Cooley

February 21, 2013

The provisions of the America Invents Act (AIA) that implement the new first-inventor-to-file patent system in the United States become effective on March 16, 2013.[1] One aspect of these provisions is the expansion of the activities and publications that are considered to be "prior art" to patent applications. Key changes to prior art and related safe harbors are summarized in the table below and their application to common scenarios is explored in the following hypotheticals.

Key Changes to Prior Art

Activities and Publications	Pre-AIA	AIA
Publications, public use, sale	Publications before the date of invention **Domestic** public use, sale, offer for sale one year before filing date	Publications before the filing date[2] **World-wide** public use, sale, offer for sale before the filing date[2]
Published Applications	Published US/PCT applications and US patents by another as of the earliest **US** priority date or international filing date	Published US/PCT applications and US patents, naming another inventor, as of earliest US or foreign priority date[3]

Grace period for all disclosures	One year grace period for all disclosures if date of invention is before disclosure (swear behind) One year grace period for disclosures made by the inventor (not by another)	One year grace period for disclosures made by the inventor or another who obtained the subject matter from the inventor[4] One year grace period for disclosures made by a third party for subject matter that had been previously publicly disclosed by the inventor or another who obtained the subject matter from the inventor[5]
Exceptions for disclosures in applications/patents[6]		Disclosure was obtained from inventor[7] Subject matter had been previously publicly disclosed by the inventor or another who obtained the subject matter from the inventor[8] Disclosure and claimed invention were owned by the same person or subject to obligation to assign to same person before or on the effective filing date of the claimed invention[9]

Our company made an invention, and before we filed a patent application, our marketing team published an article (e.g., press release, web site, journal article) describing the invention. Will the article be prior art? Yes in many foreign countries and maybe in the U.S., depending on when the application is filed. The article will not be prior art in the U.S. if your application is filed within *one year* of the article's publication date. However, it will be prior art against applications filed outside of the U.S., including European applications.

Our company made an invention, and before we filed a patent application or published an article on that invention, our competitor filed a patent application or published an article describing the same invention. Will our competitor's patent application or article be prior art? Yes, with a possible exception in the U.S. Under the current law you may be able to "swear behind" your competitor's patent application/article and remove it as prior art in the U.S. Under the AIA, however, your competitor's patent application/article will be prior art *unless* they obtained information on the invention directly or indirectly from one of your inventors. Similar to the situation in the above hypothetical, your competitor's patent application/article will be prior art against applications filed outside of the U.S., including European applications. We recommend filing claims prior to March 16, 2013 to

retain the ability to swear behind under the current law.

Our company published an article on an invention first, but before we filed a patent application, our competitor filed a patent application or published a similar article describing the invention? Will our competitor's patent application or article be prior art? For the most part, yes. In the U.S., the prior art effect of your competitor's patent application/article should be limited, but still a significant concern. If your patent application is filed within one year of publishing your article, then your competitor's patent application/article will not be prior art for disclosure that can be found in your earlier-published article. However, your competitor's patent application/article will be prior art for any additional disclosure it contains. Because patent applications often contain significant additional disclosure, the 'protection' afforded by your earlier-published article could be insufficient. Also, your earlier-published article and your competitor's patent application/article will both be prior art against applications filed outside of the U.S., including European applications.

To be clear, and despite the grace periods and exceptions under the AIA, we strongly discourage publishing or otherwise disclosing your invention(s) before filing a complete patent application. Among other concerns, such publication(s) could limit your patent rights in the U.S. and will bar such rights in foreign countries. For instance, any earlier-published articles on your invention (even your own) will be prior art against applications filed outside of the U.S., and available for evaluating both the novelty and inventiveness (or non-obviousness) of that invention. We believe the best strategy for world-wide patentability is to file a complete patent application as soon as your invention is 'ready.' Our patent attorneys can help you assess the readiness of an invention in this regard.

Our company demonstrated an invention at a tradeshow in Canada or sold the invention in Canada (or other foreign country) before a patent application was filed. Does the demonstration or sale affect our U.S. patent rights? Yes, unless a patent application is filed within *one year* of the demonstration or sale, the subject matter of the demonstration or sale will be prior art. Note that this result is a change from the current law under which a public use or sale of an invention has to occur in the United States to qualify as prior art.

An inventor from our company discussed our invention with Company X under a confidential disclosure agreement, and Company X subsequently filed a patent application directed to our invention before our company filed its patent application. Do we have any recourse notwithstanding Company X filed first? Yes, your company may challenge Company X's application by instituting a derivation proceeding in the Patent Office. Only the true inventors of an invention are entitled to a patent on the invention. In this scenario, your company may file a petition accompanied by substantial evidence demonstrating that one or more inventors of Company X's patent application derived the claimed invention from your company's inventor, as long as your company files its own patent application claiming the same or substantially the same invention.

Since there are no more interference proceedings and an applicant cannot "swear behind" prior art references under new applications subject to the AIA, is there any reason to maintain witnessed records of the conception and reduction to practice of an invention? Yes, it is still good practice to maintain detailed and accurate records of the development of an invention and records of any correspondence with third parties regarding the invention. Such records are important in derivation proceedings, because a showing of derivation must be supported by substantial evidence. It is also good practice to have a confidential disclosure agreement in place before you discuss a potential invention with a third party.

The table and hypotheticals above summarize certain key changes to prior art under the AIA, and illustrate how those changes are expected to play out in some fairly common scenarios. We hope this information helps you begin to understand how the AIA will impact your patent strategies going forward. However, this information is not comprehensive, and we understand that business and life can create any number of scenarios that differ from the above. Accordingly, please feel free to contact your Cooley patent attorney for more information on how best to navigate these changes to U.S. patent law.

Notes

1. On February 14, 2013, the U.S. Patent and Trademark Office (USPTO) issued the final rules governing the "first-inventor-to-file" provisions enacted by Section 3 of the AIA.
2. 35 U.S.C. § 102(a)(1).
3. 35 U.S.C. § 102(a)(2).
4. 35 U.S.C. § 102(b)(1)(A).
5. 35 U.S.C. § 102(b)(1)(B).
6. Other provisions of the AIA may apply to applications/patents, making them prior art regardless of these

exceptions. Please contact your patent attorney for details.
7. 35 U.S.C. § 102(b)(2)(A).
8. 35 U.S.C. § 102(b)(2)(B).
9. 35 U.S.C. § 102(b)(2)(C).

This content is provided for general informational purposes only, and your access or use of the content does not create an attorney-client relationship between you or your organization and Cooley LLP, Cooley (UK) LLP, or any other affiliated practice or entity (collectively referred to as "Cooley"). By accessing this content, you agree that the information provided does not constitute legal or other professional advice. This content is not a substitute for obtaining legal advice from a qualified attorney licensed in your jurisdiction, and you should not act or refrain from acting based on this content. This content may be changed without notice. It is not guaranteed to be complete, correct or up to date, and it may not reflect the most current legal developments. Prior results do not guarantee a similar outcome. Do not send any confidential information to Cooley, as we do not have any duty to keep any information you provide to us confidential. When advising companies, our attorney-client relationship is with the company, not with any individual. This content may have been generated with the assistance of artificial intelligence (AI) in accordance with our AI Principles, may be considered Attorney Advertising and is subject to our legal notices.

Key Contacts

Dr. Bonnie Weiss McLeod Washington, DC	bweissmcleod@cooley.com +1 202 842 7833
Dr. Carol Laherty Seattle	claherty@cooley.com +1 206 452 8777

This information is a general description of the law; it is not intended to provide specific legal advice nor is it intended to create an attorney-client relationship with Cooley LLP. Before taking any action on this information you should seek professional counsel.

Copyright © 2023 Cooley LLP, 3175 Hanover Street, Palo Alto, CA 94304; Cooley (UK) LLP, 22 Bishopsgate, London, UK EC2N 4BQ. Permission is granted to make and redistribute, without charge, copies of this entire document provided that such copies are complete and unaltered and identify Cooley LLP as the author. All other rights reserved.