

Leahy-Smith AMERICA INVENTS ACT

Licensing Executives Society



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LEGISLATIVE INITIATIVES

PROSECUTION:

- First Inventor To File (§ 3)
- Best Mode (§ 15)
- Priority Examination (§ 25)
- Assignee Filing (§ 4)
- Third Party Submissions (§ 8)

- USPTO Changes
 - Fee Setting (§ 11)
 - Funding (§ 22)
 - Satellite Offices

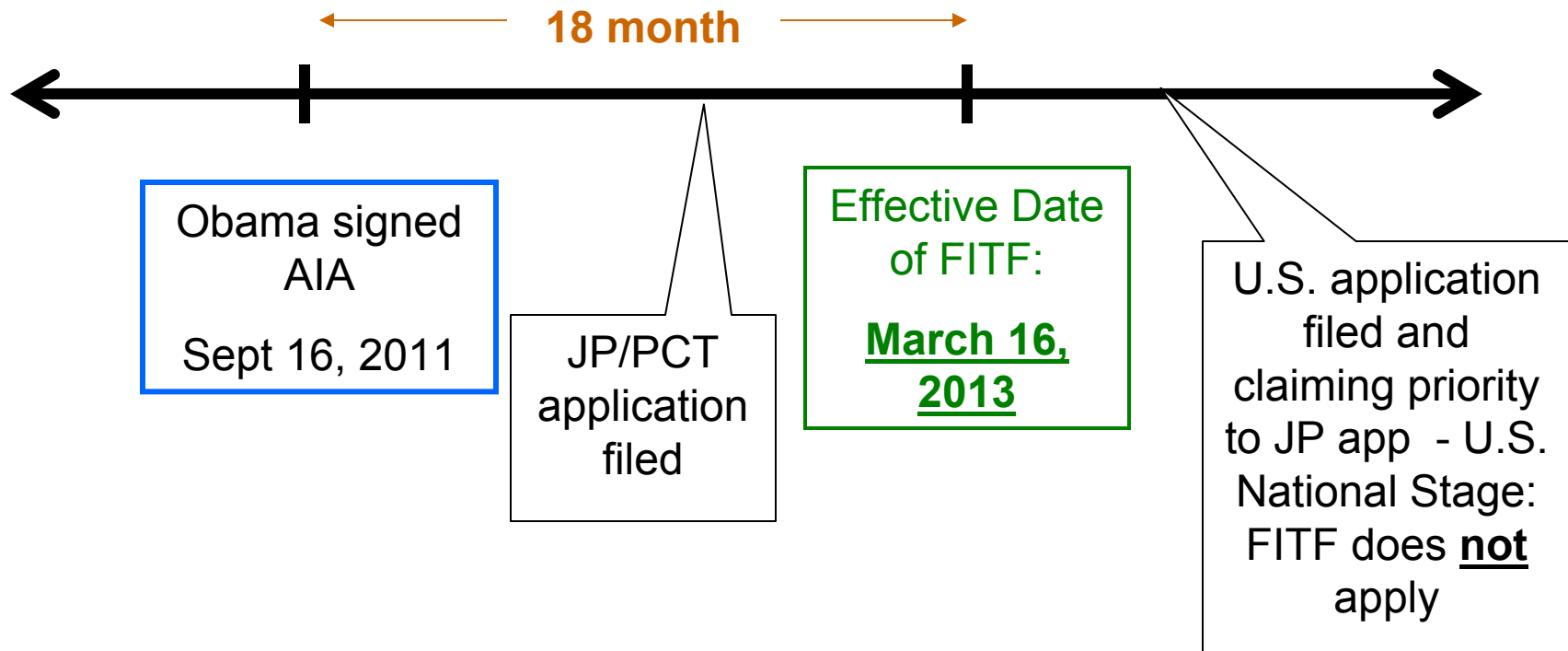
OTHER

INITIATIVES:

- Post-Grant Proceedings

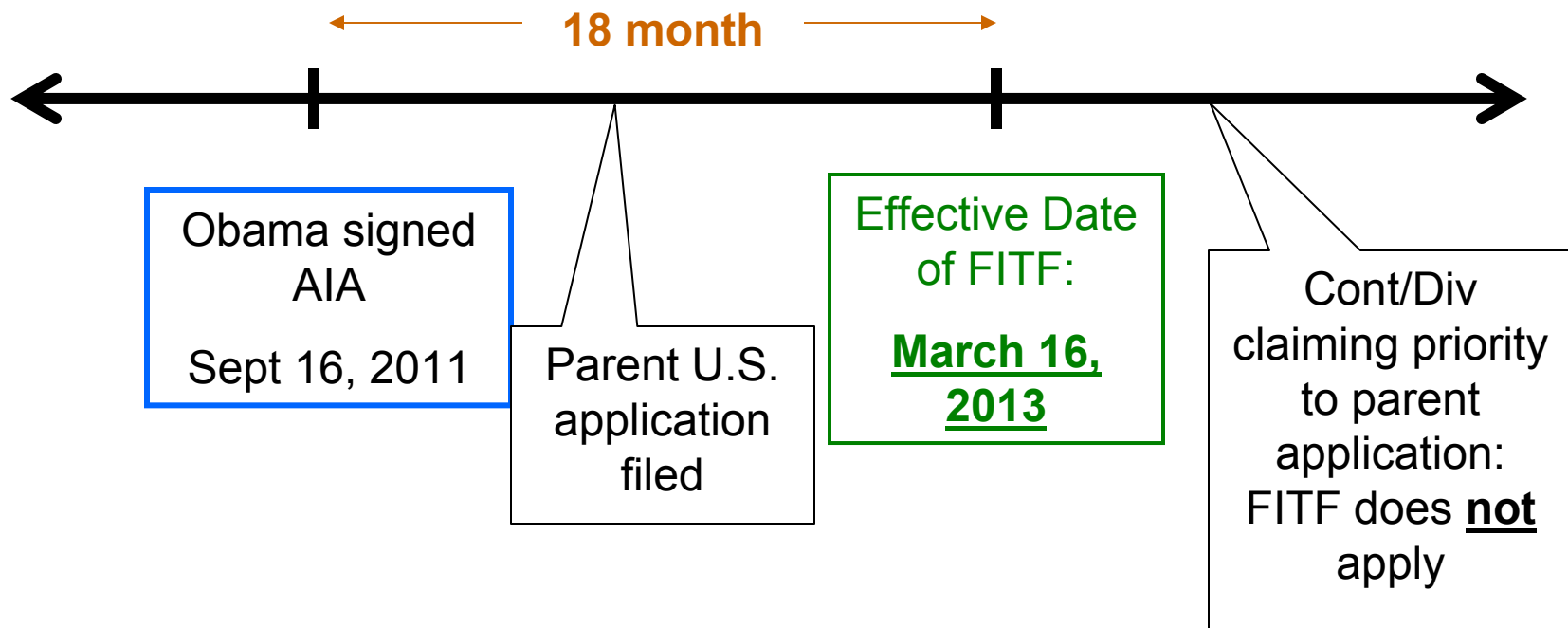
First Inventor To File: Effective Date

National Stage of Foreign/Patent Cooperation Treaty (PCT) Applications



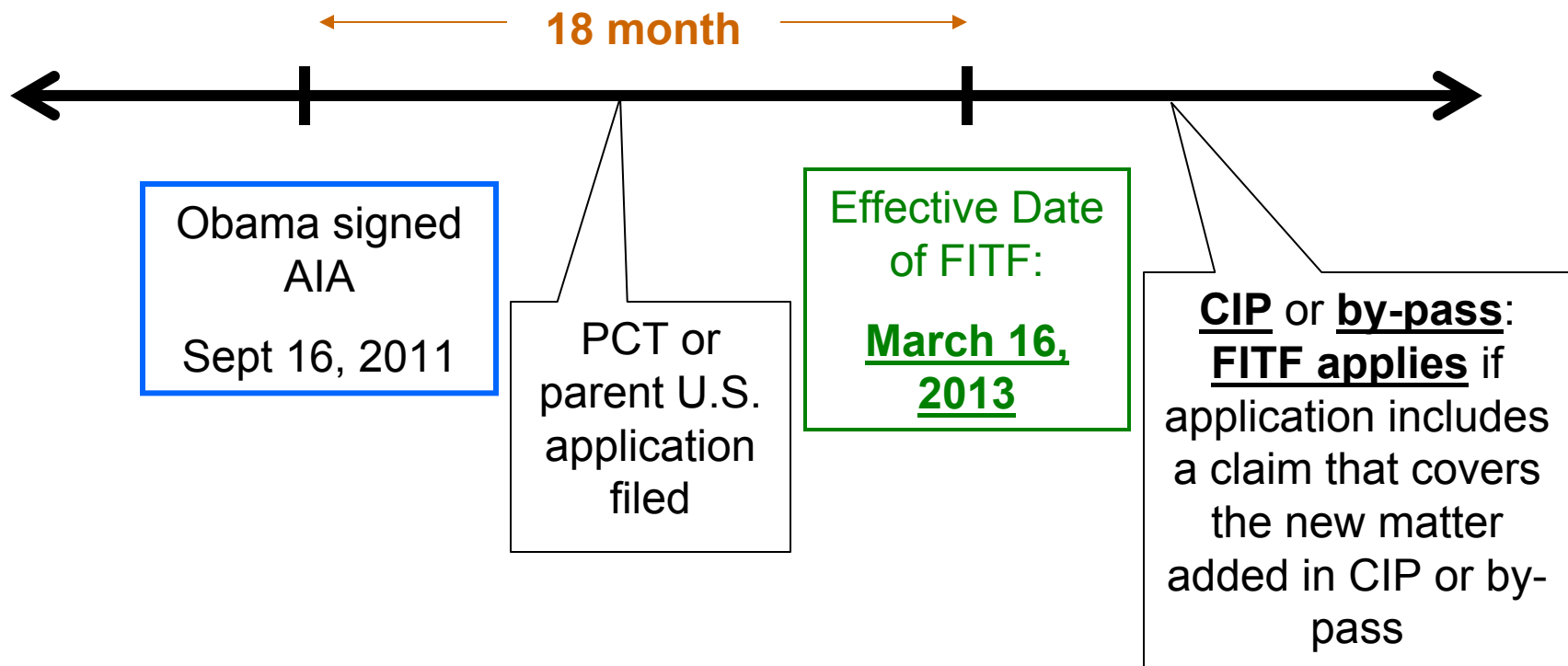
First Inventor To File: Effective Date

Continuation and Divisional Applications



First Inventor To File: Effective Date

Continuation-in-Part (CIP) or By-Pass



First Inventor To File

§ 102. Conditions for patentability; novelty

(a) NOVELTY; PRIOR ART.—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

First Inventor To File

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First Inventor To File

§ 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 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.

This provision only applies to **U.S.** patents
U.S. published applications, and published
PCT applications that designate the U.S.

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§ 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 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.

No language requirement: can file PCT in language other than English and create prior art under 102(a)(2).

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§ 102. Conditions for patentability; novelty

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U.S. patents, U.S. published applications, and published PCT applications designating the U.S. become prior art as of their earliest filing dates, including foreign priority.

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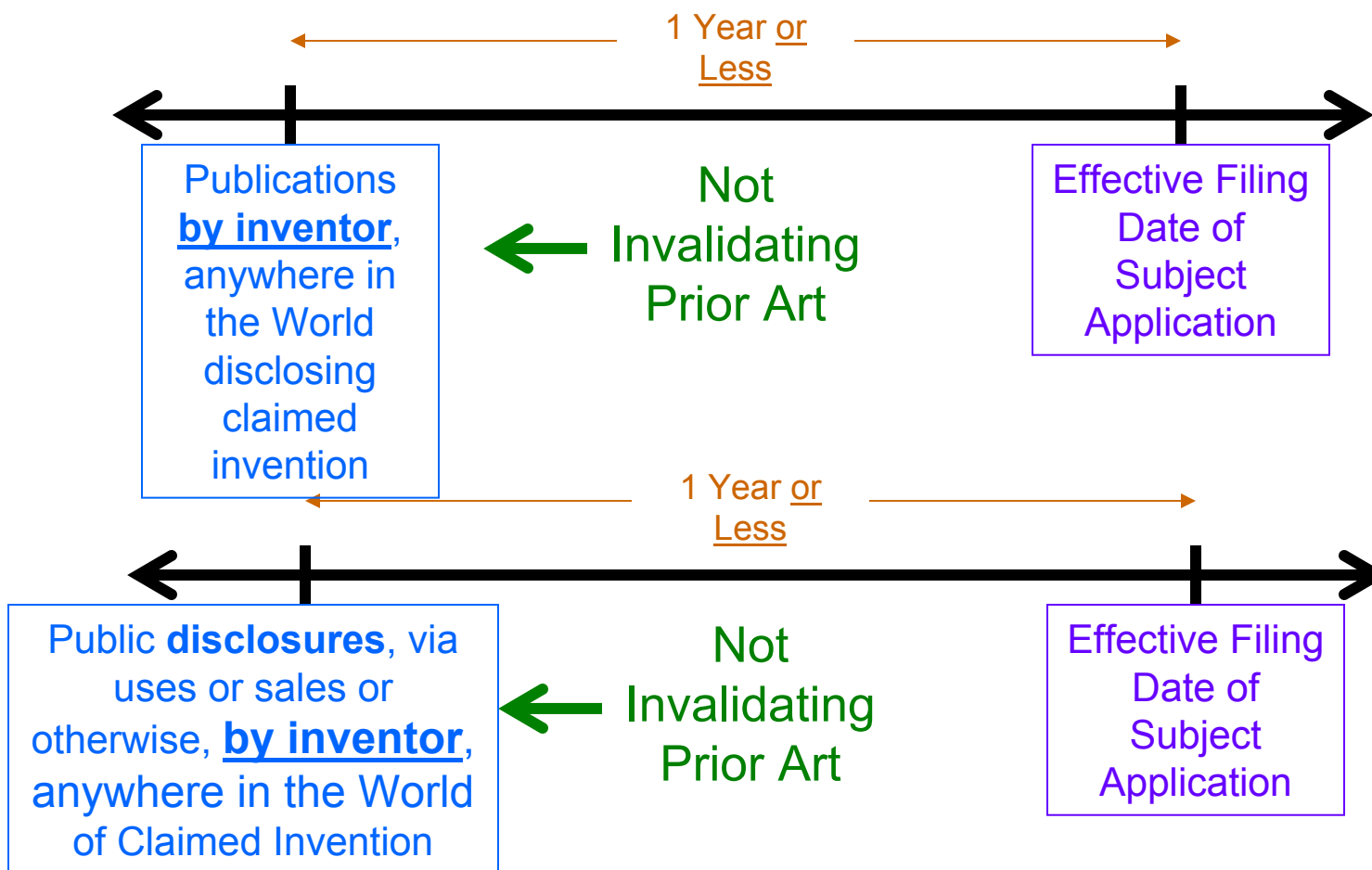
§ 102. Conditions for patentability; novelty (cont'd)

(b) EXCEPTIONS.—

- (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.

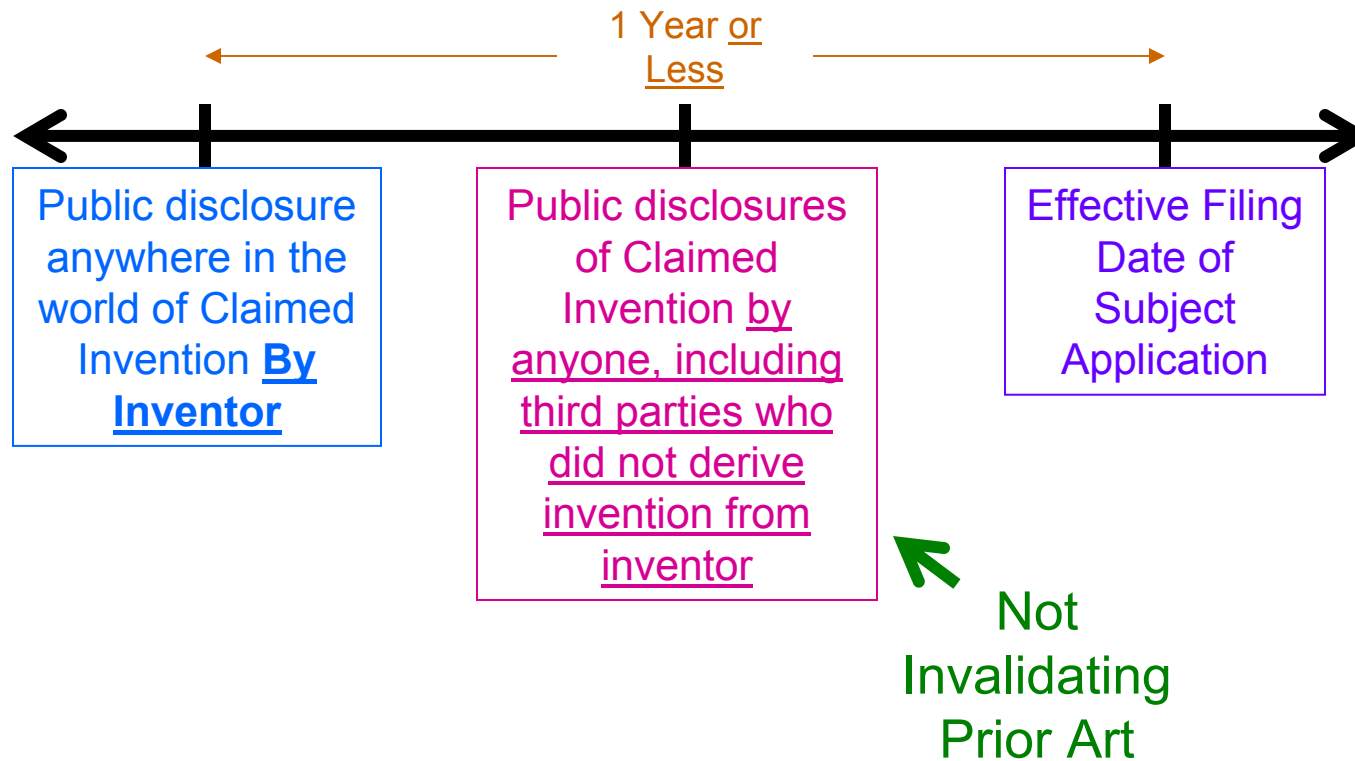
First Inventor To File

102(b)(1)(A): Personal grace period



First Inventor To File

102(b)(1)(B): First-to-Publish system



First Inventor To File

§ 102. Conditions for patentability; novelty (cont'd)

(b) EXCEPTIONS (cont'd).—

(2) DISCLOSURES APPEARING IN APPLICATIONS AND PATENTS.—A disclosure **shall not be prior art** to a claimed invention under **subsection (a)(2)** if—

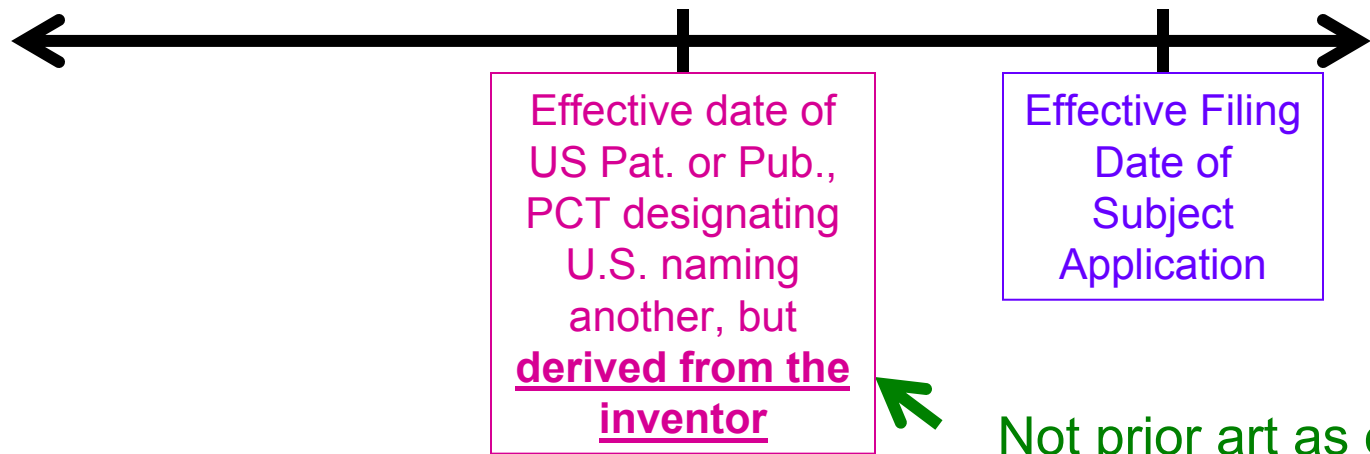
(A) the subject matter disclosed was **obtained** directly or indirectly **from the inventor** or a joint inventor;

(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** or subject to an obligation of assignment to the same person.

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102(b)(2)(A)



Effective date of
US Pat. or Pub.,
PCT designating
U.S. naming
another, but
derived from the
inventor

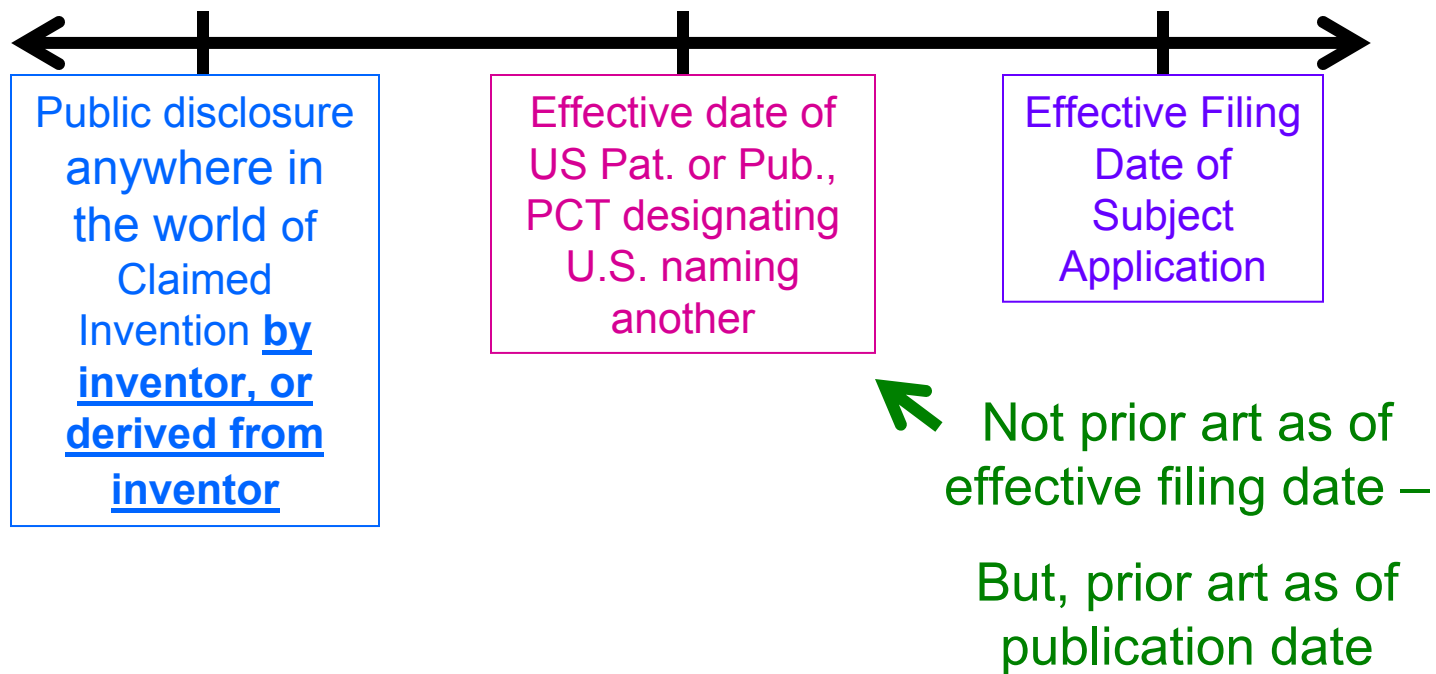
Effective Filing
Date of
Subject
Application

Not prior art as of
effective filing date –

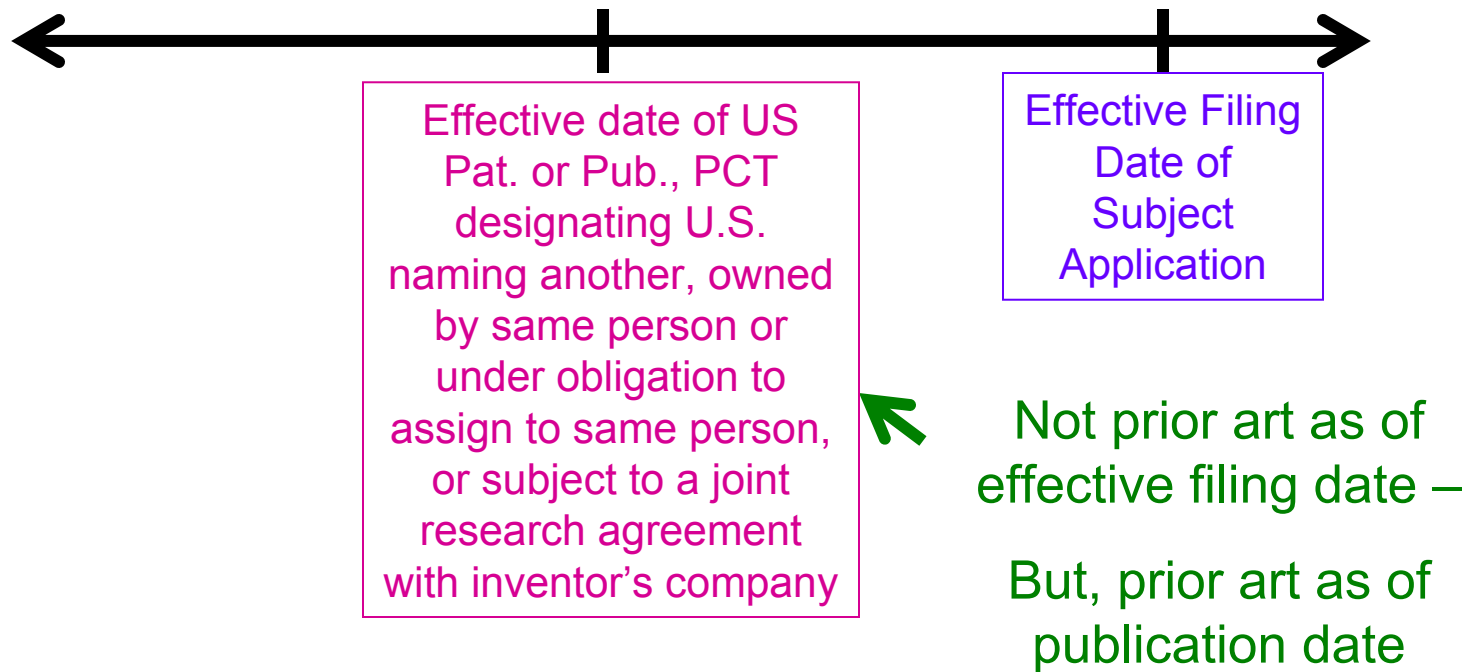
But, prior art as of
publication date

First Inventor To File

102(b)(2)(B)



First Inventor To File 102(b)(2)(C)



FTI vs. FITF vs. FTF

FTI: patent to A

A invents
+ ARP

A files

FITF: patent to B

< 1 year

B invents
(independently)

B publicly
discloses

B files

FTF: patent to nobody

BEST MODE

CURRENT LAW:

- The specification shall ... set forth the best mode contemplated by the inventor of carrying out his invention
- Basis for invalidity and unenforceability

REFORMED LAW:

➤ LITIGATION:

- The failure to disclose the best mode shall not be a basis on which any claim of a patent may be canceled or held invalid or otherwise unenforceable;

➤ PROSECUTION:

- 35 U.S.C. §§ 119(e)(1) and 120 are amended to exclude best mode as a requirement in order to be entitled to domestic priority under 120 or priority to provisional application under § 119(e)(1)

➤ EFFECTIVE DATE:

- Date of enactment and proceedings commenced thereafter

PRIORITY EXAMINATION

IMPORTANT

TECHNOLOGIES:

- Eligibility: Director can prioritize examination for applications for technologies that “are important to the national economy or national competitiveness”
- Fee: Free
- Effective Date: 9/26/12

TRACK I:

- Fee: \$4800 for prioritized examination for regular utility or plant patent applications
- Claims: Not more than 4 independent or 30 total claims
- Limit: No more than 10,000 applications until regulations are established
- No Accelerated Examination Search Document required
- Disposition: Goal is within 1 year
- Effective Date: 9/26/11

ASSIGNEE FILING

CURRENT LAW:

- An oath and/or declaration must be filed by an inventor
- An inventor must be the one applying for a patent unless the inventor refuses, is deceased, or cannot be located
 - Requires additional evidence

REFORMED LAW:

- Application: A person with an ownership interest can make an application for patent on behalf of the inventor
 - **Must still file an oath/declaration** for a notice of allowance to be issued
- Combined Submission: The declaration can be included in the document assigning rights over
- Effective Date:
 - One year after enactment (not retroactive)

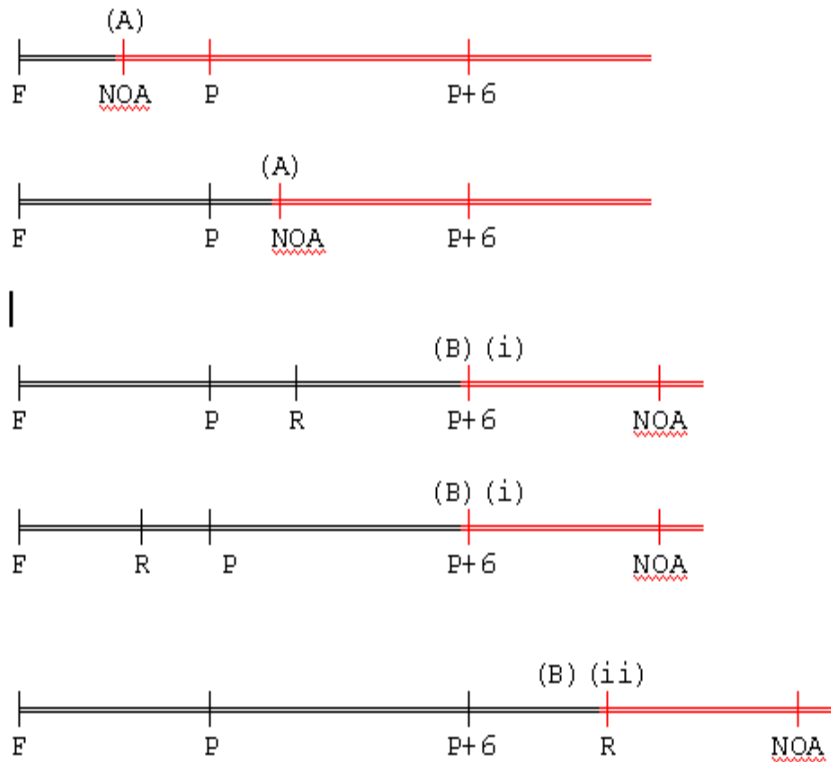
THIRD PARTY SUBMISSIONS

REFORMED LAW:

- PRIOR ART: Patents, published applications, or **other printed publications that might be relevant**
- TIMING: **Before** the earlier of
 - (A) the USPTO gives **notice of allowance**; or
 - (B) the **later** of
 - (i) **6 months after** the application is first published
 - (ii) **the date of the first rejection** of the application
- SUBMISSION: Short description of the supposed issues that each document raises
- EFFECTIVE DATE: One year from enactment
 - Retroactively applied

THIRD PARTY SUBMISSIONS

For example:



Black = timely
Red = Too late
F = Filing
P = Publication
NOA = Notice of Allowance
R = Rejection
P + 6 = Publication + 6 months

FEE SETTING PROVISIONS

NEW LAW:

- Give the USPTO the authority to adjust patent statutory fees
- Defines Micro Entities and entitles them to 75% fee reductions
- Effective Date: 9/26/11

SATELLITE OFFICES:

- Provides for at least three or more satellite offices
- Effective Date:
 - Within three years of enactment subject to available funds



FEE SETTING

- A 15% Patent Fee Surcharge took place Sept. 26, 2011 on the following:

Filing Fees

- Utility
- Design
- Plant
- Provisional
- Reissue
- Basic National Fee for entering National Stage

Application Size Fees

Excess Claim Fees

- Independent claims in excess of 3
- Total claims in excess of 20

Multiple Dependent Claim Fees

Examination & Search Fees

- Utility
- Design
- Plant
- National State of International Application
- Reissue

Request for Continued Examination

Issue Fees

- Utility
- Design
- Plant
- Reissue

Disclaimer Fees

Appeal Fees

- Notice of Appeal
- Appeal Brief
- Request for Oral Hearing

Revival Fees

- Unintentionally abandoned application
- Unintentionally delayed issue fee payment
- Unintentionally delayed response in a reexam

Extension Fees

Maintenance Fees

- Grace period surcharge for maintenance fee

USPTO FUNDING

CURRENT LAW:

- Allows for Fee Diversion, where Congress can use patent fee revenue in the general budget and not for the USPTO

NEW LAW:

- Establishes a Reserve Fund for any patent fees that do not go to the USPTO
- Annual appropriations still required to approve USPTO spending
- Effective Date: October 1, 2011

ADDITIONAL PROVISIONS

- Derivation Proceedings (§ 3)
- Tax Strategy Patents (§ 14)
- Pro Bono Program (§ 32)
- Patenting Humans (§ 33)
- PTE – 60 Day Calculation (§ 37)

EFFECTIVE DATES

EFFECTIVE DATE	LEGISLATIVE INITIATIVE
18 Months	§ 3 - First Inventor to File
18 Months	Derivation Proceeding Establishment
12 Months	§ 4 - Inventor's Oath or Declaration
Date of Enactment	§ 5 - Defense to Infringement based on Prior Commercial Use
12 Months	§ 6 - Post-Grant Review Proceedings
12 Months	§ 7 - Patent Trial and Appeal Board
12 Months	§ 8 - Preissuance Submissions by Third Parties
Date of Enactment	§ 9 - Venue
Date of Enactment	§ 10 - Fee Setting Authority
60 Days	E-Filing Incentive (\$400 fee for failure to do so)
Date of Enactment	§ 11 - Fees for Patent Services
8/26/11	Track I Priority Examination
8/26/11	15% fee increase
12 months	§ 12 - Supplemental Examination
Date of Enactment	§ 13 - Funding Agreements
Date of Enactment	§ 14 - Tax Strategies Deemed Within the Prior Art
Date of Enactment	§ 15 - Best Mode Requirement
Date of Enactment	§ 16 - Marking
12 Months	§ 17 - Advice of Counsel

EFFECTIVE DATES

EFFECTIVE DATE	LEGISLATIVE INITIATIVE
12 Months	§ 18 - Transitional Program for Covered Business Method Patents
Date of Enactment	§ 19 - Jurisdiction and Procedural Matters
12 Months	§ 20 - Technical Amendments
12 Months	§ 21 - Travel Expenses and Payment of Administrative Judges
10/1/2011	§ 22 - Patent and Trademark Office Funding
36 Months	§ 23 - Satellite Offices
12 Months	§ 24 - Designation of Detroit Satellite Office
12 Months	§ 25 - Priority Examination for Important Technologies
48 months	§ 26 - Study on Implementation
9 Months	§ 27 - Study on Genetic Testing
12 Months	§ 28 - Patent Ombudsman Program for Small Business Concerns
6 Months	§ 29 - Establishment of Methods for Studying the Diversity of Applicants
Date of Enactment	§ 30 - Sense of Congress
3 Months	§ 31 - USPTO Study on International Patent Protections for Small Businesses
Date of Enactment	§ 32 - Pro Bono Program
Date of Enactment	§ 33 - Limitation on Issuance of Patents (applications pending at enactment) to exclude human organisms
12 Months	§ 34 - Study of Patent Litigation
12 Months	§ 37 - Calculation of 60-day Period for Application of Patent Term Adjustment

THANK YOU

Questions?



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