

THE AMERICA INVENTS ACT

PROMOTING AMERICAN INNOVATION, CREATING AMERICAN JOBS, GROWING AMERICA'S ECONOMY

Understanding The America Invents Act - Right of the First Inventor to File

The America Invents Act will transition the United States to a “first-inventor-to-file” system. Every industrialized nation in the world uses a patent priority system commonly referred to as “first-to-file” – except the United States. As business and competition becomes more global, patent applicants are increasingly filing patent applications in other countries for protection of their inventions. The “first-to-invent” filing system in the United States differs from that in other patent-issuing jurisdictions, causing confusion and inefficiencies for American companies and innovators.

How The First-Inventor-to-File System Works

The America Invents Act **creates a new “first-inventor-to-file” system that will provide patent applicants in the United States with the efficiency benefits of the first-to-file systems used in the rest of the world.** The system will make the filing date that which is most relevant in determining whether an application is patentable.

The America Invents Act **establishes a new administrative proceeding to ensure that the first person to file the application is actually a true inventor.** If a dispute arises as to which of two applicants is a true inventor, it will be resolved through an administrative proceeding by the Patent Board.

The **first-inventor-to-file system will simplify the patent application system** and harmonize it with our trading partners, reduce costs, and improve the competitiveness of American inventors seeking protection globally.

The first-inventor-to-file system was supported by President Johnson’s Commission on the Patent System; in the Clinton administration by the Secretary of Commerce’s Advisory Commission on Patent Reform; by the National Research Council of the National Academies of Science in 2004; and is supported by the [Obama administration](#).

A First-Inventor-to-File System Protects Inventors From Their Own Prior Art

In a first-to-file system, prior art can include the inventor’s own disclosure of his or her invention prior to the filing date of the application. Such systems do not provide the inventor with any grace period during which time he or she is allowed to publish his or her invention without fear of it later being used against him or her as prior art.

The American Invents Act, however, adopts a **one-year grace period for inventors.** This will protect inventors from having their own invention used against them as prior art, while encouraging early disclosure of new inventions, regardless of whether an application may later be filed for a patent on it. Prior art will be measured from the filing date of the application, and will typically include all art that publicly exists prior to the filing date, other than disclosures by the inventor within one year of the filing.

Why a First-Inventor-to-File System is Important

In a first-to-file system, **the filing date of the application is most relevant: it is an objective date and is simple to determine** because it is listed on the face of the patent. In contrast, in a first-to-invent system, the date the invention claimed in the application was actually invented is the determinative date. Unlike the objective date of filing, the date someone invents something is often uncertain, and, when disputed, typically requires corroborating evidence.

In a first-to-file system, **the application with the earlier filing date prevails**. In the first-to-invent system, a lengthy, complex and costly administrative proceeding must be conducted at the USPTO to determine who actually invented first. These proceedings can take years to complete and can cost hundreds of thousands of dollars.

A first-inventor-to-file system, by moving toward a more harmonized international patent filing system, **will provide American inventors a more efficient system for obtaining patent protection globally**.

Support for a First-Inventor-to-File System

“The Administration supports Senate passage of S. 23...By moving the United States to a first-to-file system, the bill simplifies the process of acquiring rights. This essential provision will reduce legal costs, improve fairness, and support U.S. innovators seeking to market their products and services in a global marketplace.” – *Statement of Administration Policy, S. 23, February 28, 2011*

“We urge you to support a move forward to first inventor to file, creating greater opportunities for U.S. businesses, small, medium, and large, to flip the tables on our trade deficit and allow us to make more products domestically that are paid for globally.” -- *Association for Competitive Technology, February 15, 2011*

“From my perspective, the Judiciary Committee-passed bill helps independent inventors across the country by strengthening the current system for entrepreneurs and small businesses by including . . . First-Inventor-to-File protections to harmonize U.S. law with our competitors abroad while providing independent inventors with certainty.” – *Louis J. Foreman, CEO, Enventys, February 14, 2011*

“The bill is a significant step forward in improving U.S. patent law. Many of its provisions, including the adoption of a first-inventor-to-file system and the expansion of post-grant review options, will aid in strengthening the system as a whole.” -- *American Intellectual Property Law Association, March 5, 2010*

“The United States should conform its law to that of every other country and accept the first-inventor-to-file system. . . . the first-to-invent system is not working to the benefit of small entities; rather, in the preponderance of cases large firms are ensnaring small companies in complex, costly interference proceedings.” -- *National Academy of Sciences Report, A Patent System For The 21st Century, 2004*

“One way in which the Congress could significantly simplify the patent laws, provide fairer outcomes for inventors, speed final determinations of patentability and reduce overall costs for procuring patents would be through the adoption of the first-inventor-to-file principle.” -- *Testimony of Robert A. Armitage, Senior Vice President and General Patent Counsel, Eli Lilly and Company, before the Senate Judiciary Committee Subcommittee on Intellectual Property, April 25, 2005*