

Kluwer Patent Blog

The Prior Art Effect Of PCT Applications Under The America Invents Act

Courtenay C. Brinckerhoff (Foley&Lardner LLP) · Monday, February 18th, 2013

Now that we are less than one month away from implementation of the First-Inventor-To-File provisions of the America Invents Act (AIA), stakeholders are considering whether to file new patent applications now, to secure examination under the current First-To-Invent patent system, or wait until March 16, 2013, so that the applications will be governed by the new U.S. patent laws. While there are a few situations where delaying filing could be advantageous, stakeholders do **not** need to wait to file their patent applications until March 16, 2013 in order to maximize their prior art effect.

35 USC § 102(e) Versus 35 USC § 102(a)(2)

The prior art effect of a published U.S. or PCT application currently is governed by 35 USC § 102(e):

A person shall be entitled to a patent unless:

(e) the invention was described in - (1) an application for patent, published under section 122(b) by another **filed in the United States** before the invention by the applicant for patent or (2) a patent granted on an application for patent by another **filed in the United States** before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language

This means that a published U.S. or PCT application can be cited as of its earliest effective **U.S.** filing date.

The AIA replaces § 102(e) with § 102(a)(2):

A person shall be entitled to a patent unless:

(2) the claimed invention was described in a patent issued under section 151, or in an application for patent published or deemed published under section 122(b), in which the patent or application, as the case may be, names another inventor and

was **effectively filed** before the effective filing date of the claimed invention.

Section 102(d) of the AIA also is relevant:

(d) PATENTS AND PUBLISHED APPLICATIONS EFFECTIVE AS PRIOR ART.—For purposes of determining whether a patent or application for patent is prior art to a claimed invention under subsection (a)(2), such patent or application shall be considered to have been effectively filed, with respect to any subject matter described in the patent or application—

(1) if paragraph (2) does not apply, as of the actual filing date of the patent or the application for patent; or

(2) if the patent or application for patent is entitled to claim a right of priority under section 119, 365(a), or 365(b), or to claim the benefit of an earlier filing date under section 120, 121, or 365(c), based upon 1 or more prior filed applications for patent, **as of the filing date of the earliest such application that describes the subject matter.**

This means that, under the AIA, a published U.S. or PCT application can be cited as of its earliest effective filing date, including an effective filing date based on a foreign priority application. In practice, this means that a published U.S. or PCT application based on a foreign priority application could be effective as prior art **one year earlier** under the AIA than under current U.S. patent laws.

Should I Wait To File My Patent Application To Maximize Its Prior Art Effect?

The AIA has a complicated effective date, based on the effective filing date of the claims presented in the patent application at issue. In particular, under section 3(n)(1) of the AIA, applications filed before March 16, 2013 (“pre-AIA applications”) will be subject to the current First-To-Invent laws, while applications filed on or after March 16, 2013 will be subject to the new First-Inventor-To-File laws (“AIA applications”), unless all claims are supported by an earlier application such that they have an effective filing date before March 16, 2013.

But, this does **not** mean that stakeholders should wait to file their patent applications until March 16, 2013 in order to maximize their prior art effect. This is because the effective date provisions of the AIA govern which applications will be **examined** under the new First-Inventor-To-File laws, not which applications can be cited as **prior art** under § 102(a)(2) and § 102(d) of the AIA.

A published U.S. or PCT application need not itself be an AIA application in order to be citable as of its foreign priority date against AIA applications.

Examples

Application A was filed in the U.S. on February 15, 2013. (Application A will be subject to the current First-To-Invent laws.)

- Once published, Application A can be cited against pre-AIA applications as of February 15, 2013.
- Once published, Application A can be cited against AIA applications as of February 15, 2013.

Application B was filed in the U.S. on February 15, 2013, and claims priority under 35 USC § 119 to a foreign application filed on February 15, 2012. (Application B will be subject to the current First-To-Invent laws.)

- Once published, Application B can be cited against pre-AIA applications as of February 15, 2013.
- Once published, Application B can be cited against AIA applications as of February 15, 2012.

Application C was filed as a PCT application on February 15, 2013, and claims priority to a foreign application filed on February 15, 2012. (The U.S. national phase of Application C will be subject to the current First-To-Invent laws.)

- Once published, PCT Application C can be cited against pre-AIA applications as of February 15, 2013.
- Once published, PCT Application C can be cited against AIA applications as of February 15, 2012.

Application D is filed in a foreign patent office on February 15, 2013, and a PCT application will be filed by February 15, 2014. (The U.S. national phase of the PCT application based on Application D will be subject to the current First-To-Invent laws as long as all claims are fully supported by Application D, such that all claims have a pre-AIA effective filing date of February 15, 2013.)

- Because Application D does not have an effective U.S. filing date before March 16, 2013, any PCT or U.S. application based on Application D will not qualify as prior art against pre-AIA applications.
- Once published, any PCT or U.S. application based on Application D can be cited against AIA applications as of February 15, 2013.

Application E is filed anywhere in the world on March 16, 2013. (Any U.S. application based on Application E will be subject to the First-Inventor-To-File laws.)

- Because Application E is filed after the effective date of the AIA, any PCT or U.S. application based on Application E will not qualify as prior art against pre-AIA applications.
- Once published, any PCT or U.S. application based on Application E can be cited against AIA applications as of March 16, 2013.

These examples illustrate that stakeholders interested in maximizing the prior art effects of their patent applications should file PCT or U.S. applications **now**, before March 16, 2013, in able to qualify as prior art under § 102(e) against pre-AIA applications filed in the next few weeks. Those applications, once published, also will be citable against AIA applications as of their effective filing dates, including effective filing dates based on foreign priority applications.

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