America Invents Act First Inventor to File Transition

PUBLISHED ON
March 12, 2013

The America Invents Act ("AIA") was patent legislation signed into law in 2011, but has been phased into action over an 18 month period. The most important aspect of this legislation, a transition from a "first to invent system" to a "first inventor to file system", will take effect on March 16, 2013.

Under the first to invent system (old system), the right to a patent for a given invention generally lies with the date of conception, as long as inventor was diligent in reducing the concept to practice. As a result, inventors were protected under the old system from subsequent applicants, even if they had not filed a patent application, because the inventor could use the date of conception to pre-date the other applicants.

Under the first inventor to file system (new system), a patent will be awarded to the first inventor to file a patent application, regardless of an actual date of conception and/or reduction to practice. While the AIA protects an inventor from a patent applicant who derives subject matter directly from the inventor's work, that inventor is not protected from a wholly independent second inventor having the same patentable subject matter in an application that is filed first. As a result, the wholly independent second inventor can exclude the original inventor from practicing that invention, such as making, using, selling, or distributing the patented invention without permission.

The AIA also changes certain patentability requirements. While a patent application must still meet the old system's requirements of novelty and non-obviousness with respect to prior art, the scope of applicable prior art will be much more broad. Under the old system, the inventor could rely on the date of conception as the critical date to pre-date any prior art that was introduced between then and the filing of the patent application. Under the new system, the critical date will not be the date of conception, but the day the patent application is filed. As a result, the new system introduces an expansion of prior art that can be used against the patent applicant.

The first inventor to file system does provide a grace period for disclosure. For instance, an inventor is permitted to publicly disclose their invention and still file a patent application within one year of the disclosure. This disclosure would not be considered prior art against the inventor's patent application, but could count as prior art against subsequent inventors applying for a patent on the same invention. Therefore, there may be advantages in publicly disclosing your invention prior to filing.

Starting March 16, 2013, timing is of the essence in filing patent applications and issuing disclosures of your inventions. Inventors and/or applicants will need to act quickly to identify their inventions and decide if they want to seek patent protection. If so, then it may be important to promptly file a patent application sooner than one would have under the old system. However, this should be done with a purpose, meaning that the patent application should identify what really needs to be protected (i.e. will it be the commercial embodiment). Even

if different iterations of the invention have not yet been conceived, it may be necessary to first file an application directed to the first conception and then file continuations off the first application. Alternatively, there may be situations where a public disclosure is recommended first, and then file a patent application within one year of the disclosure.

Accordingly, potential patent applicants should discuss their options with patent counsel sooner than one would have under the old system, as the new first to file system will certainly affect patent filing strategies and how technology agreements are handled.

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