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*Practice Group(s):
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Major Patent Law Changes: First-to-File Provisions – Effective March 16, 2013

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On Saturday, March 16, 2013, the “first-inventor-to-file” provisions of the Leahy-Smith America Invents Act (“AIA”) go into effect.¹ These provisions replace the current “first-to-invent” system. In addition to various other changes, under the new system, the universe of references and activities which can be used as prior art will expand. For example, certain foreign patent applications and activities occurring in other countries that did not previously constitute prior art will become available as prior art under the new rules.

Now is a good time to start planning for the changes in March by reviewing patent portfolios and invention disclosures. As a hedge against the uncertainty associated with the new provisions, it may be worthwhile to evaluate draft applications and pending provisional applications, and to prioritize invention disclosures so that non-provisional applications can be filed before March 16, 2013, if circumstances warrant.

As a general matter, when evaluating invention disclosures and patent filings in the months leading up to the March 16, 2013 transition date, care should be taken to evaluate the costs and benefits associated with taking action now or proceeding with business as usual. Depending on the nature of a particular invention and knowledge regarding the state of the prior art, the changes under the AIA may be a non-event for some applicants. That said, given that the window to take action is shrinking, it is worthwhile to undertake a review at this time rather than wait until the AIA provisions take effect.

Patentability and Prior Art Changes

After March 16, 2013, 35 U.S.C. § 102(a) will establish two bases for which an applicant is not entitled to a patent. First, under 35 U.S.C. § 102(a)(1), an applicant will not be entitled to a patent if the claimed invention was patented, described in a printed publication, or in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention. Second, under 35 U.S.C. § 102(a)(2), an applicant will not be entitled to a patent if the claimed invention was described in a U.S. patent or in a published U.S. patent application which names another inventor and has an effective filing date preceding the effective filing date of the claimed invention.²

As a result of the new provisions going into effect, a prior art disclosure cannot be disqualified or antedated by showing that the inventor invented the claimed invention before the effective date of the prior art disclosure of the subject matter (*e.g.*, under the provisions of 37 CFR 1.131). Accordingly, using the date of conception to overcome a reference will no longer be an option.

The AIA revisions to 35 U.S.C. § 102 also eliminate the current requirement that a prior art activity be a prior public use or sale “in this country.” Therefore, 35 U.S.C. § 102(a) as amended by the AIA expands the prior art available against an application by including a public use or sale in a foreign country.

¹ Pub. L. 112–29, 125 Stat. 284, 288 (2011).

² See *Id.* at 285–86.

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As a result, a public disclosure, in the United States or abroad, before the filing of an application will be available to attack patentability, save for the exceptions, discussed below.

35 U.S.C. § 102(b) – the exceptions to 35 U.S.C. § 102(a)

Various exceptions to the post-AIA 35 U.S.C. § 102(a) are available. First, 35 U.S.C. § 102(b)(1) provides exceptions to 35 U.S.C. § 102(a)(1). Specifically, 35 U.S.C. § 102(b)(1) provides that a public disclosure made one year or less before the effective filing date of a claimed invention is not prior art if the disclosure was made by an inventor of the claimed invention or by another who obtained the subject matter disclosed directly or indirectly from an inventor (hereinafter “a direct or indirect inventor disclosure”). In addition, a public disclosure made one year or less before the effective filing date of a claimed invention is not prior art if the subject matter disclosed had, before such disclosure, been publicly disclosed in a direct or indirect inventor disclosure.³

Second, 35 U.S.C. § 102(b)(2) provides exceptions to 35 U.S.C. § 102(a)(2). One of these exceptions provides that U.S. patents and published U.S. patent applications are not prior art if the subject matter disclosed by the reference was obtained directly or indirectly from an inventor. Another exception provides that U.S. patents and published U.S. patent applications are not prior art if, before the effective filing date of the reference, the subject matter disclosed by the reference had been publicly disclosed in a direct or indirect inventor disclosure.⁴

The proposed examination guidelines indicate that these exceptions will be narrowly applied. In the absence of finalized guidelines, which are expected in February 2013, we recommend taking a conservative approach when making filing decisions before the March 16, 2013 transitional date.

Effective Date of Prior Art

35 U.S.C. § 102(d) as amended by section 3 of the AIA provides a definition for “effectively filed” for purposes of determining prior art. 35 U.S.C. § 102(d) establishes that the effective filing date of a U.S. patent or a published U.S. patent application is the actual filing date or the filing date of the earliest application to which the reference is entitled to claim a right of priority under 35 U.S.C. §§ 119, 120, 121, or 365, if the priority application describes the subject matter.⁵

35 U.S.C. § 119 provides priority for a U.S. application to an application filed in a foreign country which affords similar privileges in the case of applications filed in the United States or to citizens of the United States, or in a WTO member country.⁶ Therefore, 35 U.S.C. § 102(d) as amended by the AIA expands the prior art available against an application by making a U.S. patent publication prior art as of its effective filing date in a foreign country. Such references were previously excluded from being prior art by the *Hilmer* doctrine under which a foreign filing date under 35 U.S.C. § 119 could not be used to establish an effective prior art date under 35 U.S.C. § 102(e).⁷

³ See 125 Stat. at 286.

⁴ See 125 Stat. at 286.

⁵ See 125 Stat. at 286–87.

⁶ See 35 U.S.C. § 119(a).

⁷ See *In re Hilmer*, 359 F.2d 859 (C.C.P.A. 1966) and *In re Hilmer*, 424 F.2d 1108 (C.C.P.A. 1970).

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Applications Subject to the AIA

Patent applications filed before March 16, 2013 are subject to the pre-AIA version of 35 U.S.C. § 102.⁸ All patent applications filed on or after March 16, 2013 that do not claim priority to an earlier filed application are subject to the post-AIA version of 35 U.S.C. § 102. Any patent application that contains or contained at any time a claimed invention that has an effective filing date that is on or after March 16, 2013 is governed by the post-AIA version of 35 U.S.C. § 102.⁹

If a claim in an application has an effective filing date on or after March 16, 2013, the AIA amendments to 35 U.S.C. § 102 apply in determining the patentability of every claim in the application.¹⁰ As a result, for provisional applications pending now and converted to non-provisional applications on or after March 16, 2013, there is a risk that such applications will be examined under the post-AIA provisions if the effective filing date of at least one of the claims is determined to be on or after March 16, 2013.

Conclusion

The changes to 35 U.S.C. § 102 in the AIA expand the prior art available against an application. They also remove the ability to disqualify a prior art disclosure by showing that the inventor invented before the effective date of the prior art disclosure. In addition, the AIA exceptions to the new provisions of 35 U.S.C. § 102(a) may be interpreted narrowly by the United States Patent and Trademark Office.

In view of the foregoing and the uncertainty of when the AIA first-to-file provisions will be applied to an application as a function of the effective filing date of its claims, it may be worthwhile to evaluate new invention disclosures and any pending or unfiled patent applications now to assess whether or not they may be prejudiced by the new provisions coming into effect on March 16, 2013.

⁸ See 125 Stat. at 293.

⁹ See 125 Stat. at 293; see also 77 Fed. Reg. 43759, 43772-73 (July 26, 2012).

¹⁰ See 125 Stat. at 293; see also 77 Fed. Reg. 43759, 43773 (July 26, 2012).

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