applications filed before November 29, 2000 that are **voluntarily published**, must be examined in view of **patents**, whenever granted, with effective prior art dates per post-AIPA § 102(e)(2).

The following applications, when examined, will be subject to prior art available and accorded prior art dates under post-AIPA § 102(e)(2):

- (1) utility, design and plant patent applications (including first-filed applications, continuing applications under 37 CFR 1.53(b), continued prosecution applications (CPAs) under 37 CFR 1.53(d), and reissues) filed under 35 U.S.C. § 111(a) on or after November 29, 2000;
- (2) International Applications complying with National Stage requirements (35 U.S.C. § 371(c)) having international filing dates on or after November 29, 2000; and
- (3) applications filed before November 29, 2000 and pending on November 29, 2000 that are voluntarily published by the applicant under the publication procedures of the USPTO (see 37 CFR 1.221).

All other applications, not listed in 1-3 above, must continue to be examined in view of pre-AIPA § 102(e).

#### IV) Applications Subject to Pre-AIPA § 102(e)

All applications **filed before November 29, 2000**, and not voluntarily published pursuant to 35 U.S.C. § 122(b), will be examined in view of pre-AIPA § 102(e). In addition, pre-AIPA § 102(e) continues to apply regardless of whether: (1) applicant files a request for consideration of a submission under 37 CFR 1.129(a), (2) applicant files a request for continued examination (RCE) under 37 CFR 1.114, or (3) a request for reexamination is filed on a patent issued from the application.

#### V) Examination Procedures under Pre-AIPA § 102(e) and Post-AIPA § 102(e)(2)

(1) Determine which version of § 102(e) applies to the application being examined, as follows:

(a) If the application being examined was filed **before November 29, 2000** and has **not been voluntarily published** pursuant to 35 U.S.C. § 122(b), then the application is examined under pre-AIPA § 102(e). This includes an International Application complying with National Stage requirements having an international filing date prior to November 29, 2000 and which has not been voluntarily published. A request for continued examination (RCE) under 37 CFR 1.114 does not change the status of the application even if the RCE is filed on or after November 29, 2000.

(b) If the application being examined was **filed on or after November 29, 2000**, or was filed prior to November 29, 2000 but **was voluntarily published** pursuant to 35 U.S.C. § 122(b), then the application is examined under post-AIPA § 102(e). This includes an International Application complying with National Stage requirements having an international filing date on or after November 29, 2000, or having an international filing date prior to November 29, 2000 but voluntarily published pursuant to 35 U.S.C. § 122(b). The Patent Application Location and Monitoring (PALM) system will be modified to indicate the publication status of an application.

(c) Examiners should provide a copy of the appropriate § 102(e) text in the first Office action utilizing such a rejection. The Office action should make it clear whether the pre or post-AIPA version of § 102(e) is being relied upon. Form paragraphs for providing this material will be provided in due course.

(2) Determine the effective filing date(s) of the application being examined.  
See the Manual of Patent Examining Procedure (MPEP), sections 706.02, 1893.03(b), 1893.03(c), 1895 and 1895.01, Seventh Edition (rev. 1, Feb. 2000).

(3) Determine and perform an appropriate prior art search.

The Examiner should search for the most relevant prior art under 35 U.S.C. §§ 102 and 103, including patents accorded prior art dates under post-AIPA § 102(e)(2), if appropriate.

(4) Determine the appropriate § 102(e) date for each reference, if necessary, by following the guidelines and examples set forth under Part VI below:

- (a) Examiners should be aware that although a U.S. Patent based upon an International Application may not have a post-AIPA § 102(e)(2) date, the corresponding World Intellectual Property Organization (WIPO) publication of an International Application (published under PCT Article 21(2)) will likely have an earlier § 102(a) or (b) date.
- (b) Examiners should note that an appropriate prior art rejection under pre-AIPA § 102(e) made in an application filed before November 29, 2000 based on a U.S. patent issued from an International Application (the patent having a prior art date under pre-AIPA § 102(e) as of the § 371(c)(1), (2) and (4) fulfillment date) may be overcome by voluntary publication of the application being examined. The identical disclosure of the U.S. patent issued from the International Application, however, is likely to be published by WIPO prior to the patent's § 371(c)(1), (2) and (4) fulfillment date.

Thus, examiners are encouraged to apply the WIPO publication under § 102(a) or (b) against claims being examined in applications filed prior to November 29, 2000 rather than the patent issued from the International Application which had fulfilled the National Stage requirements. In the event that the patent is used, but the rejection must be withdrawn in view of voluntary publication, the examiner should look for the WIPO publication, and apply it, if appropriate. Such a rejection based on the WIPO publication may not be made final the first time it is made as the rejection was not necessitated by an amendment to the claims.

(5) Determine whether common assignee considerations apply.

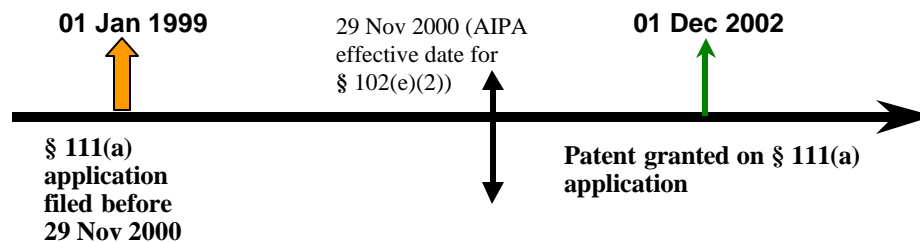
If a § 102(e) reference is applied in an obviousness rejection under 35 U.S.C. § 103 (including provisional rejections) in an application filed on or after November 29, 1999, the examiner should ascertain whether there is evidence that the claimed invention and the reference were owned by the same person, or subject to an obligation of assignment to the same person, at the time the claimed invention was made. A clear statement of entitlement to the prior art exclusion by applicant(s) or a registered practitioner would be sufficient evidence to establish the prior art exclusion. See "Guidelines Concerning the Evidence of Common Ownership, or an Obligation of Assignment to the Same Person, as Required by 35 U.S.C. 103(c)," 1241 O.G. 96 (Dec. 26, 2000) which modifies "Guidelines Concerning the Implementation of Changes to 35 USC 102(g) and 103(c) and the Interpretation of the Term 'Original Application' in the American Inventors Protection Act of 1999," 1233 O.G. 54, 55-56 (April 11, 2000).

## **VI) Examples**

In order to illustrate the prior art dates of patents under post-AIPA § 102(e)(2), seven examples are presented below. The first two examples are limited to patents issued from only applications filed under § 111(a) and/or (b). The remaining five examples are for patents issued directly or indirectly from International Applications. The examples show the effect on applications filed prior to and after November 29, 2000, the effective date of the amendments to § 102(e) made by the AIPA. The dates in the examples below are arbitrarily used and are presented for illustrative purposes only. In the examples, IA, and WIPO has been used for International Application and the World Intellectual Property Organization, respectively.

**Example 1:** Reference Patent Issued from an Application Filed under 35 U.S.C. § 111(a) with No Priority Claim.

For reference patents issued from only applications filed under 35 U.S.C. § 111(a), the prior art dates accorded these reference patents are the same under pre and post-AIPA § 102(e). Thus, a patent issued from a § 111(a) application, which does not claim any benefit under either 35 U.S.C. §§ 119(e) or 120, would be accorded the application's filing date as its prior art date.



**1. Post-AIPA § 102(e)(2) date of the patent: 01 Jan 1999**

This patent is available as prior art against:

- (a) any application filed on or after 29 Nov 2000; or
- (b) any application filed after 01 Jan 1999 but before 29 Nov 2000, which has been voluntarily published.

**2. Pre-AIPA § 102(e) date of the patent: 01 Jan 1999**

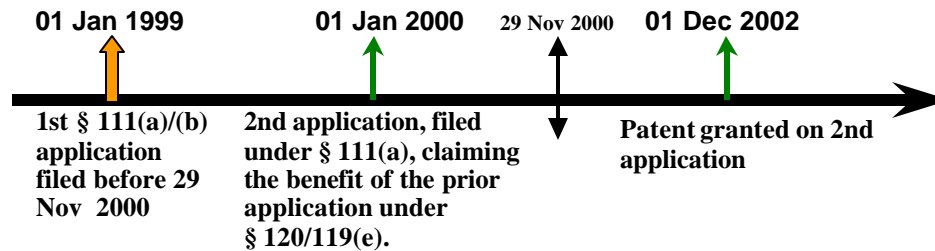
This patent is available as prior art against:

- (a) any application filed after 01 Jan 1999 but before 29 Nov 2000, which has not been voluntarily published.

**Note:** In this example, the post-AIPA § 102(e)(2) date and the pre-AIPA § 102(e) date are the same, 01 Jan 1999

**Example 2:** Reference Patent Issued from an Application Filed under 35 U.S.C. § 111(a) with a Domestic Priority/Continuity Claim.

For reference patents issued from applications filed under § 111(a) claiming the benefit under 35 U.S.C. §§ 119(e) or 120 of a prior application, the prior art dates accorded these reference patents are the same under pre and post-AIPA § 102(e). Thus, a patent issued from such application would be accorded the prior application's filing date as its § 102(e) prior art date assuming that the prior application provides proper support for the relied upon subject matter.



**1. Post-AIPA § 102(e)(2) date of the patent: 01 Jan 1999**

This patent is available as prior art against:

- (a) any application filed on or after 29 Nov 2000; or
- (b) any application filed after 01 Jan 1999 but before 29 Nov 2000 which has been voluntarily published.

**2. Pre-AIPA § 102(e) date of the patent: 01 Jan 1999**

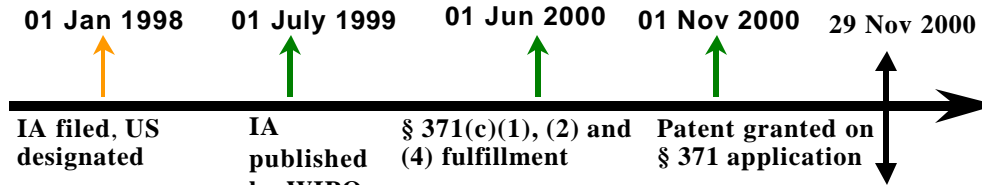
This patent is available as prior art against:

- (a) any application filed after 01 Jan 1999 but before 29 Nov 2000 which has not been voluntarily published.

**Note:** As in example 1, the post-AIPA § 102(e)(2) date and the pre-AIPA § 102(e) date are the same.

**Example 3:** Reference Patent Issued Directly from an International Application (a § 371 Application)

For reference United States patents issued directly from International Applications the prior art dates accorded to reference patents under post-AIPA § 102(e)(2) are **different** than the prior art date accorded under pre-AIPA § 102(e). A United States patent issued from an International Application will have neither the international filing date, nor its “§ 371(c)(1), (2) and (4) date,” as its post-AIPA § 102(e)(2) date. Thus, such patent have no prior art date under post-AIPA § 102(e)(2). Obviously, the patent would continue to have its grant or publication date as a prior art date under §§ 102(a) and (b). In addition, International Applications published in the English language may be available as prior art as of their international filing date under post-AIPA § 102(e)(1).



**1. Post-AIPA § 102(e)(2) date of the patent: NONE**

The patent is not available as prior art under post-AIPA § 102(e)(2)

(because there is no date under post-AIPA § 102(e)(2)) against:

(a) any application filed on or after 29 Nov 2000; or

(b) any application which has been voluntarily published.

The patent is usable under §§ 102(a) or (b) with a prior art date of 01 Nov 2000

**2. Pre-AIPA § 102(e) date of the patent: 01 Jun 2000**

This patent is available as prior art against:

(a) any application filed after 01 Jun 2000 but prior to 29 Nov 2000 which has not been voluntarily published.

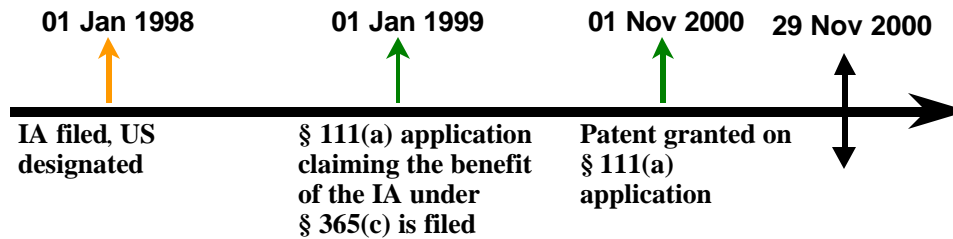
**Notes:** (1) There is no date under the post-AIPA § 102(e)(2) while there is a date under the pre-AIPA § 102(e).

(2) WIPO publication § 102(a) or (b) date is 01 Jul 1999.

**Example 4:** Reference Patent Issued from an Application Filed under 35 U.S.C. § 111(a), which is a Continuation of an International Application.

For reference patents issued from applications filed under 35 U.S.C. § 111(a), which claim the benefit of the filing dates of prior International Applications pursuant to 35 U.S.C. §§ 120 and 365(c), the prior art dates accorded these patents are the **same** under pre and post-AIPA § 102(e). A patent issuing from an application filed under 35 U.S.C. § 111(a), which claims the benefit of the filing date of a prior International Application under 35 U.S.C. §§ 120 and 365(c), will be accorded the § 111(a) filing date as its § 102(e) prior art date.





**1. Post-AIPA § 102(e)(2) date of the patent: 01 Jan 1999**

The patent is available as prior art against:

- (a) any application filed on or after 29 Nov 2000; or
- (b) any application filed after 01 Jan 1999 but before 29 Nov 2000 which has been voluntarily published.

**2. Pre-AIPA § 102(e) date of the patent: 01 Jan 1999**

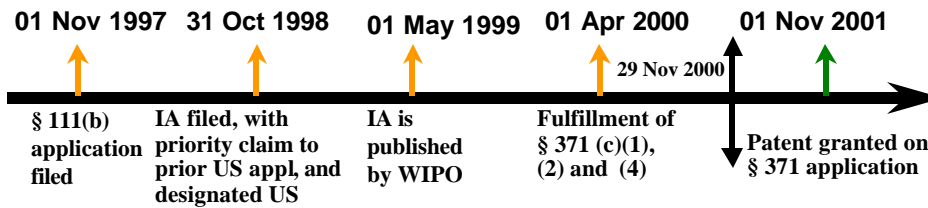
The patent is available as prior art against:

- (a) any application filed after 01 Jan 1999 but before 29 Nov. 2000 which has not been voluntarily published.

**Note:** The post-AIPA § 102(e)(2) date and the pre-AIPA § 102(e) date are the same, 01 Jan 1999.

**Example 5:** Reference Patent Issued from an International Application Complying with National Stage requirements, which International Application Claims Priority to a United States Patent Application.

For reference United States patents issuing from International Applications complying with National Stage requirements, which claim priority to prior United States patent applications under 35 U.S.C. §§ 119(e) or 120 and 365(c), the prior art dates accorded these reference patents by post-AIPA § 102(e)(2) are **different** than the prior art dates accorded by pre-AIPA § 102(e). A patent issued from an International Application complying with National Stage requirements that claims the benefit of the filing date of an earlier United States application has no prior art date under post-AIPA § 102(e)(2). Any United States filing date prior to the filing date of an International Application is not relevant for § 102(e)(2) prior art purposes.



### 1. Post-AIPA § 102(e)(2) date of the patent: NONE

The patent is not available as prior art under post-AIPA § 102(e)(2) (because there is no date under post-AIPA § 102(e)(2)) against:

- (a) any application filed on or after 29 Nov 2000; or
- (b) any application which has been voluntarily published.

The patent is usable under § 102(a) or (b) with a prior art date of 01 Nov 2001

### 2. Pre-AIPA § 102(e) date of the patent: 01 Apr 2000

The patent is available as prior art against:

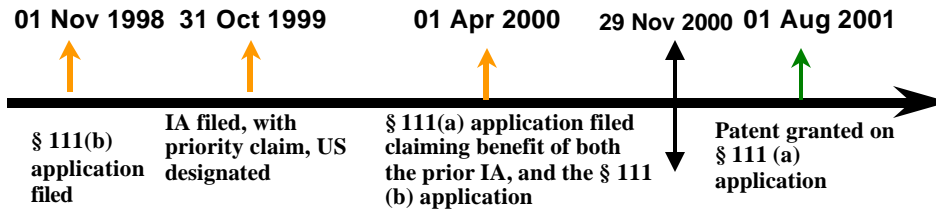
- (a) any application filed after 01 Apr 2000 but before 29 Nov 2000 which has not been voluntarily published.

Notes: (1) There is no post-AIPA § 102(e)(2) date while there is a date under pre-AIPA § 102(e).

- (2) WIPO publication has a § 102(a) or (b) date of 01 May 1999.

**Example 6:** Reference Patent Issued from an Application filed under 35 U.S.C. § 111(a) Claiming the Benefit of an Intermediate International Application and a Prior Provisional Application.

For reference patents issued from applications filed under 35 U.S.C. § 111(a), which claim the benefit of an intermediate International Application under 35 U.S.C. §§ 120 and 365(c) and a prior United States provisional application under 35 U.S.C. §§ 119(e) and 365(c), the prior art dates accorded these reference patents are the **same** under pre and post-AIPA § 102(e). Thus, a patent issuing from an application filed under 35 U.S.C. § 111(a), which claims the benefit of an intermediate International Application and a prior United States provisional application, would be accorded the application's actual filing date under 35 U.S.C. § 111(a) as its prior art date.



**1. Post-AIPA § 102(e)(2) date of the patent: 01 Apr 2000**

The patent is available as prior art against:

- (a) any application filed on or after 29 Nov 2000; or
- (b) any application filed after 01 Apr 2000 which has been voluntarily published.

**2. Pre-AIPA § 102(e) date of the patent: 01 Apr 2000**

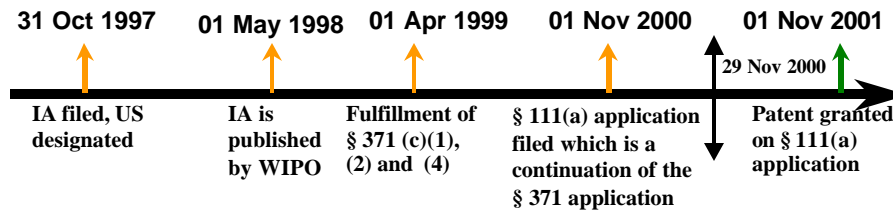
The patent is available as prior art against:

- (a) any application filed after 01 Apr 2000 but before 29 Nov 2000 which has not been voluntarily published.

**Note:** The post-AIPA § 102(e)(2) date and the pre-AIPA § 102(e) date are the same.

**Example 7:** Reference Patent issued from an Application filed under 35 U.S.C. § 111(a), which is a Continuation of the National Stage of an International Application.

For reference patents issued from applications filed under 35 U.S.C. § 111(a), which claim the benefit of the filing dates of prior International Applications pursuant to 35 U.S.C. §§ 120 and 365(c), which International Applications had complied with the National Stage requirements, the prior art dates accorded to these reference patents by post-AIPA § 102(e)(2) are **different** than the prior art dates accorded by pre-AIPA § 102(e). A patent issued from an application filed under 35 U.S.C. § 111(a), which was a continuation of an International Application which had complied with the National Stage requirements, **will** have its § 111(a) filing date as its prior art date under post-AIPA § 102(e)(2).



**1. Post-AIPA § 102(e)(2) date of the patent: 01 Nov 2000**

The patent is available as prior art against:

- (a) any application filed on or after 29 Nov 2000; or
- (b) any application filed after 1 Nov 2000 which has been voluntarily published.

**2. Pre-AIPA § 102(e) date of the patent: 01 Apr 1999**

The patent is available as prior art against:

- (a) any application filed after 01 Apr 1999 but before 29 Nov 2000 which has not been voluntarily published.

- Notes: (1) There is a different post-AIPA § 102(e)(2) date than pre-AIPA § 102(e) date.  
 (2) WIPO publication has a § 102(a) or (b) date of 01 May 1998.

FOR FURTHER INFORMATION CONTACT: Jeanne Clark or Robert Clarke, Legal Advisors in the Office of Patent Legal Administration, by telephone at (703) 305-1622, by fax at (703) 305-1013, or by e-mail addressed to [Jeanne.Clark@USPTO.gov](mailto:Jeanne.Clark@USPTO.gov) or [Robert.Clarke@USPTO.gov](mailto:Robert.Clarke@USPTO.gov).

February 2, 2001  
 [date]

/s/  
 Stephen G. Kunin  
 Deputy Commissioner  
 for Patent Examination Policy