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Implementation of "First to File System" according to Provisions in the America Invents Act (AIA)

March 16, 2013 is a key date for filing United States patent applications. On this date, the US will implement the "First to File System" provisions in which the right to a patent is awarded to the first person to file a patent application for an invention (a system currently used in most jurisdictions, including Europe). The current system used in the US, and to be soon changed, is based on a "first-to-invent system" in which the right to a patent is granted to the first to invent.

It seems that one main practical difference between the "first to invent system" and the "first to file system", according to the U.S new provisions, stems from the different definition of prior art.

In general, the new provisions provide expanded scope of available prior art which can be used against patent applications and patents (for purpose of invalidation). For instance, under the current statute, public use in a country other the US, is not considered as prior art if it is not disclosed in a publication, patent, or patent application. In contrast, under the new provisions, prior use outside the US will be regarded as available prior art. Another example is the abolishment of Hilmer doctrine (which discriminated against non US priority patent applications).

The new provisions will apply on or after March 16, 2013. Therefore, the current US law will continue to apply to applications effectively filed before March 16, 2013. A late application



filed on or after March 16, 2013 taking priority of a provisional application filed before March 16, 2013, may not be entitled to be subject to the first to invent law under the current provisions, for example, if at least one claim in the later-filed US is different from the claims in the priority application; or in the case that the enablement requirement was not fulfilled in the priority but only in the late application.

In view of the transition from "First to Invent System" to "First to File System" strategic filing may be required. ***It is highly recommended to file patent applications on an invention in the US as soon as possible, before the new provisions are in effect.*** For this purpose, it is crucial to include sufficient information to fulfill enablement requirement of the patent application before it is filed, or to file a subsequent patent application with all that information before March 16, 2013.

This article is only the opinion of the authors and is not intended to constitute legal advice.