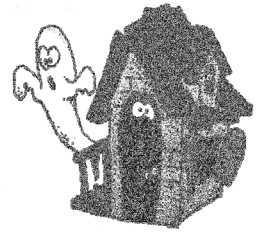




Mesmer & Deleault, PLLC
41 Brook Street, Manchester, NH 03104
Seacoast Office: One New Hampshire Ave., Suite 125
Portsmouth, NH 03801



“Tip of the Month”

Patent Reform: First-To-File, Disclosures, and Prior Art

On September 16, 2011, President Obama signed into law the Leahy-Smith America Invents Act. The America Invents Act (“AIA”) represents the most significant revision to the patent statute in several decades. One highly-publicized change to the statute is the switch to a first-to-file system instead of the first-to-invent system used prior to the AIA. The first-to-file provision will take effect 18 months after enactment, or March 18, 2013 and will apply to applications filed on or after that date.

This new first-to-file provision brings U.S. closer to the first-to-file system used in all other countries, but the U.S. version differs notably. Unlike the absolute novelty requirement in Europe, for example, the first-to-file system under the AIA provides for a one-year grace period during which an inventor may publicly disclose the invention without it being cited against the application as invalidating prior art. The first-to-file provision will also affect the definition of prior art and how prior art will be applied to patent applications. Here are some more changes:

First, under existing law, inventions disclosed (1) by someone other than the applicant, and (2) occurring less than one year before the date of the application, could be overcome as invalidating prior art by establishing that the applicant made the invention before the date of the publication. Under the first-to-file provision, this will no longer be the case. Instead, unless derived from the inventor, disclosures by someone other than the applicant will be considered prior art even when the applicant made the invention before the disclosure. In other words, competing claims to an invention will be decided based on the filing date alone. Because prior art will be measured against the date of application rather than the date of invention, applicants should file patent applications soon after making the invention to avoid losing the race to file.

Second, a sale or public use will now be considered prior art regardless of where it takes place. This is unlike the current law under which a sale or public use is prior art only when it occurs in U.S. Also, for U.S. applications claiming foreign priority, the prior art date will be determined from the foreign filing date rather than the U.S. filing date.

Third, an applicant’s own disclosure will not invalidate the applicant’s U.S. patent application if disclosed one year or less before filing. Thus, an inventor may still file an application in the U.S. without having the Patent Office citing the applicant’s own disclosure as invalidating prior art. On the other hand, an inventor’s disclosure will be prior art against later-filed applications of others. For a competitor who invented first, disclosing an invention may be strategically used to forestall the competitor’s patent application.

Fourth, disclosing an invention before filing a patent application will continue to bar patent protection in nearly every country outside of the U.S. As a general guideline, if it is possible that the applicant may wish to obtain foreign patent protection, the applicant should not disclose an invention before filing a patent application.

If you have questions about the America Invents Act or about intellectual property law in general, please call the attorneys at Mesmer & Deleault at 603-668-1971 or contact us by email at mailbox@biz-patlaw.com.

Frank B. Mesmer, Jr.
Robert R. Deleault
Steven H. Slovenski
Ross K. Krutsinger
1011

(603) 668-1971
Fax (603) 622-1445
E-mail: mailbox@biz-patlaw.com
Website: www.biz-patlaw.com