



Patent Law Reform: America Invents Act (AIA)

Introduction

- Leahy-Smith America Invents Act has gone through several revisions.
- Effective dates are very important.
- Enacts a version of first-to-file, but many other provisions.
- Provides a step toward harmonization with international patent law.
- The statute is subject to interpretation & implementation; consult your attorney.
See www.uspto.gov/aia_implementation/

Novelty and Prior Art Issues

- Old one year grace period for on-sale, publication, or public use is gone.
- A new one year grace period for public disclosure is provided (thus not a true first-to-file system).
- Effective date is March 16, 2013.
- On sale may be OK (if private).
- Priority dates for foreign filed patents may be earlier (more prior art can be asserted against you).

First-to-File

- Instead of first-to-invent, new approach is first-to-file.
- Effective date is March 16, 2013.
- Still have a one year grace period after public disclosure.
- New strategies are involved.
- Still important to maintain good records, particularly for prior use, public disclosure & derivation issues.

Best Mode Requirement

- Best mode is not eliminated.
- Removed in certain situations (defense vs. infringement).
- Still a best mode requirement in the statute.
- Still preferable to provide best mode.
 - Could come up as an enablement issue.

Micro-Entity Fees

- Timing issue: fees must be implemented by USPTO.
- For individuals, very small entities, & other cases (e.g., universities).
- Provides a reduction of 75% compared to large entity fees.
- Requires a certification.

Fee Surcharge

- Fees are increased by 15% (rounded off).
- Implemented in the Electronic Filing System (EFS), which calculates the fee for you.

Third-Party Submissions & Post Grant Review

- Submit prior art before issuance (effective September 16, 2012).
- Post Grant Review allows a third party to submit prior art after issuance (effective September 16, 2012).
- Do searches for your patent applications, and searches against competitors.
- New Inter Partes Review (Sept. 16, 2012).

Miscellaneous

- Oaths & declarations (Sept. 16, 2012).
- Prioritized examination (expensive).
- Supplemental exam can be requested (Sept. 16, 2012).
- Patents for tax strategies are restricted.
- Eliminates deceptive intent as a factor (if a prior art document was not submitted).
- Virtual marking can be done.
- Paper filing is penalized.
- Derived patent procedures (March 16, 2013).

Contact Information

J. Scott Southworth

Attorney at Law

Framingham, Massachusetts

www.southworthpatent.com

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