Success Under the AIA's "First to File" System Requires Strategy Shift

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Navigating the numerous changes under the America Invents Act (AIA) can be challenging. One of the most significant changes — the adoption to a first to file system — requires inventors to more carefully consider the timing of patent applications.

To take full advantage of the new regime, companies should be prepared to file "early and often."

Under the AIA, a patent application will be denied based on prior art if "the claimed invention was patented, described in a printed publication, or in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention." The provision expands the activities and publications that are considered to be "prior art" to patent applications.
Nonetheless, there are several key exceptions. For instance, if the inventor or another who obtained the subject matter from the inventor makes the disclosure, it is not considered prior art. In addition, disclosures made by a third party for subject matter that had been previously publicly disclosed by the inventor also fall under the exception. To qualify under the one-year grace period, these disclosures must be made within one year prior to filing a patent application. The scope of these exceptions remains to be determined. What if the invention was on sale privately but not "available to the public?" Does that start the one year clock?

In light of the changes, it is advantageous to file a provisional patent application as soon as practically possible. These patent applications are relatively low cost and require far less documentation that a standard, non-provisional patent application.

After the initial filing, inventors should file additional provisional patent applications that reflect improvements to the invention in the form of additional patentable subject matter. So long as a non-provisional patent application is filed within one year, the disclosures can be combined into a single filing.

In summary, filing early and often is the best way to prevent headaches down the road, including subsequent and intervening disclosures. To discuss your particular invention, we encourage you to contact one of our experienced patent attorneys for a free 30-minute consultation.

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