Practitioners Shifts After Filing Change

Patents

Intellectual Property

By DAVID FORSETER

April 1, 2013
while buying some time to refine it and raise money.

Patent attorneys say their advice to inventors under the first-to-file regime is to file early and file often.

Both the publishing and provisional options are unique to the U.S. In other countries, once an invention is published, it cannot be patented. This leaves foreign inventors with little breathing room to refine an idea before seeking a patent.

But even under the modified first-to-file system adopted in the U.S., securing

It's a huge paradigm shift for all of America. You can't sit on an idea anymore.”

— Darin Gibby

period in which to file for a patent, during which no other inventor with the same idea can file.

The potential downside is that if the inventor doesn't file within a year, she can't file later. And no one else can file for a patent on the idea either, even someone else who came up with the idea independently. Once the idea's been published and more than a year goes by with no filing by the inventor who disclosed it, it becomes part of the public domain.

A second and better option, patent attorneys say, is to file a provisional patent. This also buys the inventor a year to keep tinkering with the idea, at the end of which the provisional patent must be converted into a full patent. It also allows the inventor to keep his idea under wraps while he continues to refine it.

As changes are made, the inventor can continue to file updated provisional patents and then at the end of the year consolidate all of them into a single patent filing.

Filing a provisional patent is generally simpler and much less expensive than a full patent, which makes it easier for inventors with a good idea but not a lot of money to protect their creation a one-year grace period by publishing or filing a provisional patent will be of no help to the inventor if someone else filed first for a patent on the same idea.

And there's a good chance the inventor won't know that someone else got to the patent office first. When a patent application is filed, it remains secret for 18 months while it is being reviewed.

So, an inventor could file a provisional patent in April, not knowing that a month before another inventor filed on the same idea. And he may not learn about it until 17 months later, when the patent filed in March becomes public, all the while continuing to pour time and money into his invention.

Under the old system, the inventor who lost the race to the patent office could still argue she was the first to come up with the idea, and if she could prove it, win the patent. This was a potentially long and costly battle, but an option nonetheless for those willing to press their case.

But under the first-to-file system, it doesn't matter who came up with the idea first. The only recourse for the inventor who gets beat to the patent office is to show that the other inventor stole
While there are tradeoffs for inventors, the first-to-file system should make life easier for patent examiners, attorneys said. In most cases, examiners will no longer get sucked into lengthy battles over who invented something first and can instead rely on filing dates or prior disclosures of inventions to resolve patent disputes.

Gibby said he prefers this. Battles over who was the first to invent were often so long and so costly it often came down to who could afford the best legal team over the long haul.

How first-to-file works in practice also will depend on how courts interpret the language of the statute implementing the system. This will take some time. It will be at least a year before patents now entering the pipeline under the new system come out the other end.

"This is such a groundshifting change in patent law," said Gary Chapman, a patent attorney in the Denver office of Lathrop Gage. "We don't know how a lot of these things are going to be interpreted by courts."

— David Forster, DForster@CircuitMedia.com