LEGAL UPDATES

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First-to-File Starts on March 16, 2013

Services

Intellectual Property

Patent Preparation & Prosecution

The America Invents Act finally puts the first-to-file system into place on March 16, 2013. Although the two regimes will be equivalent in theory for many applicants, practical considerations mean that most inventors and companies will benefit by filing their patent applications before then.

Section 3 of the America Invents Act implements new definitions of novelty and obviousness. This means that, with small exception, to be patented an invention must meet the standards of absolute novelty against all disclosures that are publicly available anywhere in the world. Under the old law there were two temporal definitions used for prior art. First, disclosures could be prior art because they were available more than one year prior to the filing date of the application for a patent – see 35 United States Code 102(b). Second, disclosures could be prior art because they were made before the invention was invented – see 35 USC § 102(a), 102(e), 102(f) and 102(g).

The vast majority of rejections in the U.S. Patent and Trademark Office (USPTO) are based on patents and printed publications as prior art. Consider an application where the invention was pursued diligently at least a year prior to filing. On March 15, 2013, under the current 102(b), a patent or printed publication is prior art if it was in existence more than a year before the priority date of the patent application. On March 16, 2013, under the new 102(a)(1), the patent or printed publication will be prior art if it was in existence on the day before the filing of the patent application. The new 102(a)(1) creates an entire year's worth of prior art with only one calendar day passing.

Another consideration is that on March 15, 2013, under the current 102(b), the public-use and on-sale bars apply only to public uses and sales or sales offers that are made in the United States. Under the new law, almost all types of prior art can come from anywhere in the world.

The widening of temporal and geographic scope of prior art means that most patent applications will have much more prior art that can be asserted against them on March 16 than on March 15.

There are exceptions to the rule, including, but not limited to, a qualified grace period based on the inventor's prior public disclosure of the claimed invention less than a year prior to the effective filing date, the scope of which is the subject of ongoing USPTO rulemaking. In the past, there has been a crush of applications filed in the last days approaching a major change like the change coming up on March 16. If you want to consider filing your patent application before March 16, it would be prudent to contact your Husch Blackwell attorney as soon as possible to be sure that the application can be filed in time.

What This Means to You

The definition of prior art that can invalidate a patent application or patent on your invention becomes broader on March 16, 2013. If you want to file your patent application before March 16, it is important to contact your Husch Blackwell attorney at your earliest convenience.

Contact Information

For additional information about these or any other intellectual property issues, please contact your Husch Blackwell attorney.

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