
Planning for March 16, 2013: Implementation of First-Inventor-to-File Standard

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The AIA was signed into law on September 16, 2011, bringing about significant changes in US patent law. Many features of the AIA, such as new Post-Grant and *Inter-Partes* Review procedures and changes to joinder requirements in civil suits, have already been implemented. However, there are important changes in US patent law scheduled to take effect on March 16, 2013.

In particular, the AIA includes statutory provisions that implement a shift in the standard for patentability from “first to invent” to “first inventor to file.” Under this new standard, the first inventor to file a patent application (typically) is entitled to a patent. This represents a change from the current system in which the first applicant to make the invention is entitled to a patent.

To facilitate this change, the AIA redefines *and broadens* the scope of patentability-defeating prior art. For example, new § 102(a)(1) precludes a patent on an invention if the invention was patented, described in a printed publication, in public use, on sale, or otherwise available to the public before the effective filing date of the application claiming that invention. On a first read, the language used in new § 102(a)(1) is deceptively similar to terms found in pre-AIA § 102(b), e.g. patented, printed publication, public use, and on sale. Unlike § 102(b) prior to the AIA however, public uses and sales are *not* limited to events occurring in the US. Additionally, § 102(a)(1) of the AIA includes a catch-all category defined as “otherwise available to the public.” While some commentators have remarked that this catch-all category expands the definition of prior art, the true scope of available prior art will likely only be determined in the courts.

At the same time, the AIA has scaled back the scope and effect of the grace period (set forth in new § 102(b)) that provides an exception to the prior art definitions of § 102(a). The grace period applies to the public disclosure of an invention within one year of the effective filing date of the application disclosing and claiming that invention, but only if the disclosure was by an inventor or one who obtained the invention from an inventor. No longer can an inventor antedate a disclosure by another within one year of the effective filing date.¹

Thus, the new rules taking effect on March 16, 2013 will affect current practices before the United

States Patent Office in two significant ways. They will:

- broaden the scope of patent-defeating prior art; and
- narrow the scope of the grace period that excepts public disclosures from the prior art.

Considerations for Implementation of First-Inventor-to-File System:

- Contemplate filing planned patent applications on or before March 15, 2013. Any application meeting the requirements for patentability (enablement and written description) that is filed on or before March 15, 2013 will be examined under the current “first to invent” rules.
- Review and identify current technological developments/research that could be accelerated to file patents applications prior to March 16, 2013.
- Review existing patent applications filed before March 16, 2013 to confirm that each pending claim is supported and consider filing supplemental patent applications, if necessary.

¹ An exception to this rule exists for situations where the information disclosed by the third party originated from the inventor or became public after the inventor made it public.

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