U.S. Patent Law Reform
Summary of H.R. 1249, “Leahy-Smith America Invents Act”

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미국 특허법 개정

2011 년 9월 8일에 미국 상원을 찬성 89 반대 9로 압도적 찬성으로 통과한 개정된 특허법을 요약하였습니다. 오바마 대통령이 법안을 지지하고 곧 서명할 것이라고 발표하였기 때문에 9월 18일 까지는 서명을 할것으로 예상됩니다. 본 법안이 모두 37 sections 으로 되어 있지만 중요하다고 생각하는 sections 만 모아서 요약을 하였습니다. 법안 전체 또한 첨부하오니 참조하시기 바랍니다.

본 법안은 크게 두가지 측면에서 변경이 되었습니다. 첫번째는 경기 부양책으로 고용효과를 증대하는대 촛점을 두었습니다. 둘째는 국제사회와의 harmonization 을 위함입니다. 그 일환으로 오랜 숙원이었는던 선발명주의를 세계적인 추세인 선출원주의와 동등한 선발병자출원주의로 특허법을 개정하였습니다.

또한 법안에 따르면 정부 수수료가 서명후 10 일 이후부터 15% 인상이됩니다. 가능하면 수수료가 인상되기 이전에 출원할 것이 있으면 출원을 해서 수수료를 절감 할 수 있기를 바랍니다.

미국 특허법 개정에 대해서 또한 개정에 따른 특허 출원 및 소송에 대한 업무 전략 수립에 대해서 질문 및 상세한 교육이 필요하면 요청해주시기 바랍니다.

김재연 변호사 드림

Section 3. FIRST INVENTOR TO FILE

- **effective filing date**: “the actual filing date of the patent or the application for the patent containing a claim to the invention” or “the filing date of the earliest application for which the patent or application is entitled, as to such invention, to a right of priority under section 119, 365(a), or 365(b) or to the benefit of an earlier filing date under section 120, 121, or 365(c)”
- 선발명자출원 주의로 변경되었고, 선출원한 발명자가 발명의 우선권을 가지며 또한 외국에서의 선출원일도 인정함

Section 3. FIRST INVENTOR TO FILE

- NOVELTY; PRIOR ART.—A person shall be entitled to a patent unless—“(1) the claimed invention was patented, de scribed in a printed publication, or in public use, on sale, or otherwise available to the public before **the effective filing date** of the claimed invention; or“(2) the claimed invention was described in a patent issued under section 151, or in an application for patent published or deemed published under section 122(b), in which the patent or application, as the case may be, names another inventor and was effectively filed before **the effective filing date** of the claimed invention.”

Section 3. FIRST INVENTOR TO FILE

- Priority would be determined based on **effective filing date**
- Effective **18 months** from the enactment
- Exception: Grace Period: applicant's own disclosures within **1 year** before the effective filing date
- Patent Interferences would be abolished with transition provisions
- 선출원주의 실행은 18개월 이후에 실행이 되고, Grace Period 1년이 유지되며, 저촉 심사는 현재 진행중인 예외 사항을 제외하고는 폐지

Section 3. FIRST INVENTOR TO FILE

- **Derived Patents:**
- **Civil Action**: The owner of a **patent** may have relief by civil action against the owner of **another patent** that claims the same invention and has an earlier effective filing date. The action may be filed only before the end of the **1-year** period beginning on the date of the issuance of the first patent containing a claim . . .
- 선출원된 발명이 특허가 된 경우에 후출원한 발명자의 특허가 선특허와 비슷하고 선출원자가 발명을 후출원자로 부터 derive (도용) 했을 경우에 후출원자가 특허 발행후 1년안에 **소송을** 제기, 한국에서 무권리자가 특허를 가지고 있는 경우에 무효사유가 되는 것과 같은 개념

Section 3. FIRST INVENTOR TO FILE

- **Derivation proceeding** (section 135) in USPTO: **the Patent Trial and Appeal Board** shall determine whether an inventor named in the earlier application derived the claimed invention from an inventor named in the petitioner's application and, without authorization, the earlier application claiming such invention was filed. Any such petition may be filed only **within the 1-year period** beginning on the date of **the first publication** of a claim to an invention that is the same or substantially the same as the earlier application's claim to the invention
- 선출원중인 특허가 후출원중인 특허를 도용했을 경우에 특허 출원공고 후 1년 안에 derivation proceeding (무권리자 출원에 근거한 무효주장) 을 특허심판원에 제기할 수 있음

Section 4. INVENTOR'S OATH OR DECLARATION

- A person to whom the inventor has **assigned** or is under an obligation to assign the invention may make an application for patent. (Assignee filing of application would be permitted)
- Effective **1 year** from enactment
- 현재는 발명가가 출원인이 되어야 하지만 변경된 법에 의하면 회사**도** 출원인이 되어 출원 할 수 있도록 허락함, 1 년후 시행

Section 6. POST GRANT REVIEW PROCEEDINGS

Chapter 31-"INTER PARTES REVIEW"

- A petitioner (a person who is not the owner of a patent) in an inter partes review may **request to cancel** as unpatentable 1 or more claims of a patent only on a ground that could be raised under **section 102 or 103** and only on the basis of prior art consisting of **patents or printed publications**
- A petition for inter partes review shall be filed **9 months after** the grant of a patent or issuance of a reissue of a patent
- The Inter Partes Reexamination Proceeding would be abolished and replaced by this Inter Partes Review Proceeding, and **Ex Parte Reexamination proceeding will continue**
- 현재는 ex parte 와 inter partes reexamination (유효성 재심사)를 통해서 특허 무효 신청을 할수 있는데 변경된 법에 의해서 inter partes 재심사는 폐지가 되고 inter partes review 제도를 신설함. 심판원에서 결정을 하고 특허등록후 9개월 이후에 무효심판 (inter partes review)신청 가능

Section 6. POST GRANT REVIEW PROCEEDINGS

Chapter 31-“INTER PARTES REVIEW”

- THRESHOLD.—The Director may not authorize an inter partes review to be instituted unless the Director determines that the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is **a reasonable likelihood that the petitioner would prevail** with respect to at least 1 of the claims challenged in the petition.
- This threshold is changed from the current “**substantial new question of patentability standard**” in reexamination.
- 무효심판 신청을 허여하는 기준이 약간 변경이 되었음. 현재 inter partes 재심사 허여율 상당히 높기 때문에 약간 기준을 강화한 것으로 판단됨

Section 6. POST GRANT REVIEW PROCEEDINGS

Chapter 31-"INTER PARTES REVIEW"

- An inter partes review may **not be** instituted if, before the date on which the petition for such a review is filed, the petitioner or real party in interest **filed a civil action challenging the validity** of a claim of the patent; A **counterclaim** challenging the validity of a claim of a patent **does not** constitute a civil action challenging the validity of a claim of a patent for purposes of this subsection
- 법원에 특허무효소송 (침해소송을 당한 침해자가 무효소송으로 반대소송을 제기하는 것은 포함 안됨) 을 제기를 했을 경우에는 특허청에 무효심판을 제기할수 없음. 또한, 특허청에 무효심판을 제기한후에 법원에 무효소송을 제기할 경우에는 법원소송은 자동으로 유예가 됨. 그러나, 특허 권자가 법원에 유예를 취소해달라고 청원하거나, 침해소송을 재기하면 자동유예가 안됨

Section 6. POST GRANT REVIEW PROCEEDINGS
Chapter 31-“INTER PARTES REVIEW”

- Setting forth standards and procedures for **discovery** of relevant evidence
- Providing for **protective orders**
- Providing either party with the right to **an oral hearing**
- Final determination be issued not later than **1 year**, except that the Director may, for good cause shown, extend the 1 year period by not more than 6 months: at most 1 and ½ years
- May **not enlarge** the scope of the claims (same as reexamination)
- Effective 1 year from enactment
- 무효심판의 결론을 1 년안에 신속하게 낼수 있도록 했음. 법원에서 특허청의 결론을 참조하도록 심판기간을 짧게 함. 현재 inter partes 는 2-3년정도 소요되고 심사관과의 면담이 불가능하지만, 무효심판에서는 소송과 비슷하게 oral hearing, 증거조사등의 제도를 도입함, 현재 inter partes 처럼 청구항 범위를 넓게 할 수 없음, 1년후 시행됨, 기업이 침해소송을 당할 경우에 소송을 당한 당사자가 무효심판을 제기하기 위한 제도

Section 6. POST GRANT REVIEW PROCEEDINGS

Chapter 32-"POST-GRANT REVIEW"

- a person who is **not the owner** of a patent may file with the Office a petition to institute a post-grant review of the patent and request **to cancel as unpatentable 1 or more claims** of a patent on **any ground (all grounds of invalidity considered)** that could be raised under paragraph (2) or (3) of section 282(b) (relating to invalidity of the patent or any claim)
- Filed **not later than** the date that is **9 months** after the date of the grant of the patent
- Threshold: it is **more likely than not that at least 1 of the claims challenged in the petition is unpatentable**
- Providing **either party with the right to an oral hearing**
- **제 3자가** 특허가 허여된후 **9개월 이내에** Post Grant Review를 신청할수 있음. 이전 특허 및 발간물 뿐만 아니라 무효사유가 되는 다른 모든 증거들도 제출가능, Inter Partes Review에서는 이전 특허와 발간물만 가능, 제 3자 oral hearing 가능, 기업에서는 특허청 특허공보를 모니터링 해서 소송 가능성이 있는 특허를 미리 찾아내어 POST GRANT REVIEW를 신청할 필요성이 증대됨.

Section 8. PREISSUANCE SUBMISSION BY THIRD PARTIES

- **Any third party** may submit for consideration and inclusion in the record of a patent application, **any patent, published patent application, or other printed publication of potential relevance** to the examination of the application, if such submission is made in writing before the earlier of— '(A) the date a notice of allowance under section 151 is given or mailed in the application for patent; or "(B) the later of—"(i) 6 months after the date on which the application for patent is first published under section 122 by the Office, or "(ii) the date of the first rejection under section 132 of any claim by the examiner during the examination of the application for patent.
- The submission shall set forth **a concise description of the asserted relevance** of each document
- Effective **1 year** from enactment
- 현재는 제 3자가 심사중에 있는 출원에대해서 정보제공을 10개의 자료에 한해서 IDS를 제출하고, 상세한 관련성 설명은 할 수없게 되어 있는 것을 제 3자가 문헌을 제출하고 (제출문헌수는 제한이 없는 것 같음) 또한 종래기술을 분석한 설명을 함께 반드시 제출하도록 변경함. 기업이 소송과 연관된 특허 출원 진행 중인 (예를 들면, 원출원된 특허가 침해소송에 있고, continuation이나 divisional 특허 출원이 진행되고 있을 경우) 발명이 특허가 허여 되지 못하도록 정보 제공를 하는데 이용가치가 있음

Section 10. FEE SETTING AUTHORITY

- **15% surcharge** on the government fees, effective **10 days** after the day of enactment
- Small Entity: 50% deduction
- **Micro Entity (certain individuals, entities, and institutions of higher education)**: 75% deduction
- **Prioritized Examination** Fee: $4,800 (prioritized examination of a nonprovisional application for an original utility or plant patent; limited to 10,000 requests per fiscal year)
- 법 실행후 10일 이후 정부 수수료 15% 인상, 대학등 micro entity는 75% 할인, 우선심사제도를 위해서는 $4,800 별도의 정부 수수료 요구됨

Section 12. SUPPLEMENTAL EXAMINATION

- A **patent owner** may request **supplemental examination** of a patent in the Office **to consider, reconsider, or correct information believed to be relevant** to the patent.
- This is a **new** proceeding and will be like an Ex Parte Reexamination requested by the patent owner.
- If **a substantial new question of patentability** is raised by the information in the request, the **reexamination of the patent** shall be ordered.
- A patent shall **not be held** unenforceable on the basis of conduct relating to information that had not been considered, was inadequately considered, or was incorrect in a prior examination of the patent if the information was considered, reconsidered, or corrected during a supplemental examination of the patent (Unenforceability based on inequitable conduct can be avoided by the supplemental examination)
- 새롭게 신설된 제도중의 하나로써 특허권자가 supplemental examination (보정심사)를 요청할 수 있음. 목적은 심사과정중에 알고도 제출하지 못한 이전 기술 정보를 (의도적으로 정보를 제출하지 않을 경우 특허 활용을 못할 수도 있음) 특허 허여를 받았지만 제출하면서 보정심사를 요청할수 있게함.

Section 15. BEST MODE REQUIREMENT

- 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
- Effective upon enactment
- Best mode requirement would be maintained during the examination of the application
- Best Mode requirement 는 소송에서 방어용으로 사용할수 없도록 명기했으나 출원시에는 현재처럼 명세서에 best mode가 설명이 되어 있어야 함

Section 18. TRANSITIONAL PROGRAM FOR COVERED BUSINESS METHOD PATENTS

- Not later than the date that is 1 year after the date of the enactment of this Act, the Director shall issue regulations establishing and implementing **a transitional post-grant review proceeding for review of the validity of covered business method patents**.
- the term "**covered business method patent**" means a patent that claims a method or corresponding apparatus for performing data processing or other operations used in the practice, administration, or management of a financial product or service, except that the term does not include patents for technological inventions.
- A person **may not** file a petition for a transitional proceeding with respect to a covered business method patent **unless the person or the person's real party in interest or privy has been sued for infringement of the patent** or has been charged with infringement under that patent.
- Effective **1-year** from enactment
- 미국에서는 영업비밀에 대한 특허를 허용을 하고 있지만 쉽게 특허를 받지 못하도록 여러 제한들이 있는데, 위의 정의에 해당하는 영업비밀에 관해서 post-grant review proceeding 에 대한 별도의 규정을 만들도록 하고 있음

Section 23. SATELLITE OFFICES

- the Director shall, by not later than the date that is **3 years** after the date of the enactment of this Act, establish **3 or more satellite offices** in the United States to carry out the responsibilities of the Office
- 3년이내에 3개이상의 분청을 만들도록 하고 있음 (첫 분청은 디트로이트에 두로록 명기함)

Section 34. STUDY OF PATENT LITIGATION

- The Comptroller General of the United States shall conduct a study of the consequences of litigation by **non-practicing entities, or by patent assertion entities,** related to patent claims made under title 35, United States Code, and regulations authorized by that title.
- recommendations for any **changes to laws and regulations that will minimize any negative impact of patent litigation** that was the subject of such study.
- 한국에서는 특허 괴물로 알려져 있는 non-practicing entity 에대해서 미국 국회가 특허청에게 부정적인 측면에 대해서 연구를 하도록 하고 부정적인 측면을 최소하는 법을 제정하려고 하는 의도임

감사합니다.

The End

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