



MBHB *snippets* Alert

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AIA Rules Going Into Effect September 16, 2012

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As we approach the one-year anniversary of the enactment of the America Invents Act (AIA), we highlight below several important provisions that will take effect as of September 16, 2012.

- **Patent Trial and Appeal Board:** The Board of Patent Appeals and Interferences is replaced with the Patent Trial and Appeal Board with duties including: (1) reviewing adverse decisions of examiners pursuant to section 134(a), (2) reviewing appeals of reexaminations pursuant to section 134(b), (3) conducting derivation proceedings pursuant to section 135, and (4) conducting inter partes reviews and post-grant reviews pursuant to chapters 31 and 32.^{1*}
- **Inter Partes Review:** *Inter Partes* Reexamination is replaced by *inter partes* review. The Patent Trial and Appeals Board will conduct the review only after it is determined that there is a reasonable likelihood that the challenger will prevail with respect to at least one claim. *Inter partes* reviews may only be instituted on a date that is later than either (i) nine months after the patent's issue date, or (ii) the termination of a post-grant review proceeding (if one was initiated).^{2†}
- **Post-Grant Review Proceedings:** Third parties may now institute post-grant reviews of a patent. Third parties must file a request to institute a post-grant review before the expiration of nine-months from issuance of the patent. In order for a post-grant review to be initiated, the request must include information that – if not rebutted – demonstrates that it is more likely than not that at least one of the challenged claims is unpatentable. Such information may incorporate invalidity arguments on grounds including: unpatentable subject matter, anticipation (including the on-sale bar and public use), obviousness, written description, or enablement.^{3*}

- ***Transitional Program for Covered Business Method Patents:*** The Director must issue regulations establishing and implementing a transitional post-grant review proceeding for challenging the validity of claims of a business method patent.^{4†}
- ***Supplemental Examination:*** A patent owner may now request supplemental examination of a patent in view of information presented by the owner. If the Director determines that such information raises a substantial new question of patentability, the Director shall order the reexamination of that patent. Supplemental examination will prevent later-filed claims of invalidity on inequitable conduct grounds arising out of the owner's failure to submit the information during prosecution.^{5†}
- ***Citation of Written Statements:*** Any person may now cite to the Office for inclusion into the record patent statements of the patent owner filed in a proceeding before a Federal court or the Office in which the patent owner took a position on the scope of any claim of a particular patent.^{6†}
- ***Preissuance Submission by Third Parties:*** Third parties may now submit printed publications for consideration and inclusion into the record of any patent application.^{7†}
- ***Non-Obvious Subject Matter:*** Removes the provision stating that when a claim to a composition of matter that is held invalid and was the basis of a determination of nonobviousness under section 103(b)(1), the process shall no longer be considered nonobvious solely on the basis of section 103 (b)(1).^{8*}
- ***Inventor's Oath or Declaration:***
 - o The inventor's oath or declaration must now contain statements that (1) the application was made or was authorized to be made by the affiant or declarant, and (2) such individual believes himself or herself to be the original inventor or an original joint inventor of a claimed invention in the application, and (3) any additional information relating to the inventor and the invention that the Director may specify is required.^{9*}
 - o The Director is no longer permitted to "dispense with signing and execution by the inventor" for divisional applications.^{10*}
 - o Applications may now be filed by assignees when inventors are under an obligation to or have already assigned the invention. In addition, others who

show a sufficient proprietary interest can file an application on behalf of inventors. Patents granted on applications filed in such a manner will be granted to the real party in interest.^{11*}

- **Lack of Deceptive Intent:** The lack of deceptive intent is no longer required for
 - o correction of inventorship of an application or patent.^{12*}
 - o the retroactive grant of a foreign filing license when an application is filed abroad through error and does not disclose an invention within the scope of section 181 (applications subject to secrecy orders);^{13*}
 - o initiation of a reissue application;^{14*} or
 - o sustaining the validity of the remaining claims in a patent for which some claims are rendered invalid.^{15*}
- **Advice of Counsel:** The failure of an infringer to obtain the advice of counsel with respect to any allegedly infringed patent, or the failure of the infringer to present such advice to the court or jury, may not be used to prove that the accused infringer willfully infringed the patent or that the infringer intended to induce infringement of the patent.^{16*}
- **Priority Examination for Important Technologies:** The Office may now provide for the prioritization of examination of applications that are for products, processes, or technologies important to the national economy or national competitiveness.^{17*}

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¹ 35 U.S.C. §6.

² 35 U.S.C. §§311-19.

³ 35 U.S.C. §§321-29.

⁴ 35 U.S.C. Section 18.

⁵ 35 U.S.C. § 257.

⁶ 35 U.S.C. §301.

⁷ 35 U.S.C. §122(e).

⁸ 35 U.S.C. §282.

⁹ 35 U.S.C. §115.

¹⁰ 35 U.S.C. § 121.

¹¹ 35 U.S.C. § 118.

¹² 35 U.S.C. §§ 116, 256.

¹³ 35 U.S.C. §184-85.

¹⁴ 35 U.S.C. §251.

¹⁵ 35 U.S.C. §§ 253, 288.

¹⁶ 35 U.S.C. §298.

¹⁷ 35 U.S.C. §2(b)(2).

* Not retroactive to patents issued before, applications filed before, or proceedings commenced before (as the case may be) September 16, 2012.

† Retroactive to patents issued before, applications filed before, or proceedings commenced before (as the case may be) September 16, 2012.