

**RECOMMENDATION FOR FILING PATENT APPLICATIONS IN ANTICIPATION OF
THE FIRST-INVENTOR-TO FILE RULES OF THE AMERICA INVENTS ACT**

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Effects of Current Law and AIA on Prior Art

Beginning on March 16, 2013, in the US patents will no longer be granted to the first-to-invent (FTI) they will go instead to the first-inventor-to-file (FITF). This change was implemented according to the America Invents Act (AIA) by changing the definition of prior art in the current law.

The current law under 35 U.S.C. §102 contains several conditions for patentability, including conditions based on date of invention and others conditions based on filing date. These conditions in the current law were modified or eliminated by the AIA in favor of two conditions. Thus, the definition of prior art in the current law is different from the definition of prior art in the AIA.

Upon comparing the definition of prior art according to the current law to the definition of prior art according to the AIA, it becomes clear that the definition of prior art according to the AIA is broader in some important respects and narrower in others than the definition of prior art according to the current law. In other words the pool of prior art effective to defeat patentability according to the AIA is larger than the pool of prior art according to the current law. Below is a table which provides the details of the comparison of the different definitions and the results of the comparisons.

Definition of Prior Art Under Current Law (Old Definition)	Definition of Prior Art Under AIA (New Definition)	Comparison of Old & New Definitions (Is New Definition Broader or Narrower?)
<p>§102(a): Known or used by others in this country.</p>	<p>§102(a)(1): Patented, printed publication, in public use, on sale, or otherwise available to the public.</p>	<p>Broader: Public use, on sale, and otherwise available to the public, anywhere.</p>
<p>§102(b): Patented or described in a printed publication anywhere, or in public use or on sale in this country.</p>		
<p>§102(c): The inventor abandoned his invention.</p>	<p>Deleted</p>	<p>Narrower: Eliminates this potential source of prior art.</p>
<p>§102(d): Application for patent was filed anywhere more than a year before it was filed in the United States.</p>	<p>§102(a)(2): Described in a patent or application filed by another before effective filing date.</p>	<p>Broader: Foreign application no longer needs to designate the "US" under the PCT to be prior art.</p>
<p>§102(e): Described in prior patents or published applications of others.</p>		
<p>§102(f): Derived from another.</p>	<p>Deleted</p>	<p>Narrower: Derivation proceedings are available but are limited to certain conditions.</p>
<p>§102(g): Prior invention.</p>	<p>Deleted</p>	<p>Narrower: Eliminates prior invention as prior art.</p>

Recommendation for Filing Patent Applications in Light of AIA

Based on the above it is our view that the definition of prior art is broader after March 16, 2013. Thus, an application filed before March 16, 2013 would have less prior art to defeat its patentability than an application filed after March 16, 2013.

Therefore, we recommend that applicants file whatever applications they can before March 16, 2013. Our position is the same even if changes that narrow/eliminate types of prior art that take effect under the AIA are helpful to a particular applicant. It is our opinion that the law will be unsettled for a generation, repeatedly requiring judicial interpretation, thereby potentially having a negative impact on an invention for which patent protection can be pursued now. This unpredictability of the AIA alone favors early filing.

Accordingly, we recommend that Applicants begin immediately getting all invention disclosures before the review committee for approval. Inventors should be encouraged to submit all invention disclosures that they may have been holding on to, or for ideas they have been sitting on. Now is a time you may want to hold more frequent patent review meetings to clear the new disclosures. Also, outside counsel should be given specific instructions on how to handle applications they are currently drafting and any new drafting orders they may receive. Specifically, it should be made clear the dates drafts are to be completed and final versions are to be filed.