

## **“PRIOR ART” AND THE “GRACE PERIOD” IN H.R. 1249**

### **H.R. 1249 Limits Prior Art to Public Disclosures – And Fully Protects the Grace Period**

#### ***H.R. 1249 Provides A Simple Objective Standard for Determining What Constitutes Prior Art and Maintains and Improves the “Grace Period” That Inventors Enjoy Under Current Law***

H.R. 1249 simplifies the law relating to the patenting of inventions by clarifying that to qualify as “prior art” a disclosure may not be secret, but must previously have become “available to the public.” As explained in the Senate’s discussion of identical language in S.23, “the new paragraph 102(a)(1) imposes an overarching requirement for availability to the public, that is a public disclosure, which will limit paragraph 102(a)(1) prior art to subject matter meeting the public accessibility standard that is well-settled in current law, especially case law of the Federal Circuit.” (Cong. Rec. S1496, March 9, 2011). Clarifying that only publicly available disclosures qualify as prior art ensures that patent examiners will have access to all relevant information when determining whether an invention is patentable, resulting in more predictable and reliable patents.

As under current law, H.R. 1249 also specifies that an inventor’s own disclosure will not qualify as “prior art” if made one year or less before he/she seeks a patent. Again as explained in the Senate’s discussion of the identical provision in S. 23, “We intend that if an inventor’s actions are such as to constitute prior art under subsection 102(a), then those actions necessarily trigger subsection 102(b)’s protections for the inventor and, what would otherwise have been section 102(a) prior art, would be excluded as prior art by the grace period provided by subsection 102(b).”(Id.)

Together, these provisions will improve the quality of patents, while maintaining and improving the one year grace period currently enjoyed by inventors.

#### ***The Relevant Provisions of H.R. 1249 Do Not Require Further Amendment or Refinement***

The language H.R. 1249 has been carefully considered and refined over three Congresses and should not be changed, especially if that change would harm inventors by reintroducing concepts of “secret prior art,” activities that are secret and not in any way available to the public. Such prior art does not serve the Constitutional objective of advancing technological progress; it would merely retain the type of subjective and complex rules that the National Academies of Sciences urged be deleted from U.S. patent law in its seminal study. (A Patent System for the 21<sup>st</sup> Century, 2004, [http://www.nap.edu/catalog.php?record\\_id=10976](http://www.nap.edu/catalog.php?record_id=10976))