



Client Memorandum

November 20, 2012

Patent Update: First-Inventor-To-File Transition

Beginning on March 16, 2013, under the America Invents Act (AIA) a patent will be awarded to the first inventor to file a patent application directed to an invention. This change will apply to new patent applications that claim subject matter added on or after March 16, 2013. Depending on the circumstances surrounding an invention, the present first-to-invent law may offer advantages to patent applicants.

A significant change accompanying the first-inventor-to-file law is a new definition of the term “prior art”. Understanding what constitutes prior art under the AIA is important for determining a filing strategy for future patent applications, particularly in the time period leading up to the March 16, 2013, transition date. Prior art continues to include information publicly available before a patent application filing date, but the criteria to qualify as prior art will change. This patent update examines the definition of prior art under the AIA and presents some considerations regarding patent application filing strategy.

Definition of Prior Art

The AIA has both expanded and contracted the definition of prior art when compared to the current definition. For example, under the current law, prior art does not include certain foreign references, public disclosures and sales that occur outside the United States, and certain references that can be antedated, such as applications for inventions that were filed first but not invented first. Under the new first-inventor-to-file law, however, this type of information will be considered prior art. In this respect, the AIA has expanded the definition of prior art, thereby making it potentially more difficult to obtain patent protection.

In other respects, the AIA has contracted the definition of prior art. For example, a limited disclosure, such as by an inventor to one person with no evidence that the disclosure ever entered the public domain, may not meet the “public availability” standard to qualify as prior art. In addition, secret processes for making inventions and publicly inaccessible internal components may no longer render inventions “publicly available”, and therefore may not constitute prior art. Moreover, the provisions of the AIA suggest that Congress intended to exclude from prior art any private sales of the invention. Although the full scope of these changes is not yet fully understood, it is clear that the definition has changed.

Filing Strategy Considerations

In view of the new definition of prior art under the AIA, it may be worthwhile to consider filing patent applications before March 16, 2013, to remain under the current first-to-invent law. In addition to prior art considerations, pre-AIA patent applications will not be open to challenge under a new post-grant review procedure that can be used by a competitor to try to invalidate or narrow the claims of a newly issued patent. Given these changes, it makes sense to consider all options and define a filing strategy in advance of the transition date in order to be fully prepared for the change to the first-inventor-to-file law.

To help in this assessment and to assist in the preparation for the first-inventor-to-file law that takes effect on March 16, 2013, we have outlined some general strategy considerations below.

1. Consider filing before March 16, 2013. In view of the changing definition of prior art under the AIA, the present first-to-invent law may offer certain advantages in some situations. For example, because certain prior art references can be antedated under the present first-to-invent law, it may be advantageous to file applications before March 16, 2013.

It cannot be stressed enough that the circumstances surrounding each patent application should be assessed on an individual basis before deciding whether a patent application should be filed before the critical date.

2. Consider filing early and often. After the first-inventor-to-file provisions of the AIA become effective, the race to the U.S. Patent Office begins, and securing an early filing date may become more important for protecting patent rights. In most circumstances, securing an early filing date may mean filing patent applications earlier in the invention development cycle than under current practice. For example, because current patent law recognizes the first person to *invent* the claimed invention as the true inventor, there is little risk in waiting to file a patent application provided it can be demonstrated that the inventor acted with diligence from conception to the filing date of the patent application. Under the AIA, the statute will recognize the first inventor to *file* a patent application as the true inventor (with some limited exceptions).

In view of this change, the decision of whether or not to file patent applications earlier in the product development cycle should be given greater importance and consideration. In some cases, it may make sense to file multiple provisional applications during the course of the invention development cycle, the provisional applications forming the basis of one or more non-provisional patent applications.

3. Consider segregating pre-AIA and AIA subject matter. For a transitional application, such as a provisional application filed before March 16, 2013, forming the basis of a non-provisional patent application to be filed on or after March 16, 2013, it may be prudent to consider filing a second, separate application for any new subject matter not included in the original provisional application. Doing so will clearly segregate the new subject matter from the old subject matter. This segregation may help prevent the new subject matter filed under the new first-inventor-to-file law from impacting the examination of the old subject matter, which rightfully should be examined under the current first-to-invent law.
4. Continue to keep records regarding inventions. Lab notebooks continue to be relevant under the first-inventor-to-file law in order to record the details to support the disclosure, to show unexpected results, and to provide evidence of independent invention. Accurate records are also important for the “public availability” analysis — whether there has been a public disclosure, the information that was disclosed, and to whom it was disclosed.
5. Avoid public disclosure before filing a patent application. Although the one-year grace period after the public disclosure of an invention still exists in the United States under the AIA, its availability will be limited to specific circumstances. In addition, not all countries have a grace period; therefore, disclosing an invention before filing may result in the loss of foreign patent rights. Further, early disclosure may create an additional evidentiary burden in the event a third party obtains and modifies your disclosure in an attempt to obtain a separate patent on the invention.

6. Assess improvement patent application options before publication of an earlier filed application. Under the current first-to-invent law, prior art does not include earlier filed, commonly owned patent applications that have not yet issued. However, under the new first-inventor-to-file law, this exception is no longer available until issuance of the earlier patent application, but only until publication. Therefore, it may be worthwhile to consider filing improvement patent applications prior to the publication date of the earlier patent application or filing a request for non-publication if there are no plans for corresponding foreign filings. Either strategy may reduce the likelihood that your current patent application will serve as invalidating prior art against your later improvement patent application.

Please contact your COJK attorney to discuss how the AIA changes to U.S. patent law may affect your patent application filing strategies.