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INTELLECTUAL PROPERTY LAW

America Invents Act



Topic:

- Legislative History
- Effective Dates
- First Inventor to File
- Derivation Proceedings
- Inventor's Oath/Declaration
- 3rd Party Submission of Prior Art
- Supplemental Examination
- Post Grant Reviews and Inter Partes Review
- Best Mode
- Human Organism Prohibition
- Prioritized Examination
- Fees for Patent Services



Legislative History:

- March 8, 2011** - Senate passes S 23, renamed “America Invents Act”
- June 23, 2011** – House passes HR 1249
- September 8, 2011** – Senate accepts House text
- September 16, 2011** - President signs



**Effective
Dates:**

- Group I: **60 Days and Under**
- Group II: **12 Month Effective Date**
- Group III: **18 Month Effective Date**



Effective Dates:

- **Group I: 60 Days and Under**
 - On Date of Enactment (i.e., Sep. 16, 2011)
 - Inter partes reexamination threshold
 - Best mode
 - Human organism prohibition
 - Fee setting authority
 - Establishment of micro-entity
 - 10 Days After Enactment (i.e., Sep. 26, 2011)
 - Prioritized Examination (PE)
 - 15% transition surcharge
 - 60 Days After Enactment (i.e., Nov. 15, 2011)
 - Electronic filing incentive
- **Group II: 12 Month Effective Date**
- **Group III: 18 Month Effective Date**



**Effective
Dates:**

- Group I: 60 Days and Under**
- Group II: 12 Month Effective Date**
 - Inventor's oath/declaration
 - 3rd party submission of prior art for patent application
 - Supplemental Examination
 - Inter partes review
 - Post grant review
- Group III: 18 Month Effective Date**



**Effective
Dates:**

- Group I: **60 Days and Under**
- Group II: **12 Month Effective Date**
- Group III: **18 Month Effective Date**
 - First-Inventor-to-File
 - Derivation proceedings



First- Inventor- to-File:

AIA Section 3

Effective Mar. 16, 2013

- Defined Terms (AIA Section 3(a))
 - “**claimed invention**” – subject matter defined by a claim in a patent or an application for a patent
 - “**inventor**” – individual or, if a joint invention, the individuals collectively who invented or discovered the subject matter of the invention



First- Inventor- to-File:

□ Defined Terms (AIA Section 3(a)) (Cont'd)

- “**effective filing date**” for a claimed invention in a patent or application for patent, means:

(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 35 USC 119, 365(a), or 365(b) or to the benefit of an earlier filing date under 35 USC 120, 121 or 365(c), or

(A) If (B) does not apply, the actual filing date of the patent or application for the patent containing a claim to the invention.

Effective filing date includes **domestic and foreign priority dates, where 35 USC 112 (written description and enablement) disclosure requirements are satisfied**



**First-
Inventor-
to-File:**

NEW 35 USC 102. Conditions for patentability; novelty

(a) Novelty; Prior Art- A person shall be entitled to a patent unless--

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



First- Inventor- to-File:

NEW 35 USC 102. Conditions for patentability; novelty

(a) **Novelty; Prior Art- A person shall be entitled to a patent unless--**

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

(b) **Exceptions-**

(1) **DISCLOSURES MADE 1 YEAR OR LESS BEFORE THE EFFECTIVE FILING DATE OF THE CLAIMED INVENTION- A disclosure (anywhere in the world) made 1 year or less before the effective filing date (anywhere in the world) of a claimed invention shall not be prior art to the claimed invention under subsection (a)(1) (above) 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.**



First- Inventor- to-File:

NEW 35 USC 102. Conditions for patentability; novelty

(a) Novelty; Prior Art- A person shall be entitled to a patent unless--

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



First- Inventor- to-File:

NEW 35 USC 102. Conditions for patentability; novelty

(a) Novelty; Prior Art- A person shall be entitled to a patent unless--

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

(d) **Patents and Published Applications Effective as Prior Art-** For purposes of determining *whether a patent or application for patent is prior art* to a claimed invention under subsection (a)(2), such patent or application shall be considered to have been *effectively filed*, with respect to any subject matter *described* in the (US) patent or (US or PCT designating the US) application-

(2) if the patent or application for patent is entitled to claim a right of priority under section 119, 365(a), or 365(b), or (entitled) to claim the benefit of an earlier filing date under section 120, 121, or 365(c), based upon 1 or more prior filed applications for patent, as of the filing date of the earliest such application that describes the subject matter.

(1) if paragraph (2) does not apply, as of the actual filing date of the patent or the application for patent; or



First- Inventor- to-File:

NEW 35 USC 102. Conditions for patentability; novelty

(a) Novelty; Prior Art- A person shall be entitled to a patent unless--

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

(b) Exceptions-

(2) DISCLOSURES APPEARING IN (US or PCT designating the US) APPLICATIONS AND (US) PATENTS- 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.



Derivation Proceedings:

AIA Section 3

Effective March 16, 2013

- ❑ Allows USPTO to ensure that the inventor of a **first-filed** patent application did not **derive** the invention from the inventor of a **later-filed** application.
- ❑ Applicant or inventor of the later filed application must petition the USPTO to initiate the proceeding. Petition must be filed **within one year** from **the first publication date** of a claim to an invention that is the same or substantially the same as a claim in the first-filed application.
- ❑ Determination made by Patent Trial and Appeal Board (which replaces the Board of Patent Appeals and Interference)
- ❑ The derivation proceeding provision takes effect 18 months from enactment of the new law.



Inventor's Oath/ Declaration:

AIA Section 4

Effective Sep. 16, 2012

- Oath/declaration requirement of an inventor has been modified.
- A person to whom an inventor has assigned (or under an obligation to assign) an invention will be allowed to make an application for patent.

Example: A company can file an application on behalf of an employee/inventor who is under an obligation to assign the invention to the company but has refused to sign the required oath or declaration [or is otherwise unavailable].



3rd Party Submission of Prior Art:

AIA Section 8

Effective Sep. 16, 2012

- Allows third parties to submit printed publications of potential relevance to the examination of a patent application.
- Timing Requirement: Submission must be made before the earlier of:
 - (A) a notice of allowance, or
 - (B) the later of six months after publication of the application, or the date of first rejection.
- Content Requirement: Submission must include a concise description of the asserted relevance of each submitted document.
- Third-party submissions become part of the official file and, therefore, will likely require rebuttal by the applicant.



Supplemental Examination:

AIA Section 12

Effective Sep. 16, 2012

- ❑ New USPTO proceeding that will coexist with the existing *ex parte* reexamination process and provides an additional procedure for a patent owner to reopen examination of a granted patent.
- ❑ **Only the patent owner** may request supplemental examination of a granted patent.
- ❑ Patent owner may **submit any information** that raises a **substantial new question of patentability** and the submitted information is not limited to published patent documents and printed publications.
- ❑ Effect: With certain exceptions (ex. material fraud), a patent shall **not be held unenforceable** on the basis of conduct relating to information that had not been considered, was inadequately considered, or was incorrect in a prior examination if the information was considered, reconsidered, or corrected during a supplemental examination.
- ❑ Applies to any patent issued **before, on, or after effective date**.



Post Grant Review:

AIA Section 6

Effective Sep. 16, 2012

- ❑ New procedure – Allows **third party** to file a petition for post-grant review of an issued patent, provided certain conditions are met. The **patent owner is not allowed** to file such a petition.
- ❑ Timing Requirement: Deadline for a third party to file a petition for post-grant review is nine months after a patent issues. A post-grant review cannot be instituted if the third-party petitioner has already filed a civil action challenging the validity of the patent.
- ❑ Standard for Considering Petition: USPTO authorized to institute post-grant review if:
 - information presented in the petition, if not rebutted, would demonstrate that it is more likely than not that at least 1 of the claims challenged in the petition is unpatentable; or
 - petition “raises a novel or unsettled legal question that is important to other patents or patent applications.”
- ❑ During a post-grant review: Patentee may file one motion to amend the patent by cancelling any challenged patent claim or, for each challenged claim, propose a reasonable number of substitute claims, so long as the amendment does not enlarge the scope of the claims of the patent or introduce new matter. Subsequent motions may be entered upon joint request of the parties or for good cause.
- ❑ Estoppel Risks: A party filing a petition for post-grant review cannot subsequently assert in a civil action that a claim “is invalid on any ground that the petitioner raised or reasonably could have raised” during the post-grant review. As such, the estoppel risks must be taken into account before petitioning for a post-grant review.



Inter Partes Review:

AIA Section 6

Effective Sep. 16, 2012

- ❑ Replaces existing *inter partes* reexamination. Similar to the existing *inter partes* reexamination and different from the new post-grant review, *inter partes* review is limited to invalidity based on published patent documents and printed publications only.
- ❑ Timing Requirement: Can only be requested after nine months from grant of a patent or after the period for post-grant review.
- ❑ A third party is barred from filing an *inter partes* review if the third-party has already filed a civil action challenging the validity of the patent, or if more than one year has passed after the third party was served with a complaint alleging infringement of the patent.
- ❑ Termination: Different from *inter partes* reexamination which cannot be terminated by the third party requester and the patent owner, the third party requester and the patent owner can jointly request USPTO to terminate the *inter partes* review based on a settlement between the parties.
- ❑ Fast Track: Completion within one year from institution with an extension of up to six months for good cause. Compare to *inter partes* reexamination – currently taking three to four years.



Best Mode:

AIA Section 15

Effective Sep. 16, 2011

- 35 USC 282 amended to eliminate best mode as a **defense** to patent infringement

HOWEVER,

- 35 USC 112, first paragraph, maintains best mode as a **condition for patentability**

- MPEP 2165 remains the same

- Compliance with the best mode requirement requires a two-prong inquiry:

- (1) Determine whether, at the time the application was filed, the inventor possessed a best mode for practicing the invention.
- (2) If the inventor did possess a best mode, determine whether the written description disclosed the best mode such that a person skilled in the art could practice it.



Human Organism Prohibition:

AIA Section 33

Effective Sep. 16, 2011

- Patent may **not** issue on a claim directed to or encompassing a **human organism**
- USPTO policy already captures a human organism prohibition. *See* Animals- Patentability, 1077 Off. Gaz. Pat. Off., 24 (Apr. 21, 1987)



Prioritized Examination:

Effective Sep. 26, 2011

- ❑ Original utility or plant patent application accorded special status for expedited examination if:
 - \$4,800 fee, reduced by 50% for small entity;
 - No more than 4 independent claims, 30 total claims, and no multiple dependent claims; and
 - Must file application electronically (utility application)
 - Does not apply to international, design, reissue, or provisional applications or in reexamination proceedings
 - May be requested for a continuing application



Prioritized Examination:

- ❑ USPTO goal for final disposition (e.g., mailing notice of allowance, mailing final office action) is on average 12 months from date of prioritized status
- ❑ Prioritized exam is terminated without a refund of prioritized exam fee if patent applicant:
 - petitions for an extension of time to file a reply or to suspend action; or
 - amends the application to exceed the claim restrictions



Prioritized Examination:

- ❑ USPTO may not accept more than 10,000 requests for prioritized exam per fiscal year
- ❑ Changes to Implement Prioritizes Examination Track (Track 1) of the Enhanced Examination Timing Control Procedures Under the Leahy-Smith America Invents Act, 76 Fed. Reg. 5900 (Sept. 23, 2011)
- ❑ Impacts 37 CFR 1.17 and 1.102



Fees for Patent Services:

AIA Section 11

Effective Sep. 26, 2011

- 15% surcharge on all fees changed or authorized under 35 U.S.C. 41(a), (b), and (d)(1)
- 15% surcharge does not apply to international stage PCT fees, certain petition fees, and enrollment fees
- Fee table at http://www.uspto.gov/aia_implementation/15_Percent_Surcharge_Fee_Changes.pdf



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