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Thank you for your interest in *Inventions International Inc.* this July 2013.

**Who's invention will make it
to the USPTO first,
Yours or a Competitor?**



While the rest of the world's patent filing system is first-inventor-to-file, the U.S. remained first-to-invent until a historic change to the U.S. patent filing system implemented the first-inventor-to-file provision. The first-inventor-to-file provision replaces the first-to-invent U.S. patent system and grants the patent rights for an invention to the first person to submit a patent application for that invention. On Your Mark, Get Set, GO!

How Does the First-Inventor-To-File Provision Impact My Patent Rights?

The first-inventor-to-file system took effect in the U.S. on March 16, 2013. This means that if a true inventor has an invention that



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Serving the Tampa Bay Area since 2008

Unfortunately, many *true* individuals and corporate entities that “hold off” from patenting their invention can be barred from obtaining patent rights. This happens when another entity such as a competitor or an unrelated individual submits an application at a time prior to the “held off” invention. The applicant’s patent application having an earlier filing date is now considered prior art to the true inventor’s “held off” invention. Any subsequently filed patent application

they have not patented yet, a competitor could obtain a patent for the same invention if they submit an application for the invention before the true inventor. A new proceeding ensures that if a true inventor is not the first to file an application, the true inventor can challenge the first applicant's right to a patent by demonstrating that the first application is claiming an invention derived from the true inventor.



Although, the first-inventor-to-file system maintains a 12-month grace period for an inventor's own disclosures, *the legal fees associated with the derivation proceeding to*

show that that the first application is claiming an invention derived from the true inventor can cost hundreds of thousands of dollars.

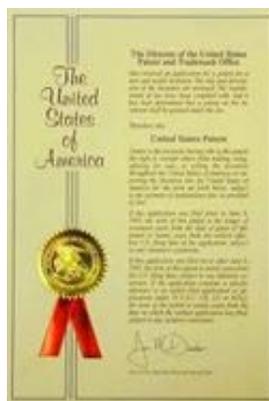
Developing an invention comprises two main steps:

1. *An inventor's date of conception* of an invention is the date in which the invention is developed to a point where someone skilled in the art could make and use the invention without undue experimentation, such as when a Registered Patent Agent has finished drafting a patent application. The conception date is important in establishing who the true inventor is in the event another inventor submits a patent application for the same invention.
2. *An inventor's reduction to practice* date is the date the inventor submitted a patent application to the USPTO or began practicing the invention. The invention is required to have been sufficiently tested to demonstrate it will work for its intended purpose.

There is a ***reasonable diligence critical period*** for an inventor who was first to conceive but later to reduce to practice the

for the same invention would stand rejected under 35 U.S.C. § 102 (a) as being anticipated by the patent application having the earlier filing date.

There is a ***reasonable diligence critical period*** for an inventor who was first to conceive but later to reduce to practice the invention. An applicant must be specific as to dates and facts when showing affirmative acts or acceptable excuses relating to the reasonable diligence with the engineering of their invention. A 2-day period lacking activity has been held to be fatal. *In re Mulder*, 716 F.2d 1542, 1545, 219 USPQ 189, 193 (Fed. Cir. 1983) (**37 CFR 1.131** issue).



Do not "hold off" your invention another day. I will diligently work with you on your patent matter to get your patent application filed.

Because some patent proceedings may be time sensitive, I am on-call and you can **contact me 24/7** at our Tampa Office Line (727)-608-8066 or email me at info@inventionsinternationalinc.com

Next month's newsletter will explore the different options an inventor can seek in obtaining a filing date to secure the "patent pending" status of their invention.

Regards,

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What Patent Services are offered?

Our patent services require the knowledge of patent laws and rules along with the USPTO practices and procedures.

- **Patentability searches**
- **Executing assignments**
- **Drafting patent drawings**
- **Patent prosecution**
- **Claims drafting**
- **Patent infringement analysis**
- **Prototype development**
- **Office action responses**

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