
The Treatment of Derivation and Independent Conception Under the America Invents Act

By Joseph A. Micallef

The Leahy-Smith America Invents Act (AIA) made several significant modifications to the test for novelty when reviewing the patentability or validity of a claimed invention under 35 U.S.C. § 102. By far the most consequential was changing the statute from a (mostly) first to invent system under pre-AIA Section 102 (Old Section 102) to a (mostly) first to file system under the AIA's Section 102 (New Section 102). This was accomplished mainly by linking all categories of prior art creating events (e.g., publication, patenting, public use . . .) to the inventor's effective filing date and by deleting Old Sections 102(f) and (g), which, respectively, made information derived from another and the prior inventions of others prior art. During the Senate debates on the AIA, Senator Kyl made much of this change, arguing it was justified and beneficial because it would remove the need to keep records of and litigate dates of conception and acts of diligence¹ and would protect inventors from the risk of some "unscrupulous third party" stealing their invention and obtaining a patent on it.²

One objection to Senator Kyl's point of view is that New Section 102 may not have actually removed the need to address inventorship or prevented a third party from deriving the invention from the original conceiver and obtaining a patent that would "block the U.S. inventor from practicing his own invention." Consider, for example, the "exceptions" to the novelty analysis set forth in New Section 102(b). These exceptions are important to that analysis because they exclude certain events from being considered prior art, even if those events fall within New Section 102(a). The phrase "the inventor" is used throughout New Section 102(b), so the meaning of that phrase will often

figure into the analysis.³ But who, exactly, does that phrase refer to in this context?

One might assume that the phrase refers to the person listed as inventor on the application or patent being analyzed. That is a plausible reading, but as demonstrated below, not the only one. And, if history is any guide, situations will arise where there are multiple individuals who might be considered "the inventor," or an inventor, under any reading of the statute. Two of the more interesting are, coincidentally, where one individual named as an inventor on a patent application derived the invention from another, and where two individuals independently conceived of the same invention at about the same time, exactly the two scenarios Old Sections 102(f) and (g) addressed.

But before addressing such situations and analyzing how New Section 102 applies to them, we need to know who "the inventor" referred to in the statute is. As noted above, one plausible interpretation of that statutory phrase is that when analyzing the novelty of a particular claim, "the inventor" is the individual named as the inventor on the application (or patent) in which the claim is found. In other words, when we are analyzing a patent application that names Jane as the inventor, then Jane is "the inventor" for purposes of our analysis of New Section 102. On the other hand, when we are analyzing a patent application that names Mary as the inventor, then Mary is "the inventor" for purposes of our analysis of New Section 102.⁴ Let's call this interpretation of the phrase "the inventor" in New Section 102 the "Named Inventor Interpretation."

This interpretation seems reasonable in view of the specific wording of the statute, the purposes of the statute, and the context in which it exists. For example, New Section 102's use of the phrase "the inventor," as opposed to "an inventor," is obviously specific to a particular individual. Who could it be? Well, as its predecessor statute did, New Section 102 begins with the phrase "[a] person shall be entitled

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to a patent unless . . .” and then sets forth the novelty-related conditions of patentability the “person” must satisfy in order to be granted a patent. Who is this “person”? Clearly, it is the individual seeking the patent, i.e., the person(s) named as inventor on the application or patent.

This view seems confirmed when we consider a typical situation in which the novelty analysis involves comparing the claim in a patent or application to, for example, a prior art printed publication. In that situation “the inventor” must be the individual named on the patent or application being analyzed, as it would be very unusual to refer to the author of a printed publication as an “inventor;” we usually label that person an “author.” But if in that situation “the inventor” referred to in the statute is the individual named on the application or patent being analyzed, the interpretation of that phrase should be the same when we compare the same claim to a different prior art reference that, for example, happens to be someone else’s patent or application.

Note also that New Section 102(a)(2) makes certain patents and applications prior art so long as they “name[] another inventor.”⁵ That also suggests the “the inventor” refers to the individual(s) named on the patent or application being analyzed.

So, what appears to be the most natural interpretation of the statutory phrase “the inventor” seems to be fairly well supported by the usual sources of information we look to for statutory interpretation. But how does that interpretation work when we are faced with the fact patterns that seemed to bother Senator Kyl? Let’s look at a couple, beginning with a scenario in which an “unscrupulous third party” derives an invention from a true inventor and then both file an application for a patent on that very same invention.

The Derivation Scenario

We will start with an admittedly somewhat contrived sequence of events, and then “tweak” the

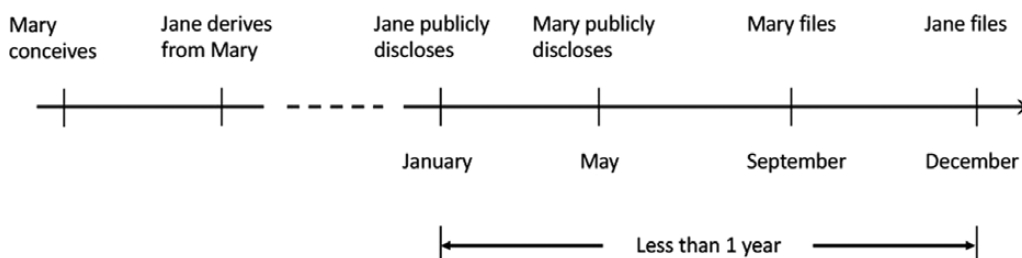
facts a little later on to hopefully show that the issues discussed here are not limited to that single, contrived set of facts.

Assume, for example, that Mary conceives of an invention. Jane later derives the invention from Mary, sometime before January of a given year, and then Jane publicly discloses the invention in January. Mary publicly discloses the same invention the following May. Mary files a patent application on the invention the following September. Jane files a patent application on the invention the following December. The timeline of these facts is depicted in Exhibit 1, with all events other than Mary’s conception and Jane’s derivation occurring within a one-year period.

Applying the Named Inventor Interpretation, and assuming that each of Mary’s and Jane’s patent applications satisfies all the relevant legal requirements and no other material prior art is located, who gets the patent?

Let’s start with Jane. Mary’s September patent application filing is not prior art to Jane’s filing under New Section 102 because, although Mary’s filing might satisfy the requirements of New Section 102(a)(2) (let’s assume it gets published under Section 122(b)), the subject matter of that filing was publicly disclosed by Jane before the filing of Mary’s application, thereby removing Mary’s application as prior art pursuant to New Section 102(b)(2)(B).⁶ Mary’s May disclosure is also not prior art to Jane’s application because it also came after Jane’s January public disclosure.⁷ Jane’s January disclosure is not prior art to Jane’s application because it is an inventor disclosure less than a year before Jane’s effective filing date.⁸ And Jane’s earlier derivation from Mary is not prior art because no part of New Section 102 makes derived information prior art. Mary’s earlier conception is also not prior art to Jane’s patent application for a similar reason: New Section 102 does not make an earlier conception/invention a prior art creating

Exhibit 1



event. It would seem that Jane gets the patent, even though she derived the invention from Mary's earlier conception and was not the first to file.

But let us consider Mary. Jane's application is not prior art to Mary's application because it was effectively filed after Mary's filing.⁹ Mary's May disclosure is not prior art to Mary's application because it is an inventor disclosure less than a year before Mary's effective filing date.¹⁰ Jane's January disclosure is not prior art to Mary's application because it was derived from Mary, and therefore is a disclosure by "another who obtained the subject matter disclosed directly or indirectly from the inventor."¹¹ So it would seem that Mary also gets the patent.

Obviously, both of these conclusions cannot be correct. We will not (or at least do not want to) issue two patents to two separate inventors on exactly the same invention. Obviously, the Named Inventor Interpretation leads to an unsatisfying result, at least in the Derivation Scenario described above. But what if we adopted a different interpretation of the statutory phrase "the inventor" used in New Section 102?

One argument against interpreting the phrase "the inventor" to mean the individual named on the patent or application under review is that the AIA expressly defined the word "inventor" to mean "the individual . . . who invented or discovered the subject matter of the invention."¹² That sounds like being named on a patent application is, by itself, insufficient for one to be considered "the inventor," and that instead Congress intended that we look behind the mere fact that someone is named as an inventor and consider whether he or she actually conceived of the invention. That would be consistent with the law as it existed before the AIA.¹³ As the Supreme Court has recently reminded in a slightly different context, "Congress enacted the AIA in 2011 against the backdrop of a substantial body of law interpreting [Section 102]," and we should presume that when Congress adopted the same language as previously used, it also adopted the earlier judicial construction of that language.¹⁴ Indeed, the AIA version of 35 U.S.C. § 256, providing for correction of inventorship, embraces both nonjoinder and misjoinder of inventors.¹⁵ A person named on a patent or patent application is not, therefore, necessarily "the inventor" for purposes of the patent laws even after the AIA.¹⁶

So, what if we were to interpret the phrase "the inventor" to mean the individual who first conceived of the invention? The AIA's definition of inventor does not refer to "conception," of course, but if the person who first conceived of the invention is not the "the individual . . . who invented or discovered the subject matter of the invention," who is? Let's call this interpretation the "First Conceiver Interpretation."

Note, however, that interpreting the phrase "the inventor" as used in New Section 102 as the person who first conceived of the invention presents at least one big jurisprudential problem. As demonstrated above, one of, if not the, primary purpose of rewriting Section 102 in the AIA was to move from a (mostly) first to invent system to a (mostly) first to file system. The modifications to Section 102 were intended to remove the inventorship issue, including the need to keep records of and prove conception, from the novelty analysis. Interpreting "the inventor" to mean the individual who first conceived of the invention places inventorship, and conception, squarely back into the middle of that analysis because, as noted above, the phrase "the inventor" is used throughout New Section 102(b).

Nevertheless, if the reader is wondering whether adopting the First Conceiver Interpretation would solve the problem set forth above, the answer is that it would not. Let's consider why, but just to be clear, remember that under this interpretation only Mary can be "the inventor," even for purposes of considering the patentability of Jane's application, because Mary was first to conceive of the invention. Now who gets the patent?

We will start again with Jane. Mary's filing of a patent application is still not prior art to Jane's application because it is still removed by Jane's January public disclosure. That is because, while Jane's January public disclosure is not by "the inventor" under this theory (because Mary is "the inventor"), it is still a public disclosure by "another who obtained the subject matter disclosed directly or indirectly from the inventor" because Jane got it from Mary.¹⁷

By the same reasoning, Mary's May public disclosure is also not prior art to Jane's filing because Jane's January public disclosure is by another (Jane) who obtained the invention from the inventor (Mary).¹⁸ And Jane's January disclosure is not prior

art to Jane's filing because it is subject matter that "was obtained directly or indirectly from the inventor [i.e., Mary]."¹⁹

Mary's conception and Jane's derivation are not prior art for the same reasons set forth above; New Section 102 does not recognize those occurrences as prior art creating events. Because all of the disclosures of the invention that preceded Jane's filing are removed as prior art by some provision of New Section 102(b), it would seem that Jane gets the patent.

But now let's consider Mary. The Jane application is still not prior art because it was filed after Mary's filing. Mary's May disclosure is not prior art because it is an inventor disclosure made within one year of filing, and Jane's January disclosure is not prior art because it is a disclosure obtained from the inventor and made within one year of filing. Mary's conception and Jane's derivation are not prior art for the same reasons set forth above. So, Mary gets the patent.

This interpretation leads to the same result. The PTO must issue two patents on the same invention to two different individuals. How do we fix this?

Some readers may be thinking that the answer is rather simple, because this is exactly the situation for which the derivation proceeding of 35 U.S.C. § 135 was created. Apparently not. Section 135 permits a party to file a petition setting forth why it is believed "that an individual named *in an earlier application* as the inventor or a joint inventor *derived such invention from an individual named in the petitioner's application* as the inventor or a joint inventor and, without authorization."²⁰ In the hypothetical set forth above (under either interpretation of "the inventor"), Jane's application is not "an earlier application" with respect to Mary's application; it was

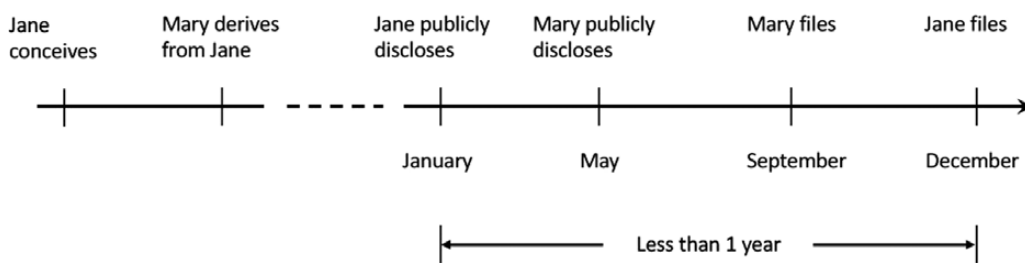
filed later. Mary's application is "an earlier application" with respect to Jane, but Jane cannot show that Mary "derived such invention" from Jane. Quite the opposite occurred; Jane derived from Mary. The derivation proceeding of Section 135 is therefore of no help. It appears that, at least in the admittedly contrived sequence of events set forth above, New Section 102 provides some odd results.

The odd results, however, are not limited to that sequence of events. Consider a "tweak" to the Derivation Scenario hypothetical above in which we make Jane the "conceiver" and Mary the "deriver," but keep all other dates the same, including the respective timing of those events. That timeline is highlighted in Exhibit 2.

Who gets the patent? I will leave the details to the motivated reader, but under either interpretation, Jane gets the patent. This is because Jane's January public disclosure removes all potential prior art events from being considered prior art against Jane's filing, but is itself prior art against Mary's filing because it made the invention "otherwise available to the public" before Mary's effective filing date and is not removed by any other provision of the statute.²¹ But that is still an odd result indeed, for a statute that was intended to move the law from a first to invent system to a first to file system because it will, in this situation, award the patent to the last to file. On the other hand, the result is at least defensible on the ground that the patent is awarded to the first to conceive, even if the AIA was intended to remove that consideration from the novelty calculus.

Now consider yet another "tweak" to the timeline in which Mary remains the "conceiver" and Jane the "deriver," but we switch the sequence of

Exhibit 2



their respective filings. That timeline looks like the timeline in Exhibit 3.

I will again leave the reader to work out the details, but as I figure it Jane gets the patent under either interpretation of the statute. Mary does not get a patent under the Named Inventor Interpretation, but does under the First Conceiver Interpretation. On the other hand, it seems that under this sequence of events Mary can make use of the derivation proceeding of Section 135. So perhaps the result here is defensible.²²

The Independent Conception Scenario

Let us now turn to a slightly different and perhaps more common situation, one where two unrelated individuals conceive of the same invention at about the same time. Let's say, for example, that instead of Jane deriving the invention from Mary, Jane independently conceived of the invention after Mary. So the timeline looks like the timeline in Exhibit 4.

Again assuming that each of Mary's and Jane's patent applications satisfies all the relevant legal requirements and no other material prior art is

located, who gets the patent? We will address this question under both interpretations.

Named Inventor Interpretation

We start again with Jane. Under the Named Inventor Interpretation, nothing is prior art to Jane's filing for the same reasons set forth above. I will leave it to the reader to figure it out in detail, but in sum, none of the events that occurred after Jane's January public disclosure are prior art to Jane because they are removed by operation of New Section 102(b)(1)(B) & (b)(2)(B), the two events that occurred before Jane's January disclosure are conceptions, which are not prior art creating events under New Section 102, and Jane's January disclosure is an inventor disclosure within one year of Jane's filing. Jane gets the patent.

Now consider Mary under the Named Inventor Theory. Jane's January public disclosure is prior art to Mary's application because it made the invention "otherwise available to the public" before Mary's effective filing date,²³ and because no exception of New Section 102(b) applies to remove it as prior art. Mary does not get the patent.

Exhibit 3

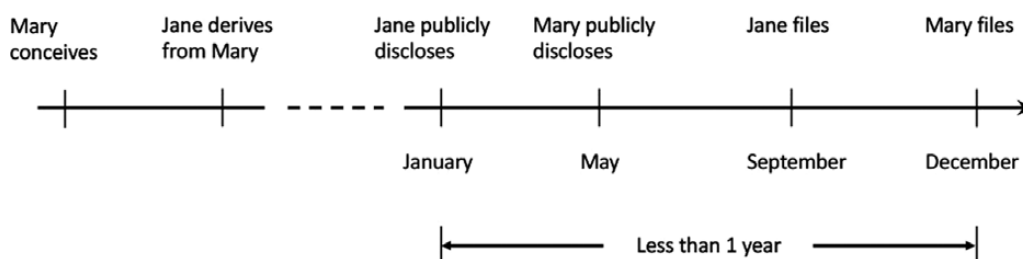
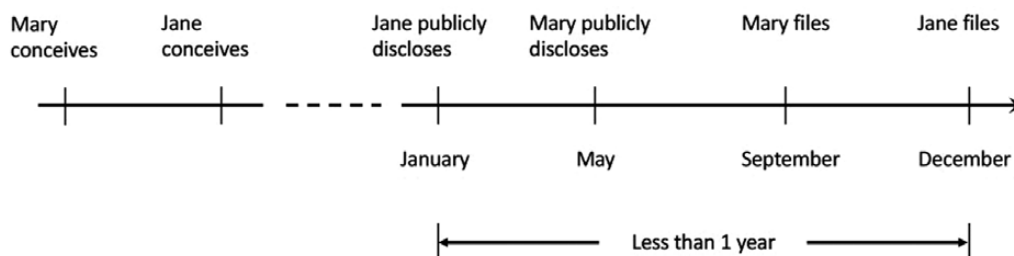


Exhibit 4



Accordingly, under this set of facts and this interpretation of the statute, the individual who was last to conceive and last to effectively file gets the patent. It is difficult to understand how one might defend that result.

First Conceiver Interpretation

What about the First Conceiver Interpretation? Under this theory, of course, Mary is “the inventor.” Let’s see what happens.

Consider Jane first. Mary’s filing would be prior art to Jane’s application under New Section 102(a) (2) because it was effectively filed before Jane’s filing, except that it is removed as prior art by New Section 102(b)(2)(B) because it occurred after Mary’s May public disclosure.²⁴ On the other hand, Mary’s May public disclosure made the invention “otherwise available to the public” before Jane’s effective filing date, and is not otherwise removed as prior art by any exception of New Section 102(b), so that disclosure is prior art to Jane’s filing. Jane does not get the patent.

And Mary? Her May public disclosure is not prior art to her own filing because it is an inventor disclosure within one year of her filing.²⁵ Jane’s January public disclosure made the invention “otherwise available to the public” before Mary’s effective filing date, and is not otherwise removed as prior art by any exception of New Section 102(b). For example, New Section 102(b)(1)(B) does not apply because it requires “the subject matter disclosed [i.e., Jane’s January disclosure] had, before such disclosure, been publicly disclosed by the inventor [i.e., Mary].” Because Mary’s May public disclosure did not occur before Jane’s January public disclosure, this exception does not apply. Accordingly, Jane’s January disclosure is prior art to Mary’s filing, so Mary does not get the patent either.

Two independent conceptions and two filings, but neither party gets the patent. Another result that is difficult to defend. Does that result hold up if, as we did above, “tweak” the sequence of events. No, but the results are sometimes still a little odd.

For example, let’s switch the sequence of conceptions but not the sequence of filing, as shown in Exhibit 5.

Here, Jane, the individual who was first to conceive but last to file, gets the patent under either interpretation because her January public disclosure removes Mary’s May disclosure and Mary’s filing as prior art to Jane by operation of New Section 102(b)(1)(B) and (b)(2)(B), respectively, and is not prior art to Jane’s filing pursuant to New Section 102(b)(1)(A).

Mary does not get the patent under either interpretation because Jane’s January disclosure made the invention otherwise available to the public before Mary’s filing date and is not removed as prior art by any portion of New Section 102(b).

Here the situation is that we award the patent not to the first to file, but to the first to invent, exactly the opposite of what Congress said it intended.

On the other hand, if we switch the sequence of filing, but not conception, the timeline looks like the timeline in Exhibit 6.

This sequence of events once again awards the patent to Jane, but not to Mary, under the Named Inventor Interpretation. That result is not odd at all. The system awarded the patent to the first to file, regardless of her not being the first to invent.

On the other hand, applying the First Conceiver Interpretation, neither gets the patent because each inventor’s public disclosure made the invention “otherwise available to the public” before the other inventor’s filing date, and neither disclosure is removed as prior art by some exception.

Exhibit 5

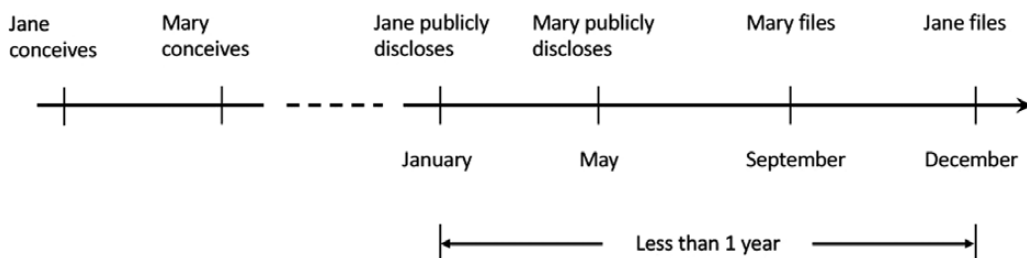
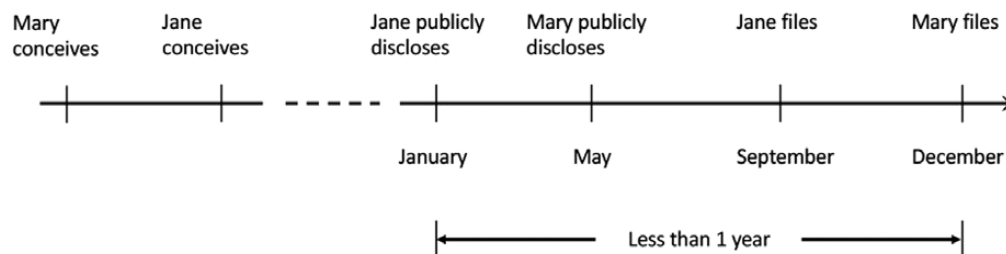


Exhibit 6



Summary

As demonstrated above, when applied to various scenarios involving derivation or multiple independent conceptions of the same invention, New Section 102 can provide some odd results that at times depend not only on the timing of conception and/or derivation, but also on an interpretation of the statutory phrase “the inventor.”²⁶ It is simply not the case that the first to file will always get the patent. Rather, things are quite a bit more complicated. It seems that, even after the courts get around to authoritatively interpreting the phrase “the inventor” as used in New Section 102, it would be advisable for inventors to continue to maintain records of inventorship, including those that evidence conception, reduction to practice, corroboration, and diligence, and be prepared to litigate dates of invention.

Notes

1. See 157 Cong. Rec. 5320 (2011) (remarks of Sen. Kyl) (“Currently, establishing a priority date requires expensive litigation and discovery into what the inventor’s notebooks show and when they show it and whether the inventor diligently perfected his invention after he conceived of it. . . . Under first to file, by contrast, inventors will file informal and inexpensive provisional applications. These applications need only disclose what the invention is and how to make it, information the inventor already needs to have in his possession anyway in order to establish a priority date under the current system. Under first to file, once the inventor files this information with the Patent Office, he has a priority date that is both secure and public. The application is a government document. There is no need to litigate over its priority date.”).
2. See 157 Cong. Rec. 5320 (2011) (remarks of Sen. Kyl) (“Both of these last two changes – the first to file and the new definition of “prior art” – will also protect American inventors against theft of their invention both at home and abroad. Under current law, if an American

inventor sells or otherwise discloses his invention, there is a risk that an unscrupulous third party will steal the idea and file a U.S. patent for it. If the thief claims he himself made the invention before the U.S. inventor, then the U.S. inventor will need to prove the invention was stolen from him. Current law even allows activities that occur in a foreign country to establish a priority date for a U.S. patent. Thus, if a U.S. inventor who has been a victim of theft is unable to prove that activities alleged to have occurred in China or India, say, never actually took place, he not only loses his patent but the foreign thief can obtain a U.S. patent and block the U.S. inventor from practicing his own invention.”).

3. See New Section 102(b):

(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 –
 - (A) the disclosure was made by *the inventor* or joint inventor or by another who obtained the subject matter disclosed directly or indirectly from *the inventor* or a joint inventor; or
 - (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.
- (2) Disclosures appearing in applications and patents. – A disclosure shall not be prior art to a claimed invention under subsection (a)(2) if –
 - (A) the subject matter disclosed was obtained directly or indirectly from *the inventor* or a joint inventor;
 - (B) the subject matter disclosed had, before such subject matter was effectively filed under subsection (a)(2), 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; or

(emphasis added).

4. The statute, of course, also refers to “joint inventors,” to account for joint inventions. But let’s just stick with the singular for purposes of clarity. The same analysis would apply to a joint inventor scenario, as joint inventors can be regarded as a single “inventive entity.” Cf. *EmeraChem Holdings v. Volkswagen Group Of Amer.*, 859 F.3d 1341, 1345 (Fed. Cir. 2017).
5. See New Section 102(a)(2) (“A person shall be entitled to a patent unless . . . (2) the claimed invention was described in a patent issued under section 151, or in an application for patent published or deemed published under section 122(b), in which the patent or application, as the case may be, names another inventor and was effectively filed before the effective filing date of the claimed invention.”).
6. See New Section 102(b)(2)(B) (“A disclosure shall not be prior art to a claimed invention under subsection (a)(2) if . . . (B) the subject matter disclosed had, before such subject matter was effectively filed under subsection (a)(2), been publicly disclosed by the inventor. . . .”). Remember, under this analysis we are assuming that for purposes of analyzing the novelty of Jane’s patent application, “the inventor” referred to in New Section 102 is Jane. More on that below.
7. See New Section 102(b)(1)(B) (“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. . . .”).
8. See New Section 102(b)(1)(A) (“A disclosure shall not be prior art to a claimed invention under subsection (a)(2) if . . . (A) the disclosure was made by the inventor or joint inventor or by another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor.”).
9. See New Section 102(a)(2) (“A person shall be entitled to a patent unless . . . the claimed invention was described in a patent issued under section 151, or in an application for patent published or deemed published under section 122(b), in which the patent or application, as the case may be, names another inventor and was effectively filed before the effective filing date of the claimed invention.”) (emphasis added).
10. See New Section 102(b)(1)(A). Similar to the analysis above, here we are assuming that for purposes of analyzing the novelty of Mary’s patent application, “the inventor” referred to in New Section 102 is Mary.
11. See New Section 102(b)(1)(A).
12. See 35 U.S.C. § 100(f) (“The term ‘inventor’ means the individual . . . who invented or discovered the subject matter of the invention.”).
13. *CR Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 1352 (Fed. Cir. 1998) (“The ‘inventor,’ in patent law, is the person or persons who conceived the patented invention.”), citing *Collar Co. v. Van Dusen*, 90 U.S. (23 Wall.) 530, 563–64, 23 L.Ed. 128 (1874) and *Burroughs Wellcome Co. v. Barr Lab., Inc.*, 40 F.3d 1223, 1227–28, (Fed. Cir. 1994) (“Conception is the touchstone of inventorship.”).
14. *Helsinn Healthcare v. Teva Pharmaceuticals*, 139 S. Ct. 628, 633–34 (2018).
15. See 35 U.S.C. § 256 (2012); *Coda Development v. Goodyear Tire & Rubber*, 916 F.3d 1350, 1358 (Fed. Cir. 2019) (“Misjoinder is the error of naming a person as an inventor who is not an inventor; nonjoinder is the error of omitting an inventor.”).
16. See *University Of Pittsburgh v. Hedrick*, 573 F.3d 1290 (Fed. Cir. 2009) (affirming a district court’s finding of misjoinder). It is true that, under pre-AIA law, those individuals named on a patent as inventors are presumed to be the actual inventors of the subject matter claimed in the patent, *Hess v. Advanced Cardiovascular Systems, Inc.*, 106 F.3d 976, 980 (Fed. Cir. 1997), and it seems safe to assume that presumption will be applied to post-AIA cases as well. But the presumption is rebuttable. See *id.*
17. See New Section 102(b)(2)(B).
18. See New Section 102(b)(1)(B).
19. See New Section 102(b)(1)(A).
20. 35 U.S.C. § 135(a)(1) (emphasis added).
21. See New Section 102(a)(1); see also *Sanho Corp. v. Kaijet Technology International Limited, Inc.*, 108 F.4th 1376, 1382 (Fed. Cir. 2024) (“In light of this purpose, ‘publicly disclosed by the inventor’ [as used in New Section 102(b)] must mean that it is reasonable to conclude that the invention was made available to the public.”).
22. Actually, Mary’s use of the derivation proceeding of Section 135 creates a different issue, at least under the First Conceiver Interpretation because, under that interpretation, both Jane and Mary are awarded a patent on the same invention. The statutory remedy awarded a successful petitioner in a derivation proceeding is the correction of inventorship (i.e., Jane is removed as the named inventor on her patent and Mary is added as the inventor). See 35 U.S.C. § 135(b). But that would result in Mary owning two patents with different filing dates on the same invention. That would violate 35 U.S.C. § 101, *Geneva Pharmaceuticals v. GlaxoSmithKline*, 349 F.3d 1373, 1377 (Fed. Cir. 2003) (“In § 101, title 35 precludes more than one patent on the same invention.”),

so it would seem that the PTO might not be permitted to grant that remedy in that particular situation.

23. See New Section 102(a)(1).

24. See New Section 102(b)(2)(B) (“A disclosure shall not be prior art to a claimed invention under subsection (a)(2) if . . . the subject matter disclosed had, before such subject matter was effectively filed under subsection (a)(2), been publicly disclosed by the inventor. . . .”). One might ask whether New Section 102(b)(2)(B) could be interpreted such that it will only remove prior disclosures as prior art against the first conceiver, an interpretation that would require a different result here. In other words, can that statute be interpreted to mean that only the first person to actually conceive of the invention is entitled to the benefit of that statute? It is difficult to see how that limitation is set forth in the wording of the statute, which

seems to be agnostic about who is getting the benefit of the exception. Along these lines, the reader may be wondering whether the phrase “the claimed invention” might carry that water. It seems not, since the AIA defined the term “claimed invention” to mean “the subject matter defined by a claim in a patent or an application for a patent.” 35 U.S.C. § 100(j). The term therefore seems to apply to any claim in any patent or application. Cf. *Celanese Int’l Corp. et al. v. ITC*, No. 22-1827 (Fed. Cir. 2024) (stating that the phrase “the claimed invention” in New Section 102 refers merely to the invention “that an applicant seeks to patent, and nothing else.”).

25. See New Section 102(b)(1)(A).

26. Note, also, that derivation itself requires proof of a prior conception. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 1576 (Fed. Cir. 1997).

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