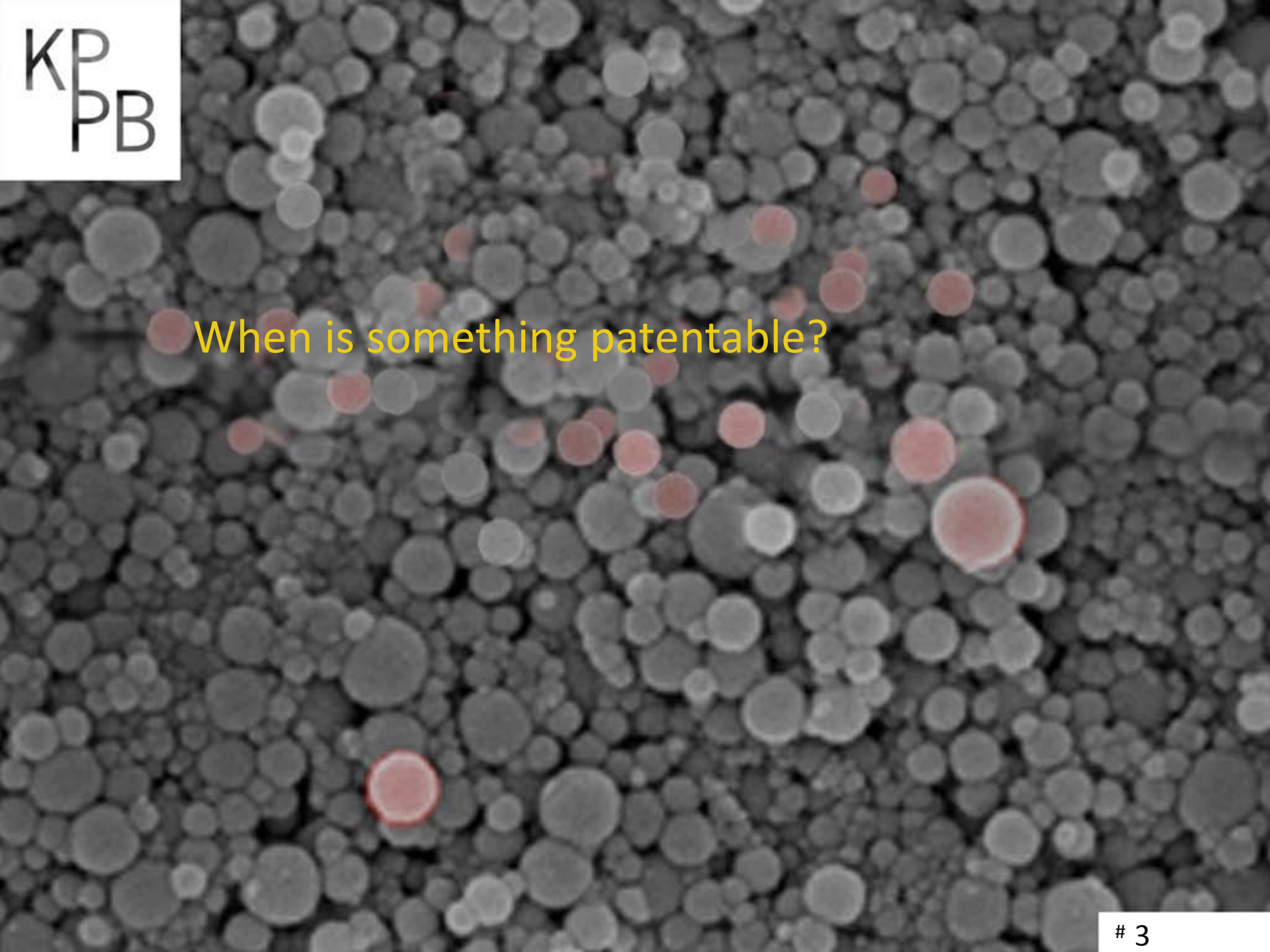
America Invents Act +

What does it mean for you?

Outline

- When is something patentable?
  - Under “first-to-invent”
  - Under “first-to-file”
- What do the changes mean for you?
- What do you need to (if anything) before March 16, 2013?
- How should you approach IP protection following March 16, 2013?


When is something patentable?

Statutory requirements for patentability

- Patentability requires:
  - Patent-eligible subject matter (35 U.S.C. § 101):

    "Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor."
  - Novelty (35 U.S.C. § 102): The invention cannot have previously been described or otherwise disclosed in the prior art.
  - Nonobvious (35 U.S.C. § 103):

    "A patent may not be obtained though the invention is not identically disclosed or described … [in the prior art art], if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains."
- Patentability hinges on the definition of "the prior art". On March 16, 2013, that definition will change.

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An overview of “first-to-invent”

- The current U.S. Patent System is a “first-to-invent” system.
- The definition of prior art seeks to grant patent rights to the first person or group of people that conceive of the invention.
- Prior art is defined relative to the date of invention instead of filing date of patent.
- No patent applications filed after your invention date can be considered.
- If the date of invention is more than a year earlier than your filing date, then some publications and products that are after your date of invention may be considered – but nothing less than a year prior to your filing date.

Benefits of “first-to-invent”

- Benefits of “first-to-invent”:
  - Less time pressure: Race to patent office is less important;
  - Deferred cost: Patent filing costs can be deferred while working in “stealth mode”; and
  - Less waste: Inventors can wait until a system is mature/less speculative before filing.
- Biggest concern is public disclosure.
  - Stanford typically addresses by filing a provisional application immediately prior to disclosure.

An overview of “first-to-file”

- On March 16, 2013, the U.S. Patent System will change from “first-to-invent” to “first-to-file”.
- Definition of prior art will change so that prior art will be defined relative to the filing date of the patent and not the date of invention:

  > “A person shall be entitled to a patent unless … 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.”

- Limited exceptions.
  - When inventor(s) publicly disclose an invention and a patent application is filed within one year of the public disclosure, then the inventor(s) own public disclosure will not be considered prior art.
  - In addition, actions by third parties that occur between the inventor(s) disclosure and the filing date will not be considered prior art.
  - A publication effectively becomes like a provisional filing in that you have one year from the publication to file a full patent application.
  - Note that by publishing before filing all international patent rights are lost.

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Benefits of “First-to-File”

- Simplifies examination and litigation.
- Brings the United States into alignment with international patent systems (furthering patent harmonization).
- In short, there is nothing in it for you.

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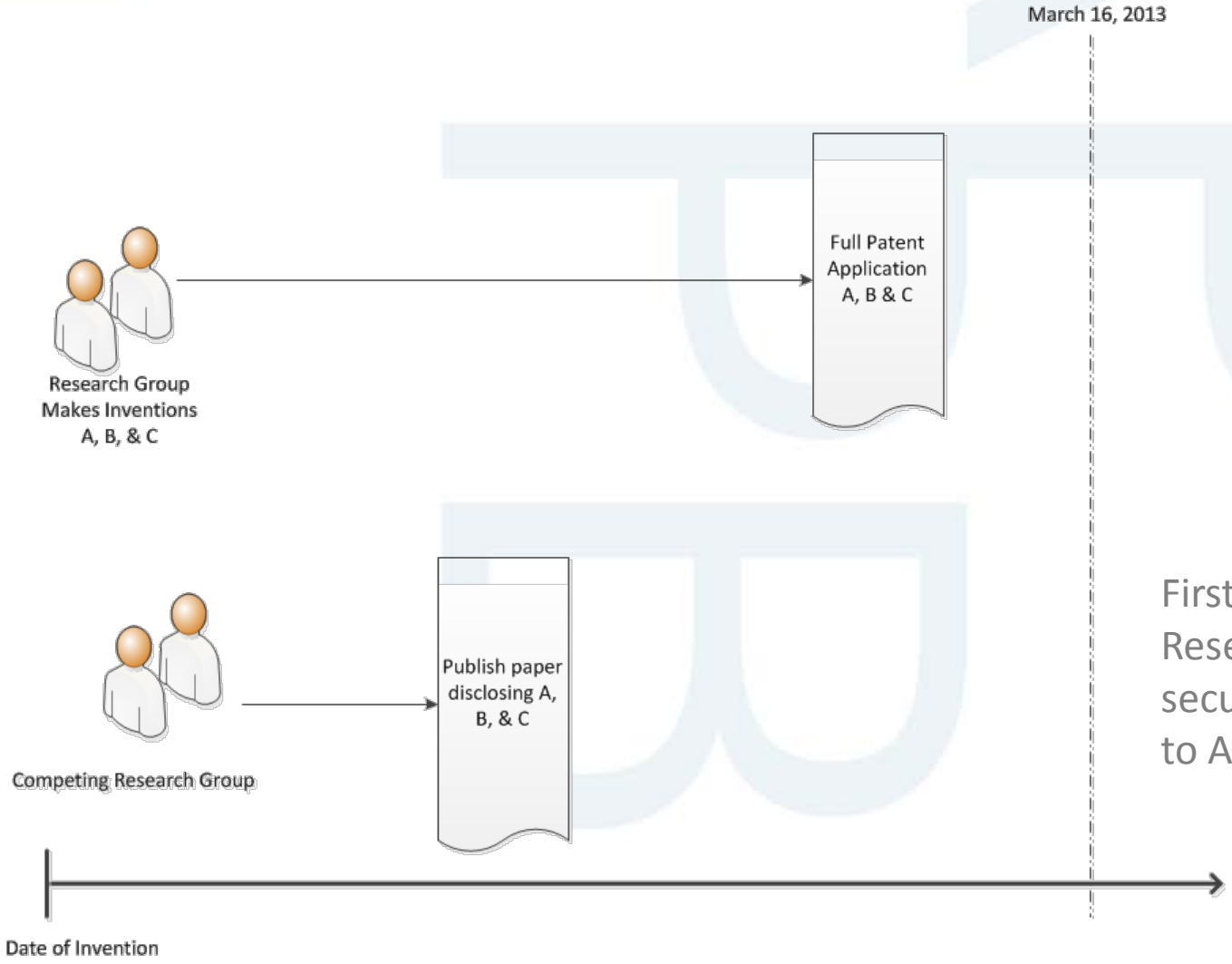
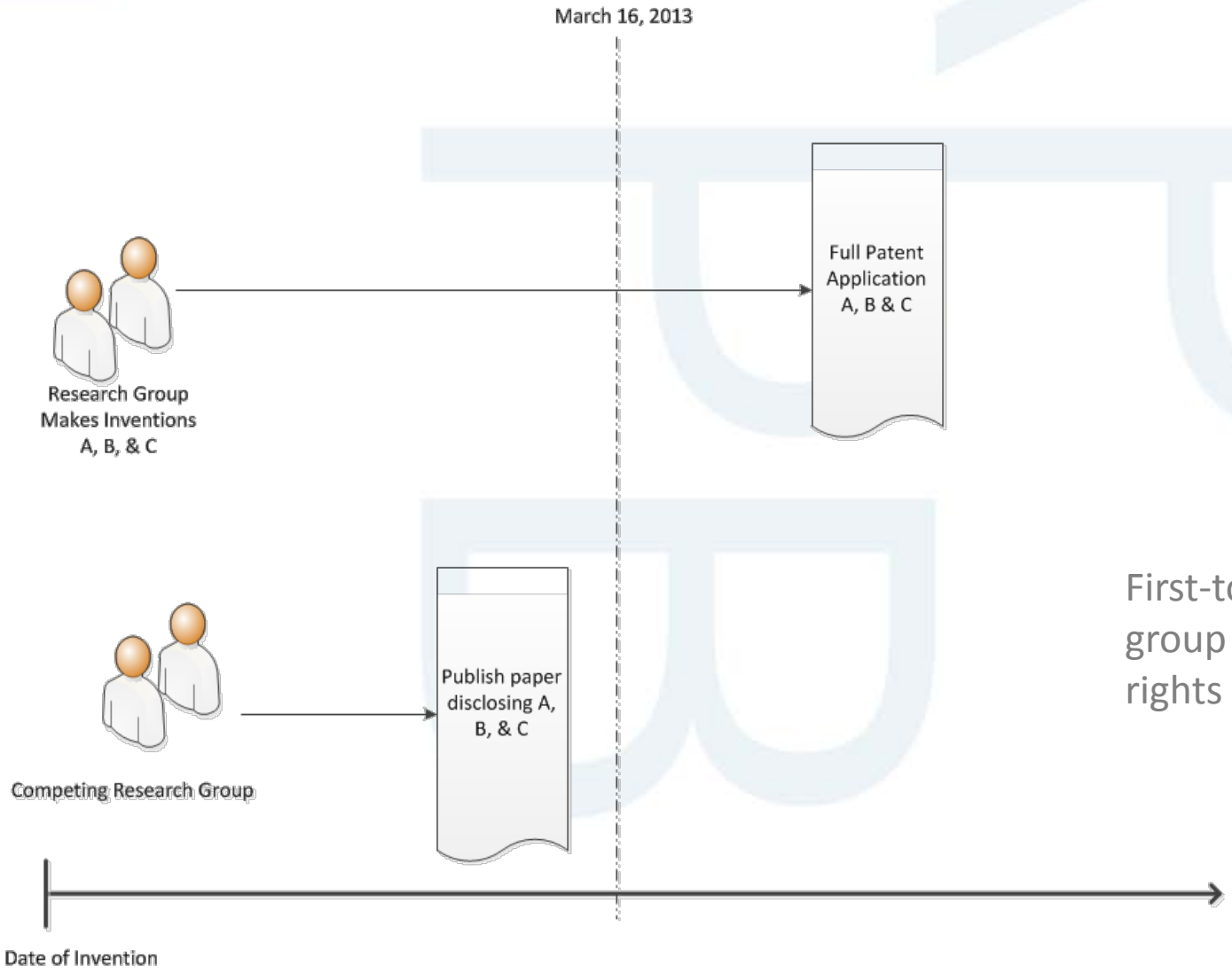
Are these changes relevant to me?

What does this really mean?



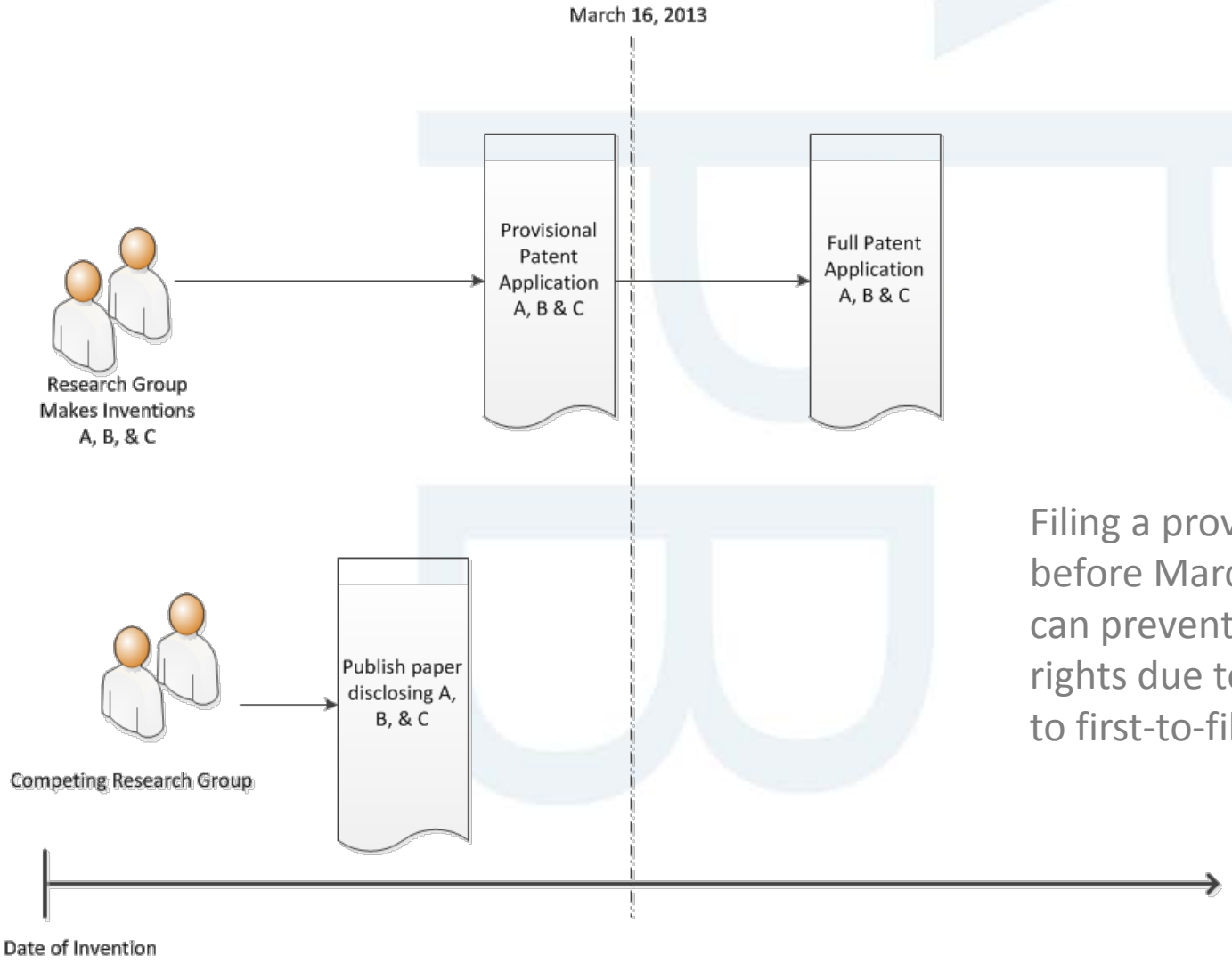
First-to-Invent: Research group secures patent rights to A, B & C.

What does this really mean? (cont.)



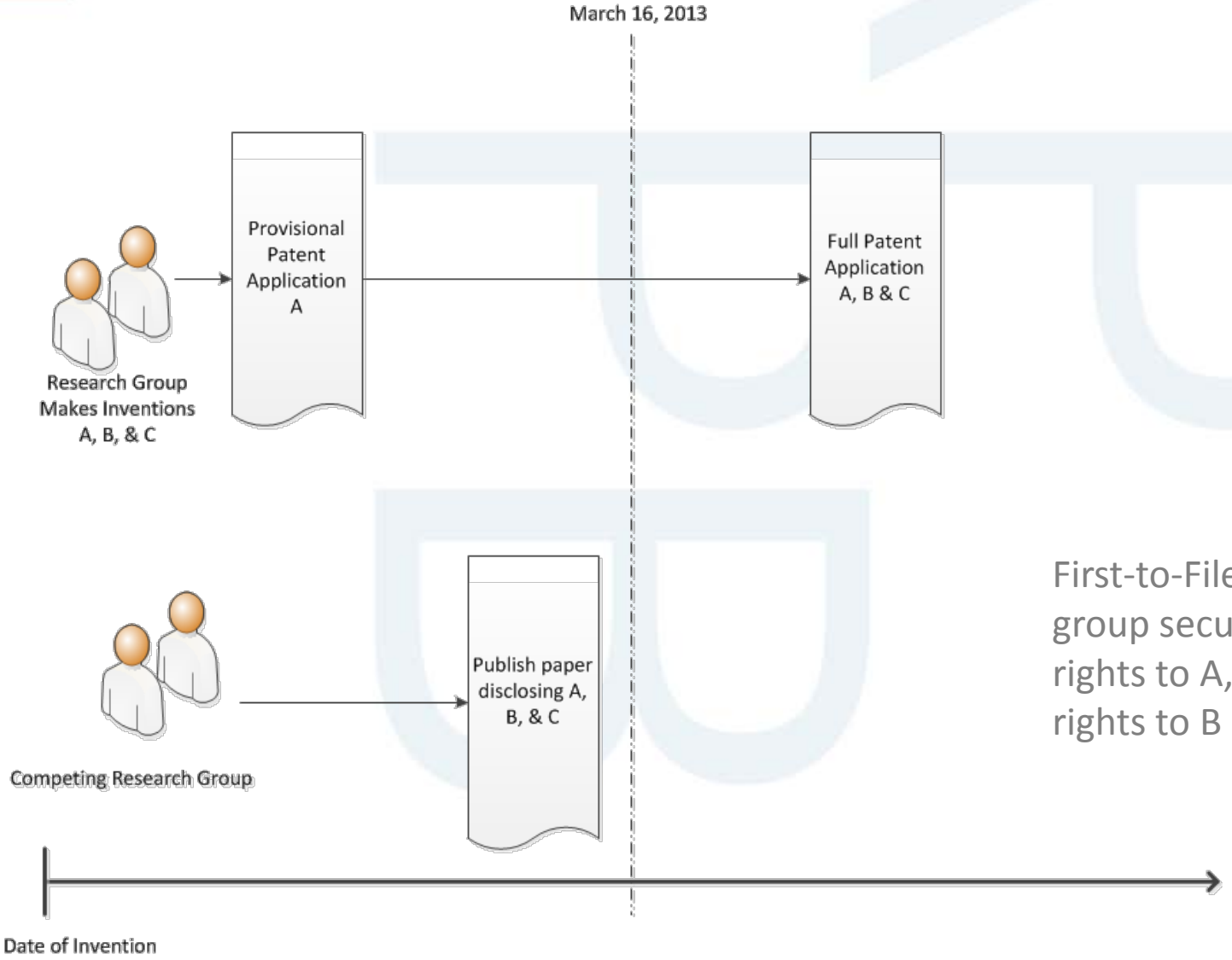
First-to-File: Research group loses patent rights to A, B & C.

What can we do to avoid losing rights?



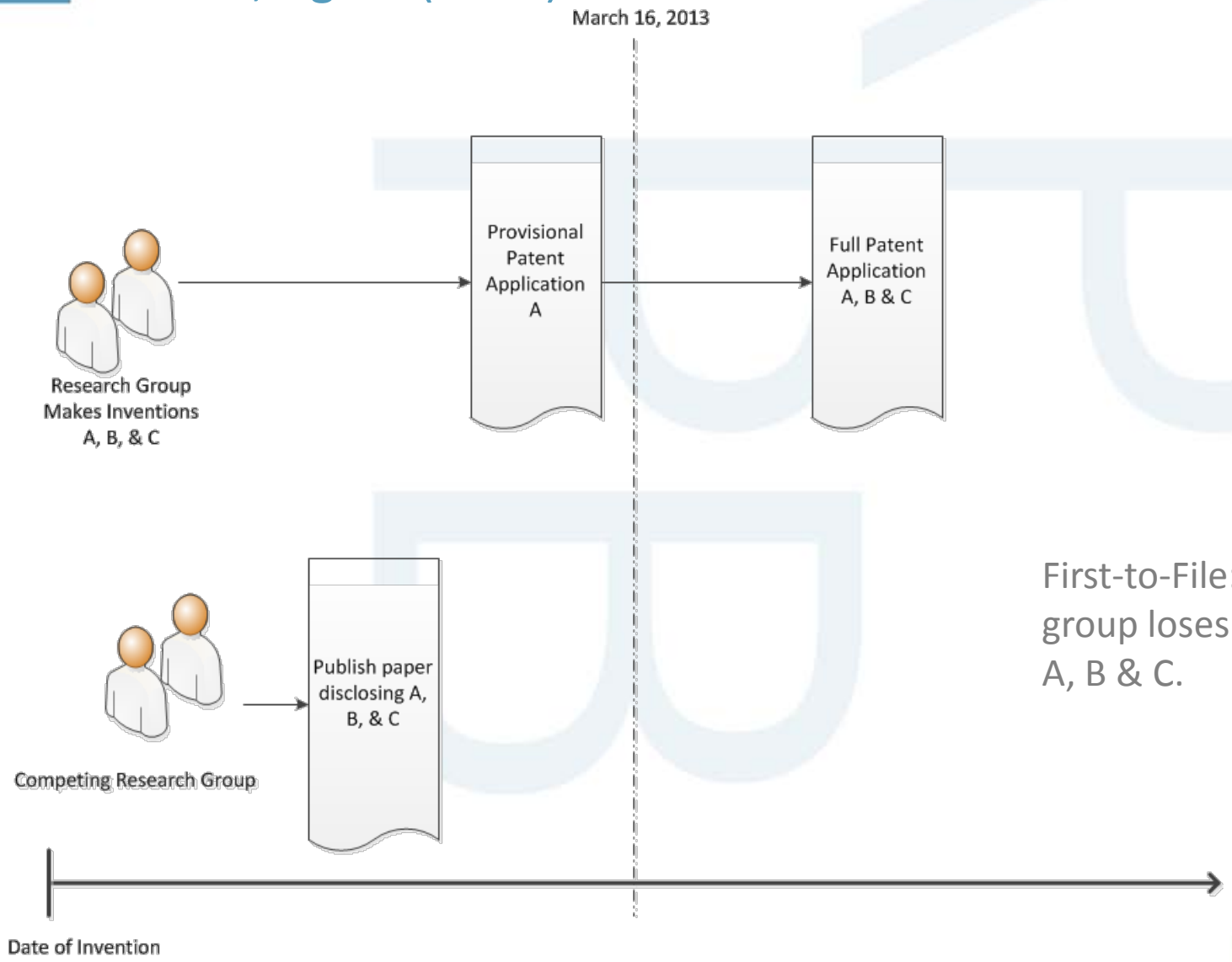
Filing a provisional before March 16, 2013 can prevent loss of rights due to transition to first-to-file.

We already have a provisional application on file so we are fine, right?



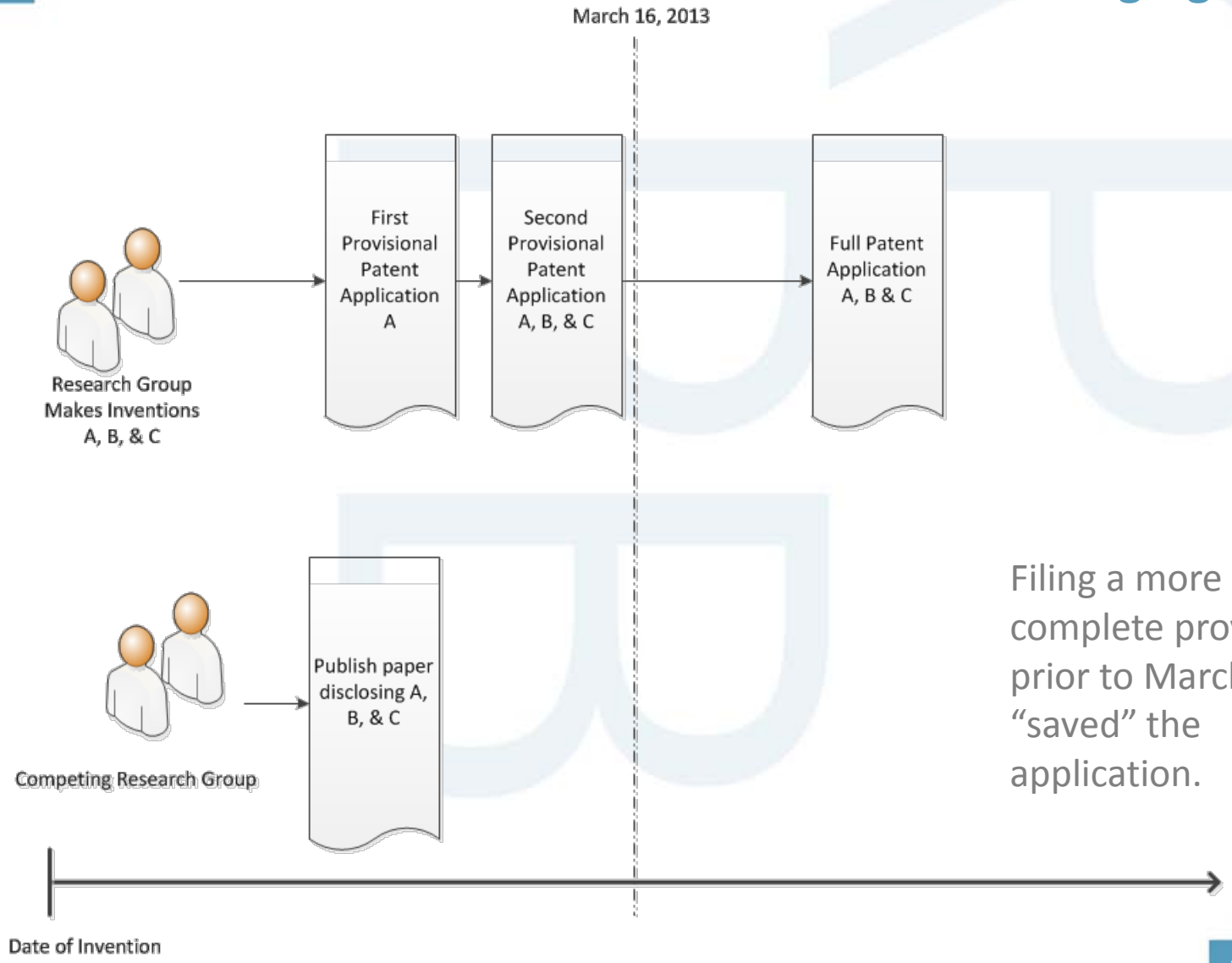
First-to-File: Research group secures patent rights to A, but loses rights to B & C.

We already have a provisional application on file so we are fine, right? (cont.)



First-to-File: Research group loses rights to A, B & C.

What can we do before March 16th to avoid losing rights?



Filing a more complete provisional prior to March 16th "saved" the application.

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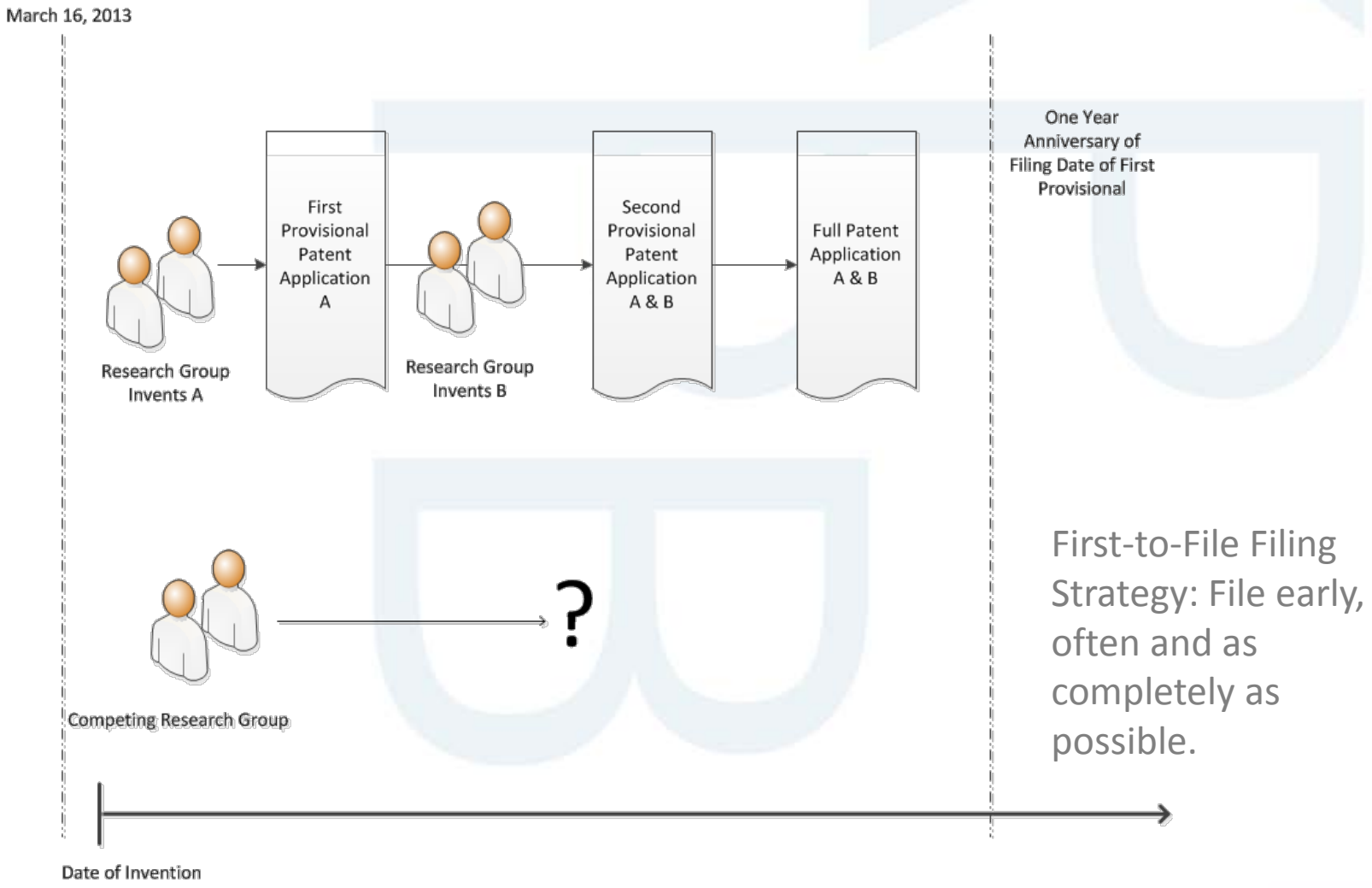
What NOT to do before March 16, 2013

- File large numbers of speculative and/or incomplete provisional applications.
- Low value IP before March 16, 2013 will still be low value IP after March 16, 2013.
- Filing applications where the technology is not “fully-baked” may run into other problems associated with enablement.
- SUMMARY: Take actions with respect to technologies that are ready to be protected and that you would have protected anyway.


Life after March 16, 2013

How to file under “first-to-file”



First-to-File Filing Strategy: File early, often and as completely as possible.

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Myths About New First-to-File System

- Circulating Myth: A publication is the same as filing a provisional application.
- They are not the same. Filing a provisional application preserves U.S. and International patent rights. Publishing will automatically result in a loss of International patent rights.
- The University likely will not take on the risk of pursuing a patent application where prior publication has occurred.

Executing your IP strategy

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Summary

- Before March 16, 2013
  - Convert applications; or
  - File more complete provisional applications.
  - Only take actions with respect to technologies that are ready to be protected and that you would have protected anyway.
- After March 16, 2013
  - File early, often, and as completely as possible; and
  - File two separate filings when adding disclosure to a pre-March 16 provisional application (one identical to provisional, one containing additional disclosure).

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