

35 U.S.C. §102(e)

An important provision of U.S. patent law was recently changed by the American Inventors Protection Act of 1999 and the Intellectual Property and High Technology Technical Amendments Act of 2002. This provision, 35 U.S.C. § 102(e), formerly permitted only U.S. patents to be applied as references, effective as of their filing date in the U. S., against a co-pending patent application. With some exceptions, the new law provides that published U.S. patent applications and published international applications, in addition to U.

S. patents, are eligible as prior art references under Section 102(e). Moreover, references under Section 102(e) are now effective as prior art references as of the earlier of the U. S. filing date or, if published in English, their international filing date.

The possible scenarios for this procedure are shown graphically in the accompanying flow chart. Although the flowchart definitely falls into the "do not use this at home" category, a broad view of the flowchart reveals some interesting generalities. The first deci-

sion block, posing the question "Is the reference by another?" shows that both the new and old law require that the reference must have a different inventive entity than the subject application for Section 102(e) to apply. The very next decision block reveals that, if the reference is something other than the three types listed, then Section 102(e) also does not apply. Such references not applicable under Section 102(e) include, for example, a Canadian patent, a Japanese published patent application, or an article from a journal. The flowchart also reveals the significance of whether the reference is based on an international application and, if so, the filing date of that international application.

In several scenarios, the flowchart prompts the reader to consider whether a related U.S. application or previously filed international application satisfies the provisions of Section 102(e) even if the subject reference does not (see the lower right portion of the flowchart). The final test of determining whether Section 102(e) applies is whether the "102(e) date" of the reference is before the invention date of the subject application. The invention date is, at least in the first instance, the priority date of the subject application.

It is important to remember, however, that when seeking to invalidate a patent, other provisions of 35 U.S.C. § 102 might be more useful in using an earlier effective date for certain subject matter. In addition, it should be noted that a fairly recent amendment to the law on obviousness (35 U.S.C. § 103(c)) prohibits an examiner from using a reference which only qualifies as prior art under three subsections of Section 102 (including Section 102(e)), so long as the reference was commonly assigned, or subject to an obligation to assign, to the same owner as the subject application.

