

Inventions: Empty the Cupboards Now Before the New Rules Apply

Under the Leahy-Smith America Invents Act (AIA), on March 16, 2013, the U.S. patent system will change to a “first inventor to file” system from the current “first to invent” system. As discussed below, there are many reasons to file patent applications now under the current system before the law changes. When the new rules apply, on and after March 16, 2013, a safe strategy to best use the patent system will be to quickly file patent applications on as many inventions as are within your company’s financial means. For the inventions that do not make the cut for quick filing, the use of strategic and selective disclosure and publication may be considered under certain circumstances to protect your rights.

What should I do before March 16, 2013? Your company should take action now to receive the advantages of the current “first to invent” system, which include (i) a narrower scope of references and documents which may be cited to reject your patent application, and (ii) the ability to avoid the post-grant review process that will be available under the 2013 “first inventor to file” system, which will allow a third-party to challenge a granted patent. You should inventory your company’s inventions and start the patent application process now for the meaningful inventions. Don’t delay, as waiting and filing under the new rules will provide fewer advantages.

How can I streamline my company’s process for disclosing inventions and filing patent applications under the “first inventor to file” system? Under the new rules, time will be of the essence. Your company must diligently communicate its inventions internally and then provide full disclosure to counsel so that a patent application may be prepared and filed expeditiously. More than ever, it will be important to track the status of meaningful inventions and promptly file on them. Important actions your company should consider:

1. **Review and revise your company’s invention disclosure procedure or policy to take into account the new need for speed (or create such a policy if there is not one);**
2. **Develop a plan to motivate your inventors to comply with the policy;**
3. **Hold regular meetings to stay on top of what is in your company’s innovation pipeline;**
4. **Anticipate your patent attorney’s needs for each invention—which will include, at a minimum:**
 - (i) **a one or two page description of how to make and use the invention, and**
 - (ii) **hand drawings, or simple black and white line drawings of the invention, including its new and important parts. For example, CAD drawings with color are not useful for filing purposes.**

Under the new rules, should my company publicly disclose its inventions sooner rather than later? The new rules of the AIA have been the subject of much discussion due to the possible benefit, in certain situations, that may result from publicly disclosing an invention before filing a patent application. Under the new rules, it now becomes important to have a record keeping system which tracks exactly what your inventors disclose (poster presentation, publication, etc.) and to whom the disclosure is made. However, don’t jump the gun. It is important not to destroy foreign patent rights by allowing a public disclosure to occur before a patent application is filed. The message here is not to have a knee jerk reaction toward making disclosures or publications. Rather, thoughtful consideration should be given to the possible benefits under the new rules, in certain situations, of providing disclosure or publication of an invention in a strategic effort to decrease the likelihood that a competitor would seek protection of a similar invention.

Wyatt patent attorneys can assist you with filing patent applications. Contact a member of the Intellectual Property Service Team or visit www.wyattfirm.com for more information.