America Invents Act

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ENET/CNET Meeting December 8, 2011
Expedited Prosecution Procedures

- **Current Expedited Examination**
  1) Patent Prosecution Highways
  2) Accelerated Examination with Pre-Exam Search

- **New Prioritized Examination**
  - Fee only ($4,800 special fee)
  - No search or other office required
  - Limited to 10,000 applications per year
  - 4 independent claims and 30 claims total
  - Time limit for responding to Office Actions is 3 months and extensions are available, but taking an extension of time will cause the prioritized status of the application to be withdrawn.
Micro-Entity Status

- **Small Entity**
  - An entity that has not assigned, granted, conveyed, or licensed any rights in the invention to a non-small entity and is under no obligation to do so.
  - A person
  - A nonprofit organization
  - A business concern whose number of employees, including its affiliates, does not exceed 500 persons.
  - 50% fee reduction

- **Micro-Entity**
  - Applicant qualifies as a small entity
  - Applicant is not named as an inventor on more than four previously filed patent applications
  - In preceding calendar year, Applicant had a gross income not exceeding three times median household income.
  - Universities*
  - 75% fee reduction
Best Mode

- Patent statute still requires disclosure of best mode
- Failure to disclose best mode no longer basis for invalidity of patent
- Failure to disclose best mode is not a basis for inequitable conduct, even if intentional
- Best mode cannot be challenged in Post Grant Review or Inter Partes Review in PTO
- Still possible for examiner to reject application for failure to disclose best mode
Marking – Old Law

- Must mark patent numbers on product to recover damages
- In past, if falsely marked product with incorrect or expired numbers, patent owner could be liable for $500 for each product sold
- In past, any person could bring law suit
- Enormous awards were possible
Marking - AIA

- Can now mark product (or label if product cannot be marked) with internet address that associates article with patent(s)

- False marking actions now can only be brought by:
  - U.S. Govt for $500 for each offense
  - Person who suffers competitive injury for damages adequate to compensate for injury

- Now, no liability for marking with an expired patent