

# **PART III**

# **Patent Reform 2011**

# Finally...here

- A long process, started several years ago
- Passed House of Representatives in June 2011
- Passed Senate Sep 8, 2011
- Will be signed into law by President any time (expectedly in the next week or two) → enactment date
  - Some provisions will become effective
    - immediately (micro-entity) or
    - almost immediately (\$4,000 prioritized examination – 10 days later)
  - While other provisions will become effective much later
    - **First-inventor-to-file: 18 months from enactment**
    - Most other provisions: 1 year from enactment

# Major Changes

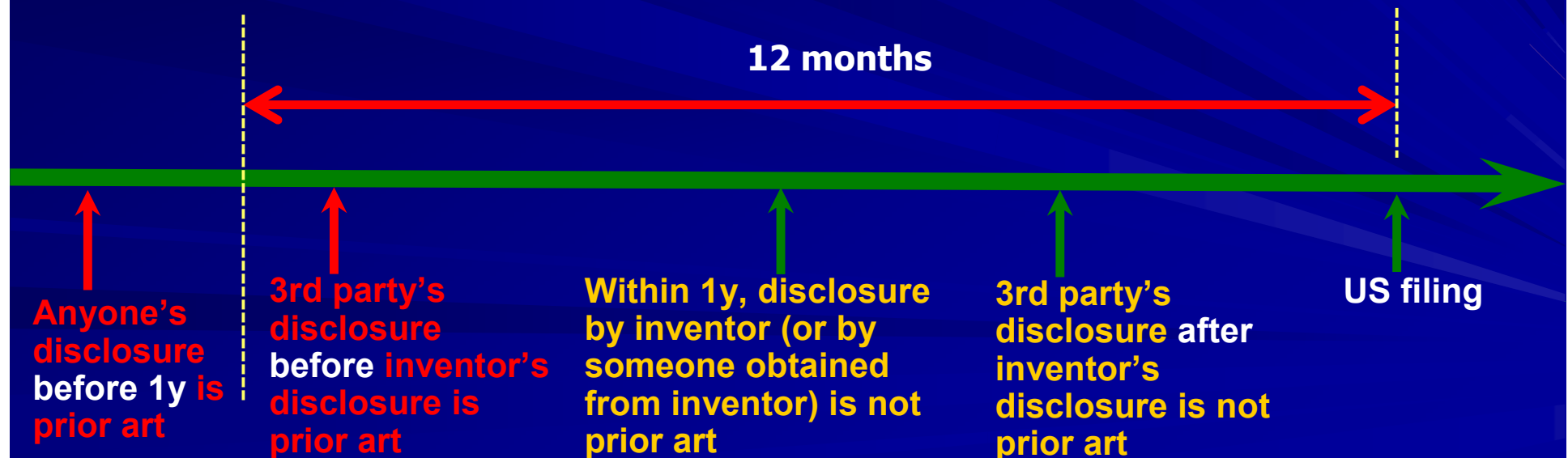
- **First-Inventor-To-File**
- Expanded Time Window for 3<sup>rd</sup> Party  
Submission of Prior Art
- New Post-Grant Review
- New Supplemental Examination
- Elimination of Best Mode as Basis for Invalidity

# Novelty - First-Inventor-To-File

- Keeps the preexisting requirement that **only inventor can apply for patent**
  - elsewhere in the world, anybody, not necessarily inventor, can apply for patent
- Removes expensive and rarely used interference proceeding, i.e., **if two people invented the same invention, whoever filed first wins**
  - interference: whoever invented first wins
- Eliminates swearing-behind practice
- Effective 18 months from enactment
  - Applies to applications **filed** on or after effective date<sup>77</sup>

# Novelty - First-Inventor-To-File

- Maintains 1-year grace period for disclosures made by or derived from inventors
  - The chart below applies where no foreign priority exists



# Expanded Time Window for 3rd Party Submission of Prior Art

- Current procedure (37 CFR 1.99): within 2 months from publication
- **New law:**
  - Within 6 months from publication
  - But before 1<sup>st</sup> action or allowance
- **Effective:**
  - 1 year after enactment
  - Applies to any application

# Opposition – Post-grant review

## ■ Current law:

- Reexamination: limited to prior art only

## ■ New law

- Added new post-grant review proceeding
  - on any ground within 12 months of issuance
    - 101, 112 grounds for invalidity permitted
    - 101, 112 grounds not available under reexamination
  - similar to opposition in other countries
- Cheaper than litigation
- Big companies may use this to harass small companies

## ■ Effective:

- 1 year after enactment

# Supplemental Examination

## ■ Current situation:

- Duty of disclosure imposes heavy burden on applicants  
→ not easy to comply
- Inequitable conduct defense is raised in almost every patent law suit where relevant art is missed

## ■ New law

- Allow Patentee to request, prior to litigation, “supplemental examination” based on relevant info never submitted before
- Exempt Patentee who survives “supplemental examination” from allegation of inequitable conduct
- Good pre-litigation strategy to avoid potential inequitable conduct allegations



# Best Mode

## ■ Current law:

- Best Mode is required for both patentability (examination before USPTO) and invalidity (litigation)

## ■ New law:

- Best Mode is no longer a basis for invalidity
  - “...failure to disclose the best mode shall not be a basis on which any claim of a patent may be canceled or held invalid or otherwise unenforceable...”
- Potential result:
  - patents only disclose a way (rather than the subjectively best way) to make/use the invention

# Questions

# ありがとうございました

ご質問等ございましたら、下記までお気軽にお問い合わせください

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