



Patent Reform 2011:

First Inventor to File

Purpose:

- Replaces the “first to invent” system previously used to determine the first inventor of the subject matter of a patent claim. Beginning on March 16, 2013, the law will now award the patent to the “first inventor to file” a patent application that discloses the subject matter, subject to certain exceptions discussed below. This change in the method for determining an inventor is intended to more closely harmonize the US Patent System with the rest of the world.

Broadened Definition of Prior Art:

- The definition of prior art available to cite against a claim in an application has been expanded. 35 U.S.C. 102(a)(1) now states:
“A person shall be entitled to a patent unless-- (1) 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 invention”
Previously, certain types of prior art were geographically limited, but now “prior use” and “on sale” activities are no longer limited to the U.S.
- It is unclear what “otherwise available to the public” will mean.

Patents and Published Applications as Prior Art:

- Patents and published patent application are available as prior art if their effective filing date is earlier than the priority date of an application. “Effectively filed” includes foreign priority dates, thereby legislatively abolishing the In re Hilmer doctrine which has long disadvantaged applicants filing first outside the U.S.
- Importantly, the effective priority date will apply for both novelty-defeating and obviousness, which is broader than approaches taken by other jurisdictions, notably the European Patent Office.
- There is an exception to prior art for commonly owned patents and patent applications and for patents and patent applications that are subject to a Joint Research Agreement that is in place prior to or at the time of filing an application. [Revised 35 U.S.C. § 102(d)]

Grace Period for Disclosure:

- A one-year grace period is provided for disclosure of the subject matter of a claim by an inventor, joint inventor or another person that directly or indirectly received information from the inventor or joint inventor. Unlike the prior law there is no grace period afforded to the inventor for any disclosure of the subject matter of a claim by another, unless that disclosure occurred after a public disclosure by the inventor, joint inventor or someone that received the information from the inventor or joint inventor. The ability to “swear behind” prior art of another is being eliminated. As a practical consideration, if a client has no interest in foreign patent rights, early publication followed by the filing of a US application within one year of disclosure should be considered. [Revised 35 U.S.C. § 102(b)]

Invention by Another:

- Interference Proceedings will be gradually eliminated in favor of a derivation proceeding. Interferences will remain available for all claims with an effective filing date before the change in the law (i.e., prior to March 16, 2013). A derivation proceeding will determine whether a party derived an invention from another. An applicant may file a petition with the USPTO to institute a derivation proceeding within one year of the first publication of a claim to the invention by another. [Revised 35 U.S.C. § 135]
- Civil Action for Derived Patents Created.
The filing of a civil action for a derived patent is a new cause of action when two patents are granted with claims to the same subject matter. The owner of a patent may bring suit for derivation within one year of the issuance of the first patent to another party containing a claim to the allegedly derived invention. [Revised 35 U.S.C. § 291]

Effective Date:

- The above changes apply to all applications with a filing date or effective filing date on or after March 16, 2013.