

Beware the Ides of March: How to prepare for changes in patent law and the March 16th deadline

February 22, 2013

Article

The American Invents Act (AIA) represents the most significant overhaul of the U.S. patent system in more than half a century. While several provisions of the AIA took effect in 2011 and 2012, additional changes that may profoundly impact the future of your company's intellectual property will take effect on March 16 - just weeks away. You should take steps now to prepare your company and avoid potential complications that may result from the impending law changes.

The most impactful change taking effect on March 16th is the switch of the U.S. patent system from a "first to invent" system to a "first inventor to file" system. This change in the U.S. Patent Law will have a number of significant effects on patent applications filed on or after March 16, 2013.

1. First to File

One of these effects is that applicants will no longer be able to claim priority based on the date of *invention* to get around a competitor's patent or other publication that predates their own. Instead, the Patent Office ("PTO") will award a patent based on the application with the "earliest effective filing date," which is the filing date of the application or the earliest available priority date of a parent application or corresponding foreign application.

This change brings the United States patent system in line with most every other country's system. However, unlike most foreign countries, the United States has retained a one year grace period for an inventor's own disclosures. This means an inventor having a later application filing date at the PTO, but an earlier disclosure within the one year grace period, can still win out over an application filed by another in the intervening time, subject to some limited exceptions. It is important to keep in mind, however, that this grace period is particular to the U.S. and any public disclosure will result in the forfeit of foreign patent rights.

2. Changes in prior art

Another significant effect of the AIA's "first inventor to file" provisions is that a greater amount of prior art – for example, patents, publications, sales, and other public disclosures – will be available to challenge and invalidate a patent. This is because the new law uniformly defines prior art with respect to the date of filing, rather than the date of invention in certain situations. Also, the geographic restrictions on prior art that exist now will be lifted, which will expand potential prior art to include things like sales, public uses, and offers for sale outside the U.S. To paraphrase the House Report on the AIA, prior art will typically include all art that exists prior to the filing date, other than disclosures by the inventor within one year of filing.

3. The new Post-Grant Review procedure

A third significant effect of filing an application on or after March 16, 2013 is that any patent issuing from the application will be subject to the new Post-Grant Review (PGR) procedure. PGR is similar in concept to European opposition proceedings and provides an opportunity for a third party to challenge a patent within the first nine months

of its issuance. The third party can petition for cancellation of claims based on grounds related to invalidity, such as novelty, obviousness, written description, enablement, and indefiniteness.

Because of these significant changes to the patent law under the AIA, it may be advantageous to file as many applications as possible before March 16th. Filing utility applications (as opposed to provisionals) and continuing applications in advance of March 16th is recommended because the AIA's first inventor to file provisions apply to any application or subsequent patent that contains, *or contained at any time*, a claim having an effective filing date on or after March 16, 2013, or a priority claim to an application that contains, *or contained at any time*, such a claim. Therefore, claiming priority to a provisional or parent application filed before March 16, 2013 can be ineffective to circumvent the new first inventor to file provisions if any claim, even if later canceled, cannot find full support in the earlier-filed application.

The next steps you need to take

If you want to file an application under the pre-AIA law, you should consider taking the following steps before March 16:

- Convert any pending U.S. provisional applications into utility applications
- Prepare and file utility applications on any old invention disclosures that have been on hold
- Organize a meeting of your company's patent review board or committee to review any pending invention disclosures and decide if an application should be fast-tracked and filed
- File any desired continuing applications

If you are interested in filing a patent application before March 16, you should contact your patent attorney as soon as possible, as little time remains to properly draft an application and file it before the deadline.

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