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

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On February 14, 2013, the USPTO published its final rules to implement provisions of the Leahy – Smith America Invents Act (AIA), effective March 16, 2013. The USPTO also published examination guidelines that provide the USPTO's interpretation of the final rules. The final USPTO rules with respect to the grace period significantly differ from the original USPTO proposal, which would have significantly narrowed its protections.

Under the first inventor to file system, a broader scope of prior art may be available against a patent application. For example, citable prior art may include patents, printed publications, and US or PCT applications that designate the US prior to the effective filing date. Further, prior art related to public use or sale is no longer limited to the United States, and can be anywhere in the world, prior to the effective filing date.

The first inventor to file system applies to patent applications having an effective filing date on or after March 16, 2013. Additionally, if a patent application with an actual filing date on or after March 16, 2013 includes all claims ever presented in the application with an effective filing date prior to March 16, 2013, examination will be conducted under the first to invent system. Applications filed prior to March 16, 2013 will be examined under the first to invent system.

Under the grace period provisions, if a third-party discloses the claimed invention one year or less before the effective filing date, that third-party disclosure cannot be used as prior art against a patent application, if the inventor publicly disclosed the subject matter prior to the third party's disclosure. Further, the applicant can be protected from having their own disclosure used against them, even if made by a joint inventor or another who obtained the subject matter directly or indirectly from the inventor or joint inventor.

The new rules require submission of certified priority documents within the later of either 4 months from the actual filing date of US application, or 16 months from the filing date of the prior foreign patent application, except where a priority document exchange agreement is in effect. Further, the new rules require applicants to provide a statement for applications filed on or after March 16, 2013 which claim priority to a pre-March 16, 2013 application, if applicant reasonably believes that such an application contains or contained at any time the claim having an effective filing date on or after March 16, 2013.

Applicants are encouraged to review and understand the new rules, and to consider their filing options with respect to the benefits and demerits. Accordingly, applicants should consider whether it would be beneficial to file a patent application under the first to invent system, which may include a US utility application, the US provisional application, a PCT application, or even a foreign application if certain conditions are met. Applicants may also want to consider appropriate disclosure policies with respect to the grace period.

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Miku H. Mehta's practice focuses on the preparation and prosecution of patent applications before the USPTO. Mr. Mehta has also worked on due diligence projects, including preparation of opinions in the areas of patentability, validity, infringement, and product clearance, as well as patent licensing. His areas of focus include the technology field such as computer software and hardware, networks, Internet-related application, environmental technologies, optics, mechanical engineering, business processes, and medical devices.