

Alert: Urgent New Patent Law Considerations

December 21, 2012

As you may know, the America Invents Act (AIA) has key amendments to the patent law effective March 16, 2013 that will convert our patent system to a "first inventor to file" system for granting priority to patents as opposed to our current system of "first to invent." This means starting March 16, 2013 there will be many inventors and their companies who will race to the Patent Office to be first to file.

In order to ensure upcoming patent applications fall within the existing rules granting priority to the first to invent and avoid triggering the new rules granting priority to the first inventor to file, many patent applications will have to be filed before March 15, 2013. Over the next three months, the Patent Office expects to be inundated with new patent applications.

What this means for you

On or after March 16, 2013 it will be important to file your patent applications at the earliest practical date so that others do not file before you on the same invention. In other words, if someone else files a patent application on your invention before your filing date, you may lose rights to your invention. Due to Patent Office confidentiality - the first 18 months from filing date - you/we are not able to monitor the Patent Office filings to check whether someone else has filed before you.

Because preparing a patent application is time consuming - discussing the invention, gathering relevant data and prior art, potentially analyzing patentability, and drafting and refining the application itself, including the specification and claims - it is critical for you to begin the process as soon as possible. This process could take several months, depending on the complexity of your invention and whether your application is a provisional or a utility application. Please note that if you change or broaden the scope of your application before you file, you may not be able to file by the anticipated date.

For more information or assistance with preparing and filing patent applications, please contact your Briggs and Morgan attorney or a member of Briggs's Patent, Trademark, and Copyright Prosecution practice group

Attorneys

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