



ARE Patent Law Alert: USPTO Issues Proposed Rules For Implementing A First-Inventor-To-File System

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(July 30, 2012) On July 26, 2012, the USPTO issued proposed rules and examination guidelines for the first-inventor-to-file patent system set to take effect on March 16, 2013, providing guidance on how the USPTO plans to handle patents affected by the AIA.

Generally, the proposed rules seek to follow the tenets of the new law and existing case law as much as possible, but provide a few useful clarifications.

The proposed rules implement a procedure by which affidavits may be used to establish derivation of a potential prior art reference, to enable an applicant to invoke the prior art exceptions in new 35 U.S.C. § 102(b).

The proposed rules also set forth a time period required to file a certified copy of a foreign priority application in order to perfect priority claims.

Turning to examples from known case law, the proposed guidelines identify a number of useful examples of what should be considered “otherwise available to the public” under new 35 U.S.C. § 102(a)(1), including “a student thesis in a university library, a poster display or other information disseminated at a scientific meeting, subject matter in a laid-open patent application, a document electronically posted on the Internet, or a commercial transaction that does not constitute a sale under the Uniform Commercial Code.” The guidelines provide as a touchstone that “the claimed invention is made sufficiently available to the public,” even if it may not otherwise qualify as a printed publication or sale.

Since the new rules will not apply to all applications pending after March 16, 2013, the proposed rules set forth procedures to help the PTO distinguish between which rules should apply. The proposed rules put the burden on the applicant to identify whether a claim to an invention that has an effective date on or after March 16, 2013 has been presented, or has additional subject matter with an effective date on or after March 16, 2013, for which no claim to the new subject matter has been presented.

One of the most difficult issues raised in the AIA is the details of the “disclosures” which are invoked in the “Exceptions” provision of new 35 U.S.C. § 102(b). In particular, under new Section 102(b), a grace period of up to 1 year is provided based on prior disclosures by an inventor. This exception also applies to third party disclosures that are derived from the



inventor's disclosure. The proposed examination guidelines adds as a gloss to this provision that the portions of the third party disclosure "relied upon" during examination should be compared to the disclosure from the inventor in order to invoke the exception. However, that comparison will not allow for even "mere insubstantial changes, or only trivial or obvious variations" for the exception to be invoked. We expect that objections to this gloss will be raised by the commentators during the public notice and comment period.

We will continue to monitor the America Invents Act as new rules are issued, and encourage you to review the publications and events page of our firm website (www.arelaw.com) for more information. Please feel free to contact one of our firm's attorneys to learn more.

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