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USPTO Issues Final Rules: First Inventor to File

The USPTO has issued proposed rule to implement the “first to file” provisions of the AIA. The rules are open for comment until October 5, 2012.

First to File System

The first-to-file system goes into effect on March 16, 2013. All patent applications with an effective filing date of March 16, 2013 or later will be subject to the first-to-file rules.

The first-to-file system grants patent rights to the first-inventor-to-file a patent application regardless of who was the first to invent. Current interference practice will be eliminated for all patent applications subject to the first to file system.

The rules are the last steps in the conversion of the U.S. patent laws from a first-to-invent system to a first-to-file system. This change continues the process of harmonizing the U.S. patent laws with the rest of the world.

Grace Period Maintained

Under current U.S. patent law there is a one-year grace period during which a patent application may be filed after the invention was in public use, on sale or publicly disclosed. The grace period remains for *disclosures* by an inventor or joint inventor or by a third party that obtained the invention from an earlier public disclosure of the inventor(s).

The grace period is calculated from the earliest U.S. or foreign file patent application, in comparison to the pre-AIA grace period which was determined based only on the earliest filed U.S. patent application.

Disclosure Defined

The USPTO provided some guidance on the meaning of “disclosure” which is not defined in the statute. Disclosure is given the same meaning as under 35 U.S.C. § 102. A disclosure may include patents, described in a printed publication, on sale, in public use, or otherwise generally available to the public.

Information otherwise generally available to the public is being treated by the USTPO as a “catch all” provision that defines a new category of prior art. The new category allows the decision-maker to focus on the whether the disclosure was “available to the public” rather than on whether the disclosure was a printed publication or fits into another statutory category. Some examples of disclosure that may be “available to the public” include a student thesis in a university library, a poster display or other information disseminated at a scientific meeting, a document posted on the Internet, or a commercial transaction that does not constitute a sale under the UCC.

Expanded Prior Art

Applications filed on or after March 16, 2013 will be subject to the new rules which expand realm of prior art available to reject the patent application. The most notable change is that evidence of prior use or sale anywhere in the world, as opposed to the pre-AIA realm of just the United States, is available as prior art.