



---

Portfolio Media, Inc. | 648 Broadway, Suite 200 | New York, NY 10012 | [www.law360.com](http://www.law360.com)  
Phone: +1 212 537 6331 | Fax: +1 212 537 6371 | [customerservice@portfoliomedia.com](mailto:customerservice@portfoliomedia.com)

---

## The § 102(b) Foreign Filing Catch

Law360, New York (January 28, 2009) -- Patentees who intend to rely on a foreign filing for a priority date in the United States should beware — when it comes to 35 U.S.C. § 102(b) (“§ 102(b)”), patentees can only rely on a date of filing in the United States.

In U.S. patent law, a foreign priority date is generally as good as a United States filing date. However, § 102(b) is a clear exception. The § 102(b) catch means that a delay in filing in the United States can turn a 35 U.S.C. § 102(a) (“§ 102(a)”) reference that a patentee could swear behind into a § 102(b) reference that cannot be overcome.

Consider the following classic § 102 scenario. An inventor invents a new widget on Jan. 1, 2007. One month later, on Feb. 1, 2007, a third party publishes a paper that describes an almost identical widget. On March 1, 2007, the inventor files a patent application claiming the widget in the United States. The timeline for this scenario looks like this:

- Jan. 1, 2007: Inventor invents a widget.
- Feb. 1, 2007: Third party publishes a paper describing the same widget.
- March 1, 2007: Inventor files a patent application claiming the widget in the United States.

During prosecution, the inventor’s application is rejected based on the third party’s paper.

Because the inventor filed his application within one year of the publication of the paper, the paper is a § 102(a) reference, not a § 102(b) reference, and the inventor can swear behind it based on his invention date of Jan. 1, 2007. This is the classic case of an inventor overcoming a § 102 rejection.

Now consider a slightly different scenario. Instead of filing in the United States on March 1, 2007, the inventor files in Germany on March 1, 2007.

The inventor then files a patent application claiming the widget in the United States (or files a PCT application designating the United States) on March 1, 2008, with priority based on the German application under 35 U.S.C. § 119 ("§ 119"). In this scenario, the timeline looks like this:

- Jan. 1, 2007: Inventor invents a widget.
- Feb. 1, 2007: Third party publishes a paper describing the same widget.
- March 1, 2007: Inventor files a patent application in Germany claiming the widget.
- March 1, 2008: Inventor files a patent application claiming the widget in United States, with priority based on the German application under § 119.

This time, the rejection cannot be overcome. Although the inventor filed in Germany within one year of the publication of the third party paper, he did not file in the United States until more than a year after the publication. Therefore, the paper is a § 102(b) reference, and the inventor cannot swear behind it.

This result comes from the text of § 102(b). Section 102(b) states that a person shall be entitled to a patent unless "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 [emphasis added]."

Section 119 further confirms the requirements of § 102(b). In general, if a United States patent application is filed within one year of a foreign application and the United States patent application claims priority to the foreign application under § 119, the United States application will be treated as if it had been filed at the time the foreign application was filed. However, § 119 states one very important exception:

No patent shall be granted on any application for patent for an invention which had been patented or described in a printed publication in any country more than one year before the date of the actual filing of the application in this country, or which had been in public use or on sale in this country more than one year prior to such filing.

Thus, § 119 reiterates that the relevant date for § 102(b) is the actual filing date of the application in the United States.

This stands in contrast to § 119(e)(1)'s rule of priority from provisional applications, which

states that a United States application claiming priority to a United States provisional application has the same effect as if it was filed on the date the provisional was filed, with no exceptions.

What matters is where the application is filed, not what kind of application is filed. Therefore, provisional applications can be an inexpensive way to preserve rights in the United States.

The focus of § 102(b) on the date of filing in the United States, rather than priority date, can sometimes lead to strange results. Consider the following scenario.

An inventor invents a new widget on Jan. 1, 2004. A month later, on Feb. 1, 2004, a third party files a patent application in the United States describing an identical widget. On March 1, 2004, the third party publishes a paper describing the widget. On April 1, 2004, the inventor files a patent application claiming the widget in Japan.

One year later, on April 1, 2005, the inventor files an application claiming the widget in the United States (or a PCT application designating the United States), with priority based on the Japanese application under § 119. Here is the timeline for this scenario:

- Jan. 1, 2004: Inventor invents widget.
- Feb. 1, 2004: Third party files a patent application describing the same widget.
- March 1, 2004: Third party publishes a paper describing the same widget.
- April 1, 2004: Inventor files a patent application in Japan claiming the widget.
- April 1, 2005: Inventor files a patent application in the United States claiming the widget, with priority based on the Japanese application under § 119.

The United States application is rejected based on the third party patent application filed on Feb. 1, 2004 and the third party paper published a month later.

The third party patent application is a § 102(e) reference, and the inventor can overcome it by swearing behind it based on his invention date of Jan. 1, 2004.

However, the third party paper published a month later is a § 102(b) reference because the inventor did not file in the United States within a year of publication of the paper.

The fact that the inventor filed in Japan within a year of the publication of the paper will not

keep the reference from being a § 102(b) reference. The inventor cannot swear behind the § 102(b) reference, even though he was able to swear behind the earlier § 102(e) reference.

The take-home message: United States patent law has gradually eliminated many distinctions between activities occurring in foreign countries and activities occurring in the United States.

For example, during interferences, foreign inventive activities are afforded the same status as United States inventive activities.

However, one significant distinction between foreign activity and United States activity remains. The relevant date for overcoming a § 102(b) rejection is not the priority date of a filing in any country, but instead the date the application was filed in the United States.

When relevant § 102(b) events are known, it is easy to ensure that a timely filing (i.e., a filing within a year of the date of publication, public use, or sale), is made in the United States. However, not all § 102(b) events will be known. It is these hidden uses, publications, and sales that the practitioner must protect against.

Because there is always the possibility that a hidden § 102(b) event has occurred, the safest course is to file a provisional application in the United States before, or concurrent with, any foreign applications.

While a United States provisional application will not preserve foreign rights in light of a prior publication, it is an inexpensive way to preserve United States rights in light of a prior publication.

Securing an early United States filing date through a provisional application can prove invaluable when hidden uses, publications and sales are discovered during prosecution in the United States.

--By Birgit Millauer (pictured) and Elspeth Simpson White, Fish & Richardson PC

*Birgit Millauer is a principal with Fish in the firm's Silicon Valley office. Elspeth Simpson White is an associate with the firm in the Silicon Valley office.*

*The opinions expressed are those of the authors and do not necessarily reflect the views of Portfolio Media, publisher of Law360.*