A. Old Law or New Law?

The first step in identifying the effective prior art date of a reference is to determine whether the old law or the new law applies, which in turn depends on the effective filing date of all of the claims in the application.

Namely, if all claims are entitled to an effective filing date prior to March 16, 2013, then the old law applies. However, if even one newly presented claim depends for its support on material added on or after March 16, 2013, then the new law applies to all of the claims. The new law will continue to apply, even if that one new claim is later canceled.

Example 1:

JP-A------------------------|------------------------US-A


Example 2:

JP-A------------------------|-------------------------PCT-----------------US-A


Example 3:


Example 4:


In this scenario, PCT claims priority from JP-A. Instead of entering the US national stage, Applicant files a CIP bypass continuation of the PCT application which in turn claims priority from JP-A. At least one of the claims depends for its support on material added with the filing of the CIP application. The new law applies.

B. Applying the New Law - Prior Art under AIA

We need to consider new §102(a)(1) and §102(a)(2). Apart from public use/sale, the broadened scope of prior art under the new law will be most apparent under §102(a)(2).

§102. Conditions for patentability: novelty
(a) NOVELTY; PRIOR ART, - A person shall be entitled to a patent unless

(1) the claimed invention was patented [anywhere in the world], described in a printed publication [anywhere in the world], or in public use [anywhere in the world], on sale [anywhere in the world], or otherwise available to the public [anywhere in the world] before the effective filing date of the claimed invention; or

(2) the claimed invention was described in a [US] patent issued under section 151, or in an application for patent [US or PCT application designating the US] published or deemed published under section 122(b) [published US or PCT application designating the US], in which the [US] patent or application [US application or PCT application designating the US], as the case may be, names another inventor and was effectively filed before the effective filing date of the claimed invention.
Example 1: Applying §102(a)(1)

X

| JP-A-----------------------------------------------US-A
Prior Art      May 1, 2013                      May 1, 2014

Because US-A has an effective filing date of May 1, 2013 that is on or after March 16, 2013, the new law applies. X, which is a Japanese kokai laid-open on Jan. 1, 2010, is prior art against US-A as of its laid-open date.

Example 2: Applying §102(a)(1)

X


Example 3: Applying §102(a)(2)

The reference in this example is a US application published July 1, 2014 and which claims priority from a Japanese application filed January 1, 2013. Under the old law, the published US application, by another, is §102(e) prior art as of its Jan. 1, 2014 US filing date. Under the new law, the published application is prior art as of its Jan. 1, 2013 Japanese filing date.

The first thing that we do is to determine whether the old law or the new law applies. We then place an “X” in the time line indicating the effective prior art date of the reference. Lastly, we determine whether that reference may be antedated (by perfecting the claim to priority).

In this example, notice how the “X” moves depending on whether the old law or the new law applies.

**Old Law**

<table>
<thead>
<tr>
<th></th>
<th>1-1-13</th>
<th>3-16-13</th>
<th>1-1-14</th>
<th>7-1-14</th>
</tr>
</thead>
<tbody>
<tr>
<td>Prior Art Date:</td>
<td>X</td>
<td></td>
<td></td>
<td></td>
</tr>
<tr>
<td>Applicant:</td>
<td>JP-A-------</td>
<td>-----------------------</td>
<td>US-A</td>
<td></td>
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</tbody>
</table>

**New Law**

<table>
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<th></th>
<th>1-1-13</th>
<th>3-16-13</th>
<th>1-1-14</th>
<th>7-1-14</th>
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</thead>
<tbody>
<tr>
<td>Prior Art Date:</td>
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<td></td>
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</tr>
<tr>
<td>Applicant:</td>
<td>JP-A-----------------------</td>
<td>US-A</td>
<td></td>
<td></td>
</tr>
</tbody>
</table>

4
Example 4: Applying 102(a)(2)

New Law

1-1-13  3-16-13  1-1-14  7-1-14
Prior Art Date: X


We can antedate the reference with respect to those claims which find support in JP-A1, but not with respect to those claims which are based on material added with the filing of JP-A2.

Example 5: Invoking New Law by Presenting a Claim Based on Material Added on or After March 16, 2013

JP-A1 filed Dec. 15, 2012 discloses that Y of formula (1) is a 5- or 6-member heterocyclic group including at least one atom selected N, S and O. No examples are given. JP-A2 filed May 1, 2013 supplements the definition of Y to describe that Y is pyridinyl in a preferred embodiment. US-A filed Dec. 15, 2013 claiming priority from both JP-A1 and JP-A2 is filed with claims that are fully supported by JP-A1 (i.e., Y is a 5- or 6-member heterocyclic group). At this point, the old law applies.

During prosecution, Applicant adds a claim which recites that Y is pyridinyl. The new law now applies.
Using the date pattern of Example 4, we see that a reference that was not prior art when US-A was filed (old law) becomes prior art once Applicant adds the claim which recites that Y is pyridinyl (invoking the new law).

**Old Law: All claims find support in JP-A1**

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<tr>
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<th>1-1-14</th>
<th>7-1-14</th>
</tr>
</thead>
<tbody>
<tr>
<td>Prior Art Date:</td>
<td>X</td>
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**New Law: Applicant adds a claim based on JP-A2**

<table>
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<tr>
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<th>1-1-14</th>
<th>7-1-14</th>
</tr>
</thead>
<tbody>
<tr>
<td>Prior Art Date:</td>
<td>X</td>
<td></td>
<td></td>
<td></td>
</tr>
</tbody>
</table>

We can antedate the reference with respect to those claims which find support in JP-A1, but not with respect to those claims which are based on material added with the filing of JP-A2.
Example 6: WIPO Publication Language no Longer Relevant

Old Law: No §102(e) date if WIPO publication was not in English

1-1-10  1-1-11  7-1-11
(Japanese)
Prior Art: X §102(a)
Applicant: JP-A --------------------- USA

Old Law: WIPO publication in English and PCT designates the US

1-1-10  1-1-11  7-1-11
(English)
Prior Art: X §102(e)  X §102(a)
Applicant: JP-A --------------------- USA

New Law: Prior art date carries back to PCT priority application

1-1-14  1-1-15  7-1-15
(Japanese)
Prior Art: X §102(a)(2)  X §102(a)(1)
Applicant: JP-A --------------------- USA