Schnader
ATTORNEYS AT LAW

Schnader Harrison Segal & Lewis LLP

NEW YORK PENNSYLVANIA CALIFORNIA WASHINGTON, D.C. NEW JERSEY DELAWARE

INTELLECTUAL PROPERTY ALERT

FEBRUARY 2013

Consider Taking These Actions Before March 16, 2013, The Effective Date of New U.S. Patent Laws

By Ronald J. Ventola II and Stephenie W. Yeung

Eighteen months after enactment of patent reform via the Leahy-Smith America Invents Act, important new provisions of U.S. patent law will become effective on March 16, 2013. Inventors, their employers, and other owners of inventions should take at least two steps in preparation for the coming deadline.

First, all new inventions and improvements to existing inventions should be evaluated immediately so that any necessary patent applications can be filed by March 15, 2013, before the new provisions go into effect. This evaluation applies to any invention intended to be included in any type of patent application — regardless of whether the application is a new patent application having no claim to an earlier priority date, a provisional patent application, a continuation-in-part patent application, or a formal or nonprovisional patent application that will contain new matter in addition to the information contained in its parent application.

Second, inventors, employers, and invention owners should examine their procedures for obtaining invention disclosures and for filing patent applications, in order to determine whether the procedures should be adjusted to place a greater emphasis on early filing of patent applications.

The new provisions implement two of the most substantial changes to U.S. patent law in at least 50 years. First, patent applications filed on or after March 16, 2013 will be evaluated under a first-inventor-to-file system (often called "first to file") instead of the existing first-to-invent system. For many inventors, the ability to rely on a date of invention earlier than the application filing date to circumvent prior art — the patents, printed publications, or activities that may cause a patent application to be rejected in the Patent Office — has been critical in obtaining patent protection or in preserving the validity of a patent. Under the new first-inventor-to-file system, the filing date of the application is dispositive in most circumstances and an applicant for patent loses this ability to swear behind or antedate prior art. Under the new provisions, those inventors will simply not obtain — or will lose in litigation — patent protection that would have been available under the current law.

Second, patent applications filed on or after March 16, 2013 will be subject to a significantly expanded statutory definition of prior art. As a result, in some cases a patent application filed March 15, 2013 will issue as a patent, whereas an identical patent application filed March 16, 2013 would be rejected under the new provisions.

In the face of these imminent changes, it is imperative to consider filing patent applications in advance of the March 15, 2013 deadline. Possible filings should be evaluated now to allow an assessment of the best course of action, as well as the time to prepare any necessary documents. Because the new provisions are generally less

(continued on page 2)

(continued from page 1)

favorable to inventors than the existing law, in most cases inventors, their employers, and invention owners will benefit from filing patent applications on or before March 15, 2013.

Further, going forward, research-and-development entities should re-evaluate internal policies and procedures for pursuing patent protection. In view of the importance of being the first inventor to file a patent application in the Patent Office, existing policies may need to be amended to adopt a "file early, file often" approach. Finally, organizations should make their inventors aware of the changing landscape in U.S. patent law and ensure that the inventors submit invention disclosures in a timely manner. ◆

For more information about Schnader's Intellectual Property Practice Group or to speak with a member of the Firm, please contact:

Ronald E. Karam, Co-Chair
215-751-2364
rkaram@schnader.com

Joan T. Kluger, Co-Chair
215-751-2357
jkluger@schnader.com

Ronald J. Ventola II
215-751-2358
rventola@schnader.com

Stephenie W. Yeung
215-751-2277
syeung@schnader.com