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ALERT

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USPTO Finalizes "First Inventor to File" Rules

The United States Patent and Trademark Office (USPTO) finalized the rules of practice implementing the "first inventor to file" provision of the America Invents Act (AIA). The rules take effect March 16, 2013. The "first inventor to file" provision at the heart of the AIA brings the U.S. patent system in line with those of foreign counterparts and eliminates the "first to invent" regime – the hallmark of U.S. patent practice. Prior to the passage of the AIA, the United States was the only country with a patent office using a "first to invent" regime. The USPTO's final rule, published in the Feb. 14, 2013, Federal Register (Vol. 78, No. 13), was accompanied by the USPTO's Examination Guidelines.

The new rules amend the patent law in several critical ways and apply to certain patent applications filed on or after March 16, 2013. Four of the key provisions are:

(1) Converting the U.S. patent system from a "first to invent" system to a "first inventor to file" system;

(2) Treating U.S. patents and published applications as prior art as of their earliest effective filing date (regardless of whether the earliest effective filing date is based upon a U.S. or foreign application);

(3) Eliminating the requirement that a public use or sale be in the U.S. to qualify as prior art; and

(4) Treating commonly owned patents and published applications as being by the same inventive entity for purposes of novelty as well as nonobviousness.

Simply put, the date of invention is no longer relevant under 35 U.S.C. Sec. 102. Section 3 of the AIA specifically amends 35 U.S.C. Sec. 102(a) to provide, in part, that "[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." Exceptions to the prior art are set forth in 35 U.S.C. Sec. 102(b), which, among other provisions, allows for a one-year grace period after a first disclosure of an invention in which the inventor may file a patent application, so long as the disclosure was first made by the inventor (or by another who obtained the subject matter directly or indirectly from the inventor). Gone are provisions relating to patent interference proceedings (determining first to invent), and new provisions for patent derivation proceedings have been put into place (determining whether the first to file derived the invention from a later applicant).

Prior to the AIA, under 35 U.S.C. Sec. 102(e), WIPO-published applications designating the U.S. would be treated as U.S. patent applications only under certain circumstances. Now, under AIA 35 U.S.C. Sec. 374, WIPO-published applications designating the U.S. are treated as U.S. patent application publications for prior art purposes and are effective as prior art as of the filing date of the earliest such application.

The previous requirement that restricted public uses and sales to activity in the United States is eliminated – public uses and sales anywhere in the world may now qualify as prior art. The USPTO has indicated that secret sales, offers for sale, or uses do not qualify as prior art under the AIA, however.

The exception in 35 U.S.C. Sec. 103(c), which applied in the context of an obviousness analysis to prior art that was commonly owned at the time and that qualified as prior art under 35 U.S.C. Sec. 102(e), (f), and/or (g), is broadened. Now, under 35 U.S.C. Sec. 102(b)(2)(C), a disclosure made in a U.S. patent or published application, or WIPO-published

application, is not prior art if the subject matter disclosed and the claimed invention were owned by the same person or subject to an obligation of assignment to the same person. Under the new rules, certain prior patents and published applications of co-workers and collaborators will not qualify as prior art either for purposes of novelty (35 U.S.C. Sec. 102) or nonobviousness (35 U.S.C. Sec. 103).

The changes apply to any application for a patent that contains, or contained at any time, a claim with an effective filing date on or after March 16, 2013 (or a specific reference under 35 U.S.C. Secs. 120, 121, or 365(c) to any patent or application that contains or contained at any time such a claim). In these cases, the entire application would be subject to the new rules. Because the changes apply only to certain applications filed on or after March 16, 2013, however, the USPTO is adopting additional requirements for nonprovisional applications that claim priority to, or the benefit of, the filing date of an earlier application (foreign, provisional, nonprovisional, or international applications designating the U.S.) that was filed prior to March 16, 2013. If a nonprovisional application contains, or contained at any time, a claim to a claimed invention that has an effective filing date on or after March 16, 2013, the applicant must provide a statement to that effect. This will permit the USPTO to readily determine whether the application is subject to the changes to prior art under 35 U.S.C. Secs. 102 and 103 in the AIA.

The changes take effect March 16, 2013, and the new patent fee schedule follows, taking effect March 19, 2013.

The USPTO's final rule, published in the Feb. 14, 2013, Federal Register (Vol. 78, No. 31), is available at http://www.gpo.gov/fdsys/pkg/FR-2013-02-14/pdf/2013-03453.pdf.

The USPTO's Examination Guidelines, also published in the Feb. 14, 2013 Federal Register (Vol. 78, No. 31), are available at http://www.gpo.gov/fdsys/pkg/FR-2013-02-14/pdf/2013-03450.pdf.

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