



TWO WORLDS COLLIDE - SURVIVING POST AIA

By Sherrie M. Flynn

By now, most individual inventors, as well as the companies that employ inventors, know that because of the America Invents Act (AIA), America has gone from a system of "first-to-invent" (the first person to invent has the rights to a patent on the invention), to a system of "first-to-file" (the first person to file a patent application has the rights to the patent, even if someone else independently came up with the same invention first). While most inventors and their employers understand this basic premise, most do not comprehend the other far-reaching implications of the AIA, which are complicated and confusing. Because an understanding of them is critical to surviving in the post-AIA world, this article will discuss the AIA.

One of the most important aspects of the AIA to first understand is whether pre-AIA law or the AIA (or both) applies to a particular patent or patent application. This can sometimes be a complex determination. Simply stated, all patent applications having an "effective filing date" on or before March 15, 2013, are subject to pre-AIA law, and those having an "effective filing date" on or after March 16, 2013 are subject to the AIA.

What complicates the analysis is the meaning of "effective filing date." The "effective filing date" is the actual patent application filing date, *unless* the invention claimed in the application is entitled to the benefit - "priority" - of an earlier patent filing, such as a provisional application.

Priority exists where (1) a proper claim for priority is made, and (2) the earlier patent filing contains a written description of the invention, including how to make and

use the invention claimed. However, a patent application may (and usually does) have many claims, and not all of the claims may be entitled to the priority of the previously-filed patent application. Because there are no requirements that a patent application detail which claims are and are not entitled to priority, an analysis of the written description in the prior filing must be undertaken on a claim-by-claim basis. Patent examiners and patent practitioners are left to sort out the priority of each claim.

If all claims in a patent application have an effective filing date on or before March 15, 2013, then the AIA does not apply at all, and the patent applicant can rely on pre-AIA law, including the actual date of invention. On the other hand, if all claims in the patent application have an effective filing date on or after March 16, 2013, then the AIA applies to the application, and the applicant can only rely on the effective filing date, *not* the invention date.

To further complicate matters, a single patent application may have one or more claims with an effective filing date prior to March 16, 2013, and one or more claims with an effective filing date on or after March 16, 2013. This "hybrid" application may occur where an application is filed on or after March 16, 2013, but one or more of the claims in the application are entitled to the priority date of an earlier-filed application, while one or more other claims are not entitled to the same benefit, for example, because the written description in the prior-filed application does not cover the particular variation (embodiment) of the invention in these other claims. So how are these "hybrid" applications treated?

Before addressing that question, it is also important to understand that the AIA did more than just transform U.S. patent law from a first-to-invent system to a first-to-file system. The AIA also changed the fundamental assumptions for what is considered "prior art." In simple terms, prior art is evidence that something claimed in a patent application has been done before. Prior art has the potential of rendering the invention claimed by the patent application unpatentable because only novel and non-obvious inventions can be patented, not inventions that were previously known or are obvious in light of what was previously known.

In the pre-AIA world, prior art included inventions publicly known or used by others, **in this country**. Now, post-AIA, public disclosures before the effective filing date of the claimed invention **anywhere in the world** (and in any language) will be considered prior art against the claims in a patent application. Consequently, the body of what is now considered prior art has significantly expanded, making it extremely difficult for a patent owner to discover every piece of prior art that may exist against his or her invention.

On the other hand, the AIA limits what is considered prior art in some other respects. Now, common ownership (e.g., patent and patent applications that are assigned to one owner) and inventions developed under joint research agreements are not considered to be prior art under the AIA. This is true so long as the ownership is in place by the effective filing date (there does not need to be common ownership at the time of invention).

Now, back to the question of the hybrid application. The hybrid application secures some of the benefits/detriments of the pre-AIA world as well as some of the benefits/detriments of the AIA world. As a result of certain provisions of the AIA, all claims of a hybrid application will be subject to the prior art provisions of the AIA (e.g., the broader provisions providing that disclosures anywhere in the world are prior art, the narrower provisions providing an exception for common ownership, etc.) *and* the first-to-invent provisions of the pre-AIA world, *even if* a particular claim in a hybrid application or patent has an effective filing date on or after March 16, 2013, and the claim would otherwise be strictly an AIA claim. Confusing? Yes, particularly for the AIA novice.

Yet, what should be apparent is that it is critical in this new AIA world that patent applicants and their attorneys pay particular attention to the effective filing date of each claim they are filing to ensure that all claims in an application are either pre-AIA or AIA claims, unless of course, the applicant/attorney **wants** the claims evaluated under the AIA "hybrid" rules (e.g., to take

advantage of the common ownership exception to the prior art rules in certain pre-AIA claims).

Because the AIA is so new, it is difficult to know how the courts will ultimately interpret issues relating to the issues discussed in this article. For that reason, it is also critical that patent applicants and their attorneys maintain an in-depth working knowledge of both pre-AIA and AIA law, so that they may know whether third-party applications and patents qualify as prior art to the client's patents or patent applications. Otherwise, the inventions may end up falling out of both the pre-AIA and the AIA worlds, and into the "unpatentable" abyss.

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