

-NACET-

**»the America Invents Act«
Good or Bad for Small
Businesses?**

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TOPICS

- First-to-File
- Preissuance Submissions
- Post-Grant Proceedings
- False Marking
- Fees
- Best Mode Requirements

Patentability Criteria

- Invention must be:
 - Proper Subject Matter (101)
 - No changes to the general requirements
 - Novel (102)
 - First-to-Invent -----> First-to-File
 - Non-Obvious (103)
 - No change to the general requirements

A dark, atmospheric photograph of a classical building with columns and a large red sphere in the foreground. The scene is dimly lit, with the building's facade and columns visible in the background. A large, smooth, red sphere is positioned in the lower-left foreground, partially obscuring the view of the building. The overall mood is serious and professional.

First-to-File

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Definitions

- Effective Date of Filing (EDF) – the date on which the earliest related application was filed
- Date of Invention (DOI) – the date on which both conception and a reduction to practice of the invention occurs
- Conception (C) – the date on which a mental formulation of the invention arises
- Reduction to Practice (RTP) :
 - Actual (ARTP) – the date on which a prototype of the invention is tested to demonstrate that the invention works as intended
 - Constructive (CRTP) – the date on which the earliest related application disclosing the invention was filed

NOVELTY – 35 USC §102

Old :“First-to-Invent” Law under 102a:

- Not entitled if, before the DOI, the invention was:
 - Known or used by another in the U.S.
 - Patented or described by another in a printed publication anywhere

NOVELTY – 35 USC §102

Old “One-Year-Grace Period” Law under 102b:

- Not entitled if, more than 1 year before the EDF, the invention was:
 - Used or offered for sale in the U.S.
 - Patented or described in a printed publication anywhere
- [Patentee has 1 year to get to the patent office after patentee’s disclosure]

ABSOLUTE NOVELTY

New “First-to-File” Law under 102a:

- Not entitled if, before the EDF:
 - The invention was patented, described in a printed publication, in public use, on sale or otherwise available **anywhere**

ABSOLUTE NOVELTY

New “One Year Grace Period” Law under 102b:

- Entitled if, 1 year or less before the EDF:
 - The invention is disclosed **by an inventor**, or one authorized by the inventor; or
 - The subject matter of the disclosure was obtained from **the inventor**

ABSOLUTE NOVELTY

New Law “One Year Grace Period” 102b
– Further Exception – third party disclosure if commonly owned:

- Entitled if, 1 year or less before the EDF, the invention is disclosed by a third party, and:
 - The invention was subject to an obligation to be assigned to the third party before the date of disclosure [see next slide re: joint research agreements]

ABSOLUTE NOVELTY

Inventions resulting from a Joint Research Agreement are commonly owned if:

- The invention was subject to a Joint Research Agreement in effect before the DOI; and
- The invention resulted from activities within the Joint Research Agreement scope; and
- The application discloses the names of the parties to the Joint Research Agreement.

NON-OBVIOUS

- No change in the law on how obviousness is determined.
- References for obviousness determinations may be used as prior art if published before the DOI date.

PRACTICAL EFFECT OF FIRST-TO-FILE LAW

None

- Patent rights no longer determined by Interference Proceeding
 - (so what - junior party seldom wins)
- Derivation proceeding still permitted in the event another “stole” the invention and filed before the true inventor’s EDF date
 - proceeding must be started within 1 year of issuance of the earlier patent
- Inventor still has a 1 year grace period to file
 - Applies only to self or if commonly owned



Preissuance Submissions

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Preissuance Submissions

- Old : under 37 CFR§1.99:
 - Must be filed w/i 2 months of publication
 - Or must show that it could not have been submitted sooner
 - Only references are submitted
 - Cannot provide argument

Preissuance Submissions

- New:
 - Must be filed w/i 6 months of publication
 - Or before the date of first rejection
 - A statement of relevance of each reference is required



Post Grant Proceedings

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Post Grant Proceedings

- Old :
 - Reexamination
 - Initiated for the purpose of having the patent office consider prior art not considered before
 - Initiator may be a third party, the patentee, or the patent office
 - Reissue
 - By patentee only to correct errors committed without deceptive intent
 - Filed w/i 2 years if to broaden claims

Post Grant Proceedings

- New :
 - Post-Grant Review
 - Third party initiates
 - Must be initiated w/i 9 months of issuance
 - Any invalidity defense may be raised
 - Inter Partes Review
 - Third party initiates after 9 months after issuance
 - Only based on novelty or obviousness



False Marking

False Marking

- Old :
 - Whoever, with deceptive intent, marks an article “patent pending” when no application has been made or marks with a patent number when no patent applies, shall be fined not more than \$500/offense
 - Any person may sue
 - $\frac{1}{2}$ goes to the government

False Marking

- New :
 - Whoever marks an article “patent pending” when no application has been made, for purposes of deceiving the public, shall be fined not more than \$500/offense
 - Only a person suffering a commercial injury may sue
 - Expressly excludes marking of an expired patent number

The background of the slide is a dark, moody photograph of a classical building with several columns. In the foreground, a large, smooth, red sphere is positioned on the left side. The overall lighting is low, creating a sense of depth and shadow.

Fees

Fees

- Old :
 - Two tiered fee schedule
 - Large Entity (500+ employees)
 - Small Entity (less than 500 employees)
 - Pays 50% of large entity fees

Fees

- New :
 - Adds a “Micro Entity” fee schedule
 - 25% of large entity fees
 - Criteria for Micro Entity
 - Qualifies as a small entity
 - Named as an inventor in no more than 4 previous applications filed in the US
 - In the prior year, did not have a gross income exceeding 3X the medium household income
 - Has not assigned or under obligation to assign to an entity having 3X medium household income



Best Mode

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Best Mode

- Old :
 - In defense of an action for patent infringement, the failure to comply with any requirement of §112 may be asserted (including the best mode contemplated by the inventor)
- New:
 - Best mode requirement as a defense expressly excluded

Q & A

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