



First-Inventor-to-File System Becomes Effective March 16, 2013

February 27, 2013

As you may be aware, the Leahy-Smith America Invents Act (AIA) changed a number of important U.S. patent law provisions. One such change moves the United States from a first-to-invent system to a first-inventor-to-file system on March 16, 2013. Under the new system, priority will be awarded to the first inventor who files a patent application instead of to the applicant who conceived of the invention first. This will remove the Patent Office's burden of determining who invented something first when two people separately file similar patent applications. Even under the new system, however, an applicant must still be an actual inventor and cannot validly file an application for something that he did not invent.

The definition of prior art has also been expanded to include some information from third parties that is publicly available before a patent application is filed, regardless of whether the applicant conceived of the invention first. Thus, while an inventor still has a one-year grace period for filing a U.S. patent application after disclosure, that grace period will be severely weakened.

The effect of both of these changes is that applicants will often benefit by filing patent applications as soon as reasonably possible. Provisional patent applications will become much more important for obtaining filing dates, and applicants may want to file multiple provisionals as advancements are made; a nonprovisional application can then be filed linking back to the filing dates of the provisional applications.

Please let us know if you have any questions regarding particular issues that you face, if you would like to discuss the AIA in more detail, or if you would like additional written materials about the AIA. If you want a patent application to be governed by the current laws, a full disclosure must be made to the Patent Office prior to March 16, 2013, and the application cannot be amended after March 16 to claim any new subject matter. As each patent application is unique, some will fare better under the current laws while others will benefit from the AIA. If you have any questions or wish to discuss forming a filing strategy that meets your needs, please contact your Lathrop Gage attorney or any of the attorneys listed above.