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Fitzpatrick Cella Harper & Scinto
New York

Michael K O'Neill

Spotlight on first-to-publish

As the United States continues its transition to the first-inventor-to-file (FITF) system, which became effective in March, 2013, it is worthwhile to recall that some situations give rise to exceptions that excuse strict application of first-to-file rules. Among these exceptions is the so-called first-to-publish exception which excuses an intervening publication by a third party which, although independent of the inventors' work, was published after a prior publication attributable to the inventors.

In its Fall 2014 travelling roadshow, the USPTO focused on FITF and specifically explained the regulatory mechanisms it has implemented for invoking the first-to-publish exception. Declarations under Rule 130(b) are the preferred route, and the USPTO gave examples of declarations that are compliant and those that are deficient.

One common deficiency is a failure of the declaration to assert inventorship. Explaining that exceptions in FITF apply only to inventors, the USPTO will require an assertion of inventorship, which cannot be satisfied by an application data sheet (ADS) alone. Rather, the USPTO will require a properly signed oath (Rule 63) by the inventors, or an assertion of inventorship in the declaration itself which may also refer to an oath.

As for the content of the declaration, the USPTO explained that it was wrong to focus on the claims. Rather, the proper focus was a comparison of the inventors' prior publication to the third party's intervening publication. The reason: it is only the subject matter actually disclosed by the inventors that might be excludable from the intervening publication.

Four different fact scenarios were outlined, with two resulting in successful application of the exception and two not. The exception applies where the inventors' prior publication is identical to or more specific than the intervening publication. For example, where the inventors' prior publication describes species X and the intervening publication describes a genus containing X, then the exception applies and the intervening publication may be excluded.

The exception does not apply in the inverse scenario, where the intervening publication is more specific than the inventors' prior publication. Thus, an inventor who publishes a genus containing X, but does not actually mention X, will not be able to exclude an intervening publication of X.

Likewise, the exception does not apply where the intervening publication discloses a variant – even an obvious variant – of the inventors' prior publication. Reiterating its basic theme, the USPTO explained that it is only the subject matter actually disclosed in the inventors' publication that can be excluded from the intervening publication.

In view of these limitations, a better result will almost certainly be obtained by an early filing date as opposed to a prior publication. A prior publication simply does not provide the same benefits as a patent application, even a provisional application. Inventors should therefore continue to pursue an early filing date, and rely on the first-to-publish exception cautiously.