

MVS Filewrapper® Blog: Changes to Implement and Guidelines for Examination under AIA

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The United States Patent and Trademark Office has released its rules regarding changes under first inventor to file provisions of the Leahy-Smith America Invents Act. The rules published by the USPTO in the Federal Register on March 16, 2013 provide **guidelines for implementing** the new patent law and **guidelines for examination** of patent applications under the new standards. The documents cover a broad range of topics, with a high degree of specificity, but we provide highlights from both of the Federal Register publications are as follows:

- **First-to-file standards only apply to applications filed on or after March 16, 2013**

If an application claims priority to an application filed prior to March 16, 2013, it will be examined under the pre-AIA guidelines, i.e., first to invent standard. The application may not claim new matter, i.e., matter not supported by the originally filed application (priority application). If the application does have new matter, it will be examined under the first-to-file standards.

- **Required statements from the applicant in transition applications**

Transition applications are those where a non-provisional application is filed on or after March 16, 2013 that claims priority or the benefit of the filing date of an earlier application. If the application contains, or at any time contained, a claim to an invention that has an effective filing date of March 16, 2013 or after, the applicant is required to file a statement indicating that there is matter or was matter claimed that has an effective filing date on or after March 16, 2013. The guidelines clearly state that the particular limitation does not have to be specified. Thus, if any new matter is added to the claims of a transition application, the Applicant must inform the patent office in a statement.

- **In certain respects, prior art under the statute is broader than before**

For applications being examined under the

first-to-invent standards, prior art is broader than before. Now any patent or published patent application is prior art as of its earliest effective U.S., foreign, or international filing date. Furthermore, the first-to-file standard eliminates the requirement that prior public use or sale be “in this country,” and therefore may now be anywhere in the world.

- Interference proceedings have been replaced by the new derivation proceedings

Under the first-to-invent standards interference proceedings existed to determine who invented first. Under the new first-to-file patentability standards, interference proceedings have been replaced by derivation proceedings. The derivation proceedings are instituted to determine if a prior public disclosure of an invention was actually derived from the inventor and is one that does not bar the invention from patentability