Statutory Bars Under Section 102

§ 5:1 Introduction

Certain circumstances or situations described in sections 102(a) through (g) of the statute can bar a person from securing a patent for an invention, and therefore are known as statutory bars.

§ 5:2 Step 2 of the Flow Chart for Patentability

The second step for investigating patentability, as demonstrated in the Flow Chart for Patentability in chapter 3, is to determine based on dates alone whether the reference cited against the inventor’s application or patent is a possible statutory bar under subsection (b) of section 102. Before discussing how section 102(b) relates to the second step in the flow chart, this chapter first examines all the statutory bars set forth in the subsections of section 102.

§ 5:3 Statutory Bars Under Sections 102(a) and 102(b)

There are eight statutory bars specified in section 102(a) and section 102(b). If any statutory bar is applicable, an inventor is not entitled to a patent, because the claimed invention is “contemplated” by the prior art. In other words, the claimed invention is not “new,” and it is not patentable. This is also known as a “complete anticipation,” which precludes the issuance of a patent.1

1. If the prior art is something less than the complete invention, it can still be evaluated under the unobviousness requirement of section 103. See chapter 7.
Sections 102(a) and 102(b) read:

A person shall be entitled to a patent unless—\(a\) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

\(b\) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States. . . .

The eight statutory bars can be interpreted as whether the claimed invention was:

(1) Known by someone other than the inventor, in the United States, before the inventor’s Date of Invention, section 102(a);

(2) Used by someone other than the inventor, in the United States, before the inventor’s Date of Invention, section 102(a);

(3) Patented by someone other than the inventor, anywhere in the world, before the inventor’s Date of Invention, section 102(a);

(4) Published by someone other than the inventor, anywhere in the world, before the inventor’s Date of Invention, section 102(a);

(5) Patented by the inventor or anyone else, anywhere in the world, more than one year before the Effective Filing Date of the inventor’s U.S. patent application, section 102(b);

(6) Published by the inventor or anyone else, anywhere in the world, more than one year before the Effective Filing Date of the inventor’s U.S. patent application, section 102(b);

(7) Used by the inventor or anyone else, in the United States, more than one year before the Effective Filing Date of the inventor’s U.S. patent application, section 102(b); or

(8) Sold by the inventor or anyone else, in the United States, more than one year before the Effective Filing Date of the inventor’s U.S. patent application, section 102(b).

Table 5-1 lists these eight statutory bars under section 102(a) and section 102(b).
### TABLE 5-1

**STATUTORY BARS UNDER SECTION 102(a) AND SECTION 102(b)**

<table>
<thead>
<tr>
<th>Section 102</th>
<th>What</th>
<th>Who</th>
<th>Where</th>
<th>When</th>
</tr>
</thead>
<tbody>
<tr>
<td>(a)</td>
<td>Known</td>
<td>Others</td>
<td>United States</td>
<td>Before the Date of Invention*</td>
</tr>
<tr>
<td>(a)</td>
<td>Used</td>
<td>Others</td>
<td>United States</td>
<td>Before the Date of Invention*</td>
</tr>
<tr>
<td>(a)</td>
<td>Patent</td>
<td>Others</td>
<td>Anywhere</td>
<td>Before the Date of Invention*</td>
</tr>
<tr>
<td>(a)</td>
<td>Publication</td>
<td>Others</td>
<td>Anywhere</td>
<td>Before the Date of Invention*</td>
</tr>
<tr>
<td>(b)</td>
<td>Patent</td>
<td>Anyone</td>
<td>Anywhere</td>
<td>More than 1 year before the EFD**</td>
</tr>
<tr>
<td>(b)</td>
<td>Publication</td>
<td>Anyone</td>
<td>Anywhere</td>
<td>More than 1 year before the EFD**</td>
</tr>
<tr>
<td>(b)</td>
<td>Use</td>
<td>Anyone</td>
<td>United States</td>
<td>More than 1 year before the EFD**</td>
</tr>
<tr>
<td>(b)</td>
<td>Sale</td>
<td>Anyone</td>
<td>United States</td>
<td>More than 1 year before the EFD**</td>
</tr>
</tbody>
</table>

*This date can be in the United States, NAFTA countries, or WTO countries. The Date of Invention can be an Effective Filing Date (EFD) or earlier notebook records.

**Here, the Effective Filing Date (EFD) of the inventor’s U.S. patent application cannot include a “foreign convention date” due to the “exception” specified in section 119. (See section 4:3.1[D].)

The Effective Filing Date specified in [5], [6], [7], and [8] for section 102(b) can include the benefit of a provisional application [section 119], a continuation application [section 120], a continuation-in-part application [section 120], or a divisional application [section 121]. The Effective Filing Date cannot include the benefit of a convention application [section 119] because of the “exception” promulgated in
section 119.\textsuperscript{2} The exception means that an earlier “foreign convention date” cannot be used as an Effective Filing Date to determine whether there is a statutory bar under section 102(b). In other words, the one-year time period specified in section 102(b) cannot be tacked on the “foreign convention date” specified in section 119.

Based on the North American Free Trade Agreement (NAFTA), effective December 8, 1993, activities in any NAFTA country, such as Canada or Mexico, must be considered for establishing a Date of Invention under U.S. patent laws. Based on the General Agreement on Tariffs and Trade (GATT), effective January 1, 1996, activities in any World Trade Organization (WTO) country must also be considered for establishing a Date of Invention.

\section*{§ 5:3.1 “Use” As a Statutory Bar}

In order for use in (2) and (7) above to qualify as a bar under section 102(a) and section 102(b), the use should be accessible to the public, that is, performed openly. A secret use is generally not a bar under section 102(a) and section 102(b).

Experimental use also does not constitute a bar under section 102(a) and section 102(b). Experimental use relates to developing, perfecting, or testing the invention.

The CAFC, in the 2008 Omeprazole decision\textsuperscript{2.1} concerning a possible “use” bar, extended the two-prong Pfaff test for a “sale” bar\textsuperscript{2.2} as follows:

We may nevertheless affirm the district court’s conclusion that the claims were not invalid under section 102(b) based on the court’s factual determination that the claimed formulation was not ready for patenting until after the clinical studies were completed. . . . (“the ready for patenting component of Pfaff’s two-part test [is] another necessary requirement of public use bar.”). The district court found that the claimed formulation was not reduced to practice before the clinical trials were completed, and we uphold that finding.

To be a “complete anticipation” under section 102(a) and section 102(b), the prior art use must contemplate the complete invention being claimed by the inventor. If the prior art use is something less than the complete invention, the use can still be considered under section 103.\textsuperscript{3}

\begin{itemize}
  \item \textsuperscript{2} See section 4:3.1[D] for a discussion of the exception.
  \item \textsuperscript{2.1} In re Omeprazole Patent Litig., 536 F.3d 1361 [Fed. Cir. 2008].
  \item \textsuperscript{2.2} See section 5:3.3, infra.
  \item \textsuperscript{3} See chapter 7 for a detailed discussion of unobviousness.
\end{itemize}
§ 5:3.2 “Knowledge” As a Statutory Bar

Knowledge in (1) above should also be accessible to the public to qualify as a section 102(a) bar. The prior art knowledge must contemplate the inventor’s complete invention, as claimed, in order to be a “complete anticipation.” If the prior art knowledge is something less than the complete invention, the knowledge can still be evaluated under section 103.

§ 5:3.3 “Sale” As a Statutory Bar

An offer for sale, such as a demonstration, or an actual sale in (8) above can cause a bar under section 102(b). To qualify as a “complete anticipation,” the prior art sale must contemplate the complete invention being claimed by the inventor. If the prior art sale is something less than the complete invention, the sale can still be considered under section 103. This is illustrated in a 1999 decision, where the CAFC stated that the subject matter of the offers for sale did not fully anticipate the claimed invention and the alleged infringer did not argue that the offers would have rendered the invention obvious.

The U.S. Supreme Court in the Pfaff decision has promulgated a two-prong test for proving a sale bar. First, the product must be the subject of a commercial sale or sales offer. Second, the invention must be “ready for patenting,” which can be established by a reduction to practice or by proof that the inventor has drawings or other descriptions of the invention that are sufficiently specific to enable a person skilled in the art to practice the invention.

In 2000, the CAFC applied the Pfaff test to determine whether the subject matter of a patent was on sale to qualify as a bar under section 102(b). According to the court, there was sufficient evidence that the invention was ready for patenting, that is, a model of the invention and its subsequent promotion.

Three 2001 decisions clarified the standard for an “offer for sale” to satisfy the first prong of Pfaff’s two-prong test for proving a sales bar, i.e., the product must be the subject of a commercial sale or sales offer. The Group One court stated that because of “the importance of having a uniform national rule regarding the on-sale bar, we hold that the question of whether an invention is the subject of a commercial offer for sale is a matter of Federal Circuit law, to be analyzed under the law of contracts as generally understood.” As guidance, the court

suggested the Uniform Commercial Code, the *Restatement (Second) of Contracts*, and the vast amount of existing contract law.

The next decision addressed the second subpart of the first prong of the *Pfaff* test, namely, that the sale or sales offer must be for the “patented invention.” According to the court, “the invention that is the subject matter of the offer for sales must satisfy each claim limitation of the patent, though it may do so inherently.” See also the *Tec Air* decision, above, where an offer can render the invention obvious.

In the third decision, the *Linear* court based its definition of an offer for sale on *Restatement (Second) of Contracts* section 24: “the manifestation of willingness to enter into a bargain, so made as to justify another person in understanding that his assent to that bargain is invited and will conclude it.”

The *Pechiney Rhenalu* court in 2002 promulgated three guidelines for determining whether there is a commercial offer under traditional contract law. First, the transaction must rise to a level where the other party could bind the offeror by an acceptance. Second, the offer is the manifestation of a willingness to enter into a bargain in such a way that the offeree believes an acceptance will create a binding contract. Third, the language used by the offeror should be indicative of a legal offer with certain phrases suggesting such a legal offer.

Mere quotations do not constitute commercial offers for sale under section 102(b), since they are only suggestions to negotiate. More terms are required in addition to the quotations, such as time and place of delivery, price, and quantity.

Merely sending samples to customers, without any other evidence of entering into a contract, is not an offer that triggers the sale bar. Again, the transaction should include contract terms, such as prices and the like.

In a 2003 decision, the CAFC considered the type of invention (tangible or intangible) and the type of transaction (sale, license, or lease) with regard to the sale bar. Concerning the invention, the court stated:

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there are different types of sales of different types of inventions. It is not correct that “nothing in §102(b) compels different treatment between an invention that is a tangible item and an invention that describes a series of steps in a process.” The very nature of the invention may compel a difference. The sale of a tangible item is usually a straightforward event; the item is transferred from the seller to the buyer, who normally owns it outright. In contrast, a process is a series of acts, and the concept of sale as applied to those acts is ambiguous.

With respect to the transaction, the court noted “the established rule that merely granting a license under potential patent rights is usually not a ‘sale’ of the invention within the meaning of the statute.” In contrast

“a commercial transaction arranged as a ‘license’ or a ‘lease’ of a product or a device . . . may be tantamount to a sale [e.g., a standard computer software license], whereupon the bar of §102(b) would be triggered because ‘the product is . . . just as immediately transferred to the ‘buyer’ as if it were sold.’”

§ 5:3.4 “Publication” As a Statutory Bar
As a statutory bar under section 102(a) and section 102(b), a publication in (4) and (6) above can be anything that is printed and available to the public in any country without any injunction of secrecy. This can include, for example, material in a public library, a catalog for promoting sales, or papers distributed at a meeting of a technical society. The prior art publication must contemplate the inventor’s complete invention, as claimed, in order to be a “complete anticipation.” If the prior art publication describes something less than the complete invention, the publication can still be evaluated under section 103.

§ 5:4 Problem on Statutory Bars Under Sections 102(a) and 102(b)
Assume the following facts: A’s Date of Invention is June 1, 1985. A’s Effective Filing Date (EFD) for a patent application covering the invention is September 1, 1986.
Consider statutory bars under section 102(a) and section 102(b) with regard to each of the following “specific” activities:

(a) A sold the invention in the United States on July 1, 1985.
(b) B’s U.S. patent disclosing the invention was issued on December 1, 1985.
(c)  C published an article describing the invention in Japan on May 1, 1985.

(d)  D publicly used the invention in Belgium on February 1, 1955.

(e)  E in the United States knew about the invention on March 1, 1960.

(f)  B sold the invention in France on August 1, 1985.

(g)  C’s British patent disclosing the invention was issued on July 1, 1985.

(h)  A publicly used the invention in the United States on August 1, 1985.

(i)  A published an article describing the invention in the United States on May 1, 1986.

(j)  B’s U.S. patent disclosing the invention was issued on August 1, 1985.

(k)  B in Holland knew about the invention on January 1, 1948.

(l)  E sold the invention in the United States on February 1, 1986.

(m)  A published an article describing the invention in France on August 1, 1985.

(n)  A sold the invention in Germany on August 1, 1985.

§ 5:5  Answers to Problem on Statutory Bars Under Sections 102(a) and 102(b)

(a)  There is no section 102(a) bar, because a sale is not an activity specifically enumerated in section 102(a). Furthermore, the section 102(a) activity must be performed by someone other than the inventor. There is a section 102(b) bar, because A sold A’s invention more than one year before A filed a patent application.

(b)  Since B’s patent was issued after A’s Date of Invention, there is no section 102(a) bar. Since B’s patent was not issued more than one year before A’s Effective Filing Date (EFD), there is no section 102(b) bar.

(c)  A section 102(a) bar exists, since C’s article was published before A’s Date of Invention. A section 102(b) bar also exists, since C’s article was published more than one year before A’s Effective Filing Date.
(d) There is no section 102(a) bar, because the use was in a foreign country. There is no section 102(b) bar for the same reason.

(e) E’s U.S. knowledge, which was before A’s Date of Invention, is a section 102(a) bar. Knowledge is not an activity specifically enumerated in section 102(b).

(f) No section 102(a) bar is present, since a sale is not an activity specifically listed in section 102(a). No section 102(b) bar is present, since the sale occurred in a foreign country.

(g) There is no section 102(a) bar, because C’s patent was issued after A’s Date of Invention. There is a section 102(b) bar, because C’s patent was issued more than one year before A’s Effective Filing Date.

(h) A’s public use is not a section 102(a) bar, since the public use must be by someone other than the inventor. A’s public use is a section 102(b) bar, since the public use was more than one year before A’s Effective Filing Date.

(i) A section 102(a) bar does not exist, because the article was not published by someone other than the inventor. A section 102(b) bar does not exist, because the article was not published more than one year before A’s Effective Filing Date.

(j) There is no section 102(a) bar, because B’s patent was issued after A’s Date of Invention. There is a section 102(b) bar, because B’s patent was issued more than one year before A’s Effective Filing Date.

(k) B’s knowledge, in a foreign country, is not a section 102(a) bar. Knowledge is not an activity specifically listed in section 102(b).

(l) No section 102(a) bar exists, because a sale is not an activity listed in section 102(a). No section 102(b) bar exists, because the sale did not occur more than one year before A’s Effective Filing Date.

(m) There is no section 102(a) bar, since the article was not published by someone other than the inventor. There is a section 102(b) bar, since the article was published more than one year before A’s Effective Filing Date.

(n) Since a sale is not an activity specifically listed in section 102(a), there is no section 102(a) bar. Since A’s sale was in a foreign country, there is no section 102(b) bar.

To summarize: knowledge, use, or sale in a foreign country is never a bar under section 102(a) or section 102(b).
§ 5:6 Statutory Bar Under Section 102(c)

A person who abandons an invention is barred from securing a patent. Section 102(c) reads:

A person shall be entitled to a patent unless—

(c) he has abandoned the invention.

When abandonment occurs, the invention is dedicated to the public, and the inventor loses any right to a patent. For example, the inventor may expressly intend not to file a patent application for the invention. This intent can be evidenced by the inventor’s oral or written statements. An intent to abandon may also be implied, for example, by an inexcusable delay in filing a patent application. Furthermore, patent rights are abandoned if the inventor engages in an activity that results in a statutory bar under section 102(b), discussed above in sections 5:3 through 5:5, or section 102(d), discussed below in sections 5:7 through 5:9.

Abandonment may also occur during the prosecution of a patent application. If the subject matter of the invention is disclosed in a patent application but never claimed in that patent application (or in a continuing patent application), the unclaimed subject matter may be dedicated to the public. If broad subject matter is claimed in a patent application but is not claimed in a patent issuing therefrom (or in a continuing patent application), the broad subject matter may be dedicated to the public. If the applicant fails to file an amendment or take some other appropriate action within the required time period during the prosecution of the patent application, the application and its subject matter may be abandoned. A patent application may also be expressly abandoned.

Section 253 provides for disclaimers relating to an issued patent. The patentee may disclaim one or more claims in a patent or the entire term of a patent. The patentee (or applicant) may disclaim a terminal part of the term of the patent granted (or to be granted).

§ 5:7 Statutory Bar Under Section 102(d)

Under certain circumstances, a person who first obtains a patent in a foreign country may be barred from obtaining a U.S. patent. Section 102(d) reads:

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5. See Flow Chart 2-1.
7. See Rule 138.
8. See section 4:4 for a discussion of terminal disclaimers.
A person shall be entitled to a patent unless—

[d] the invention was first patented or caused to be patented, or was the subject of an inventor’s certificate, by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application for patent or inventor’s certificate filed more than twelve months before the filing of the application in the United States.

If A’s corresponding foreign patent application is filed more than twelve months before the Effective Filing Date of A’s U.S. patent application and if A’s corresponding foreign patent application issues before the Effective Filing Date of A’s U.S. patent application, there is a statutory bar under section 102(d). Therefore, two requirements must be met in order to have a section 102(d) bar.

The Effective Filing Date of the U.S. patent application under section 102(d) includes the benefit of a section 120 continuation application, a section 120 continuation-in-part application, or a section 121 divisional application, but does not include the benefit of a section 119 convention application.

Section 102(d) should be contrasted with section 119. As discussed in chapter 4, a section 119 convention application exists when the Effective Filing Date of a U.S. patent application is within twelve months from the earliest filing date of a corresponding patent application in a “convention” foreign country. The earliest foreign filing date becomes the “new” Effective Filing Date for the U.S. patent application, except when determining certain statutory bars under section 102.

§ 5:8 Problem on Section 102(d) and Section 119

For each of these four sets of facts, determine the following: What is the Effective Filing Date under section 119? Is there a statutory bar under section 102(d)?

(1) A’s corresponding German patent application was filed on June 1, 1980, and was issued on April 1, 1981. A’s U.S. patent application was filed on May 1, 1981.

(2) A’s corresponding German patent application was filed on June 1, 1980. A’s corresponding French patent application was filed on August 1, 1980. A’s U.S. patent application was filed on July 1, 1981.

(3) A’s corresponding Belgian patent application was filed on April 1, 1984, and was issued on October 1, 1984. A’s U.S. patent application was filed on June 1, 1985.

(Hildreth, Rel. #12, 10/10) 5–11
A's corresponding Japanese patent application was filed on November 1, 1972, and was issued on November 1, 1974. A's U.S. patent application was filed on December 1, 1973.

§ 5:9 Answers to Problem on Section 102(d) and Section 119

(1) A's Effective Filing Date is June 1, 1980, since the U.S. patent application was filed within twelve months from the filing of the German patent application. There is no section 102(d) bar, since the German patent application was not filed more than twelve months before A's U.S. patent application.

(2) The Effective Filing Date of A's U.S. patent application is July 1, 1981. A's U.S. patent application was not filed within twelve months from the earliest German patent application. Furthermore, the French patent application was not the earliest filed patent application. Therefore, section 119 does not apply. There is no section 102(d) bar, because no corresponding foreign application was issued before A's U.S. filing date.

(3) A's Effective Filing Date is June 1, 1985, since A's U.S. patent application was not filed within twelve months from the Belgian patent application. There is a section 102(d) bar, because the Belgian patent application was filed more than twelve months before A filed a U.S. patent application, and the Belgian patent application was issued before A filed a U.S. patent application.

(4) The Effective Filing Date is December 1, 1973, because A's U.S. patent application was not filed within twelve months from the Japanese patent application. There is no section 102(d) bar, since the Japanese patent application did not issue before A's U.S. filing date.

§ 5:10 Statutory Bar Under Section 102(e)

In some situations, a person is barred from securing a patent if the invention that has been disclosed in a U.S. patent issued to another. Section 102(e) reads:

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 interna-
tional 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 the applicant for patent.

According to section 102(e), the “disclosure” (not claimed) of a U.S.
patent, issued to another, can be cited as prior art against an inventor’s
patent application (or issued patent) when the cited U.S. patent was
filed before the inventor’s Date of Invention and when the cited U.S.
patent was issued “after” the inventor’s Date of Invention. If a cited
U.S. patent, issued to another, was issued “before” the inventor’s Date
of Invention, section 102[a], discussed above in sections 5:3 through
5:5, would be applicable. If the cited U.S. patent, issued to another,
“claims” the same subject matter as the inventor, section 102[g],
discussed below in section 5:12, would be applicable.9

Based on the North American Free Trade Agreement (NAFTA),
effective December 8, 1993, activities in any NAFTA country, such as
Canada or Mexico, must be considered for establishing a Date of
Invention under U.S. patent laws. Based on the General Agreement on
Tariffs and Trade (GATT), effective January 1, 1996, activities in any
World Trade Organization (WTO) country must also be considered for
establishing a Date of Invention.

The Reform Act of 1999 has amended section 102(e). If a U.S.
application has been published,10 the U.S. filing date can be used as a
prior art reference against another person under section 102[e].

There is another amendment to section 102(e) under the Reform
Act of 1999. If a U.S. application claims the benefit of an earlier filed
PCT application, the section 102[e] prior art date against another
person is the filing date of the PCT application, provided that the PCT
application has been published in English.

If the PCT application is not published in English, the section 102[e]
prior art date against another person is the filing date of the U.S.
application.

Section 103 has also been amended by the Reform Act of 1999.
Subject matter developed by another person that qualifies as prior art
only under section 102[e] does “not preclude patentability under this
section where the subject matter and the claimed invention were, at
the time the invention was made, owned by the same person or subject
to an obligation of assignment to the same person.” Thus, the subject
matter previously developed by a coworker in the same organization
might not be prior art only under section 103.

9. See Table 6-1 for an illustration of section 102[g].
10. See section 1:9 for a discussion of the publication of a U.S. patent
application.
§ 5:11 Statutory Bar Under Section 102(f)

A person who did not invent the subject matter is barred from securing a patent. Section 102(f) reads:

A person shall be entitled to a patent unless—

. . .

(f) he did not himself invent the subject matter sought to be patented.

Based on section 102(f), the declaration for a patent application must be executed by the inventor of the claimed subject matter. Certain exceptions (legal representatives, etc.) were discussed in chapter 1.

A person is barred under section 102(f) from securing a patent if that person derived the invention from another. In order to prove that an invention was derived from another, it may be necessary to show (1) the invention was conceived by another and (2) the conception by another was communicated to that person.

Subject matter “admitted” to be prior art, either in a patent application or during the prosecution of a patent application, can be cited as a rejection under section 102(f). However, according to a 1984 amendment to section 103, subject matter developed by another person that qualifies as prior art only under section 102(f) does not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

This means, for instance, the subject matter previously developed by a coworker in the same organization might not be prior art only under section 103.

§ 5:12 Statutory Bar Under Section 102(g)

In some situations, a person may be barred from securing a patent if the invention was previously made in the United States by another. As discussed heretofore, where the dates are applicable, a NAFTA country and a WTO country must also be considered for establishing a Date of Invention. Section 102(g) reads:

A person shall be entitled to a patent unless—

. . .

(g) before the applicant’s invention thereof the invention was made in this country by another who had not abandoned, suppressed, or
concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

Section 102(g) is the basis for determining who is the prior inventor of the claimed invention. A person who loses an interference proceeding before the U.S. Patent and Trademark Office or loses a cause of action under section 291, is barred under section 102(g) from securing a valid U.S. patent. This is because another person had an earlier Date of Invention in the United States (or where the date is applicable in any NAFTA or WTO country) for the same invention, and priority was awarded to the other person.

Section 102(g) also applies when a prior invention has been "admitted" either in a patent application or during the prosecution of a patent application. However, according to a 1984 amendment to section 103, subject matter developed by another person, which qualifies as prior art only under section 102(g), does not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

This means, for instance, that the subject matter previously developed by a coworker in the same organization might not be prior art only under section 103.

§ 5:13 Step 2 of the Flow Chart for Patentability

A Date of Invention can be an Effective Filing Date or an earlier notebook record.

Step 2 in the Flow Chart for Patentability in chapter 3 is to consider, based on dates alone, whether a reference, cited against the inventor’s application or patent, is a possible statutory bar under section 102(b). If the cited prior art reference is a published article, use, or sale, the date of publication, use, or sale determines whether the cited published article, use, or sale is a statutory bar under section 102(b).

If the cited prior art reference is a foreign patent, the issue date of the foreign patent determines whether the cited foreign patent is a section 102(b) statutory bar.

If the cited prior art reference is a U.S. patent, the issue date of the U.S. patent determines whether the cited U.S. patent is a section 102(b) statutory bar.

§ 5:13 Step 2 of the Flow Chart for Patentability

A Date of Invention can be an Effective Filing Date or an earlier notebook record.

Step 2 in the Flow Chart for Patentability in chapter 3 is to consider, based on dates alone, whether a reference, cited against the inventor’s application or patent, is a possible statutory bar under section 102(b). If the cited prior art reference is a published article, use, or sale, the date of publication, use, or sale determines whether the cited published article, use, or sale is a statutory bar under section 102(b).

If the cited prior art reference is a foreign patent, the issue date of the foreign patent determines whether the cited foreign patent is a section 102(b) statutory bar.

If the cited prior art reference is a U.S. patent, the issue date of the U.S. patent determines whether the cited U.S. patent is a section 102(b) statutory bar.

§ 5:13 Step 2 of the Flow Chart for Patentability

A Date of Invention can be an Effective Filing Date or an earlier notebook record.

Step 2 in the Flow Chart for Patentability in chapter 3 is to consider, based on dates alone, whether a reference, cited against the inventor’s application or patent, is a possible statutory bar under section 102(b). If the cited prior art reference is a published article, use, or sale, the date of publication, use, or sale determines whether the cited published article, use, or sale is a statutory bar under section 102(b).

If the cited prior art reference is a foreign patent, the issue date of the foreign patent determines whether the cited foreign patent is a section 102(b) statutory bar.

If the cited prior art reference is a U.S. patent, the issue date of the U.S. patent determines whether the cited U.S. patent is a section 102(b) statutory bar.

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11. See chapter 8 for a detailed discussion of interference.
statutory bar. This applies to both the disclosure and the claims of the U.S. patent.

Table 6-1 in chapter 6 also indicates the date used for each of these cited prior art references with regard to Step 2 in the Flow Chart for Patentability for four different categories.

The Effective Filing Date of the inventor’s application or patent is also employed in Step 2 to ascertain if there is a possible section 102(b) bar. The Effective Filing Date for Step 2 can be based on a section 119 provisional application, a section 120 continuation application, a section 120 continuation-in-part application, or a section 121 divisional application. However, the inventor’s Effective Filing Date for Step 2 cannot be based on a section 119 convention application because of the “exception” stated in the first paragraph of section 119.¹²

Suppose, for example, A filed on April 1, 1985, a Japanese patent application for a chair, and A filed on March 1, 1986, a corresponding U.S. patent application for the chair. Suppose B published on February 1, 1985, in Italy an article describing the same chair. Is there a statutory bar under section 102(b) based on dates alone?

The answer is “yes.” Under section 119, the Effective Filing Date of the U.S. application is April 1, 1985, that is, the Japanese convention date. (See Step 1 in the Flow Chart.) However, in view of the “exception” in section 119, this convention date cannot be used to determine if there is a section 102(b) statutory bar. The publication date of February 1, 1985, is more than one year before the U.S. filing date of March 1, 1986. Hence, there is a section 102(b) statutory bar based on dates alone. (See Step 2 in the Flow Chart.)

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¹² See section 4:3.1[D] for a discussion of the exception.