



## America Invents Act implementation: countdown to first-to-file

Dickinson Wright's **Chris Mitchell** and **John S Artz** prepare US inventors for the implementation of the country's 'first-to-file' regime

**T**he America Invents Act ("AIA"), which went into effect 16 September 2011, has brought, and continues to bring, some of the most significant changes to the US patent system since the first US patent was issued in 1790.

Under the AIA's rolling implementation, we have already seen new law go into effect on the AIA's enactment date, repealing the "best mode" defence, changing the nature of "false patent marking" claims, and incentivising "virtual patent marking".

September saw significant changes to the way issued patents are challenged in the US Patent and Trademark Office ("USPTO"). Finally, next March will see the US go from being a "first-to-invent" country to a "first-to-file" country.

### Challenging patents in a post-AIA world

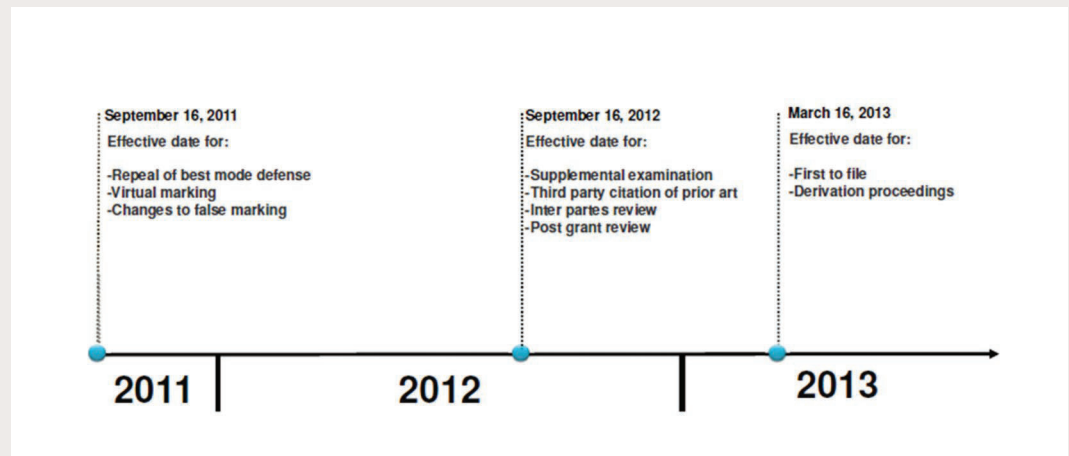
It is currently possible to challenge an issued patent under a process known as re-examination. In this process, the USPTO reconsiders the original decision to grant a patent in light of information provided by the party requesting re-examination. Currently, to qualify for re-examination, the submitted information must be in the form of printed publications and/or prior patents, and the request to re-examine a patent is only granted upon a showing by the requesting party that there is a "substantial new question of patentability" as to the patent being challenged. Presently, re-examination comes in two forms: *Ex parte* re-examination, in which the requesting party is involved only in instituting the re-examination; and *inter partes* re-examination, in which the requesting party has more of an adversarial role and, accordingly, greater opportunity to comment during the process.

Under the AIA, *ex parte* re-examination will continue unchanged and may be requested at any time. On the establishment of a "substantial new question of patentability", the case will be re-opened for *ex parte* re-examination. Not so for *inter partes* re-examination.

On 16 September 2011, the standard for invoking an *inter partes* re-examination became higher than the previously applicable "substantial new question of patentability" standard. Now the requesting party must meet a greater threshold requirement by showing that they are likely to prevail with respect to at least one challenged claim.

Further, *inter partes* re-examination ceased to exist entirely in favour of "*inter partes* review". *Inter partes* review, which will have a lot of the same character as *inter partes* re-examination, may be requested as to any issued patent, whether filed before or after the March 2013 implementation of the first-to-file system. However, *inter partes* review cannot be requested until a nine month window after the patent issued closes. This leaves a nine month "black-out" period for any patents issued from 16 September onward and which were filed under the old first-to-invent regime where neither *inter partes* review nor post grant review (discussed further) are available.

Post grant review, which came online on 16 September, promised to be much more powerful than *ex parte* re-examination or *inter partes* review. This is because the basis for a post grant review request is not limited to invalidity on the grounds that a patent's claims are obvious or anticipated by prior patents or printed publications, but also includes nearly every other notable statutory basis for patent invalidity. This includes lack of enablement or written description of the invention; indefiniteness of the claims; evidence of a prior sale or invalidating



Graph showing the AIA's patent law reform

public disclosure; or non-patentable subject matter under Section 101 of the Patent Act. However, this basis to challenge will *only* be for the new first-to-file regime; eg, filed on or after 16 March 2013.

### Get to the patent office first:

The most significant change to the US patent system will take place on 16 March 2013, when the US will become a "first-to-file" country. Historically, patents granted in the US have gone to the first-to-invent the claimed subject matter. Where separate inventors were working on similar inventions at the same time, the "first-to-invent" system could sometimes result in interference proceedings at the USPTO to determine who was the first to come up with the claimed invention. Fortunately, the AIA guards against a party getting a patent from an earlier-filed application the subject matter of which was obtained from the later-filing inventor.

However, this will require the inventor to either institute a "derivation proceeding" in the USPTO or file a case in a Federal District Court (the full effect and requirements of a derivation proceeding are not yet completely known).

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Related to our move to a "first-to-file" country, the novelty provision of the Patent Act will change to create an absolute bar to patentability if the claimed invention of a patent application was "patented, described in a printed publication, or in public use, on sale, or otherwise available to the public" *anywhere in the world before the patent application's effective filing date*. This is a major transformation in at least two respects.

First, with respect to activities outside the US, the law before the AIA only limited as a bar to patentability foreign patents and printed publications. Other activities, such as public use, sale or other "public availability" outside of the US were not considered. After 16 March of next year, that will no longer hold true.

Second, because the law before the AIA permitted applicants in some situations to prove that they came up with their inventions before the effective date of a cited patent or printed publication, there was recourse if another entity independently developed the same invention after you, but beat you to the USPTO with a patent application directed to the subject matter. Again, this will not be true when, come 16 March 2013, what will matter is when you filed your patent application, and not when you came up with your invention.

The combination of these changes to the law should encourage filing patent applications *before* 16 March if possible, in order to take advantage of the present "first-to-invent" system's more limited view of foreign prior art and potential for proving an earlier date of invention than the date of a patent or publication cited against you by the USPTO.

But if you do not file until 16 March or later, the AIA's changes to the US patent system should encourage filing patent applications as soon as practicable, or risk the possibility that someone else – anywhere in the world – may have already filed an application disclosing subject matter that will keep you from getting a patent.

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