

Patent Reform

Successful Women in IP



Elizabeth A. Howard

Orrick, Herrington & Sutcliffe LLP

First to File

- Old 35 U.S.C. § 102 (a) – (d):

~~(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent~~

~~(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for a patent in the United States~~

~~(c) he has abandoned the invention~~

~~(d) patented in a foreign country 12 months before the US filing~~

→ NEW LAW:

102(a)(1): 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.

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- Old 35 U.S.C. § 102 (e):

102 (e) the invention was described in: ~~1) an application for a patent, published under section 122(b), by another filed in the United States before the invention by the applicant for a patent or 2) a patent granted on an application for a patent by another filed in the United States before the invention by the applicant for a patent.~~

→ NEW LAW:

102(a)(2): the **claimed** invention was described in **a patent issued under section 151 [issued], or in** an application for a patent published **or deemed published** under section 122(b), in which the patent or application, as the case may be, **names another inventor** and was effectively **before the effective filing date** of the **claimed** invention.

First to File -- Grace period exceptions

- Old 35 U.S.C. § 102 b one year grace period:
 - the invention was patented or described in a printed publication in this or a foreign country **or in public use or on sale** in this country, more than one year prior to the date of the application for a patent in the United States
- NEW LAW (exceptions to 102(a)(1)):
 - A **disclosure** made 1 year or less before the effective filing date of a claimed invention shall not be prior art to the claimed invention under (a)(1) if:
 - (a) the **disclosure** was made by the inventor or joint inventor or by another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor; or
 - (b) the subject matter **disclosed** had, before such disclosure, been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor.

First to File -- Grace period exceptions

- Old 35 U.S.C. § 102 b one year grace period:
 - the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for a patent in the United States
- NEW LAW (exceptions to 102(a)(2)):
 - A disclosure shall not be prior art to a claimed invention under (a)(2) if:
 - a) the subject matter disclosed was **obtained directly or indirectly from the inventor or a joint inventor**;
 - b) the subject matter disclosed had, before such subject matter was effectively filed under (a)(2), been publicly disclosed by the inventor or a joint inventor or another who obtained . . . directly or indirectly from the inventor
 - c) the subject matter disclosed and the claimed invention, not later than the effective filing date of the claimed invention, **were owned by the same person or subject to an obligation of assignment to the same person.**

Litigation issues

- Best mode – required for patentability *but no longer available as a litigation defense*
- Prior commercial use defense – commercial use of “a process, or consisting of a machine, manufacture, or composition of matter, used in a manufacturing or other commercial process that would otherwise infringe” not an infringement if:
 - use was at least one year before the earlier of the effective filing date of the claimed invention or the date on which the claimed invention disclosed to the public and
 - use was in the United States.
- willfulness
- joinder
- false marking

PTO issues

- Derivation proceedings
- Post-grant review
- Pre-issuance submissions by third parties
- Inter partes review
- Supplemental examination

Effective dates

NOW:

- False marking cases – pending and future
- Best mode defense – filed on or after 9/16/11
- Joinder – filed on or after 9/16/11
- prior commercial use – patents issued on or after 9/16/11

ONE YEAR:

- Post grant review
- third party pre-issuance submissions
- supplemental examination

18 MONTHS:

- First to file regime begins
- Derivation proceedings