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Electronic Publications as Prior Art – Disclosures in the Grey Area

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Some Prior Art Provisions

AIA 35 U.S.C. § 102(a)(1)

A person shall be entitled to a patent unless the claimed invention was patented, **described in a printed publication**, or in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention

Pre-AIA 35 U.S.C. § 102

(a) A person shall be entitled to a patent unless 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

(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

“Printed Publication”

- A reference is a “printed publication” if it is accessible to the public
 - Dissemination; or
 - Otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art, exercising reasonable diligence, can locate it
- Just like any other publication, an electronic publication is considered a “printed publication” if it is publicly accessible

Electronic Publications

- In particular, social media sites on the Internet, such as YouTube, Twitter, Facebook, and public forum posts, can be a source of prior art, provided the public accessibility requirement is met
 - Public accessibility is a case-by-case determination
 - Videos obtained from the Internet, such as YouTube videos, must be reduced to a writing, such as in the form of screen shots, a transcript, or explanation of the pertinent portions of the video

Date of Availability

- Prior art disclosures on the Internet are considered to be publicly available as of the date the item was publicly posted
- If the publication itself does not include a publication date (or retrieval date), it cannot be relied upon as prior art
 - Examiners are encouraged to consult the Scientific and Technical Information Center (STIC) to find the earliest date of publication
 - Examiners may rely on routine business practices to establish a public accessibility date

Digital Access to Prior Art

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Access to Prior Art Project

- Leveraging electronic resources to retrieve relevant information (prior art, search reports, etc.) from applicant's other applications.
- Automatically import relevant information into the file wrapper at the earliest point.
 - Potentially reduce applicants burden under the duty of disclosure.

Anticipated Benefits

- Quality and efficiency of examination is increased
- Examiner access to relevant prior art and supplemental information in a conveniently searchable manner
- Decreased applicant expense of submitting information and information disclosure statements
- Reduced burden for applicant compliance with duty to disclose information material to patentability

Current Project Status

- Request for Written Comment Period Ended – October 28, 2016
- Application Case Studies – Spring 2017
- Examiners Focus Sessions – Spring 2017
- Gathering and Refining Business Requirements – Ongoing
- Begin Phase 1 Development – Fall 2017
- Implementation of Phase 1 – Summer 2018

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Thank you!

