



# America Invents Act: September 16, 2011

What Does the New Patent Act Mean for  
Universities?



# Effective Date

Some of these changes will take effect immediately, while others will go into effect 12 months or 18 months from the date of enactment, September 16, 2011.



# Most Significantly . . .

## Old Patent Law

- First-to-invent

- A first-to-file system will advance the race between companies, universities, and other entities toward filing their patent applications, thus universities must file right away, or risk losing their patent rights to an earlier filer.
- Under the new system, a later filer can still obtain a patent if they can prove an earlier filer derived the invention from the work of the later filer (this cannot be used, however, where the same invention was independently developed by 2 different parties).

## New America Invents Act

- First-to-file
- This eliminates the need for interference proceedings
- Will go into effect 18 months from date of enactment



# Statutory Invention Registration (SIR)

- Under the old Patent Act, SIR was a publication of an invention by the USPTO, at the request of an inventor, applicant, or assignee.
  - Under the New America Invents Act, legislation repeals statutory invention registration
- This will not have an effect, as most patent applications are already published 18 months after being filed with the USPTO.



New procedures for challenging  
the patentability of a pending  
patent application or the validity of  
a newly issued patent . . .



# Pre-issuance Prior Art Submissions and Reexamination

## Old Patent Law

- There were no set procedures in place for dealing with this type of reexamination

## New America Invents Act

- Any third party can submit prior art for consideration during the pendency of a patent application
- Will go into effect 12 months from the date of enactment

## What Does this Mean for RPI?

- Another company or university can submit prior art during the pendency of a patent application; this could potentially tie up an application at the PTO.



# First Window, Post-Grant Challenges

In order for a technology to be patentable, it must be novel, non-obvious, useful, and meet the enablement requirement.

## Old Patent Law

- There were no time restraints in place on post-grant review procedures
- The time restraint on these issued patents allows a much smaller window for others to challenge validity of our patents.

## New America Invents Act

- For issued patents, third parties may petition the USPTO to institute a review of the validity of a patent up to one year after the patent issues.
- Parties wishing to file a petition must do so within 9 months of the issuance of that patent
- Will go into effect 12 months from the date of enactment



## *Inter Partes* Reexamination

*Inter partes* reexamination is a USPTO administrative proceeding to challenge the validity of patents that have already issued. In *inter partes* reexamination, a person challenges the patent by submitting a request to the Patent Office. The request must supply prior art references and make proposed rejections of the claims.

### Old Patent Law

- Any third-party requester at any time could file a request for *inter partes* reexamination by the PTO
- A petitioner had to show that there is a “substantial new question of patentability” to prevail

### New America Invents Act

- Once the window for post-grant patentability review has expired, a party can file for *inter partes* review
- A party filing must show a “reasonable likelihood that the petitioner would prevail against one or more claims of the patent,” under 35 USC § 102 and § 103
- Will go into effect 12 months from the date of enactment



# Supplemental Examination

## Old Patent Law

- “Any person at any time may file a request for reexamination by the Office of any claim of a patent on the basis of any prior art cited under the provisions of . . . this title.”
- “Within three months following the filing of a request for reexamination under the provisions of . . . this title, the Director will determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request, with or without consideration of other patents or printed publications.”
- There were no specific supplemental examination procedures outlined in the former Patent Laws.

## New America Invents Act (adds § 257)

- A patent owner may request the supplemental examination of an issued patent by the Patent Office to consider or correct information believed to be relevant to the patent.
- The USPTO will have 3 months to conclude whether the information raises a substantial new question of patentability that would warrant reexamination.
- Will go into effect 12 months from the date of enactment
- The implementation of this supplemental examination will have negative affects on RPI; however, if other patent owners request examination of our patents, we can do the same to them, so patent holders should be cautious in using this procedure.



# Defenses to Infringement

## Old Patent Act (35 USC § 282 (3))

- Failure to disclose the best mode was a defense that could be asserted for patent infringement
- “The following shall be defenses in any action involving the validity or infringement of a patent and shall be pleaded: (3) Invalidity of the patent or any claim in suit for failure to comply with any requirement of **sections 112** or 251 of this title”

## New America Invents Act (change to § 282 (3))

- Asserting that a patentee failed to disclose the best mode of the invention in the patent is no longer allowable as a defense to infringement
  - Effective upon date of enactment
- This may help RPI, as using improvements to an invention where the patentee did not disclose the best mode, will not automatically lead to infringement against RPI.  
(Infringement will be harder to show if the patentee does not disclose their best mode)



# Prior Use Rights

## Old Patent Law

- Prior users could assert the 'prior use defense' when accused of infringing a method patent.
- This defense could only be asserted for a method patent.
- Most likely, this defense will not be used against RPI, as they fall under the 'university exception.'

## New America Invents Act

- Allows the 'prior use defense' as a defense to infringement on all patents
- University Exception: This defense cannot be asserted against inventions owned by, or assigned to universities.
- Effective upon date of enactment



# Change to the Definition of Prior Art

- Under the America Invents Act, “a person shall be entitled to a patent unless 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.”
- This addition of language may well expand the types of prior art that can be put forth to prevent a patent from issuing.