



Leahy-Smith America Invents Act Impact on European Industry

ETIC - Echte Patente! Training
19. April 2012 im SIGNAL-IDUNA-PARK Dortmund

Dr. NORMAN B. THOT

US PATENTRECHT IN DEUTSCHLAND

America Invents Act

General Information

- First major change to US patent law since 1952
- Signed by President Obama on September 16, 2011 as Public Law 112 – 29
- 57 Pages, 37 Sections
➔ <http://www.gpo.gov/fdsys/pkg/PLAW-112publ29/content-detail.html>
- Numerous Effective Dates:
➔ www.uspto.gov/aia_implementation/aia-effective-dates.pdf



- Sec. 1. Short title; table of contents.
- Sec. 2. Definitions.
- Sec. 3. First inventor to file.
- Sec. 4. Inventor's oath or declaration.
- Sec. 5. Defense to infringement based on prior commercial use.
- Sec. 6. Post-grant review proceedings.
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- Sec. 28. Patent Ombudsman Program for small business concerns.
- Sec. 29. Establishment of methods for studying the diversity of applicants.
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- Sec. 31. USPTO study on international patent protections for small businesses.
- Sec. 32. Pro bono program.
- Sec. 33. Limitation on issuance of patents.
- Sec. 34. Study of patent litigation.
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- Sec. 36. Budgetary effects.
- Sec. 37. Calculation of 60-day period for application of patent term extension.



America Invents Act

Overview

- Part 1** **First to File Provisions**
- Part 2** **Post Grant Proceedings**
- Part 3** **Litigation Provisions**
- Part 4** **Miscellaneous Provisions**



US v. EP/DE Patent Law

Overview of Differences between United States and European / German Patent Applications before the Act

	<u>USA</u>	<u>Europe</u>
• Patent granted to first to...	Invent	File
• Absolute Novelty	No	Yes
• Patent Owner	Inventor	Employer
• Application always published	No	Yes
• Prior user defense (Germany)	Limited	Yes
• Post-Grant Opposition	No	Yes
• Re-examination	Yes	No



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US v. EP/DE Patent Law

Overview of Differences between United States and European / German Patent Applications after the Act

	<u>USA</u>	<u>Europe</u>
• Patent granted to first to...	File*	File
• Absolute Novelty	Yes*	Yes
• Patent Owner	Employer*	Employer
• Application always published	No	Yes
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• Post-Grant Opposition	Yes	Yes
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Part I

First to File Provisions



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Section 3

Novelty

Effective Date: Patent/patent application with an effective filing date (“EFD”) on/after March 16, 2013



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Novelty

New: 35 USC § 102(a)(1)

A person shall be entitled to a patent unless:

claimed invention was:

- patented,
- described in a printed publication, or
- in public use,
- on sale, or
- otherwise available to the public

before **EFD** of claimed invention



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Novelty

New 35 USC § 102(a)(1)

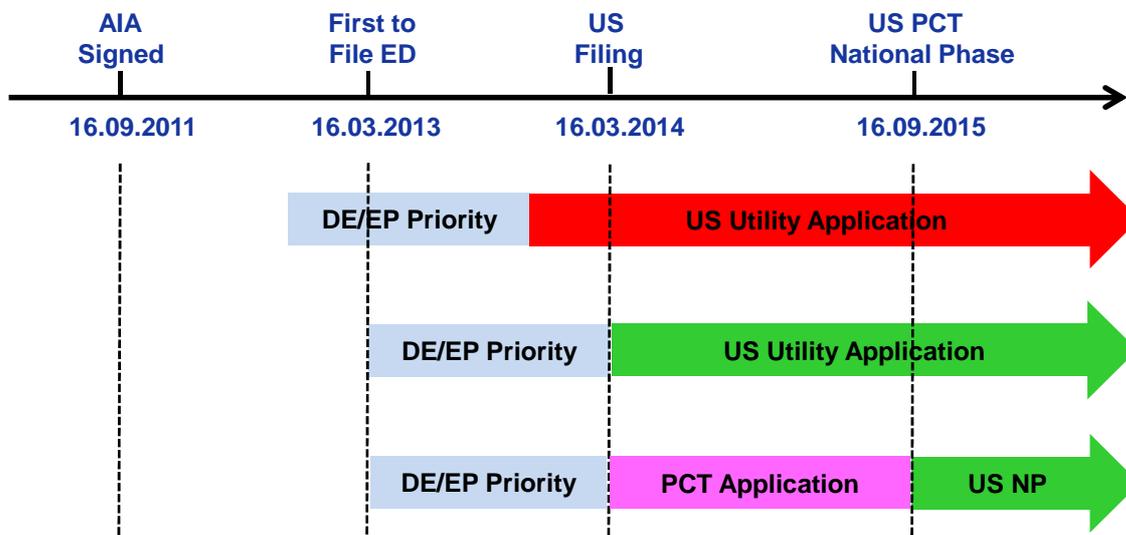
- “Absolute” novelty worldwide as of EFD of claimed invention
- **EFD** of claimed invention =
 - **Actual filing date** of patent/patent application in USA, or
 - **Earliest priority date** to which patent/patent application claims priority (US, PCT or foreign priority)
- Provisional applications lose their luster
- Can avoid or apply AIA by claiming/not claiming priority



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Novelty Effective Date



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Exception to Novelty

New: 35 USC § 102(b)

Disclosure \leq 1 year before EFD \neq prior art if:

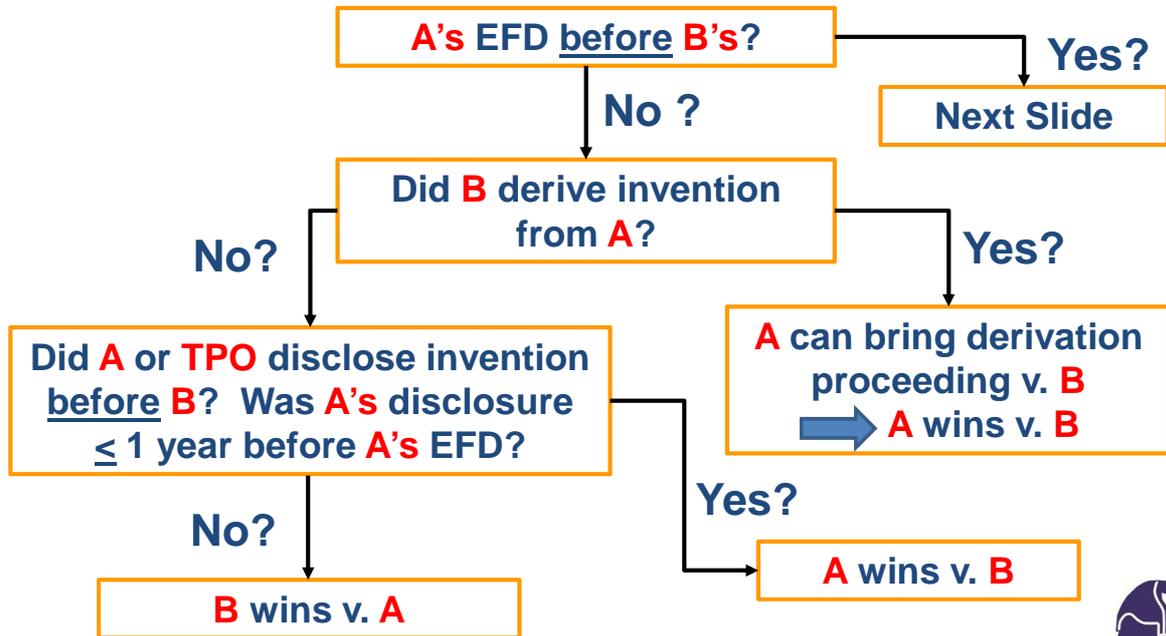
- (A) Disclosure by inventor or third party who obtained subject matter from inventor (“TPO”); or**
- (B) Disclosure by third party, but after disclosure by inventor or TPO**

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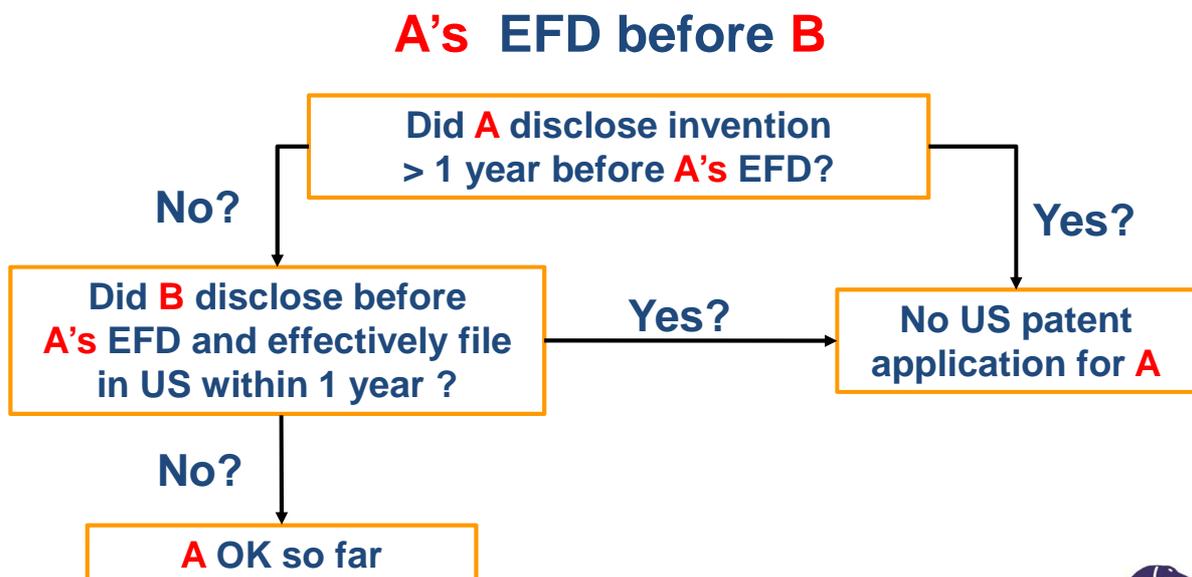


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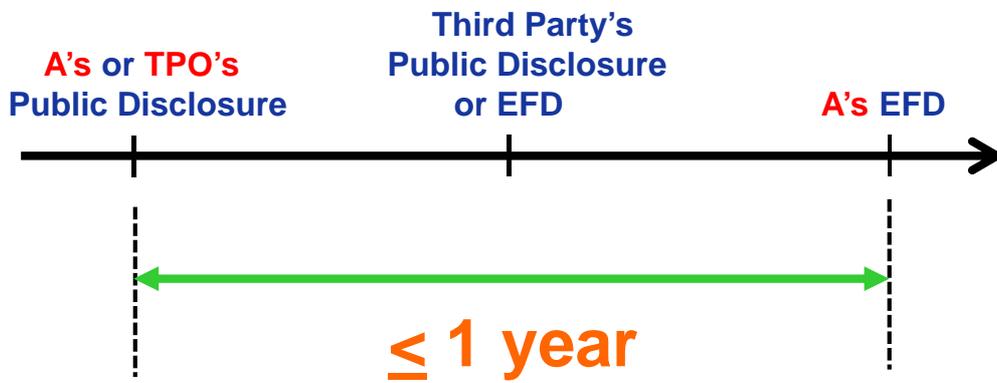
Novelty Flow Chart I



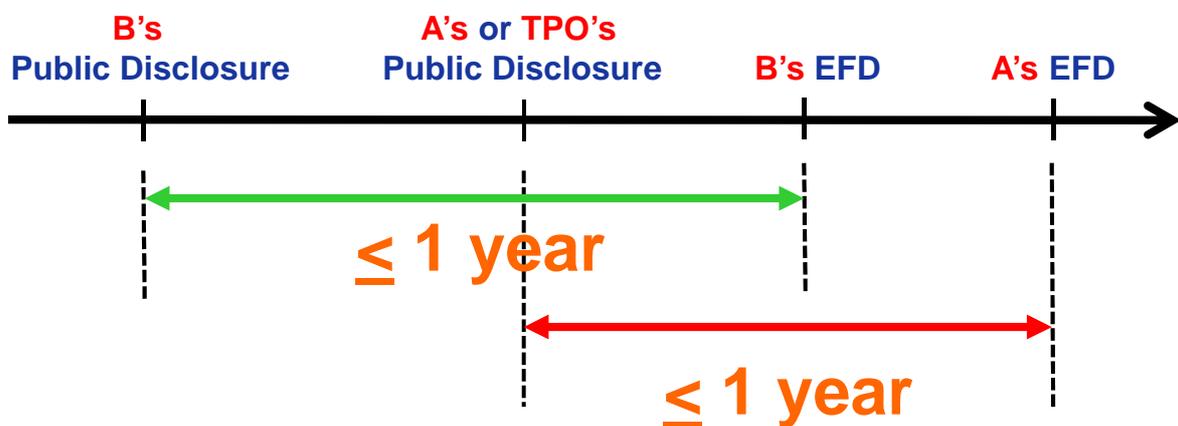
Novelty Flow Chart II



Novelty Timeline



Novelty Timeline



Novelty

New: 35 USC § 102(a)(2)

A person shall be entitled to a patent unless:

Claimed invention is described in:

- Issued US patent / published US patent application;
which
- Names another inventor; and
- Has EFD **before** claimed invention

Note: EFD includes priority via 35 USC § 102(d)(2)
(= US, PCT, foreign priority)

Compare to: **Älteres Recht**



Exception to Novelty

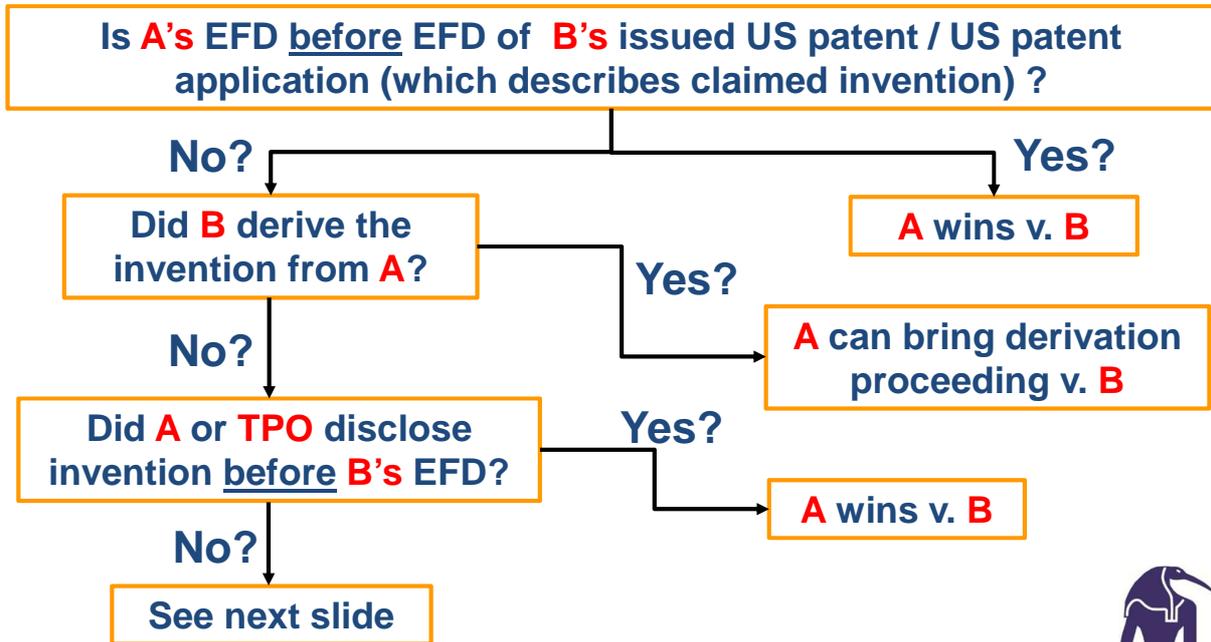
New: 35 USC § 102(b)

Disclosures in US patents / patent applications made before EFD of claimed invention ≠ **prior art** if:

- (A) Disclosure by **TPO**;
- (B) Public disclosure by **inventor** or **TPO** before third party disclosure was effectively filed
- (C) Subject matter disclosed + claimed invention were **owned** (or subject to **obligation of assignment**) to the same person not later than EFD of claimed invention
 - Deemed common ownership if a **Joint Research Agreement** in place before EFD



Novelty Flow Chart III

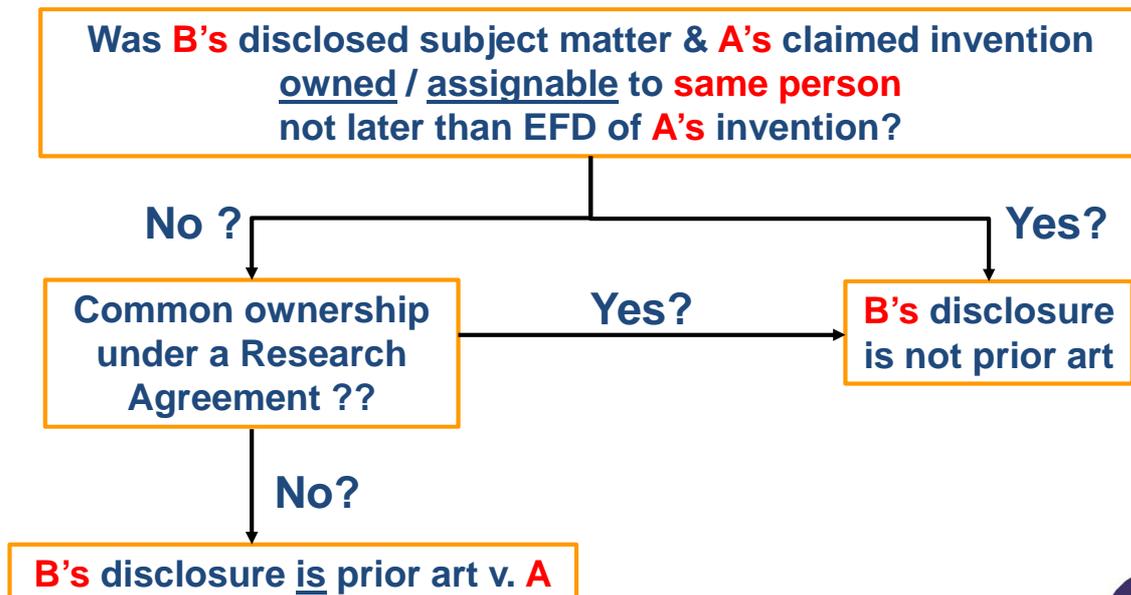


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Novelty Flow Chart III



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Section 3

Obviousness

Effective Date: Patent/patent application with an EFD on/after March 16, 2013



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Obviousness

New: 35 USC § 103

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section ~~102 of this title~~, if the differences between the claimed inventions~~subject matter sought to be patented~~ and the prior art are such that the claimed invention ~~subject matter~~ as a whole would have been obvious before the effective filing date of the claimed invention~~at the time the invention was made~~ to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.



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Obviousness

New: 35 USC § 103

- **Time period for determining obviousness changes**
 - Is now “before the effective filing date of the claimed invention”
 - Was “at the time the invention was made”
- **Scope of review redefined**
 - Is now “claimed invention”
 - Was “subject matter sought to be patented”
- **Prior art determined by § 102**
- **All other provisions ((b)(1)-(c)(3) deleted**



Part II

Post-Grant Proceedings



Post-Grant Proceedings

Procedures Available until September 16, 2012

1. Ex-Parte Reexamination
2. Inter-Partes Reexamination
3. Reissue
4. Interference



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Post-Grant Proceedings

Procedures Available as of September 16, 2012

1. Ex-Parte Reexamination
2. Inter-Partes Review (IPR)
3. Reissue
4. Derivation Proceedings

New Procedures Available as of September 16, 2012

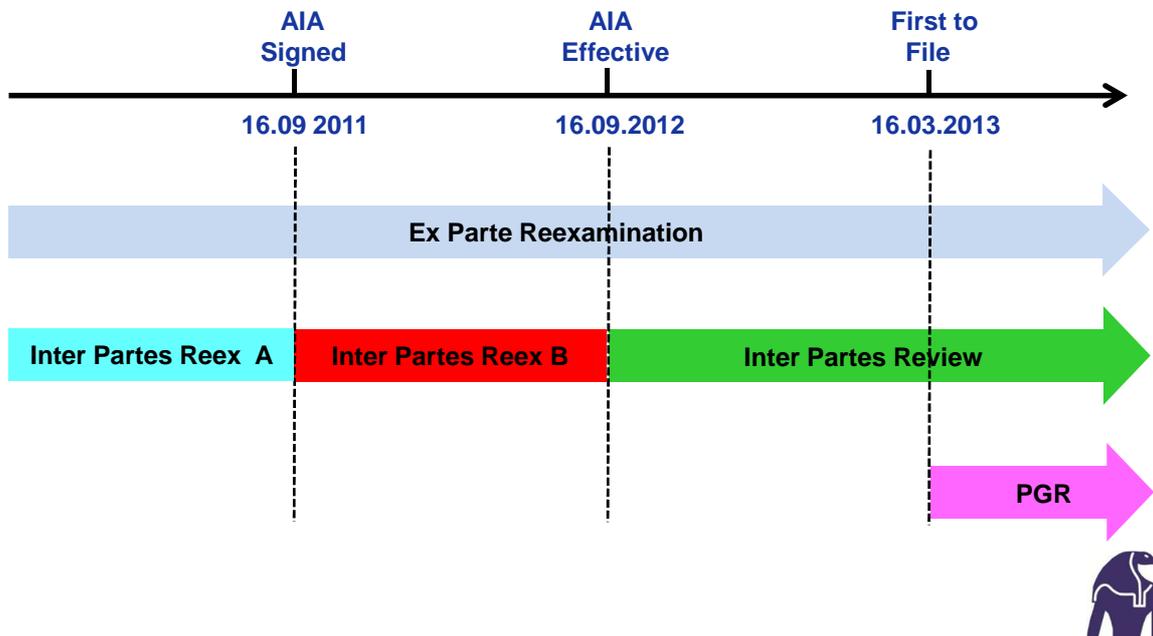
5. Post-Grant Review (PGR)
6. Supplemental Examination (SE)
7. Transitional PGR for Covered Business Methods



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Timing Example I



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Past USPTO Post-Grant Review Proceedings - Reexamination

	Ex Parte Reex.	Inter Partes Reex.
Who can Request	Patentee or Individual/Company (can be anonymous)	Individual/Company (can't be anonymous)
Participation of Reexam Requester	Terminates Prior to First Office Action by USPTO	Continues Through Reexam and Appeal
Patents Eligible	Granted on Application Filed On/After July 1, 1981	Filed On/After November 29, 1999
Prior Art Available	Patents and Printed Publications	Patents and Printed Publications
Threshold	Substantial New Question of Patentability	Substantial New Question of Patentability
Standard of Proof	Preponderance of Evidence	Preponderance of Evidence
Settlement?	No	No
Discovery	No	No
Appeal	BPAI + CAFC	BPAI + CAFC
Estoppel	No	Yes (USPTO + Civil Action)

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Current USPTO Post-Grant Review Proceedings - Reexamination

	Ex Parte Reex.	Inter Partes Reex.
Who can Request	Patentee or Individual/Company (can be anonymous)	Individual/Company (can't be anonymous)
Participation of Reexam Requester	Terminates Prior to First Office Action by USPTO	Continues Through Reexam and Appeal
Patents Eligible	Granted on Application Filed On/After July 1, 1981	Filed On/After November 29, 1999
Prior Art Available	Patents and Printed Publications	Patents and Printed Publications
Threshold	Substantial New Question of Patentability	Reasonable likelihood to prevail on at least one claim
Standard of Proof	Preponderance of Evidence	Preponderance of Evidence
Settlement?	No	No
Discovery	No	No
Appeal	BPAI + CAFC	BPAI + CAFC
Estoppel	No	Yes (USPTO & Civil Action)

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USPTO Post-Grant Proceedings as of Sept. 16, 2012

	Ex Parte Reex.	IPR	PGR
Who can Request?	Patentee or Individual/Company (can be anonymous)	Individual/Company (can't be anonymous)	Individual/Company (can't be anonymous)
Participation of Reexam Requester	Terminates Prior to First Office Action by USPTO	Continues Through Review and Appeal	Continues Through Review and Appeal
Patents Eligible	Granted on Application Filed On/After July 1, 1981	After 9 months of patent grant or reissue; or after end of post-grant review On/After: Sept. 16, 2012	Within 9 months after patent grant / reissue On/After: Sept. 16, 2012 <u>Note: first to file patents!</u>
Prior Art Available	Patents and Printed Publications	Only § 102 & 103 and only patents and printed publications	Anything under § 282(2)-(3) relating to invalidity (§ 101-103, 112, 251)
Threshold	Substantial New Question of Patentability	Reasonable likelihood to prevail on at least one claim	More likely than not that at least 1 claim of patent is unpatentable
Standard of Proof	Preponderance of Evidence	Preponderance of Evidence	Preponderance of Evidence

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USPTO Post-Grant Proceedings as of Sept. 16, 2012

	Ex Parte Reex.	IPR	PGR
Examiner Interview?	Yes	No	Probably Not
Discovery?	No	Yes	Yes
Estoppel?	No	<ul style="list-style-type: none"> • Yes for USPTO, Civil Action + ITC • Written decision of PTAB • “Raised or reasonably could have raised” 	<ul style="list-style-type: none"> • Yes for USPTO, Civil Action + ITC • Written decision of PTAB • “Raised or reasonably could have raised”
Relation to Civil Action	No Automatic Stay	<ul style="list-style-type: none"> • IPR barred if civil action already started • Civil action stayed if brought afterwards 	<ul style="list-style-type: none"> • PGR barred if civil action already started • Civil action stayed if brought afterwards
Relation to Preliminary Injunction (PI)	None	None	PGR doesn't stay patent holder's request for PI if filed <u>≤ 3 months</u> after patent issues

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USPTO Post-Grant Proceedings as of Sept. 16, 2012

	Ex Parte Reex.	IPR	PGR
Relation to Patent Infringement Suit	None	Need to file for IPR < 1 year of service of complaint	None
End via Settlement?	No	<ul style="list-style-type: none"> • Yes (then no estoppel) • Submit joint request of parties • Submit copy of Settlement Agreement • Can keep confidential 	<ul style="list-style-type: none"> • Yes (then no estoppel) • Submit joint request of parties • Submit copy of Settlement Agreement • Can keep confidential
End via Petitioner Withdrawal?	No	PTAB has discretion	PTAB has discretion
Claim Amendment?	<ul style="list-style-type: none"> • Cancel or narrow claims • Can't broaden 	<ul style="list-style-type: none"> • Cancel or narrow claims • Submit (reasonable # of) substitute claims • Can't broaden 	<ul style="list-style-type: none"> • Cancel or narrow claims • Submit (reasonable # of) substitute claims • Can't broaden

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USPTO Post-Grant Proceedings as of Sept. 16, 2012

	IPR	PGR
Replies	<ul style="list-style-type: none"> • Petitioner files request for IPR • Patent owner files preliminary response • Director institutes IPR (not appealable) • Patent owner files response • Petitioner files written comments 	<ul style="list-style-type: none"> • Petitioner files request for PGR • Patent owner files preliminary response • Director institutes PGR (not appealable) • Patent owner files response • Petitioner files written comments
Oral Hearing?	Yes (each party)	Yes (each party)
Decision	PTAB	PTAB
Appeal	CAFC (each party)	CAFC (each party)
Timing	Completion within 1 year (extendable by six months)	Completion within 1 year (extendable by six months)
Intervening Rights?	Yes	Yes

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Proposed Costs of USPTO Post-Grant Proceedings

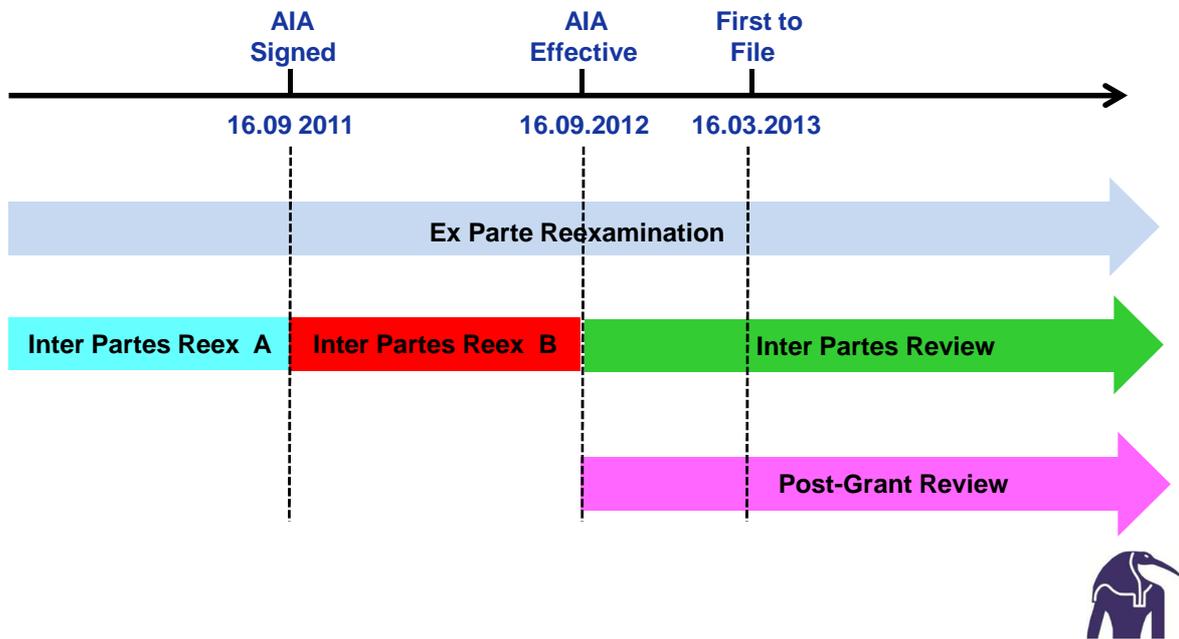
Proposed Fees:

	Current	Proposed
Ex Parte Reexamination	\$ 2,520	\$ 17,760
Inter Partes Review (IPR)	\$ 8,800	\$ 27,200 (1-20 claims) \$ 95,200 (61-70 claims) \$ 27,200 (for each additional 10 claims)
Post-Grant Review (PGR) including PRG for Business Methods		\$ 38,500 (1-20 claims) \$ 125,300 (61-70 claims) \$ 35,800 (for each additional 10 claims)
Supplement Examination		\$ 5,180 (request) + \$ 16,120 (Reexam)

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Timing Issues

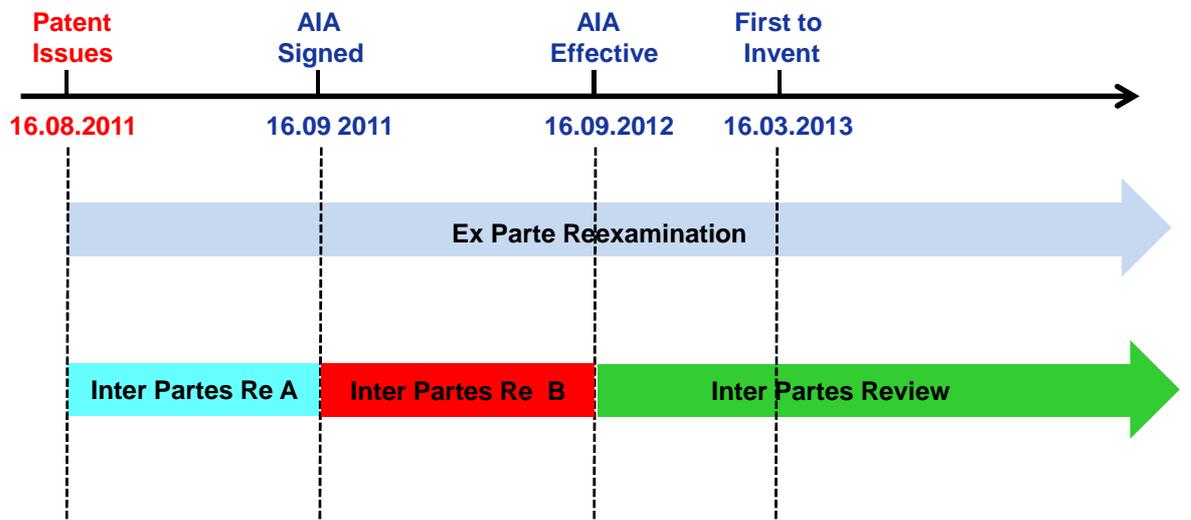


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Timing Example I



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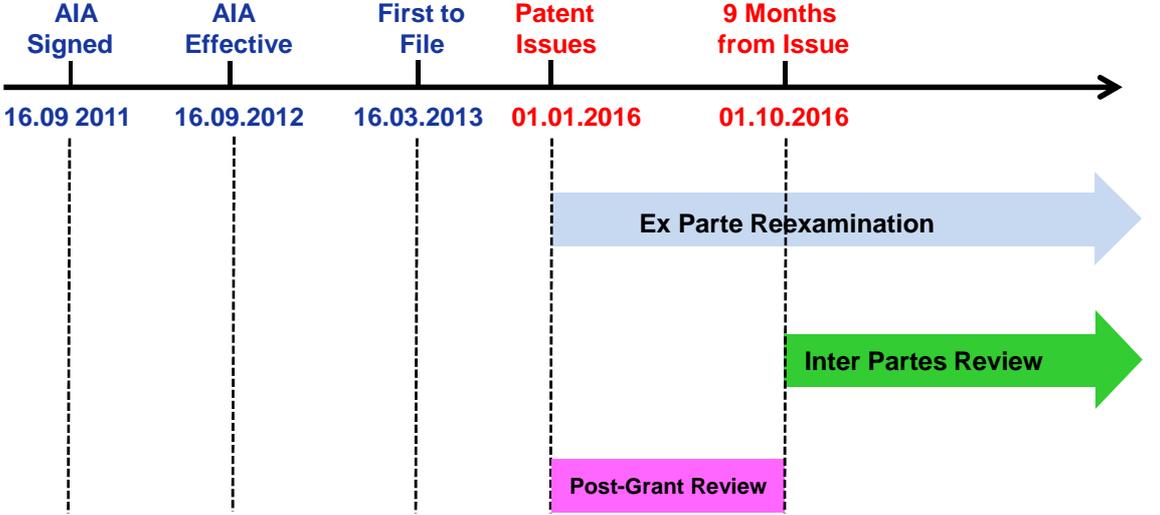


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Timing Example II



Timing Example III



Section 12

Supplemental Examination

Effective Date: Patents issued before, on or after September 16, 2012



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Supplemental Examination

New 35 USC § 257

- Can only be requested by **patent owner**
- Why request SE? To have the USPTO “consider, reconsider or correct information believed to be relevant to the patent”
 - “**Information**” is broad. Examples include public prior use, prior sales or offers of sale etc.
- Effect? Patent **cannot be held unenforceable or invalid** if information is considered, reconsidered or corrected during SE
- SE request **doesn't impact enforceability** of patent



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Supplemental Examination

Patent owner submits **request** to the Director

- Threshold: **substantial new question of patentability (SNQ)**

Director has **3 months** to decide on SE request

- If SNQ exists, Director will order **reexamination** of patent

Rules for ex parte reexamination generally apply (but **not** limited to patents and printed publications)



Supplemental Examination

Exception: Enforceability can be affected when:

- **Prior Allegation** is pled in a **civil action** or a **Hatch-Waxman Act ANDA notice letter** **before** date of SE request
- **Prior Allegation** is made in **patent infringement action** or **ITC action**, unless SE and reexamination are concluded **before** action is brought

Fraud

- Can use SE to cure misconduct (inequitable conduct)
- If **material fraud**: Director **can** cancel claims, and **must** refer fraud to the Attorney General for prosecution (example: inventor's false declaration)



Section 18

Transitional PGR Program for Covered Business Methods

Effective Date: Sept. 16, 2012 to Sept. 16, 2020



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Business Methods

Director to establish transitional post-grant review proceedings (“**TPGR**”) regulations by Sept. 16, 2012

What is a Covered Business Method Patent?

- A patent that claims (method, apparatus) for performing data processing used in the **practice, administration, or management of a financial product or service**

Can't file petition for unless sued for **infringement !**

Procedure similar to **PGR**, except:

- **Can** stay civil action if preliminary injunction requested
- Estoppel before civil court or ITC more limited
 - “on any ground that the petitioner **raised** during the PGR”
 - (**not**: “or reasonably could have raised”)



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Section 3

Derivation Proceedings

Effective Date: Patent/patent application with an EFD on/after March 16, 2013



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Derivation

- 35 USC §§ 135 and 291 are amended to delete **interferences** and to provide for **derived patents** and **derivation proceedings**
- Derivation = when one inventor derives/obtains invention from (true) inventor
- Can involve:
 - two patents
 - two patent applications, or
 - a patent application and a patent



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Derivation of Patents

Civil Action via 35 USC § 291

- Involves **two patents** to the same invention
- One patent has earlier EFD
- Patent with earlier EFD derived from (true) inventor
- Must bring action no later than **1 year** after first patent issued

Compare to § 8 Satz 2 PatG



Derivation of Applications

Petition to USPTO via 35 USC § 135

- Involves **two patent applications or patent application and patent**
- Must file petition no later than **1 year** after first publication of a claim that is substantially the same as earlier applicant's claim
- Support by "**substantial evidence**"
- Director may, but need not, institute a derivation proceeding. The Director's decision is **not appealable**
- If proceeding opened, PTAB determines if earlier inventor derived invention
- PTAB can correct inventorship



Derivation of Applications

- PTAB decision adverse to claims of an application = final refusal of the claims. A PTAB decision adverse to claims of a patent = cancellation of the claims.
- Parties can terminate proceedings by filing a **written statement** reflecting agreement on the correct inventorship
 - PTAB accepts agreement (unless inconsistent with evidence)
 - Agreement can be kept secret
- Parties can submit any issue to arbitration
- Patent term is **extended** during the derivation proceeding via 35 USC § 154(b)(1)(C)
- Losing party can **appeal** to CAFC via 35 USC § 146



Part III

Litigation Provisions



Section 7

Patent Trial and Appeal Board (PTAB)

Effective Date: Generally to proceedings started on/after September 16, 2011



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Patent Trial & Appeal Board (PTAB)

35 USC § 6

- Board of Patent Appeals and Interferences (BPAI) **renamed** Patent Trial and Appeal Board (PTAB)
- Duties of PTAB:
 - Review appeals of adverse Examiner decisions
 - Review appeals of reexaminations
 - Conduct derivation proceedings, IPR and PGR
- Have (at least) 3 members
- Can **appeal** decision to CAFC



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Section 5

Prior Commercial Rights

Effective Date: Patents issued on/after September 16, 2011



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Prior Commercial Rights

New: 35 USC § 273

Defense to infringement under 35 USC § 282(b) if:

- Person, in good faith, commercially used subject matter in the United States in connection with:
 - An internal commercial use or
 - An actual arm's length transaction

Prior use must have occurred **> 1 year** before earlier of:

- EFD of claimed invention or
- Date when claimed invention disclosed to public

Defense must be established by **clear and convincing evidence**

No defense if only preparations to use („Veranstaltungen“)



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Prior Commercial Rights

Deemed Commercial Uses:

- **Premarketing regulatory review** (to test safety or efficacy)
- Use by **nonprofit research laboratory** or other **nonprofit entity** (university or hospital) if:
 - Public is intended beneficiary
 - Defense only for continued and noncommercial use by & in laboratory / nonprofit entity

Exhaustion of Patent Rights

- Sale by person entitled to the defense also **exhausts** patent owner's rights



Prior Commercial Rights

Limitations and Exceptions

- Can only be raised by person who **performed** or **directed** the commercial use (or by entity controlled by or under common control with person)
- Cannot be **licensed, transferred, assigned** (except for good faith sale of entire enterprise or line of business)
- Can only be used **at site** where used
- Can't raise defense if invention derived from patentee
- Defense **≠ general license** of patent. Defense goes only to the subject matter of qualifying commercial use
 - Can vary quantity and volume
 - Improvements included
- Can't raise defense if use was **abandoned**



Prior Commercial Rights

Limitations and Exceptions Cont.

- Can't raise defense if invention was subject to an **obligation of assignment** to a university or technology transfer organization when made

Miscellaneous:

- If infringer raises the prior user defense, then fails to demonstrate a **reasonable basis** for the defense, court must find the case **exceptional** & award attorney fees
- Patent is not deemed **invalid** because the defense is raised

Compare: § 12(1) PatG



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Section 15

Best Mode Requirement

Effective Date: Applies to any patent infringement proceeding brought on or after September 16, 2011



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Best Mode

New 35 USC § 112(a) now requires that:

“Specification ... shall set forth the best mode contemplated by the inventor or joint inventor of carrying out the invention.”

New 35 USC § 282(3), however, now removes the best mode as a defense to patent infringement based on patent invalidity



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Section 16

Patent Marking

Effective Date: Applies to any case pending on, or commenced on or after Sept. 16, 2011



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Patent Marking

False Marking

- Only United States can sue to fine \$ 500 for false patent marking
- Any person who suffered a **competitive injury** by a false patent marking can sue in a US District Court for damages
- No false patent marking violation if **expired patent** placed on product

Amended 35 USC § 287(a) allows for “**virtual marking**”=

- Free public internet address
- Patented article associated with patent number



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Other Litigation Provisions

Other Litigation Provisions



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Other Litigation Provisions

Venue (§ 9 AIA)

USDC ED Virginia replaces **USDC DC** for certain actions:

- Civil action to obtain patent
- Civil action for derivation proceedings
- Appeal from patent term adjustment determination
- Jurisdiction over non-resident patentees

Joinder in Civil Actions (§ 19 AIA)

Can now join alleged infringers in one civil action only if:

- Right to relief asserted jointly /severally
- Based on same transaction / occurrence
- Relating to same accused product / process
- Can't join based because parties infringed same patent

Effective Date: Civil action commenced on/after Sept. 16, 2011



Other Litigation Provisions

Advice of Counsel (New 35 USC § 298)

- Can't use failure to obtain advice of counsel or failure to provide such advice of counsel to court/jury to prove that (alleged) infringer **willfully infringed** or intended to **induce infringement** of patent.

Effective Date: Presumably on/after Sept. 16, 2012
(based on catch-all provision)



Part IV

Miscellaneous Provisions



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Section 8

Preissuance Submissions by Third Parties

Effective Date: Can submit for any patent application filed before, on or after Sept. 16, 2012



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Third Party Submissions

New 35 USC § 122(e)

- Any **third party** can submit patents, published patent applications or other printed publications in a **patent application**
- Submit in writing before earlier of:
 - Date of Notice of Allowance
 - or the later of:
 - **6 months** after date of first publication (previously 2 months) or date of **first rejection** by Examiner
- Provide **concise description of relevance** of each document submitted



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Section 4

Inventor's Oath or Declaration

Effective Date: Any patent application filed on or after Sept. 16, 2012



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Oath or Declaration

New: 35 USC § 115

Oath / Declaration must include:

- Name of each inventor
- That inventor authorized application to be filed
- Inventor believes he/she is the **original inventor**
 - Statement can be included in **assignment**

Submit **substitute statement** (instead of oath/declaration) if:

- Inventor is deceased, legally incapacitated, cannot be found or refuses to sign
- Must identify inventor, set forth circumstances why statement is being filed, and contain any additional information Director might require



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Section 4

Filing by Other than Inventor

Effective Date: Any patent application filed on or after Sept. 16, 2012



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Filing by Other than Inventor

New: 35 USC § 118

Application for patent can be filed by:

- Patent application can be filed by person to whom inventor **has assigned / is obligated to assign**
- 35 USC § 118 no longer contains the language:
“Whenever an inventor refuses to execute an application for patent, or cannot be found after diligent effort ...”
- Person other than inventor can file patent application if:
 - Shows sufficient proprietary interest
 - Proof of pertinent facts
 - Provides showing that such action is appropriate to preserve the rights of the parties
- Patent granted is to the **real party in interest**



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Filing by Other than Inventor

Potential Impact 35 USC § 118

- German company can therefore file the patent application directly based on ArbEG + employment agreement:
 - ArbEG + employment agreement = showing of sufficient proprietary interest & proof of pertinent facts
 - Provide showing that such action is appropriate to preserve the German company's rights
- Patent granted to German company as **real party in interest**

Recommendation: Wait and See



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Section 11

Prioritized Examination

Effective Date: Utility application filed on/after Sept. 26, 2011

Participate earlier via PCT bypass



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Prioritized Examination

Prioritized Examination (PE) Requirements:

- Request for PE
- Pay fee of **\$ 4,800** (reduction proposed to **\$ 4,000**)
+ fees for filing, search, examination, excess claims, size fees, processing fee and publication fees
- Until regulations are issued:
 - No more than 4 independent + 30 total claims
 - No more than 10,000 requests/year
- Application must be complete (oath etc.) + filed via EFS



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Prioritized Examination

Goal

- Final disposition within 12 months after granting prioritized status
 - “Final disposition” = notice of allowance, final office action, notice of appeal, completing examination, RCE, or abandonment

PE Terminated if:

- File petition for extension of time
- Request suspension of action
- Filing amendment resulting in > 4 independent or > 30 claims
- No refund if terminated



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Other Miscellaneous Provisions

Other Miscellaneous Provisions



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Other Miscellaneous Provisions

Fee Setting Authority (§ 10 AIA)

- USPTO can set/adjust fees to cover costs
- Establishment of **Reserve Fund** (§ 22 AIA)
- **75 %** reduction of fees for **micro entities**
 - Discount also granted if applicant employed by / obligated to assign to “**institution of higher education**”
- New **proposed fees** are generally higher
➔ See [USPTO Proposed Fee List](#)

Tax Strategies (§ 14 AIA)

- For reducing / avoiding / deferring tax liability are deemed to be prior art

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Other Miscellaneous Provisions

Deletion of “Deceptive Intent” (§ 20 AIA)

Examples: Amending inventorship, foreign filing license, reissue, disclaimer

Satellite Offices (§ 23 AIA)



Elijah J. McCoy
(1844-1929)

- USPTO can create 3 or more offices
- First in Detroit = “Elijah J. McCoy United States Patent and Trademark Office”

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Other Miscellaneous Provisions

Patents on Human Beings (§ 33 AIA)

- No patent may issue on a claim directed to or encompassing a human organism.
- Analog R 29(a) EPC



My Goose is Cooked!

End



For Questions....



**PATENT LAW OFFICES OF
DR. NORMAN B. THOT**

**Mülheimer Straße 12
40878 Ratingen**

**Postfach 10 37 56
40837 Ratingen**

**Tel: (02102) 168928-0
Fax: (02102) 168928-20
E-Mail: mail@thot-patent.de
Internet: www.thot-patent.de**

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