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Intellectual Property Update

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Filing Based on Foreign Priority? Advantage Yours

An invention is only patentable when it is novel and not obvious over what others have invented before, called the "prior art." **Creating prior art citable against a competitor's patent applications by filing your own patent application can prevent the competitor from obtaining a patent, or the full protection it desires.** The US Patent Office's interpretation of changes in US patent law made by the American Inventors Protection Act of 1999 ("AIPA") provides a way to create prior art with an earlier effective date, and may be of particular interest for those filing in the US based on a foreign or Patent Cooperation Treaty ("PCT") application.

An applicant's goal is to achieve the earliest possible date at which the application will stand as prior art. If claiming priority to a foreign or a PCT application, an applicant can accomplish this goal by filing a 35 U.S.C. § 111(a) application in the US. When a PCT application provides the basis for a US filing, the PCT filing should be in English and designate the US. Although this seems to be fairly simple, priority and prior art are complex areas of patent law. For more specific information or questions about using one's own patent application to create the best prior art position, a patent applicant should consult a patent attorney.

Generally, in pursuing patent protection, it is best to obtain the earliest possible filing date. The earlier an application is filed, the sooner it should issue as a patent. Secondly, filing as soon as possible may create prior art to prevent a competitor from obtaining a patent, or may narrow the scope of a competitor's patent. One reason is that the US Patent Office views the US filing date as the constructive date of invention.

To obtain a US patent, an inventor must be the first inventor. In addition, other statutes address situations where patent rights may be lost even though an inventor may have been the first to invent.

A US patent application may be based on an earlier filed foreign patent application or PCT application. The actual US application may be filed as a national application under § 111(a), claiming priority to a foreign filing or PCT application, or the US application may be filed as a national stage application under § 371, claiming priority to a PCT application. The AIPA changed the prior art effect given to § 111(a) and § 371 applications and patents issuing from such applications.

Prior to the enactment of the AIPA, US law provided that a patent issuing from a § 111(a) application became a prior art reference against another pending application as of the date the application was filed in the US. If the same patent issued from a PCT national stage application filed under 35 U.S.C. § 371, then the patent became a prior art reference as of the date when the national stage requirements were fulfilled with the US Patent Office, which could be months after the date of commencement of the US national stage.

For a US patent application filed on or after November 29, 2000, the AIPA provides that, in most cases, the application will publish 18 months after being filed. Because a pending US patent application may now become available to the public, US law was changed to identify when pending applications and patents will be prior art references against another inventor's application.

Applicants' understanding of the changes is still evolving, but the Patent Office has interpreted the changes[1]. This interpretation may provide a competitive edge by showing an applicant how to establish the earliest prior art date to be cited against a competitor also seeking a patent.

Generally, an application with a foreign priority claim has three paths to enter the US patent system:

1. Start with a complying[2] PCT application, i.e., a PCT application in English and designating the US.

2. Start with a non-complying PCT application, i.e., a PCT application in a language other than English or not designating the US.

3. Enter the US within one year from the earliest foreign priority filing date.

An example of each of these three filing paths is represented below and numbered. The paths show the dates when the application or resulting patent will be a prior art reference against another application or patent[3]. In paths 1 and 2, the applicant has the strategy choice of proceeding with a § 111(a) application, path 1a and 2a, (claiming priority to the first filed foreign application or a PCT application) or a § 371 application, path 1b and 2b, (claiming priority to a PCT application). In path 3, the applicant proceeds with a § 111(a) application (claiming priority to the first filed foreign application).

From these scenarios, it is apparent that the Patent Office is no longer giving prior art effect to patents issuing from § 371 applications and, in some circumstances, to § 371 applications. Therefore, for an application and a patent to become a prior art reference against another application as early as possible, the US application should be filed under § 111(a). If the PCT is used, then the PCT application should be in English and designate the US. Two exemplary recommended procedures for establishing the prior art position most likely to affect competitors applications follow:

- File a provisional application in the US as soon as possible. Provisional applications do not need to be in English, so a US provisional could be filed at the same time as, or shortly after, the foreign priority application is filed. Then, within one year, file a US non-provisional application under § 111(a), claiming priority to the provisional, and provide an English translation of the provisional. Under this procedure, the prior art date for the US application and the resulting patent should be the filing date of the provisional application.

- File a PCT application in English designating the US and then enter the US by filing a § 111(a) application on or before the PCT deadline. This way, the prior art date for the US application will be the filing date of the complying PCT. However, the prior art date for the patent will be the date the § 111(a) application was filed (or, if applicable, the date a US provisional application was filed). ▣

[1] Manual of Patent Examining Procedure, Sec. 1896 "Effective Date as a Reference" (8th Ed. Aug. 2001).

[2] As used herein, complying or non-complying does not refer to the validity or viability of a PCT application.

[3] When there is a printed publication, such as a PCT publication, then the publication will be a reference against another's application as of the date of the publication.

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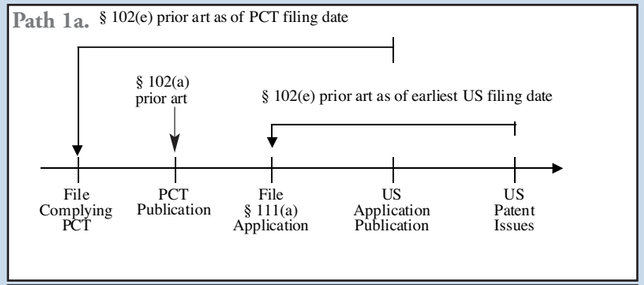

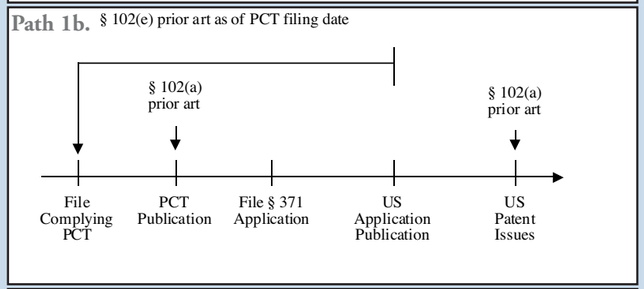

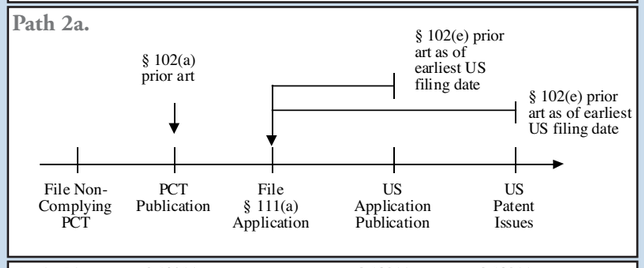

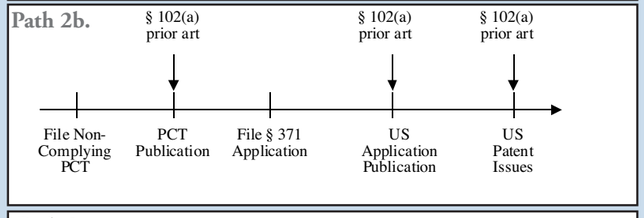

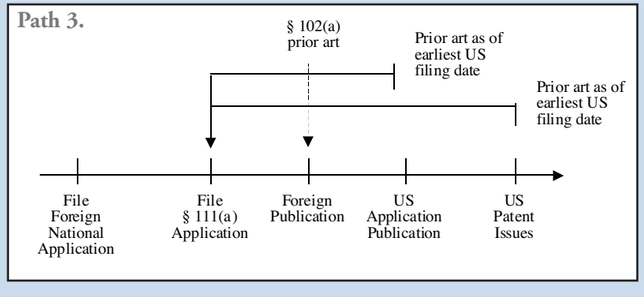

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