

## America Invents Act

On September 16, 2011, President Obama signed into law The America Invents Act. Seven years in the making, the AIA is the first major overhaul of the U.S. patent system in over 50 years.

The most significant change under the new law is that, **effective March 16, 2013**, the U.S. changed from a “first to invent” to a “first inventor to file” system, thus bringing it into line with most other patent jurisdictions around the world. With this change, if two people separately apply for patents on the same invention, the patent will go to the inventor who filed a patent application first (assuming that neither inventor published prior to filing).

Although the new law does preserve the traditional one-year grace period for an inventor to file a patent application after making a public disclosure, OTL feels it makes more sense strategically to proceed as if the U.S. had transitioned to a true “first to file” system, such as exists in Europe. Thus, it will be very important for inventors to disclose inventions and work with us prior to publication. **OTL has made a decision that we will not file patent applications if the invention has been publicly disclosed prior to filing.**

Conversion of the U.S. from a “first to invent” to “first inventor to file” system is intended to provide inventors with greater certainty regarding the scope of protection for intellectual property, as well as promote international uniformity by harmonizing the U.S. patent system with those of its trading partners.

The AIA also makes it easier to challenge a patent after issuance, and to provide input while a third party’s patent application is being examined. More specifically:

- After a patent application has been filed and prior to the patent being granted, any third party may submit relevant publications for the patent examiner to consider.
- Following grant of a patent, there will be a 9-month window during which any third party may challenge the patent on any statutory grounds.
- Nine months after grant, any third party may file for review limited to consideration of certain patentability issues based on prior art patents and printed publications.

A note about provisional patent applications – while it is true that the AIA emphasizes filing early, it is also true that provisional patent applications still need to be as complete and detailed as possible at the time of filing. Other aspects of the new law, such as increased ability of third parties to provide input at various stages of prosecution, make this particularly important. Patent applications still have to be sufficiently supported and enabled in order to be as strong as possible.