

PATENT FILING STRATEGIES IN VIEW OF THE AMERICA INVENTS ACT

Intellectual Property Alert
January 28, 2013

Practices & Industries

Copyrights

Since the passage of the America Invents Act (AIA) in September 2011, many of its provisions (such as prior-user rights, false-marking provisions, and *inter-partes* review proceedings, among others) have been implemented. On March 16, 2013, another key provision will take effect—the change from a first-to-invent system to first-to-file system. Understanding the implications of this change will better allow applicants to navigate the uncharted waters of the AIA era as well as to devise strategies for the transition period.

The change from a first-to-invent (pre-AIA) system to a first-to-file (AIA) system expands the scope of the prior art that is relevant to patentability of an invention. For example, under the first-to-file system, eliminating certain prior-art references by establishing an earlier date of invention will no longer be an option because the applicant's date of invention is irrelevant.

The non-relevancy of the date of invention also eliminates interference proceedings, in which a dispute between two parties seeking patent protection for the same invention results in the patent office deciding which inventor was the first to invent.

Determination of whether the claims of a patent application will be examined under the pre-AIA or the AIA rules will depend on the priority date accorded to the claims. If all claims in a patent application are entitled to a priority date earlier than March 16, 2013, the claims will be examined under the pre-AIA rules. If all claims are entitled to a priority date of March 16, 2013, or later, the claims will be examined under the AIA rules. Examination under pre-AIA rules means more options to overcome prior art but includes the possibility of being subject to interference proceedings. Examination under AIA rules means fewer options to overcome prior art but no possibility of being subjected to interference proceedings.

The analysis becomes more complicated for applications having some claims with a priority date earlier than March 16, 2013, and other claims with a priority date of March 16, 2013, or later—the “mixed-bag” situation. In this case, all of the claims will be examined under the AIA rules, and all can be subject to interference proceedings. Deleting claims with one or the other priority does not change the situation because this rule applies if the claims were present “at any time” during prosecution.

PATENT FILING STRATEGIES IN VIEW OF THE AMERICA INVENTS ACT

The mixed-bag situation may occur, for example, if a priority application, such as a provisional application, was filed before March 16, 2013, and the corresponding non-provisional is filed on or after March 16, 2013. It is possible that not all claims in the non-provisional application are accorded priority to the provisional. For example, there may be new matter added in the non-provisional application that provides support for some of the claims. As explained above, even if a single claim is denied priority to the provisional, all of the claims will be examined under the AIA rules, and yet all of the claims (including the one that was denied priority) can be subject to interference proceedings.

In view of this peculiar rule, applicants may want to avoid the mixed-bag situation. For example, if a provisional application has already been filed, applicants may consider filing a corresponding non-provisional or an international application under the Patent Cooperation Treaty (PCT) before March 16, 2013, even if the 12-month period from the filing date of the provisional is not over. Similarly, if a continuation-in-part application is contemplated, applicants may wish to file it before March 16, 2013. In addition, applicants may also wish to use continuing applications to segregate claims with different priority dates.

Careful review of your options with patent counsel should help to identify the appropriate filing strategy suited to your situation.

