

TIPS FOR TRANSITIONING TO FIRST-TO-FILE U.S. PATENT SYSTEM

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One of the most significant changes to the U.S. patent system brought about by the America Invents Act is that the U.S. will transition from a first-to-invent to a first-to file regime. The new system will apply to all applications filed on or after March 16, 2013, with claims that are not supported by an earlier application.

No longer will inventors be able to rely on earlier inventive activity to pre-date prior art. Under the first-to-file regime, if you have been working on an invention for a year and someone else has been working on it for a week and files a patent application one day before you, you cannot get a patent on that invention.

With little more than a year before the race to the U.S. Patent Office determines patent rights, inventors should:

FILE EARLY, FILE OFTEN

Applications filed before the March 16, 2013 transition date that support later-filed claims can be used to delay the effects of the transition by retaining reliance on early inventive activity during prosecution. This will permit applicants to continue to use the time-honored tradition of pre-dating prior art within a year of the application's filing date. A registered patent attorney can advise inventors on pre- and post-transition date filing strategies and assist in the preparation and filing of patent applications and claims.

After March 16, 2013, you should file applications early and frequently during the invention process. Each time there is a significant improvement to the invention, you should file a new application to prevent competitors from winning the race on the improvement


as well. If a competitor files first, even by one day, you will not be entitled to a patent for that invention.

It is also important to file early and file often in 2012, because patent applications with all claims having an effective filing date before March 16, 2013 are examined under the current first-to-invent system. Patent applications with even one claim dating on or after that transition date will be examined under the first-to-file regime.

FILE MULTIPLE PROVISIONAL APPLICATIONS

Under the current first-to-invent system, inventors often file a quick provisional application before a public disclosure and then wait a year to file a full non-provisional application that includes sufficient detail to warrant a patent. They rely on the inventive activity during that year to pre-date prior art. That strategy will not work under the first-to-file system. If the first provisional is not adequately supported and enabled, an intervening filing by a competitor may trump the first provisional.

Under the new first-to-file regime, after the first provisional application is filed, inventors should file additional provisional applications as details of the invention develop to minimize the potential adverse effects of intervening applications.

Filing early, filing often, and filing provisionals are just a few ways inventors can maximize efforts to protect their inventions as the U.S. transitions to a first-to-file patent system. 

For more information about the America Invents Act, visit the U.S. Patent and Trademark Office website at: www.uspto.gov/aia_implementation/index.jsp.

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