

**Patent Law Reform-
America Invents Act**

**DOE Patent Attorney Conference
September 13, 2011**

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H.R. 1249 Significant Changes to U.S. Patent System

Short Title:

Leahy-Smith America Invents Act

Passed by the House June 23, 2011

Senate Adopts House Version (Sept. 6)

Approved September 8

Heads to President for Signature

Effective Date – 1 Year After Enactment *unless otherwise specified*

First Inventor to File

- **Transitions the U.S. to a first-inventor-to file patent system from a first-to-invent while maintaining a 1-year grace period for disclosures.**
 - **Each application receives an “effective filing date”**
 - **Patentability Judged on Availability of Prior Art Available Prior to that date.**
 - **Invention Must Still be New, Useful, and Within One of the Statutory Classifications**

First-Inventor to File (con't)

- **Can No Longer Swear Behind Prior Art**
- **Cannot Establish Priority in Interference**
- **“Derivation Proceeding”**
 - **Original Inventor Alleges a Patent Applicant Derived the Invention from the Inventor’s Work.**

“Effective Filing Date”

- **35 U.S.C. § 100 (definitions)**
- **(i)(1) effective filing date**
 - **Either the actual filing date or**
 - **Filing date of earliest application the patent or application is entitled.**

Effective Date of F-I-T-F

- **Section 3(n) of Act-**
- **Effective date is expiration of 18 month period after enactment, and will apply to any patent application that contains a claim that has an effective filing date (as defined in 35 USC 100(i)(1))**

More Definitions

- **35 U.S.C. § 100 will also include definitions for:**
- **“inventor” (§ 100(f))**
- **“joint inventor” (§ 100 (g))**
- **“joint research agreement” (§ 100(h))**
- **has relevance to § 102-conditions for patentability, determinations of common ownership, prior art.**

Inventor's Oath or Declaration

- **Provides for Assignee Filing When Inventor is Unable or Unwilling to Do So
---35 U.S.C. 115 (b)**
- **Will make it easier for Corporation to File a Substitute Inventor's Oath When the Inventor is Non-Cooperative**

Third-Party Challenges to Patent Rights

- **Three Expanded Ways that a 3rd Party Can Use the PTO to Challenge a Patent:**
 - Pre-Issuance Third-Party Submissions
 - Third-Party Requested Post Grant Review
 - *Inter Partes* Review Proceedings

- **Inventor Still Required to Set Forth Best Mode for Accomplishing Invention**
 - **But Failure to Do So Cannot be Used to Invalidate an Issued Patent**
 - **PTO Still has Duty to Only Issue Patents Where Best Mode Requirement is Met**

Funding Agreements

- **35 U.S.C. 202(c)(7)(E)(i)**
- **When royalty receipts exceed 5% of facility's annual budget**
- **Increases Share of Royalties retained by Universities under Bayh-Dole for Federally Funded Inventions to 85% (from current 25%)**
- **15% to Treasury (from current 75%)**

- **Obligations Under Bayh-Dole**
 - **Disclose to DOE Within 2 Months After Inventor Discloses to Contractor**
 - **Elect Within 2 Years After Disclosure**
 - **File Patent Application Within 1 Year of Election**

- **Waiting 2 Years from Disclosure to Elect Could Impact Patent Effort Because of Potential Intervening Prior Art Coming Into Play**
- **Increase in Provisional Filings?**

What Else?

- **15% Surcharge on all Patent Fees**
 - Effective 10 Days After Enactment
- **PTO will need to publish a number of Federal Register Notices**
 - Bill requires Final Rules within 60 days of enactment

References

- **USPTO.GOV**
 - http://www.uspto.gov/patents/init_events/aia_implementation.jsp
 - May send comments directly to:
 - aia_implementation@uspto.gov
 - Or, Just Google “America Invents Act”