

# THE AMERICA INVENTS ACT

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# Overview

- Brief Review of Patents 101
- Leahy-Smith America Invents Act
- Law Prior to March 16, 2013 – First to Invent
- Law Post March 16, 2013 – First to File
  - ▣ Hypotheticals
  - ▣ Exceptions
- Questions

# Patents 101

- What is a Patent
  - ▣ A U.S. patent confers the right to exclude others from making, using, selling, or offering to sell, a patented invention in the U.S., or importing a patented invention into the U.S., during the patent term.
  - ▣ Does not confer right to make, use, sell, or offer to sell.
- Term
  - ▣ 20 Years from “priority date” (filing date of earliest non-provisional application).
- Requirements
  - ▣ Utility, Novelty, Non-Obviousness, Enablement, and Written Description.

# Leahy-Smith America Invents Act

- Enacted 112 Congress, September 16, 2011.
- The law represents the most significant change to the U.S. patent system since 1952.
- Switches the U.S. patent system from a "first-to-invent" to a "first-inventor-to-file" system, eliminates interference proceedings, and develops post-grant opposition.
- Expands the gamut of prior art (e.g., no geographic restriction).
- Attempts to bring U.S. patent law into better harmony with the patent law of other countries, most of which operate on the "first-inventor-to-file" system.

# The AIA Affects Virtually All Stages of the Patent Process



## Post-Grant Provisions at PTO

- Post-Grant Review
- *Inter Partes* Review
- Supplemental Examination

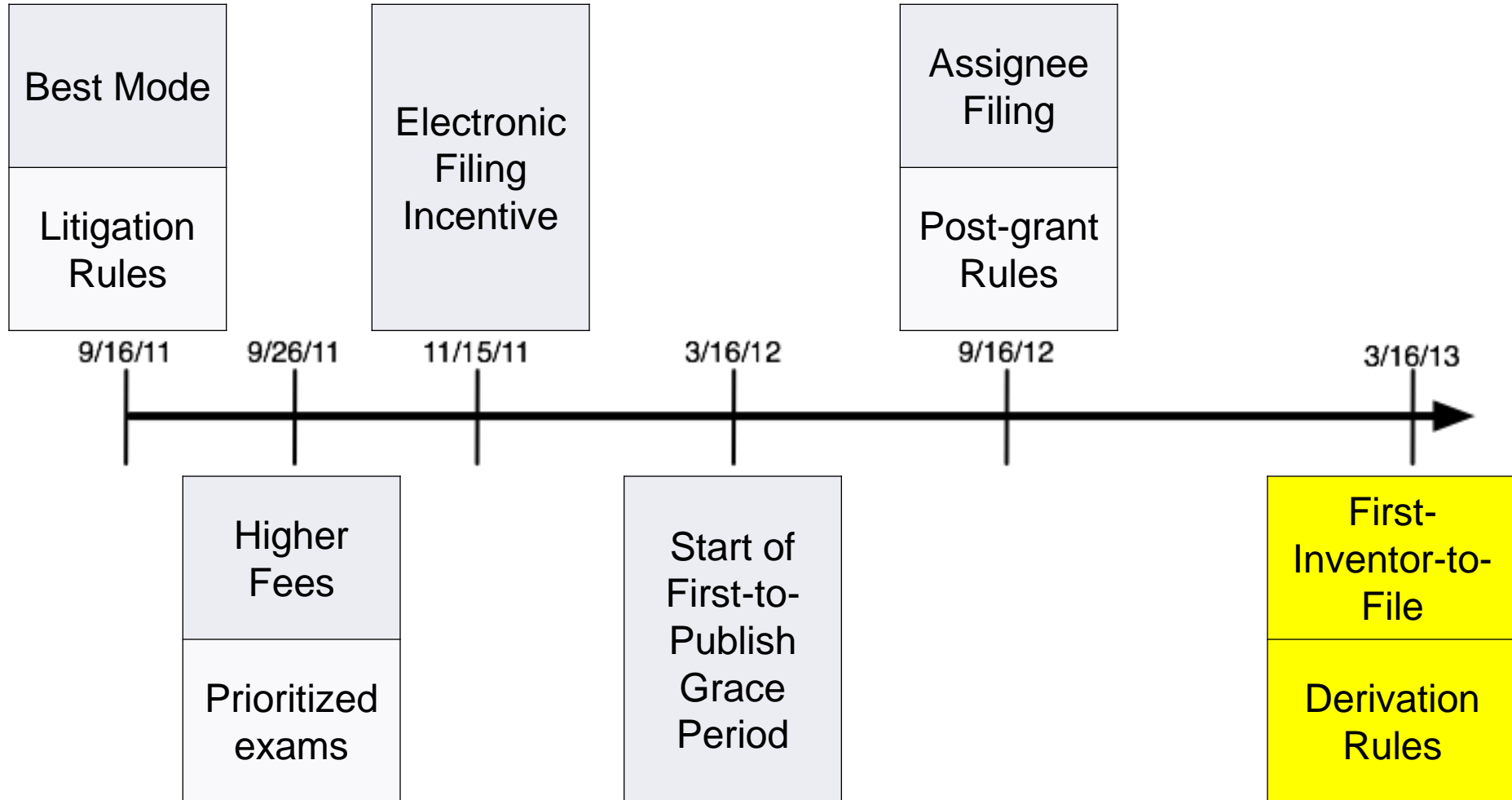
## Pre-Grant Provisions

- Fees and “micro entity” status
- First Inventor to File and New Prior Art Rules
- Third Party Submissions
- Prioritized Examination

## Litigation-Related Provisions

- Advice of Counsel
- Prior User Rights
- Best Mode
- Joinder
- Marking

# Implementation of AIA



# Law Prior to March 16, 2013

## □ First-to-Invent System

- Generally defined to comprise two steps: (1) conception of the invention and (2) reduction to practice of the invention.
  - When an inventor conceives of an invention and *diligently* reduces the invention to practice (by filing a patent application, by practicing the invention, etc.), the inventor's date of invention will be the date of conception.
  - Provided an inventor is diligent in actually reducing an application to practice, he or she will be the first inventor and the inventor entitled to a patent, even if another files a patent application, constructively reducing the invention to practice, before the inventor.
- However, the first applicant to file has the *prima facie* right to the grant of a patent.
- Should a second patent application be filed for the same invention, the second applicant can institute interference proceedings to determine who was the first inventor (as discussed in the preceding paragraph) and thereby who is entitled to the grant of a patent.

# Law Post March 16, 2013

## □ First-Inventor-to-File System

- The right to the grant of a patent for a given invention lies with the first person to file a patent application for protection of that invention, regardless of the date of actual invention.
- Date of conception of invention will no longer be taken into consideration.
- The proceedings at the U.S. Patent Office for resolving priority contests among near-simultaneous inventors who both file applications for the same invention ("interference proceedings") are repealed, because priority will be determined based on filing date.
- *Take-away*: time is referenced with respect to effective filing date, not date of invention.



# First-Inventor-to-File

March 16, 2013

## First to Invent

- Existing prior art rules
  - Swearing behind
- 200+ years of case law
- Interference practice

## First Inventor to File

- Simplified prior art rules, but scope of prior art expanded
- Derivation practice
- Subject to new post-grant challenges

# 35 U.S.C. § 102 - Novelty

## □ New Law

### ■ § 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.

## □ What does this mean?

# When can Party A receive a patent?

Party A



Party B





# Even if Party A invents first, A loses if B files before A (CHANGE)



**Party A**



**Party B**



# Exceptions – 1 Year Grace Period

- § 102(B)(1) Exceptions – 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.
  
- What does this mean?
  - One year grace period still applies to the inventor's own disclosure.
  - One year grace period extends **only** to “subject matter disclosed”.
  - Most other countries do **not** provide a one year grace period.

# Party A loses out if B publishes first (CHANGE)

Party A



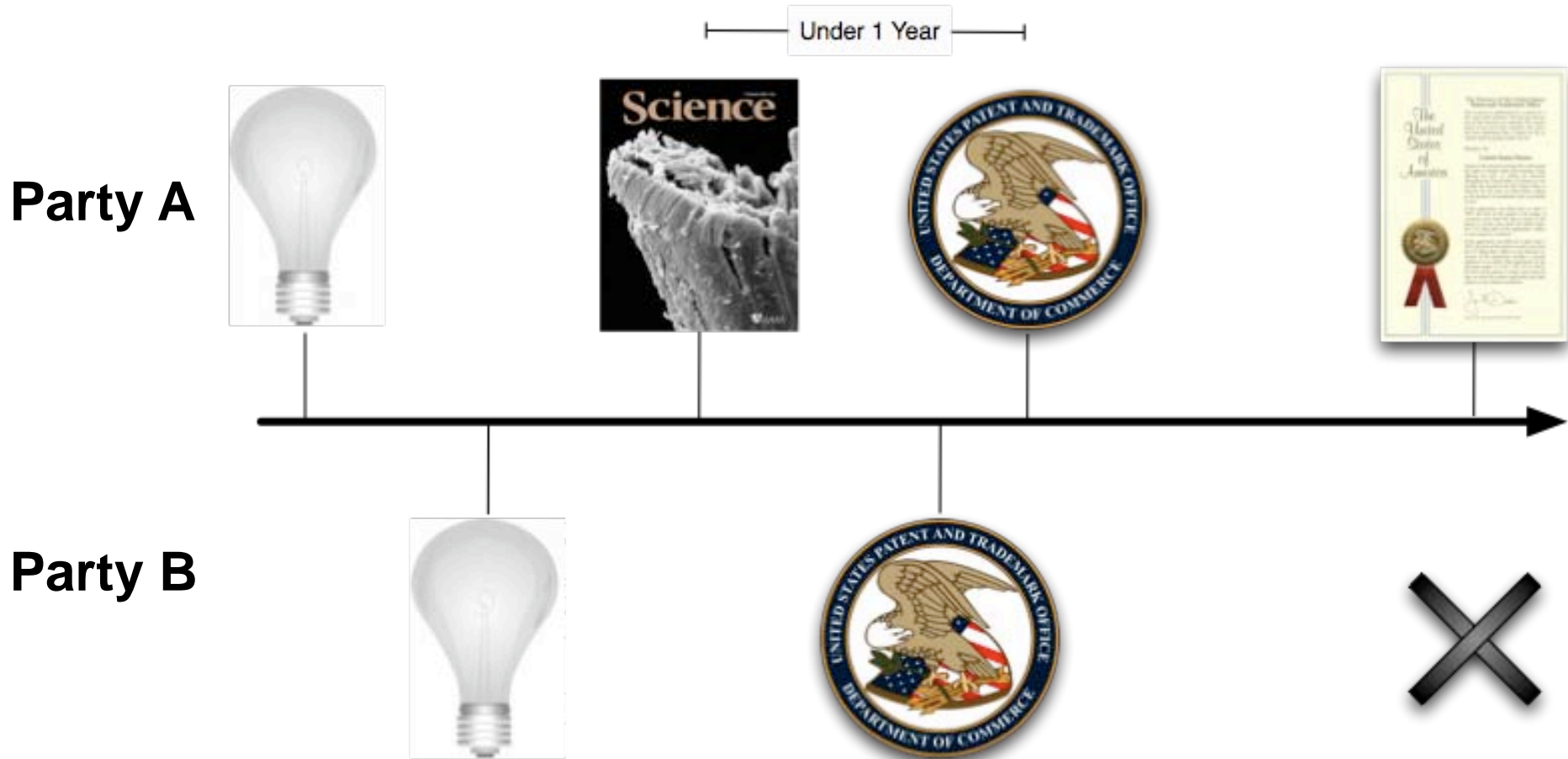
Party B



1 Year



# Party A wins if Party A publishes first



# Party A wins if Party A publishes first (SAME)

Party A

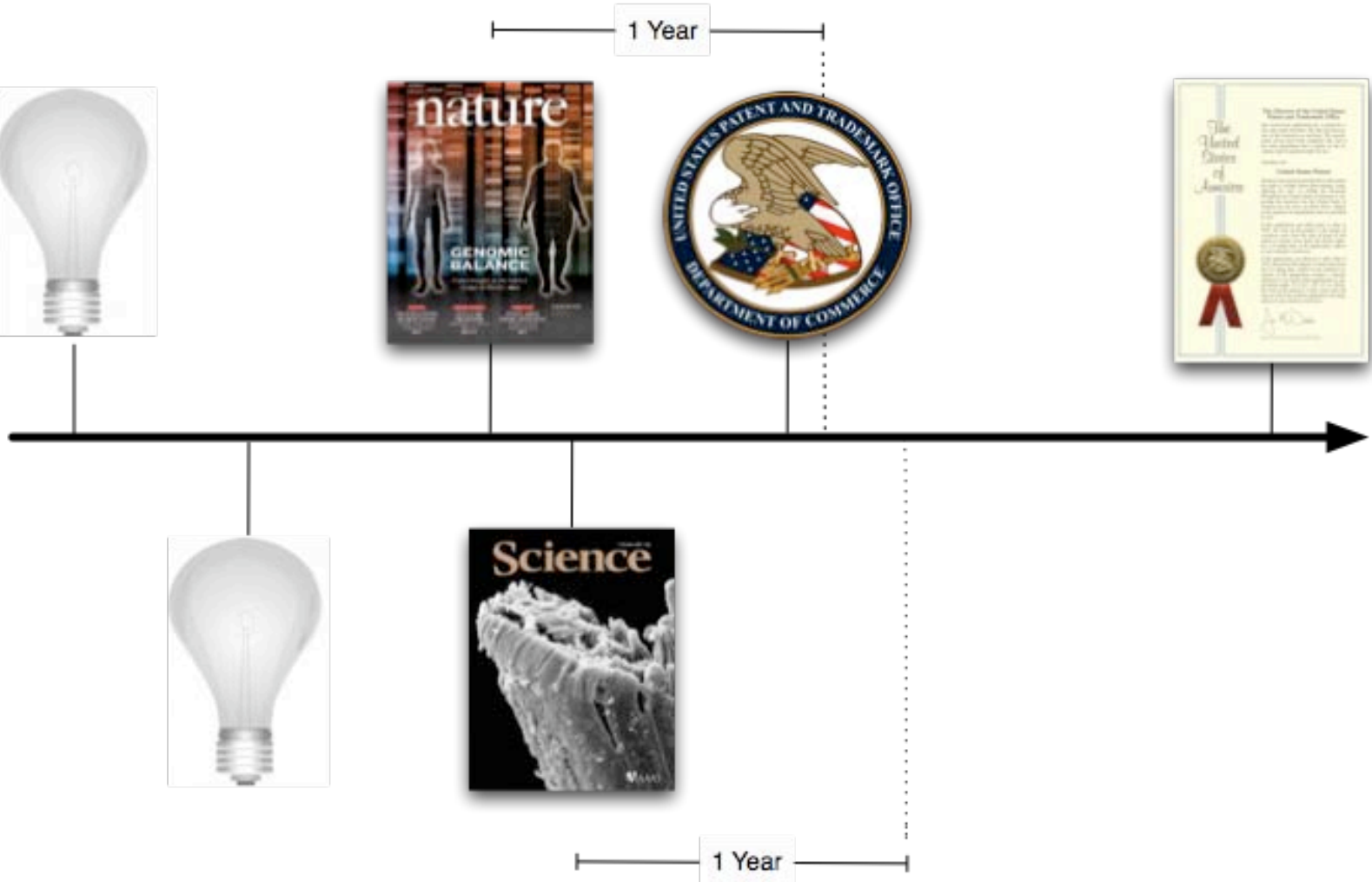


1 Year

Party B



1 Year





# Party A loses if Party B publishes first (CHANGE)

Party A



1 Year

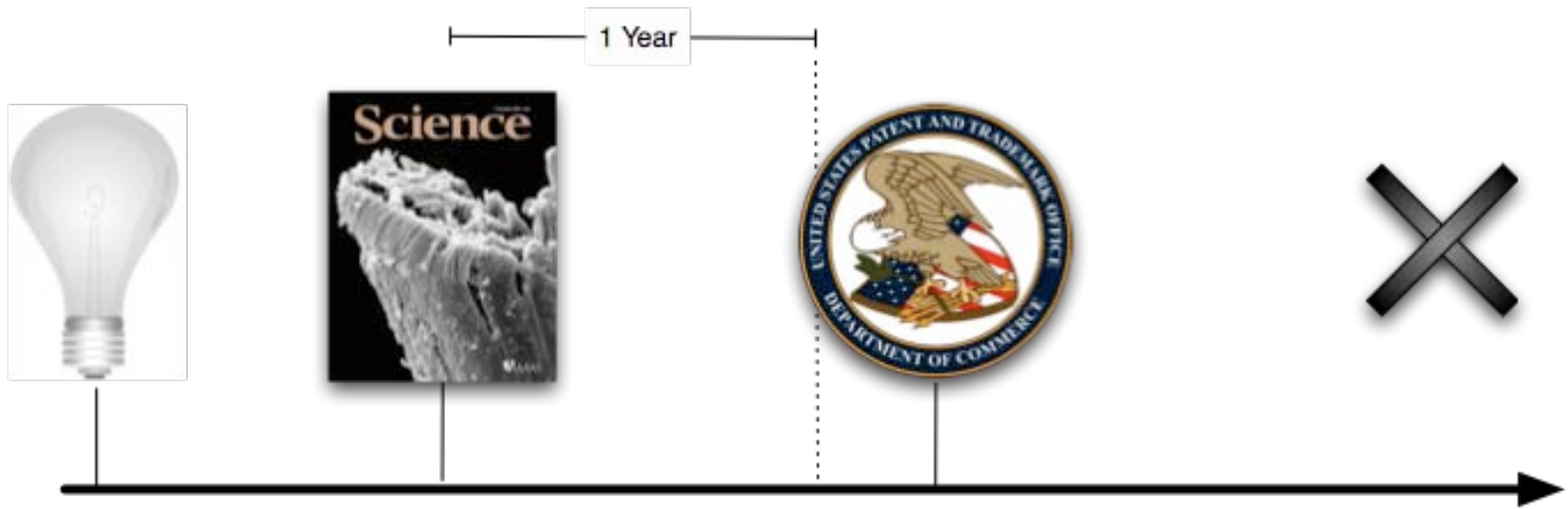
Party B



1 Year

# CAUTION: You Still Only Have 1 Year After Publication

Party A



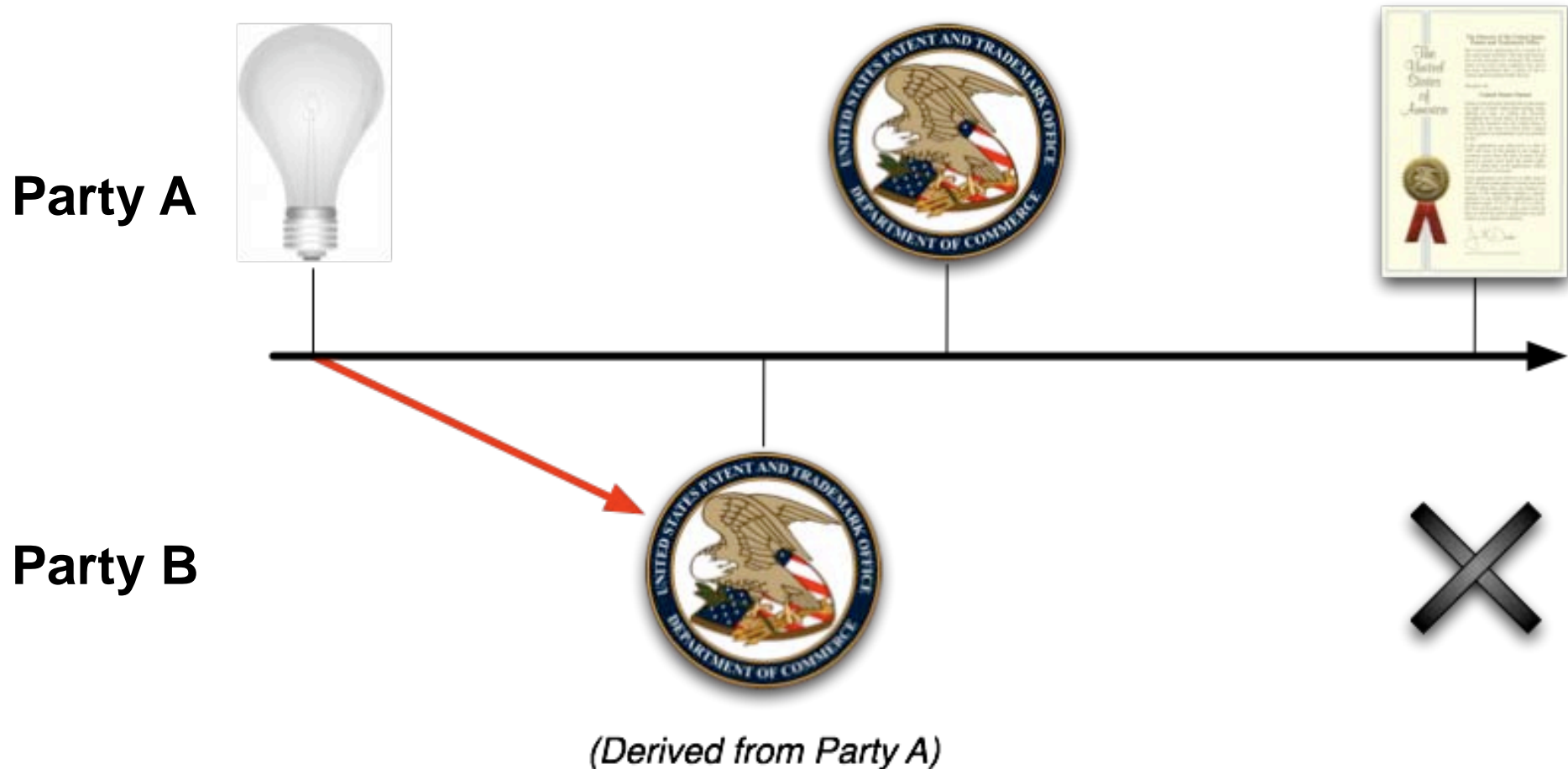
# What if B (Literally) Stole Your Idea



# Derivation Proceedings (35 U.S.C. § 291)

- Can be filed by a patent applicant against another applicant who derived the claimed invention from the petitioner without permission.
- Must be filed within 1 year of publication of the petitioner's claim (to the same or substantially the same invention as the earlier-filed, allegedly derived claim).
- Eliminates interference proceedings.

# Party A wins if B stole A's idea (derivation)



# What does all this mean?

## □ Summary

- As of March 16, 2013 we will be a First-Inventor-To-File System.
- Cannot “swear behind” a reference to establish an earlier date of invention.
- Have a 1-year grace period – but only sometimes.
  - If you take advantage of the 1-year grace period by publishing before filing, you may be giving up foreign rights.

# Practical Tips & Discussion

- Is there really any change?
  - OTL has always looked at the importance of foreign filing and has tried to file before publication and within a reasonable time after conception.
- Disclose early to OTL
  - Publication of article may be used in your favor, but allow OTL the opportunity to make that decision.
  - Give the OTL fair warning in advance of any planned publication dates.
  - While the US will have a 1 year grace period for your own publication – most foreign countries do not.
  - Continue to maintain detailed notebooks (e.g., for derivation proceedings)
- Questions?



# Thank you.

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