



Patent Law Reform – America Invents Act (AIA)

Important changes in patent law will take effect on March 13, 2013, when the America Invents Act (AIA) becomes effective. The most significant change is that the U.S. is moving from a first-to-invent to a first-to-file system. Now, more than ever, it is important to **disclose inventions and technologies to RFMH as soon as possible because patent applications filed before March 13, 2013 will have the benefit of the current, first-to-invent system**, with which RFMH and our patent attorneys are familiar. We strongly encourage and recommend that you file disclosures with us well before you are ready to publish results, in order to take advantage of the new first-to-file system.

As a reminder, all inventions and technology conceived, developed, made, or reduced to practice by RFMH employees in the scope of their employment, or by state employees participating in funded activities administered by RFMH, must be promptly disclosed to RFMH.

Key Messages:

- Submit disclosures to RFMH ASAP, but **by Feb. 1, 2013 at the latest**, in order to take advantage of the current laws and rules.
- Stay in contact with RFMH regarding publication plans for inventions.
- As always, feel free to call or email Ashley Hart, the Technology Transfer Associate at RFMH, regarding questions about changes in patent law, questions about when and what to disclose, etc.

Ms. Ashley Hart, Esq.

518-408-2186

ahart@rfmh.org

- **[Link to disclosure forms – click here](#)**

For your information we have summarized the upcoming changes below:

- **March 16, 2013** – all applications will be examined at the U.S. Patent & Trademark Office (PTO) under the new laws.
- **Changing to first-to-file** – Currently, the inventor who can prove s/he was first to invent, is entitled to patent rights. After March 16, 2013, the date that matters is the date the application is filed at the Patent Office.
- **Provisional patent applications will be more important than ever after March 16** – Reserve your spot in line at the PTO by filing a provisional patent application because you will not be able to “swear behind” any competing patents or references (i.e. publications) to show that you invented first! First to invent will no longer matter.
- **1 year grace period for inventor’s own disclosure** – after an inventor has publicly disclosed the invention (via presentation, poster, publication, etc.), the inventor has 1 year to file a patent application
 - **CAUTION:** Public disclosure by another person of the same invention may count against you.
 - Example: You, the Inventor, publish about your invention in a scientific journal. You have one year to file a patent application. However, before you file your patent application, Inventor B submits a patent application for the same invention



you disclosed in the article. Inventor B may be able to obtain the patent and you may not be able to obtain the patent.

- **REMINDER:** Disclose to RFMH prior to publication, keep RFMH informed of your publication and other disclosure plans, and we will work together with patent counsel to file an application ASAP.
- **Public disclosures anywhere in the world act as “prior art” as of the date they were made public** – “Prior art” is a phrase used by the PTO to describe any disclosure that may disqualify you from obtaining a patent. Prior art can be a patent, a printed publication (including publications online), public use, or public sale. Before the AIA, some disqualifying prior art was only disqualifying if it was made in the U.S. After March 16, 2013, prior art can be disqualifying if it is from anywhere in the world.

Links for more information

- RFMH forms: http://corporate.rfmh.org/technology_transfer/index.asp?page=forms
- Genetic Engineering & Biotechnology News: A Practical Guide to Patent Reform <http://www.genengnews.com/gen-articles/a-practical-guide-to-patent-reform/4158/>
- Local intellectual property firm’s newsletter summarizing changes (see p. 2–3) <http://www.iplawusa.com/news/newsletters/Feb-Mar2012newsletter.pdf>
- Blog posting from Congress regarding importance of patent law reform <http://thehill.com/blogs/congress-blog/economy-a-budget/167671-patent-reform-is-long-overdue>