

February 20, 2013



Final Rules for Implementing the First-Inventor-to-File Provisions of the America Invents Act

The transition to the first-inventor-to-file (FITF) system occurs on March 16, 2013. To prepare for implementing the change to the FITF system, the United States Patent and Trademark Office (USPTO), on February 14, 2013, published the final rulemaking entitled "Changes To Implement the First Inventor To File Provisions of the Leahy-Smith America Invents Act" (hereinafter, final rules) in the Federal Register (78 Fed. Reg. 11024).

The change to the FITF system applies to all applications filed on or after March 16, 2013 that contain or contained at any time (1) a claimed invention that has an effective filing date that is on or after March 16, 2013 or (2) claimed the benefit of a US nonprovisional application or an international application (i.e., under 35 U.S.C. §§ 120, 121, or 365(c)) that contains, or contained at any time, a claimed invention that has an effective filing date that is on or after March 16, 2013.

The final rules cover three major topics: (1) a new timing requirement for submitting a certified copy of foreign priority documents; (2) required statements for applications filed on or after March 16, 2013 claiming priority to, or the benefit of, an application filed before March 16, 2013; and (3) affidavits or declarations of attribution or prior public disclosure. The final rules differ slightly from the proposed rules published on July 26, 2012 as noted below.

Timing Requirement for Submitting Certified Copies of Foreign Priority Documents

The final rules require that applicants provide a certified copy of foreign applications to which an application claims priority in a specific time period. In particular, the USPTO amended 37 C.F.R. § 1.55 to specify that in an original application filed under 35 U.S.C. § 111(a), which claims priority to a foreign application, the applicant must file the claim for priority, as well as the certified copy of the foreign application, within the later of:

- (1) four months from the actual filing date of the application or
- (2) sixteen months from the filing date of the prior foreign application.

Applicants can use the priority document exchange program with the European Patent Office, the Japan Patent Office, the Korean Intellectual Property Office, and the World Intellectual Property Organization in fulfilling the requirement for certified copies of foreign priority documents.

The final rules also provide that the requirement for the certified copy of foreign priority documents will be considered satisfied if the applicant:

- (1) files an uncertified copy of the foreign application labeled as "Interim Copy" within the time period specified above; and
- (2) files a certified copy of the foreign application before the patent issues.

Required Statements for Applications Filed on or After March 16, 2013 Claiming Priority to, or the Benefit of, an Application Filed Before March 16, 2013

The final rules (37 C.F.R. §§ 1.55 and 1.78) require that if a nonprovisional application filed on or after March 16, 2013:

- (1) claims the priority/benefit of the filing date of a foreign, provisional, or non-provisional application filed before March 16, 2013 and
- (2) also contains, or contained at any time, a claim to a claimed invention that has an effective filing date on or after March 16, 2013,

then the applicant must provide a statement to that effect within the later of:

- (a) four months from the actual filing date of the later-filed application,
- (b) four months from the date of entering the US national phase,

- (c) sixteen months from the filing date of the prior-filed application, or
- (d) the date that a first claim to a claimed invention that has an effective filing date on or after March 16, 2013 is presented in the application.

The USPTO requires applicants to make such a statement when the above conditions are met to aid patent examiners in determining whether the “first-to-invent” system or the FITF system applies to applications filed on or after March 16, 2013. The USPTO will revise the application data sheet to provide a box for applicants to check to make such a statement.

The final rules do not require that the statement specify which claims have an effective filing date on or after March 16, 2013. Also, the final rules did not adopt the proposed rule that if an application filed on or after March 16, 2013 contains unclaimed subject matter not disclosed in a priority/benefit application filed before March 16, 2013, then the applicant must make a statement to that effect.

Affidavits or Declarations of Attribution or Prior Public Disclosure

The USPTO greatly simplified the language 37 C.F.R. § 1.130 in the final rules (in comparison to the proposed rule) to provide for two types of affidavits or declarations: attribution or prior public disclosure. These affidavits or declarations provide a mechanism for disqualifying a disclosure as prior art due to an exception under 35 U.S.C. § 102(b) as amended by the AIA. As such, either type of affidavit or declaration will only be available for overcoming a rejection based on a disclosure made one year or less before the effective filing date of the invention.

An affidavit or declaration of attribution is appropriate to disqualify a disclosure as prior art when the applicant wishes to establish that (1) the disclosure was made by the inventor or (2) the subject matter disclosed was obtained directly or indirectly from the inventor.

The USPTO also amended 37 C.F.R. § 1.77 to provide for a section entitled “Statement regarding prior disclosures by the inventor or a joint inventor” in the specification of the application. Inclusion of a statement concerning such a disclosure in the specification should expedite prosecution if the statement has sufficient information (e.g., it provides a satisfactory showing that the inventor or a joint inventor is in fact the inventor of the subject matter of the disclosure) so that it is not necessary for the USPTO to issue a rejection based on such a disclosure.

An affidavit or declaration of prior public disclosure is appropriate to disqualify a third party's disclosure as prior art in situations where, prior to the third party's disclosure, the subject matter had been publicly disclosed by (1) the inventor or (2) another who obtained the subject matter disclosed directly or indirectly from the inventor. In such an instance, the affidavit or declaration must identify the subject matter publicly disclosed and the date of the public disclosure. Also, the affidavit or declaration must (1) include a copy of the subject matter publicly disclosed if it was disclosed in a printed publication on that date or (2) describe the subject matter with sufficient detail and particularity to determine what subject matter was publicly disclosed on that date if it was not disclosed in a printed publication.

Potential Strategies and Practice Tips

If you have a provisional or foreign application pending and need to add subject matter when filing a nonprovisional application, consider filing the nonprovisional application before March 16, 2013 so that the nonprovisional application is not subject to the FITF system and the requirements of the final rules. Similarly, if you have a continuation-in-part application (CIP) to file, consider filing the CIP application before March 16, 2013. However, in certain circumstances, the FITF system may provide benefits due to its broader “commonly owned” and CREATE Act provisions.

Make changes to your docketing system to include reminders for (1) filing a certified copy of foreign priority documents within the required time period and (2) making any necessary statements for applications filed on or after March 16, 2013 claiming priority to, or the benefit of,

an application filed before March 16, 2013.

For applications filed on or after March 16, 2013, consider whether it is worthwhile making a statement regarding any public disclosures an inventor made regarding the claimed invention a year or less before the effective filing date of the claimed invention in order to expedite prosecution and avoid a rejection based on the disclosure.

For more information, please contact:

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