America Invents Act
What does it mean for you?
Outline

• When is something patentable?
  – Under “first-to-invent”
  – Under “first-to-file”

• What do the changes mean for you?

• What do you need to (if anything) before March 16, 2013?

• How should you approach IP protection following March 16, 2013?
When is something patentable?
Statutory requirements for patentability

• Patentability requires:
    “Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor.”
  – Novelty (35 U.S.C. § 102): The invention cannot have previously been described or otherwise disclosed in the prior art.
    “A patent may not be obtained though the invention is not identically disclosed or described ... [in the prior art art], if the differences 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 said subject matter pertains.”

• Patentability hinges on the definition of “the prior art”. On March 16, 2013, that definition will change.
An overview of “first-to-invent”

- The current U.S. Patent System is a “first-to-invent” system.
- The definition of prior art seeks to grant patent rights to the first person or group of people that conceive of the invention.
- Prior art is defined relative to the date of invention instead of filing date of patent.
- No patent applications filed after your invention date can be considered.
- If the date of invention is more than a year earlier than your filing date, then some publications and products that are after your date of invention may be considered – but nothing less than a year prior to your filing date.
Benefits of “first-to-invent”

• Benefits of “first-to-invent”:
  – Less time pressure: Race to patent office is less important;
  – Deferred cost: Patent filing costs can be deferred while working in “stealth mode”; and
  – Less waste: Inventors can wait until a system is mature/less speculative before filing.

• Biggest concern is public disclosure.
  – Stanford typically addresses by filing a provisional application immediately prior to disclosure.
An overview of “first-to-file”

- On March 16, 2013, the U.S. Patent System will change from “first-to-invent” to “first-to-file”.

- Definition of prior art will change so that prior art will be defined relative to the filing date of the patent and not the date of invention:
  
  “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.”

- Limited exceptions.
  
  - When inventor(s) publicly disclose an invention and a patent application is filed within one year of the public disclosure, then the inventor(s) own public disclosure will not be considered prior art.
  
  - In addition, actions by third parties that occur between the inventor(s) disclosure and the filing date will not be considered prior art.
  
  - A publication effectively becomes like a provisional filing in that you have one year from the publication to file a full patent application.
  
  - Note that by publishing before filing all international patent rights are lost.
Benefits of “First-to-File”

• Simplifies examination and litigation.
• Brings the United States into alignment with international patent systems (furthering patent harmonization).
• In short, there is nothing in it for you.
Are these changes relevant to me?
What does this really mean?

First-to-Invent:
Research group secures patent rights to A, B & C.
First-to-File: Research group loses patent rights to A, B & C.
What can we do to avoid losing rights?

Filing a provisional before March 16, 2013 can prevent loss of rights due to transition to first-to-file.
We already have a provisional application on file so we are fine, right?

First-to-File: Research group secures patent rights to A, but loses rights to B & C.
We already have a provisional application on file so we are fine, right? (cont.)

First-to-File: Research group loses rights to A, B & C.
What can we do before March 16\textsuperscript{th} to avoid losing rights?

Filing a more complete provisional prior to March 16\textsuperscript{th} “saved” the application.
What NOT to do before March 16, 2013

• File large numbers of speculative and/or incomplete provisional applications.
• Low value IP before March 16, 2013 will still be low value IP after March 16, 2013.
• Filing applications where the technology is not “fully-baked” may run into other problems associated with enablement.
• **SUMMARY:** Take actions with respect to technologies that are ready to be protected and that you would have protected anyway.
Life after March 16, 2013
How to file under “first-to-file”

First-to-File Filing Strategy: File early, often and as completely as possible.
Myths About New First-to-File System

- Circulating Myth: A publication is the same as filing a provisional application.
- They are not the same. Filing a provisional application preserves U.S. and International patent rights. Publishing will automatically result in a loss of International patent rights.
- The University likely will not take on the risk of pursuing a patent application where prior publication has occurred.
Executing your IP strategy
Summary

• Before March 16, 2013
  – Convert applications; or
  – File more complete provisional applications.
  – Only take actions with respect to technologies that are ready to be protected and that you would have protected anyway.

• After March 16, 2013
  – File early, often, and as completely as possible; and
  – File two separate filings when adding disclosure to a pre-March 16 provisional application (one identical to provisional, one containing additional disclosure).
David Bailey
Eugene Chong
John Peck, Ph.D.
info@kppb.com