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America Invents Act:
Provisions Effective March 16, 2013

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America Invents Act

- The America Invents Act (AIA) was signed into law on September 16, 2011.
- Of the various provisions enacted, some:
  - went immediately into effect (Sept. 16, 2011)
  - became effective at 1 year anniversary (Sept. 16, 2012)
  - become effective at 18 months (March 16, 2013)
- Provisions effective on March 16, 2013 include:
  - First Inventor to File provisions
  - Derivation Proceedings provisions
  - Repeal of Statutory Invention Registrations
    - Statutory Invention Registrations simply no longer exist.

America Invents Act

- Pre-AIA, the U.S. was First Inventor to Invent system
  - This system is more complex as "invention date" must be determined through discovery
  - Inventors may antedate prior art by proving earlier "invention date" than the date of the prior art
  - Interferences proceedings occur when different inventors claim the same invention
    - Each inventor must attempt to prove earliest invention date
    - Proceedings can take many years to complete
  - Almost every country other than U.S. already uses First Inventor to File system in which:
    - the filing dates are easily known, without any discovery
    - prior art is simply defined as anything prior to the filing date
    - No interferences exist, as it is merely a race to the patent office

Pre-AIA Prior Art Definitions

- Pre-AIA Section 102(a), (b), and (e) defined prior art:
  - A person shall be entitled to a patent unless:
    - (a) the invention was known/used by others in this country, or described in a printed publication anywhere, before the invention thereof by the applicant for patent, or
    - (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or
    - (e) the invention was described in:
      - (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or
      - (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language

AIA - First Inventor to File

- Law harmonizes U.S. with the rest of the world
- Each application is given an effective filing date
  - Patentability is judged on prior art that pre-dates the effective filing date
  - Law maintains a one year grace period for filing after inventor-made or inventor-derived disclosures
  - Replaces interference proceedings with derivation proceedings

- In a first to file system, it only matters who was the earliest filer
- Unless the earlier-filed applicant can be shown to have derived the invention from information from the later-filed applicant (or one who made a publication derived from information from the later-filed applicant)

AIA Prior Art Definitions

- Post-AIA Section 102(a) defines prior art:
  - A person shall be entitled to a patent unless -
    - (1) the claimed invention was described in a printed publication (or was in use, on sale, or otherwise publicly available) before the effective filing date of the claimed invention; or
    - (2) the claimed invention was described in a U.S. Patent, U.S. Patent Application Publication, or PCT Publication, names another inventor, and was effectively filed before the effective filing date of the claimed invention.

  - New 102(a) includes straightforward definitions
    - No geographical limitations on prior art
    - No language-based limitations on prior art
    - Eliminates the *Hilmer* rule (now secret prior art can originate anywhere)
  - Section 102(a)(1) is subject to the exceptions of 102(b)(1)
  - Section 102(a)(2) is subject to the exceptions of 102(b)(2)

AIA Prior Art Definitions

- Post-AIA Section 102(b)(1) sets forth exceptions to prior art defined in 102(a)(1):
  - (1) 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.

AIA Prior Art Definitions

- Post-AIA Section 102(b)(2) sets forth exceptions to prior art defined in 102(a)(2):
  - (2) 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.

AIA Prior Art Definitions

- Post-AIA Section 102(c) clarifies common ownership:
  - (c) common ownership under a Joint Research Agreement does get benefit of being considered commonly owned
- Post-AIA Section 102(d) defines effective date for references as prior art:
  - (d) For purposes of determining whether a patent or application for patent is prior art to a claimed invention under subsection (a)(2), the effective filing date is:
    - (1) the actual filing date of the patent or the application for patent; or
    - (2) if priority under 119, 120, 121, or 365(a)(c), as of the filing date of the earliest such application that describes the subject matter.

AIA Obviousness Definition

- Post-AIA Section 103 defines obviousness:
  - A patent for a claimed invention may not be obtained, notwithstanding that the claimed invention is not identically disclosed as set forth in section 102, if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains. Patentability shall not be negated by the manner in which the invention was made.

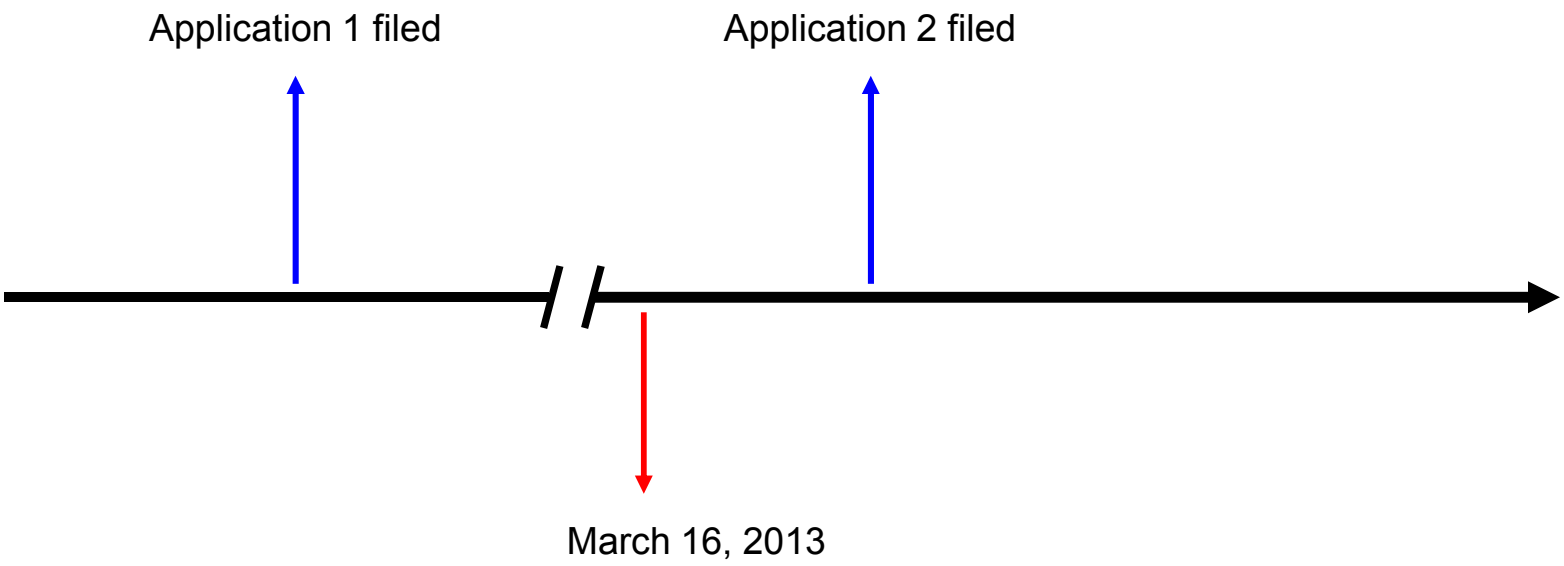
AIA Applicability

- Effective March 16, 2013
  - Applicable to any application for patent, or patent issuing thereon, that contains or contained at any time –

    - a claim having an effective filing date on or after the effective date (March 16, 2013); or
    - a specific reference under section 120, 121, or 365(c) of title 35, United States Code, to any patent or application that contains or contained at any time such a claim
  - Thus, the subject matter of each claim must be examined
    - Each claim has an effective filing date based on whether the subject matter of that claim is supported by any parent or priority applications

    - If the subject matter of any claim is not supported by an application with a filing date prior to March 16, 2013, then the entirety of the application containing that claim will be considered under the new rules and can never revert to the old rules (even if the claim is canceled or amended)

AIA Timeline Examples

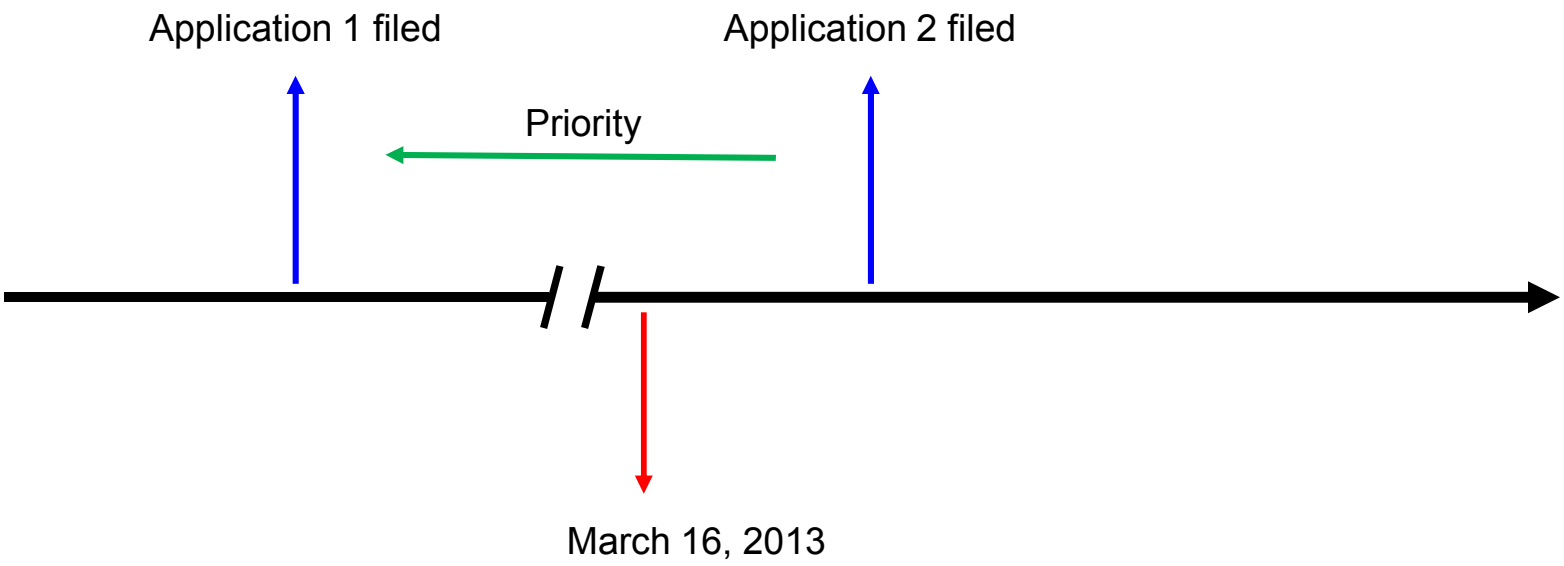


Applications 1 and 2 are not related.

Application 1 is subject to old rules.

Application 2 is subject to new rules

AIA Timeline Examples

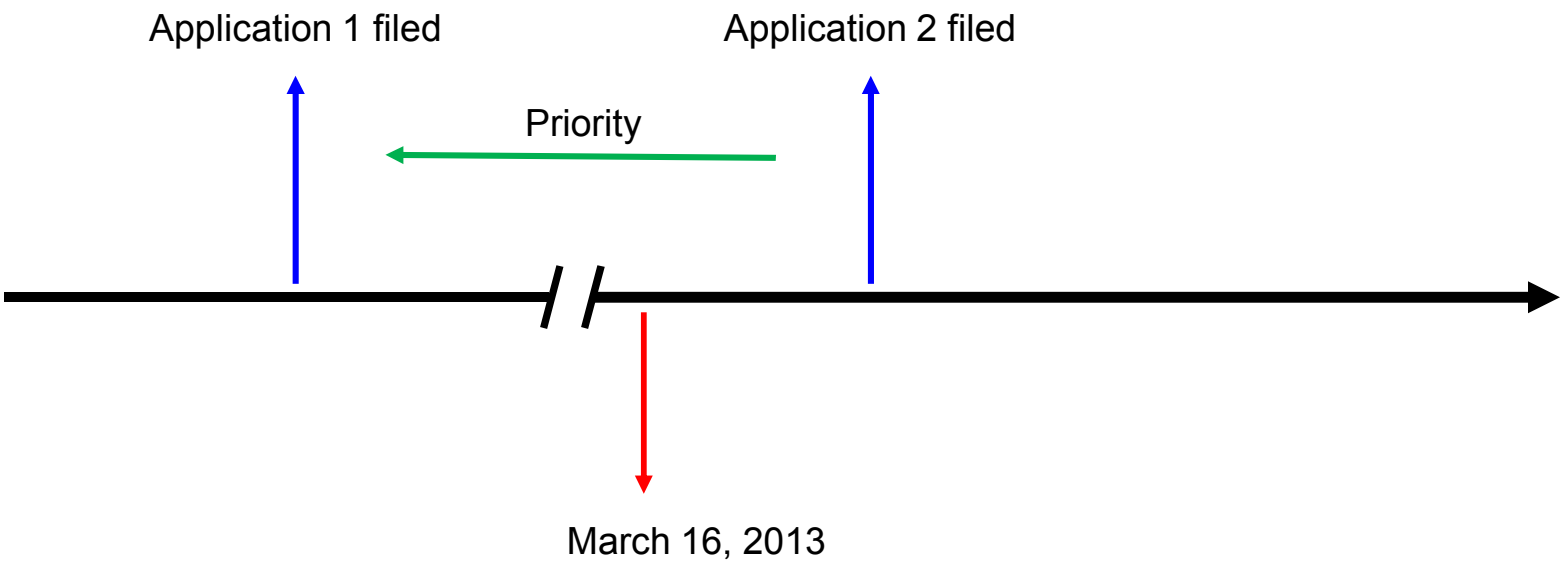


Priority is claimed to Application 1 and all claims of Application 2 are always fully supported.

Applications 1 and 2 are subject to old rules.

Application 2 may be continuation, divisional, national stage, or Paris convention application.

AIA Timeline Examples

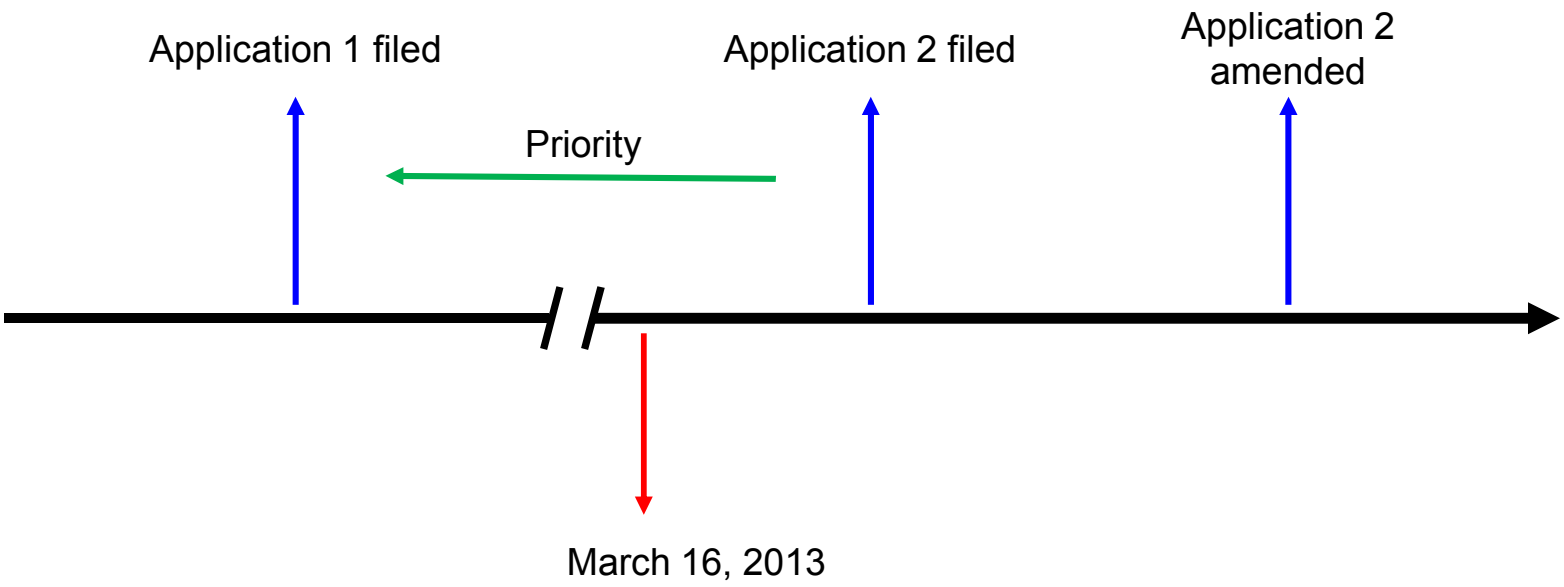


Priority is claimed to Application 1, but at least one claim of Application 2 is not supported.

Applications 1 is subject to old rules, but Application 2 is subject to new rules.

Application 2 is Continuation-in-Part application.

AIA Timeline Examples

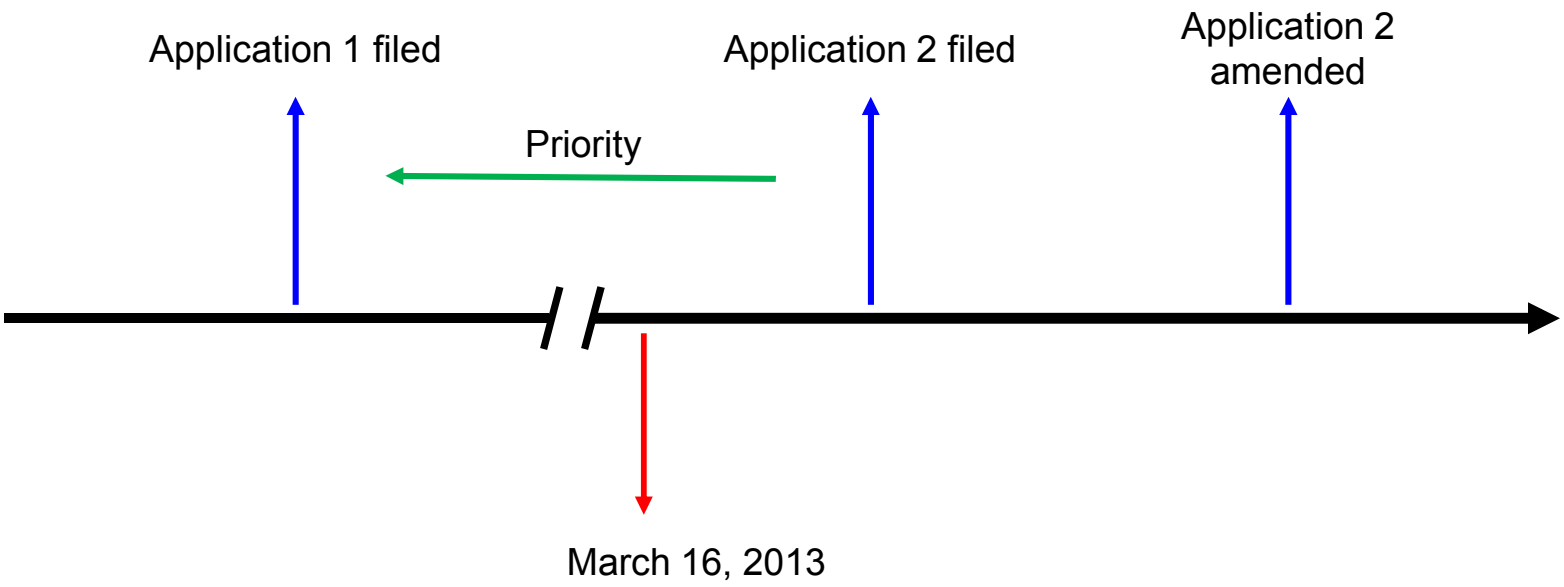


Priority is claimed to Application 1 and, as filed, all claims of Application 2 are fully supported.

As amended, at least one claim of Application 2 is not supported.

Applications 1 and 2 are subject to old rules and a rejection under 35 U.S.C. 112 is issued.

AIA Timeline Examples

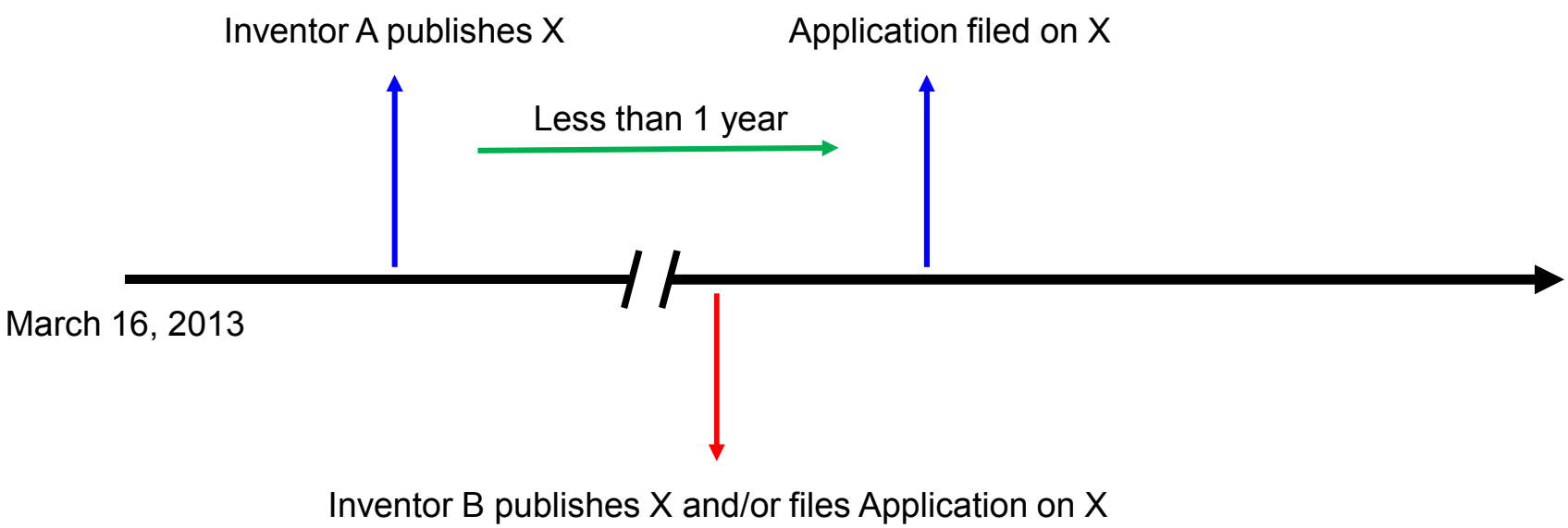


Priority is claimed to Application 1 and, as filed, all claims of Application 2 are fully supported. However, Application 2 is a CIP application and contains new disclosure.

As amended, at least one claim of Application 2 is not supported by the original disclosure, but is supported by the new disclosure.

Application 1 is subject to old rules. Application 2 was subject to old rules at filing, but is subject to new rules upon amendment.

AIA Timeline Examples

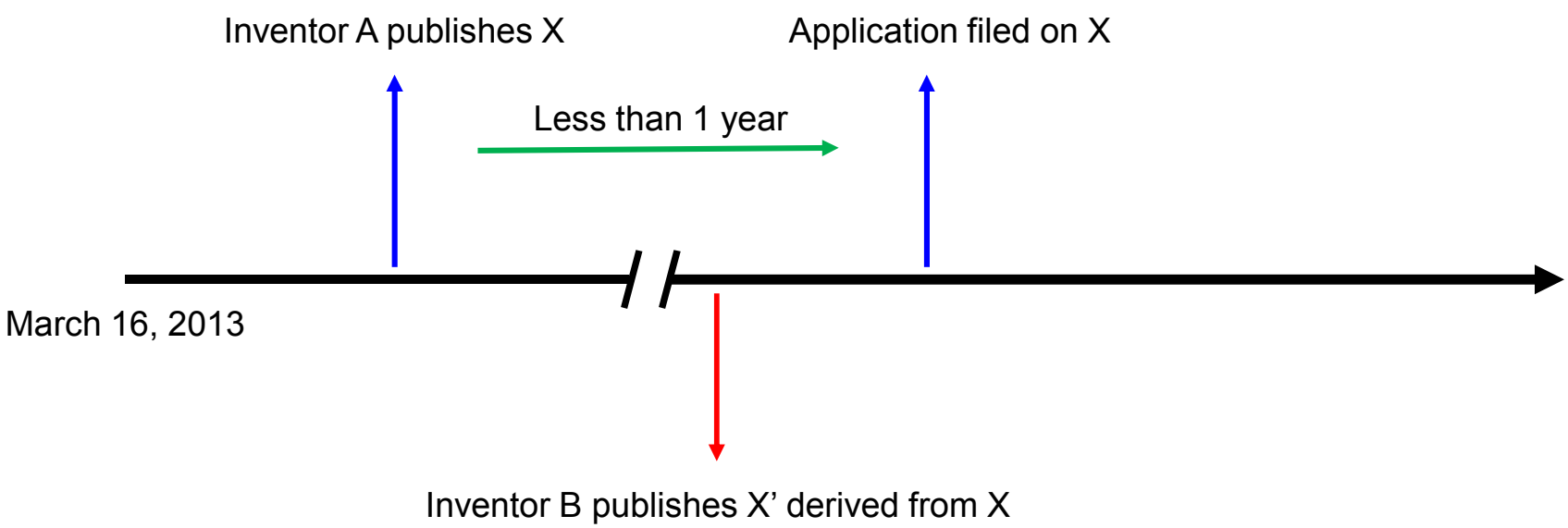


After March 16, 2013, when Inventor A publishes a description of invention X, a 1-year grace period begins. Inventor A filed a patent application in less than 1 year.

During the 1-year grace period, if another Inventor B publishes a description of invention X and/or files an application claiming X, then:

The publication or application by Inventor B is not prior art to the application by Inventor A. The publication by Inventor A is prior art to any application by Inventor B.

AIA Timeline Examples



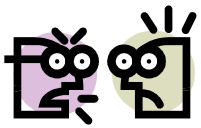
After March 16, 2013, when Inventor A publishes a description of invention X, a 1-year grace period begins. Inventor A filed a patent application in less than 1 year.

During the 1-year grace period, if another Inventor B publishes a description of invention X' derived from X, then:

The publication by Inventor B may be prior art to the application by Inventor A. This depends on whether the subject matter of X' is the same as X.

Practice Points

- After March 16, 2013, Office Actions will indicate whether an application is considered pre-AIA/post-AIA
  - If Applicant disagrees with the indication of pre-AIA/post-AIA



    - Applicant can challenge the indication by submitting arguments as to the correct classification
    - Applicant can also appeal the indication of pre-AIA/post-AIA, if an agreement cannot be reached with respect to the classification
  - If an application is filed having claims that are supported by the priority document, but other claims that are not supported
    - Applicant must state which claims are supported and which claims are not supported by the priority document at the time of filing
    - Doing so will determine the effective filing date used for examination on a claim-by-claim basis
    - If any claims have an effective filing date after March 16, 2013, then post-AIA prior art definitions will be used for the entire application

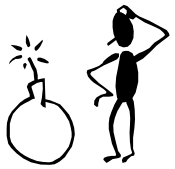
Practice Points

- For post-AIA cases, USPTO Rules set forth some specific issues:
  - Personal publications and derived publications may only fall under exception if the disclosed subject matter is exactly the same

    - No verbatim requirement, but variations in the disclosed subject matter raise a question as to whether the publication is available as prior art
    - Summarizing/re-wording of inventor-based disclosure material is likely not prior art
    - Alternative embodiments, even obvious variants, likely will be considered prior art
    - Also, no exception for independent publication or filing by another
    - No exceptions exist for public use, public sales, or public offers for sale that are made prior to filing an application
      - However, sales and offers for sale must be public
      - Confidential sales or offers for sale do not trigger 102 event

Practice Points

- Be mindful of whether events trigger new 102 prior art:
  - Sales, offers to sell, or use do not qualify, if confidential
  - Offers to license do not qualify
    - Courts have held that: an offer to enter into a license under a patent for future sale of the invention covered by the patent when and if it has been developed … is not an offer for sale
    - However, if such activity makes public any details of the invention, those public details may separately constitute prior art



  - Public sales or offers to sell trigger a prior art event when:
    - The invention is "ready for patenting," and
    - The invention is the subject of a commercial sales transaction
  - Public use as prior art
    - Public uses in foreign countries did not qualify as prior art before March 16, 2013, but will qualify after March 16, 2013
    - Experimental use exception may still exist

Practice Points

- Publications made within the grace period
  - Do not qualify only when the subject matter is the same
    - Inventor's own disclosures within grace period do not need to be verbatim, but must contain same subject matter to be excepted
  - Must have same authors as inventive entity
    - If authors are different than inventive entity, the Applicant must show that the authors who are not inventors did not contribute the subject matter in order to disqualify the publication from prior art
  - Intervening disclosures can be excepted only if they contain the same or more general subject matter
    - If alternative disclosure is made, then it may qualify as prior art
  - Enabling disclosure in the prior art:
    - is required for patents, patent application publications, and publications
    - But NOT required for public uses or public sales/offer to sell

Derivation Proceedings

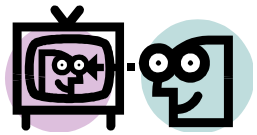
- Effective March 16, 2013:
  - Derivation proceedings apply to:
    - Applications that all have an effective filing date after March 16, 2013
    - USPTO will determine whether subject matter contained in earlier-filed application was derived from the inventor of a later-filed application
  - Interference proceedings still apply to:
    - Any patent, and any patent issued thereon, for which the amendments made by this section also apply, if such application or patent contains or contained at any time –
      - a claim to an invention having an effective filing date as defined in section 100(i) of title 35, United States Code, that occurs before the effective date set forth in paragraph (1) of this subsection; or
      - a specific reference under section 120, 121, or 365(c) of title 35, United States Code, to any patent or application that contains or contained at any time such a claim.
    - Thus, if any claim of an involved application has an effective filing date prior to March 16, 2013, then Interference Proceeding is conducted instead of Derivation Proceeding

Derivation Proceedings

- Effective March 16, 2013:
  - In a derivation proceeding, Applicant must file an affidavit or declaration of attribution with actual facts showing derivation
  - § 1.130 sets forth procedural requirements for an affidavit or declaration of attribution
    - Must identify the specific subject matter publicly disclosed and provide a publication date
      - If the disclosure is in print, a copy must be provided and, if not, the affidavit or declaration must be in sufficient detail for a proper determination
  - Timing for instituting Derivation Proceedings
    - Must be filed within 1 year of the first publication of a claim to an invention that is the same or substantially the same subject matter

Practice Points

- Interferences still apply whenever an involved patent or patent application has any claim with an effective filing date before March 16, 2013, otherwise derivation proceedings apply
- Interference-type conflicts in post-AIA cases
  - The USPTO will attempt to avoid issuing a later-filed application as a patent for the same invention as contained in an earlier-filed application
  - To help with this, the Applicant of the earlier-filed application can request early publication and cite the earlier-filed application into the later-filed application
    - This is dependent on being aware of the later-filed application

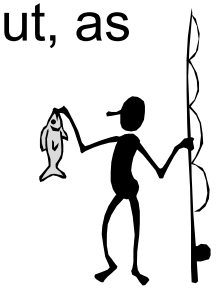


The Sad Saga of Joe-Bob

BACKGROUND:

- Joe-Bob is an avid fisherman. In January of 2010, he began his quest for the perfect fishing lure. For months, he tried every conceivable combination of body shapes and sizes, hooks, feathers, and eye sizes. By March 1, 2010, Joe-Bob was convinced he had invented and built the perfect fishing lure. So, under a non-disclosure agreement he sent an offer for sale including a complete written description of his invention to the world's foremost lure company, the French company Lure De Jour. Lure De Jour declined.

- Joe-Bob then contacted his brother, Jim-Bob, at Acme Manufacturing Company with an offer to license any patent that came from his invention. Joe-Bob did not give any details about his invention. Unfortunately, Acme management declined the licensing offer, but, as a favor to Joe-Bob, Jim-Bob circulated the offer to every other company in town. None accepted.

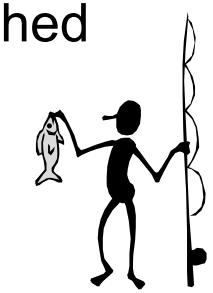


The Sad Saga of Joe-Bob

- On April 20, 2012 Joe-Bob wrote a complete written description of his invention and planned to contact a patent attorney to prepare a patent application. Self conscious about his writing he decided to send his friend Billy-Bob what he had written for proofreading.

- Several days later, Billy-Bob sent it back to Joe-Bob, having only corrected minor grammatical errors, with a written note saying "what a clever invention…I would have never thought of that." As Joe-Bob was out fishing, the reply sat in his inbox with a mountain of spam.

- Billy-Bob, not having heard back further from Joe-Bob and wanting to attract the attention of a lady at the local newspaper, submitted a harrowing account of his fishing experiences. Within his submission was an exact description of Joe-Bob's lure. The account published in the local paper on March 18, 2013.

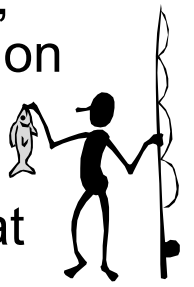


The Sad Saga of Joe-Bob

- An executive at Lure Du Jour reads Billy-Bob's publication and, only remembering that he had previously seen a lure similar to what was described, had an application filed that copies the description of the lure exactly, including Billy-Bob's poetic style, on March 21, 2013.

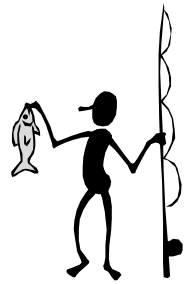
- With the town abuzz, Joe-Bob was ecstatic. He immediately went back to his trailer, contacted his patent attorney, and told him to file the complete written description of his invention. The patent attorney filed Joe-Bob's invention on April 1, 2013.

- Lure du Jour's application publishes on September 21, 2014, and, as Joe-Bob's patent attorney offered a patent application publication monitoring service, Joe-Bob was immediately notified of the competing application. Upon reading the publication, Joe-Bob recognized Billy-Bob's poetic style and told his patent attorney that the application was based on a copying of Billy-Bob's article.

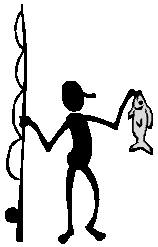


The Sad Saga of Joe-Bob

- A first office action issued on June 1, 2014 citing Billy-Bob's local paper article for a 102(a)(1) rejection.
- After hearing from his patent attorney, Joe-Bob spent hours searching through his inbox and finally found his email exchange with Billy-Bob.
- What observations can we make regarding the validity of Joe-Bob's patent in view of the secret offer for sale, public offer to license, rejection based on the pre-filing publication, and the competing application by Lure du Jour?



The Sad Saga of Joe-Bob



Joe-Bob

March 1, 2010
Conception & RTP

February 1, 2011
Public offer to license the lure

April 1, 2013
Joe-Bob files application

June 1, 2014
Office Action issued citing Billy-Bob's publication

Lure de jour

September 1, 2010

LDJ receives offer for sale from Joe-Bob under NDA

April 20, 2012

Joe-Bob sends Billy-Bob complete description of invention. Billy-Bob acknowledges receipt.

March 18, 2013
Billy-Bob publishes exactly Joe-Bob's ideas in local newspaper

March 21, 2013

LDJ files application exactly based on Billy-Bob's publication

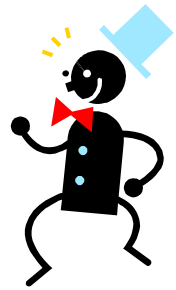
September 21, 2014

LDJ application publishes

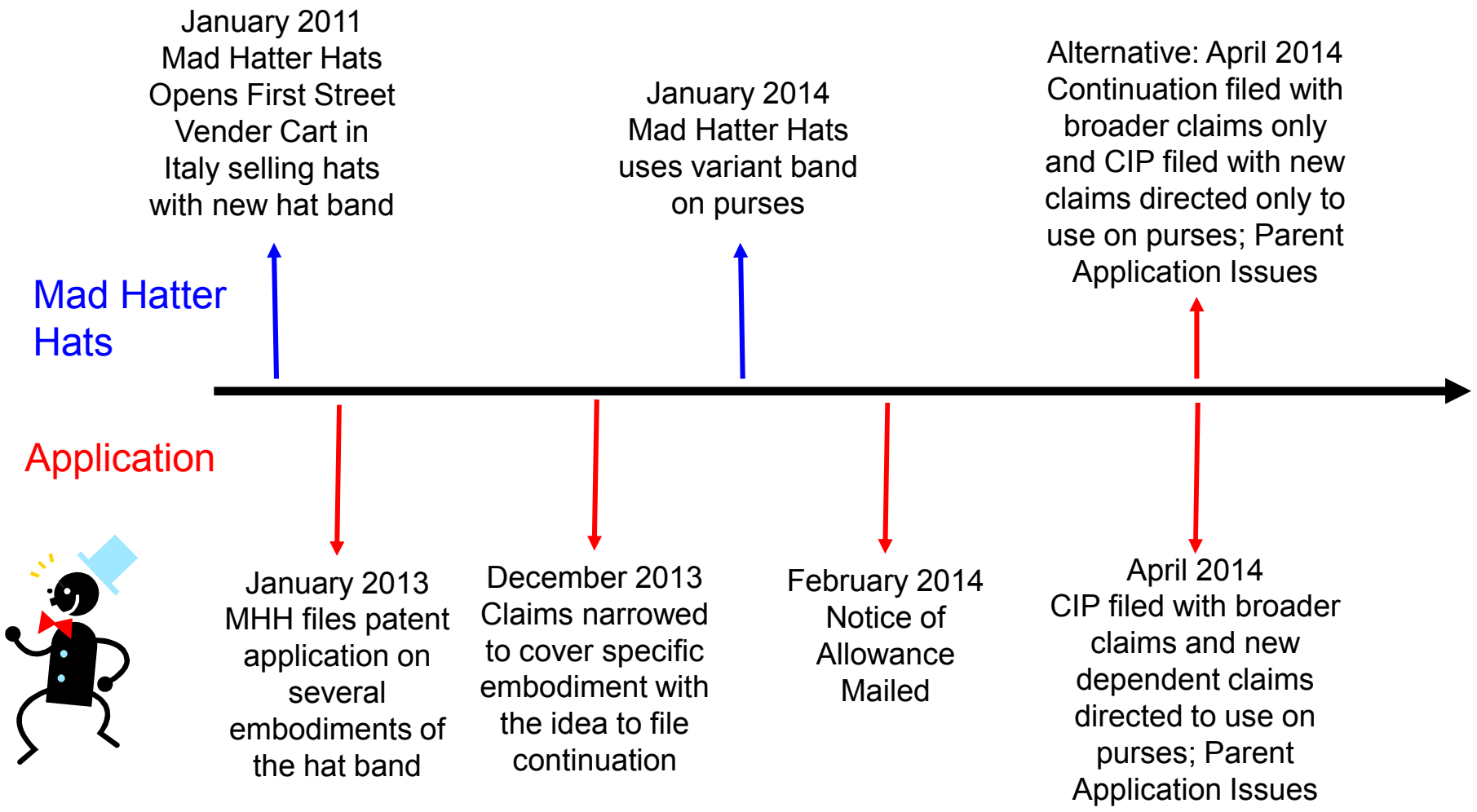
Billy-Bob

The Myth of Mad Hatter Hats

- January 2011, Mad Hatter Hats (MHH) Opens First Street Vender Cart in Italy selling hats with new hat band.
- January 2013, MHH files patent application on several embodiments of the new hat band.
- December 2013, Claims narrowed to cover specific embodiment with the idea to file continuation in order to gain allowance.
- January 2014, Mad Hatter Hats uses variant band on purses.
- February 2014, Notice of Allowance mailed in parent application.
- April 2014, a Continuation-In-Part (CIP) application is filed with broader claims from parent application and new dependent claims directed to use on purses; Parent application issues.
- Alternative: April 2014, Continuation application filed with broader claims only and CIP filed with new claims directed only to use on purses; Parent application issues.
- What observations can we make regarding prior art events in the two alternative scenarios?



The Myth of Mad Hatter Hats



THANK YOU

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