

America Invents Act

Preparing for First Inventor to File ("FITF") Practice Tips

Review provisional and foreign applications filed on or after March 16, 2012

If there is new subject matter to be added before filing a nonprovisional application, consider if it is advantageous to file the nonprovisional application with the new subject matter (1) before March 16, 2013 and claim priority/benefit or (2) on or after March 16, 2013 and not claim priority/benefit.

Considerations for New Filings

As March 16, 2013 approaches, consider whether it is more advantageous to (1) file before March 16, 2013 and be subject to pre-AIA 102 or (2) file on or after March 16, 2013 and be subject to AIA 102.

- Pre-AIA 102 has a smaller prior art universe:
 - AIA 102 expands the scope of prior art to include public use or sales outside the US.
 - Under AIA 102, patents and published patent applications are available as prior art as of their earliest filing date (this includes the foreign filing date).
- Pre-AIA 102 has a broader grace period; the grace period for AIA 102 is a personal grace period for the inventor.
- AIA 102 has advantageous common ownership/joint research agreement provisions:
 - Under AIA 102, the common ownership provisions apply to anticipation rejections under § 102 and obviousness rejections under § 103 (rather than just obviousness rejections under § 103).
 - Under AIA 102, the common ownership provisions are based on the time of filing the application (rather than the time of the invention).
- Applications that have only contained claims subject to AIA 102 will have no recourse to interference proceedings to demonstrate the applicant was the first to invent.

Other Practice Tips to Consider

- Consider if any CIP applications need to be filed before March 16, 2013.
- If an application is subject to pre-AIA 102, then keep notes on subject matter that is added to continuing applications filed on or after March 16, 2013.
- If possible, try to avoid relying on AIA 102(b) exceptions.
- Keep records of public disclosures made before filing a patent application (and during the time period between filing a provisional and a nonprovisional).
- For the present, continue to require laboratory notebooks.

Patent Application Process

Entities that have optimized their processes for filing a patent application will have an advantage in the FITF world. To optimize your process:

- Capture inventions in-house as soon as possible;
- Timely review invention disclosures and decide whether to file a patent application;
- Employ an efficient process for drafting applications (including all communications and review); and
- Quickly approve and file applications.

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