



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

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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)”

Section 3. FIRST INVENTOR TO FILE

- NOVELTY; PRIOR ART.—A person shall be entitled to a patent unless—“(1) the claimed invention was patented, described 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

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 . . .

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

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

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**

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.

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

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

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

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

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)

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)

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

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

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

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.



Thank You!

U.S. PATENT AND TRADEMARK OFFICE

The End

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