

Generic Pharmaceutical Patent and FDA Law § 1:71

Generic Pharmaceutical Patent and FDA Law  
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Chapter 1. Basics of Patent Law  
III. Statutory Provisions  
F. Sections 119, 120, and 121: priorities

[References](#)

§ 1:71. Section 119: Claiming foreign priority—Section 102(b) prior art is not affected by section 119(a)

**West's Key Number Digest**

**West's Key Number Digest, Patents** 🔑90(1)

Another portion of § 119(a) worth mentioning is the interaction of §§ 119(a) and 102(b) for the purposes of determining prior art dates when the U.S. patent claims priority to a foreign application. In *Janssen Pharmaceutica v. Eon Labs Manufact. Inc.*, an issue in the case involved whether § 102(b) activity invalidated [U.S. Patent No. 5,633,105](#).<sup>1</sup> Operatively, Janssen filed the foreign application on Sept. 3, 1992. Within one year, Janssen duly filed the U.S. application (via the PCT filing) on Aug. 27, 1993. What is the prior art date to invalidate the patent? Most people would believe that the earliest effective filing date is Sept. 3, 1992, and hence applicable § 102(b) prior art would have be dated for at least one year before this, i.e., Sept. 2, 1991. That is wrong. Because of the last sentence of § 119(a), it states that the foreign priority date cannot be used by the patentee/applicant when adjudicating the patentability of § 102(b) prior art. Accordingly, the relevant filing date is the PCT filing date of Aug. 27, 1993, and hence the relevant “critical date” for § 102(b) prior art is one year before this date, i.e., Aug. 27, 1992. As such, if there is intervening prior art between the foreign priority date and the U.S. filing date, it might invalidate the U.S. claims.

**Practice Tip:**

For generic companies attempting to invalidate a U.S. patent that claims priority to foreign applications, the critical date for § 102(b) prior art is one year before the actual U.S. filing date. For foreign patent applicants, it is important to know the effect of waiting the traditional one year after filing the foreign priority document before filing the later U.S. application. It might be prudent in circumstances to file the U.S. application shortly after the foreign priority application.

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Footnotes

<sup>1</sup> [Janssen Pharmaceutica, N.V. v. Eon Labs Mfg., Inc.](#), 134 Fed. Appx. 425 (Fed. Cir. 2005).