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

Section 3 of the America Invents Act (AIA) amended the patent laws, in particular 35 U.S.C. § 102, to convert the United States patent system from a "first-to-invent" system to a "first-inventor-to-file" (FITF) system. To prepare for implementing the change to the FITF system, on July 26, 2012 the United States Patent and Trademark Office (USPTO) published a notice of proposed rulemaking (hereinafter, proposed rulemaking) entitled "Changes To Implement the First Inventor To File Provisions of the Leahy-Smith America Invents Act" (hereinafter, proposed rulemaking) in the Federal Register (77 Fed. Reg. 43742). Comments on the proposed rulemaking can be submitted to the USPTO on or before October 5, 2012.

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 proposed rulemaking covers 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) submission of affidavits or declarations for establishing that a 102(b) exception is applicable.

Timing Requirement for Submitting Certified Copies of Foreign Priority Documents

In the proposed rulemaking, the USPTO proposes a requirement that a certified copy of foreign applications to which an application claims priority be provided in a specific time period. In particular, the USPTO proposes to amend 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 claim for priority, as well as the certified copy of the foreign application, must both be filed 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.

In an application entering the US national stage from an international application after compliance with 35 U.S.C. § 371, the claim for priority must be made, and a certified copy of the foreign application filed, within the time limit set forth in the Regulations under the PCT (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 requirement will be considered satisfied if the applicant:

- (1) files a request, in a separate document, that the USPTO obtain a copy of the foreign application from a foreign intellectual property office participating in the priority document exchange program;
- (2) the foreign application is identified in an application data sheet; and

- (3) the copy of the foreign application is received by the USPTO within the required time period or by such later time as may be set by the USPTO.

USPTO form SB/38 is currently available for requesting that the USPTO obtain the necessary certified copies and contains the caveat that it is ultimately an applicant's responsibility to make sure the USPTO retrieves the necessary certified copies.

Previously the certified copy of the foreign application could be filed up until the grant of the patent. The USPTO seeks to make these changes since patent application publications will have a prior art effect as of the earliest priority date (for subject matter disclosed in the priority application) with respect to applications subject to 35 U.S.C. § 102, as amended by the AIA, in order to ensure the USPTO has a copy of the priority application by the time of publication.

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

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 proposes requiring certain statements be made when the application claims priority to, or the benefit of, an application filed before March 16, 2013. In particular, the USPTO proposes to amend 37 C.F.R. §§ 1.55 and 1.78 to include the requirement for the statements by an applicant.

The USPTO proposes to require that if a nonprovisional application filed on or after March 16, 2013:

- (1) claims the 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.

Also, the USPTO proposes that if a nonprovisional application filed on or after March 16, 2013:

- (1) claims the benefit of the filing date of a foreign, provisional, or nonprovisional application filed before March 16, 2013 and
- (2) does not contain a claim to a claimed invention that has an effective filing date on or after March 16, 2013, but discloses subject matter not also disclosed in the prior-filed application,

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, or
- (c) sixteen months from the filing date of the prior-filed provisional application.

The proposed rules do not require that these statements specify which claims have an effective filing date on or after March 16, 2013 or what subject matter was not disclosed in the prior application. The USPTO also notes in the proposed rulemaking that if an applicant files an untimely statement, or retracts a previously made statement, then the USPTO may issue a requirement for information under 37 C.F.R. § 1.105 pointing out support for the claims having an effective filing date prior to March 16, 2013 in the prior application(s) filed before March 16, 2013.

Submission of Affidavits or Declarations for Establishing That a 102(b) Exception is Applicable

The proposed rulemaking proposes changes to 37 C.F.R. § 1.130 to provide a mechanism for filing an affidavit or declaration to establish that a disclosure is not prior art due to an exception under 35 U.S.C. § 102(b) as amended by the AIA. Thus, 37 C.F.R. § 1.130 will only be applicable for applications subject to the FITF system. In addition, 37 C.F.R. § 1.130 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. The existing provisions of 37 C.F.R. § 1.130 are proposed to be moved to 37 C.F.R. § 1.131. Affidavits or declarations under 37 C.F.R. § 1.131 would then apply to applications for patent (and patents issuing thereon) that are subject to 35 U.S.C. § 102 in effect on March 15, 2013 (the “first-to-invent” system).

There are three categories of disclosures that can be overcome by establishing the disclosure is not prior art due to an exception under 35 U.S.C. § 102(b). The first category includes rejections based on disclosures made by an inventor. In such an instance, the affidavit or declaration must provide a satisfactory showing that the inventor is in fact the inventor of the subject matter of the disclosure. The USPTO notes that the satisfactory showing should be in line with the *In re Katz* decision. The USPTO also notes that if the disclosure includes additional authors, not named as an inventor on the application, a reasonable explanation for the presence of the non-inventor author should be included.

The USPTO also proposes to amend 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.

The second category includes rejection based on disclosures made by a non-inventor who obtained the subject matter disclosed directly or indirectly from an inventor. In such instances, the affidavit or declaration must provide a satisfactory showing that an inventor is the inventor of the subject matter of the disclosure (this is the same showing needed for the first category of disclosures discussed above) as well as provide a showing that an inventor directly or indirectly communicated the subject matter of the disclosure to the non-inventor. The USPTO indicates that the direct or indirect communication of the subject matter of the disclosure to the party must be sufficient to enable one of ordinary skill in the art to make the subject matter of the claimed invention.

The third category includes rejections based on disclosures by another made after a public disclosure of the subject matter by an inventor or a non-inventor who obtained the subject matter publicly disclosed from an inventor. In such instances, the affidavit or declaration must identify and provide the date of the earlier disclosure of the publicly disclosed subject matter. If the earlier disclosure was a printed publication, then a copy of the printed publication must accompany the affidavit or declaration. If the earlier disclosure was not a printed publication, then the affidavit or declaration must describe the earlier disclosure with sufficient detail and particularity to determine that the earlier disclosure is a public disclosure of the subject matter. In addition, if an inventor made the earlier public disclosure of the subject matter, then the showing required for the first category of disclosures discussed above must also be provided in the affidavit or declaration. Also, if a non-inventor made the earlier public disclosure of the subject matter after obtaining the subject matter directly or indirectly from an inventor, then the showings required for the second category of disclosures discussed above must also be provided in the affidavit or declaration.

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 proposed rulemaking. Similarly, if you have a continuation-in-part application (CIP) to file, consider

filing the CIP application before March 16, 2013.

For applications filed on or after March 16, 2013 claiming priority to a foreign application, consider requesting that the USPTO obtain the certified copy of the foreign application under the priority document exchange program, if available.

Start to 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 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, or if you have comments on the proposed rulemaking that you would like us to submit to the USPTO by the deadline of October 5, 2012, please contact:

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