

First Inventor to File (FITF) Comprehensive Training



Definitions Under the AIA



Definitions Under AIA

| | AIA Term | Statutory Definition | Regulation |
|---|------------------------------|---|----------------------------------|
| 1 | Inventor | 35 U.S.C. 100(f) | 37 CFR 1.9(d)(1) |
| 2 | Joint Inventor or Coinventor | 35 U.S.C. 100(g) | 37 CFR 1.9(d)(2) |
| 3 | Joint Research Agreement | 35 U.S.C. 100(h) (definition unchanged by AIA) | 37 CFR 1.9(e) |
| 4 | Claimed Invention | 35 U.S.C. 100(j) | 37 CFR 1.9(f) |
| 5 | Effective Filing Date | 35 U.S.C. 100(i)(1) (non-reissue) | 37 CFR 1.109(a) (non-reissue) |
| 6 | Effectively Filed Date | Taken from 35 U.S.C. 102(d) | none |
| 7 | Grace Period | Taken from 35 U.S.C. 102(b)(1) | none |
| 8 | Applicant | Taken from 35 U.S.C. 118 | 37 CFR 1.42 |



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Definitions of **Inventor** and **Joint Inventor**

- “Inventor” is defined as the individual or, if a joint invention, the individuals collectively who invented or discovered the subject matter of the invention.
 - The terms “inventive entity” and “inventorship” are not statutory terms, but have the same meaning as the term “inventor”.
- “Joint inventor” and “coinventor” are both defined as any one of the individuals who invented or discovered the subject matter of a joint invention.



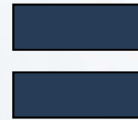
Illustration 1: **Inventor v. Joint Inventor**



“Inventor” or
“Inventive Entity” or
“Inventorship”



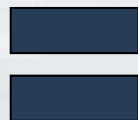
Ross



“Joint Inventor” or
“Coinventor”



May



“Joint Inventor” or
“Coinventor”



Inventor or Applicant?

- “Inventor” and “Applicant” are no longer synonymous under the AIA.
- The term “Applicant” can include inventor(s), assignee(s), or others with a proprietary interest.
- When considering a prior art or a double patenting rejection, an examiner should remember that someone listed as an applicant is not necessarily an inventor.



Definition of **Joint Research Agreement**

- A joint research agreement is defined as a written contract, grant, or cooperative agreement entered into by two or more persons or entities for the performance of experimental, developmental, or research work in the field of the claimed invention.
- Joint research agreements are relevant to exceptions to 102(a)(2) disclosures as set forth in 102(b)(2)(C).



Definition of **Claimed Invention**

- The claimed invention is the subject matter defined by a claim in a patent or an application for a patent.



Definition of **Effective Filing Date** in an AIA Application

The effective filing date of a claimed invention in an AIA application (other than reissue applications) is the earlier of:

(1) the actual filing date of the application

or

(2) the filing date of the earliest application for which the application is entitled, as to such invention, to a right of **foreign priority** or the domestic benefit of an earlier filing date.



Illustration 2: Effective Filing Date

July 1, 2013

July 1, 2014

Taylor files
Japanese patent
application
disclosing X

Taylor files a
nonprovisional patent application
claiming X with a foreign priority
claim to the Japanese application

- Effective filing date for Taylor's invention X is July 1, 2013, which is the filing date of the **foreign priority** application



Concept of “**Grace Period**” is Taken From 35 U.S.C. 102(b)(1)

- The grace period is the one year time period before the effective filing date of the claimed invention, which can be the foreign priority filing date.
- The concept of a grace period is taken from the language of 35 U.S.C. 102(b)(1) which defines exceptions to public disclosures as set forth in 35 U.S.C. 102(a)(1).



Illustration 3: **Grace Period** Under 35 U.S.C. 102 (b)(1)

Effective Filing Date
(may be a domestic or
foreign filing date)





Concept of “**Effectively Filed Date**” for Prior Art Under 35 U.S.C. 102(a)(2)

The effectively filed date of subject matter in a U.S. patent or published application as prior art under 35 U.S.C. 102(a)(2) is the earlier of:

- 1) the actual filing date of the U.S. patent or published application being used as the reference

or

- 2) the filing date of the earliest application to which the U.S. patent or published application being used as the reference is entitled to claim a right of **foreign priority** or domestic benefit which describes the subject matter.



Illustration 4: Effectively Filed Date of a Reference Under AIA 102(a)(2)

Jackson files German patent application disclosing X

June 5, 2011

Jackson files U.S. patent application disclosing X; foreign priority is claimed his earlier German application

June 5, 2012

Jackson's U.S. patent application publishes

December 18, 2012

- Jackson's patent application publication is being considered as possible prior art against claims in an AIA application.
- Jackson's prior art patent application publication was effectively filed on June 5, 2011, which is the filing date of the foreign priority application.



For Questions...

- AIA Internal Microsite:

<http://ptoweb.uspto.gov/patents/fitf>

FITF First Inventor To File

HOME Public FAQs

PTO Net > Patents > First Inventor To File

First Inventor to File (FITF)

Welcome to the First Inventor to File micro-site!

The first inventor to file (FITF) provision of the America Invents Act transitions the U.S. to a first-inventor-to-file system from a first-to-invent system and becomes effective on March 16, 2013. Because the provision introduces changes to 35 U.S.C. § 102 that impact your daily examination process, we have created this special micro-site to house all information that you need to know. Specifically, this micro-site includes information about FITF training schedules, training materials, videos, frequently asked questions, and the like. We encourage you to use this micro-site as "one-stop-shopping" for your first inventor to file interests and questions.

Videos

- Introductory FITF Video (March 2013)
- Follow up FITF Video (March 2013)

Training Materials

- First Inventor to File Statutory Framework (laminated card handout)
- Introductory FITF Video slides
 - Introductory FITF Video slides with script
- First Inventor to File Live Overview Training Slides
 - First Inventor to File Live Overview Training Slides with script
- Follow up FITF Video slides
 - Follow up FITF Video slides with script

Rules and Guidelines

- First Inventor to File Final Rules
- First Inventor to File Guidance

Questions?

Please email any questions regarding FITF to the following:

- FITF_examiner_questions@uspto.gov

Team Members

- Robert Bahr
- Kathleen Bragdon
- Kathleen Fonda
- Nathanya Ferguson
- Janet Gongola
- Chris Grant
- Tom Hughes
- Gerry Leffers
- Jennifer Lo
- MaryBeth Jones
- Valencia Martin-Wallace
- Camilo Reyes
- Steve Saras
- Joel Sincavage
- Don Sparks
- Sandie Spyrou
- Mary Till
- Susy Tsang-Foster



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Lead FITF Points of Contact

| Contact | Business Unit |
|------------------|----------------------------|
| Cassandra Spyrou | TC 2600 & 2800 |
| Chris Grant | TC 2100, 2400, & OPT |
| Tom Hughes | TC 3600, 3700, & CRU |
| Kathleen Bragdon | TC 1600, 1700 & 2900 |
| Gerald Leffers | OPQA/ TC 1600, 1700 & 2900 |
| Steve Saras | OPQA/ TC 2600 & 2800 |
| Don Sparks | OPQA/ TC 2100, 2400, & OPT |
| MaryBeth Jones | OPQA/ TC 3600, 3700, & CRU |



Time Code

- Time code = **ATRRAIN 0118 090101**

Thank You!

