

# Leahy-Smith America Invents Act: Overview

*This Note, contributed to [InhouseBlog](#) by [Practical Law Company](#), summarizes the key features of the Patent Reform Act of 2011, known as the Leahy-Smith America Invents Act (AIA). It provides an overview of the AIA's reforms to US patent law, including changing the patent system from a first-to-invent to a first-inventor-to-file system, the scope of prior art used to determine novelty and the procedures for challenging the validity of issued patents. The Note also provides an overview of provisions that expand the prior use defense to patent infringement, eliminate the best mode defense and the need to obtain an opinion of counsel to defend against a willful infringement claim, allow for virtual patent marking and change false patent marking law, create a new supplemental examination procedure to limit potential inequitable conduct claims and change US Patent and Trademark Office and patent litigation procedures.*

*Authored by PLC Intellectual Property & Technology*

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On September 16, 2011, President Obama signed into law the Leahy-Smith America Invents Act (AIA) ((Pub. L. No. 112-29 (2011)). The AIA reformed patent law by significantly changing various aspects of the Patent Act ([www.practicallaw.com/6-504-3807](http://www.practicallaw.com/6-504-3807)).

This Note summarizes key provisions of the AIA including:

- Changing the US to a first-inventor-to-file system, including changing the definition of prior art.
- Creating new procedures in the US Patent and Trademark Office ([www.practicallaw.com/9-383-7926](http://www.practicallaw.com/9-383-7926)) (USPTO) for a third party to challenge the validity of patents.
- Expanding the prior commercial use defense.
- Eliminating the failure to disclose the best mode as a defense.
- Eliminating the requirement to obtain advice of counsel to avoid liability as a willful infringer.
- Allowing patent marking via the internet.
- Eliminating qui tam false patent marking litigation.
- Changing certain procedures concerning patent litigation.
- Eliminating certain subject matter from eligibility for patent protection.
- Creating a new supplemental examination procedure that may limit some inequitable conduct claims.
- Changing certain USPTO procedures.

For a more detailed perspective on the implications of the AIA, please see [Expert Q&A on the Patent Reform Act of 2011](#) ([www.practicallaw.com/5-508-5015](http://www.practicallaw.com/5-508-5015)).

For a chart setting out the effective dates of the AIA's key provisions, please see [Leahy-Smith America Invents Act: Key Effective Dates Chart](#) ([www.practicallaw.com/3-508-1711](http://www.practicallaw.com/3-508-1711)).

## First-inventor-to-file Patent System

The AIA transitions the US from a first-to-invent patent system to a first-inventor-to-file system. The new system is similar to the first-to-file patent systems used in most non-US jurisdictions. AIA provisions relating to the first-inventor-to file system go into effect on March 16, 2013 and apply to patents and patent applications having an effective filing date on or after that date.

Under the first-to-invent system, if a conflict arises concerning the priority of pending patent applications or a recently issued patent and a pending patent application owned by different parties, an administrative, interference proceeding is conducted at the USPTO to determine who invented the invention first. Under the new system, the inventor who first files a patent application on the invention is awarded the patent on the invention, subject to certain limitations.

The key provisions of the AIA relating to the first-inventor-to-file system:

- Change the definition of prior art ([www.practicallaw.com/6-507-1490](http://www.practicallaw.com/6-507-1490)) used to determine the patentability and validity of an invention (see Scope of Prior Art) (35 U.S.C. § 102 (2011) and AIA § 3 (2011)).
- Eliminate interference proceedings to determine priority of inventorship for competing patent applications and instead create derivation proceedings (see Derivation Proceedings) (35 U.S.C. §§ 135, 146 and 291 (2011) and AIA § 3 (2011)).

### **Scope of Prior Art**

The AIA significantly changes and broadens the definition of prior art for patent applications filed on or after March 16, 2013. For these patent applications or patents issuing from these applications, prior art:

- Is based on information available or activity occurring before the effective filing date of the patent or patent application containing the claimed invention against which the prior art is to be applied (relevant patent) rather than before the invention date.
- Covers information and activity anywhere in the world. There is no longer any geographical limit to where prior art can be found.

### **Categories of Prior Art**

Specifically, the AIA establishes various categories of information or activity that prevent an inventor from obtaining a patent on an invention or that can be used to invalidate a patent. These are:

- The following events, if they occur before the effective filing date of the relevant patent:
  - patenting the claimed invention;
  - describing the claimed invention in a printed publication;
  - placing the claimed invention in public use;
  - placing the claimed invention on sale; or
  - otherwise making the claimed invention available to the public.
- Describing the claimed invention in an issued US patent or published US patent application that:
  - names another inventor; and

- was effectively filed before the effective filing date of the relevant patent.

The AIA eliminates prior invention as a category of prior art to move the US to a first-inventor-to file system (see First-inventor-to-file Patent System).

The AIA also limits prior art to information and activity occurring before the effective filing date of the relevant patent application rather than allowing the inventor to use the invention date (which may be earlier) as the baseline for certain prior art determinations. Under the AIA, the effective filing date is either:

- The actual filing date of the relevant patent, if the relevant patent is not entitled to an earlier filing date.
- The filing date of the earliest patent application on which the relevant patent is entitled to claim either:
  - foreign priority; or
  - the benefit of the earlier US filing date.

### **Statutory Exceptions to Prior Art**

The AIA excludes two types of disclosures from prior art. The AIA breaks up the exceptions by the type and timing of the disclosure, so that the following disclosures may not be prior art under certain conditions:

- Disclosures made one year or less before the effective filing date (see Disclosures Made One Year or Less Before the Effective Filing Date).
- Disclosures in published patent applications and patents (see Disclosures in Published Patent Applications and Patents).
- Disclosures Made One Year or Less Before the Effective Filing Date

For certain categories of prior art, the AIA eliminates the one-year grace period that allowed a patent applicant to engage in certain activities, such as sales and use activity, without forfeiting the right to obtain a patent on the invention. However, the AIA does provide a one-year period during which certain disclosures may be made without preventing the inventor from obtaining a patent on the subject matter of the disclosure. Under the AIA, a disclosure made one year or less before the effective filing date of the relevant patent is not prior art to the relevant patent if an inventor, or someone else who obtained the disclosed subject matter directly or indirectly from an inventor, either:

- Made the disclosure.
- Publicly disclosed the subject matter before the disclosure by some other party.
- Disclosures in Published Patent Applications and Patents

In addition, certain disclosures in an earlier patent or published patent application (earlier patent) are not prior art to a later patent or patent application (later patent) if any of the following apply:

- The subject matter disclosed in the earlier patent was directly or indirectly obtained from the inventor of the later patent.
- The inventor of the later patent, or someone else who obtained the subject matter of the later patent's disclosure directly or indirectly from the inventor, publicly disclosed the subject matter before the effective filing date of the earlier patent or patent application.
- The subject matter disclosed in the earlier patent and the later patent were (not later than the effective filing date of the later patent) owned by the same person or under an obligation of assignment to the same person.

### **Derivation Proceedings**

Before the AIA, disputes between two inventors over which of the two was the first inventor were determined by an interference proceeding in the USPTO. With the change to a first-inventor-to-file system, interference proceedings are eliminated as of March 16, 2013 for patents and patent applications having an effective filing date on or after that date. A new derivation proceeding allows a later applicant to challenge an earlier applicant if the earlier applicant derived the claimed invention from the later applicant.

Some of the key features of a derivation proceeding are that:

- The derivation proceeding must be instituted within one year of the first publication of the claimed invention.
- The Patent Trial and Appeal Board (PTAB), which replaces the Board of Patent Appeals and Interferences, makes the derivation determination and can:
  - refuse the issuance of claims in a pending patent application;
  - cancel claims if a patent has issued; and
  - correct the inventorship in an application.

The USPTO intends to issue new rules setting out standards for the conduct of derivation proceedings.

### **USPTO Procedures for Patent Challenges**

The AIA provides several new administrative ways for a party to challenge the validity of another's patent. These changes generally become effective on September 16, 2012.

#### **Post-grant Review**

The AIA creates the post-grant review, a new procedure to be conducted by the PTAB that allows a third party to challenge the validity of a recently issued patent. The post-grant review procedure goes into effect on September 16, 2012 and applies generally to patents having an effective filing date on or after March 16, 2013 (35 U.S.C. §§ 321 - 329 (2011) and AIA § 6 (2011)) This six month window will allow the USPTO time to issue rules for this new procedure before the first review is instituted.

*USPTO Procedure for Post-grant Review*

The party challenging the patent must file a petition with the USPTO to institute a post-grant review. The petition:

- Can be based on any grounds allowed under patent law to challenge a patent's validity.
- Must be filed no later than nine months after the patent issue or reissue date.
- Must show either that:
  - it is more likely than not that at least one claim is unpatentable; or
  - a novel or unsettled legal question exists that is important to other patents or patent applications.

A post-grant review must be completed within one year after the institution of the review, although a six month extension may be provided on a showing of good cause.

The USPTO intends to issue rules for conducting post-grant reviews, including rules for discovery and sanctions for abuse of discovery, protective orders, oral hearings and providing the petitioner with at least one opportunity to file written comments during the review.

#### *Related Litigation Issues*

Counsel should consider the following litigation issues concerning a post-grant review:

- Post-grant review is not allowed where the petitioner seeking post-grant review previously filed an action in court challenging the relevant patent's validity (a petitioner's counterclaim does not prevent the review).
- If the petitioner files an action challenging the relevant patent's validity (a petitioner's counterclaim does not prevent the review) on or after the date the petitioner files a petition for post-grant review, the action is stayed until the:
  - patent owner files a motion to lift the stay;
  - patent owner files an action or counterclaim alleging that the petitioner infringed the patent; or
  - petitioner files a motion to dismiss the action.

If a patent infringement action is filed within three months after patent issuance, the court may not stay its consideration of the patent owner's motion for a preliminary injunction on the basis of a post-grant review proceeding.

After a final post-grant review decision concerning a patent claim, the petitioner may not:

- request or maintain another USPTO proceeding concerning the patent claim on any ground that the petitioner raised or reasonably could have raised in the post-grant review; and
- assert in a civil action or International Trade Commission (ITC) proceeding that the patent claim is invalid on any ground that the petitioner raised or reasonably could have raised during the post-grant review.

Where an amended or new claim is determined to be patentable and is included in the patent undergoing post-grant review, any person who made, purchased, used in the US or imported into the US anything covered by the amended or new claim, or who made substantial preparation for those activities, is entitled to certain intervening rights to continue those activities under certain conditions. (35 U.S.C. § 252 (1999)).

### **Inter Partes Review**

The AIA eliminates the previous inter partes reexamination procedure and creates a new inter partes review proceeding. It shares some similarities with the post-grant review process (see *Post-grant Review*). However, an inter partes review proceeding can only be instituted based on narrower grounds and generally after the time period allowed for post-grant review.

The AIA provisions relating to inter partes review proceedings are effective as of September 16, 2012 and apply to any patent issued before, on or after that date. Until September 16, 2012, inter partes reexaminations may still be filed. However, they will only be instituted if the requestor shows that there is a reasonable likelihood that it would prevail on at least one of the challenged claims. ( 35 U.S.C. §§ 311 - 319 (2011) and AIA § 6 (2011)).

#### *USPTO Procedure for Inter Partes Review*

The party challenging the patent must file a petition with the USPTO to institute inter partes review. The petition:

- May only be brought on the ground that the claim is invalid as anticipated or obvious under Sections 102 or 103 of the Patent Act and based solely on prior art patents or printed publications.
- Must be filed after the later of:
  - nine months after the patent issue or reissue date; or
  - the date of termination of any post-grant review relating to the challenged patent.
- Must show a reasonable likelihood that the petitioner would prevail on at least one of the challenged claims.

The USPTO intends to issue rules for inter partes review, including rules relating to discovery, sanctions for abuse of discovery, protective orders, oral hearings and providing the petitioner with at least one opportunity to file written comments during the review.

An inter partes review must be completed within one year after its institution, although a six month extension may be provided on a showing of good cause.

#### *Related Litigation Issues*

Counsel should consider the following litigation issues concerning the new inter partes review proceeding:

- Inter partes review is not allowed if the petitioner seeking review previously filed a civil action challenging the relevant patent's validity (a petitioner's counterclaim does not prevent the review).
- If the petitioner files a civil action challenging the patent's validity (a petitioner's counterclaim does not prevent the review) on or after the date on which the petitioner files a petition for inter partes review, the action is automatically stayed until:
  - the patent owner moves the court to lift the stay;
  - the patent owner files an action or counterclaim alleging that the petitioner infringed the patent; or
  - the petitioner moves the court to dismiss the action.

Inter partes review may not be instituted if the petition is filed more than one year after the petitioner is sued for patent infringement.

After a final inter partes review decision concerning a patent claim, the petitioner may not:

- request or maintain another USPTO proceeding concerning the patent claim on any ground that the petitioner raised or reasonably could have raised in the inter partes review; or
- assert in a civil action or ITC proceeding that the patent claim is invalid on any ground that the petitioner raised or reasonably could have raised during the inter partes review.

Where an amended or new claim is determined to be patentable and is incorporated in the patent subjected to an inter partes review, any person who made, purchased, used in the US or imported into the US anything covered by the amended or new claim, or who made substantial preparation for those activities is entitled to certain intervening rights to continue those activities under certain conditions (35 U.S.C. § 252 (1999)).

### **Transitional Procedure For Business Method Patent Review**

The AIA creates a temporary administrative procedure for the review of business method patents where an owner of the business method patent has asserted an infringement claim against the petitioner seeking review. It takes effect on September 16, 2012 and expires on September 16, 2020. This temporary procedure will apply to business method patents issued before, on or after September 16, 2012 except for patents having an effective filing date on or after March 16, 2013 during the period in which a petition for post-grant review could be filed.

The USPTO intends to issue rules for establishing and implementing this transitional procedure. It will share many of the standards and procedures of the new post-grant review mechanism (see Post-grant Review) (AIA § 18 (2011)).

### **Third-party Submissions**

The AIA includes provisions that allow third parties to submit information to the USPTO that may be relevant to the patentability of pending applications or granted patents.

### *Pre-issuance Submission*

The AIA provides a pre-issuance submission procedure allowing a third party to submit certain potentially relevant information in writing for the USPTO to consider and include in the patent application file history. This submission must be made before the earlier of either:

- The date of a notice of allowance in the patent application.
- The later of:
  - six months after the publication date of the patent application; or
  - the date of the first office action rejecting any claim in the patent application.

The submission is limited to patents, patent applications and printed publications. It must also:

- Set out a concise description of the relevance of each submitted document.
- Include the appropriate fee.
- Include a statement by the person making the submission affirming that the submission was made in compliance with the requirements of the AIA section regarding pre-issuance submissions.

This provision is effective as of September 16, 2012 and will apply to any patent application filed before, on or after that date ( 35 U.S.C. § 122 (2011) and AIA § 8 (2011)).

### *Other Submissions*

Any person at any time may cite to the USPTO in writing any:

- Prior art consisting of patents or printed publications which that person believes to have a bearing on the patentability of any claim of a particular patent.
- Statements of the patent owner filed in a proceeding before a federal court or the USPTO in which the patent owner took a position on the scope of any claim of a particular patent. However, this statement can only be used to determine the proper meaning of that claim.

This provision is effective as of September 16, 2012 and will apply to any patent issued before, on or after that date. ( 35 U.S.C. § 301 (2011) and AIA § 6 (2011)).

## **Patent Infringement Defenses**

The AIA changes some of the defenses that are available to an alleged patent infringer by:

- Broadening the scope of the prior use defense (see Prior Commercial Use Defense).
- Eliminating the failure to disclose the best mode as a defense (see Best Mode Requirement).
- Eliminating the requirement to obtain advice of counsel to avoid liability as a willful infringer (see Advice of Counsel).

### **Prior Commercial Use Defense**

The AIA expands the prior use defense that is available to a party that first invents and uses, but does not patent, an invention accused of infringement by a second party that later makes the same invention and patented it.

The AIA provides a defense for the first party based on its earlier activities. Before the AIA, this "prior use" defense was limited to business method patents. The AIA expands this defense to include manufacturing processes and other subject matter relating to manufacturing and other commercial processes.

This change became effective on September 16, 2011 and applies to any patent issued on or after that date (35 U.S.C. § 273 (2011) and AIA § 5 (2011)).

#### *Elements of Prior Use Defense*

A person who used a process or a machine to manufacture or a composition of matter in a manufacturing or other commercial process (commercial use) has a defense against a claim of patent infringement concerning the person's commercial use in the US if it is either:

- An internal commercial use.
- An actual arm's length sale or other arm's length commercial transfer of a useful end result of the commercial use.

In addition, this activity must have occurred at least one year before the earlier of either:

- The claimed invention's effective filing date.
- The date the claimed invention was disclosed to the public in a manner that qualifies it for exception from prior art under the AIA (see Statutory Exceptions to Prior Art).

Commercial use under the AIA specifically includes uses:

- During a pre-marketing safety or efficacy regulatory review period.
- By a nonprofit research laboratory or other nonprofit entity, such as a university or hospital, for which the public is the intended beneficiary but only for continued and noncommercial use by and in the laboratory or other nonprofit entity.

#### *Limitations of the Defense*

The prior commercial use defense has the following limitations:

- It may be asserted only by either:
  - the entity that performed or directed the performance of the commercial use; or
  - an entity that controls, is controlled by or is under common control with that entity.
- It is only transferable to another party if it is part of a good-faith assignment or transfer of the entire enterprise or line of business to which the defense relates.

- It may only be asserted for sites where the commercial use that would otherwise infringe a claimed invention is in use before the later of either:
  - the effective filing date of the claimed invention; or
  - the date of assignment or transfer of the enterprise or line of business.
- It may not be used if the commercial use was derived from the patent holder or persons related to the patent holder.
- It is not a general license under all of the claims of the relevant patent but extends only to the alleged infringer's specific commercial use.
- A person who abandoned the commercial use may not rely on activities performed before the date of the abandonment in establishing the defense for actions taken on or after the date of the abandonment.
- It does not apply against patents owned by a university or related technology transfer organization, unless any of the activities required to reduce to practice the claimed invention could not have been undertaken using funds provided by the federal government.

### **Best Mode Requirement**

Under the AIA, an inventor must still set out in the patent application the best mode contemplated by the inventor of carrying out the invention. However, the AIA eliminates the failure to disclose the best mode as a basis for a third party to seek invalidation of a claim in the resulting patent.

This change became effective on September 16, 2011 and applies to any proceeding commenced on or after that date ( 35 U.S.C. § 282 (2011) and AIA § 15 (2011)).

### **Advice of Counsel**

The AIA specifies that an infringer's failure to obtain advice of counsel may not be used to prove willful infringement or inducement of infringement.

A finding of willful infringement may result in a trebling of damages and the award of attorneys' fees to the patent owner (see 35 U.S.C. §§ 284 - 285 and Practice Note, Patent Infringement Claims and Defenses: Enhanced Damages ([www.practicallaw.com/0-507-2685](http://www.practicallaw.com/0-507-2685))).

The AIA's new language codifies the development of a modified standard to prove willful infringement by the US Court of Appeals of the Federal Circuit ([www.practicallaw.com/9-507-0272](http://www.practicallaw.com/9-507-0272)) (Federal Circuit).

Until recently, a finding of willful infringement was typically based on evidence that the infringer failed to obtain advice from counsel that the infringer was free to engage in the infringing conduct because the conduct was not infringing or that the patent was invalid. However, the Federal Circuit has now ruled that willful infringement requires a showing of objective recklessness rather than the absence of advice from counsel. Under this standard, the patent holder must show by clear and convincing evidence ([www.practicallaw.com/3-501-6612](http://www.practicallaw.com/3-501-6612)) that the infringer both:

- Acted despite an objectively high likelihood that its actions constituted infringement of a valid patent.
- Knew or should have known about this objectively defined risk.

(See *In re Seagate Technology, LLC*, 497 F.3d 1360 (Fed. Cir. 2007).)

This change is effective on September 16, 2012 and will apply to any patent issued on or after that date (35 U.S.C. § 298 (2011) and AIA § 17 (2011)).

## Patent Marking

For a patent owner to recover damages for patent infringement, patented products must be marked with the patent numbers covering the product. The AIA modifies aspects of the marking requirement (see *Virtual Patent Marking*) and litigation based on claims of falsely marked products (see *False Patent Marking*).

### Virtual Patent Marking

The AIA permits "virtual patent marking." This allows a patent holder to meet the patent marking requirement by placing the word patent or the abbreviation pat. on the patented product with an internet address that both:

- Is free to the public.
- Associates the patented product with the relevant patent number or numbers.

By doing this the patent owner can provide updated patent number information and a current listing of the marked products at the internet address.

This change applies to any patent litigation that is pending on or commenced on or after September 16, 2011 (35 U.S.C. § 282 (2011) and AIA § 16 (2011)).

### False Patent Marking

The AIA places the following restrictions on false patent marking litigation:

- Only the US can sue for false patent marking to recover the statutory damages.
- Only a person who suffers a competitive injury from false marking may sue to recover its damages.

Marking a product with a patent that covers the product and that has since expired is not false marking.

These changes apply to any patent litigation that is pending on, or commenced on or after September 16, 2011 (35 U.S.C. § 292 (2011) and AIA § 16 (2011)).

Before the AIA, a party that marked a product with patent numbers that did not cover the product or expired patent numbers with the intent to deceive the public could be:

- Subject to statutory damages.
- Sued by any person for the statutory damages, with one-half of the damages going to the US and the other half retained by the party bringing suit.

## Litigation Procedure

### Venue

The AIA makes changes to venue in patent proceedings in certain cases.

#### *Actions Against the USPTO*

As the USPTO is based in Virginia, under the AIA, actions against the USPTO will now be heard in the US District Court for the Eastern District of Virginia because the USPTO is located in Virginia.

This change became effective on September 16, 2011 and applies to any action commenced on or after that date (15 U.S.C. § 1071(b)(4) (2011) and 35 U.S.C. §§ 32, 145, 146, 154(b)(4)(A) and 293 (2011) and AIA § 9 (2011)).

#### *Automated Teller Machines*

The AIA also limits the ability of a business method patent owner to establish venue in a patent infringement action based on the physical location of an automated teller machine. The AIA clarifies that an automated teller machine is not a regular and established place of business for determining venue.

This change is effective on September 16, 2012 and applies to any patent issued on or after that date ( 28 U.S.C. § 1400(b) (2011) and AIA § 18 (2011)).

### No State Jurisdiction

The AIA clarifies that state courts do not have jurisdiction over any claim for relief arising under any act of Congress relating to:

- Patents.
- Plant variety protection.
- Copyrights.

This change became effective on September 16, 2011 and applies to any action commenced on or after that date ( 28 U.S.C. § 1338(a) (2011) and AIA § 19 (2011)).

### Joinder of Parties

The AIA limits situations where joinder of multiple defendants in patent litigation is proper. Under the AIA, joinder of defendants is allowed only where the following elements apply:

Infringement is based on the same transaction, occurrence or series of transactions or occurrences relating to the same accused product or process.

There are questions of fact common to all defendants or counterclaim defendants that will arise in the action.

It is now insufficient for joinder to simply assert that the defendants are all infringing the same patents.

This change became effective on September 16, 2011 and applies to any action commenced on or after that date (35 U.S.C. § 299 (2011) and AIA § 19 (2011)).

## Non-patentable Subject Matter

The AIA identifies two specific types of subject matter that are ineligible for patent protection:

- Tax strategies (see Tax Strategies).
- Human organisms (see Human Organisms).

### Tax Strategies

Strategies for reducing, avoiding or deferring tax liability are not patentable. They are considered to be prior art (see also Scope of Prior Art).

However, this provision does not apply to inventions relating to:

- Preparation of tax returns.
- Financial management.

This change became effective on September 16, 2011 and applies to any patent application pending on or filed on or after that date and to any patent issued on or after that date (AIA § 14 (2011)).

### Human Organisms

The AIA expressly prohibits patents having a claim directed to or encompassing a human organism.

This change became effective on September 16, 2011 and applies to any patent application pending on, or filed on or after that date (AIA § 33 (2011)).

## Other USPTO Procedures

### Supplemental Examination Requests by Patent Owners

The AIA allows a patent owner to request supplemental examination at any time of a patent in the USPTO to consider, reconsider or correct information believed to be relevant to the patent. The petition for the supplemental examination must raise a substantial new question of patentability. This change is

effective on September 16, 2012 and applies to any patent issued before, on or after that date. (35 U.S.C. § 257 (2011) and AIA § 12 (2011)).

A key feature of supplemental examination is that after the supplemental examination, the patent cannot be held to be unenforceable on the basis of information that had not been considered, was inadequately considered or was incorrect in an earlier examination of the patent if the information was considered, reconsidered or corrected during the supplemental examination of the patent.

However, the supplemental examination must be concluded before the date on which the patent owner brings a patent enforcement action for this to apply. Similarly, this limitation on unenforceability claims does not apply where certain patent allegations under the Hatch-Waxman Act are made before the date of a supplemental examination request.

### **Priority Examination for Important Technologies**

The USPTO will give examination priority to applications for products, processes or technologies important to the national economy or national competitiveness.

This change is effective on September 16, 2012 and applies to any patent issued on or after that date (35 U.S.C. § 2(b)(2) (2011) and AIA §§ 25 and 35).

### **Inventor Oaths**

The AIA makes some changes to the requirements for oaths that the inventor typically must file with a patent application. Before the AIA, when an inventor did not sign the oath, an assignee had to prepare and file a petition to sign on the inventor's behalf. The changes aim to help in the filing of the patent application by assignees of the inventor's application where the assignee cannot get the inventor's signature.

For example, under the AIA, assignees can file substitute statements for non-signing inventors. In addition, an assignee may file the patent application on the inventor's behalf. If the USPTO grants a patent on an application filed by the assignee, the patent is granted to the assignee with a notice to the inventor.

This change is effective on September 16, 2012 and applies to any patent application filed on or after that date (35 U.S.C. §§ 115 and 118 (2011) and AIA § 4 (2011)).

### **USPTO Fees**

The AIA includes several provisions concerning the fees the USPTO collects for its services. These include:

- Giving the Director of the USPTO authority to set USPTO user fees. This change became effective on September 16, 2011.

- Creating a Patent and Trademark Fee Reserve Fund where fees collected in excess of the amount that Congress appropriates to the USPTO are deposited, presumably to use for PTO expenses. This change is effective on October 1, 2011
- Imposing a 15% surcharge on all user fees to use for USPTO expenses. This change is effective on September 26, 2011.

(35 U.S.C. §§ 41 and 42 (2011) and AIA §§ 10, 11 and 22.)

### **Patent Term Extension**

The AIA clarifies the deadline for filing an application for patent term extension after receiving regulatory approval to market the product. Under the AIA, the date on which a product receives regulatory approval is deemed to be the next business day, if the approval is transmitted either:

- After 4:30 p.m. Eastern Time, on a business day.
- On a day that is not a business day.
- "Business day" means any weekday excluding any legal holiday.
- This change became effective on September 16, 2011 and applies to any application for patent term extension either:
  - Pending on or filed after this date.
  - On which a decision regarding patent term extension is subject to judicial review on that date.

(35 U.S.C. § 156(d)(1) (2011) and AIA § 37 (2011).)

### **Miscellaneous Provisions**

The AIA also includes various other provisions that:

- Allow the USPTO to set the pay for administrative patent judges.
- Establish satellite offices for the USPTO at different locations around the US, including Detroit.
- Require the USPTO to set up a Patent Ombudsman Program and pro bono programs to assist small businesses and independent inventors.
- Require the USPTO to set methods to study the diversity of patent applicants.
- Require the USPTO to study:
  - the AIA's implementation;
  - effective ways to provide certain genetic diagnostic tests where gene patents and exclusive licensing from primary genetic diagnostic tests exist;
  - how the USPTO can help small businesses with international patent protection; and
  - the consequences of litigation by non-practicing entities.

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