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Business Method Patents and September 16, 2012

On September 16, 2012, the USPTO will begin implementing a new procedure for post-grant review of business method patents. The new procedure is a result of the Leahy-Smith America Invents Act (AIA) and is referred to as the Transitional Program for Covered Business Method Patents.¹ A party charged or sued with infringement of a “covered business method patent” can request the procedure from the USPTO. A “covered business method patent” is defined in the AIA as “a patent that claims a method or corresponding apparatus for performing data processing or other operations used in the practice, administration, or management of a financial product or service, except that the term does not include patents for technological inventions.”² Unlike other post-grant review procedures, the request can cite any grounds for invalidity, including patent eligibility under 35 U.S.C. § 101 and indefiniteness under 35 U.S.C. § 112. When considering prior art rejections for the procedure, the first-to-invent prior art rules and the first-to-file prior art rules should be considered. If the patent being reviewed under this post-grant review is involved in a patent infringement suit, a stay can be requested from the district court, and estoppel applies to the post-grant review requestor for any grounds raised during the post-grant review by the requestor. This new procedure is available until September 16, 2020.

¹ Pub. L. No. 112-29, 125 Stat. 284 (2011).

² *Id.* at 331.