

First-to-File Cautions and Strategies

When the U.S. Patent and Trademark Office (USPTO) adopted the America Invents Act (AIA) “first-to-file” system on March 16, the following scenarios became reality.

Scenario 1: U.S. Inventor A invents a widget and, relying on the one-year U.S. grace period, publishes the invention and applies for a U.S. patent within one year from publication. Within a year from the U.S. application filing date, Inventor A files an

Grace Period Standards

In Scenario 1, if Inventor A filed a U.S. patent application within six months of publication, the result would not change. This is because countries outside the U.S. (other than Korea) that allow for a pre-publication grace period measure the grace period back from the country’s domestic filing date.

The AIA went against this world standard by basing the U.S. pre-publication grace period on the earliest effective filing date which, for foreign-based applications, goes back to the original foreign (domestic) application filing date. Thus, under the AIA, both U.S. and foreign applications are completely equal with respect to the grace period.

Prior Art Exceptions

Consider Scenario 3: U.S. Inventor A invents a widget and, within the one-year grace period, publishes an article disclosing elements X and Y of the widget. After reading A’s publication, Competitor B publishes an article disclosing elements X, Y, and Z prior to the filing date of Inventor A’s U.S. patent application. Competitor B’s article will become a prior art against Inventor A’s patent application. That is, the one-year grace period cannot be invoked to remove Competitor B’s article as a prior art against Inventor A’s patent application.

The reason for the outcome of this scenario is as follows: The AIA provides that if an inventor publicly discloses their invention prior to filing, then any third-party disclosure made in the interim shall not be considered prior art to defeat patentability of the claimed invention. However, according to the USPTO’s Proposed Rules (*Federal Register*, Vol. 77, No. 144 / July 26, 2012/ Proposed Rules), this prior art exception can only be invoked if the subject matter in the third-party disclosure is substantially identical to the subject matter previously disclosed by the inventor. The proposed rules specify that even if the only differences between the inventor’s disclosure and the third-party disclosure “are mere insubstantial changes, or only trivial or obvious variations,” the prior art exception does not apply. (Note: the Examination Guidelines for Implementing the First Inventor To File Provisions of the Leahy-Smith America Invents Act published on February 14 have clarified that if the subject matter of an intervening disclosure is simply a more general description of



international patent application and claims priority to her U.S. patent application filing date. Result: Inventor A may obtain a granted U.S. patent, but her publication prior to filing her U.S. patent application (reliance upon the U.S. one-year grace period) will bar her from obtaining a patent in most foreign countries.

Scenario 2: Japanese Inventor B invents a widget and, relying on the six-month Japanese grace period, publishes the invention and applies for a Japanese patent within six months from publication. Within a year from the Japanese application filing date, Inventor B files a patent application in the U.S. and claims priority to his Japanese patent application filing date. Result: Inventor B may be granted both a Japanese and a U.S. patent.



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subject matter previously publicly disclosed by the inventor or a joint inventor, the prior art exception does apply.)

Therefore, if an inventor publishes their invention prior to filing a patent application, third parties can create prior art that can be used against the inventor's patent application by merely publishing minor variations on the original invention.

Protection Limitations

In Scenario 4, two researchers meet at a conference and discuss a similar invention they are independently working on. Realizing that each is close to protecting their common invention, Researcher A immediately publishes a paper on the invention to create prior art against Researcher B. Subsequently Researcher B files for a U.S. patent application on the invention, after which Researcher A files a patent application on the invention.

As a result, Researcher A's publication prevents Researcher B from obtaining a patent, and Researcher B's patent application prevents Researcher A from obtaining a patent. Since neither can obtain a patent, the invention cannot be protected. The promoted goal of the AIA to "give a boost to American companies and inventors ... and let them focus instead on innovation and job creation" is completely lost in this scenario.

Although a one-year grace period to file a patent application is still available under the AIA, the grace period protection is not applicable to most publications by persons other than the inventor(s). Under the AIA, the grace period is personal to the inventor(s), and offers only limited protection from third-party publications. The exclusions to the one-year grace period offer new opportunities for so-called defensive publications to prevent others from obtaining patent protection.

Final Considerations

In light of these and other possible scenarios, the best strategy for inventors and patent applicants is to file patent applications as early as possible and ideally before any publication is made. If necessary, companies should develop procedures to file provisional applications rapidly when needed.

Companies and/or inventors should avoid disclosing too much information about development plans or progress on projects that might spur competitors into filing their own patent applications or publications. Remember that the one-year grace period does not apply to publications by others and that relying on the one-year grace period can become a bar to obtaining foreign patents. 🌐

