

Considerations for the United States

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Leahy-Smith America Invents Act

- First Inventor to file, with grace period
- Derivation Actions
- Prior user rights defense
- New Opposition procedures

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- Fee setting authority
- Filing by other than inventor
- Micro-entity
- Supplemental examination
- Patent Trial and Appeal Board
- Patent and Trademark Office funding
- Inventor's oath or declaration
- Best mode
- False marking

Key dates:

- 16 Sep 2011: Effective date of Act: several Commissioner powers effective immediately
- 16 July 2012: Scheduled date for publication of Regulations in the Federal Register
- 16 Sep 2012: Implementation date for many procedural matters
- 16 Mar 2013: Regime for First Inventor to File, with grace period (FITFG) applies to newly filed applications

Sense of Congress

“It is the **sense of the Congress** that converting the United States patent system from “**first to invent**” to a system of “**first inventor to file**” will promote the progress of science and the useful arts by securing for limited times to inventors the exclusive rights to their discoveries and provide inventors with greater certainty regarding the scope of protection provided by the grant of exclusive rights to their discoveries.” (AIA, Sec. 3 (o))

Interference Out: Derivation In

Under the AIA:

- The concept of an “interfering” patent is eliminated.
- Interference proceedings are eliminated.

- The concept of a “derived patent” is introduced.
- Derivation proceedings are introduced.

Novelty

The AIA imposes a new standard of strict novelty, applicable to disclosures worldwide, but simultaneously grants the inventor a grace period of 1 year for his own disclosures and derived disclosures.

Novelty

35 USC § 102 (a): “A person shall be entitled to a patent unless—

(1) the claimed invention was patented, described in a printed publication, or in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention; or

(2) the claimed invention was described in a patent issued under section 151, or in an application for patent published or deemed published under section 122(b), in which the patent or application, as the case may be, names another inventor and was effectively filed before the effective filing date of the claimed invention.”

Grace Period: 1 Year

35 USC §102 (b)(1): “EXCEPTIONS: DISCLOSURES MADE 1 YEAR OR LESS BEFORE THE EFFECTIVE DATE OF THE CLAIMED INVENTION —

A disclosure made 1 year or less before the effective filing date of a claimed invention shall not be prior art to the claimed invention under subsection (a)(1) if—

(A) the disclosure was made by the inventor or joint inventor or by another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor; or

(B) the subject matter disclosed had, before such disclosure, been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor.”

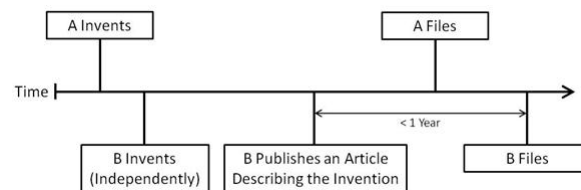
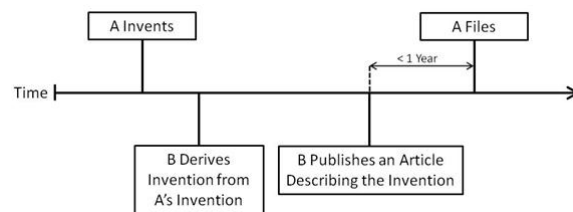
Grace Period (unpublished patent applications)

35 USC §102 (b)(2): A disclosure shall not be prior art to a claimed invention under subsection (a)(2) if—

(A) the subject matter disclosed was obtained directly or indirectly from the inventor or a joint inventor;

(B) the subject matter disclosed had, before such subject matter was effectively filed under subsection (a)(2), been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor; or

(C) the subject matter disclosed and the claimed invention, not later than the effective filing date of the claimed invention, were owned by the same person or subject to an obligation of assignment to the **same person.**”



Obviousness / Inventive Step

The standard for obviousness is substantially unchanged by AIA, except for the new exceptions to “prior art” under §102 (*supra*).

Derived Patents

35 USC § 291:

“(a) IN GENERAL.—The owner of a patent may have relief by civil action against the owner of another patent that claims the same invention and has an earlier effective filing date, if the invention claimed in such other patent was derived from the inventor of the invention claimed in the patent owned by the person seeking relief under this section.

“(b) FILING LIMITATION.—An action under this section may be filed only **before the end of the 1-year period** beginning on the date of the issuance of the first patent containing a claim to the allegedly derived invention and naming an individual alleged to have derived such invention as the inventor or joint inventor.”

Derivation proceedings

35 USC § 135 (a):

- “An applicant for patent may file a petition to institute a derivation proceeding in the Office.”
- “The petition shall set forth with particularity the basis for finding that an inventor named in an earlier application derived the claimed invention from an inventor named in the petitioner’s application”
- “Any such petition may be filed only within the 1-year period beginning on the date of the first publication of a claim to an invention that is the same or **substantially** the same as the earlier application’s claim to the invention, . . . and shall be supported by substantial evidence.”
- “Whenever the Director determines that a petition filed under this subsection demonstrates that the standards for instituting a derivation proceeding are met, the Director may institute a derivation proceeding.”
- “The determination by the Director whether to institute a derivation proceeding shall be final and nonappealable.”**

Derivation Proceedings

35 USC § 135 (b):

- “In a derivation proceeding . . . , the Patent Trial and Appeal Board shall determine whether an inventor named in the earlier application derived the claimed invention from an inventor named in the petitioner’s application and, without authorization, the earlier application claiming such invention was filed.”
- “In appropriate circumstances, the Patent Trial and Appeal Board may correct the naming of the inventor in any application or patent at issue.”
- “The **Director shall prescribe regulations setting forth standards for the conduct of derivation proceedings**, including requiring parties to provide sufficient evidence to prove and rebut a claim of derivation.”

Prior user rights defense

- Previously, prior user rights encompassed business methods only.
- AIA broadens the “prior user rights defense” to encompass:
“subject matter consisting of a process, or consisting of a machine, manufacture, or composition of matter used in a manufacturing or other commercial process.” (35 U.S.C. § 273 (a))

Prior user rights defense

- The defense applies if:
 - (1) [the defendant] “acting in good faith, commercially used the subject matter in the United States, either in connection with an internal commercial use or an actual arm’s length sale or other arm’s length commercial transfer of a useful end result of such commercial use; and
 - (2) such commercial use occurred at least 1 year before the earlier of either—
 - (A) the effective filing date of the claimed invention; or
 - (B) the date on which the claimed invention was disclosed to the public in a manner that qualified for the exception from prior art under section 102(b).” (35 U.S.C. § 273 (a))

Opposition proceedings

Eliminated Procedure: *Inter partes* reexamination

Retained Procedure: *Ex parte* reexamination

New Procedures:

1. Preissuance Submission by Third Parties
2. Post Grant Review
3. *Inter partes* Review

Preissuance Submissions by Third Parties

Scope:

“(1) IN GENERAL.—Any third party may submit for consideration and inclusion in the record of a patent application, any patent, published patent application, or other printed publication of potential relevance to the examination of the application, . . . “(35 USC 122 (e))

Timing:

•earlier than the date a notice of allowance; and

•not later than the later of —

(i) 6 months after the date on which the application for patent is first published . . . , or

(ii) the date of the first rejection (35 USC 122 (e) (1))

Post Grant Review

Scope:

“(2) the petition identifies, in writing and with particularity, each claim challenged, the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim, including—

(A) copies of patents and printed publications that the petitioner relies upon in support of the petition; and

(B) affidavits or declarations of supporting evidence and opinions, if the petitioner relies on other factual evidence or on expert opinions; . . .” (35 USC § 322 (a))

Timing:

“(c) FILING DEADLINE.—A petition for a post-grant review may only be filed not later than the date that is 9 months after the date of the grant of the patent or of the issuance of a reissue patent (as the case may be).” (35 USC 321)

Inter partes Review

Scope:

“(b) A petitioner in an inter partes review may request to cancel as unpatentable 1 or more claims of a patent only on a ground that could be raised under section 102 or 103 and only on the basis of prior art consisting of patents or printed publications.” (35 USC 311)

Timing:

“the later of either—

(1) the date that is 9 months after the grant of a patent or issuance of a reissue of a patent; or

(2) if a post-grant review is instituted under chapter 32, the date of the termination of such post-grant review.” (35 USC 311 (c))

***Ex parte* reexamination**

Scope:

IN GENERAL.—Any person at any time may cite to the Office in writing—
(1) prior art consisting of patents or printed publications which that person believes to have a bearing on the patentability of any claim of a particular patent; or
(2) statements of the patent owner filed in a proceeding before a Federal court or the Office (35 USC 301(a))

Timing:

“Any person at any time” (35 USC 302)

Summary: Opposition proceedings

1. Preissuance Submissions by Third Parties

Scope: narrow
Appellate Body: N/A
Reviewing Body: Examination Unit
Discovery: No
Estoppel: N/A

2. Post Grant Review

Scope: Broad
Appellate Body: Federal Circuit
Reviewing Body: PTAB
Discovery: Yes. Reg's will clarify.
Estoppel: Yes

3. *Inter partes* Review

Scope: less broad than PGR
Appellate Body: Federal Circuit
Reviewing Body: PTAB
Discovery: Yes. Reg's will clarify.
Estoppel: Yes

4. *Ex parte* reexamination

Scope: broad
Appellate Body: PTAB, then Federal Circuit (Patentee only)
Reviewing Body: Reexamination Unit
Discovery: No
Estoppel: No