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IP FLASH

AMERICA INVENTS ACT CONVERTS THE US TO A "FIRST INVENTOR TO FILE" PATENT SYSTEM

The Leahy-Smith America Invents Act (AIA) is US federal legislation enacted into law on September 16, 2011, that changes US patent law. Certain provisions of the AIA have already become effective and additional provisions will become effective on March 16, 2013. Notably, on March 16, 2013, the US transitions from a "first to invent" system to a "first inventor to file" system. A patent applicant will no longer be able to use an earlier date of invention to overcome prior art or provoke an interference with another patentee.

The definition of prior art has been clarified and expanded under the AIA to include non-printed disclosures, including oral disclosures, made available to the public anywhere in the world. Additionally, US patents and US published applications will become prior art as of their first effective priority date, regardless of whether that priority date is from foreign or US priority, thus eliminating the so-called Hilmer doctrine which limits the effective prior art date of US patents and US published applications to only their earliest US priority filing date.

The broad one year grace period that previously existed under US patent law will be eliminated and replaced with a fairly limited grace period that is tied to a disclosure by the inventor. Under the AIA, a disclosure made within one year before the effective filing date of a claimed invention is not prior art if the disclosure was made by the inventor (or joint inventor) or by another who obtained the subject matter directly or indirectly from the inventor. Another provision provides that the grace period may apply to a disclosure by a non-inventor within one year prior to the inventor's filing date where the subject matter disclosed had been publicly disclosed by the inventor before the disclosure by the non-inventor. However, the USPTO appears to be interpreting this provision very narrowly and has indicated that the public disclosure of the inventor must be substantially identical to the subsequent disclosure by the non-inventor, and that even trivial differences may render the subsequent disclosure as applicable prior art. Further, the AIA provides that a US patent or US published application having an effective filing date before, and a publication date after, that of another claimed invention is not prior art where the subject matter disclosed and the other claimed invention, at the time of the effective filing date of the other claimed invention, were owned by the same person or subject by an obligation of assignment to the same person.

A number of review processes are implemented by the AIA that are conducted before the Patent Trial and Appeal Board. For example, a post-grant review process provides that within 9 months of issuance of a US patent, it may be possible for a third party to challenge the validity of one or more claims, and an inter partes review process, that replaces the former inter partes reexamination process, enables challenges by a third party to one or more claims more than 9 months after a patent issues.

Other provisions of the AIA that are currently in effect include provisions that enable the real party in interest, such as the assignee, to be the applicant for a patent instead of the inventor(s). An oath or declaration is still required from each inventor regardless of the applicant, although requirements of the oath or declaration have changed somewhat. It is noted, however, that it has become a simpler process to proceed with an application in the case of an uncooperative inventor. Additionally, assertion of the requirement for inventors to set forth the best mode to carry out the invention has been eliminated as a way of invalidating a patent. Also, the ability to file a false marking lawsuit has been significantly curtailed; specifically, it is required that actual damages from purported false marking be proven, and marking with an expired patent number is no longer a violation of the false marking statute.

In view of the first-inventor-to-file provisions, an assessment should be made of pending invention disclosures that have not yet been filed as patent applications. Although the USPTO has not yet issued final rules for implementing the first-inventor-to-file provisions of the AIA, as of March 16, 2013, it may no longer be possible to rely on a grace period following a prior disclosure of an invention nor will it be possible to rely on a date of invention prior to the filing date to obtain a patent. It is therefore advisable to consider filing any patent applications that might be adversely affected by the AIA changes before March 16, 2013.

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