

## AUTHORS

Robert Kinberg  
Michael A. Sartori, Ph.D.  
Fabian M. Koenigbauer

## RELATED PRACTICES

Intellectual Property  
Patent Prosecution and  
Counseling

## ARCHIVES

2013 2009 2005  
2012 2008 2004  
2011 2007 2003  
2010 2006

## Articles

January 2013

### The U.S. First-to-File Patent System Takes Effect March 16, 2013

#### What You Need to Know

March 16, 2013 is a critical cross-over date in the U.S. patent law which changes from a first-to-invent system to a first-to-file system. Under the current first-to-invent system, the first person to invent is entitled to patent rights. Under the new first-to-file system, patent rights are granted to the first inventor to file a patent application regardless of who was the first to invent. Any application or patent that contains, or contained at any time, a claimed invention having an effective filing date on or after March 16, 2013, will be subject to the new first-to-file system. The first-to-file system opens up a significantly larger body of prior art applicable to a claimed invention. Accordingly, we suggest, if at all possible, taking necessary steps to ensure that applications filed in the immediate future fall under the old first-to-invent system. A brief overview of how applications are affected by this change follows.

- Pending applications: First-to-file is only applicable when an application contains, or contained at any time, a claimed invention having an effective filing date of March 16, 2013 or later. Thus, applications pending before March 16, 2013 remain under the first-to-invent system even if new claims are added during prosecution, so long as the original disclosure of the pending application supports the new claims.
- New applications (without a priority claim): Any new, non-priority, non-provisional application that is intended to be prosecuted under the first-to-invent system needs to be filed before March 16, 2013.
- Continuation-in-part applications will be subject to the first-to-file system if the application contains, or contained at any time, any claimed invention having an effective filing date of March 16, 2013 or after. If just a single claim requires support of subject matter added on or after March 16, 2013, the whole application and any of its progeny (i.e. continuation or divisional) application are subject to first-to-file rules. Thus, great care should be taken when drafting the claims for a continuation-in-part application.
- Applications claiming domestic or foreign priority to applications filed before March 16, 2013: U.S. applications filed on or after March 16, 2013 and claiming priority to any application filed before March 16, 2013 (i.e. a continuation, divisional, U.S. national stage, or a non-provisional claiming benefit of a provisional application or a foreign application) will still be subject to the first-to-invent system, so long as no claimed invention requires support of subject matter added to the application on or after March 16, 2013. Great care should be taken to ensure that the priority document complies with U.S. requirements for enabling disclosure. Any disclosure added to an application claiming an earlier priority and filed on or after March 16, 2013, will convert the application and any of its progeny applications to a first-to-file application, if the added disclosure is required to support any claim in the application (i.e. such a claim would then have an effective filing date after the critical date).

Please contact us immediately if you wish to file a U.S. patent application before the March 16, 2013 cross-over date, or if you have any questions regarding the foregoing.