

Shifting Strategies: Public Disclosure Under the AIA

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The final phase of the America Invents Act ("AIA") was implemented on March 16, 2013, and marked the end of the transition from the old first inventor to invent system to the new first inventor to file system. This monumental change has far reaching implications concerning the role of public disclosure, and may require future patent applicants to shift their overall patenting strategies.

Under the pre-AIA's first to invent system, the critical date for determining what constituted prior art was the date of conception of the invention. The inventor could rely on the date of conception of the invention to antedate intervening prior art by "swearing back" to the conception date. Additionally, inventors had a 12 month grace period exception before they filed their patent applications, where they could publically disclose their invention, without the disclosure becoming prior art against themselves.

Under the AIA, an inventor is entitled to a patent unless the claimed invention is already patented, described in a printed publication, or in public use, on sale, or otherwise available to the public before the *effective filing date*. The critical date for applicants has now become the effective filing date, not the date of conception. The effective filing date is the date on which a patent application is filed. A public disclosure before the effective filing date becomes prior art against the applicant's invention, unless subject to an exception, regardless of when the applicant conceived of the invention.

However, similar to the old system, the AIA also provides a 12 month grace period exception, whereby inventors can publically disclose their inventions and still be permitted to file patent applications. Provided the inventor's disclosure was made within the grace period, it will not be counted as prior art against the inventor. However, the inventor's disclosure can serve as prior art against other inventors applying for a related patent. Importantly, the grace period exception only applies to disclosures made by the inventor, or disclosures by another who obtained the subject matter from the inventor. The grace period exception does not apply to disclosures made by independent third parties. Disclosures by independent third parties made prior to the effective filing date will still count as prior art against the inventor.

The rules for what constitutes a patented or printed publication have remained the same. Under both the old and new systems, any patent or printed publication anywhere in the world can serve as prior art. However, public use and on sale definitions have greatly expanded. Under the old system, public use and on sale could only serve as prior art if they occurred *in the US*. Under the AIA, the definition has been expanded to include anywhere in the world. Additionally, prior art has been expanded to include any disclosures *otherwise available to the public*, encompassing any form of public disclosure.

Consequently, there may be strategic advantages to publically disclosing an invention prior to filing a patent application, with the first being that they are more cost effective than filing a provisional patent application and very

cost effective compared to filing a non-provisional patent application. An inventor merely has to make the information accessible to the public. The second is that the inventor can choose the timing and method of disclosure in an offensive or defensive manner, based on the competitive landscape. No form or content requirements exist for a public disclosure, so inventors are free to choose the most advantageous method for their situations.

A number of disadvantages accompany public disclosures. Any public disclosure will trigger the 12 month grace period, so the invention needs to be at a stage whereby a patent application can be filed with a broad enough scope to offer meaningful protection. Additionally, a public disclosure precludes the ability to pursue a trade secret strategy, and will eliminate obtaining patents in many foreign countries that prohibit filing a patent application if the invention has been disclosed publically anywhere before the patent application is filed.

Another problematic issue is that the prior art generated against competitors from a public disclosure is limited to the scope of the disclosure. In evaluating a patent application, the subject matter of the first inventor's public disclosure and the subject matter of a second inventor's intervening disclosure will be compared, and any differences become *prior art against the first inventor*. Thus, in order to maximize the gain from a disclosure, the disclosure should be as full and complete as possible.

Clearly, this may be challenging in highly competitive fields where full disclosure may divulge too much information to competitors, allowing them to adapt their strategies to include competing solutions. The 12 month grace period also gives savvy competitors the opportunity to generate targeted prior art against the disclosure, by releasing their own public disclosures of further variations. The net effect would be that original inventors would be faced with newly generated prior art before they had a chance to file their patent applications, and thus the scope of the patent claims would be limited to the content of the original disclosure.

Interested third parties will likely challenge a patent on the grounds of a defective grace period. For applicants choosing to use public disclosures, meticulous record keeping is essential. Not only must an applicant be able to produce documentation on the content of the disclosed subject matter, but also the facts surrounding the disclosure. Remember, while the grace period applies to public disclosures by the inventor, it also applies to public disclosures by third parties who obtained their subject matter from the inventor. Having documented evidence, such as a list of attendees at a seminar or the names on a email listserve, can be equally important as the content of the public disclosure itself.

Accordingly, we recommend that you discuss your options with patent counsel on the best patent strategies for public disclosures under the AIA. The highlighted advantages and disadvantages depend on which side of the equation you are on, and patent counsel can assist you in effectively using them in both offensive and defensive ways.