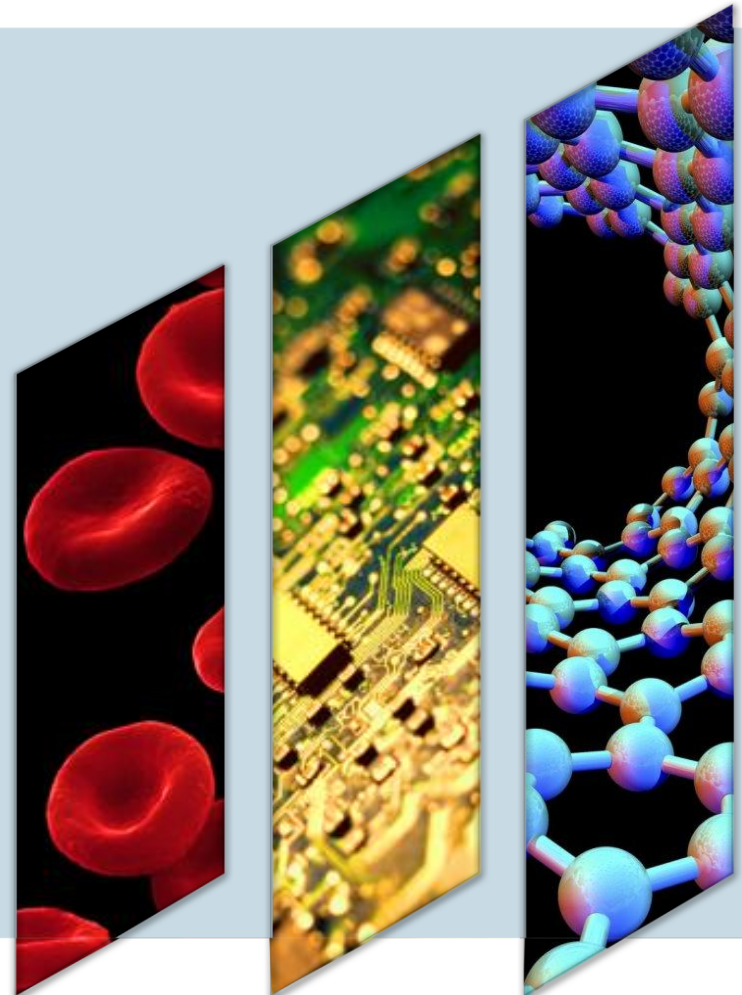


# America Invents Act

**Marc S. Johannes**

**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extensions are available, but taking an extension of time will cause the prioritized status of the application to be withdrawn.**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