

THE NEW “FIRST INVENTOR TO FILE” RULES BEGIN MARCH 16, 2013

The America Invents Act (AIA), signed by President Obama into law on September 16, 2011, is the most significant overhaul of the US patent system since its codification in the Patent Act of 1952. For patent applications filed on or after March 16, 2013, the AIA expands the scope of prior art that can negate patentability to include any public disclosure, use or sale of the invention anywhere in the world prior to the filing date. (Under the existing system, oral disclosures, as well as uses or sales in a foreign country do not necessarily negate patentability.)

Perhaps most importantly for inventors at universities and research institutions, the AIA changes the “first-to-invent” rule to a “first-inventor-to-file” rule, under which an inventor will be denied patent protection if the claimed subject matter is disclosed or claimed in a patent application of another inventor, which has an *earlier* effective filing date.

These changes bring the US patent laws much closer to those of the rest of the world where *absolute novelty* is required for seeking patent protection for an invention. The AIA, however, provides exceptions to the absolute novelty requirement based on an inventor’s own public disclosures. In particular, it provides a one-year “grace period” during which publication of the invention by the inventor or someone who has obtained the invention from the inventor will not negate patentability.

Additionally, an inventor’s public disclosure of the invention can provide a shield against subsequent disclosures of that subject matter by others during the grace period to preserve the inventor’s patent rights. The AIA also excludes from prior art patent applications (unpublished prior to the effective filing date) that were owned or subject to assignment to the same entity not later than the effective filing date of the invention.

The publication exception can, however, be a trap for inventors who believe that they can preserve the broadest scope of their patent rights by simply publishing

the subject matter of the invention and subsequently filing a patent application during the grace period.

The temptation to rely on the publication grace period can be particularly strong in academic settings where researchers are eager to publish their research results as quickly as possible. The researchers may believe that they can have their cake and eat it too by publishing first and filing a patent application during the grace period.

This approach, however, has many pitfalls. Such publications can destroy foreign patent rights as most foreign jurisdictions continue to require absolute novelty as a condition of patentability.

Further, even if one is not concerned with foreign patent rights, such publication may not necessarily protect the inventor's US patent rights against public disclosures or patent filings of others during the grace period. One such scenario is depicted by the following illustration:

In the above illustration, inventor A publishes the subject matter of invention X and subsequently B publishes a variation of the subject matter published by A, depicted as X', during the grace period. Finally, inventor A files a patent application to seek patent protection for invention X before the end of the grace period. The publication by A may not act as a shield against the subsequent

publication by B as the subject matter published by B is not identical to that published by A.

The U.S. Patent Office recently published proposed guidance for examiners for implementing the patentability provisions of the AIA. Under the proposed guidance, in the above scenario, inventor A would not be able to rely on disclosure of X to remove X' as prior art. The guidance suggests that even if the differences between X and X' are "mere insubstantial changes, or only trivial or obvious variations," X' would remain as a prior art reference.

As the courts grapple with the interpretation of the AIA provisions in the coming years, we will know more how the courts will deal with such scenarios. This process will, however, take many years as patent applications filed under the new "first-inventor-to-file" regime percolate through the US Patent Office and then through the courts.

For now and foreseeable future, notwithstanding the grace period, filing of a patent application that adequately describes the invention prior to first publication remains the safest course of action for preserving patent rights.

FREQUENTLY ASKED QUESTIONS:

- Q. Can Tufts OTDIC file a patent application even if I have published my invention already?
- A. Yes and No. The AIA preserves the one-year grace period in the U.S. but publication before filing will preclude all foreign patent rights.
- Q. Will publication protect me against other inventors in the U.S. so long as Tufts ODIC files within the one-year grace period?
- A. Yes but only against inventors that have the same invention. If another inventor beats you to the Patent Office and has a different but closely related invention, you may lose your patent rights or be limited to the specific species or embodiments disclosed in your publication.

Q. Does a public oral disclosure constitute a publication?

A. A public oral disclosure (e.g., at a conference or open meeting) works just like a printed publication. It destroys foreign patent rights and it starts the clock running on your U.S. grace period. It also provides the same limited protection against other inventors who file first – and may present an additional headache for you: proving years later what you actually disclosed!