

# Cooley

March 11, 2013

On March 16, 2013, the United States switches from the current first-to-invent patent system to a new first-inventor-to-file (first-to-file) patent system under the America Invents Act (AIA). Recently, the United States Patent and Trademark Office (USPTO) published a set of final rules and examination guidelines providing additional insight as to when applications will be examined under the current first-to-invent rules or the new first-to-file rules of the AIA.

In particular, the rules and guidelines clarify when new claims or claim amendments will subject an application to the first-to-file rules. It is important to understand these guidelines, because the new rules significantly expand the scope of prior art that can be cited against the claims. See Cooley's prior *Alert* entitled "[The Changing Boundaries of Prior Art under the AIA: What Your Company Needs to Know](#)."

## Key elements of the new first-to-file rules (AIA)

Applications having one claim with an effective filing date on or after March 16, 2013, will be examined under the new first-to-file rules. In contrast, applications filed prior to March 16, 2013, will be examined under the current first-to-invent rules.

For "transition applications" (*i.e.*, a nonprovisional application filed on or after March 16, 2013, that claims priority to or the benefit of the filing date of an application filed prior to March 16, 2013)<sup>1</sup>, a new claim or amendment that is not supported in the application *will not be examined under the new first-to-file rules, unless the claim is presented in a preliminary amendment filed on the same day as the application*. Instead, the USPTO will issue a new matter rejection and examine the application under the current first-to-invent rules.

Remember, regardless of the claims presented, if an application claims priority to an application having a claim with an effective filing date on or after March 16, the application will be examined under the new first-to-file rules.

Accordingly, to increase the likelihood that transition applications are examined under the current first-to-invent rules, we advise:

- filing utility, continuation or divisional applications on or after March 16, 2013, with claims that are identical to the claims presented in the priority or parent applications filed before March 16, 2013; and
- filing any new claims or amendments in preliminary amendments *after* the filing date of the utility, continuation or divisional application.

Additional practice pointers are noted in the illustrations below.

## Navigating the new first-to-file rules (AIA)

**Scenario 1: New claims added at the time of filing a utility application on or after March 16, 2013.** I have a pending provisional application that was filed before March 16, 2013. I file a utility application on or after March 16, 2013, that claims priority to the provisional application. At the time of filing the utility application, at least one claim is filed that was not present in the prior filed provisional application. The Office alleges that this "new" claim does not have written description support in the provisional application.

The utility application will be examined under the new first-to-file rules. The claim that was not present in the prior filed provisional application is not deemed "new matter" because all claims presented in the utility application (or in a preliminary amendment on the filing date of the application) are part of the original disclosure and have written description support in the claims themselves.

**Practice Point.** Utility applications filed on or after March 16, 2013, that claim priority to a provisional application filed before March 16, 2013, should be filed with the original provisional claims. If new claims or amendments are desired, they should be made *after* the utility filing date. Once the new claims or amendments are presented, the Office will determine whether they have adequate support and should be entered and examined. For any new claims that are desired, consider reviewing the disclosure of an existing application and, if necessary, adding new disclosure/claims to the application prior to March 16, 2013, to explicitly support these new claims. Alternatively, if it is not possible to file the new material prior to March 16, 2013, consider filing a new application explicitly supporting the new claims and pursuing these claims in a separate line of related applications to preserve the first-to-invent status of the original claims.

**Scenario 2: New disclosure added on or after March 16, 2013.** I have a pending provisional application that was filed before March 16, 2013. I file a utility application on or after March 16, 2013, that claims priority to the provisional application. At the time of filing the utility application, disclosure is added to the specification but no new claims are added that solely rely on the new disclosure for written description support. In a subsequent amendment, claims are added or amended that solely rely on the post-March 16 disclosure for written description support.

Prior to the amendment, the utility application will be examined under the current first-to-invent rules. Once a new claim is amended or added such that written description support is only found in the disclosure present on or after March 16, 2013, examination of that application will be converted from the current first-to-invent rules to the new first-to-file rules under the AIA. The new claim is not deemed "new matter" because written description support for the claim can be found in disclosure present on or after March 16, 2013. Canceling the new claim will not revert the application back to the current first-to-invent rules.

**Practice Point.** Utility applications filed on or after March 16, 2013, that claim priority to a provisional application filed before March 16, 2013, but which also have disclosure added on or after March 16, 2013, should be prosecuted very carefully to ensure that no claim is amended or added that relies on the post-March 16, 2013, disclosure for written description support. In addition, we advise filing a separate utility application that does not include the new disclosure to mitigate the potential of inadvertent conversion to the new first-to-invent rules.

**Scenario 3: Filing continuation and/or divisional applications on or after March 16, 2013.** I have a pending utility application filed before March 16, 2013. I file a continuation or divisional application on or after March 16, 2013. At the time of filing the continuation application, a preliminary claim amendment is filed. There is no written description support for the new claims in the parent application.

The continuation application will be examined under the new first-to-file rules. The new claims would likely be granted an effective filing date of the new continuation application, not the parent application, because claims filed in a preliminary amendment presented on the filing date of the application are part of the original disclosure and have written description support in the claims themselves.<sup>2</sup> In this case, because the claims solely rely on the preliminary amendment for written description support, the first-to-file rules apply. Canceling the claims that do not have written support in the parent application will not convert the application to a first-to-invent application.

**Practice Point.** Continuation or divisional applications filed on or after March 16, 2013, whose parent was pending before March 16, 2013, should be filed with one or more of the original claims of the parent application. Any new claims or claim amendments should be filed after the continuation or divisional application is filed.

**Scenario 4: New claims added during prosecution of an application filed on or after March 16, 2013.** I have an application filed

on or after March 16, 2013, that claims priority to an application filed before March 16, 2013. During prosecution of the application, claims are amended or added where the new claims do not have written description support in the application. The claims are rejected as new matter under 35 U.S.C. § 112(a).

A new matter rejection will not convert the examination of the application to the first-to-file system.

**Practice Point.** When rebutting the new matter rejection, do not rely on any post-March 16, 2013, disclosure that may have been added to the application at the time of filing. If the new matter rejection is successfully overcome using the post-March 16, 2013, disclosure as the sole basis for written description support, examination of the application may be converted to the first-to-file system. If the goal is to maintain examination under the first-to-invent rules, only point to pre-March 16, 2013, disclosure to rebut new matter rejections.

**Scenario 5: Claiming benefit to provisional applications straddling March 16, 2013.** I have two pending provisional applications: one that was filed before March 16, 2013, and one that was filed on or after March 16, 2013. I file a utility application on or after March 16, 2013, that claims priority to both provisional applications. At the time of filing the utility application, the claims are identical to those in the provisional application filed before March 16, 2013.

Merely claiming priority to an application that contains a claim having an effective filing date on or after March 16, 2013, will subject the application to examination under the AIA's first-to-file rules.

**Practice Point.** Utility applications filed on or after March 16, 2013, that may claim priority to provisional applications that straddle March 16, 2013, should be maintained as separate lines of cases. One utility application should be filed that claims priority to the provisional application filed before March 16, 2013, and the other utility should be filed claiming priority to either both provisional applications, or the provisional application filed on or after March 16, 2013.

**Scenario 6: Continuation-in-part applications filed on or after March 16, 2013.** I have a pending utility application that was filed before March 16, 2013. I file a continuation-in-part (CIP) application on or after March 16, 2013. One or more claims of the CIP rely on the CIP disclosure for written description support.

The CIP application will be examined under the first-to-file rules. The new claims are not deemed "new matter" because they have written description support in the post-March 16, 2013, "CIP disclosure."

**Practice Point.** Instead of filing a CIP application, consider filing a new provisional application and starting a new line of cases that will be examined under the first-to-file system. CIP applications are typically useful only under narrow circumstances, and may be less useful when filed as a transition application on or after March 16, 2013. You are advised to consult with your patent attorney when filing any CIP application.

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While this *Alert* highlights important considerations regarding how the presentation of claims in applications filed on or after March 16, 2013, may be examined, it is not exhaustive and other scenarios may be encountered. Two key consequences of being examined under the first-to-file system are: (1) the prior art pool will be expanded; and (2) showing an earlier date of invention to overcome rejections will no longer be an option. Understanding these consequences is especially important for crowded and fast-moving fields where multiple applications may be filed within a short period of time. However, the courts will ultimately determine how the AIA is interpreted.

Cooley's patent practitioners are available to assist you in implementing the best filing strategies for navigating the switch in patent regimes given your particular circumstances.

## NOTES

1. Changes To Implement and Examination Guidelines for Implementing the First Inventor To File Provisions of the Leahy-Smith America Invents Act; Final Rules, 78 Fed. Reg. 11048 (February 14, 2013).
2. The claims may still be rejected under 35 U.S.C. §112.

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