

Giving Priority

There has been a lot written recently about the importance of filing patent applications as soon as possible. Now that the US has moved to a First Inventor to File (FITF) patenting system, the importance of quickly filing an application has become obvious. But obvious doesn't mean new: filing an application as soon as possible has always been advisable.

The filing date of a patent application establishes a disclosure date for the invention. And in a FITF system, this disclosure date is used to establish the inventor eligible for a patent when multiple inventors are claiming the same invention. But the disclosure date also establishes the cutoff date for the patent searches for novelty and non-obviousness. To reject a patent claim, the USPTO can only use information that was publically available before the disclosure date.

Unfortunately, the strict use of the filing date gets complicated when an invention requires the filing of multiple applications. This can happen in several situations:

An inventor may want to add new discoveries or improvements to the invention.

The USPTO may decide that an application is really two inventions and require that the inventor file two applications. This happens in about 35% of textile related applications. A typical scenario is when a new loom is designed to build a new type of fabric. If the inventor filed a single application for protection on both the fabric and the loom capable of building it, the USPTO would most likely issue a "restriction" requiring the invention to be split into two applications.

Sometimes in the examination process, the examiner allows some, but not all, of the requested claims. In this situation, an applicant may decide to file a new application that splits the original application. By doing this, applicants can clear the path for the allowed claims to issue as a patent. At the same time they maintain their right to continue to pursue the disallowed claims through the new application.

In each of these instances, an inventor would want to be able to file a new application without losing the benefit of the earlier filing date for the original invention. This benefit is called "priority." When filing an application, the USPTO permits you to claim the filing date of a prior application. This is done in the new application by including a reference specifically identifying the prior application and directly stating the type of relationship between the applications. The types of relationship include the above situations. In addition, the USPTO allows applications to claim priority to patent applications filed in other countries as long as the inventions are the same.

The big rule here is that applicants cannot claim the benefit of a prior filing date for material that was not disclosed in the prior application. "New matter" can only claim the filing date of the application in which it is initially disclosed. This leads to inventions having multiple disclosure dates for different components within the invention.

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