First-to-file and 35 U.S.C. §102

In general, after March 16, 2013, two significant changes will occur to the United States Patent System, the first relating to the necessity to be the first inventor to either file an application or publish information about an invention, and the second which modifies information to be included within Prior Art under 35 U.S.C. §102.

Under the first-to-file patent system a risk exists that an independent third party may be the first to act in publishing information or filing a patent application for an invention, which may preclude an award of patent rights, or even result in liability for patent infringement, against an inventor who has delayed action in the publication or protection of an invention.

Under the new first-to-file patent system, an inventor must either be the first-to-file for a patent on an invention or the first-to-publish information about the invention and file a patent application within one year of the date of publication in order to obtain patent rights. Thus, if you are second-to-invent and first-to-file or publish (followed by filing within a year), you may have superior rights over someone who is first-to-invent but delayed action in the filing of a patent application or publishing an invention.

Under the new first-to-file system of the America Invents Act (AIA), the one year grace period for filing a patent application is limited to the inventor's own disclosures. Many foreign countries, however, do not have a grace period. If you are considering patent protection in most foreign countries, you should file a patent application prior to any public disclosure of your invention.

We recommend that inventors who are seeking patent protection consider filing provisional applications as early as possible during the inventive process and as often as is necessary to capture any improvements to the invention. This action will enable you to lock down the earliest possible filing date. This action also lets you defer, by up to one year following the provisional patent application filing date, the decision to seek domestic and foreign patent protection.

You may also wish to consider publishing your invention subsequent to filing your provisional application. If you do not ultimately file a utility application, this prevents people who file after your publication date from being able to receive patent protection for the subject-

matter of your disclosure. The decision to publish can be complicated. Please contact us to discuss the considerations more fully.

The application of the first-to-file and first-to-publish provisions of the American Invents Act will be very fact specific, and may be very complicated. It is impractical to attempt to identify all of the situations which may be affected by the mandates of the American Invents Act at this time. We have identified below a few simple examples showing how the first-to-file or first-to-publish provisions of the American Invents Act will work in practice.

Example 1

Invents 1st →→→→ Files App 1st →→→→→→→→→ Receives Patent

Invents 2nd→→→→→→ Files App 2nd →→→→→→→→ No Patent, Possible Infringer

Explanation: The First inventor is the first-to-file a patent application, and therefore receives the patent.

Example 2

Invents 1st →→→→→→→→→→→→→→→→→→→→ Files App 2nd →→→→ No patent, possible infringer

Invents 2nd →→→→ Files App 1st →→→→→→→→→→→→→→→→→→→→ Receives patent

Explanation: The second inventor receives the patent because he is the first-to-file a patent application for the invention.

Example 3

1st to Publish Grace Period

|——————————————————|

Invents 1st →→→ Publish 1st →→→→ Files App 1st →→→→→→→→ Receives Patent

Invents 2nd →→→→→→→→→→→→→→→→→→→→ No Patent, Possible Infringer

Explanation: The first inventor was the first-to-publish the invention, and the first-to-file the patent application, within the first to publish grace period, resulting in a patent.

Example 4

Invents 1st →→→→→ Files App 1st →→→→→→ Receives Patent

Invents 2nd →→→→→→ Publishes 1st →→→→→ No Patent, Possible Infringer

Explanation: The first inventor was the first-to-file the patent application, which occurred prior to the second inventor publishing the invention, therefore the first inventor receives the patent.

Example 5

1st to Publish Grace Period

|————————————————|

Invents 1st →→→ Publish 1st →→→→→→→→→→→→→ Files App 1st →→ No Patent

Explanation: The first inventor publishes the invention but delays the filing of the patent application beyond the full year grace period (the grace period expires) resulting in no issuance of a patent and the dedication of the invention to the public.

Example 6

1st to Publish Grace Period

|——————————————————|

Invents 1st →→→→→→→→→Publish 1st →→→→→ Files App 1st →→ Receives Patent

Explanation: The first inventor publishes the invention and files the patent application within the full year grace period resulting in a patent.

Example 7

Invents 1st →→→→ →→→→→→→→→→→→→→ →→→Files App 1st →→ No Patent

1st to Publish Grace Period

|——————————————————|

Invents 2nd →→Publish 1st→→→→→→→→→→→→

Explanation: The second inventor is the first to publish. The first inventor delays filing of the patent application, and files the application more than one year after the invention publication date. The publication is Prior Art under 35 U.S.C. §102 and no patent issues and the invention is dedicated to the public.

Example 8

Invents 1st →→→→→→→→→→→→→→→→→ Files App 1st →→ No Patent

1st to Publish Grace Period

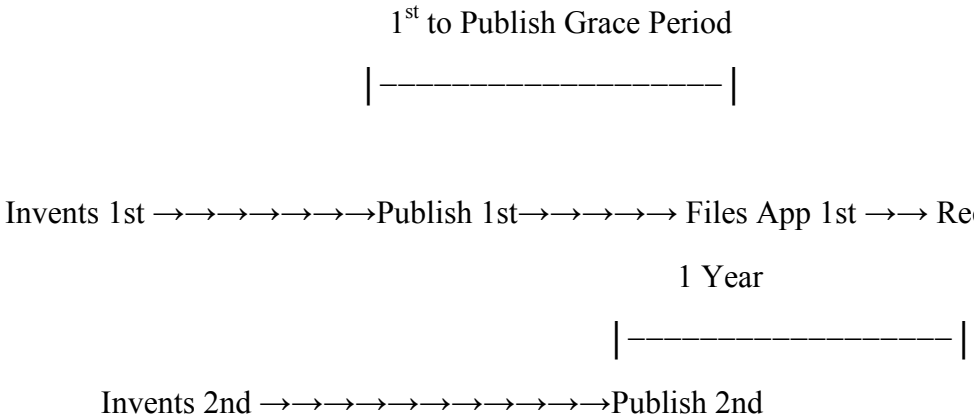
|————————————|

Invents 2nd →→→→→→→→Publish 1st→→→→→→→→→

Explanation: The second inventor is the first to publish. The first inventor delays filing of the patent application and files the patent application within one year of the invention publication

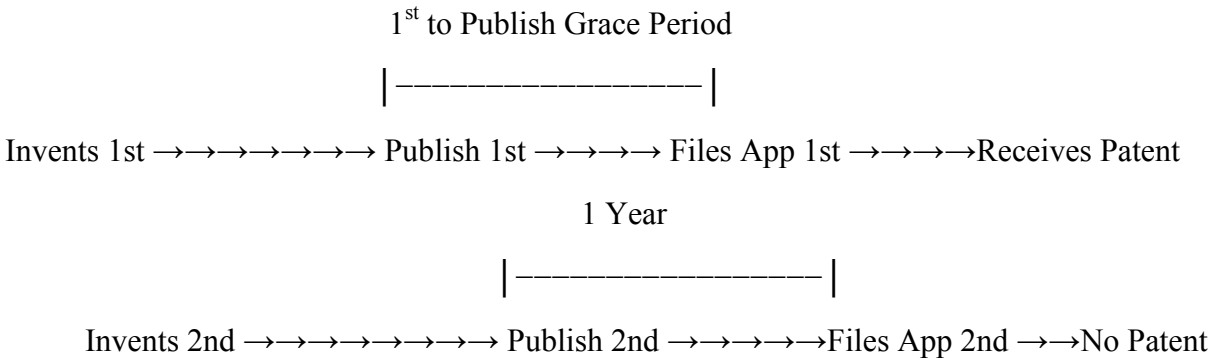
date. The publication is Prior Art under 35 U.S.C. §102 and no patent issues and the invention is dedicated to the public.

Example 9



Explanation: The first inventor publishes the invention first and files the patent application within the full year grace period resulting in a patent. The second inventor is second to publish, however, the second publication is prior to the patent application filing date. The second publication is of no legal consequence because the first inventor was the first to publish and the patent application was filed within the full year grace period.

Example 10



Explanation: The first inventor publishes the invention first and files the patent application within the full year grace period resulting in a patent. The second inventor is second to publish, and files the second patent application within the one year grace period for the second

publication date. The second publication is prior to the first patent application filing date. The second publication and the second patent application are of no legal consequence because the first inventor was the first to publish and the first patent application was filed within the first full year grace period.

Example 11

Invents 1st →→→→→→ Files App 1st →→→→→→→→→→→→→→Receives Patent

AB AB A

A + B

Invents 2nd →→→→→→→→→→ Files App 2nd →→→→→→→ Receives Patent

AC AC A + C

Explanation: The first inventor was the first-to-file a patent application disclosing invention A alone and the combination AB. Invention AB is patentably distinct from invention AC. The first inventor receives a patent for both invention A alone and the combination AB. The second inventor receives a patent for the patentably distinct invention for AC, because the second invention for AC is a patentable improvement on invention A and is also patentable as compared to AB.

Example 12

Invents 2nd →→ Files App 1st →→→→→→→→→→→→→→Receives Patent

AB AB A

A + B

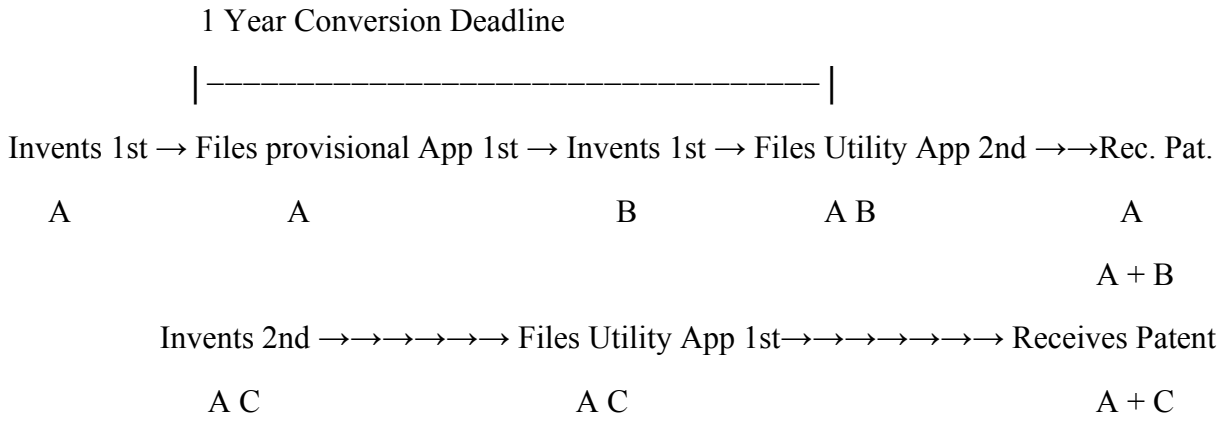
Invents 1st →→→→→→→→→→→→→→ Files App 2nd →→→→→→→ Receives Patent

AC AC A + C

Explanation: The second inventor was the first-to-file a patent application disclosing invention A alone and the combination AB. Invention AB is patentably distinct from invention AC. The second inventor receives a patent for both invention A alone and the combination AB. The first inventor receives a patent for the patentably distinct invention for AC, because the first inventor delayed the filing of the application for invention AC. If the first inventor had acted first, then he

would have been entitled to a patent for A alone and AC and the second inventor would have been restricted to a patent for AB only.

Example 13



Explanation: Inventions AB and AC are patentably distinct. The first inventor filed the provisional application for invention A first. The first inventor has a one year period of time to convert the provisional application for invention A into a utility application which he did. Since AB and AC are patentably distinct, the first inventor receives a patent for A and AB and the second inventor receives a patent for AC.

Please contact our office if you have any questions as related to the provisions of the first-to-file or first-to-publish mandates of the American Invents Act. In order to avoid inadvertent loss of patent rights please contact our office at your earliest opportunity concerning your inventions/innovations.

35 U.S.C. §102

In summary, for a patent application filed after March 16, 2013, an inventor will no longer be permitted to swear behind a reference asserted by the patent office during patent prosecution. The definition of Prior Art under 35 U.S.C. §102 has also been expanded to include additional information which is publically available within the United States and Internationally.

Repeated at the end of this document is the new statutory language for 35 U.S.C. §102 defining prior art. The changes to 35 U.S.C. §102, and the application of the changes into practice, is a complicated proposition.

In general:

New 35 U.S.C. §102(a)(1) may be referred as being directed to public disclosure prior art which would generally include patents, printed publications, public use, on sale, or information otherwise available to the public. This provision generally would not include offers for sale or secret prior art which were not otherwise publicly available. This provision would also generally include as prior art information in use or on sale outside of the United States provided that the information is publicly accessible.

New 35 U.S.C. §102(a)(2) may be referred as being directed to patent filing prior art which would generally include issued patents, published applications, or applications deemed published under§122(b), and foreign PCT applications designating the United States. This provision generally would not include abandoned applications, applications with secrecy orders, provisional applications, or foreign or PCT applications not designating the United States which eventually are not patented.

New 35 U.S.C. §102(b)(1) is an exception to 35 U.S.C. §102(a)(1) which in general is directed to disclosures made one year or less before the effective filing date of the claimed invention, if the disclosure was made by the inventor or joint inventor or by another who obtained the information directly from the inventor or joint inventor.

New 35 U.S.C. §102(b)(2) is an exception to 35 U.S.C. §102(a)(2) which in general is directed to prior-filed but later published United States or United States PCT patent filings, which are subject to three separate exceptions concerning: disclosures by inventors: disclosures originating from inventors; or information originating from a common owner.

There is no one-size-fits all strategy for managing intellectual property rights. The strategic considerations may be complicated. If you have any questions concerning the impact of the America Invents Act on your intellectual property rights or your business, please do not hesitate to contact us at your earliest convenience.

We have prepared topical summaries of the revisions mandated by the AIA. You can access these summaries on our website (www.vaslaw.com), within the tab identified as 'VAS News & Cases'. If you would prefer to receive copies of one or more of the topical summaries by mail, please contact our office.

At Vidas, Arrett, and Steinkraus P.A., we work diligently to keep you advised of matters which may impact your intellectual property rights, so that you may protect your inventions and profit from your creations.

Statutory Language for Revised 35 U.S.C. §102

(a) NOVELTY; PRIOR ART.--A person shall be entitled to a patent unless--

(1) the claimed invention was patented, described in a printed publication, or in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention; or

(2) the claimed invention was described in a patent issued under section 151, or in an application for patent published or deemed published under section 122(b), in which the patent or application, as the case may be, names another inventor and was effectively filed before the effective filing date of the claimed invention.

(b) EXCEPTIONS.--

(1) DISCLOSURES MADE 1 YEAR OR LESS BEFORE THE EFFECTIVE FILING DATE OF THE CLAIMED INVENTION.--A disclosure made 1 year or less before the effective filing date of a claimed invention shall not be prior art to the claimed invention under subsection (a)(1) if--

(A) the disclosure was made by the inventor or joint inventor or by another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor; or

(B) the subject matter disclosed had, before such disclosure, been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor.

(2) DISCLOSURES APPEARING IN APPLICATIONS AND PATENTS.--A disclosure shall not be prior art to a claimed invention under subsection (a)(2) if--

(A) the subject matter disclosed was obtained directly or indirectly from the inventor or a joint inventor;

(B) the subject matter disclosed had, before such subject matter was effectively filed under subsection (a)(2), been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor; or

(C) the subject matter disclosed and the claimed invention, not later than the effective filing date of the claimed invention, were owned by the same person or subject to an obligation of assignment to the same person.

(c) COMMON OWNERSHIP UNDER JOINT RESEARCH AGREEMENTS.--Subject matter disclosed and a claimed invention shall be deemed to have been owned by the same person or subject to an obligation of assignment to the same person in applying the provisions of subsection (b)(2)(C) if--

(1) the subject matter disclosed was developed and the claimed invention was made by, or on behalf of, 1 or more parties to a joint research agreement that was in effect on or before the effective filing date of the claimed invention;

(2) the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement; and

(3) the application for patent for the claimed invention discloses or is amended to disclose the names of the parties to the joint research agreement.

(d) PATENTS AND PUBLISHED APPLICATIONS EFFECTIVE AS PRIOR ART.--For purposes of determining whether a patent or application for patent is prior art to a claimed invention under subsection (a)(2), such patent or application shall be considered to have been effectively filed, with respect to any subject matter described in the patent or application--

(1) if paragraph (2) does not apply, as of the actual filing date of the patent or the application for patent; or

(2) if the patent or application for patent is entitled to claim a right of priority under section 119, 365(a), or 365(b), or to claim the benefit of an earlier filing date under section 120, 121, or 365(c), based upon 1 or more prior filed applications for patent, as of the filing date of the earliest such application that describes the subject matter.