

Summary of America Invents Act (AIA), signed into law on Sept. 16, 2011

35 USC 102 – Conditions for Patentability; Novelty (Effective Date March 16, 2013)

Note: On March 16, 2013 the USPTO will change from a First to Invent (FTI) to a First Inventor to File (FITF) system.

(The basis for the following can be found in 35 USC § 102(a) – (d))

(a) Novelty; Prior Art

A claimed invention is not novel after March 15, 2013 if the invention (35 USC § 102(a)):

(1) 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;

(2) the claimed invention was described in an issued patent or published application 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.

(“Effective Filing Date” = earliest priority date including U.S. & Foreign. The priority date will be the effective date for both novelty-defeating and obviousness.)

Exceptions include:

(1) Disclosures Made 1 Year or Less Before the Effective Filing 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. (35 USC § 102(b)(1))

(Note: Grants a one year grace period to the inventor or joint inventor.)

(2) Disclosures Appearing in Applications and 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 (“commonly owned”) or subject to an obligation of assignment to the same person. (35 USC § 102(b)(2))

(c) Common Ownership Under Joint Research Agreements

Subject matter disclosed and a claimed invention shall be deemed to have been owned by the same person or subject to an obligation of assignment to the same person in applying the provisions of subsection (b)(2)(C) if—

(1) the subject matter disclosed was developed and the claimed invention was made by, or on behalf of, 1 or more parties to a joint research agreement that was in effect on or before the effective filing date of the claimed invention;

(2) the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement; and

(3) the application for patent for the claimed invention discloses or is amended to disclose the names of the parties to the joint research agreement. (35 USC § 102(c)(1))

(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 patent or application—

(1) if paragraph (2) does not apply, as of the actual filing date of the patent or the application for patent; or (35 USC § 102(d)(1))

(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 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. (35 USC § 102(d)(2))

Applicant Under 35 U.S.C. 118 (Filing other than by Inventor)

- Permits an assignee, person to whom there is an obligation to assign, or person with a sufficient proprietary interest in the claimed invention to be the applicant
- Term “applicant” is no longer synonymous with the inventor
- Each inventor must still execute an oath or declaration (35 USC § 118)

Note: Permits assignee filing and permits filing of the inventor’s oath/declaration to be postponed until the application is otherwise in condition for allowance, however surcharge fee is applied if oath is not filed with the application.

The Applicant

Applicant may be the person:

- To whom the inventor has assigned;
- To whom the inventor is under an obligation to assign (obligated assignee); and
- Who otherwise shows sufficient proprietary interest in the matter

Applicant may also be:

- Legal representative of a deceased or incapacitated inventor; or
- Remaining joint inventor(s) if a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort

Application Data Sheet (ADS): Requirement (Information Required at Filing of Application)

ADS is required for:

- assignee, obligated assignee, or a person who otherwise shows sufficient proprietary interest to be considered the applicant in an application (except national stage applications);
- claim for foreign priority (except national stage applications); and
- claim for domestic benefit

Note:

- Presence of the priority claim in the oath/declaration will not be recognized
- Claim for domestic benefit must be set forth in an ADS
- Presence of the benefit claim in the first sentence(s) of the specification will not be recognized

Supplemental Examination (Effective Date: September 16, 2012) (35 USC 257):

Supplemental Examination: Goals

Statutory provision aims to provide patentees with a mechanism to immunize a patent from allegations of inequitable conduct

Final rules designed to:

- create a process that allows for completion of the supplemental examination within the 3-month statutory time frame and for prompt resolution of any ex parte reexamination; and
- avoid a post-patent process involving large submissions of unexplained documents (like IDS practice)
- Request for supplemental examination may be filed only by the patent owner
- Request may be filed at any time during the period of enforceability of the patent, e.g., generally 6 years after expiration of the patent
- Third party may not request supplemental examination or participate in a supplemental examination

Preissuance Submissions by Third Parties (Effective Date: September 16, 2012) (35 USC 122(e)):

Statutory provision aims to improve the quality of examination and issued patents

Final rule is designed to promote:

- efficient processing of submissions; and
- focused submissions of the most relevant documents
- Applies to: Pending or abandoned application filed before, on, or after September 16, 2012
- Any third party may submit printed publications of potential relevance to the examination of an application for consideration and inclusion in the record of the application
- Must be timely made in writing and include:
 - Concise description of asserted relevance of each document;
 - Fee; and
 - Statement of compliance with statute
- Submissions are limited to “printed publications,” for example:
 - U.S. patents and patent application publications
 - Foreign patents and published patent applications
 - Non-patent documents, such as articles, Office actions, communications from foreign patent offices, etc. that qualify as publications

Administrative Patent Trials: Final Rules

The Board of Patent Appeals and Interferences becomes the Patent Trial and Appeal Board (PTAB)

- Derivation proceedings replace Interferences
- PTAB takes responsibility for the two new types of inter partes proceedings:
 - “Post-Grant Review”
 - “Inter Partes Review”
- effective date September 16, 2012
- Post-Grant Review (PGR): available for the first 9 months following a patent’s issuance
- Inter Partes Review (IPR): available after PGR period/conclusion

Inter Partes Review (77 Fed. Reg. 48612, August 14, 2012):

Inter partes review (IPR) is a new trial proceeding conducted by the PTAB to review the patentability of one or more claims in a patent only on a ground that could be raised under 35 USC §§ 102 or 103, and only on the basis of prior art consisting of patents or printed publications. Inter partes review process begins with a third party (a person who is not the owner of the patent) filing a petition after the later of either: (1) 9 months after the grant of the patent or issuance of a reissue patent; or (2) if a post grant review is instituted, the termination of the post grant review. The patent owner may file a preliminary response to the petition. An inter partes review may be instituted upon a showing that there is a reasonable likelihood that the petitioner would prevail with respect to at least one claim challenged. If the proceeding is instituted and not dismissed, a final determination by the Board will be issued within 1 year (extendable for good cause by 6 months). The procedure for conducting inter partes review will take effect on September 16, 2012, and applies to any patent issued before, on, or after September 16, 2012.

Post Grant Review (77 Fed. Reg. 48612, August 14, 2012):

Post grant review (PGR) is a new trial proceeding conducted at the PTAB to review the patentability of one or more claims in a patent on any ground that could be raised under § 282(b)(2) or (3). Post grant review process begins with a third party filing a petition on or prior to the date that is 9 months after the grant of the patent or issuance of a reissue patent. The patent owner may file a preliminary response to the petition. A post grant review may be instituted upon a showing that, it is more likely than not that at least one claim challenged is unpatentable. If the proceeding is instituted and not dismissed, a final determination by the Board will be issued within 1 year (extendable for good cause by 6 months). The procedure for conducting post grant review took effect on September 16, 2012, and generally applies to patents issuing from applications subject to first inventor-to-file provisions of the AIA.

Transitional Program for Covered Business Method Patents (77 Fed. Reg. 48612, August 14, 2012):

The transitional program for covered business method patents (TPCBM) is a new trial proceeding conducted at the PTAB to review the patentability of one or more claims in a covered business method patent. TPCBM proceedings employ the standards and procedures of a post grant review, with certain exceptions. For example, for first to invent patents only a subset of prior art is available to support the petition. Further, a person may not file a petition for a TPCBM proceeding unless the person or the person's real party in interest or privy has been sued for infringement of the patent or charged with infringement under the patent. The procedure for conducting TPCBM review took effect on September 16, 2012, but only applies to covered business method patents. The program will sunset for new TPCBM petitions on September 16, 2020.

Derivation Proceeding (77 Fed. Reg. 48612, August 14, 2012):

A derivation proceeding is a new trial proceeding conducted at the Board to determine whether (i) an inventor named in an earlier application derived the claimed invention from an inventor named in the petitioner's application, and (ii) the earlier application claiming such invention was filed without authorization. An applicant subject to the first-inventor-to-file provisions may file a petition to institute a derivation proceeding only within 1 year 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. The petition must be supported by substantial evidence that the claimed invention was derived from an inventor named in the petitioner's application. The effective date for the derivation procedure will take effect on March 16, 2013.

For a More Thorough Explanation:

For more detailed information regarding the AIA, the reader is directed to the following USPTO website:

http://www.uspto.gov/aia_implementation/faq.jsp