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Race to File Under the America Invents Act

The Leahy-Smith America Invents Act (“AIA”) is the most significant change to patent law since the 1952 Patent Act. The USPTO has gradually implemented numerous provisions of the AIA. Significantly, patent applications filed on or after March 16, 2013 will be subject to the following Rule changes:

- **First-to-File System.** Previously, patent applications were filed based on a “first-to-invent” system. Now, the patent system will rely upon a first-to-file rule, whereby an inventor who first files a patent application will beat later-filed applications. Additionally, this will be accompanied by an expanded definition of prior-art, which will include public uses and public sales outside of the United States, as well as the availability of patents and published patent applications on their earliest filing date.
- **Derivation Proceedings.** As a result of the new “first-to-file” rule, interference proceedings aimed at resolving priority disputes among separate but simultaneous inventors will be eliminated. Instead, the USPTO will utilize a new administrative proceeding (a “derivation” proceeding) to ensure that the first inventor to file a patent application is the original inventor, and that the application was not derived from another.

- **Statutory Invention Registration.**

Previously, statutory invention registrations (“SIRs”) were used by inventors to publish patent applications on subject matter for which it would not seek patent protection. This would place the subject matter in the public domain, and would effectively prevent others from obtaining a patent on the invention. The USPTO will no longer accept SIRs.

BEST PRACTICES

Patent applicants should modify their intellectual property strategy. First, patent applications should be filed as soon as possible to comply with the first-to-file system. Efficient, stream-lined internal procedures should be put in place in order to facilitate information collection and assist patent drafting. Second, evidence relevant to inventorship should be preserved for possible derivation proceedings. Detailed laboratory notebooks, invention memorandum, and other evidence concerning conception and reduction of practice should be gathered and archived. AIA provisions will have a major impact on patent practice, and potential patent applicants are well-advised to be aware of the upcoming effective date. documentation (including on-going risk analyses, policies and procedures, training logs, and disclosure logs) organized and easily accessible, so that OCR can be provided with evidence of general HIPAA compliance quickly and without difficulty.