



# Intellectual Property Legal Services

BOND,  
SCHOENECK  
& KING, PLLC

## The “GRACE Period”

University of South Florida

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# The ‘Catch’

(no pain, no gain)

“If you want to understand my invention, you have to learn a ‘little’ math” (anon. inventor)

If you want to understand the  
“GRACE PERIOD”

you have to learn a ‘little’ patent law.

# Conditions for patentability

- *35 USC § 101:* Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent there for...
- *35 USC § 103:* A patent may not be obtained if the differences between the claimed invention if the claimed invention as a whole would have been obvious before the effective filing date...

# **35 U.S.C. 102 Conditions for patentability; novelty**

**NOVELTY; PRIOR ART.—A person shall be entitled to a patent unless—**

102(a)(1): the claimed invention was

- patented,
- described in a printed publication,
- in public use,
- on sale,
- otherwise available to the public (whether, not how)
- before the effective filing date of the claimed invention; or

# **35 U.S.C. 102 Conditions for patentability; novelty**

**NOVELTY; PRIOR ART.—A person shall be entitled to a patent unless—**

- 102(a)(2): the claimed invention was
  - described in a US patent or
  - described in a published US application
  - described in a published PCT application
  - that names another inventor and
  - was filed before the effective filing date of the claimed invention.

# **35 U.S.C. 102** Conditions for patentability; novelty

102(b): EXCEPTIONS – The “*GRACE PERIOD*”

(1)(A): A disclosure made 1 year or less before the filing date of a claimed invention shall not be prior art if the disclosure was made

- by the inventor or
- a joint inventor or
- by another who obtained the subject matter disclosed from the inventor or a joint inventor

# **35 U.S.C. 102** Conditions for patentability; novelty

## 102(b): EXCEPTIONS – The “*GRACE PERIOD*”

(1)(B): A disclosure made 1 year or less before the filing date of a claimed invention shall not be prior art if the disclosed subject matter had, before such disclosure,

- been publicly disclosed by the inventor or a joint inventor or
- another who obtained the subject disclosed matter from the inventor or a joint inventor.

# **35 U.S.C. 102** Conditions for patentability; novelty

## 102(b): EXCEPTIONS – The “GRACE PERIOD”

(2)(A): A disclosure shall not be prior art to a claimed invention that was described in a US patent or in a published US application that names another inventor and was earlier filed if  
-the subject matter disclosed was obtained directly or indirectly from the inventor or a joint inventor;

# **35 U.S.C. 102** Conditions for patentability; novelty

## 102(b): EXCEPTIONS – The “GRACE PERIOD

(2)(B): A disclosure shall not be prior art to a claimed invention that was described in a US patent or in a published US application that names another inventor and was earlier filed if

- the disclosed subject matter had, before filing, been publicly disclosed by the inventor or a joint inventor or another who obtained the disclosed subject matter from the inventor or a joint inventor;
- or

The prior art exception in 102(b)(1)(B) requires that the subject matter in the earlier public disclosure and the prior art disclosure must be substantially IDENTICAL!

- “Even if the only differences between the subject matter in the prior art disclosure that is relied upon under 35 USC 102(a) and the subject matter publicly disclosed by the inventor ... are **mere insubstantial changes or only trivial or obvious variants**, the ('grace period' exception) does not apply.”

## Examples:

Inventor publishes research in a journal;  
<1 yr later inventor files application.

- The journal article is probably not eligible for the 102(b)(1)(B) prior art exception! There will almost certainly be *at least* “insubstantial changes” and/or “trivial variations” between the article and the application!
- Inventor A invents and discloses a jacket that uses a Velcro closing mechanism. Inventor B subsequently, but before inventor A files a patent application, discloses a jacket that uses snaps as a closing mechanism.
  - \*snaps used as a closing mechanism would be prior art to the patent application filed by inventor A, and
  - if Velcro would be viewed as **obvious** in light of snaps, inventor A may not be able to obtain a patent on her disclosed invention as the result of an independent, slightly different disclosure during the ‘Grace Period’.

- If the inventor had publicly disclosed A, B and C, and a subsequent intervening disclosure discloses A, B, C and D, then only element D of the intervening grace period disclosure is available as prior art under 35 USC§102(a)(1).
- If the inventor had publicly disclosed a species, and a subsequent intervening disclosure discloses a genus (i.e., provides a more generic disclosure of the species), the intervening grace period disclosure of the genus is not available as prior art under 35 USC§102(a)(1).
- If the inventor had publicly disclosed a genus, and a subsequent intervening disclosure discloses a species, the intervening grace period disclosure of the species would be available as prior art under 35 USC§102(a)(1).

Likewise, if the inventor had publicly disclosed a species, and a subsequent intervening disclosure discloses an alternative species not also disclosed by the inventor, the intervening disclosure of the alternative species would be available as prior art under AIA 35 USC§102(a)(1).

# **35 U.S.C. 102** Conditions for patentability; novelty

## 102(b): EXCEPTIONS – The “GRACE PERIOD”

(2)(C): A disclosure shall not be prior art to a claimed invention that was described in a US patent or in a published US application that names another inventor and was earlier filed if

-the disclosed subject matter and the claimed invention, not later than the filing date of the claimed invention, were owned by the same person or subject to an obligation of assignment to the same person.

- **Example 1:** Acme Company brings a ‘new invention’ machine to a trade show (in or outside the US). Acme has not yet filed a patent application for the new invention’ machine. The ‘inventive’ aspects of the machine are not apparent from looking at the machine and Acme does not reveal how to make and use the new invention’ machine.

-Acme offers to sell the new machine to a customer at the trade show. The machine is ‘on sale’ and Acme **immediately forfeits its U.S. patent rights**. The machine may still be patented in the rest of the world, which even though ‘absolute novelty,’ does not care about ‘sales’ or ‘offers for sale.’

-Acme operates the machine for the conf goers. This is a ‘public use’ and Acme **immediately forfeits its U.S. patent rights**, even though the public use did not ‘disclose the invention.’ The machine still may be patented in the rest of the world, because the rest of the world does not care about ‘public use.’

**Example 2:** At the same trade show, Xena Company brings its own 'new invention' machine . Xena also has not filed a patent application for the new invention machine. The new machine is not yet operational and Xena is not ready to take orders for the machine, so Xena does not sell or publicly use the machine.

- Xena publicly discloses how to make and use the invention. Xena does **NOT** forfeit U.S. patent rights, because Xena (the inventor) made the disclosure. Xena has one year to file the U.S. patent application; however, their public disclosure immediately terminates most foreign patent rights (absolute novelty).
- Xena provides a 'printed publication' that discloses how to make and use the invention. Because this disclosure was made by Xena, they have one year to file a U.S. patent application; however, the printed publication immediately terminates most foreign patent rights.

ACME loses its patent rights, even though they did not disclose the invention.

Xena keeps its patent rights, even though they did disclose the invention.

# Bond, Schoeneck & King, PLLC (‘BOND’)

- founded in 1897
- 215 lawyers in New York, Florida, Kansas
- 20 practice areas, 11 industry groups
- The 2014 U.S. News - Best Lawyers “Best Law Firms” nationally

# George R. McGuire



- Mr. McGuire is Chair of Bond's IP Group and a Registered Patent Attorney.
- 
- patent and trademark prep and prosecution, IP litigation, patent and trademark opinions on novelty, validity and (non)infringement, due diligence in M & A, asset purchase, or other financial transactions, Board of Patent Appeals and Interferences,
- Trademark Trial and Appeal Board, technology transfer and license agreements, computer law matters.
- Adjunct Professor at Syracuse University Law School where he teaches Computer Law, Internet Law, and Entertainment Law, and has taught and lectured on Trademark and Unfair Competition Law, Intellectual Property and Technology Transfer,
- Advisory Editorial Board of the Journal of the Association of University Technology Managers (AUTM),
- *Best Lawyers in America®*, New York Super Lawyers®,
- Who's Who in America, Who's Who in American Education, Who's Who in American Law, Who's Who in Emerging Leaders.
- B.S. Aerospace Engineering - Syracuse University
- J.D. Syracuse University, *Magna Cum Laude*.

# William Greener

- Registered Patent Attorney
- nanotechnology, microfluidics, optics, lasers, medical devices, ophthalmic surgery and apparatus, imaging systems, semiconductor devices, biodynamics, photonics, telecom, software, business architecture and e-commerce,
- develop a patent strategy aligned to business goals and objectives and particularly working with entrepreneurial start-ups and university spin-outs to secure foundation IP and freedom to operate opinions,
- identify people and resources for launching and funding new companies.
- *Best Lawyers in America®* IP- 2009, 2010, 2011, 2012, 2013, 2014,
- Seed Capital Fund of Central New York ([www.scfcny.com](http://www.scfcny.com)),
- law clerk to Chief Judge Michael A. Telesca of the Western District of New York.
- B.S. Physics – Canisius College
- M.S. Optics- University of Rochester Institute of Optics
- J.D. SUNY Buffalo School of Law, *Cum Laude*.



# Dr. Alek P. Szecsy



- Registered Patent Attorney
- Advanced materials, semiconductor device/process technology, nanophotonics, solar PV, magnetics, chemical engineering, organic polymer and industrial catalysts,
- Prior to becoming a patent attorney, Dr. Szecsy was employed in industry at IBM (Fishkill, NY) in scientific, engineering and administrative positions.
- B.S. Chemistry - Hofstra University,
- Ph.D. Physical Inorganic Chemistry - SUNY Stony Brook
- J.D. Pace University School of Law

# Jeremy P. Oczek



- Registered Patent Attorney
- Complex IP litigation, portfolio development, counseling and strategic advice, working with technology clients nationwide.
- IP litigation counsel for in US federal and appeals courts for Analog Devices, Church & Dwight, Facebook, General Media Communications (owner of Penthouse brands), ImClone, Ivoclar, MKS Instruments and Transamerica Life Insurance,
- technology areas: computers and software, networking and telecommunications, e-commerce and internet-based technologies, industrial equipment and manufacturing processes, biotechnology and life sciences, medical devices,
- National media commentary on IP issues in *The National Law Journal*, *BNA's Patent, Trademark & Copyright Journal*, *The Metropolitan Corporate Counsel*, *Law360*.,
- 2010 *Super Lawyers Rising Star* in the area of IP litigation.

# Daniel P. Malley



- Registered Patent Attorney,
- digital and analog circuits; aircraft landing systems; telecommunications systems; fiber optic components, systems, and network architectures; satellite-communication systems; fiber-to-the curb/home (FTTC and FTTH); micro-electro-mechanical systems (MEMS); electronic controls; projection optical systems and printer systems; electronic camera controls; transmission screens for television and computer applications; photolithography systems; and GFCI/AFCI protective devices.
- *Best Lawyers in America® IP*
- B.S.E.E. and M.S.E.E. – SUNY Buffalo,
- J.D. - George Mason School of Law.

# Blaine T. Bettinger, Ph.D.



- Registered Patent Attorney
- patent prep and prosecution, copyright, licensing, litigation related to patent, trademark and copyright infringement
- biochemistry, genetics, cell biology, molecular biology, microfluidics
- Dr. Bettinger also conducts research in the field of personal genomics
- Justinian Honorary Law Society
- Order of the Coif, Syracuse University College of Law Chapter
- Editor, Journal of Genetic Genealogy, 2009-Present
- Notes and Comments Editor, Syracuse Science & Technology Reporter
- Blaine T. Bettinger, George R. McGuire, "How the Supreme Court Got It Right in *Mayo v. Prometheus*," The SciTech Lawyer, Volume 10, Issue 1, Fall 2013
- B.S. Biology, *Cum Laude*, St. Lawrence University,
- Ph.D. Biochemistry and Molecular Biology - SUNY Upstate Medical University,
- J.D. Syracuse University College of Law, *Magna Cum Laude*.

# Joseph M. Noto

Registered Patent Attorney



patent validity and infringement opinions, application preparation and prosecution, reexamination and reissues

in-house and private practice experience to counsel domestic and international corporations, university research institutions, start-ups, and entrepreneurs

chemical and mechanical arts, energy, petroleum cracking catalysts, catalytic converters, internal combustion engines, biofuels, fuel cells, nanotechnology, semiconductor fabrication, medical devices, MEMS, electrospray ionization and nanofabrication techniques, medical devices, optical fibers, and pharmaceuticals

- B.S. Chemistry - SUNY Cortland
- J.D. George Washington University

# David L. Nocilly



- Registered Patent Attorney
- Litigation of patent, trademark, and copyright infringement.
- conducted patent claim construction hearings,
- trial counsel in Federal District Courts and the International Trade Commission on matters involving nationally known consumer electronic goods, medical devices, computer software systems, electrical wiring receptacles, and roller coasters,
- prepared and prosecuted patent applications for electromechanical, biomedical, and mechanical inventions, such as optical imaging/RFID enabled medical devices, genetic assays for brain diseases, pulmonary diagnostic devices, auditory detection systems, microRNA amplification processes, and NMR detectors
- counsels inventors on patent matters and assists companies with implementing value driven intellectual property strategies.
- B.S. Biology - Cornell University
- J.D. Syracuse University College of Law, *Summa Cum Laude*.

# Fred J.M. Price



- Registered Patent Attorney
- IP litigation - pharmaceutical dispute over cancer therapy drug
- patent and trademark prosecution and IP licensing, IP due diligence for M & A
- cancer therapies and diagnostics, microbiology, chemistry, alternative and renewable energy, software systems, medical devices, and manufacturing systems
- Prior to joining Bond, Mr. Price was with the New York City office of Fulbright & Jaworski LLP (Fulbright)
- research on the heterogeneous catalysis of a wide variety of environmental and industrial processes including exhaust gas purification; chemical research on new consumer products
- B.S. Biology - Lemoyne College
- J.D. Syracuse University College of Law, *Magna Cum Laude*.

# Michael D. Billok



- Registered Patent Attorney
- High profile patent infringement litigation regarding LCD projector technology, mobile phone text messaging and emergency response to 911 calls
- Submarine officer in the United States Navy, where he was qualified as an Engineer Officer by the Office of Naval Reactors,
- instructor at the Naval Nuclear Power Training Unit in Ballston Spa, New York, training sailors on aspects of nuclear propulsion
- B.S. in Physics, *with distinction* -United States Naval Academy
- J.D. Georgetown University Law Center

# Thank You

## Questions?

## Answers!

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Technique™**