

IP NEWS QUARTERLY

IP Attorneys Group, LLC

Winter 2013

America Invents Act — The United States Becomes A First To File Patent System.

With the America Invents Act (AIA), the US joins the world trend of awarding patent rights to the inventor who files first for protection of an invention, rather than the inventor who first invents the invention. This is known as a “first to file” system, and it will take effect on March 16, 2013. Under the new system, inventors may have an incentive to file earlier rather than later, as opposed to the old “first to invent” system which promoted delaying filing to postpone the commencement of the term of patent protection. The present system will continue to apply to any patent application wherein at least one claim was filed before March 16, 2013.

*“An
Act...”*

Prior Art under the AIA

Under the AIA, it appears that publication may now constitute patent frustrating prior art which will give the publishing inventor priority over all other competing inventors. This would make publication more significant than under the present system where publication creates a one year window within which all competing patent applications must be filed. To be prior art under the AIA, there must be *public* use or *public* availability as opposed to under the present system where *any* use or availability constitutes prior art. Ultimately, the definition of prior art will evolve through litigation in the coming years.

Please contact this office should you have any questions regarding the America Invents Act.

In this issue:

America Invents Act (AIA). 1
AIA continued. 2

Did you know?

- George Washington signed the first U.S. patent act into law on April 10, 1790.
- The act placed responsibility for issuing patents with a three member board consisting of the Secretary of State, the Secretary of war, and the Attorney General.
- Only three patents were issued that year.

America Invents Act continued...

Derivation Proceedings

Under the AIA, patent rights are awarded to the inventor who files first, which in turn makes the filing date more important than the date of invention. Accordingly, interference proceedings are abolished. Nonetheless, derivation proceedings are still available if the inventor of an earlier filed patent application "derived" the invention from the inventor of a later filed patent application.

Under the AIA, a derivation may only be filed against an inventor who actually derived the invention from the challenger, so a truly independent inventor who files first will not be susceptible to a derivation claim. The time

limit for filing a derivation proceeding is one year after 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."

Prior Commercial Use Defense

In some cases an entity that has been using an invention commercially before it is patented by another entity may continue to use the invention without infringing. However, the defense only applies if the entity was using the invention commercially at least one year before the patent application filing date. Additionally, the entity may not expand use of the invention beyond the use which existed prior to filing.

Prioritized Examination

In order to make the patenting process more flexible, the AIA creates a procedure for prioritized examination. An applicant desirous of prioritized examination must submit an additional \$4,800 in order to have his patent application examined ahead of other applications.

However, in order to be eligible for prioritized examination, the patent application cannot have more than 4 independent claims and 30 claims in total.

Please contact this office should you have any questions regarding the America Invents Act.

Learn more about us at www.ipattorneysgroup.com

IP Attorneys Group, LLC

Patents—Trademarks—Copyrights

16 Oxford Road, 2nd Floor

Milford, CT 06460

Tel: 203 298 4830

Fax: 203 298 4832

E-mail: info@ipattorneysgroup.com