

# One Minute Memo<sup>®</sup>



## Filing Deadline for Patent Applications to Avoid New Prior Art and First-to-File Limitations

Several provisions of the America Invents Act relating to the types of prior art that can be used against patent applications go into effect March 16, 2013. Many of these provisions dramatically expand the prior art the U.S. Patent Office can use to determine whether an invention is patentable in the United States. Therefore, consideration should be made to file patent applications before the March 16 changes.

In particular, after March 16, 2013, numerous activities will be considered “prior art” that automatically render an invention unpatentable. Currently, prior art includes evidence showing that the invention disclosed and claimed in the application was sold, offered for sale, or in public use more than one year prior to the filing of a patent application, but only if that activity occurred in the United States. Starting March 16, any sale, offer for sale, or public use the invention anywhere in the world more than one year prior to the filing of a patent application is considered prior art, rendering the invention unpatentable in the United States.

Another important change beginning March 16 is the move from a “first to invent” to a “first to file” system. Currently, under the “first-to-invent” system, a patent application is given priority based on the date of invention, not the date the application was filed with the US Patent Office. Therefore, under the current “first to invent” system, a patent applicant can overcome prior art by showing he invented his invention before the publication date of the prior art, thus rendering that prior art moot. After March 16, however, an applicant can no longer overcome such prior art by relying on the date the invention was invented, because the application’s priority is fixed to the date it was filed with the U.S. Patent Office. This means that any prior art published before the application filing date can be used to render an invention unpatentable, regardless of whether the inventor actually invented his invention before the prior art was published.

The March 16 provisions provide additional barriers to obtaining meaningful patent protection in the United States, compared to the current system. Therefore, there may be significant benefits to file patent applications before the March 16, 2013 changes in the law. If you have any inventions that you are considering seeking patent protection, please contact one of our registered patent attorneys.

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