

IMPLEMENTATION OF THE AMERICA INVENTS ACT (AIA)

By Darren Crew

The America Invents Act (AIA) was signed into law on September 16, 2011. The AIA modifies many different subject areas of U.S. patent practice, including at least: (i) inventor's oath or declaration (effective September 16, 2012); (ii) falsely marking products as "patented" (effective September 16, 2011); (iii) post grant review (effective September 16, 2012); (iv) inter partes review (effective September 16, 2012); and (v) micro entity fees (available in the future).

1. Inventor's Oath/Declaration (Effective September 16, 2012)

The U.S. Patent and Trademark Office (USPTO) has proposed changes to the existing rules of practice, in order to implement the inventor's oath or declaration provisions of the AIA.

Each inventor will still be required to execute an oath or declaration. However, under the proposed rule changes, that requirement can be satisfied by filing an assignment that includes all necessary statements. Thus, a separate oath or declaration will not be required.

Previously, an application for a patent could only be made by the inventors. However, as of September 16, 2012, pursuant to the proposed rule changes, the USPTO will permit assignees to make an application for patent, under some circumstances. For example, the assignee will be permitted to make an application for patent when the inventors are not available or when the inventors are not willing to sign an oath or declaration.

The oath or declaration will be required to contain statements that the application was made or was authorized to be made by the affiant or declarant, and the individual believes himself or herself to be the original inventor or an original joint inventor of a claimed invention in the application. However, the oath or declaration will not be required to include an inventor's citizenship. Also, the oath or declaration will not be required to include the clause "without any deceptive intention." The oath or declaration will not require that the inventor state that he/she believes himself/herself to be the "first" inventor of the subject matter sought to be patented.

2. Falsely Marking Products as "Patented" (Effective September 16, 2011)

It is an offense under the False Marking Statute (35 USC 292) to falsely mark goods as "Patented." Prior to the enactment of the AIA on September 16, 2011, any person could sue under the False Marking Statute. However, effective immediately on September 16, 2011, the AIA made significant changes to the false marking laws. Under the AIA, only the U.S. government can now sue for the civil penalty listed in the statute. Private entities can still sue under the False Marking Statute, but they can only sue for compensatory damages, and must prove actual competitive injury due to the false marking. It is no longer a violation to mark a product with an expired patent, if the indicated patent at one time covered

the product. Under the AIA, the changes to the false marking laws apply to all cases pending on September 16, 2011, and all cases commenced on or after September 16, 2011.

3. Post Grant Review (Effective September 16, 2012)

Post grant review is a new trial proceeding at the Patent Trial and Appeal Board (formerly the Board of Patent Appeals and Interferences). The post grant review process is utilized to review the patentability of claims in a patent on any ground that could be raised pursuant to 35 USC 282(b)(2) or (3). A post grant review may be instituted upon a showing that, it is more likely than not, that at least one claim challenged is unpatentable. The process begins with a third party filing a petition on or prior to the date 9 months after the grant of the patent or issuance of a reissue patent. Patent owner may file a preliminary response to the petition. A final determination will be issued within 1 year.

4. Inter Partes Review (Effective September 16, 2012)

Inter partes review is a new trial proceeding at the Patent Trial and Appeal Board utilized to review the patentability of one or more claims in a patent only on a ground that could be raised under 35 U.S.C. 102 or 103. This is on the basis of prior art only consisting of patents or printed publications. An inter partes review may be instituted upon a showing that there is a reasonable likelihood that the petitioner would prevail with respect to at least one claim challenged. The inter partes review process begins with a person, not the owner of the patent, filing a petition after the later of either: (a) 9 months after the grant of the patent or issuance of a reissue patent; or (b) if a post grant review is instituted, the termination of the post grant review. Patent owner may file a preliminary response to the petition. A final determination will be issued within 1 year.

5. Micro Entity Fees (Available in the Future)

On September 16, 2011, the AIA introduced a new definition of applicant, known as a “micro entity.” An applicant is a micro entity if it qualifies as a small entity, if it has not been named as an inventor on more than 4 previously filed patent applications, and if it satisfies the limit on income of the applicant. There are considerations regarding institutes of higher education. An applicant satisfying the requirements of a micro entity will qualify for a 75 percent discount on some fees. However, the micro entity fee discount will not be available until the USPTO sets or adjusts fees using a new fee setting authority (expected in September 2012 or possibly later).

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