



## America Invents Act

### First Inventor to File

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Under the America Invents Act (AIA), for applications with an effective filing date after March 16, 2013, a patent will be awarded to the first inventor to file a patent application that discloses an invention, subject to certain exceptions discussed below.

The first-inventor-to-file system will replace the first-to-invent system currently used in the United States. This change in the method for determining inventorship based on the time of filing is intended to more closely harmonize the U.S. patent system with the rest of the world.

#### **Effective Date:**

The changes apply to all applications with an effective filing date on or after March 16, 2013.

#### **Broadened Definition of Prior Art:**

The definition of prior art available to cite against a claim in an application has been expanded. 35 U.S.C. 102(a)(1) now states:

“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 invention.”

Previously, certain types of prior art were geographically limited, but now “prior use” and “on sale” activities are no longer limited to the United States.

The full scope of these changes is not yet fully understood as the statutory language remains to be interpreted by the courts. It is unclear what “otherwise available to the public” will mean in practice. According to the USPTO’s guidelines, a limited disclosure, such as by the inventor to one person, with no evidence that the disclosure ever entered the public domain may not meet the “public availability” standard required to qualify as prior art. In addition, secret processes for making inventions and publicly inaccessible internal components of inventions may no longer render inventions “publicly available,” and therefore may not constitute prior art.

Moreover, the provisions of the AIA are being interpreted by the USPTO to exclude from prior art any private sales or offers for sale, including those made by the applicant.

### **Patents and Published Applications as Prior Art:**

Patents and published patent applications are available as prior art if their effective filing date is earlier than the priority date of an application. The effective filing date now includes foreign priority dates, thereby abolishing the *In re Hilmer* doctrine, which has long disadvantaged applicants filing first outside the United States.

Importantly, the effective priority date will be relevant to both novelty and obviousness, which is broader than approaches taken by other jurisdictions, notably the European Patent Office.

There is an exception to prior art for patents and patent applications that are commonly owned or subject to a joint research agreement that is in place when the application is filed. However, this exception does not apply if the prior patent or application was published before the effective filing date of the application.

### **Grace Period for Disclosure:**

A one-year grace period is provided for disclosure of the subject matter of a claim by an inventor, joint inventor or another person that directly or indirectly received information from the inventor or joint inventor. Unlike the prior law, there is no grace period afforded to the inventor for any disclosure of the subject matter of a claim by another, unless that disclosure occurred after a public disclosure by the inventor, joint inventor or someone that received the information from the inventor or joint inventor. The ability to “swear behind” prior art of another is eliminated.

### **Invention by Another:**

Interference proceedings, which are used to determine who was the first person to invent, will be gradually eliminated in favor of a derivation proceeding. Interferences will remain available for all applications with an effective filing date prior to March 16, 2013. A derivation proceeding will determine whether a party derived an invention from another. An applicant may file a petition with the U.S. Patent and Trademark Office to institute a derivation proceeding within one year of the first publication of a claim to the invention by another.

### **Civil Action for Derived Patents Created:**

The filing of a civil action for a derived patent is a new cause of action when two patents are granted with claims to the same subject matter. The owner of a patent may bring suit for derivation within one year of the issuance of the first patent to another party containing a claim to the allegedly derived invention.