

America Invents Act - U.S. Prior-Art System to Change on March 16, 2013

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The America Invents Act ("AIA") has changed U.S. patent law in many significant ways. Some of these changes have already taken effect, while others will take effect soon. Several of the changes under the AIA that will take effect soon pertain to the prior-art system that will be applied. These prior-art system changes have an effective date of March 16, 2013. On that date, the U.S. prior-art system will transition from a first-to-invent system to a modified first-to-file system.

Which prior-art system will be applied?

U.S. patent applications that have a U.S. or foreign priority date before March 16, 2013 are now, and will continue to be, examined under the first-to-invent system. This is the case even if the filing date of the U.S. patent application is on or after March 16, 2013, so long as all claims in the U.S. patent application are entitled to the U.S. or foreign priority date. If even one claim in the U.S. patent application is not entitled to a pre-March 16 priority date, the entire U.S. patent application will be examined under the modified first-to-file system of the AIA. Also, if only one claim in the U.S. patent application as originally filed is not entitled to a pre-March 16 priority date, and that one claim is later canceled during prosecution, the entire U.S. patent application will still be examined under the modified first-to-file system of the AIA. Thus, for example, for U.S. provisional patent applications filed on or after March 16, 2012, it may be beneficial to file a U.S. non-provisional patent application before March 16, 2013 that claims priority from the provisional patent application.

Changes to the U.S. grace period

Because of the AIA, changes to the one-year grace period will also go into effect on March 16, 2013. Under the current first-to-invent system, patent applicants are entitled to a one-year grace period to file a U.S. patent application ("the old grace period"). The old grace period begins to run, for example, from the date of a printed publication. While the AIA still includes a grace period ("the AIA grace period"), the AIA grace period is significantly different from the old grace period. In similar fashion to the old grace period, the AIA grace period begins to run, for example, from the date of a printed publication. However, the AIA grace period requires, for example, that the printed publication have been made by the inventor or someone who obtained the subject matter of the printed publication from the inventor. The AIA grace period is also different from the old grace period in that a patent-application filing outside the U.S., and not just a U.S. patent application, tolls the AIA grace period.

Increased amount of available prior art

Patent applications examined under the modified first-to-file system will be subject to more available prior art than patent applications examined under the first-to-invent system. For example, under the first-to-invent system, public-use and on-sale activities are considered prior art only if those activities occurred in the U.S. The modified first-to-file system put in place by the AIA contains no such geographic limitations. As a result, under the modified first-to-file system, public-use and on-sale activities that occur ANYWHERE IN THE WORLD are available as prior art against U.S. patent applications. The AIA also introduces a new category of prior art. Under the AIA, art "otherwise available to the public" that does not fall into one of the above-mentioned categories will also be available to an examiner as prior art.

In addition, under the first-to-invent system, when an examiner wants to reject a U.S. patent application based on a U.S. patent or patent-application publication (a "Reference Document"), the filing date of a foreign patent application from which the Reference Document claims priority has no bearing on the effective date of the Reference Document as prior art. In contrast, under the modified first-to-file system, the filing date of a foreign patent application from which the Reference Document claims priority is considered the effective filing date of the Reference Document for purposes of citation of it as prior art against a later-filed U.S. patent application undergoing prosecution. Moreover, in contrast to the first-to-invent system, under the modified first-to-file system, a cited reference CANNOT BE REMOVED as prior art by a demonstration of invention prior to the effective filing date of the cited reference.

Recommended course of action

Simply stated, there may be benefits to filing a non-provisional U.S. patent application before March 16, 2013 in order to ensure that the non-provisional U.S. patent application is examined under the first-to-invent system. However, because such a determination is very case-specific, this decision should only be made after a detailed review of the facts surrounding each particular case.

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