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To: ai_a_implementation
Subject: Attn: Hiram Bernstein

ATTN: Hiram Bernstein, Senior Legal Advisor, Office of Patent Legal Administration
Comment Regarding Implementation of the America Invents Act

I. First Inventor to File 35 U.S.C. 102 Effective Date

The current USPTO implementation documents state that the First Inventor to File provisions take "effect 18 months from date of enactment; and Applies to any application and patent (i) with a claim having an effective date on or after enactment, or (ii) having a specific reference under sections 120, 121, or 365(c) to an application having such a claim."

See Implementation Documents,
http://www.uspto.gov/patents/init_events/patents_items.pdf (emphasis added).

Based on any reasonable reading of the America Invents Act of 2011 ("AIA"), the cutoff date should be "with a claim having an effective date more than 18 months after enactment." Specifically, the relevant provision of the AIA states:

(n) EFFECTIVE DATE

(1) IN GENERAL. –Except as otherwise provided in this section, the amendments made by this section shall take effect upon the expiration of the 18-month period beginning on the date of the enactment of this Act, and shall apply to any application for patent, and to any patent issuing thereon, that contains or contained at any time—
(A) a claim to a claimed invention that has an effective filing date as defined in section 100(i) of title 35, United States Code, that is on or after the effective date described in this paragraph; or
(B) a specific reference under section 120, 121, or 365(c) of title 35, United States Code, to any patent or application that contains or contained at any time such a claim.

H. R. 1249, Sec. 3(n)(1).

Although this section is poorly worded, the "effective date described in this paragraph" (i.e., the relevant cutoff date) can only mean "upon the expiration of the 18-month period beginning on the date of the enactment of this Act." If Congress had intended a cutoff date of as of the date of enactment, sub-paragraph (A) would have stated "that is on or after the date of enactment," instead of "on or after the effective date described in this paragraph."

Thus, contrary to the Implementation Documents, any patent application filed or issued within the 18-month period following enactment would not be subject to the First Inventor to File provisions of the AIA. As for applications filed or issued after the 18-month period, only if those applications or patents contain or contained at any time at least one claim with an effective filing date after the 18-month period, or a reference under section 120, 121, or 365(c), to any patent or application that contains or contained at any time a claim with an effective filing date after the 18-month period, would the First Inventor to File provisions apply.

Best regards,

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