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TALKING POINTS

Overhauling patents: A tale of two laws

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None of the significant revisions made to U.S. patent laws by the America Invents Act ("AIA") is more significant than conversion of the U.S. patent system from a "first-to-invent" to a "first-to-file" system, which will place this aspect of U.S. patent law in line with that of the rest of the world.


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U.S. patent applications whose earliest filing or priority date is on or before March 15, 2013 will continue to enjoy the advantages of the existing first-to-invent law, but applications with a later effective filing date will be subject to the AIA's first-to-file and related provisions.

Given that the normal lifetime of a U.S. patent is 20 years from the effective filing date, and that patent litigation may commence late in a patent's lifetime, patent lawyers and others will be living with two distinctly different sets of patent law for about the next 25 years.

The current first-to-invent system means that in the case of two different patent applicants claiming substantially the same patentable invention, the patent will be awarded to the first inventor to invent, who may not necessarily have been the first-to-file his or her patent application in the U.S. Patent and Trademark Office.

For all post-AIA applications, the inventor who files first will normally be awarded the patent, assuming all other requirements are met, regardless of which competing inventor first made the invention.

Race to the Patent Office

The new first to file system will engender a race to the USPTO. The availability of provisional patent applications facilitates entering the race by filing what amounts to only a technical disclosure of the invention, with no need for the presentation of patent claims, the proper preparation of which requires time-consuming research and detailed consideration.

While no patent is ever granted on a provisional application, a standard application, including claims and usually significantly more detail than the provisional application, if filed within one year of the provisional application, may claim priority of the provisional filing date for all information contained in the provisional application. Because a standard application may claim priority of more than one provisional application, it is possible to file a number of provisional applications as the invention is developed.

Under the existing law, "prior art" with respect to which patent claims must demonstrate both novelty and non-obviousness, has been greatly expanded. For pre-AIA filings, the prior art includes publications anywhere in the world in any language, and public-informing activities in the United States and in North American Free Trade Agreement and World Trade Organization countries. For post-AIA applications, not only publications but public-informing activities anywhere in the world will be prior art against the applicant. Further, prior art published prior to filing a patent application but after the date of invention are not effective references against pre-AIA applications but are effective against post-AIA applications. Under the AIA, in order to be patentable, not only must the invention have been made, but the patent application must have been filed prior to the prior art publication date.

New defense against infringement

Under the AIA, any U.S. patent granted on or after Sept. 16, 2012, regardless of when it was filed, is subject to a defense of prior commercial use of the invention in the U.S. That defense, which previously had been available only against business method patents, is now available, depending on when the prior use commenced, against any U.S. patent except one owned by an institution of higher learning.

For post-AIA applications, early effective filing dates are of paramount importance and the date of invention is relatively insignificant. Applications should be filed as early in the development process as is feasible, consistent with having sufficient information on hand to make even a provisional patent application meaningful. For inventions undeveloped enough for filing a standard application, it will likely be prudent to file one or more provisional applications during the development phase. ■

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