

IEEE

*Leahy Smith America Invents Act,
Public Law 112-29*

Patent Practice Transitions

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October 22, 2011
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Effective Dates and Practice Changes

Preparation to deal with the Leahy Smith America Invents Act, Public Law 112-29, requires prioritization based upon what's most important and, particularly, what's most important in the near and mid-range future:

Effective Dates and Practice Changes

Prepare now for the September 16, 2012 *Procedural Laws*: Many of the most important procedures become available, some *retroactively effective for all pending applications and/or patents*, as from September 16, 2012.

Effective Dates and Practice Changes

- **Substantive Changes Six Months Later:**
The *substantive law* takes center stage on March 16, 2013 when SEC. 3 becomes effective.
- SEC. 3 deals with both first-to-file and various broadenings of the definition prior art.

Effective Dates and Practice Changes

- Some of the procedures will take months of preparation as part of rulemaking that must be finalized by the September 16, 2012, kickoff date.
- It will also take much of this year to understand the nuances of the new law to effectively utilize the new techniques, particularly the “IPR” weapon.

Effective Dates and Practice Changes

- The most effective way to be truly prepared and know the ins and outs of the procedure is to be totally involved with the rulemaking process that the Patent Office has made wide open and transparent to the public. To gain access to the new regime and the rulemaking process have a special page on the website of the U.S. PTO. *See New Law – Patent Office Website, slide 21.*

“First to File” March 16, 2013

- First to file becomes a reality on March 16, 2013, for all applications filed on or after that date *except* for applications where *all claims* are *substantively* entitled to an earlier priority date.
- One claim not awarded priority “poisons” the entire application forever, even if poisoned claim is cancelled and even if continuation is filed without the poisoned claim.

“First to File” March 16, 2013

- The transition will be *relatively* easy for pharma and other industries and companies which have long operated under the global first-to-file reality.
- Overseas-based businesses already operate under first-to-file and will have less of a challenge to meet the new law.

“First to File” March 16, 2013

- The transition will be most difficult for domestic concerns which have not had to deal with foreign patenting.
- Such entities must restructure their invention disclosure and priority filing systems to permit the smoothest possible adaptation to first-to-file.
- For companies which have not converted to first-to-file it will take every minute of the next seventeen months before the effective date to create a smoothly operating first-to-file system.

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Expanded Prior Art

The new prior art definition is effective concurrently with first-to-file on March 16, 2013: The lobbying forces for the majority of industry behind the new law were somewhat successful in strengthening the positions of infringement defendants which includes a broadening of the scope of prior art.

Expanded Prior Art

- A United States patent based upon a foreign priority application now has a retroactive patent-defeating effect for both novelty and obviousness as of the foreign priority filing date.

Expanded Prior Art

- “On sale” and “public use” *anywhere in the world* is now prior art.
- It is unclear whether “a secret” commercialization under *Metallizing Engineering* is or is not prior art under the new law.
- It is unclear whether there is or is not a grace period for the inventor’s own “on sale” or “public use” activities

Avoiding First-to-file in 2012

- The new “first to file” regime takes effect March 16, 2013:
- Applications with a priority date starting from May 16, 2012, may be impacted by the new law to the extent that the priority year will run past the effective date of the new law.

Avoiding First-to-file in 2012

- It is imperative that, where possible, ***all*** applications which are expected to be prosecuted to a conclusion should have an ***actual*** filing date not later than March 15, 2013.
- An “old law” date best assures that the application will fall under the current “first inventor” regime and otherwise avoid the broadened definition of prior art that is part of the SEC. 3 “first to file” provisions.

“Bubble” filings in March 2013

- **Be Prepared for the Pre-First to File “Bubble” filings in March 2013:** A continuing application should be filed for all important inventions not later than March 15, 2013, as a safeguard to provide an application that falls under the old law.
- The original application may continue to be prosecuted, using the continuation as an insurance policy.

“Bubble” filings in March 2013

- If an application is filed by March 15, 2013, it falls under the current law. The new first-to-file law governs an application ***if any claim*** in an application filed after March 16, 2013, ***is not entitled to a pre-March 16 priority.***
- This is an incurable defect as the cancellation of such a claim does not destroy the new law status.
- Neither is it possible to avoid the new law by filing a continuing application that goes through a chain that includes a “poisoned” new application.

Inventorship (Avoiding PTO “Derivation”)

- Several interesting changes have been made to the law including eliminating “secret” prior art under § 102(f).
- Elimination of § 102(f) opens the door for the victim of derivation to take ownership of a wrongfully filed application.
- The statute legislatively overrules the controversial 1997 *OddzOn* case that made derivation part of the prior art for obviousness.

Inventorship (Avoiding PTO “Derivation”)

- “Derivation” proceedings replace patent interferences.
- A statutory definition of joint invention and joint inventorship may legislatively overrule the 1997 *Kimberly-Clark* case that held that joint inventorship requires “some quantum” of collaboration between the joint inventors.

New Law – Patent Office Website

- **Leahy-Smith America Invents Act Implementation,**

http://www.uspto.gov/aia_implementation/index.jsp

- **Public Testimony on Implementation:**

Comments on Leahy-Smith America Invents Act Implementation,

http://www.uspto.gov/patents/law/comments/aia_implementation.jsp

Acknowledgment

Pavan Agarwal, Hon. Sharon Barner, Courtenay Brinckerhoff, Andrew Cheslock, Paul Hunter, Antoinette Konski, Stephen Maebius, Shoichi Okuyama, Liane Petersen, Kristel Schorr, Lauren Stevens, Lorna Tanner, Hon. Robert Stoll and Jackie Wright-Bonilla have each made presentations on the new law, presenting views that have helped shape the writer's understanding of the new law and practice



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The views expressed in this presentation are those of the author and do not necessarily reflect the views of any colleague, organization or client thereof.

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