

PROPOSED U.S. PTO FIRST-INVENTOR-TO-FILE RULES IN COMPLIANCE WITH THE AMERICA INVENTS ACT: A SUMMARY

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We hope you enjoy the rest of your summer!

The America Invents Act (AIA, signed into law on September 16, 2011) amends the laws of patentability in order to convert the United States from a “first to invent” system to a “first-inventor-to-file” system. The U.S.PTO has proposed rules on July 26, 2012 in order to amend the rules of practice in patent cases to implement the changes to the conditions of patentability in the AIA. These rule changes become effective on March 16, 2013.

Prior Art under 35 U.S.C. § 102:

The AIA expands the scope of materials considered prior art during examination. Section 102(a) has been amended so that claims are now subject to rejection by evidence of a prior public use or sale of the invention anywhere in the world, rather than just in the United States. Section 102(b) as amended by the AIA provides for certain exceptions to the provisions of section 102(a). For example, section 102(b) provides for a “grace period” for disclosures made by an inventor or joint inventor within one year of the effective filing date of a claimed invention. This means that an inventor may still file a patent application within one year after publicly disclosing the invention, without having the disclosure be used as prior art. The U.S.PTO Examination Guidelines provides that the one-year grace period is measured from the earliest U.S. or foreign patent application to which the patent or application is entitled to claim the benefit of priority, whereas the one-year grace period in pre-AIA section 102(b) is measured from only the earliest application filed in the United States.

The U.S.PTO Examination Guidelines further indicates that the grace period will be largely limited to disclosures made by the inventors of an application and will not extend to third-party disclosures. The U.S.PTO’s proposed rules provide for “the submission of affidavits or declarations showing that: (1) [a] disclosure upon which a claim rejection is based was by the inventor or joint inventor or by a party who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor; or (2) there was a prior public disclosure by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or joint inventor.”

The AIA also provides for U.S. patents and U.S. patent application publications to be treated as prior art as of their earliest effective filing date regardless of whether the earliest effective filing date is based on an application filed in the United States or in another country. The U.S.PTO proposed rules provide “for the situation in which a U.S. patent or U.S. patent application publication has a prior art effect as of the filing date of a foreign priority application by requiring that the certified copy of the foreign application be filed within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior foreign application.”

The AIA in section 102(a)(1) provides for a “catch all” provision, which defines a new additional category of potential prior art not provided for in pre-AIA section 102. Now, a claimed invention cannot be patented if it was “otherwise available to the public” before its effective filing date. This provision allows Examiners to focus on whether the disclosure was available to the public, rather than on whether the disclosure falls within a category listed in section 102 such as “printed publication.” Some examples of information “available to the public” provided in the U.S.PTO Examination Guidelines include a student thesis in a university or a poster display at a scientific meeting.

For U.S. nonprovisional patent applications filed on or after March 16, 2013 that claims the benefit of a filing date prior to March 16, 2013 of a foreign, U.S. provisional, or U.S. nonprovisional application, the U.S.PTO proposes the following requirements:

[1] If such a nonprovisional application contains at any time a claim to a claimed invention that has an effective filing date on or after March 16, 2013, the applicant must provide a statement to that effect...[and]

[2] if such a nonprovisional application 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 foreign, provisional, or nonprovisional application, the applicant must provide a statement that the application includes subject matter not disclosed in the foreign, provisional, or non-provisional application.

The above-mentioned statements must be filed within a specified deadline. In other words, a U.S. patent application, filed on or after March 16, 2013 that claims the benefit of the filing date of an earlier filed patent application filed before March 16, 2013, should have its claims and specification supported by the earlier filed application; otherwise, the above-described statement must be filed in a timely manner. The above requirements will permit the U.S.PTO “to readily determine whether the nonprovisional application is subject to the changes to 35 U.S.C. 102 and 103 in the AIA.”

Prior Art Under U.S.C. § 103:

The AIA amends section 103 to provide that a patent for a claimed invention may not be obtained if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains. The U.S.PTO Examination Guidelines reiterates that the critical time for a section 103 rejection has been shifted from “the time that the invention was made” (as was the case in pre-AIA section 103) to “the effective filing date of the claimed invention.”

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