



Since the March 16, 2013 effective date of the first-inventor-to-file provision, the USPTO and patent applicants are prosecuting patent applications under two legal frameworks for prior art—first-to-invent provisions and first-inventor-to-file provisions. There are three possible scenarios that may arise in terms of which framework to apply to an application. These three scenarios are depicted in the graphic below.

First, as shown in the far left green circle, if an application was filed before March 16, 2013 and all domestic benefit or foreign priority claims made in the application are to applications filed before March 16, 2013, then the application is subject to examination under the pre-AIA law (first-to-invent).

Second, as shown in the far right blue circle, if an application is filed after March 16, 2013 and all domestic benefit or foreign priority claims made in the application are to applications filed on or after March 16, 2013, then the application is subject to examination under the AIA law (first-inventor-to-file).

Third, as shown in the middle red circle, if an application is filed after March 16, 2013 but all domestic benefit or foreign priority claims made in the application are to applications filed before March 16, 2013, then the applicant must file a statement under 37 CFR 1.55 or 1.78 (1.55/1.78 Statement) with the Office if the application contains claims to subject matter not supported by the domestic benefit or foreign priority filing and therefore should be examined under the AIA law (first-inventor-to-file). The USPTO has designated an application that falls into this third scenario as a "transition" application, and they are the focus here.

SCOPE OF 1.55/1.78 STATEMENT IN TRANSITION APPLICATION

In filing a 1.55/1.78 Statement, an applicant simply needs to state that the application contains at least one claims that does not find support in one of the applications to which benefit or priority is sought. Here are example statements that an applicant could file:

This application filed on or after March 16, 2013 which claims benefit or priority to an application filed before March 16, 2013, contains one or more claims NOT entitled to a filing date before March 16, 2013.

This application claims benefit or priority to an application filed before March 16, 2013, and contains one or more claims NOT entitled to a filing date before March 16, 2013.

This application contains one or more claims NOT entitled to a filing date before March 16, 2013.

This application contains a claim having an effective filing date on or after March 16, 2013.

Notably, the applicant is not required to identify the subject matter lacking support in the pre-March 16 domestic benefit or foreign priority filings. Nor is the applicant required to identify the specific claims drawn to the newly-added subject matter. To make it easy for an applicant to provide a 1.55/1.78 Statement to the Office, the USPTO has included a 1.55/1.78 Statement on the Application Data Sheet (ADS) with a check box that an applicant can use and thereby meet the statement requirement. More information about the use of the 1.55/1.78 Statement on an ADS is discussed below.