

# Kluwer Patent Blog

## U.S. First-Inventor-To-File Laws Take Effect

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

The first-inventor-to-file provisions of the America Invents Act (AIA) took effect on March 16, 2013. While the effective date provisions for the first-inventor-to-file provisions are complicated, the new laws will apply to all U.S. applications with an earliest effective filing date on or after March 16, 2013, and also to U.S. applications that claim subject matter with an earliest effective filing date on or after March 16, 2013, even if such applications have an earlier priority date. Other changes to USPTO practice apply to all applications filed from now forward, even those that fall under substantive first-to-invent laws.

### New Requirement For “Transition” Applications

The USPTO rules impose a new requirement for “transition” applications that straddle March 16, 2013, e.g., applications that have an actual filing date on or after March 16, 2013, but an earlier priority date. If any such application “contains, or contained at any time, a claim to a claimed invention that has an effective filing date on or after March 16, 2013, the applicant must provide a statement to that effect” within the later of the following time periods:

- four months from the actual filing date of the application
- four months from the date of entry into the national stage of an international application
- sixteen months from the filing date of the prior filed foreign application, or
- the date that a first such claim is presented in the application.

The statement can be provided on an Application Data Sheet (ADS), as indicated by the [new ADS](#) available on the USPTO website.

To minimize the burden of this requirement, the USPTO rules provide:

An applicant is not required to provide such a statement if the applicant reasonably believes on the basis of information already known to the individuals designated in § 1.56(c) that the nonprovisional application does not, and did not at any time, contain a claim to a claimed invention that has an effective filing date on or after March 16, 2013.

### Certified Copies of Priority Documents

Now that all U.S. patent applications can be cited as prior art as of their effective filing dates, including any foreign priority dates, the USPTO is requiring that certified copies of priority documents be filed within the later of the following time periods:

- four months from the actual filing date of the application
- sixteen months from the filing date of the prior filed foreign application

For U.S. national stage applications, this requirement will be satisfied if a certified copy of the priority application was filed in the PCT application, and a copy was forwarded to the USPTO as a designated Office.

To minimize the burden on applicants, the rules provide the following alternative ways to satisfy this requirement:

1. The priority application was filed in a participating foreign intellectual property office (or a copy of the foreign application was filed in an application subsequently filed in a participating foreign intellectual property office) and the Office either receives a copy of the foreign application from the participating foreign intellectual property office or a certified copy of the foreign application within the pendency of the application and before the patent is granted; or
2. The applicant provides an interim copy of the original foreign application within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior foreign application, and files a certified copy of the foreign application within the pendency of the application and before the patent is granted.

### **Substantive First-Inventor-To File Changes**

While the impact of the substantive first-inventor-to-file changes may not be felt for sometime—until new applications are under examination—stakeholders can review new 37 CFR § 1.130 and the related commentary in the USPTO’s First Inventor To File Examination Guidelines in order to get an idea of what will be required to invoke the [grace period prior art exceptions](#) of new 35 USC § 102(b). As [I have written previously](#), foreign applicants are mostly likely to notice the citation of earlier-filed, later-published PCT and U.S. applications as of their foreign priority dates in obviousness rejections, since most other patent offices only cite such applications if they raise novelty issues, and only cite such applications as of any domestic priority date.

### **New USPTO Fees**

On March 19, 2013, a new [USPTO fee schedule](#) takes effect that embodies the [USPTO’s new fee-setting authority](#). In addition to raising most fees in order to build a new reserve fund and account for the new [Micro Entity status](#), the new fee schedule adjusts some fees to disincentivize certain behaviors, such as the new, higher fee for a second or subsequent RCE (\$1700) and a new \$2000 fee for transferring an application to the Patent Trial and Appeal Board, due within two months of the Examiner’s Answer to an Appeal Brief.

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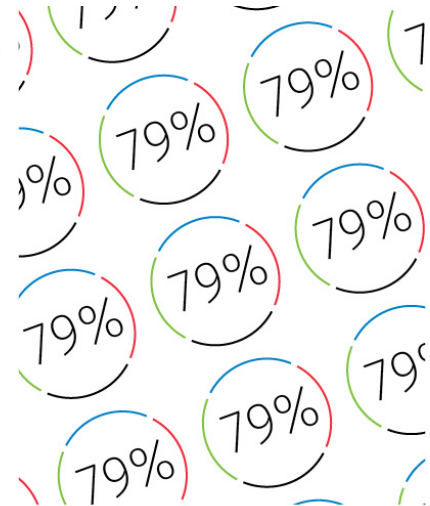
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This entry was posted on Monday, March 18th, 2013 at 6:00 am and is filed under [United States of America](#)

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