



Planning for the First to File

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Historically, the United States has been a first-to-invent jurisdiction. A diligent inventor that applied for a U.S. patent might be able to assert superior rights over a subsequent inventor, even if the subsequent inventor was the first to file a U.S. patent application. In contrast, most other nations are first-to-file jurisdictions, meaning that the first to file a patent application holds superior rights over another applicant who claims the same invention in a later-filed application. Some refer to such jurisdictions as “race to file” jurisdictions.

The Leahy-Smith America Invents Act, among other things, converts the United States to a first-to-file (or “first-inventor-to-file”) jurisdiction, and the first-to-file provisions will become effective in February 2013 once the Act is signed into law by President Obama. The President is expected to sign any day.

For patent applicants, what are some things to consider with the change to first-to-file?

* Review your pre-filing strategy and the nature of your field of technology. If the field is very active with research and development, or if you have competitors who might be working on technologies similar to yours, then welcome to the race to the PTO! Consider involving your patent attorney soon after conception of an invention.

* If you are in the race, review your use of provisional patent applications. Provisional patent applications face fewer requirements for formality, can cost less than non-provisional utility applications, and can generally be filed more quickly than non-provisional utility applications. Always bear in mind, though:

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In some cases an inexpensive and speedy filing may be possible by using or building on existing documents that describe an invention. This quest for speed, though, can encourage less formality or disclosure.

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There is a fundamental requirement that a provisional patent application be enabling; the standard is “a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same,” 35 U.S.C. 112¹.

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Potential infringers or patent examiners may study differences between a provisional patent application and a non-provisional or international Patent Cooperation Treaty (PCT) application. Substantial differences in subject matter could support arguments that a claim is not entitled the priority date of the provisional patent application, which could jeopardize a first-to-file claim.

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Provisional applications are not examined, and a non-provisional application claiming the benefit of a provisional application must be filed within 12 months of the provisional application filing date.

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A non-provisional utility or PCT application may claim the benefit of priority to multiple provisional patent applications. This can encourage incremental documentation of invention during development.

* Provisional patent applications are optional; if you understand the invention, believe that you have sufficient time, and are able to make the disclosure required for a non-provisional application, then it may be cheaper to file a non-provisional application as soon as possible.

* Do not discard your unused inventor’s notebooks. The legislation provides a proceeding to address patents that may have been improperly derived from others:

“(a) IN GENERAL — The owner of a patent may have relief by civil action against the owner of another patent that claims the same invention and has an earlier effective filing date, if the invention claimed in such other patent was derived from the inventor of the invention claimed in the patent owned by the person seeking relief under this section.

Leahy-Smith America Invents Act § 291(a).

* The PTO recently announced an initiative seeking preliminary input from “stakeholders and the public”

on regulations required under the Leahy-Smith America Invents Act, some of which must be implemented within a year. More information is available at <https://www.uspto.gov>.

¹ This can encourage greater formality and disclosure.

Should you have any questions, please contact M. Bruce Harper at 757.473.5357 or , or any other member of the Williams Mullen Intellectual Property Team.

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