Client Alert: Navigating the Transition from a First-to-Invent to a First-to-File Patent System: Implementation March 16, 2013

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On March 16, 2013, the First-to-File provisions of the American Invents Act (AIA) take effect, thus moving the United States from a First-to-Invent patent system to a First-to-File patent system. The United States Patent and Trademark Office (USPTO) rules and examination guidelines for the First-to-File provisions will apply to all patent applications having an effective filing date on or after March 16, 2013.

I. First-to-File provisions take effect on March 16, 2013:

1. Applications filed on or after March 16, 2013, are no longer entitled to a date of invention to establish inventive priority. This means that patents are no longer granted to the first inventor to invent; rather patents granted on applications filed on or after March 16, 2013 are awarded to the first applicant to file a patent application on the invention.
2. Applications entitled to a priority filing date prior to March 16, 2013, such as continuation, divisional and continuation-in-part applications that do not include claims encompassing newly added subject matter (added on or after March 16, 2013), if filed on or after March 16, 2013, will be examined pre-AIA while applications that do encompass even one claim with an effective filing date after March 16, 2013, such as a newly added claim in continuation-in-part applications based on newly added subject matter, will be examined under the AIA.
3. For applications filed on or after March 16, 2013, a reference can no longer be removed as prior art by "swearing behind" it to establish a prior date of invention. More specifically, an inventor named on an application filed or after March 16, 2013, can no longer submit evidence showing that he or she invented prior to the effective date of a prior art reference, in order to remove the reference as prior art.
4. For applications filed on or after March 16, 2013, the current pre-AIA 1-year grace period with regard to third-party disclosures is eliminated. For patent applications that are filed prior to March 16, 2013, an inventor has up to 1-year to file a patent application after a disclosure, including a third-party disclosure, of the invention. A pre-

AIA disclosure is a disclosure that is accessible to the public.

5. For applications filed on or after March 16, 2013, an inventor will have a ***personal*** 1-year grace period for the inventor's own public disclosures or public disclosures derived by others directly or indirectly from the inventor. Note: AIA "disclosures" are public disclosures that include publications, public uses, sales. *See* AIA 35 USC §§102(a) and 102(b).
6. If commonly owned (or subject to an obligation of assignment to the same person), previously filed patent applications naming another inventor that issued or published after the effective filing date of a patent application, are not prior art against the patent application for either anticipation under 35 USC §102 or obviousness under 35 USC §103. *See* AIA 35 USC §102(c).
7. Under 35 USC §§102 (novelty) and 103 (obviousness), as rewritten, generally prior art will include all ***public disclosures*** including publications, public uses, sales, that occur prior to the filing date of the application except for disclosures by the inventor or derived by others from the inventor within 1-year of the filing date of the application, ***without geographic limitation***. ***Secret,*** i.e., not public, processes practiced before an effective filing date of a patent application will ***not*** be considered prior art against the application.
8. On or after March 16, 2013, US patent and US/PCT patent application publications claiming priority under section 119 or 365 (right of priority) are now available as prior art as of their ***foreign filing dates***. This means that the subject matter of priority applications filed in any country, in any language, may be available as prior art under the AIA for both novelty and obviousness purposes. *See* AIA 35 USC §102(a)(2).
9. On or after March 16, 2013, inventions that are in public use, or on sale, or otherwise available to the public ***in a foreign country*** are now available as prior art. *See* AIA 35 USC §102(a)(1).
10. On or after March 16, 2013, obviousness is determined at the time of filing, not at the time of invention. Note that prior art available under AIA 35 USC §102(a)(2) is available as prior art under 103 (Contrast: intervening art in Europe is only available as novelty defeating and cannot be used to show lack of inventive step).

II. Strategies:

1. Consider filing patent applications prior to March 16, 2013 in order to take advantage of the soon to expire U.S. First-to-Invent system.
2. On or after March 16, 2013, understand that speed counts. File patent applications as quickly and completely as possible.
3. Consider filing provisional applications on all invention disclosures and ensure invention disclosures are complete as possible, i.e., include adequate written description and enabling disclosure. Review and revise your Invention Disclosure Form to help ensure completeness.
4. Consider filing serial provisional applications to build scope and strength, each being as complete as possible including adequate written description and enabling disclosure.
5. Tighten-up controls on pre-filing disclosures.
6. Foreign entities may wish to file in their country first instead of first filing in the US for an earlier 102(e) date.

*This alert is an **overview only** of **only some** of the First-to-File provisions of the AIA being implemented on March 16, 2013; this is **not** a comprehensive analysis of such provisions.*