Cooley

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On March 16, 2013, the United States switches from the current first-to-invent patent system to a new first-inventor-to-file (first-to-file) patent system under the America Invents Act (AIA). Patent applications entitled to a priority filing date prior to March 16, 2013 will be examined under the current first-to-invent rules. However, applications having even one claim with an *effective* filing date after March 15, 2013 will fall under the new first-to-file rules.

Since the new rules significantly expand the scope of prior art that can be cited against an application, it is important to consider filing applications before March 16, 2013 to increase the likelihood that they will be examined under the old rules, particularly under any of the following situations.

I have a new invention. Should I file a provisional application before March 16, 2013?

Yes, you should file a new provisional application before March 16, 2013. This application should be as complete as possible and include detailed description of all embodiments and all available supporting data, as well as fully developed claim sets.

There is a tendency to add to a pending provisional application at the time of conversion. Be aware that if you add claims with an *effective* filing date on or after March 16, 2013, examination of the application will be under the first-to-file rules. To minimize this risk, consider filing two applications at the time of conversion, where one application includes only pre-March 16, 2013 claims and subject matter.

I have a pending provisional application with a one year date after March 15, 2013. Is there anything I need to do before March 16, 2013?

If you have additional data or disclosure that you plan to add to the application by the one year date, you should file another application *before* March 16, 2013. This application should include all the new data and disclosure, as well as any additional claims being considered. The new application could be either a provisional application or a utility application (or both), considering both the likelihood of additional data or disclosure being generated on or after March 16, 2013 and the effect on patent term.

I have a pending utility application. Is there anything I need to do before March 16, 2013?

Should I file a continuation and/or divisional before March 16, 2013?

Consider filing continuations and/or divisionals with complete claim sets *before* March 16, 2013, so they will be examined under the first-to-invent rules, particularly if you are considering making any amendments to the original claims.

Continuations and/or divisionals filed *after* March 15, 2013 will be examined under the first-to-invent rules only if all claims have an *effective* filing date before March 16, 2013.

Is there a benefit to filing multiple continuations and/or divisionals before March 16, 2013?

Yes. Once the first-to-file rules apply to an application, they will apply to that application and to all children of that application. The first-to-file rules will apply to applications containing at any time even one claim entitled to an effective filing date after March 15, 2013, and to applications that claim priority to an application that falls under the first-to-file rules (even if this priority claim is later removed).

By maintaining separate lines of applications, you can increase the likelihood of being able to prosecute claims clearly supported by a parent application filed before March 16, 2013 under the first-to-invent rules, while providing the flexibility to prosecute amended or new claims in another line.

I'm drafting new claims for an existing application. Should I file the new claims before March 16, 2013?

Yes. Remember, if you file any claims in the future that are not entitled to an effective filing date before March 16, 2013, the application will be examined under the first-to-file rules, and any applications claiming priority to this application will also be subject to the first-to-file rules. Also remember that categorization of an application under the first-to-file rules cannot be cured by canceling the claims that are denied benefit of priority.

Consider filing new claims prior to March 16, 2013, if you have an application from which you would like to pursue claims to cover a particular product that the application wasn't designed for originally.

When filing new claims, always consider filing multiple applications before March 16, 2013, as maintaining a line clearly entitled to an effective filing date prior to March 16, 2013 minimizes the risk that the first-to-file rules will apply to every claim you prosecute.

While this list highlights important considerations in the months leading up to March 16, 2013, it is not exhaustive and other scenarios may be encountered. Two key consequences of being examined under the first-to-file system are: (1) the prior art pool will be expanded; and (2) showing an earlier date of invention to overcome rejections will no longer be an option. Understanding these consequences is especially important for crowded and fast-moving fields where multiple applications may be filed within a short period of time.

Cooley's patent practitioners are available to assist you in implementing the best filing strategies for navigating the switch in patent regimes given your particular circumstances.

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