



# America Invents Act: Patent Reform<sup>©</sup>

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# AIA: Patent Reform

- From “First-to-Invent” to “First-to-File”
- Pre- and Post-Issuance Proceedings
- Litigation Issues
  - Prior User Rights
  - Patent Marking
  - Best Mode Requirement

# From “First-to-Invent” to “First-to-File”

# First to File: Effective Dates

- First to file provisions effective March 16, 2013
- Current “first to invent” laws will continue to apply for roughly another 23 years
- Applicable law depends on whether or not an application or patent contains only claims having an *effective filing date* before March 16, 2013

# Definitions of Prior Art – 35 U.S.C. § 102

- Current laws define seven categories of prior art
  - Several categories are defined relative to date of invention
  - Permits removal of prior art with inventor declaration
  - Provides for interferences
- New laws define two categories of prior art
  - Both are relevant to effective filing date
  - Narrow exceptions to both categories

# Definitions of Prior Art (cont.)

- Patented, printed publication, public use, on sale, or otherwise available to public *before* effective filing date
- Exceptions
  - 1 year grace period
    - “Disclosures” made 1 year or less before effective filing date of the claimed invention, if disclosure is by inventor or another who obtained subject matter from inventor

# Definitions of Prior Art (cont.)

- A patent or patent application, filed by another, having an earlier effective filing date for the claimed invention.
- Exceptions to Prior Art
  - Removal of prior patent or application
    - Using prior publication
    - Proving disclosed subject matter was obtained from inventor(s) or
    - Subject to common ownership

# Definitions of Prior Art (cont.)

- Example – Removing prior application using prior publication



- B can remove A's application as prior art by relying on B's earlier publication
- B's earlier publication is prior art that will prevent A from obtaining a patent (even though A was the first to file)



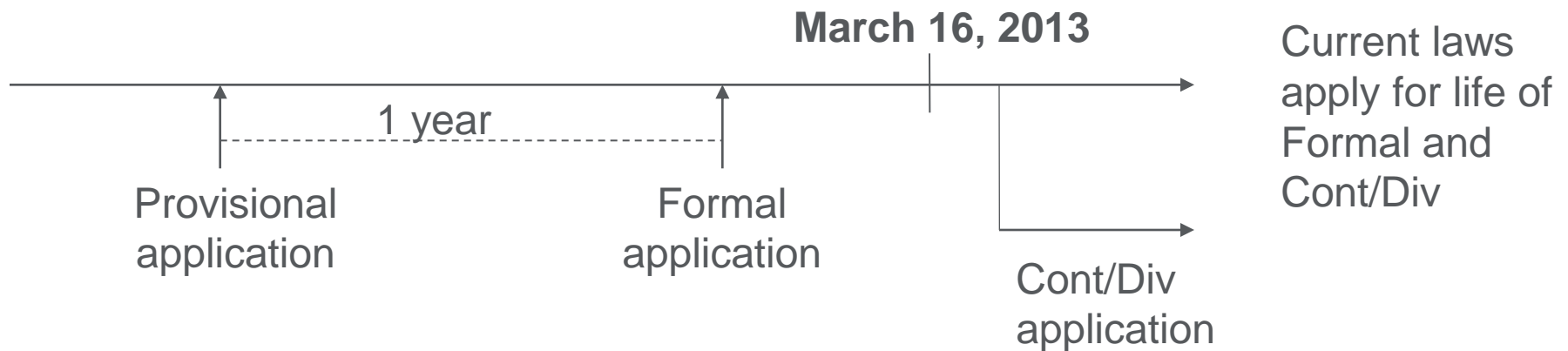
# First to File: Effective Filing Dates

- Effective filing date – 35 U.S.C. § 100(i)(1)
  - The actual filing date of the patent application containing a claim to the invention
  - The filing date of the earliest application for which a patent or application is entitled to a right of priority

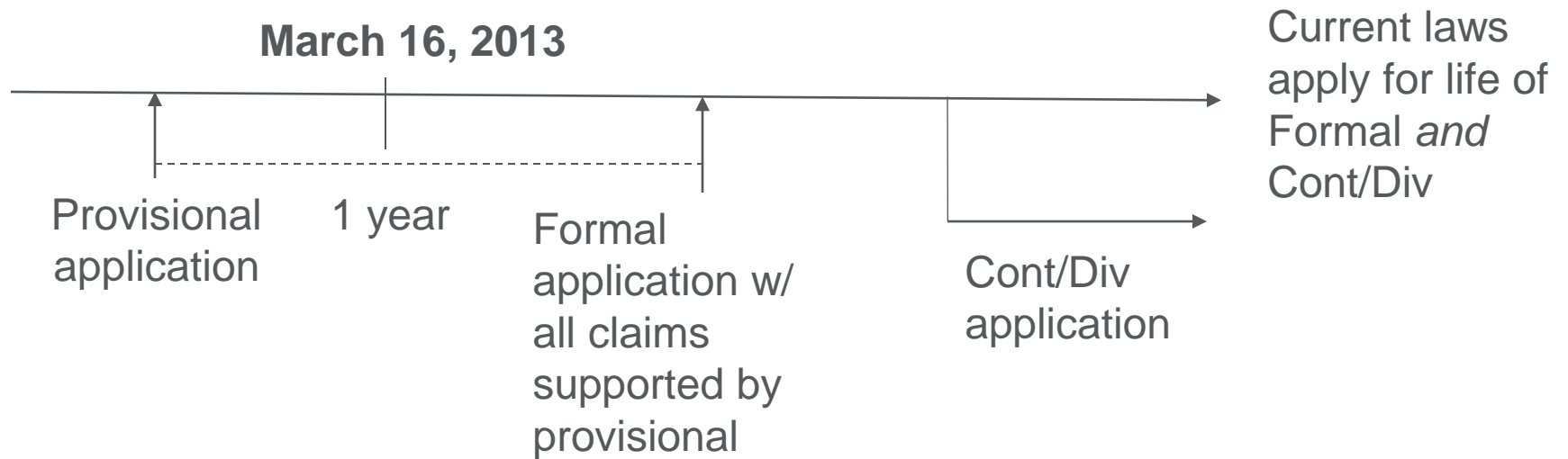
# First to File vs. First to Invent: Which Laws Apply?

- The new “first to file” laws apply to any application or patent that contains *or contained at any time*:
  - a claim that has an effective filing date that is on or after March 16, 2013; or
  - a specific reference under 35 U.S.C. § 120, 121, or 365(c) to any patent or application that contains *or contained at any time* such a claim

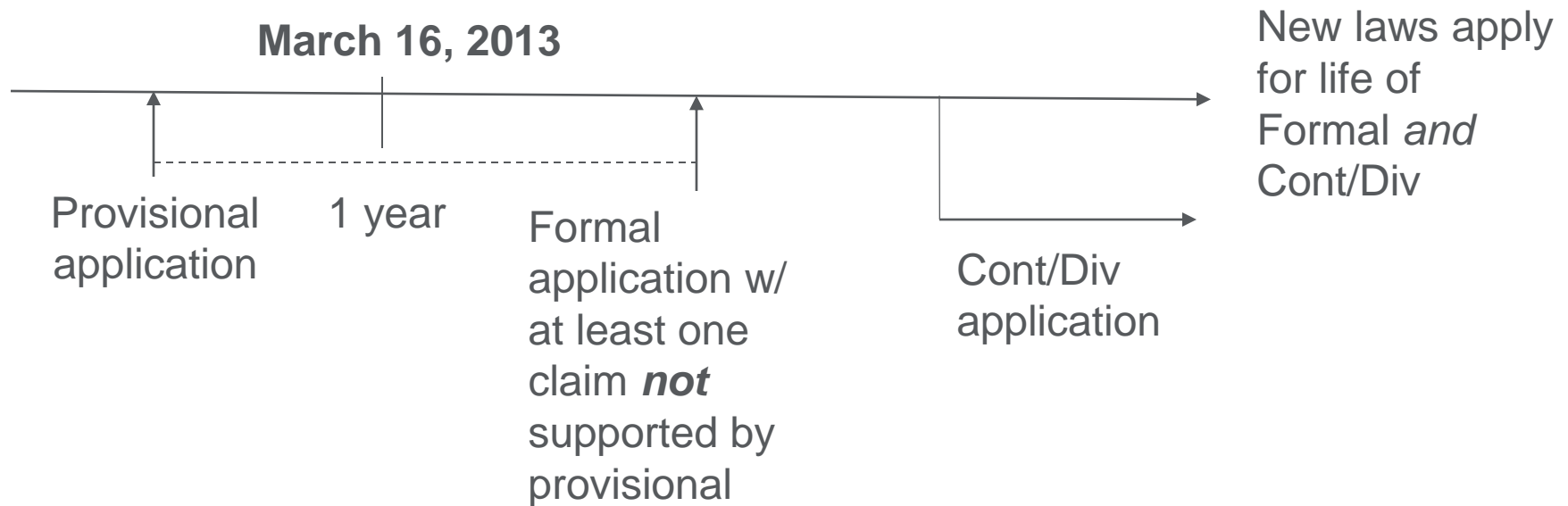
# First to File vs. First to Invent: Example #1



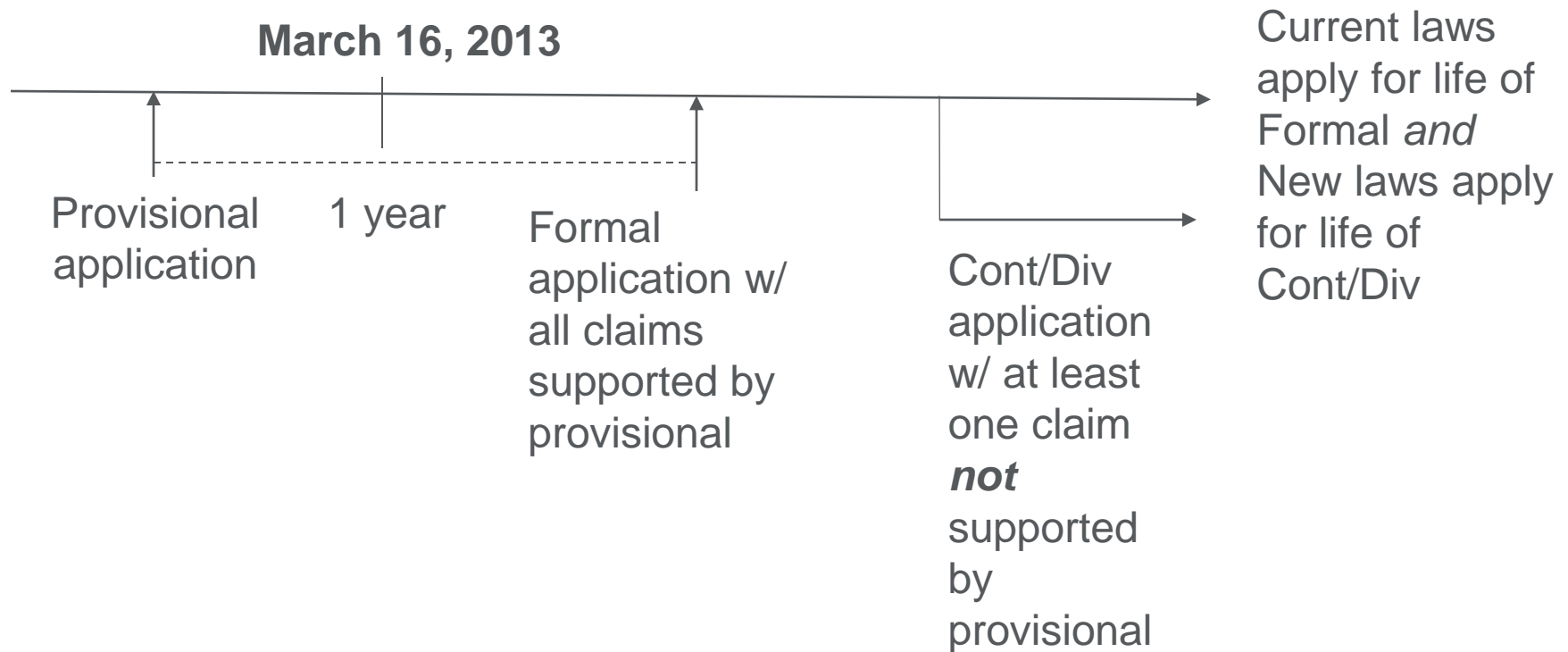
# First to File vs. First to Invent: Example #2



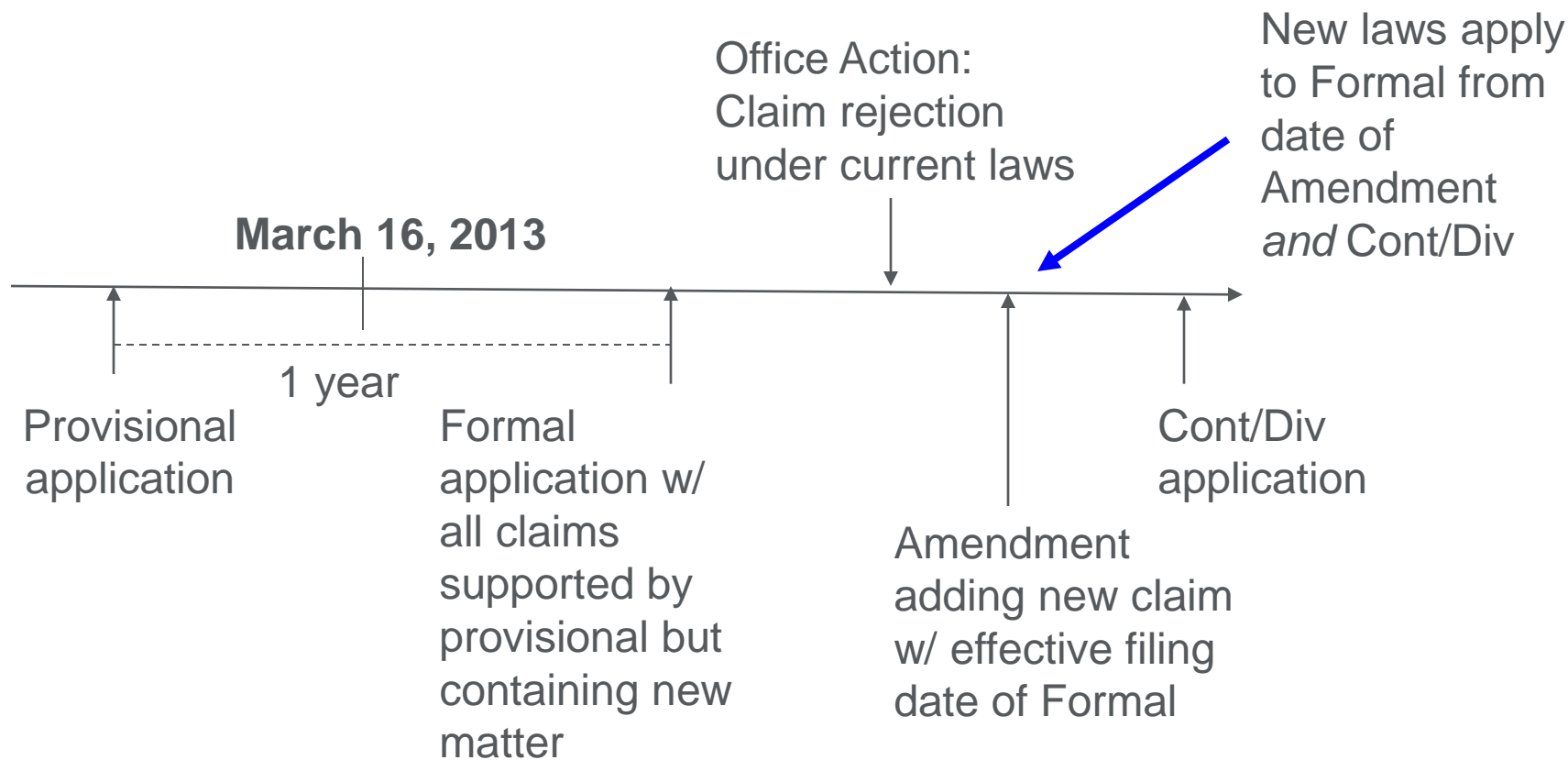
# First to File vs. First to Invent: Example #3



# First to File vs. First to Invent: Example #4



# First to File vs. First to Invent: Example #5



# Options for Filing

## □ Recommendations

- Avoid minimal disclosure provisional applications
- Consider filing formal application before March 16, 2013
- For formal applications after March 16, 2013, do not include claims directed to new subject matter
- If new claims are important, consider filing two US applications



# Pre- and Post-Issuance Proceedings

# Post-Issuance Practice (PIP) After Patent Reform

## Patent Challenger Procedures

- Preissuance Submissions
- Post-Grant Review
- *Inter Partes* Review
- *Ex Parte* Reexamination

## Patentee Procedures

- Supplemental Examination
- Reissue
- Continuation Practice

## Procedures for Patentees and Patent Challengers

- Interferences
- Derivation Proceedings

# Supplemental Examination

- Have PTO consider, reconsider, or correct information
  - Substantial new question of patentability
  - Any information
  - Any basis
- “Cure” inequitable conduct
  - No unenforceability if information is (re)considered/corrected during supplemental examination

*Available Sept 16, 2012 • Applies to all patents*

# Preissuance Submissions

- Submit art in pending applications
- Patents and printed publications
- “Of potential relevance to examination”
- Now permitted by statute
- Now permits/requires a “concise description of the asserted relevance”

*Effective Sept 16, 2012 • Applies to all applications*

# Post-Grant Review

- Anticipation, Obviousness, *and 112 issues* (Enablement, Written Description, Indefiniteness)
- Any information
- “More likely than not” that a challenged claim is unpatentable –or– novel/unsettled legal question

*Effective Sept 16, 2012 • Generally applies to all patents to which new prior art rules apply*

## *Inter Partes Review*

- Replaces *Inter Partes* Reexamination
- Anticipation or obviousness
- Patents and printed publications
- “Reasonable likelihood” that a challenged claim is unpatentable

*Effective Sept 16, 2012 • Generally applies to all patents*

# Current Interference Practice

- Some application vs. patent interferences may be converted to post-grant review
- Application vs. application interferences will continue
- Current interference laws will continue to apply to each claim of patent or application that contains or contained at any time:
  - a claim to a claimed invention that has an effective filing date that is before March 16, 2013; or
  - a specific reference under 35 U.S.C. § 120, 121, or 365(c) to any patent or application that contains or contained at any time such a claim

# Derivation Proceedings

- Party alleging derivation must prove prior conception and communication to other party
- Instituted in PTO by applicant or in district court by later patentee
- File petition within 1 year from publication of application or grant of patent

*Effective Mar 16, 2013 • Generally applies to all applications to which new prior art rules apply*



# Litigation Issues - Prior User Rights, 35 U.S.C. § 273(b)(6)

- Prior user rights defense extended to all subject matter, if:
  1. commercially used
  2. at least one year before the earlier of
    - patent's effective filing date, or
    - public disclosure of the invention
- Strengthens trade secret protection
- “Carve out” provision for universities
  - Defense not available if university/tech transfer office is patent holder

*Effective Sept 16, 2011 • Applies to all patents issued on/after Sept 16, 2011*

# Litigation Issues – Marking

- Legal standing in false marking cases is limited to persons who have suffered “competitive injury”
  - 35 U.S.C. § 292
- Virtual marking now available
  - 35 U.S.C. § 287(a)
  - Products may be “marked” with a website address that provides the applicable patents

*Effective Sept 16, 2011 • Applies to all pending and future cases*

# Best Mode Requirement

- The failure to disclose the best mode in an application for patent cannot be a basis for invalidating an issued patent
- PTO rejections can still be made

*Effective Sept 16, 2011 • Applies to all proceedings commenced on/after Sept 16, 2011*



**THANK YOU**

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