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What You Need to Know about the USPTO's Final Rules and Examination Guidelines for the First-to-File Provisions of the Leahy-Smith America Invents Act

Intellectual Property Alert

The USPTO's **final rules** and **examination guidelines** for the first-to-file provisions of the Leahy-Smith America Invents Act, which was issued on February 14, 2013, contain several provisions that require Applicant action or consideration.

Key Rules Applicants Should Know

Treatment of transition applications

The first-to-file system is applicable to any application or patent that contains, or contained at any time, any claimed invention having an effective filing date on or after March 16, 2013. Once an application is subject to first-to-file rules, any progeny (i.e. continuation or divisional) of that application will also be subject to first-to-file rules.

The USPTO places the burden on Applicants to indicate if a transition application (i.e. an application filed on or after March 16, 2013, which claims priority to an earlier application filed before that date) is subject to the first-to-file system. Unless Applicants indicate otherwise, the USPTO will examine a transition application under the first-to-invent system. Applicants must file a statement with the USPTO indicating that a transition application is subject to first-to-file when the application contains or contained at any time a claim having an effective filing on or after March 16, 2013. The statement may, therefore, be necessary in any application filed on or after March 16, 2013, claiming domestic or foreign priority to an earlier filed application and which adds new disclosure to the application which is required for the support of any claim made in the application. No claim-by-claim analysis is necessary. This statement has to be filed within the later of: (a) four months from the actual U.S. filing date; (b) four months from the entry into U.S. national stage; (c) sixteen months from the filing date of the prior filed application; or (d) the first time a claim having an effective filing date on or after March 16, 2013 is presented. The USPTO is revising the application data sheet template to include a check box to make this statement.

Such a statement does not need to be filed when persons having a duty of disclosure reasonably believe that the application does not contain a claim having an effective filing date of on or after March 16, 2013. Thus, the USPTO ties the requirement for such statements with the duty of disclosure (i.e. the general duty of candor and good faith of dealing with the USPTO). In egregious cases, a court may deem a deliberate violation of that duty to amount to inequitable conduct, which renders a patent unenforceable.

Foreign priority claims and references to related applications

For any application filed on or after March 16, 2013, the new rules require filing the certified copy of a foreign priority application within the later of four months of from the actual filing date or sixteen months from the filing date of the foreign priority application. The requirement may be satisfied by filing a request for electronic transfer of the priority document from a foreign intellectual property office that allows the USPTO access to such application (i.e. the European Patent Office, Japanese Patent Office, Korean Intellectual Property Office or WIPO); or by providing an interim copy of the priority application within the four/sixteen months window and a certified copy before grant of the U.S. patent. The rules also provide for a good cause exception that allows for submission of the priority document after the specified periods.

A translation of the priority application only needs to be submitted (1) when the application is involved in an interference or derivation proceeding, (2) when necessary to overcome the date of a reference relied

upon the Examiner, or (3) when required by the Examiner. The rules also specify that cross-references to related applications (including foreign applications) to which priority is not claimed should only appear in the specification instead of in an application data sheet. However, applications from which priority is claimed must be identified in the application data sheet.

USPTO Guidelines for Examination of First-to-File Applications

The America Invents Act expands the scope of available prior art applicable to a first-to-file application. In addition to patents and printed publications, a prior “public” sale and/or use anywhere in the world by another are a bar to patentability. According to the Examination Guidelines, “private” sales and uses will not constitute prior art, which is a deviation from existing law. Further, U.S. applications/patents and published PCT applications designating the U.S. are prior art as of their earliest claimed domestic or foreign priority date.

Practice Tips

Transition applications

For transition applications that add additional matter, Applicants may want to consider a clear demarcation of what matter has been added to allow an easy determination of whether the application should be examined under first-to-file. In some circumstances, Applicants may want to consider filing two applications: (1) an application which only contains claims relying on material disclosed in an earlier application filed prior to before March 16, 2013; and (2) an application for claims relying on subject matter added on or after March 16, 2013.

Provision of foreign priority documents

Applicants relying on a foreign priority claim should consider providing the certified copy of the foreign priority along with the filing instructions to ensure that the certified copy is timely filed.

Addition of new claims

The rules package indicates that amendments (other than preliminary amendments filed with the application) that seek to add a new claim that is directed to new matter does not convert an application into a first-to-file application. Thus, Applicants cannot inadvertently automatically convert an application to a first-to-file application by introducing a claim that the USPTO subsequently rejects for allegedly being new matter. However, if there is any doubt as to whether the claim is supported by the specification, Applicants may want to consider delaying filing a preliminary amendment, which adds new claims, until after the filing of the application.

The USPTO rules and guidelines provide Applicants with some insights into the scope of prior art under complex prior art provisions of the America Invents Act. In the future, courts will likely determine the scope of these prior art provisions. In the meantime, Applicants may want to consider consulting with their patent counsel as to how to navigate this new regulatory framework. If you have any questions regarding this new regulatory framework or patent law, do not hesitate to contact our patent practitioners.