

Changes in patent laws create confusion for inventors

Effective on March 16, 2013, the U.S. totally revamped its patent laws.¹ The change represents a complete shift in how the Patent Office determines which one of two inventors that develop the same invention at about the same time, is entitled to receive the patent.

In the past, a U.S. patent was usually awarded to the inventor who could prove that they were the first to invent the technology.² Under the new law, the general rule is that the first inventor to file a patent application will receive the patent. The dates that the respective inventors developed the invention are not relevant.³ This change generally means that inventors should file a patent application on their invention as early as possible.

However, the new law includes an exception from the general rule that the first inventor to file is awarded the patent. The exception is that an inventor who has made a public disclosure of their invention prior to filing their patent application, has one year from the date of that public disclosure to make a patent filing.⁴ Even if someone else independently develops the same invention and files a patent application first, the inventor who made the earlier public disclosure would be entitled to receive the patent, as long as they file their application within one year of the public disclosure.⁵ In addition, the new law appears to make any form of public disclosure a basis to make a patent filing within one year, and not have to be concerned about others who may independently develop the same thing and make an earlier patent filing.

Unfortunately for inventors who want to rely on a public disclosure to reserve their rights to file for a patent within one year, the Patent Office is construing the new law very narrowly. The Patent Office takes the view that the opportunity to file an appli-

cation for one year only applies to exactly what was included in the public disclosure. For example, Inventor A makes a public disclosure of their invention before filing a patent application. Inventor A files a patent application within one year of their public disclosure. Inventor B independently develops a similar invention less than one year after the public disclosure by Inventor A (but before Inventor A files their patent application), and either files a patent application or makes their own public disclosure which is different in minor ways from the public disclosure of Inventor A. The Patent Office may cite the patent filing or public disclosure of Inventor B as “prior art” against the patent application of Inventor A, despite Inventor A’s earlier public disclosure. The Patent Office says it can do this because the later filing or public disclosure of Inventor B is different than Inventor A’s first public disclosure.⁶

Sound confusing? No one can predict how future legal cases will be decided that involve which of two inventors of nearly identical technology should receive the patent. It will likely be years before court decisions involving this scenario are issued.

In the meantime, most commentators recommend against relying on a public disclosure to protect an inventor’s rights to later file a U.S. patent application. Therefore, the best practice is to file a patent application before public disclosure. However, if a public disclosure is going to be relied upon, the disclosure should be as broad as possible, and well-documented.

Also, this aspect of the new law is inconsistent with the law in the rest of the world. In many countries, if a public disclosure of an invention is made without having first filed a patent application, the opportunity to obtain a patent in that country is lost. As a result, an inventor who relies on making a



pre-filing public disclosure to protect their rights to file a U.S. patent, generally waives the opportunity to obtain foreign patents.

This area of patent law is just one of many that has been made uncertain by the changes in the new America Invents Act. ♦

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Endnotes

- 1 Public Law 112-29. The Leahy-Smith America Invents Act (“Act”). Section 35 of the Act had a general effective date of September 16, 2012. However, Section 3(N)(1)A-B of the Act, which is applicable to 35 U.S.C. § 102 and which implement the “first inventor to file” provisions, did not take effect until March 16, 2013.
- 2 Prior 35 U.S.C. § 102(g) and 35 U.S.C. § 135, which provided for awarding the patent to the first inventor to invent the subject matter.
- 3 35 U.S.C. § 102(a)(2).
- 4 35 U.S.C. § 102(b)(2)(B).
- 5 35 U.S.C. § 102(b)(1) provides the exception to the general rule that a public disclosure by an inventor of their invention before making a patent filing bars receipt of a patent, provided the patent filing is made within one year of the public disclosure.
- 6 Examination Guidelines for implementing the First Inventor to File Provisions of the Leahy-Smith America Invents Act. Fed. Reg. Vol. 78, No. 31, February 14, 2013, pages 11059-11087, particularly Section II B 2 (a) and (b).