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THE NEW NOVELTY: DEFINING THE CONTENT OF “OTHERWISE AVAILABLE TO THE PUBLIC”

Caroline Schneider

I. INTRODUCTION

The “Leahy-Smith America Invents Act” (America Invents Act) was enacted on September 16, 2011.¹ The purpose of the Act was to provide greater harmony between the U.S. patent system and patent systems of our international trading partners.² A patent gives an inventor a monopoly in the issuing country to make, use, and sell the invention for a limited term in exchange for the disclosure of how to make and use the invention. In the United States, the granting of monopolies for limited terms is justified mainly on utilitarian grounds. The patent system is seen as the best way to incentivize innovation and the disclosure of innovative secrets.³ In Europe, patents are mostly justified on natural rights grounds. Inventors are seen as having a natural property right in their ideas, and a patent is seen as a deserved reward for the work of the inventor.⁴

The main way the America Invents Act afforded greater harmony between the U.S. system and the European system was by changing the U.S. patent system from a first-to-invent system to a first-to-file system.⁵ The America Invents Act also redefined prior art and therefore, appears to have broadened what can be used to prevent an inventor from obtaining a patent.⁶ Most of the language used to define the prior art is identical to the previous act.⁷ However, Congress added “or otherwise available to the public” to the existing definition of the prior art.⁸ The question of how to read this additional language is what this note will try to answer.

This note explores the potential interpretations of the new § 102(a) under the America Invents Act. It attempts to define what references would be included in the prior art under each of the terms listed in § 102(a). To do so, it considers United States case law on novelty, European treaty articles on nov-

1. Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 285 (2011).

2. 157 CONG. REC. E1219 (daily ed. June 28, 2011) (statement of Rep. Lamar Smith).

3. See e.g. *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470, 480 (1974).

4. See e.g. Fritz Machlup & Edith Penrose, *The Patent Controversy in the Nineteenth Century*, 10 J. ECON. HIST. 1, 11-21 (1950).

5. 157 CONG. REC. E1219 (daily ed. June 28, 2011) (statement of Rep. Lamar Smith).

6. Leahy-Smith America Invents Act, 35 U.S.C.A. § 102 (West 2011).

7. *Id.*

8. *Id.*

elty, the United Kingdom's patent statute, United Kingdom case law on novelty, the United States' Congressional record for the America Invents Act, and the United States Patent and Trademark Office Guidelines on the implementation of the Act. This note argues that U.S. case law viewed in light of canons of statutory interpretation is the most helpful in determining what is prior art under the new § 102(a).

II. THE AMERICA INVENTS ACT

The federal law on patents is codified at 35 U.S.C. §§ 100-319. It defines what is allowed to be the subject of a U.S. patent based on several criteria, one of which is novelty. In other words, to receive a patent, an invention must be new. An invention is new if it is not part of the prior art. 35 U.S.C. § 102 is the section of the U.S. Code that requires an invention to be new to be patentable and lists the ways in which an invention can become part of the prior art. Important changes under the America Invents Act, including the change to a first-to-file system and the changes in § 102, took effect on March 16, 2013.⁹ Before the America Invents Act, 35 U.S.C. § 102 stated that:

A person shall be entitled to a patent unless —

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States.¹⁰

Because the America Invents Act amended § 102, it now states that:

(a) A person shall be entitled to a patent unless —

(1) the claimed invention was patented, described in a printed publication, or in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention.¹¹

The analysis of what is prior art under the new § 102(a) is presented in two sections. Section three addresses the language that has not changed. It discusses the terms "patented," "printed publication," "public use," and "on sale." The fourth section analyzes the new language of § 102(a). It attempts to define the content of "otherwise available to the public."

9. Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 285, § 3 (2011).

10. 9 Manual of Patent Examining Procedure §§ 2132-33 (2014).

11. 35 U.S.C.A. § 102(a)(1) (West 2011).

III. THE UNCHANGED LANGUAGE

Most of the ways a claimed invention can be disqualified as prior art in the new § 102 were also ways to be disqualified under the old § 102. § 102(a), under the America Invents Act, includes in the prior art inventions that are patented, described in a printed publication, in public use, on sale, or otherwise available to the public. Before the America Invents Act, § 102 also included inventions in the prior art that were patented, described in a printed publication, in public use, or on sale.

According to the prior-construction canon of statutory interpretation, if a statute uses words or phrases that have already been defined by the court of last resort or have been defined uniformly by inferior courts or administrative agencies, they should be given that definition.¹² This canon applies most clearly in reenactments.¹³ “In adopting the language used in the earlier act, Congress ‘must be considered to have adopted also the construction given by this Court to such language, and made it part of the enactment.’”¹⁴

Because Congress used the same wording in the same section of the statute, it is very likely that Congress understood that those words would be given the same meaning. This is confirmed by the legislative history. Senator Kyl said on the Senate floor when arguing for the America Invents Act that he “would hope that even those opponents of first-to-file who believe that supporters of the bill cannot rely on committee reports and sponsors’ statements would at least concede that Congress is entitled to rely on the consistent judicial construction of legislative language.”¹⁵

A. Patented

“Patented” is a term of art. There is no ambiguity in the term. Either one or more governments have granted a patent on the invention or they have not. There could perhaps be some ambiguity on whether an invalid patent constitutes a patent for the purposes of § 102. However, that question is moot because whatever invalidated the previously granted patent would probably also invalidate the prospective patent and in any case, the invalidated patent’s published application would disqualify the prospective patent under the old § 102(e) or § 102(a)(2) under the America Invents Act.

While “patented” very likely continues to mean the same thing both before and after the America Invents Act went into effect, Congress did change the relevant date for a patented invention to be included in the prior art. Before the America Invents Act, an invention had to be patented by another

12. ANTONIN SCALIA & BRYAN A. GARNER, *READING LAW: THE INTERPRETATION OF LEGAL TEXTS* 322 (2012).

13. *Id.*

14. *Shapiro v. United States*, 335 U.S. 1, 16 (1948) (quoting *Hecht v. Malley*, 265 U.S. 144, 153 (1924)).

15. 157 CONG. REC. S5402 (daily ed. Sept. 8, 2011) (statement of Sen. Jon Kyl).

before its invention by the patent applicant to be prior art.¹⁶ After the effective date of the America Invents Act, an invention has to be patented by another before the filing date of the patent applicant to be prior art.¹⁷

Significantly, patents by their nature make the invention available to the public. The justification for granting an inventor a monopoly for a limited term on his invention is the public disclosure of that invention society receives in return. 35 U.S.C. § 112 requires the specification of the patent application to:

contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor or joint inventors of carrying out the invention.¹⁸

The requirements for the disclosure in the specification of the patent application of written description, enablement, best mode, and definiteness are substantial.¹⁹ Besides the obvious problem of granting two people the right to exclude others from the use of their invention, a patent makes an invention part of the prior art because it puts the invention completely in the public domain.

B. Printed Publication

The United States Court of Appeals for the Federal Circuit has determined what constitutes a “printed publication” for the purposes of novelty. The Federal Circuit’s analysis centered on whether the reference was sufficiently available to the public. “Because there are many ways in which a reference may be disseminated to the interested public, ‘public accessibility’ has been called the touchstone in determining whether a reference constitutes a ‘printed publication’ bar under 35 U.S.C. § 102(b).”²⁰

In *In re Klopfenstein*, applicants for a patent appealed rejection from the Patent and Trademark Office for lack of novelty under the old § 102(b) because it had appeared in a printed publication one year before the applicants filing date.²¹ The applicants had displayed fourteen slides disclosing the invention on poster board continuously for two and a half days at an American Association of Cereal Chemists meeting and for less than a day at an Agriculture Experiment Station at Kansas State University.²² The applicants argued that in order for something to be considered a “printed publication” it

16. 9 Manual of Patent Examining Procedure § 2132 (2014).

17. 35 U.S.C.A. § 102(a)(1) (West 2011).

18. 35 U.S.C.A. § 112 (West 2011).

19. *See id.*

20. *In re Hall*, 781 F.2d 897, 898-99 (Fed. Cir. 1986).

21. *In re Klopfenstein*, 380 F.3d 1345, 1346 (Fed. Cir. 2004).

22. *Id.* at 1347.

must be distributed or indexed.²³ The court rejected that argument.²⁴ The court found that the key inquiry in determining whether something constitutes a “printed publication” is whether it has been made publicly accessible.²⁵ To determine if information was sufficiently accessible, the court considered the following factors: “the length of time the display was exhibited, the expertise of the target audience, the existence (or lack thereof) of reasonable expectations that the material displayed would not be copied, and the simplicity or ease with which the material displayed could have been copied.”²⁶ After considering those factors, the court held that the display of the slides was sufficiently accessible to the public to be a “printed publication.”²⁷

In *In re Cronyn*, college students presented their undergraduate theses to a board of faculty members.²⁸ Index cards listing the name of the student and the title of his or her thesis were filed alphabetically by the student’s name.²⁹ The court held that the student theses were not “printed publications” because they were not sufficiently available to the public.³⁰ In *Massachusetts Institute of Technology v. AB Fortia*, the court held that a paper, which was given orally to about 500 people of ordinary skill in the art and distributed to at least six people, was a “printed publication” and therefore part of the prior art.³¹ The fact that the paper was distributed was key in the court’s finding.³² In *Kyocera Wireless Corp. v. International Trade Commission*, the court held that a reference was publicly accessible, and therefore a “printed publication,” if a person of ordinary skill in the art could locate it by exercising reasonable diligence.³³ The court found that a collection of technical specifications was publicly available and constituted a “printed publication” under the old § 102 because access to the facility where it was maintained, granted access to interested parties and 25,000 copies had been sold.³⁴

C. On Sale

The United States Supreme Court has defined what constitutes “on sale” for the purposes of novelty. In *Pfaff v. Wells Electronics, Inc.*, the Court held that the commercial marketing of a newly invented product could count as “on sale” even if it had not been reduced to practice.³⁵ The inventor had sold

23. *Id.* at 1348.

24. *Id.*

25. *Id.*

26. *Id.* at 1350.

27. *Id.* at 1352.

28. *In re Cronyn*, 890 F.2d 1158, 1159 (Fed. Cir. 1989).

29. *Id.*

30. *Id.* at 1161.

31. 774 F.2d 1104, 1108-09 (Fed. Cir. 1985).

32. *Id.* at 1109-10.

33. *Kyocera Wireless Corp. v. Int’l Trade Comm’n*, 545 F.3d 1340, 1350 (Fed. Cir. 2008).

34. *Id.* at 1351.

35. 525 U.S. 55, 67-68 (1998).

a computer chip socket, based on a sketch, over a year before filing for a patent.³⁶ The Court held the “on sale” bar applies when the invention is the subject of a commercial offer for sale and the invention is ready for patenting.³⁷ An invention does not need to be reduced to practice to be patentable.³⁸ “Invention” in the statute refers to the concept, not its embodiment.³⁹ The Court held that the ready for patenting condition could be satisfied by proof of reduction to practice or by proof that the inventor had prepared drawings or other descriptions of the invention that were sufficiently specific to enable a person skilled in the art to practice the invention.⁴⁰ In that case, the detailed engineering drawings the inventor had sent to a manufacturer were sufficient to prove that the invention was ready for patenting.⁴¹

While Congress’s reuse of the phrase “on sale” indicates that this jurisprudence can be applied to § 102 after the effective date of the America Invents Act, Congress did extend the geographical limits of the “on sale” bar. Before the America Invents Act, an invention was included in the prior art only if it was “on sale” in the United States. After the America Invents Act, any invention offered for sale anywhere in the world is included in the prior art.

D. Public Use

The United States Supreme Court and the United States Court of Appeals for the Federal Circuit have each contributed to the definition of “public use.” In *Egbert v. Lippmann*, the Supreme Court held that the use of corset steels in her corsets by the inventor’s future wife was a “public use” that barred patentability.⁴² The Court held that use by one person is enough to constitute “public use” as long as there are no restrictions or limitation on the use.⁴³ The Court also held that the public’s inability to see an invention does not bear on whether or not it was put to a “public use.”⁴⁴ Again, as long as there are no restrictions placed on the use, it can constitute “public use” and bar patentability.⁴⁵

In *Motionless Keyboard Co. v. Microsoft Corp.*, the Federal Circuit found that demonstrations of a keyboard were not “public uses” because the keyboard was not connected to a computer or any other device during the demonstrations.⁴⁶ The court held that for a use to be a “public use,” the invention must

36. *Id.* at 57-58.

37. *Id.* at 67.

38. *Id.* at 60.

39. *Id.*

40. *Id.* at 68.

41. *Id.*

42. 104 U.S. 333, 338 (1881).

43. *Id.* at 336.

44. *Id.*

45. *Id.*

46. 486 F.3d 1376, 1385 (Fed. Cir. 2007).

be used as it would be in the normal course of business.⁴⁷ The court held that the demonstrations disclosed the visual design of the invention but that the invention was not put into use.⁴⁸ Because Congress used the phrase “public use” in the America Invents Act, the cases defining it are very likely still good law. However, Congress did extend the “public use” bar to include “public use” anywhere in the world rather than just “public use” in the United States.

IV. OTHERWISE AVAILABLE TO THE PUBLIC

“Otherwise available to the public” is entirely new language added by Congress. The surplusage canon says that a statute should be interpreted so that every word is given effect.⁴⁹ The Supreme Court has reason that the words used in a statute “cannot be meaningless, else they would not have been used.”⁵⁰ Under this canon, “otherwise available to the public” must do some work. This section discusses what that work could be and what is included in “otherwise available to the public.”

A. Associated-Words

The associated-words canon suggest that when several words are used together, they should bear on each other’s meaning.⁵¹ The canon especially applies when words are used in a list. Because “otherwise available to the public” is used in a list, the other members of that list may inform its meaning. “Otherwise available to the public” should have a related or similar meaning to the terms “patented,” “printed publication,” “public use,” and “on sale.”

The United States Court of Appeals for the Federal Circuit has defined public accessibility in regards to what constitutes a “printed publication” for the purposes of §102. In *Kyocera Wireless Corp. v. International Trade Commission*, the court held that a reference was publicly accessible if a person of ordinary skill in the art could locate it by exercising reasonable diligence.⁵² That standard could be applied to “otherwise available to the public.” The accessibility or availability assessment probably remains the same, but “otherwise available to the public” would include references that are not printed. If information were in a recorded speech or lecture that someone of ordinary skill in the art could reasonably find, then that would probably be included in “otherwise available to the public.” If the lecture were not recorded, but people of ordinary skill in the art knew about it and could have attended it, the lecture would probably still be within the meaning of “otherwise available to the public,” and therefore part of the prior art.

47. *Id.*

48. *Id.*

49. SCALIA & GARNER, *supra* note 11, at 174.

50. *United States v. Butler*, 297 U.S. 1, 65 (1936).

51. SCALIA & GARNER, *supra* note 11, at 195.

52. *Kyocera Wireless Corp. v. Int’l Trade Comm’n*, 545 F.3d 1340,1350 (Fed. Cir. 2008).

In *In re Klopfenstein*, the court listed several factors to aid in the determination of whether the information was sufficiently accessible to the public.⁵³ Those factors were “the length of time the display was exhibited, the expertise of the target audience, the existence (or lack thereof) of reasonable expectations that the material displayed would not be copied, and the simplicity or ease with which the material displayed could have been copied.”⁵⁴ Because of the associated-words cannon, those factors can also be used to aid the determination of what would be sufficiently accessible to fall within “otherwise available to the public.”

The amount of time the public has with a reference can definitely help determine if it has made the invention available to the public. If a reference is accessible for three days, as was the case in *In re Klopfenstein*, it probably has been made available to the public.⁵⁵ If the reference is accessible for only five minutes, it probably has not been made available to the public with the meaning of § 102. Where the line is between what is long enough and what is not remains unclear, especially because the length of time a reference is displayed or accessible is only one of four factors. However, what is long enough for a “printed publication” can inform what is long enough for “otherwise available to the public,” and what is a sufficient length of time for a reference to be “otherwise available to the public” can inform what a sufficient length of time is for a “printed publication.”

The expertise of the target audience factor can also be applied to “otherwise available to the public” element. If the target audience is likely full of people who have ordinary skill in the art, as was the case in *In re Klopfenstein*, then it probably has been made available to the public.⁵⁶ If, on the other hand, the target audience is made up of laypeople or children, the reference probably does not make the invention available to the public. It is unclear whether a court would find that a reference is made available to the public where there is a mixed audience of both laypeople and a person or people of ordinary skill in the art.

One person in the audience being of ordinary skill in the art probably does make the reference available to the public. The Supreme Court held in *Egbert v. Lippmann*, that use by one person can constitute “public use.”⁵⁷ More recently, the Court held that a sale to one person, or even just the offer to sell to one person, is sufficient to constitute “on sale.”⁵⁸ Because “public use” and “on sale” are also terms within the list in § 102(a), their definitions also bear on what constitutes “otherwise available to the public.” If one person is sufficient to constitute a “public use” or “on sale,” then making an invention available to one person is probably sufficient to make it fall within

53. *In re Klopfenstein*, 380 F.3d 1345, 1350 (Fed. Cir. 2004).

54. *Id.*

55. *Id.* at 1351.

56. *Id.*

57. *Egbert v. Lippmann*, 104 U.S. 333, 336 (1881).

58. *Pfaff v. Wells Elec., Inc.*, 525 U.S. 52, 67 (1998).

“otherwise available to the public,” and thus, make it part of the prior art.

The existence or lack thereof of an expectation that information will not be copied can help determine if the information has been made available to the public. If there are no measures taken to protect the information from being copied, as was the case in *In re Klopfenstein*, then the information probably was made available to the public.⁵⁹ However, if there is some professional or social norm that dictates that the information should not be copied, it will be less likely that the information has been made available to the public.⁶⁰ If steps have been taken to insure that the information would not be copied, the information will probably not have been made available to the public.⁶¹

For example, an inventor could have people sign non-disclosure agreements.⁶² An inventor could also use anti-copying software, or posts signs saying that copying is not allowed.⁶³ Whether any of these norms or steps would be sufficient to prevent information from being made available to the public, probably depends on whether they create a reasonable expectation that the information will not be copied.⁶⁴ And whether or not a reasonable expectation has been created probably depends on the facts of the case.

The simplicity or ease with which information can be copied could easily apply to the determination of whether an invention is within the meaning of “otherwise available to the public” under § 102(a). If the information or display is simple and it is easy to take notes, as was the case in *In re Klopfenstein*, then the information probably was made available to the public.⁶⁵ However, if the information is complex or there is a lot of it and it would be difficult for the audience to take notes, the information probably has not been made available to the public.

A two-hour lecture on a complex invention where the audience was not allowed to take notes would probably not fall within the scope of “otherwise available to the public.” Facts such as that the lecture was only given once, the lecturer talked very quickly, or there was a lack of accompanying slides or other displays make it less likely that the invention would be considered available to the public. If the audience was made up of only laypeople unfamiliar with the topic, then the likelihood that the invention was available to the public would decrease further, and if there were signs posted that prohibited note taking and recording the lecture, then the likelihood would decrease further still, especially if there were people who enforced that prohibition. The situation described is probably not very realistic, but serves as an example of situations that fall outside of the scope of “otherwise available to

59. *In re Klopfenstein*, 380 F.3d 1345, 1351 (Fed. Cir. 2004).

60. *Id.*

61. *Id.*

62. *Id.*

63. *Id.*

64. *Id.*

65. *Id.*

the public” under § 102(a). Conversely, a lecture that could be recorded with an audience of people who have ordinary skill in the art would probably be considered prior art under the new § 102(a) because case law and interpretive canons suggest such a situation is within the scope of the “otherwise available to the public” language.

B. *Ejusdem Generis*

The ejusdem generis canon says that when general words follow a list of two or more things, they apply only to things of the same general kind.⁶⁶ “Otherwise available to the public” is a general catchall phrase, and as such, includes only situations similar to an invention being patented, described in a printed publication, in public use, or on sale.

Based on the courts’ analysis of patented, described in a printed publication, in public use, and on sale, “otherwise available to the public” could probably extend to inventions that have or have not been reduced to practice. An invention can be “patented” with or without being reduced to practice first. There is no requirement or prohibition of reduction to practice in the statute.⁶⁷ A “printed publication” could include an invention in the prior art whether or not it was reduced to practice. A “printed publication” could describe the invention just as well as the written specification in the patent application, and whether or not the invention was reduced to practice would have no barring.⁶⁸ Being “on sale” also can bar an invention from being patented whether or not it was reduced to practice. To become part of the prior art by being “on sale” an invention needs only to be offered for commercial sale and to be ready for patenting.⁶⁹ However, a “public use” could probably not apply to an invention that had not been reduced to practice. The invention must be used as it would in the ordinary course of business to constitute a “public use.”⁷⁰ An invention probably cannot be used in the ordinary course of business without being reduced to practice.

Given this, “otherwise available to the public” probably includes things done before and after the invention was reduced to practice. Three of the four other ways for an invention to become prior art allow an invention that has not been reduced to practice to become part of the prior art. The one that does not, “public use,” does not include inventions that have not been reduced to practice because use inherently cannot be made of invention that has not been reduced to practice. An invention can be made available to the public without being reduced to practice. Because it is possible for an invention to be available to the public with or without it being reduced to practice and the majority of the other terms in the list include both inventions that have and have

66. SCALIA & GARNER, *supra* note 11, at 199.

67. 35 U.S.C.A. §§ 100-212 (West 2011).

68. 35 U.S.C.A. § 112 (West 2011).

69. *Pfaff v. Wells Elec., Inc.*, 525 U.S. 52, 67 (1998).

70. *Motionless Keyboard Co. v. Microsoft Corp.* 486 F.3d 1376,1385 (Fed. Cir. 2007).

not been reduced to practice, the phrase “otherwise available to the public” probably includes both inventions that have been reduced to practice and inventions that have not.

C. Known or Used

The previous statute included inventions that were known or used in the U.S. in the prior art. The content that was included under “known or used” could potentially give some insight into what would fall into “otherwise available to the public.” However, Congress did not use the same language. So it would be unwise to assume that they mean the same thing.

The United States Supreme Court and the United States Court of Appeals for the Fifth Circuit have each helped to define the content of “known or used.” In *Gayler v. Wilder*, the Supreme Court held that a fireproof safe was not known or used even though another inventor had previously created the same safe but no longer had it.⁷¹ The Court reasoned that if knowledge is lost, then when it is invented the second time, it is truly new and the public and the inventor should be able to reap the benefits facilitated through the patent system.⁷² In *Rosaire v. Baroid Sales Division, Nat’l Lead Co.*, the Fifth Circuit held that a method for prospecting oil was known or used because a research department had already implemented it in Texas oil fields.⁷³ The trial court’s finding of fact that the method had been successfully reduced to practice made it part of the prior art.

The principle articulated in *Gayler v. Wilder*, if knowledge is lost, then when it is invented the second time, it is truly new, probably applies to “otherwise available to the public.”⁷⁴ If knowledge is lost, then it is not available to the public. So the fireproof safe at issue in *Gayler v. Wilder* would still not be part of the prior art under the new § 102, as it would probably not be included in “otherwise available to the public.”⁷⁵

However, *Rosaire* would probably come out differently under the new § 102. The fact that one research department knows about and successfully tested a method for prospecting oil does not mean that method is available to the public. The company did not publish the idea or the results of the testing, and it did not give the public the benefit of the invention in any other way.⁷⁶

There is a possibility that a court would use the fact that the Gulf Oil Company’s research department spent a year performing the method in oil fields in Texas to find that the method was made available to the public.⁷⁷

71. *Gayler v. Wilder*, 51 U.S. 477, 498 (1850).

72. *Id.* at 497.

73. *Rosaire v. Baroid Sales Div., Nat’l Lead Co.*, 218 F.2d 72, 74 (5th Cir. 1955).

74. *Gayler*, 51 U.S. at 497.

75. *Id.* at 498.

76. *Rosaire*, 218 F.2d at 73.

77. *Id.* at 74.

The testing was done outside in the open. Any member of the public could have observed the method any number of times within that year. Anyone could have taken notes on the method. So in that sense the method for prospecting oil was made available to the public. However, even if *Rosaire* would be decided the same way today it would be on different grounds. The method for prospecting oil would be prior art not because a company had known about it and used it, but rather because the way in which the company used it made it available to the public.

D. European and United Kingdom Novelty

The purpose of the America Invents Act was to provide greater harmony between the U.S. patent system and the patent systems throughout the rest of the world.⁷⁸ The change to further this end was the change from a first-to-invent system to a first-to-file system. Congressman Lamar Smith in a speech on the House floor said, “moving to a first-inventor-to-file system will modernize and harmonize our patent system with our international trading partners.”⁷⁹ Because greater harmony among patent systems was the goal of the changes to U.S. patent law, it may be informative to look at the requirements for patentability and what is excluded as prior art in other patent systems to give meaning to “otherwise available to the public.” This subsection considers the European Patent Convention and its application in the United Kingdom.

Article 52(1) of the European Patent Convention states that “European patents shall be granted to any inventions, in all fields of technology, provided that they are new, involve an inventive step and are susceptible of industrial application.”⁸⁰ Article 54(1) of the European Patent Convention defines novelty. “An invention shall be considered to be new if it does not form part of the state of the art.”⁸¹ Article 54(2) of the European Patent Convention defines the state of the art. “The state of the art shall be held to comprise everything made available to the public by means of a written or oral description, by use, or in any other way, before the date of filing of the European patent application.”⁸²

In the U.K. law, the requirement of novelty is declared in section 1(1) of the Patents Act 1977.

A patent may be granted only for an invention in respect of which the following conditions are satisfied, that is to say -

- (a) the invention is new;
- (b) it involves an inventive step;

78. 157 CONG. REC. E1219 (daily ed. June 28, 2011) (statement of Rep. Lamar Smith).

79. *Id.*

80. Convention on the Grant of European Patents [hereinafter EPC], art. 52(1), Oct. 5, 1973, 1065 U.N.T.S. 199.

81. *Id.* art. 54(1).

82. *Id.* art. 54(2).

(c) it is capable of industrial application;
(d) the grant of a patent for it is not excluded by subsections (2) and (3) or section 4A below.⁸³

Section 2(1) says that an invention is new if “it does not form part of the state of the art.”⁸⁴ The state of the art is defined in section 2(2):

The state of the art in the case of an invention shall be taken to comprise all matter (whether a product, a process, information about either, or anything else) which has at any time before the priority date of that invention been made available to the public (whether in the United Kingdom or elsewhere) by written or oral description, by use or in any other way.⁸⁵

In *Synthon BV v. SmithKline Beecham (No. 2)*, the House of Lord’s held that an invention has been made available to the public if there has been an enabling disclosure.⁸⁶ Enabling disclosure requires both prior disclosure and enablement.⁸⁷ To satisfy the requirement of prior disclosure, a reference must disclose an invention that would infringe the patent if performed.⁸⁸ There is no room for experimentation to satisfy the prior disclosure requirement.⁸⁹ It must be an inevitable consequence of following the disclosure.⁹⁰ To satisfy the enablement requirement, a person skilled in the art must be able to get the invention to work from the disclosure.⁹¹ The person skilled in the art is assumed to be willing to do some trial and error experimentation to satisfy the enablement requirement.⁹²

To be available to the public, it does not matter if the public actually accessed the information. If they could have, that is sufficient for it to be available to the public and part of the state of the art. A document that is placed in a library or other place where it can be consulted as a matter of right by any person is “available to the public” whether or not a there is a fee charged.⁹³ Section 130(1) of the U.K.’s Patents Act 1977 defines published and includes it within the meaning of made available to the public:

“published” means made available to the public (whether in the United Kingdom or elsewhere) and a document shall be taken to be published under any provision of this Act if it can be inspected as of right at any place in the United Kingdom by members of the public, whether on payment of a fee or not; and “republished” shall be construed accordingly.⁹⁴

The state of the art does not include the disclosure of unlawfully obtained

83. Patents Act, 1977, c. 37, § 1(1) (U.K.).

84. *Id.* § 2(1).

85. *Id.* § 2(2).

86. *Synthon BV v. SmithKline Beecham (No. 2)*, [2006] R.P.C [10] (U.K.).

87. *Id.* at [19].

88. *General Tire & Rubber Co. v. Firestone Tyre & Rubber Co. Ltd.*, [1972] R.P.C 457, 485 (U.K.).

89. *Kirin-Amgen Inc. v. Roche Diagnostics GmbH*, [2002] R.P.C [1] (U.K.).

90. *Id.*

91. *See SmithKline Beecham*, [2006] R.P.C. at [26].

92. *Id.* at [32].

93. Patents Act, 1977, c. 37, § 1(1) (U.K.).

94. *Id.*

information or information that was disclosed in a breach of confidence. Article 55(1)(a) of the European Patent Convention states that a disclosure shall not be included in the state of the art if it occurred no more than six months before the application was filed and it was due to “an evident abuse in relation to the applicant or his legal predecessor.”⁹⁵ Section 2(4) of the Patents Act 1977 excludes from the state of art a disclosure made less than six months prior to filing if:

(a) the disclosure was due to, or made in consequence of, the matter having been obtained unlawfully or in breach of confidence by any person

(i) from the inventor or from any other person to whom the matter was made available in confidence by the inventor or who obtained it from the inventor because he or the inventor believed that he was entitled to obtain it; or

(ii) from any other person to whom the matter was made available in confidence by any person mentioned in sub-paragraph (i) above or in this sub-paragraph or who obtained it from any person so mentioned because he or the person from whom he obtained it believed that he was entitled to obtain it;

(b) the disclosure was made in breach of confidence by any person who obtained the matter in confidence from the inventor or from any other person to whom it was made available, or who obtained it, from the inventor.⁹⁶

The state of the art also does not include disclosures made at international exhibitions. Article 55(1)(b) of the European Patent Convention provides that “the fact that the applicant or his legal predecessor has displayed the invention at an official or officially recognized, international exhibition falling within the terms of the Convention on International exhibition” shall not be considered part of the state of the art if it occurred less than six months before the filing of the patent application.⁹⁷ Section 2(4)(c) of the U.K.’s Patents Act 1977 states that a disclosure shall be excluded from the state of the art if it was within the six months prior to filing and if “the disclosure was due to, or made in consequence of the inventor displaying the invention at an international exhibition.”⁹⁸ Under Articles 1 and 2 of the Convention on International Exhibitions 1928, an international exhibition is one that is non-commercial, lasts at least three weeks, is officially organized by a nation and other nations

95. EPC, art. 55(1)(a), Oct. 5, 1973, 1065 U.N.T.S. 199.

96. Patents Act § 2(4).

97. EPC, art. 55(1)(b).

98. Patents Act §2(4)(c).

are invited.⁹⁹

Courts in the United Kingdom have also held that secret or inherent use is not sufficient in itself to destroy novelty. In *Merrell Dow v. Norton*, Merrell Dow had patented a metabolite.¹⁰⁰ Before the priority date of its patent on a metabolite, Merrell Dow gave volunteers in clinical trials the antihistamine terfenadine.¹⁰¹ This caused the patented metabolite to be produced in the livers of the volunteers.¹⁰² The court held that the production of the metabolite in the livers of the volunteers was not sufficient to put the metabolite into the state of the art.¹⁰³ The court held that “the use of a product makes the invention part of the state of the art only so far as that use makes available the necessary information.”¹⁰⁴ The court reasoned that the invention, which is the information or concept, must be made available to the public.¹⁰⁵ U.K. courts have also found that giving away or selling a single item is sufficient to make it part of the state of the art.¹⁰⁶ Limited use in a remote area is also sufficient to make an invention available to the public and therefore, make it part of the state of the art.¹⁰⁷

In the European and U.K. patent systems, there is a much more stringent test for whether a reference anticipates an invention than in the U.S. References must be enabling to prevent an inventor from obtaining a patent in the U.K.¹⁰⁸ A person skilled in the art must be able to create the working invention from the disclosure.¹⁰⁹ An enabling discloser is not required in the U.S. system. However, it is much easier for a European inventor’s own actions to prevent her from getting a patent. In the U.S., there is a one-year grace period. The inventor’s own disclosures made within one year before filing will not be treated as prior art against her.¹¹⁰ There is no such grace period in the European or U.K. patent systems. Disclosures made by the inventor before filing will prevent the inventor from obtaining a patent unless specific exception applies.¹¹¹

There are some similarities between the U.S.’s and the U.K.’s interpretations of prior art. Both countries focus on previous disclosures of the invention. Both countries’ interpretations of published center on the question of whether the information is accessible to the public. The U.S. also excluded information that was obtained illegally or deceptively from the inventor. 35

99. Convention Relating to Int’l Exhibitions, art. 1-2, Nov. 22 1928, 111 L.N.T.S. 343.

100. *Merrell Dow v. Norton*, [1996] R.P.C 76.

101. *Id.* at 85.

102. *Id.*

103. *Id.* at 88.

104. *Id.* at 86.

105. *Id.*

106. *Fomento Indus. SA v. Mentmore Mfg. Co. Ltd.*, [1956] R.P.C 87, 99.

107. *Windsurfing Int’l Inc. v. Tabur Marine (Great Britain) Ltd.*, [1985] R.P.C 59, 72.

108. See *SmithKline Beecham*, [2006] R.P.C. at [10].

109. *Id.* at [26].

110. 35 U.S.C.A. § 102(b) (West 2011).

111. See e.g. EPC, art. 55(1)(b), Oct. 5, 1973, 1065 U.N.T.S. 199; Patents Act, 1977, c. 37, §2(4)(c).

U.S.C. § 102(b)(1)(A) provides that disclosure made less than one year before the effective filing date will be excluded from the prior art if “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.”¹¹²

In this regard, U.S. patent law is more lenient than European and U.K. patent law. The U.S. will exclude any information that was obtained from the inventor whether or not it rises to the level of illegality or a breach of confidence.¹¹³ It also excludes disclosures made in the year before the patent application was filed rather than just the six months for which the European Patent Convention and the U.K.’s Patents Act 1977 provide.¹¹⁴ Section 102(b)(1)(A) also allows for not only the disclosure of an invention made at an international conference to be excluded from prior art, but also any disclosure made by the inventor made less than one year before the effective filing date of the patent application.¹¹⁵ The U.S. law allows for more disclosures within a greater length of time to be excluded from the prior art.¹¹⁶

The court’s finding in *Merrell Dow* that secret or inherent use is not sufficient to destroy novelty is probably applicable to the meaning of “otherwise available to the public” under § 102(a).¹¹⁷ If information is not known, it cannot be available to the public. It is a similar principle to the one the United States Supreme Court articulated in *Gayler v. Wilder* that lost knowledge when reinvented is truly new.¹¹⁸ Unknown information is not even accessible to the inventor, it, therefore, cannot be accessible to the public. Inherent use may be included in the prior art under “public use,” but it probably is not included under “otherwise available to the public.”

The biggest discrepancy between the U.K. and U.S. patent systems is that the U.K. system requires a disclosure to be enabling to part of the state of the art and the U.S. system does not. It is possible that “otherwise available to the public” could be interpreted to include only enabled disclosures. However, this would be an awkward interpretation because the other ways a reference can become prior art under § 102(a) do not require enablement. This interpretation would violate both the associated-words canon and the ejusdem generis canon. To require enablement in a disclosure for it to be “otherwise available to the public,” would make “otherwise available to the public” qualitatively different than the other terms in the list in § 102(a). That qualitative difference would effectively strike the word “otherwise” from the statute.

It is clear that Congress wanted to harmonize the U.S. patent system with

112. 35 U.S.C.A. § 102(b)(1)(A) (West 2011).

113. *Id.*

114. *Id.*; EPC, art. 55(1)(a), Oct. 5, 1973, 1065 U.N.T.S. 199; Patents Act §2(4).

115. 35 U.S.C.A. § 102(b)(1)(A) (West 2011).

116. *Id.*; EPC, art. 55(1)(b); Patents Act §2(4)(c).

117. *Merrell Dow v. Norton*, [1996] R.P.C at 85 (U.K.).

118. *Gayler v. Wilder*, 51 U.S. 477, 497 (1850).

the patent systems of our international trading partners. However, it is unlikely that Congress meant to adopt the European patent system in its entirety. The language in the America Invents Act is not strong enough to support such a conclusion. The Supreme Court held in *Whitman v. American Trucking Ass'ns* that "Congress . . . does not alter the fundamental details of a regulatory scheme in vague terms or ancillary provisions – it does not, one might say, hide elephants in mouseholes."¹¹⁹ Harmonization with Europe is clearly a goal of the America Invents Act. The Court has firmly stated, however, "No legislation pursues its purposes at all costs. Deciding what competing values will or will not be sacrificed to the achievement of a particular objective is the very essence of legislative choice—and it frustrates rather than effectuates legislative intent simplistically to assume that *whatever* furthers the statute's primary objective must be the law."¹²⁰ The European definition of "available to the public" can inform what is "otherwise available to the public" for U.S. patentability. For example, the U.K.'s precedent of a reference being prior art if the public could have accessed it whether or not anyone did and whether or not a small fee is charged could reasonably be applied to the U.S. definition of "otherwise available to the public," but if Congress wishes to adopt the European definition of in its entirety it will probably have to do so expressly.

E. Legislative History

There is some disagreement about whether legislative history should be considered when interpreting the meaning of a statute.¹²¹ In 1821, James Madison, said this about Constitutional interpretation: "As a guide in expounding and applying the provisions of the Constitution, the debates and incidental decisions of the Convention can have no authoritative character."¹²² Legislative history is not voted on.¹²³ It cannot be amended.¹²⁴ The president does not sign it or have an opportunity to veto it. Often it is not even heard or read by senators, congressmen, or the president.¹²⁵ The legislative history is not the law.¹²⁶ However, legislative history can provide some insight into what Congress meant or intended when it enacted a law. It can give some definition or context to words that may otherwise have none. Moreover, it is a tool employed by some judges when interpreting statutes. Therefore, this subsection analyzes the legislative history on § 102 of the America Invents Act.

On September 8, 2011, Senator Jon Kyl, in a speech of the Senate floor

119. *Whitman v. Am. Trucking Ass'ns*, 531 U.S. 457, 468 (2001).

120. *Rodriguez v. United States*, 480 U.S. 522, 525-26 (1987) (emphasis in original).

121. SCALIA & GARNER, *supra* note 11, at 369.

122. *Id.* at 371.

123. *Id.* at 385.

124. *Id.*

125. *Id.* at 386.

126. *Id.* at 385.

referred to Congressmen Smith's comments on § 102 of the America Invents Act: "As Chairman [Smith] most recently explained in his June 22 remarks, 'contrary to current precedent, in order to trigger the bar in new 102(a) in our legislation, an action must make the patented subject matter "available to the public" before the effective filing date.'"¹²⁷ Senator Kyl went on to say:

When the committee included the words "or otherwise available to the public" in section 102(a), the word "otherwise" made clear that the preceding items are things that are of the same quality or nature. As a result, the preceding events and things are limited to those that make the invention "available to the public." The public use or sale of an invention remains prior art, thus making clear that an invention embodied in a product that has been sold to the public more than a year before an application was filed, for example, can no longer be patented. Once an invention has entered the public domain, by any means, it can no longer be withdrawn by anyone. But public uses and sales are prior art only if they make the invention available to the public.¹²⁸

Senator Kyl argued in his remarks on the Senate floor that the addition of the phrase "otherwise available to the public" modified the preceding terms in the list. Senator Kyl uses the associated-words canon of statutory interpretation to argue backwards. He argues that the terms "patented," "printed publication," "public use," and "on sale" must be similar to "otherwise available to the public" rather than arguing that "otherwise available to the public" must be similar to "patented," "printed publication," "public use," and "on sale." The distinction is subtle, Senator Kyl is contending that the addition of "otherwise available to the public," rather than adding additional content to what is excluded under prior art or perhaps in addition to adding content to the prior art, changes what is included in the prior art by the terms "patented," "printed publication," "public use," and "on sale."

Under Senator Kyl's interpretation, "public use" and "on sale" would be redefined. "Patented" and "printed publication" would probably remain the same. A patented invention has been made fully available to the public through the disclosure required in the specification of the application. The "printed publication" bar has already been defined by the courts as having a public accessibility requirement. Senator Kyl is arguing that public uses and offers for sale must make the invention available to the public. This would change the law so that private sales would no longer prohibit patentability. It would add a requirement to the two listed in *Pfaff*. *Pfaff* only required that an invention be offered for commercial sale and that it be ready for patenting for it to be included in the prior because it was "on sale."¹²⁹ Under Senator Kyl's interpretation, a sale would have to make the invention available to the public in addition to being offered for commercial sale and being ready for patenting for it to be included in the prior as part of the "on sale" bar. This

127. 157 CONG. REC. S5431 (daily ed. Sept. 8, 2011) (statement of Sen. Jon Kyl) (quoting 157 CONG. REC. H4429 (daily ed. Sept. 22, 2011)).

128. 157 CONG. REC. S5402-02 (daily ed. Sept. 8, 2011) (statement of Sen. Jon Kyl).

129. *Pfaff v. Wells Elec., Inc.*, 525 U.S. 52, 67 (1998).

reading of the statute would also change the outcome in *Egbert v. Lippmann*. The use of the corset steels in one woman's corsets did not make the invention available to the public.¹³⁰

Senator Kyl's interpretation of § 102(a) of the America Invents Act may also require an enabling disclosure for any disclosure to be prior art as the European Patent Convention does. If the addition of the phrase "otherwise available to the public," modifies the preceding terms in the list in § 102(a) and availability to the public requires an enabling disclosure, then disclosure under any of the terms in the list would have to be enabling. This is a possible interpretation of § 102(a), but it is unlikely that a court would not only apply the European definition of available to the public to "otherwise available to the public," but also extend the European definition further to "patented," "printed publication," "public use," and "on sale."

F. United States Patent and Trademark Office Guidelines

Guidelines from the United States Patent and Trademark Office (USPTO) could potentially help in defining the content of "otherwise available to the public." The USPTO will be the first institution to interpret and apply the new § 102(a). Its interpretation will eventually be reviewed by an Article III Court, either when an applicant appeals the rejection of his patent application or when a defendant in an infringement suit or a plaintiff in a suit for a declaratory judgment of invalidity asserts that a patent with an effective filing date after March 16, 2013 is invalid for lack of novelty. However, the USPTO's interpretation of "otherwise available to the public" is potentially important in determining what will actually bar an invention from patentability and what will not.

In its Examination Guidelines for Implementing the First Inventor to File Provisions of the Leahy-Smith America Invents Act, the United States Patent and Trademark Office stated that:

AIA [America Invents Act] 35 U.S.C. 102(a)(1) provides a "catch-all" provision, which defines a new additional category of potential prior art not provided for in pre-AIA 35 U.S.C. 102. Specifically, a claimed invention may not be patented if it was "otherwise available to the public" before its effective filing date. This "catch-all" provision permits decision makers to focus on whether the disclosure was "available to the public," rather than on the means by which the claimed invention became available to the public or on whether a disclosure constitutes a "printed publication" or falls within another category of prior art as defined in AIA 35 U.S.C. 102(a)(1).¹³¹

This is a similar interpretation to the one arrived at by using the surplusage, associated-words, *eiusdem generis* cannons of statutory interpretation. It gives to "otherwise available to the public" a meaning of the same kind as

130. *Egbert v. Lippmann*, 104 U.S. 333, 336 (1881).

131. Examination Guidelines for Implementing the First Inventor to File Provisions of the Leahy-Smith America Invents Act, 78 Fed. Reg. 11059, 11075 (Feb. 14, 2013) (to be codified at 37 C.F.R. pt. 1).

those given to “patented,” “printed publication,” “public use,” and “on sale.” The USPTO goes on in its Guidelines to suggest situations in which a reference might fall under the “otherwise available to the public” bar to patentability.

The availability of the subject matter to the public may arise in situations such as a student thesis in a university library, a poster display or other information disseminated at a scientific meeting, subject matter in a laid-open patent application, a document electronically posted on the Internet, or a commercial transaction that does not constitute a sale under the Uniform Commercial Code.¹³²

The USPTO’s interpretation of § 102(a) is a probably a permissible interpretation of the statute. It follows the *supplurage* canon. The USPTO interprets “otherwise available to the public” as a fifth category under which references can be included in prior art. It includes content under “otherwise available to the public” that is not included in any of the preceding terms in the list in § 102(a). The USPTO stated that “Even if a document or other disclosure is not a printed publication, or a transaction is not a sale, either may be prior art under the ‘otherwise available to the public’ provision of AIA 35 U.S.C. 102(a)(1), provided that the claimed invention is made sufficiently available to the public.”¹³³ The USPTO sees the inquiry of whether a reference is include in the prior art because it is “otherwise available to the public” as hinging on whether it has been made sufficiently available to the public. The sufficiency of availability to the public is determined in the same way it has been determined for prior art in the cases before the America Invents Act was enacted. This is a sensible, reasoned, and principled approach to determining what constitutes “otherwise available to the public,” and as such it is probably a reasonable interpretation of § 102(a).

The USPTO also included in it guidelines its view on whether the addition of “otherwise available to the public” changes the meaning of the proceeding terms in § 102(a). Its view is that it does.

The pre-AIA 35 U.S.C. 102(b) “on sale” provision has been interpreted as including commercial activity even if the activity is secret. AIA 35 U.S.C. 102(a)(1) uses the same “on sale” term as pre-AIA 35 U.S.C. 102(b). The “or otherwise available to the public” residual clause of AIA 35 U.S.C. 102(a)(1), however, indicates that AIA 35 U.S.C. 102(a)(1) does not cover secret sales or offers for sale. For example, an activity (such as a sale, offer for sale, or other commercial activity) is secret (non-public) if it is among individuals having an obligation of confidentiality to the inventor.¹³⁴

The USPTO takes the position of Senator Kyl. This is an interesting position because while it follows the associated-words canon of statutory interpretation, it contradicts the prior-construction canon. It uses “otherwise available to the public” to inform what constitutes “public use” and “on sale”

132. *Id.*

133. *Id.*

134. *Id.* at 11074-75.

which is what the associated-words cannon says should be done. But it also redefines to some extent both “public use” and “on sale” even though Congress keep the same phrasing it had used in previous patent statutes. This is exactly what the prior-construction cannon says should not be done. It is probably a permissible reading of the statute because it reads the statute as a whole and is the most sensible reading of the plan language.

V. CONCLUSION

There are at least three ways “otherwise available to the public” can be read. It can be read as having a related meaning to the other terms which have been previously defined by case law. This interpretation follows the prior-construction, surplusage, associated-words, and ejusdem generis cannons. If one wanted to look only to the text of the statute and prior case law, this would probably be the most natural reading of the statute. However it does not take into consideration all of the available evidence on what constitutes “otherwise available to the public.”

The second way “otherwise available to the public” can be read is by looking to European and United Kingdom jurisprudence on what constitutes “available to the public.” This interpretation best survives the purpose of the America Invents Act. It best facilitates the harmonization of the United States patent system with the patent systems of European countries. Prior art under the European Patent Convention is defined as material that is “available to the public.”¹³⁵ There is a whole body of precedent that defines the phrase Congress used in the statute. However, adopting the European definition of “available to the public” would contradict U.S. precedent and violate the associated-words cannon and the ejusdem generis cannon. It would mean that for an invention to be “otherwise available to the public,” the disclosure would have to be enabling. While this is in keeping with a substantial body of European case law, it is a big change from the U.S. precedent. The patent system is carefully balanced by Congress.¹³⁶ One needs to be careful not to upset that balance by trying to achieve greater harmonization than was intended.

The Third way “otherwise available to the public” could be interpreted is by reading it as modifying the other terms in the list in § 102(a). This interpretation considers that section as a whole when interpreting each of the individual terms. It applies the associated-words cannon to not only “otherwise available to the public,” but also to “patented,” “printed publication,” “public use,” and “on sale.” It is also the interpretation that is supported by both the legislative history and the United States Patent and Trademark Office. However, this interpretation violates the prior-construction cannon. “Patented,” “printed publication,” “public use,” and “on sale” have been well defined by U.S. courts, and Congress used the exacted same terms again in

135. EPC, art. 54(2), Oct. 5, 1973, 1065 U.N.T.S. 199.

136. *Bonito Boats v. Thunder Craft Boats*, 489 U.S. 141, 146 (1989).

the American Invents Act. If Congress wanted to modify their meaning, why didn't Congress modify its language? Relying on legislative history or an agency's interpretation is a precarious proposition. Neither is the law, and they should not be treated as law.

The first interpretation is most likely to be adopted by U.S. courts. They will likely be resistant to big changes in the law without textual support. The second interpretation ignores U.S. precedent in favor of European precedent without an express mandate from Congress to do so. Considering the European definition of "available to the public" can be valuable, but the prior-construction, surplusage, associated-words, and ejusdem generis cannons are far more helpful. The third interpretation, the one supported by the legislative history and adopted by the USPTO, is probably the most holistic reading of the statutory language and would probably be the interpretation adopted by the courts if the terms used had not been previously defined. However, Congress did not enact the America Invents Act in a vacuum, and the courts will probably not change the definitions of terms that have not changed.