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Hurry, Scurry So You Don't Fret & Worry

America Invents Act The new law compels inventors to file patent applications early

The America Invents Act approved in September directly affects independent inventors and patent filers of all stripes. We examine how the new law alters the playing field – and what you need to know to avoid new pitfalls and take advantage of new opportunities.

By Hani Sayed



The America Invents Act has changed the intellectual property landscape.

How these changes will affect individuals, companies and investors remains to be seen. Much of the Act will take effect over the coming months. Yet it's important to understand the new rules before they officially become the law of the land.

The goal of the America Invents Act was to update the patent system to spur innovation, job creation and economic growth. Another significant purpose was to reduce frivolous lawsuits and uncertainty of patent ownership. Critics question whether the Act as written will accomplish any of those.

The aspect that has stirred most debate and discussion is the change from a first-to-invent jurisdiction to a first-to-file system.

For Patent Owners

First to File

Although being the first to the patent office is advisable under the changes, the Act attempts to strike a balance to ensure whomever is the first to file is actually the legitimate inventor.

The new rules state an inventor may get a patent unless the invention was patented, described in a printed publication, in public use, on sale, or otherwise available to the public before the patent application was filed.

Additionally, the new patent rules state if an invention was described in a patent or published application naming another inventor and that application was filed before your application, then you may be precluded from obtaining a patent.

The first-to-file effect shows up most clearly in determining what inventions and patent filings came before your patent filing. Similar to the old definitions of what was filed or disclosed – commonly known as “prior art” – a patent or patent application is prior art to a new application.

An exception is still generally provided if the prior application is jointly owned, similar to previous rules.

However, there is no longer an exception for inventors who say they conceived of the idea prior to the filing date of the prior application. The second inventor to file will face a prior art challenge by the disclosure from the first invention regardless of when either application was actually conceived. This effectively eliminates the concept of “first to conceive.”

Many are concerned the new rules leave inventors open to having their invention ideas stolen, with patents awarded to those who pilfered.

The Act attempts to strike a balance here for limited relief when the true inventor tries to file after the invention has been stolen.

For example, a patent or published application will not be used as prior art under this section if the true inventor can show they publicly disclosed the invention prior to the filing date of the first potentially fraudulently filed application, or if the true inventor can show that subject matter of the potentially fraudulently filed application was obtained from the inventor.

Although the Act attempts to reduce the uncertainty to patent ownership by instituting the first-to-file standard, the Act also attempts to balance the burden on the U.S. Patent and Trademark Office the uncertainty in the patent system and the cost of resolving the uncertainty with that of a true inventor.

Under limited time and circumstantial constraints, later filing inventors could prevail in proving they’ve been ripped off.

What is Prior Art?

The America Invents Act expands on what can be used against your patent application with respect to prior art.

Generally, any public information can now be used as prior art if it was available before the “effective filing date” of the invention.

The new rules eliminate the one-year bar as well as the distinctions between foreign and domestic activities. The previous rules required that public disclosure or sales had to be in this country and not in foreign countries. Now, disclosure anywhere in the world can be used as a bar to patent filing. These new rules essentially suggest to inventors, individuals and companies alike that the sooner an application is filed, the better off the applicant will be.

One rule that has not changed from the old rules is a grace period for disclosure and prior use. Essentially, the rules give a variation of the one-year grace period to file a patent application after public disclosure.

The public disclosure from an inventor will not be considered prior art to their own application as long as the application is filed within one year of that disclosure. The one-year grace period applies only to a disclosure from an inventor or by another who obtained the information from the inventor, and also includes any public disclosure by another party that happens after the initial disclosure of the original inventor.

Although the grace period lessens the effects of the first-to-file rule, it is still generally advisable to file an application before any disclosure occurs.

Defense to Infringement

Another new facet to the Act is the ability to defend against patent infringement based on prior commercial use of the technology.

The Act states a person will be entitled to a defense to a patent-infringement attack if they have been using the technology commercially at least one year prior to either the patent filing or the public disclosure by the party that is alleging patent infringement.

Inventors should document any commercial use of their invention for use as a defense against a potential patent owner at a later date.

In addition to internal documentation, it’s a good idea to file for a patent on the product or process as soon as possible to create a prior art obstacle. Considering the tradeoff for keeping a product or process a trade secret, the product or process also may be published or otherwise disclosed to the public to similarly create a prior art hurdle.

For Patent Challengers

Prior Use Defenses

Prior user defense to patent infringement has been expanded.

The defense had been available only in cases related to business method patents. But it now applies to all issued patents. Under the prior use defense, patent infringement claims are prohibited against parties that can show: a) they acted in good faith; b) they actually reduced the subject matter of a patented invention to practice at least one year before the patentee filed its patent application; and c) they commercially used that subject matter before the patentee filed its patent application.

Another important aspect is that any third party can submit an issued patent, published patent application or other printed publication of potential relevance for consideration in the prosecution of a patent application.

The submission should be made in writing within six months of publication of the application and should include a concise description of the asserted relevance of each submitted document. In essence, this gives any third party the right to challenge any patent application filing without waiting to start a re-examination process, which was one of the few defenses available to make a challenge before the new Act.

A new administrative proceeding also is included in the Act whereby the USPTO may institute a "post-grant review." While the current reexamination system is limited to patent challenges based on novelty and obviousness, under the new post-grant review procedure third parties can challenge the validity or scope of an issued patent using any ground of patentability.

Additionally, under the new post-grant review, any evidence of unpatentability may be introduced by the challenger, not just prior art patents and printed publications as required by current reexamination procedures. However, under the new post-grant review proceedings, the review of an issued patent must begin within nine months of the issuance of the patent. Existing reexamination proceedings remain available beyond the nine-month period.

Best Mode Challenges

Under current patent law, a patent applicant must articulate the best mode of carrying out the invention contemplated by the inventor on the date of filing. The best mode requirement keeps inventors from applying for patents while hiding preferred aspects of their inventions from the public.

The America Invents Act does not eliminate this best mode requirement. Rather, it eliminates the failure to disclose the best mode as a defense for an alleged infringer in a patent infringement action.

However, a failure to include the best mode known to the inventor at the time of filing a patent application might still be considered in a USPTO proceeding. As such, the best mode requirement might still be used to keep a patent from issuing or to invalidate a patent in a proceeding in front of the USPTO, such as the new post-grant review proceeding.

- Congress approved the America Invents Act June 23, 2011 in a 304-117 vote. The Senate approved the bill Sept. 8, 2011. President Obama signed the Act into law on Sept. 16, 2011.
- Almost all patent fees have now increased by 15%, except for micro entities or independent inventors.
- It pays to file digitally. Starting Nov. 15, 2011, the USPTO imposed an additional \$400 fee for those filing on paper; the extra fee is \$200 for independent inventors.

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[December 7, 2011 at 11:34 pm](#)

This is a pretty darn good article! If it leaves you wanting MORE then take a look!

Do you know about the Provisional Patent Application? It only costs \$125 and was designed by Congress to give individual inventors a chance at bringing their inventive ideas to market easily. It is SUPER EASY to do..

To see the top 10 reasons to file a Provisional Patent Application please watch the second video in this blog.

<http://www.filepatentapplications.com/blog/>

If a provisional patent application looks like the right thing for you to do then take a look at another website that shows EXACTLY how to file one using a video format.

<http://provisionalpatentvideo.com/>

If you need to know how to get your product sold on TV or to Costco, or Home Depot, or Target and the like then you might also enjoy reading this information by the Ginsu Knife guy! It is pretty cool. He gives you all his contacts and personal email!

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Of course you could ALSO just go to the US Patent Office and figure out how to file a patent yourself. Here is the link..

<http://www.uspto.gov/patents/process/index.jsp>

The flow chart there is pretty nice to give you an idea how to do what you want to do!

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