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**Advancing the effective filing date in an
inter partes review proceeding**

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When and why would a party want to advance the effective filing date?

A party in an *inter partes* review proceeding may wish to claim an earlier effective filing date for the challenged patent or an invalidating reference. This can be done by claiming priority to, or claiming the benefit of, an earlier-filed application.¹

Either party in an *inter partes* review proceeding may wish to claim the benefit of an earlier filing date for the patent being challenged. Most commonly, a patent owner claims an earlier effective filing date for the challenged patent to antedate and disqualify one or more of the references on which the challenge is based.

But an earlier effective filing date also means an earlier expiration date. If the challenged patent would expire during the pendency of review, claims are construed under the narrower *Phillips* standard rather than the broadest reasonable interpretation standard. Depending on the case, either the petitioner or the patent owner would want to advance the filing date for this reason.

In rare instances, the petitioner is the one advocating for an earlier effective filing date for the challenged patent to ensure that the *inter partes* review petition is timely filed.

A petitioner may also wish to advance the filing date of the invalidating reference to make it available as prior art against the challenged patent.

This paper will review recent PTAB decisions and provide practical guidance for parties to an *inter partes* review proceeding wishing to claim the benefit of an earlier filing date for a challenged patent or an invalidating reference.

¹ An owner of a pre-AIA patent may also antedate an invalidating reference by proving prior invention under pre-AIA 35 U.S.C. § 102(a). Discussions of prior invention, conception, and reduction to practice are outside the scope of this paper.

“Effective filing date” under the AIA

The America Invents Act defines “effective filing date” as the earlier of (A) the actual filing date of the patent or application for the patent containing a claim to the invention or (B) the filing date of the earliest application for which the patent or application is entitled, as to such invention, to a right of priority under section 119, 365(a), or 365(b), or to the benefit of an earlier filing date under section 120, 121, or 365(c).²

These applications would include:

foreign national applications (§ 119(a), (b), (c), and (d));

domestic provisional applications (§ 119(e));

continuing applications based on prior United States nonprovisional applications (§ 120);

divisional applications based on prior United States nonprovisional applications (§ 121); and

PCT applications that designate the United States or other countries (§ 365).

Any of these applications can confer an earlier effective filing date on a later-filed patent application.

² See 35 U.S.C. § 100(i)(1). The AIA equates “priority” and “benefit” without qualification, and simply tracks the preexisting difference in wording in Sections 119 and 120. This paper generally uses “advance the effective filing date,” that is, move the effective filing date earlier in time, to refer to the concept of claiming priority to or the benefit of an earlier filing date. *But see Technology Licensing Corp. v. Videotek, Inc.*, 545 F.3d 1316, 1324 n.5 (Fed. Cir. 2008) (“For clarity, we refer not to a priority date but to entitlement to the benefit of a filing date, or simply the “effective filing date.”). This convention is used for the sake of concision, even though a filing date that is “advanced” in this sense is being moved further back in time from the present moment. *See also*, Stephen Hawking, *A Brief History of Time* ch. 9, “The Arrow of Time,” (1st ed., Bantam Dell Publishing Group 1988).

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