

# Il brevetto USA alla luce delle nuove regole e dei nuovi scenari competitivi

Nuove strategie e procedure per la valorizzazione dell'IP-

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## Disclaimer

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## Summary of the presentation

- Introduction: AIA- a complex series of provisions with different scope and effective dates- Overview and timelines.
- FITF (effective 13-03.2013); Oath/declaration applicant-inventor (effective 16.09.2012)
- Post-grant&Inter-partes review (effective 16.09.2012)
- Supplemental examination (effective 16.09.2012)
- Pre-grant prior art submissions (effective 16.09.2012)
- Pre-grant accelerated procedures (effective 16.09.2012)
- Selected additional provisions (best mode «attenuated» 16.09.11; deceptive intent removed from reissue applications 16.09.12; virtual marking and false marking 16.09.11; opinion of counsel 16.09.11; fees 16.09.11)

## FTI (first-to-invent): current US system

Currently:

It applies to any invention made in any WTO country, documented according to US standards.

A ownership conflict on same patentable subject matter claimed independently by two (or more) inventors is solved by an administrative procedure before the USPTO (Interference)

Key elements:

- C (Conception date)
- R (Reduction to Practice: constructive or actual)
- D (Diligence)

## FTI (first-to-invent): current US system (follows)

Summary conclusion, relative to an Interference procedure (key principle):

The inventor who is first to reduce to practice wins the Interference, unless the one who was later to reduce to practice was first to conceive the invention and was diligent from a time prior to the conception of «the other» inventor to its reduction to practice.

As to the prior art effect of any publication prior to earliest filing date, there is no prior art effect if publication occurred up to one year before such filing, but after conception date of the invention.

## FTF (first-to-file): current EPC system

**The right to a patentable invention** belongs to the applicant/inventor who was first to file a regular patent application on it, in any country adhering to the «Paris Convention».

**As to the prior art effect of any publication prior to earliest filing date**, there is always a prior art effect, both for novelty and inventive step, for **any** (i.e. own as well as third party ones) subsequently filed patent application.

FITF («first-inventor-to-file»): NEW US system (from 16.03.2013).  
alias (personal view): *first inventor/applicant to disclose and then file (FIT-DTF)*

**The rights to a patentable invention** belong to the applicant/inventor who was first to file a regular patent application on it, in any country adhering to the «Paris Convention».

**As to the prior art effect of any publication of the subject matter of the patented invention up to one year prior to the earliest filing date, the following applies:**

- publication from inventor/applicant: no prior art effect
- publication from a third party: no prior art effect either because of derivation from inventor or because it followed an earlier disclosure by the inventor

# Welcome to GraceLand ! (part I)

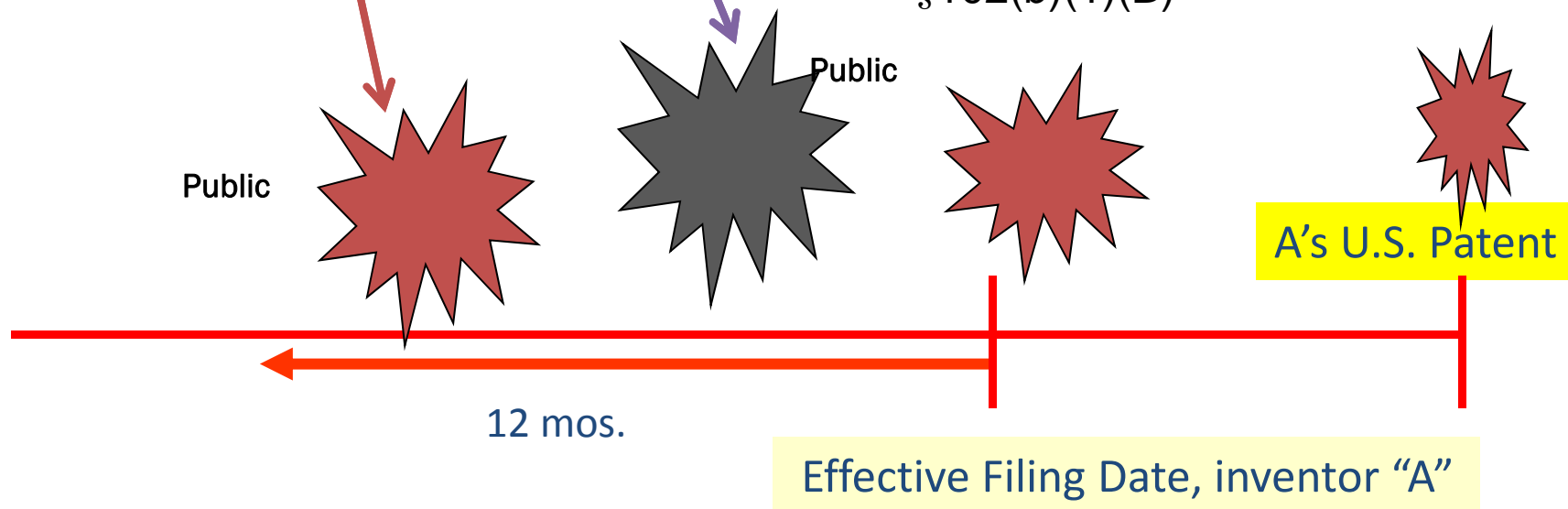
## How the NEW U.S. Grace Period Will Work: §102(b)(1)(A) and (B)

Disclosure “by” or “obtained from” an INVENTOR (“A”)

§102(b)(1)(A)

Disclosure by ANYONE

§102(b)(1)(B)



“A” is entitled to a US patent because its own (pre)disclosure is not prior art under 102(b)1(A) and **the third party disclosure of the invention** is not prior art to it because of 102(b)(1)(B)



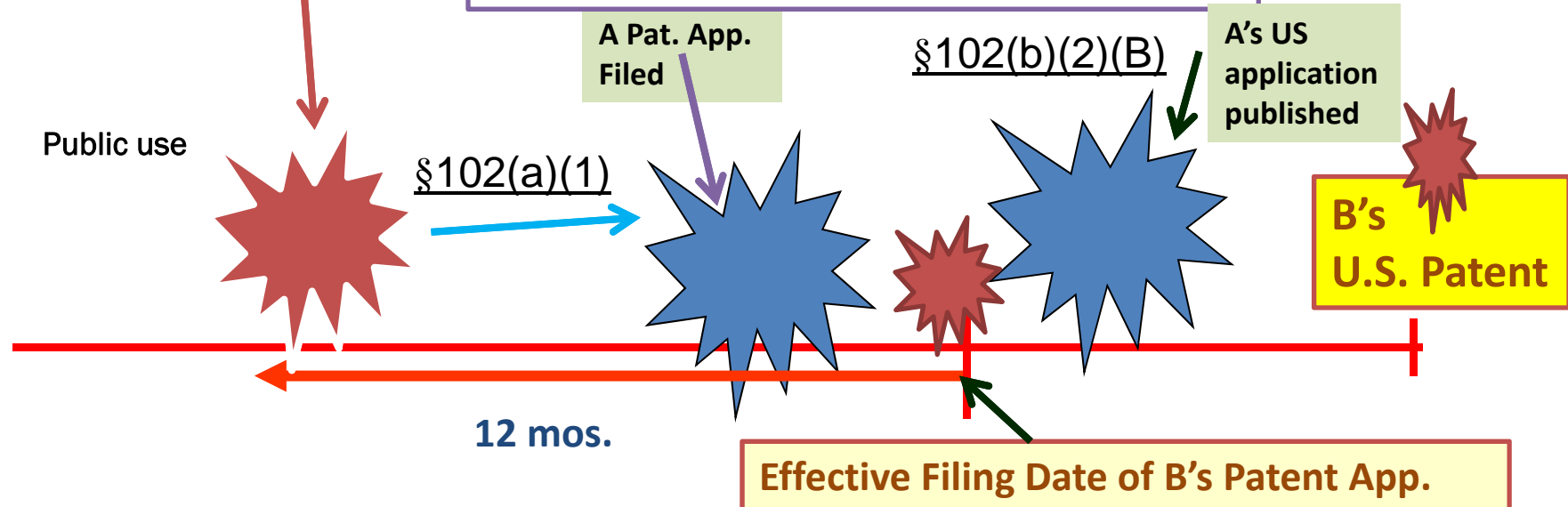
## Welcome to GraceLand ! (part II)

### How the NEW U.S. Prior Art Provisions (102/103) Will Work: A Sword and A Shield

Disclosure “by or obtained from”  
Inventor B

§102(b)(1)(A)

Filing by independent inventor A



*B avoids public use through §102(b)(1)(A); B's public use avoids A's publication through §102(b)(2)(B) and defeats A through § 102(a)(1);*

*First inventor to file ("A") loses because the other (independent) inventor ("B") disclosed first, even if it filed "last"...*

## Impact of new US FIFT system on global patent strategies

- **Marginal and residual** as long as there is not a common, internationally implemented set of rules modelled on AIA, e.g. changing the EPC FTF into a similar «EPC-FITF» system.
- In such a case, a new framework for global patent strategies will be set, in particular if it will embrace JP, CN, KR..
- **If a AIA-like system becomes a worldwide standard, it is to be expected that disclosing the invention first and then filing a patent application within the grace period may become a paying strategy.**

## US FIFT system: The devil is in the *details*

- AIA grace period is a complete novelty not only for the US but also worldwide. It would be advisable to allow sufficient time to collect data, evaluate its effects over time in the US patent system before planning of expanding it worldwide..

### Areas of attention:

- No right of priority from earlier public disclosure (theory v. practice)
- Grace for inventors' work and work derived directly or indirectly from it: structural uncertainty and third party «rights»
- Grace only for «enabled» prior disclosures ?
- Grace only for «identical» content of the earlier disclosure and «later» **claimed invention** (?)

## US FIFT system : The devil is in the *details* (continued)-

Areas of attention(follows):

- Grace only for «identical» content of the earlier disclosure and «later» **claimed invention** (?) same enabled disclosure by a later independent inventor to file (first) is defeated by earlier first publication of the third party/independent inventor, but patentable or non-patentable variations (that are not included in the first published document) published by the third party should stand as full prior art against later filed «broadening» application by the one who was first to disclose and later to ..
- »disclosures of the the claimed invention».. (102 (b)): uncertainty for third parties not just until after grant of a given patent, but perpetuated through the related continuing chain of applications ..
- No duty for applicant to list its prior publications (in particular the first one they are aware of) which are considered to be covered by the grace period and to make its documented content easily available for public inspection/evaluation ?

**Definitely increased third parties' uncertainty and burden/costs for patent evaluation (for FtO purposes..) under the new system...**

## US FIFT system : The devil is in the *details* (continued)

### In conclusion:

Cost/benefit analysis of the new system in fostering/hindering innovation to be evaluated over time and in light of rules- still to be implemented- and subsequent later relevant case law

It is evident however that, to have a chance to operate internationally, it should be sufficiently detailed to reduce to the maximum extent the uncertainties of the new system, some of which appear actually to be intrinsically associated with it and give clearcut answers to questions such as those outlined above..

## An international grace period for Europe: the implementation factor

To implement a Europe-wide (international) grace period it appears to be necessary to modify (via Diplomatic Conference) the EPC, Art 55, that may be a time-consuming exercise.

In case the avenue of the Revision of the EPC is undertaken, it is recommended to have, as a first priority for its amendment, the amendments to Artt. 14(1) and 177(1), to provide for a single procedural language under the EPC.

## Art.14 EPC: languages of the EPO, the European patent applications and other documents

(1) Official languages of the EPO shall be English, French and German.

## Art.177 EPC: languages of the Convention

(1) This Convention, drawn up in a single original in the English, French and German language ....

## Assignee as patent applicant-Effective 16.09.2012

- AIA allows ASSIGNEE to be PATENT APPLICANTS (previously only INVENTORS could be patent applicants) and to sign applications for reissue of a Patent.
- Consequently, a number of requirements for patent applications are streamlined and moved into a «substitute statement» to be signed by ASSIGNEE/PATENT APPLICANT
- INVENTORS still have to sign a «simplified»/modified Oath or Declaration..



## PostGrant&InterPartes Reviews- Effective 16.09.2012

- 1. PostGrant Review--PGR** (New, available for patents granted on applications filed ON/AFTER 13.03.2013)
2. InterPartes ReExamination (terminating 16.09.2012, to be replaced by IPR, see below)
- 3. InterPartes Review– IPR** (New, available for any patents granted on, before or after 16.09.2012)
4. *Transitional program for covered business method patents*
- 5. Supplemental examination**

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6. *ExParte ReExamination remains in place as before, unaltered*

### 3. InterPartes Review--**IPR**-Effective 16.09.2012

- Applies to **any patents issued before, on or after effective date**
- Can be requested **9 months after grant or reissue or at the end of a PGR** if one has been initiated
- It is a request to **cancel one or more claims of a patent a unpatentable on any grounds under 35USC102/103** that are baed on printed **publications** or patents
- Petitioner must be real party in interest
- The **threshold to initiate** the procedure is reasonable likelihood **that the petitioner would prevail at least with respect to one challenged claim**
- **Timing to completion: 1y** from its being declared (+6m exceptionally)
- **Quasi-litigation procedure**, in front of PTBA (Patent Trial and Appeal Board- see below), with possibility to appeal negative decisions to CAFC
- Provisions for a **limited discovery** (evidence directly related to factual assertions advanced by either party in the proceedings)
- **Fees: 27 200 \$ + 600 \$ per claim in excess of 20**

# 1. PostGrant Review--**PGR**- *Effective 16.09.2012*

- Applies to **patents granted on applications filed on or after 16.03.2013** (in case a priority date is claimed which is before 16.03.13, the resulting patent is excluded from PGR only if all the claims are entitled to the earlier filing date, otherwise all the claims of the patent can be subjected to PGR)
- Can be requested **within 9 months from grant or reissue**
- It is a request to **cancel one or more claims of a patent a unpatentable on any grounds under 35USC 282 (2 or 3)** (prior art, utility/eligibility, enablement, written description, definiteness)
- Petitioner must be real party in interest
- The **threshold to initiate** the procedure is more likely than not **that the petitioner would prevail at least with respect to one challenged claim** (or raises a novel, unsettled legal question)

# 1. PostGrant Review--**PGR**- *Effective 16.09.2012*

follows

- A PGR may not be instituted if the petition requests cancellation of a claim that is identical to or narrower than a claim in the original patent, if the time limitations would bar filing a petition for the original patent: 35 USC 325(f)
- **Timing to completion: 1y** from its being declared (+6m exceptionally)
- **Quasi-litigation procedure**, in front of PTBA (Patent Trial and Appeal Board- see below), with possibility to appeal negative decisions to CAFC
- Provisions for a **limited discovery** (evidence directly related to factual assertions advanced by either party in the proceedings)
- **Fees:** 35 800 \$ + 800 \$ per claim in excess of 20

# Progressively increasing standards of initial proof

## 1. ReExamination

**SNQ** -substantial new question of patentability, i.e. substantial likelihood that a reasonable examiner would consider the prior art an an important one in deciding whether or not a claim is patentable

## 2. IPR (InterPartes review)

**Reasonable likelihood** that the petitioner would prevail with at least one of the claims challenged in its petition

## 3. PGR (PostGrant review)

**More likely than not** that at least one of the challenged claims is unpatentable

## Patent Trial and Appeal Board—PTAB- 35 USC 6(a)

- Panel of three «administrative patent judges» to conduct appeals on adverse decisions by/in:
  - USPTO examiners (35 USC 134(a))
  - ReExamination (35 USC 134(b))
  - **Derivation proceedings** (35 USC 135)
  - **IPR** (35 USC 31)
  - **PRG** (35 USC 32)
- Procedural elements:
  - Parties can request discovery (limited, no litigation-scale discovery available)
  - Witness who have submitted affidavits or declarations can be deposed
  - Parties can present oral arguments before the Board

# Patent Trial and Appeal Board—PTAB- 35 USC 6(a) *follows*

- PTBA decisions can be appealed to CAFC (35 USC 141(c)):
  - **Questions of facts** are reviewed on a **substantial evidence** standard
  - **Question of law** are reviewed *de novo*

## *Transitional program for covered business method patents-- TPCBM- Effective 16.09.12*

- Special program to sunset 16.09.2020
- Object: review business method claims that are not «technology inventions»
- Applies to any patent either under FTI or FITF
- Standard and procedures: same as PGR, but a person may not file a petition for PPCBM unless it (or the real party in interest) is charged with/has been sued for infringement of the patent
- Technology invention requirement: will be addressed case-by-case, by looking at whether the claimed subject matter as a whole recites a technology feature that is novel and not obvious over the prior art and solves the technical problem using a technical solution.
- Not limited to «financial services», but applies to any field



## ***Supplemental examination- SE-*** ***Effective 16.09.2012***

- A patent owner can request a SE of its patent to «consider, reconsider or correct» information believed to be relevant to the patent
- «Information believed to be relevant to the patent» is not limited to patent or printed publications, but extend to any other evidence relevant to patentability issues under 35 USC 101 or 112 (same scope as PGR in this respect)
- Only patent owner can participate in the procedure
- USPTO, within 3 months from petition must conduct SE and conclude it, by issuing a certificate indicating whether the submitted info raises a SNQ (substantial new question of patentability)
- If a SNQ is raised, USPTO must order ExParte ReExamination, that in this case has a broader scope than «normal» ReExamination since it embraces unpatentability under 35 USC 101 or 112 (see above)
- Fees: 5 180 \$ for initial request plus 16 120 \$ for ReExamination (this latter refundable if ReExamination is not ordered)

## ***Supplemental examination- SE-*** ***Effective 16.09.2012 follows***

- The inequitable conduct side of it: A patent shall not be held unenforceable on the basis of a conduct relating to information that was not considered, was inadequately considered or was incorrect in a previous examination, if the information was considered, reconsidered or corrected during supplemental examination (35 USC 257)
- Patentee must use SE before being accused of inequitable conduct: the protection deriving from SE does not apply to an allegation pled before in a civil action or set forth in an ANDA notice letter (35 USC 257(c)(2)(A)) received before the date of the request
- Patentee must use SE before bringing suite: the protection deriving from SE does not apply to any defense raised in a patent enforcement action under ITC 337(e) or in a District Court based on info considered, reconsidered or corrected during SE, unless SE or any connected ExParte ReExamination are finished before the action is brought

## Pre-issuance submissions- Effective 16.09.2012

Third parties can submit patents, published patent applications or other printed publications of potential relevance together with a short statement of relevance, in a patent application file. *(37 CFR 1.290(a))*

- Submissions

- Timing: the earlier of
  - the date of notice of allowance
  - six months after the first publication of the application
  - the date of first examiner's rejection
- Content: may include also litigation papers and court documents not subject to protective or secrecy orders but does not include unpublished (internal) docs, (trade) secret info, etc. Electronic submission encouraged.
- Language: English or translated into English
- Number of docs: 12 items max per submission, but multiple submissions are possible
- Fee: 180 \$ per submission
- Entering into patent application file: only after review for compliance; if refused, can be resubmitted. Entered submissions will be identified on the face of the patent

- Sumbitter may be anonymous but must declare that it is under no duty to disclose

## Pre-grant accelerated procedures

1. Accelerated examination (already in place since 25.08.2006)
2. «Track 1» Prioritized examination (effective since 26.09.2012)

Both systems are commenced with a petition to be filed concurrently with the patent application. The USPTO commits to complete the examination process, on average, in 12 months, in both cases.

Without entering in a side-by-side comparison of the various procedural elements, the following table tries to summarize what are considered among the possibly most relevant pros/cons of each of them, to support a possible general conclusion and be of help in elaborating *ad hoc* strategic recommendations.

## Pre-grant accelerated procedures *follows*

Procedural element	Accelerated examination	Prioritized examination
Prior art search and analysis	Yes/ (-)	No/ (+)
Failure to respond to OA	No extension; Automatic abandonment of the patent application / (-)	No abandonment of application, possible extension with automatic exit of prioritized exam / (+)
Fee	Normal / (+)	Normal plus 4 800 \$ / (-)
Argue separate patentability of dependent claims	No / (-)	Yes / (+)
Filing a RCE	Maintains accelerated status / (+)	Automatic exit of prioritized examination / (-)
Traverse	Automatic exit of accelerated examination/ (-)	Do not terminate prioritized examination / (+)
Claims (max)	total 20, independent 3 / (-)	Total 30, independent 4 / (+)

## Selected additional provisions

- best mode «attenuated» 16.09.11
- deceptive intent removed from reissue applications 16.09.12
- virtual marking and false marking 16.09.11
- opinion of counsel 16.09.11
- fees and USPTO fee setting authority 16.09.11

Thank you for your  
attention !