Understanding The New Patent Law Changes

An Online Continuing Education Course for Engineers

Course Number: BS-3015

Credit: 3 Hours / 3 PDH / 3 CPD

UNDERSTANDING THE NEW PATENT LAW CHANGES

OVERVIEW OF THE LEAHY-SMITH AMERICA INVENTS ACT ON PATENTS: WHAT YOU NEED TO KNOW ABOUT WHAT HAS CHANGED AND WHAT REMAINS THE SAME

You have undoubtedly heard about the 2011 changes to the patent laws in the America Invents Act ("AIA"). But what does it all mean? How does it impact the way you handle your invention protection strategies? Will this make it harder or easier? Will it be more (or less) expensive? This course will focus on the most practical implications of the new laws and what you need to know to take the best advantage of the new patent system.

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In this seminar, we will explain:

- the implications of the change to a first-to-file system
- the increased importance of provisional patent applications and confidentiality agreements
- how to develop a provisional patent application that can withstand a challenge
- important exceptions to the first-to-file rule for inventor's own disclosures
- expansion of the on-sale and in-use patent bars
- understanding how prior art will be defined under the new laws
- changes in the Best Mode challenge to patent validity – no longer a way to invalidate your patent
- the New Oath and Declaration procedures that allow assignees such as employers to sign if the inventor is unavailable or uncooperative
- the new prohibition on issuance of patents claiming "a Human Organism" and "Tax Strategies"
- technology updates to business practices – New Virtual Patent Marking
- some good news for businesses – changes aimed at reducing patent troll activity and false marking claims
- Expedited Proceedings – for a small fee, you can buy your way to the front of the line!
- lower fee structure for micro entities – how to qualify for the savings
- how to take advantage of initiatives for assisting small businesses and independent inventors
- the new Derivation Proceedings – what to do if someone uses your technology to derive their own "invention"
- Third-Party Challenges – new opportunities during prosecution for preventing your competitors from getting patents for inventions that are not novel or are obvious
- how to ensure you have timely notice of patent publications so you can act in time
- how to perform a do-it-yourself search for patent publications
- when a Prior User Defense can be asserted in a patent infringement case
- how the new supplemental examination can "cure" potential inequitable conduct issues
- an introduction to post-grant review including ex parte re-examination, inter partes re-examination and inter partes review
- the scope of patent protection for future discoveries

Changes from "First-to-Invent" to "First-to-File" System

When patents are examined for patentability, the Patent Examiner studies the state-of-the-art technology that existed before the priority date of the invention. Things before that date can be cited (as a reference) against the invention in a rejection for "novelty" (Section 102) or "non-obviousness" (Section 103).

A typical rejection under current Section 102 is:

> *A person shall be entitled to a patent unless –*
>
> *(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.*
>
> *Claims 1, 7 and 13 are rejected under 35 USC 102(b) as being anticipated by [cited reference].*

A typical rejection under current Section 103 is:

> *A person shall be entitled to a patent unless –*
>
> *(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the difference between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. Patentability shall not be negative by the manner in which the invention was made.*

Claims 1, 7 and 13 are rejected under 35 USC 103(a) as being unpatentable over [cited reference] in view of [cited reference].

One of the most controversial changes is to convert the U.S. pat… …w system from a "**first-to-invent**" priority system to a "**fi**… …der current U.S. patent law, the d… …l on whether the refe… …the new patent laws… …is prior art will inste… …date" (not the inven… …novel if it is descri… …inventor and was fil…

There i… …applications "by the … …r disclosed directly … …s creates a "first to … …mind that publishin… …new law, for one y… …ainst you. These sa… …nd in the race to th… …archers a year aft… …er cost "provisionc… …the decision is made whe… …full-blown (or non-provisional) patent, and it gives … …time to search for an investor willing to pay patenting costs. However, this safe harbor does not help outside U.S. borders, since most foreign patent offices do not give inventors the one-year grace period. Notably, Japan may be expanding its grace period in this regard. It will be interesting to see if other countries follow suit.