



MBHB *snippets* Alert

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Preparing for the Final Phase of the America Invents Act Going Into Effect March 16, 2013

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The final phase of the America Invents Act (AIA) takes effect on March 16, 2013. This means that any patent application filed in the U.S. *on or after* that date, which, at any time during its pendency, contains a claim that is not fully supported in an application filed before March 16, 2013, will be subject to the new first-inventor-to-file rules under the AIA. As a result of this imminent change in U.S. patent law, it is recommended that companies consider including the following options:

1. If you have any disclosures or any new continuing applications that you are considering filing, and you believe such disclosures or continuing applications might benefit from the current (first-to-invent) regime as opposed to the new (first-inventor-to-file) regime, it is recommended that you provide those to your prosecution counsel as soon as possible with instructions to file those applications before March 16, 2013.
2. At the very least, it is recommended that you consider having your prosecution counsel file provisional applications in order to establish a priority date prior to March 16, 2013. To the extent a provisional application provides support under 35 U.S.C. § 112, it can help you secure an effective filing date before March 16, 2013. *But note: for the special case of an application filed on or after March 16, 2013 that claims priority to an application filed before March 16, 2013, the application filed on or after March 16, 2013 will not be entitled to consideration under the current, first-to-invent law if it contains, or contained at any time, a claim that is not fully supported by the priority application filed before March 16, 2013. Consequently, a provisional application filed before March 16, 2013 might be of little value if it does not fully support all of the claims in an application filed on or after March 16, 2013.*

3. It is also recommended that you talk with your prosecution counsel to discuss your filing expectations. Since independent development by someone else who files before your filing can result in loss of rights, you may want to consider how quickly an application should be filed.
4. Even after March 16, 2013, time-sensitive applications may benefit from the filing of one or more provisional applications. One option to consider would be for your prosecution counsel to file a provisional application submitting the original invention disclosure. Alternatively (or in addition) your prosecution counsel could file a provisional application upon receipt of sufficient disclosure details from the inventors, submitting a synopsis of the clarified disclosure, and perhaps submit a partial or full set of claims, if available.
5. After March 16, 2013, you may also want to give serious consideration in some situations to filing two parallel applications, with one application claiming no more than what is expressly supported by a pre-March 16, 2013 application (or a provisional application filed on or after March 16, 2013), and the second application claiming any additional subject matter.
6. New first-inventor-to-file rules are about to be issued by the PTO. You may want to keep any eye out for them.
7. Finally, if you have not done so already, it is recommended that you advise your scientists and engineers about the AIA and the new first-inventor-to-file rules. Clearly, the time to file an application will depend on how quickly your prosecution counsel receives: (i) a complete disclosure of all information that is required to file an application, and (ii) final review and approval by your inventors.

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