WILMERHALE

Planning for March 16, 2013: Important Considerations as US Moves to a First-Inventor-to-File System

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The America Invents Act (AIA) has already brought extensive reforms to US patent law since it was signed into law on September 16, 2011. On March 16, 2013, perhaps the most publicized change will take place when the US officially moves from a "first-to-invent" to "first-inventor-to-file" system.

A patent application filed on or before March 15, 2013 will be examined according to the "first-to-invent" and pre-AIA prior art rules. Continuation or divisional applications filed after March 16, 2013 that claim *only* the subject matter disclosed in a parent application filed on or before the deadline will also be examined under pre-AIA rules, without being subject to the "first-inventor-to-file" rule and the expanded prior art mandated by the AIA.

In implementing the "first-inventor-to-file" system, the AIA has revised the definition of 'prior art' and in some ways expanded the scope of available prior art for rejecting patent applications and invalidating patents. For applications filed under the AIA *after* March 15, 2013:

- ***Inventors generally cannot overcome prior art by showing they made their inventions before publications by others.*** The AIA provides an exception that allows an inventor to rely on his or her own public disclosure within a year of filing to overcome public disclosures by others that occurred between the time of the inventor's disclosure and the inventor's later patent filing. However, an inventor will not otherwise be able to overcome a rejection based on prior art before the inventor's effective filing date.
- ***Inventors may face rejections based on oral disclosures by others.*** Under the new AIA standard, prior art can include not just written disclosures but also oral disclosures if sufficiently public. The contours of what will qualify as prior art will be fleshed out by the courts.
- ***Foreign patent applications by others may become more potent as prior art.*** Under the AIA-expanded definition of prior art, use or sale of an invention anywhere in the world, including in a foreign country prior to the effective date of an application, is deemed prior art.
- ***Patents issued based on applications filed on or after March 16, 2013 will be subject to post-grant review.*** Such proceedings are expensive and conservative estimates of the

cost to patentees, including one put forth by the USPTO, are in excess of $250,000.

In light of the above, there are several important steps that should be considered in the weeks leading up to March 16, 2013:

- ***Coordinate to have all planned patent applications filed on or before March 15, 2013.*** Since all applications filed on or before this date will receive the benefit of the current "first-to-invent" system, it will be important these next few weeks to make sure all applications originally slated to be filed before the new AIA provisions take effect are indeed filed by the deadline.
- ***Identify additional patent applications that should be filed on or before the deadline.*** If there is any current research or development that could be accelerated so that additional patent applications could be filed, it may be worthwhile to have these applications filed as well.
- ***Analyze currently pending patent applications for claim support.*** Applicants are encouraged to review and analyze claims of all patent applications filed before March 16, 2013 to confirm that each pending claim is adequately supported in each specification. If not, filing supplemental patent applications by the deadline may be another option to consider.
- ***Evaluate patent procedures to ensure timely consideration and filing.*** After March 16, 2013, the "first-inventor-to-file" structure places a premium on filing before someone else files or publishes. Accordingly, this is a good time to review and update patent procedures to ensure that potential filings are timely evaluated and filed.

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