

Going Forward After March 16, 2013: Succeeding in a First-Inventor-to-File System Under the AIA

2013-04-19

On March 16, 2013, the US officially moved from a first-to-invent to first-inventor-to-file system under the America Invents Act (AIA). In the wake of this well-publicized transition, new administrative requirements have been put in place and new patent procedures are available to applicants. In order to get ahead under the first-inventor-to-file system, new procedures for managing your patent portfolio should be considered:

- ***Develop and implement a system to coordinate and ensure timely review and filing of patent applications.*** The first-inventor-to-file structure places a premium on filing before anyone else files or publishes. Therefore, applicants (institutions, companies or individuals) should:
 - Develop a system for early identification of inventions as well as facilitate and streamline the patent drafting and filing process (including provisional applications);
 - While prompt patent filings are certainly recommended, avoid rushing too quickly to file, as this may result in applications with insufficient or narrow descriptions of the invention;
 - Put in place a set of checks and balances to ensure that applications have sufficiently detailed and robust descriptions; and
 - Work closely with patent counsel to make sure that they are applying the same level of ‘managed urgency’ to the patent filing process.
- ***Maintain transitional procedures to handle both AIA and pre-AIA filings.*** Although the March 16, 2013 date has passed, all pending applications filed before this date will still be examined according to the first-to-invent and pre-AIA prior art rules. Continuation or divisional applications filed on or 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 prior art mandated by the AIA. Therefore, transitional procedures should be established while the US Patent & Trademark Office (USPTO) continues to examine patent applications under both standards. For instance, applicants should:

- Track which pending patent applications were filed before March 16, 2013;
 - Maintain pre-AIA practices and procedures for these filings in conjunction with the new procedures for AIA filings; and
 - Keep these pre-AIA practices in place even after all pending applications have been granted (as continuation and divisional applications may still need to be filed).
- **Keep new filings under pre-AIA rules.** Although the new AIA standards are now in full effect, there are a few ways to keep some new filings under pre-AIA rules:
- File a patent application with claims that are directed to subject matter of a provisional patent application filed before March 16, 2013;
 - File a continuation or divisional application that claims only the subject matter disclosed in a parent application filed before March 16, 2013 (note: if there is even one claim that is not entitled to a pre-AIA filing date, then the entire application, and all children applications filed from this application, is assessed under AIA rules); and
 - Where the option to pursue under both systems exists, review prior art and disclosure activities relevant to the invention to determine whether it is advantageous or necessary to remain under pre-AIA review.
- **Monitor patent applications of competitors for potential third party prior art submissions.** Before enactment of the AIA, third parties (i.e., non-applicants) could only submit prior art in limited circumstances during the prosecution of a patent application and were not allowed to submit a description with the prior art or any other documents to the USPTO. Under the AIA regime, third parties are now permitted to submit prior art patents or publications for any pending patent application, regardless of its filing date. Third-party submissions have been expanded and must be filed before the earlier of: (1) the date of allowance, or (2) the later of six months after the date of first pre-grant publication or the date of a first office action rejecting any claim. With these submissions, third parties are also required to provide a “concise description of the asserted relevance of each submitted document.” Statements made by the patent applicant to the USPTO or in court filings may also be included as admissions or evidence of inconsistent positions taken by the applicant. Submission of third-party prior art may be a useful tool to ensure that the examiner considers all relevant prior art before granting a patent. However, the submission of prior art does not provide the same opportunities to discuss the prior art as would a post-grant proceeding or litigation. Consequently, companies should consider the following:
- Monitor the publication of competitors’ patent applications; and
 - Determine whether to submit relevant prior art publications and comments so that the USPTO may consider these during patent prosecution of these applications.
- **Make sure post-grant proceedings are filed with the USPTO within nine months of issuance.** Post-grant review is a new procedure that is most closely related to the present *inter partes* review. Unlike *inter partes* review, post-grant review allows the petitioner to request invalidation of a patent claim based on any basis for invalidity, including non-statutory subject matter (Section 101), lack of enablement or written description support (Section 112, 1st paragraph), and claim indefiniteness (Section 112, 2nd paragraph), and

even through the use of references other than patents or publications. Because post-grant review provides a strategically important, but time-limited, opportunity for third parties to invalidate their competitors' patents, companies should consider the following:

- Monitor the issuance of competitors' patents; and
- Determine within the time frame of the nine-month deadline from the patent's issue or reissue date whether to file for post-grant review of those patents.

— ***Modify and update record keeping procedures to prepare for new derivation***

proceedings. Derivation proceedings are a new form of *inter partes* proceeding that are available for all applications subject to the first-inventor-to-file provisions of the AIA.

Applicants seeking to prove derivation will need to establish that an alleged “inventor” of an earlier-filed application derived their invention from the true inventor who later filed their patent application. Therefore, applicants should consider the following:

- Maintain evidence of conception, reduction to practice, and records of witnesses who can corroborate such evidence; and
- Keep track of individuals who had access to the inventions prior to the patent application being filed on those inventions, as this information may be needed to show derivation.

In light of the changes that have taken place with the implementation of the AIA, innovators will want to take new steps to manage their patent portfolios as we move forward in the first-inventor-to-file system. [For additional information, the USPTO has released several videos and presentations as part of its program to educate examiners and the public.](#)

Authors

Mary Rose Scozzafava, PhD

RETIRED PARTNER

☎ +1 617 526 6000