

Why the Grace Period Restoration Act Is a Bad Idea

Article By:

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Representatives **Sensenbrenner** (R-WI) and **Conyers** (D-MI) have introduced the “Grace Period Restoration Act of 2015? (H.R. 1791) to “correct the drafting problem in the Leahy-Smith American Invents Act relating to the grace period,” and “maintain the position of leadership of the United States in educational, technological, and scientific programs.” After giving some thought to the proposed legislative “fix,” I can think of at least five reasons why it could do more harm than good.

The Grace Period “Problem”

H.R. 1791 is directed to the grace periods reflected in 35 USC § 102(b)(1)(B) and (b)(2)(B), relating to the “shielding” effect of an inventor’s pre-filing public disclosure. Section 102(b)(1)(B) provides:

(b) EXCEPTIONS.—

(1) DISCLOSURES MADE 1 YEAR OR LESS BEFORE THE EFFECTIVE FILING DATE OF THE CLAIMED INVENTION.—A disclosure made 1 year or less before the effective filing date of a claimed invention shall not be prior art to the claimed invention under subsection (a)(1) if—

(B) the subject matter disclosed had, before such disclosure, been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor.

35 USC § 102(b)(2)(B) is similar, but disqualifies disclosures in applications and patents filed before the effective filing date of the claims at issue but after the inventor’s public disclosure.

The USPTO’s implementing regulation is 37 CFR § 1.130, but it is the USPTO’s First Inventor To File Examination Guidelines which reveals the USPTO’s narrow interpretation of the scope of this exception to the first-inventor-to-file paradigm. Although the USPTO backed away from its initial interpretation that would have required nearly *ipsis verbis* identity between the inventor’s public disclosure and the disclosure being disqualified (discussed in [this article](#)), the USPTO still believes that the subject matter in the disclosure being disqualified “must be **the same ‘subject matter’** as the subject matter previously publicly disclosed by the inventor.” The Examination Guidelines give these examples:

- [I]f the inventor ... had publicly disclosed a species, and a subsequent intervening grace period disclosure discloses a genus (i.e., provides a more generic disclosure of the species), the intervening grace period disclosure of the genus is not available as prior art under AIA 35

BUT

- [I]f the inventor ... had publicly disclosed a genus, and a subsequent intervening grace period disclosure discloses a species, the intervening grace period disclosure of the species would be available as prior art
- [I]f the inventor or a joint inventor had publicly disclosed a species, and a subsequent intervening grace period disclosure discloses an alternative species not also disclosed by the inventor or a joint inventor, the intervening grace period disclosure of the alternative species would be available as prior art

The Grace Period “Solution”

H.R. 1791 would add new § 102(b)(3):

(3) DISCLOSURES BY ANY PERSON AFTER PUBLIC DISCLOSURE OF A CLAIMED INVENTION BY AN INVENTOR.—

(A) DEFINITIONS.—In this paragraph—

(i) the term ‘covered person’, with respect to a claimed invention, means—

(I) the inventor;

(II) a joint inventor; or

(III) another who obtained the claimed invention directly or indirectly from the inventor or a joint inventor; and

(ii) the term ‘relevant section 112(a) requirements’ means the requirements for a specification under section 112(a) other than the requirement to set forth the best mode of carrying out the invention.

(B) PUBLIC DISCLOSURE.—A disclosure by any person shall not be prior art to a claimed invention under subsection (a) or section 103 if—

(i) the disclosure is made under subsection (a)(1) or effectively filed under subsection (a)(2) 1 year or less before the effective filing date of the claimed invention; and

(ii) before the disclosure described in clause (i) is made or filed, and 1 year or less before the effective filing date of the claimed invention, the claimed invention is publicly disclosed in a printed publication by a covered person in a manner that satisfies the relevant section 112(a) requirements.

(C) DETERMINATION THAT PUBLIC DISCLOSURE WOULD HAVE SATISFIED SPECIFICATION REQUIREMENTS.—In determining under subparagraph (B) whether a claimed invention was publicly disclosed in a printed publication by a covered person in a manner that satisfied the relevant section 112(a) requirements—

(i) only the state of the art known on and before the date of the disclosure may be considered; and

(ii) satisfaction of the relevant section 112(a) requirements may be—

(I) established by 1 or more public disclosures in printed publications made by a covered person during the period of 1 year or less between—

(aa) the disclosure by the covered person described in subparagraph (B)(ii); and
(bb) the effective filing date of the claimed invention; and

(II) supported by statements under declaration or oath relating to the existence and content of the public disclosure or disclosures in printed publications described in subclause (I).

(D) PRESUMPTION OF VALIDITY.—An applicant for a patent shall present to the Patent and Trademark Office, before the Patent and Trademark Office issues a notice of allowance of the application for the patent, each disclosure under subparagraph (C)(ii)(I) and any statement under subparagraph (C)(ii)(II) in order for the section 112(a) support provided by each such disclosure or statement under subparagraph (C)(ii) to be taken into account under the section 282(a) presumption of validity of an issued patent.

(E) CERTAIN DISCLOSURES NOT PRIOR ART.—A disclosure described in paragraph (1)(A), (2)(A), or (2)(C) shall not be prior art to a claimed invention under this paragraph.

(F) PROCEDURES.—The Patent and Trademark Office may establish procedures to carry out this paragraph.

Five Reasons Why H.R. 1791 Is A Bad Idea

1. A broader grace period could lead to the loss of foreign patent rights. One “finding” upon which H.R. 1791 is based is that “[m]isappropriation ... of disclosed inventions is likely to increase, especially in countries that take advantage of the technological prowess of the United States without appropriately compensating inventors.”** Yet, expanding the grace period could weaken the intellectual property protections available to U.S. inventors in other countries, because many other countries do not have any grace period. This means that U.S. inventors who are lulled by H.R. 1791 into publicly disclosing their inventions before filing their patent applications may not be able to obtain a patent in any other country, leaving competitors free to exploit their inventions outside the United States.

**If this is meant to be a dig at China, Congress should confer with the USPTO on its initiatives to improve Chinese intellectual property laws, regulations and enforcement procedures.

2. H.R. 1791 rests on a number of unproven “findings.” Section 2 of H.R. 1791 sets forth “findings” upon which the legislation rests. Some of the more questionable ones include:

- [I]nstitutions of higher education and government laboratories face a difficult and expensive challenge in gaining and utilizing the full scope of patent rights.
- Job growth and the creation of start-up companies and small businesses are thwarted ... by the difficulty and expense of gaining and utilizing patent rights, which hinders the economy of the United States and the technological leadership of the United States in a competitive global economy.
- Discouragement of scientific research publication [by requiring patent applications to be filed first?] ... delays, if not denies, the opportunity for the public to realize the benefits of research results.

3. A narrow grace period creates more certainty. Another “finding” in H.R. 1791 asserts that uncertainty surrounding the scope of the grace period discourages early publication which in turn “thwarts scientific advances and “chills collaborative research activities.” If universities, start-up companies, and small businesses understand that the “shielding disclosure” grace periods are narrow, they can implement policies that facilitate prompt patent application filings and permit early disclosures once an effective filing date has been secured.

4. H.R. 1791 would create more uncertainty. If uncertainty is a problem, proposed § 102(b)(3)(C) cannot be the solution. The new grace period exception would require a showing that the inventor’s public disclosure satisfied the written description and enablement requirements for the claimed invention and would permit that showing to be supported by other disclosures made by the inventor in other grace period printed publications and to be supported by declarations. An exception that invokes two complicated legal standards (written description and enablement) and contemplates extrinsic evidentiary support will not simplify the patent system for U.S. inventors and will foster, not reduce, patent litigation over the availability of the grace period.

5. The USPTO’s interpretation of 35 USC § 102(b)(1)(B)/(b)(2)(B) has not been tested. While it’s possible that an applicant has tried to invoke the grace period exception of 35 USC § 102(b)(1)(B) or (b)(2)(B) and been unable to do so because of the USPTO’s narrow interpretation, I am not aware of any PTAB decision upholding a rejection based on non-disqualified intervening prior art, or any court decision upholding the USPTO’s interpretation. Thus, H.R. 1791 attempts to solve a problem that may not even exist, while jeopardizing the international patent position of U.S. inventors.

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