

February 22, 2013



## Patent Filing Considerations Under the AIA on the Eve of March 16th

March 16, 2013 is rapidly approaching. This date is significant because it is the effective date of Section 3 of the American Invent's Act (AIA). Section 3 of AIA includes the first-inventor-to-file provisions (FITF). Most of these provisions will be codified in Title 35 of the U.S. Code, most notably, as a complete rewrite of 35 U.S.C. 102 – the section that defines what constitutes prior art. The effective date provisions of AIA Section 3 are found in Sections 3(n)(1) and 3(n)(2). These two provisions provide a complicated transition period requiring practitioners to consider two regimes – pre-AIA 102 or AIA 102 – when contemplating claiming strategies. Significantly, while sections 3(n)(1) and 3(n)(2) will not actually be codified in Title 35, they nonetheless will impact patent law practitioners for years to come. Thoughtful prosecution and claim presentation will allow a practitioner to exert some control over which section 102 applies for examination of a particular application.

Section 3(n)(1) indicates that, with a few exceptions, the amendments in AIA section 3 will take effect on March 16, 2013, and shall apply to any application (or patent issuing thereon), that **contains or contained at any time** (A) a claim to an invention that has an **effective filing date** that is on or after March 16, 2013; or (B) to any continuation, divisional or continuation-in-part application of any patent or application that **contains or contained at any time** such a claim. In other words, "new" AIA section 102 applies for examination of applications that include at least one claim having an effective filing date on or after March 16, 2013. Once an application falls under AIA section 102 it always remains under AIA 102. Moreover, any progeny of an application subject to AIA section 102 will be subject to AIA section 102.

"Effective filing date" applies on a claim by claim basis, and is defined by 35 USC 100(i) to mean the **actual filing date** of the patent or application containing a claim to the invention; **or** the filing date of the earliest application for which the patent or application is entitled to a foreign priority right (section 119), or domestic benefit claim (section 120). Entitlement to foreign priority or domestic benefit requires that the earlier application provide both written description and enablement support for a particular claimed invention.

There is another twist to the effective date provisions. For applications with claims having "mixed" effective filing dates (e.g., a first claim with an effective filing date before March 16 and a second claim with an effective filing date after March 16), section 3(n)(2) provides that the provisions of new AIA 102 apply and the provisions of "pre-AIA" sections 102(g), 135, and 291 of title 35 apply at the same time. Thus, such applications will be subject not only to AIA prior art, but will also be subject to pre-AIA 102(g) prior art and interferences. In other words, this subset of applications can be invalidated because of prior invention by another in the United States, or become subject to an interference proceeding to determine who was the first inventor to invent; in addition to being subject to the new AIA 102 prior art. On the positive side, an applicant faced with such circumstances will be able to swear behind or show prior invention when confronted with certain 102(g) secret prior art.

Going forward, it will be important to assess the effective filing date for each claim in an application to determine whether pre-AIA 102, AIA section 102, or both, will apply. Three possibilities will exist – an application will include all pre-AIA claims, all post-AIA claims, or a mix of claims that have effective filing dates of before March 16 and after March 15. Applications with claims all having an effective filing date prior to March 16, 2013 will be subject to the 35 USC 102 we know today. Applications with claims all having an effective filing date on or after March 16, 2013 will be subject to the AIA 35 USC 102. Applications that include "mixed" effective filing dates will fall within sections 3(n)(1) and 3(n)(2).

Now is the time to consider filing non-provisional applications (whether a new filing or a continuation or divisional) prior to March 16, 2013 to avoid the possibility of mixing of pre- and post-AIA effective filing dates. An additional benefit of filing prior to March 16, 2013 is that patents issuing on such applications will not be subject to attack via a post-grant review proceeding, which becomes available for challenging patents issuing from applications filed on or after March 16, 2013. As a caveat, however, we do not recommend prematurely filing applications with disclosures that are insufficient to satisfy the enablement and written description requirements. In our view, the downside of filing an insufficiently disclosed application outweighs the theoretical upside of examination under pre-AIA 102.

Moreover, there are in fact certain advantageous provisions in AIA 102 compared to pre-AIA 102. Under the pre-AIA law, 103(c) disqualifies subject matter otherwise qualifying under 102(e), (f), or (g) from being relied on in an obviousness rejection where the subject matter and the claimed invention were commonly owned or under a joint research agreement (JRA) at the time the invention was made. Under AIA, new 102(b)(2) (C), and 102(c) liberalize these provisions such that 1) common ownership or a joint research agreement only needs to be in place by the time the application under consideration was filed (as opposed to the time the invention was made); and 2) both novelty and obviousness rejections can be disqualified (as opposed to just obviousness rejections).

In sum, as March 16th approaches, we recommend reviewing portfolios with an eye to determining whether it makes sense to file any continuations or divisionals prior to March 16, 2013, to potentially benefit from a smaller universe of prior art. However, for applications or disclosures that would benefit from the liberal common ownership and CREATE Act provisions of the new 102, consider filing an application with claims having mixed effective filing dates; or at least including unclaimed subject matter, that if claimed in the future, would have an effective filing date on or after March 16, 2013. This would provide an option in the future to come under potentially favorable AIA 102 provisions, or to obtain treatment under 3(n)(2) to provoke an interference.

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