

Practice Tips and the AIA

Stanford University – February 2013

CRAWFORD MAUNU

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INTELLECTUAL PROPERTY LAW

Presented By Bob Crawford and Eric Curtin

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Overview

- *First Inventor To File – a big change*
- *Provisional Applications*
- *Sufficient Disclosure Trap*
- *Assignment & Oath/Declaration*

AIA – “First Inventor To File”

Overview

- Old system of first to invent is no longer
- Race to file first
- No one-year grace period as before
- Heightened importance to maintain confidentiality and file prior to publication
- Emphasis on first *inventor* to file



AIA – “First Inventor To File”

Publication and Disclosure

- ⦿ Your publication may not be *immediately* adverse but *your colleague’s related publication* may be adverse
- ⦿ What constitutes a “publication” under the AIA?
- ⦿ Concerns regarding international filings remain
- ⦿ Important: File applications early, and expect that others will piggy-back on your work

AIA – *Pre-filing concerns:*

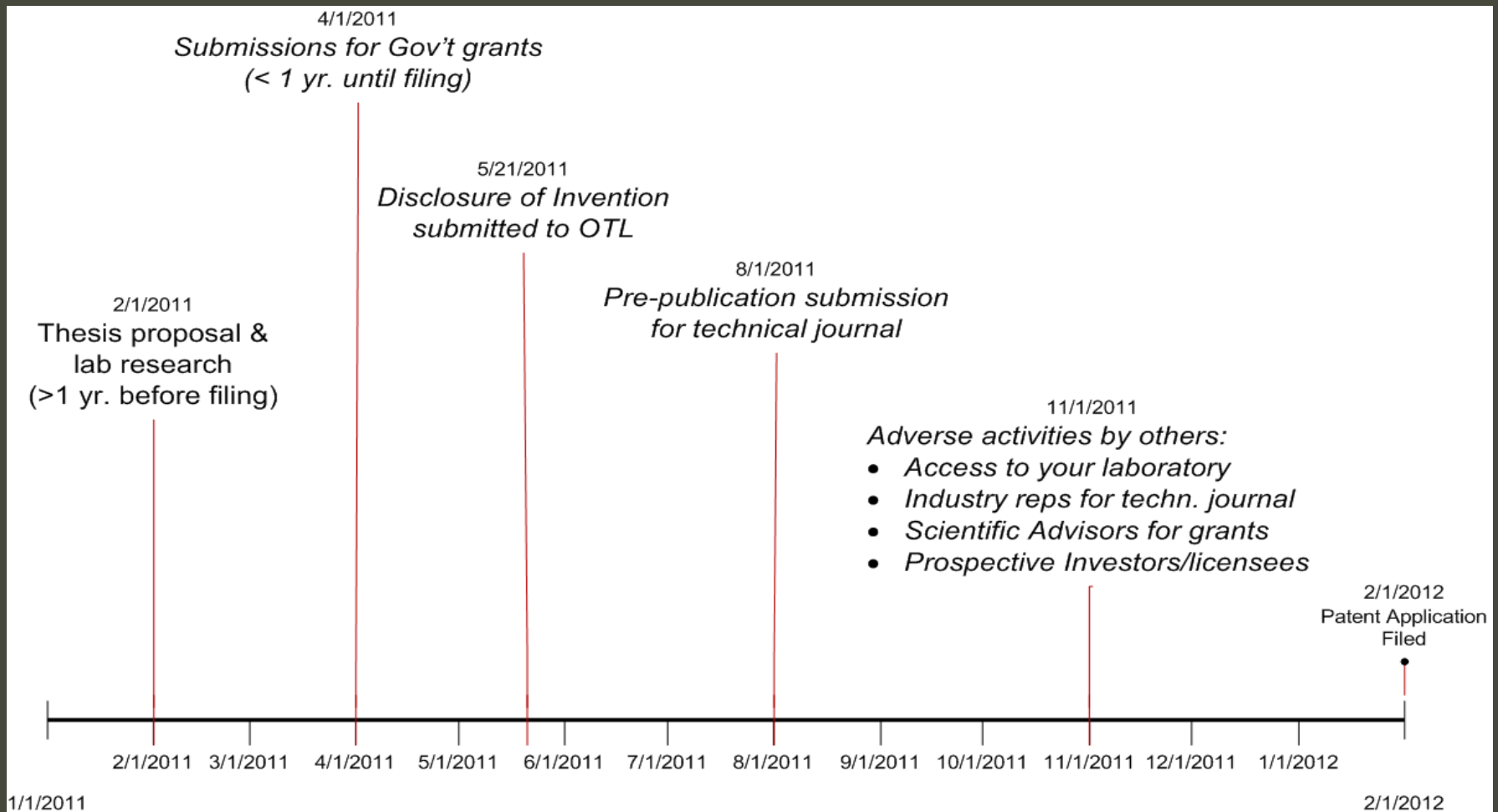
- ⦿ Disclosures that are not confirmed as being “confidential”
- ⦿ Miscellaneous reviews by others (*e.g.*, peers, pre-publication, lab visits, investors)
- ⦿ Laboratory: restrict access to confidential information
- ⦿ Outside discussion – classroom, colleagues
- ⦿ Non-confidential presentations and pre-publication submissions
- ⦿ Grant submissions in light of peer review and FOI Act
- ⦿ Miscellaneous commercialization efforts

AIA – Disclose with Caution:

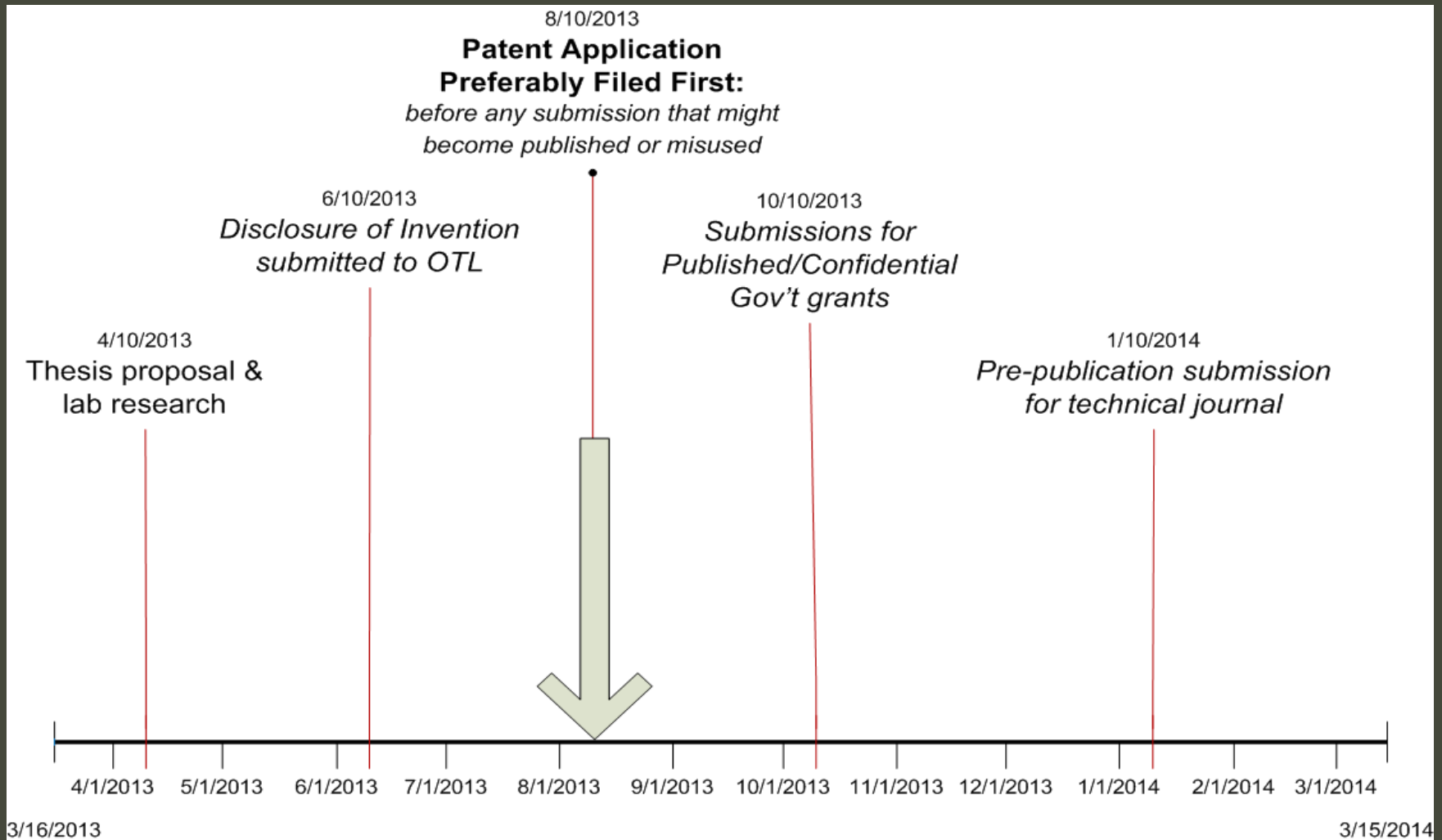
Disclosure of IP before filing can affect patent rights ... even if confidential

- *Publication by you* ... in conferences, meeting posters, website postings, cataloged theses, submissions to journals, confidential grant submissions that become published or misused
- *Publication or filing by another* ...
 - of the same/similar IP stemming from one of the above activities could create problematic prior art
 - problematic prior art could also be created by a scientist's peer review of a grant/pre-publication submission followed by an innocent sharing of your breakthrough proposal, leading to such activities before you file
- Such activities have often occurred but with loss of IP lessened by the pre-AIA laws
- Learn the funding institution's public-access policies **before** seeking a research grant as some include conflict provisions and restrictions to lessen risk of misuse/public access
See, e.g., www.nih.gov/icd/od/foia/grants.htm
- COGR's report (for research universities) presents concerns with the AIA (www.cogr.edu):
 - Need for more monitoring of faculty invention disclosures and filing more provisional patent applications to prevent misuse/stealing of IP
 - Partial success in Congress to pass a problematic Act (HR 3433 GRANT Act) that would cause the posting of grant applications on a public website

Pre-AIA Example Timeline (with existing Foreign Laws)



Post-AIA Example Timeline



Must we file on all research?

- ◉ What indicates that a patent application should be filed?
 - Good disclosures show *enablement* by technical details, impressive lab results and/or theories supported by publications of others
 - Patentability is shown by novelty, others' related efforts/needs, discovery of unrecognized problems and unexpected results

The Subject Matter Invented

- ◉ Be specific in identifying discoveries (problems/solutions) and unexpected results
- ◉ Does the prior art teach away from your invention?
- ◉ If the device is prior art, consider a snapshot of the device in special use and/or during manufacture
- ◉ Real-life implementations and applications
- ◉ Alternatives
- ◉ Step back from narrow focus to describe and show possession of broader claims
- ◉ Fall-back positions/detailed embodiments
- ◉ Separate claims or discussion with preamble/body directed to licensable applications

When should I submit a Web Disclosure to OTL?

- ◎ Confidentially memorialize your documentation early:
 - Attach the research proposal and early lab-work documentation
 - Email attachments help to memorialize your invention
- ◎ Contact OTL with your concerns regarding IP protection and/or its derivation by others and consider, “What if my colleague ...?”

AIA – *Derivation Considerations*

- ◉ Where two applicants file within one year, one may claim the other derived the invention from the other
- ◉ Independent creation is a defense
- ◉ Highlighted importance of evidence (*e.g.*, log books, records of experimentation)
- ◉ Consider AIA issues with lab visits, ongoing inventor work after leaving Stanford, unintentional derivation
- ◉ Proving derivation may be difficult and expensive

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Economics & Provisionals

- ⦿ USPTO filing and prosecution costs are significantly higher
- ⦿ Provisional applications can be helpful to secure a filing date
- ⦿ Disclosure must be completely supportive of claims
- ⦿ Risk of incomplete disclosure may sacrifice rights to intervening filer
- ⦿ Continued importance of confidentiality until non-provisional is filed
- ⦿ Further developments prior to non-provisional filing may be subject to intervening rights

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Disclosure Trap (§112)



- ◉ Consider filing before March 16, 2013 to avoid AIA **but** know that insufficient written disclosures may trigger application of AIA.
- ◉ Example : “Cover sheet” provisional is filed in 2012. Ensuing non-provisional application filed after March 16, 2013 may trigger AIA
- ◉ Expect fewer continuation-in-part applications and more carefully-filed continuation-type applications

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Assignment & Oath/Declaration

- ◉ Evidence of assignment or obligation to assign patent rights facilitates the use of a substitute statement in lieu of an inventor's Declaration
- ◉ Less burdensome for inventors
- ◉ Less administrative burden
- ◉ Facilitates rush filings without worry of obtaining signatures



Assignment & Oath/Declaration

- ⦿ Highlights importance of securing early
- ⦿ Particularly relevant for inventors that may move on
- ⦿ Inventors should review and understand the contents of the application and claims, and be aware of the duty to disclose material information
- ⦿ Delayed filing of a Declaration in national stage applications can negatively affect patent term adjustment, emphasizing usefulness of obtaining Assignment early

Message from the OTL

- ◎ Submit your invention disclosures as soon as you have enough data to support a filing
- ◎ The OTL will not consider filing a patent application if the invention has been publically disclosed

Thank You!

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