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2105 Patentable Subject Matter — Living Subject Matter [R-1]

The decision of the Supreme Court in *Diamond v. Chakrabarty*, 447 U.S. 303, 206 USPQ 193 (1980), held that microorganisms produced by genetic engineering are not excluded from patent protection by 35 U.S.C. 101. It is clear from the Supreme Court decision and opinion that the question of whether or not an invention embraces living matter is irrelevant to the issue of patentability. The test set down by the Court for patentable subject matter in this area is whether the living matter is the result of human intervention.

In view of this decision, the Office has issued these guidelines as to how 35 U.S.C. 101 will be interpreted.

The Supreme Court made the following points in the *Chakrabarty* opinion:

1. “Guided by these canons of construction, this Court has read the term ‘manufacture’ in § 101 in accordance with its dictionary definition to mean ‘the production of articles for use from raw materials prepared by giving to these materials new forms, qualities, properties, or combinations whether by hand labor or by machinery.’”

2. “In choosing such expansive terms as ‘manufacture’ and ‘composition of matter,’ modified by the comprehensive ‘any,’ Congress plainly contemplated that the patent laws would be given wide scope.”

3. “The Act embodied Jefferson’s philosophy that ‘ingenuity should receive a liberal encouragement.’ 5 Writings of Thomas Jefferson, at 75-76. See *Graham v. John Deere Co.*, 383 U.S. 1, 7-10 (1966). Subsequent patent statutes in 1836, 1870, and 1874 employed this same broad language. In 1952, when the patent laws were recodified, Congress replaced the word ‘art’ with ‘process,’ but otherwise left Jefferson’s language intact. The Committee Reports accompanying the 1952 act inform us that Congress intended statutory subject matter to ‘include any thing under the sun that is made by man.’ S. Rep. No. 1979, 82d Cong., 2d Sess., 5 (1952).”

4. “This is not to suggest that § 101 has no limits or that it embraces every discovery. The laws of nature, physical phenomena, and abstract ideas have been held not patentable.”

5. “Thus, a new mineral discovered in the earth or a new plant found in the wild is not patentable subject matter. Likewise, Einstein could not patent his celebrated law that $E=mc^2$; nor could Newton have patented the law of gravity.”

6. “His claim is not to a hitherto unknown natural phenomenon, but to a nonnaturally occurring manufacture or composition of matter — a product of human ingenuity ‘having a distinctive name, character [and] use.’ ”

7. “Congress thus recognized that the relevant distinction was not between living and inanimate things, but between products of nature, whether living or not, and human-made inventions. Here,

35 U.S.C. 102(a) or (b).); *In re Talbott*, 443 F.2d 1397, 170 USPQ 281 (CCPA 1971) (Applicant cannot avoid a 35 U.S.C. 102(d) rejection by exercising an option to keep the subject matter of a German Gebrauchsmuster (petty patent) in secrecy until time of U.S. filing.).

IV. THE SAME INVENTION MUST BE INVOLVED

“Same Invention” Means That the Application Claims Could Have Been Presented in the Foreign Patent

Under 35 U.S.C. 102(d), the “invention... patented” in the foreign country must be the same as the invention sought to be patented in the U.S. When the foreign patent contains the same claims as the U.S. application, there is no question that “the invention was first patented... in a foreign country.” *In re Kathawala*, 9 F.3d 942, 945, 28 USPQ2d 1785, 1787 (Fed. Cir. 1993). However, the claims need not be identical or even within the same statutory class. If applicant is granted a foreign patent which fully discloses the invention and which gives applicant a number of different claiming options in the U.S., the reference in 35 U.S.C. 102(d) to “`invention... patented' necessarily includes all the disclosed aspects of the invention. Thus, the section 102(d) bar applies regardless whether the foreign patent contains claims to less than all aspects of the invention.” 9 F.3d at 946, 28 USPQ2d at 1788. In essence, a 35 U.S.C. 102(d) rejection applies if applicant’s foreign application supports the subject matter of the U.S. claims. *In re Kathawala*, 9 F.3d 942, 28 USPQ2d 1785 (Fed. Cir. 1993) (Applicant was granted a Spanish patent claiming a method of making a composition. The patent disclosed compounds, methods of use and processes of making the compounds. After the Spanish patent was granted, the applicant filed a U.S. application with claims directed to the compound but not the process of making it. The Federal Circuit held that it did not matter that the claims in the U.S. application were directed to the composition instead of the process because the foreign specification would have supported claims to the composition. It was immaterial that the formulations were unpatentable pharmaceutical compositions in Spain.).

2136 35 U.S.C. 102(e)

35 U.S.C. 102. Conditions for patentability; novelty and loss of right to patent.

A person shall be entitled to a patent unless-

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

ONLY U.S. PATENTS AND SIRS ARE ELIGIBLE AS PRIOR ART UNDER 35 U.S.C. 102(e)

The reference must be a U.S. patent to be eligible for use in a 35 U.S.C. 102(e) rejection. *Ex parte Smolka*, 207 USPQ 232 (Bd. App. 1980) (A foreign patent document with priority back to an abandoned U.S. application cannot be the basis for a 35 U.S.C. 102(e) rejection. The foreign document cannot be prior art until it is patented or published.). Statutory Invention Registrations (SIRS) can also be used in 35 U.S.C. 102(e) rejections as of their filing dates.

DEFENSIVE PUBLICATIONS ARE NOT PRIOR ART AS OF THEIR FILING DATE

A defensive publication is not a patent, it is a publication. Therefore, it is prior art only as of its publication date. *Ex parte Osmond*, 191 USPQ 334 (Bd. App. 1973) (Examiner rejected the claims over Defensive Publication T-858,018 issued by the PTO to Jacobson. The examiner made a 35 U.S.C. 102(a) rejection contending that a defensive publication can be used as a reference under 35 U.S.C. 102(a) as of its filing date. This position was authorized at that time by the MPEP and a Commissioner’s Notice establishing the Defensive Publication Program. The Board found that in order for a 35 U.S.C. 102(a) rejection to apply, the reference must be of public knowledge and a Defensive Publication is not public knowledge at the time of its filing. Thus, the Board reversed the rejection. The Board also found that 35 U.S.C. 102(e) could not be used as a basis for rejection because the use of Defensive Publications as of their filing dates was not supported by section 102(e.). See MPEP § 711.06(a) for more information on Defensive Publications as references.

2136.01 Status of U.S. Patent as a Reference Before and After Issuance

WHEN THERE IS NO COMMON ASSIGNEE OR INVENTOR, AN APPLICATION MUST ISSUE AS A PATENT BEFORE IT IS AVAILABLE AS PRIOR ART UNDER 35 U.S.C. 102(e)

Generally, a U.S. patent must issue before it can be used as a reference in a 35 U.S.C. 102(e) rejection. *Ex parte Smolka*, 207 USPQ 232 (Bd. App. 1980) (An application to Smolka and Schwuger was rejected over 35 U.S.C. 102(e) based on a pending U.S. application to Corkill whose filing date antedated the Smolka *et al.* application. A German application corresponding to the Corkill application had been published, but did not antedate the effective filing date of the Smolka *et al.* application. The Board reversed the

rejection holding that a U.S. patent had to be issued to Corkill before it could become available as prior art under 35 U.S.C. 102(e). There was no common assignee nor any common inventor between the two applications.).

WHEN THERE IS A COMMON ASSIGNEE OR INVENTOR, A PROVISIONAL 35 U.S.C. 102(e) REJECTION OVER AN EARLIER FILED APPLICATION CAN BE MADE

Based on the assumption that an application will ripen into a U.S. patent, it is permissible to provisionally reject a later application over an earlier application under 35 U.S.C. 102(e). *In re Irish*, 433 F.2d 1342, 167 USPQ 764 (CCPA 1970). Such a provisional rejection “serves to put applicant on notice at the earliest possible time of the possible prior art relationship between copending applications” and gives applicant the fullest opportunity to overcome the rejection by amendment or submission of evidence. In addition, since both applications are pending and usually have the same assignee, more options are available to applicant for overcoming the provisional rejection than if the other application were already issued. *Ex parte Bartfeld*, 16 USPQ2d 1714 (Bd. Pat. App. & Int. 1990) *aff’d on other grounds*, 925 F.2d 1450, 17 USPQ2d 1885 (Fed. Cir. 1991). Note that provisional rejections over 35 U.S.C. 102(e) are only authorized when there is a common inventor or assignee, otherwise the copending application must remain confidential. MPEP § 706.02(f) and § 706.02(k) discuss the procedures to be used in provisional rejections over 35 U.S.C. 102(e) and 103.

2136.02 Content of the Prior Art Available Against the Claims

A 35 U.S.C. 102(e) REJECTION MAY RELY ON ANY PART OF THE PATENT DISCLOSURE

Under 35 U.S.C. 102(e), the entire disclosure of a U.S. patent having an earlier filing date can be relied on to reject the claims. *Sun Studs, Inc. v. ATA Equip. Leasing, Inc.*, 872 F.2d 978, 983, 10 USPQ2d 1338, 1342 (Fed. Cir. 1989).

U.S. PATENT REFERENCE MUST ITSELF CONTAIN THE SUBJECT MATTER RELIED ON IN THE REJECTION

When a U.S. patent is used to reject claims under 35 U.S.C. 102(e), the disclosure relied on in the rejection must be present in the issued patent. It is the filing date of the U.S. patent being relied on as the critical reference date and subject matter not included in the patent itself can only be used when that subject matter becomes public. Portions of the patent application which were canceled are not part of the patent and thus cannot be relied on in a 35 U.S.C.

102(e) rejection over the issued patent. *Ex Parte Stalego*, 154 USPQ 52 (Bd. App. 1966). Likewise, subject matter which is disclosed in a parent application, but not included in the child continuation-in-part (CIP) cannot be relied on in a 35 U.S.C. 102(e) rejection over the issued CIP. *In re Lund*, 376 F.2d 982, 153 USPQ 625 (CCPA 1967) (The examiner made a 35 U.S.C. 102(e) rejection over an issued U.S. patent which was a continuation-in-part (CIP). The parent application of the U.S. patent reference contained an example II which was not carried over to the CIP. The court held that the subject matter embodied in the canceled example II could not be relied on as of either parent or child filing date. Thus, the use of example II subject matter to reject the claims under 35 U.S.C. 102(e) was improper.).

THE SUPREME COURT HAS AUTHORIZED 35 U.S.C. 103 REJECTIONS BASED ON 35 U.S.C. 102(e)

U.S. patents may be used as of their filing dates to show that the claimed subject matter is anticipated or obvious. Obviousness can be shown by combining other prior art with the U.S. patent reference in a 35 U.S.C. 103 rejection. *Hazeltine Research v. Brenner*, 382 U.S. 252, 147 USPQ 429 (1965).

2136.03 Critical Reference Date [R-1]

I. FOREIGN PRIORITY DATE

Reference's Foreign Priority Date Under 35 U.S.C. 119(a)-(d) Cannot Be Used as the 35 U.S.C. 102(e) Reference Date

A U.S. patent reference is effective prior art as of its U.S. filing date. 35 U.S.C. 119(a)-(d) does not modify section 102(e) which is explicitly limited to patent references “filed in the United States before the invention thereof by the applicant” (emphasis added). Therefore, the foreign priority date of the reference under 35 U.S.C. 119(a)-(d) cannot be used to antedate the application filing date. In contrast, applicant may be able to overcome the 35 U.S.C. 102(e) rejection by proving he or she is entitled to his or her own 35 U.S.C. 119 priority date which is earlier than the reference’s U.S. filing date. *In re Hilmer*, 359 F.2d 859, 149 USPQ 480 (CCPA 1966) (*Hilmer I*) (Applicant filed an application with a right of priority to a German application. The examiner rejected the claims over a U.S. patent to Habicht based on its Swiss priority date. The U.S. filing date of Habicht was later than the application’s German priority date. The court held that the reference’s Swiss priority date could not be relied on in a 35 U.S.C. 102(e) rejection. Because the U.S. filing date of Habicht was later than the earliest effective filing date (German priority date) of the application, the rejection was reversed.). See MPEP

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