

The Amazing Race to the Patent Office: New law will replace first-to-invent with first-to-file

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“The America Invents Act” will be up for vote before the United States Senate in September and is likely to be signed into law. If this happens, this legislation will bring significant changes to existing patent laws, and will align the United States with a more European approach to patents.

One of the most notable changes will replace “first-to-invent,” giving priority to the “first-inventor-to-file.” This change creates more of a race to the U.S. Patent Office by granting rights to the first person to *file* regardless of who may have first conceived the invention. This change may be problematic to individual inventors and smaller businesses that don’t have the time and financial resources or manpower to initiate the patent process as quickly as larger entities. If the America Invents Acts passes in September 2011, the “first-inventor-to-file” rule will be effective eighteen months after the date of enactment of this law, or March 2013.

Under existing law, an inventor has up to one year to file a patent application *after* the sale or offer of sale of the invention, the public use of the invention, or disclosure of the invention in a printed publication. This one-year grace period can allow the inventor and/or business additional time to refine the invention, raise funds and determine commercial viability before incurring the expense of preparation and filing of a patent application.

When the proposed legislation becomes law, an inventor or business owning an invention may be barred from obtaining a patent if the patent application is not filed before the invention is offered for sale, described in a printed publication, used publicly or otherwise available to the public. The inventor may obtain a one-year grace period by “publicly disclosing” the invention. However, such public disclosure will likely limit the inventor’s rights to obtain patent protection in other countries.

An inventor can protect his or her rights by filing a provisional patent application. The preparation and filing of the provisional patent application should cost significantly less than a non-provisional patent application and its timely filing can establish a first effective filing date for a later filed non-provisional patent application. Multiple subsequent provisional patent applications can be filed as the inventor adds additional features, refinements and applications; however, the non-provisional patent application covering the complete invention must be filed within 12 months from the date the provisional application was initially filed.

It is critically important that an inventor and/or a business that owns potential inventions to maintain the secrecy of the invention and, without delay, work with their patent attorneys to prepare and timely submit a provisional patent application(s) on their inventions.