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Why The Ides Of March 2013 Will Be Important Around The World

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The "first-to-file" provisions of the United States "America Invents Act (AIA)" take effect on March 16, 2013. Because of other changes to the U.S. patent system, this date will be just as important to patent applications being filed around the world as it will be to those being filed in the United States. Here, I highlight several reasons why global patent applicants—and their patent counsel—should be aware of the significance of March 15, 2013—the Ides of March.

A Global View Of "Effective Filing Date"

The AIA amends 35 USC § 100 to add a new definition of "effective filing date." Although the statutory language is complicated, it embodies the familiar concept of the "effective filing date" being the filing date of the earliest priority application that supports the claimed invention at issue. Significantly, this definition—like other provisions in the AIA—takes a global view and includes the filing date of any ex-U.S. applications that can support a priority claim under 35 USC § 119 or 35 USC § 365.

This change has several ramifications for global patent applicants.

- **Earlier Prior Art Effect**: Under current U.S. law, a U.S. patent application can be cited as prior art as of its U.S. (or PCT) filing date. When the "first-to-file" provisions of the AIA take effect, U.S. patent applications may qualify as prior art as of the filing date of any priority application that describes the subject matter at issue. This means that a U.S. patent application could qualify as prior art a full 12 months earlier than it can under current U.S. law, if the application claims priority to an ex-U.S. application filed one year before the U.S. (or PCT) application was filed, as is permitted under the Paris Convention.
- **Avoiding The U.S. "First-To-File" Provisions**: The "first-to-file" provisions will apply to U.S. patent applications that claim subject matter with an effective filing date of March 16, 2013 or later. This means that global patent applicants can secure the ability to have their U.S. applications examined under the current "first-to-invent" system by filing priority applications in their own countries ***no later than March 15, 2013,*** and then ensuring that their U.S. applications claim only subject matter that is supported by its priority application.

Why The Ides Of March Matters

Some global patent applicants may wonder why it could be important to file their patent applications by March 15, 2013, since most countries already have a first-to-file system.

One difference lies in the way U.S. patent law defines "prior art" and uses that definition to assess both the novelty and the nonobvious requirements for patentability. While many countries permit "secret" prior art to be used only to defeat novelty, U.S. patent law recognizes only a single definition of prior art (found in 35 USC § 102) and permits all prior art to be considered for both novelty and nonobviousness purposes. For example, it is well-established that a U.S. patent application that qualifies as prior art only as of its U.S. (or PCT) filing date under current 35 USC § 102(e) can be used to reject a claim as obvious under 35 USC § 103. While some commentators question whether this law will be carried forward under the AIA, there is no express language in the new law that signals a departure from the status quo.

Another difference is that U.S. patents granted from applications subject to the "first-to-file" provisions of the AIA will be subject to the new Post Grant Review proceedings which will be conducted in the U.S. Patent Office. Post Grant Review proceedings will offer third parties an opportunity to challenge a patent (within nine months of its grant date or reissue date) under a preponderance of the evidence standard "on any ground that could be raised" under 35 USC § 282(b)(2) or (3). This includes issues pertaining to 35 USC § 101 and 35 USC § 112, which cannot be raised in Reexamination or Inter Partes Review proceedings. While many patent offices offer similar opposition proceedings, Post Grant Review will have its own quirks and complexities, including a limited scope of discovery, very short timetables required to meet the statutory mandate of completion within 12 months, and broad estoppel effects on any other Patent Office or court proceedings.

A Measured Approach To The Ides Of March

While the patentability of many inventions may not depend on which version of U.S. patent law applies, global patent applicants concerned about the possibility of additional prior art and/or the threat of Post Grant Review may want to consider advising their researchers of the significance of March 15, 2013, so that inventions that may be ready for patenting can be evaluated and flagged for patent application filings before the next Ides of March.

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