



## America Invents Act (AIA)

### Key Provisions of Change to First-to-File System

#### Definition of “Effective Filing Date”

Under the AIA, the “effective filing date” for a claimed invention means the actual filing date of the patent or the application containing a claim to the invention, or the filing date of the earliest application for which the application or patent is entitled to a right of priority for the claimed invention (including domestic and foreign priority claims).

#### Section 102(a) and (b): Novelty and First to File

##### First to File:

- Under the AIA, the “first to file” system replaces the “first to invent” system. Thus, a person would not be entitled to a patent if the claimed invention was first described in a U.S. patent or in a published U.S. application by another having an earlier effective filing date. §102(a)(2).

##### Novelty Requirement:

- To meet the novelty requirement, an invention must not have been (1) patented, (2) described in a printed publication, (3) in public use, (4) on sale, (5) or otherwise available to the public, anywhere in the world, before the effective filing date of the claimed invention. § 102(a)(1).

##### Expanded Scope of Prior Art:

- In connection with the change to a first-to-file system, the AIA also expands the scope of prior art that can be used to defeat patentability. The chart below illustrates the new types of prior art that can be used to make rejections after March 16, 2013:

Type of Prior Art	First-to-Invent (Current System)	First-to-File (Effective March 16, 2013)
Foreign Offers for Sale	No	Yes
Foreign Sales	No	Yes
Foreign Public Use	No	Yes
US application with foreign priority claim	Yes (but only as of its US filing date)	Yes (as of its foreign filing date)
International application with foreign priority claim	Yes (but only as of its international filing date)	Yes (as of its foreign filing date)

**When Inventor's Disclosure is not Prior Art under § 102(a)(1):**

- A disclosure of an invention by the inventor(s) or another who obtained knowledge of the invention from the inventor(s) is not prior art under 102(a)(1) if the disclosure is made one year or less before the effective filing date of the claimed invention. § 102(b)(1)(A). For example, a publication by an inventor made within one year of the effective filing date of the claimed invention will not destroy novelty.

**When an Inventor Can Overcome a Disclosure by Another:**

- A disclosure by another is not prior art under § 102(a)(1) if the inventor or another who obtained knowledge of the invention from the inventor had disclosed the claimed invention: (i) before the disclosure by the other party and (ii) within one year of the effective filing date of the claimed invention. § 102(b)(1)(B).

**When an Inventor Can Overcome an Earlier Filed Application:**

- An earlier-filed application or patent is not prior art under §102(a)(2) with respect to a later-filed application if the claimed subject matter was obtained directly or indirectly from the inventor of the later-filed application. §102(b)(2)(A).
- A later-filed application is given priority over an earlier-filed application if the inventor of the later-filed application publicly disclosed (e.g., published) the claimed invention before the effective filing date of the earlier-filed application and within one year of the later-filed application. §102(b)(2)(B).
- An earlier-filed application or patent is not prior art under §102(a)(2) with respect to a later-filed application if the earlier earlier-filed application or patent and the later-filed application were commonly owned or subject to an obligation of assignment to the same person as of the effective filing date of the later-filed application. §102(b)(2)(C).

**Section 102(a) and (b) Practice Tips:**

- The date of invention is no longer relevant to prior art. An applicant can no longer “swear behind” a prior art reference by establishing an earlier invention date.
- Legislative history of the AIA suggests that the meaning of “otherwise available to the public” in section 102(a)(1) requires a disclosure of the claimed invention in such a manner that one skilled in the art could, through reasonable diligence, find the disclosure and understand the invention.
- When delaying the filing of an application, applicants may want to consider publishing a description of the invention to avoid intervening prior art that arises between the publication and the eventual filing date, as long as the application is filed within one year of the publication. § 102(b)(1)(B) and (b)(2)(B). However, such pre-filing publications (or other pre-filing disclosures) have some significant disadvantages, including destroying patent rights in many foreign countries. Also, many of the legal consequences of pre-filing disclosures remain unknown. For example, it remains unclear as to whether a later disclosure of an obvious variant of subject matter earlier disclosed by an inventor would constitute prior art against that inventor.
- An application filed on or after March 16, 2013, will be examined under pre-AIA statute governing prior art if all claims of the application have an effective filing date earlier than March 16, 2013. Conversely, an application filed on or after March 16, 2013, and claiming a priority date earlier than March 16, 2013, will be examined under the AIA if the application contains even a single claim having an effective filing date of March 16, 2013 or later. Thus, an applicant should file any new, non-provisional applications and continuation-in-part applications before March 16, 2013, to ensure examination under pre-AIA prior art rules.