

Client Alert.

July 27, 2012

USPTO Releases Proposed First-Inventor-to-File Rules and Examiner Guidelines

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Implementation of the “first-to-file” provisions of the Leahy-Smith America Invents Act (AIA) took a step forward yesterday when the United States Patent and Trademark Office (USPTO) published proposed rules and proposed examination guidelines for the first-inventor-to-file provision of the AIA. Both are open for comment until October 5, 2012. The final versions will go into effect on March 16, 2013, and will apply to all patent applications with an effective filing date of March 16, 2013, or later.

OVERVIEW

The AIA was enacted on September 16, 2011, and although signed into law on that date, numerous provisions of the AIA required rulemaking by the USPTO before they could be effective. Prior Morrison & Foerster client alerts on the AIA and a chart of effective dates of the various provisions of the AIA can be found in our [Patent Reform Resource Center](#).

The documents published yesterday are some of the USPTO’s first steps in implementing Section 3 of the AIA, moving the United States from a “first-to-invent” to a “first-inventor-to-file” patent system. This shift represents one of the most significant changes to the patent statute in the last 50 years.

THE NEW FIRST-TO-FILE SYSTEM

The AIA transforms the U.S. from a “first to invent” system to one where the right to a patent is given to the inventor who is the first inventor to file. Under current law, an inventor may challenge another’s patent application through the interference process by arguing that he or she can document a prior invention date. Going forward, the inventor with the earliest-filed application is now the one entitled to claim the patent over another inventor, regardless of who invented the claimed subject matter first. The change in the law also marks the beginning of the end of interference practice, and serves to harmonize the U.S.’s patent system with that of every other major jurisdiction throughout the world.

ONE-YEAR GRACE PERIOD

The AIA provides a grace period for disclosures made by an inventor or joint inventor within one year of the effective filing date of a claimed invention. Thus, an inventor may file a patent application within one year after publicly disclosing the invention, without having the disclosure be available as prior art. According to the guidance, the one-year grace period in the AIA is measured from the earliest U.S. or foreign patent application to which the patent or application is entitled to claim the benefit of priority, whereas the one-year grace period in pre-AIA 35 U.S.C. 102(b) is measured from only the earliest application filed in the U.S.

EXPANDED PRIOR ART

The AIA expands the scope of materials considered prior art during examination. Claims are now subject to rejection by evidence of a prior public use or sale of the invention anywhere in the world, rather than just in the U.S.

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DEFINITIONS OF STATUTORY TERMS

The documents published yesterday also seek to clarify certain terms in the AIA.

As we noted in our September 8, 2011 client alert, the AIA does not define the word “disclosure.” Specifically, the use of this term in the statute was criticized as being unclear as to whether public use or sales activities by inventors are considered to be a disclosure for the purpose of the grace period. The guidance published yesterday confirms that the grace period will be largely limited to disclosures made by the inventors of an application and will not extend to third-party disclosures.

In its proposed guidance, the USPTO states that the provision of 35 U.S.C. 102(a)(1)—stating that a claimed invention may not be patented if it was “otherwise available to the public”—is a “catch-all” provision that permits USPTO examiners to rely on prior art not available under pre-AIA 35 U.S.C. 102. Specifically, the provision allows examiners to rely on disclosures available to the public despite the fact that the disclosure may not constitute a “printed publication.” Examples of information “available to the public” provided in the guidance are: a student thesis in a university, a poster display at a scientific meeting, subject matter in a laid-open patent application, a document on the Internet, or a commercial transaction that does not constitute a sale under the Uniform Commercial Code.

OUTLOOK

The proposed guidelines published yesterday are not final, and do not have the force and effect of law. Morrison & Foerster will continue to provide client alerts on the implementation of the AIA.

Within the next month, and no later than August 16, 2012, the USPTO will publish its final rules regarding the numerous new post-issuance procedures, including the post-grant review and *inter partes* review procedures. We will issue a client alert when those rules are published.

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