



Greenblum & Bernstein, P.L.C.  
**CLIENT ADVISORY**  
Recent Changes in Rules and Procedures

January 22, 2013

**AMERICA INVENTS ACT FINAL RULE**

**From “*First-to-Invent*” to “*First-to-File*” System**

**Pending U.S. Provisional Applications**

Dear Clients:

As a reminder, the U.S. will undergo a major change in the patent law on March 16, 2013, changing from a “first-to-invent” (current law) to a “first-inventor-to-file” (new law) jurisdiction.

This Advisory is being sent to clients that have filed U.S. provisional applications on or after March 16, 2012, and which could benefit from filing a U.S. nonprovisional application *before* the one-year anniversary.

Note that any application filed on or after March 16, 2013, which does *not* claim priority to an application filed prior to that date, will be treated under the new law. However, note that if an application is filed on or after March 16, 2013, but claims priority to an application filed prior to that date, it may still be treated under the *new* law if it includes *new matter* added to the application filed on or after March 16, 2013 and any claim relies on that new matter for support. Thus, the USPTO will apply the new law to any application that includes *any* claim that has an effective date on or after March 16, 2013. The only applications that are certain to be entitled to treatment under the current law are those for which *all* claims are entitled to a filing date before March 16, 2013.

In view of these imminent changes, we suggest that our clients review all pending provisional applications filed on or after March 16, 2012 that may be used as the basis for priority – and expedite the filing of U.S. nonprovisional applications so as to file on or before March 15, 2013. The only way to ensure treatment under the current law is to file these applications on or before March 15, 2013.

We anticipate a very significant increase in the number of U.S. application filings in the last weeks before March 15, 2013; moreover, in the last days, we expect the burden on the USPTO’s resources to be excessive. To avoid possible problems due to an overload on USPTO resources, and also to better manage our own anticipated increased workload, we urge our clients to send instructions for these applications no later than February 15, 2013.

Should you have any questions with regard to the above, please do not hesitate to

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Best regards,

GREENBLUM & BERNSTEIN, P.L.C.

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