

AIA best practices

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The changes made in shifting the U.S. from the first-to-invent regime that had been in place for 226 years were substantial and sometimes unclear. The full effects of the changes probably won't be known until applicable patents issue and are litigated, which means it will likely be eight to 10 years before we starting getting direction from the courts.

So, what best practices can inventors/applicants/companies adopt or continue under the AIA?

Consider implementing a virtual patent marking system

This is likely to be a more efficient and less costly manner of appropriately marking your patented products. Also, an effective patent marking system allows a patent owner to obtain damages for infringing acts that occurred before an infringer received actual notice of infringement.

Monitor the art closely

Be aware of commercial activities of competitors, scientific journals, symposiums, and published patent applications both inside and outside the United States. Knowledge of the art is important for facilitating the preparation and prosecution your patent applications. Additionally, closely monitoring the art will make it possible for you to timely institute certain PTO proceedings such as a derivation action, an inter partes review, or a post-grant reviews.

Utilize prior art exceptions

In addition to the normal benefits associated with an extensive knowledge of the relevant art, closely monitoring the art may allow you to utilize certain exceptions to remove references from the prior art to your application by acquiring ownership of an earlier-filed application or executing a joint research agreement before the effective date of your application.

Keep detailed records of research activities and disclosures

Don't assume that because the U.S. has switched to a "first-to-file" system that you can throw out your detailed lab notebooks from years ago. Instead, continue to keep detailed records

about research activities and disclosures (when, where, by and to whom). These records may be useful to:

- Establish that a disclosure you made was about an independently developed invention, and so qualifies as prior art to a competitor's application;
- Defend against a charge that the invention in your earlier-filed application was derived from another with a later-filed application; or
- Support a prior commercial use defense.

Avoid pre-filing disclosures both public and confidential

Notwithstanding the above-described grace period, if at all possible, it is more important than ever to file a patent application before disclosing your invention publicly or even pursuant to a confidentiality agreement.

Increase provisional application filings

File provisional applications early and often as advances are made and prior to any disclosure. Because it is now a race to the Patent Office, you may wish to have your attorney immediately file a detailed, enabling invention disclosure prepared by the inventor(s) as a provisional application and file a follow-up attorney-prepared provisional application as soon as possible thereafter.

Avoid intervening disclosures

Because many provisional applications are filed early, it is common for the commercially relevant embodiments of an invention to change as the invention is developed. Thus, even if you've filed a provisional application, avoid making disclosures about your invention until after the non-provisional application is filed.

Don't necessarily race to the patent office

The expansion of the prior commercial user defense — along with the described elimination of the bar against a patentee from practicing an invention for extended periods before seeking patent protection — seems to have substantially mitigated the potentially negative consequences of not filling a patent application for inventions that can be secretly exploited. In other words, if makes more sense from a business perspective to confidentially use or test your product before filing, don't be afraid to discuss that option with your patent attorney. Not everyone has to burn rubber to the patent office.