

The webinar presentation, accompanying slides, and Question and Answer session do not contain legal advice, should not be relied upon as legal advice, do not create an attorney-client relationship, and the viewers, listeners and readers should consult with legal counsel in regard to their particular circumstances.

New Year and New Patent Laws Scientists Should Know

January 12, 2012

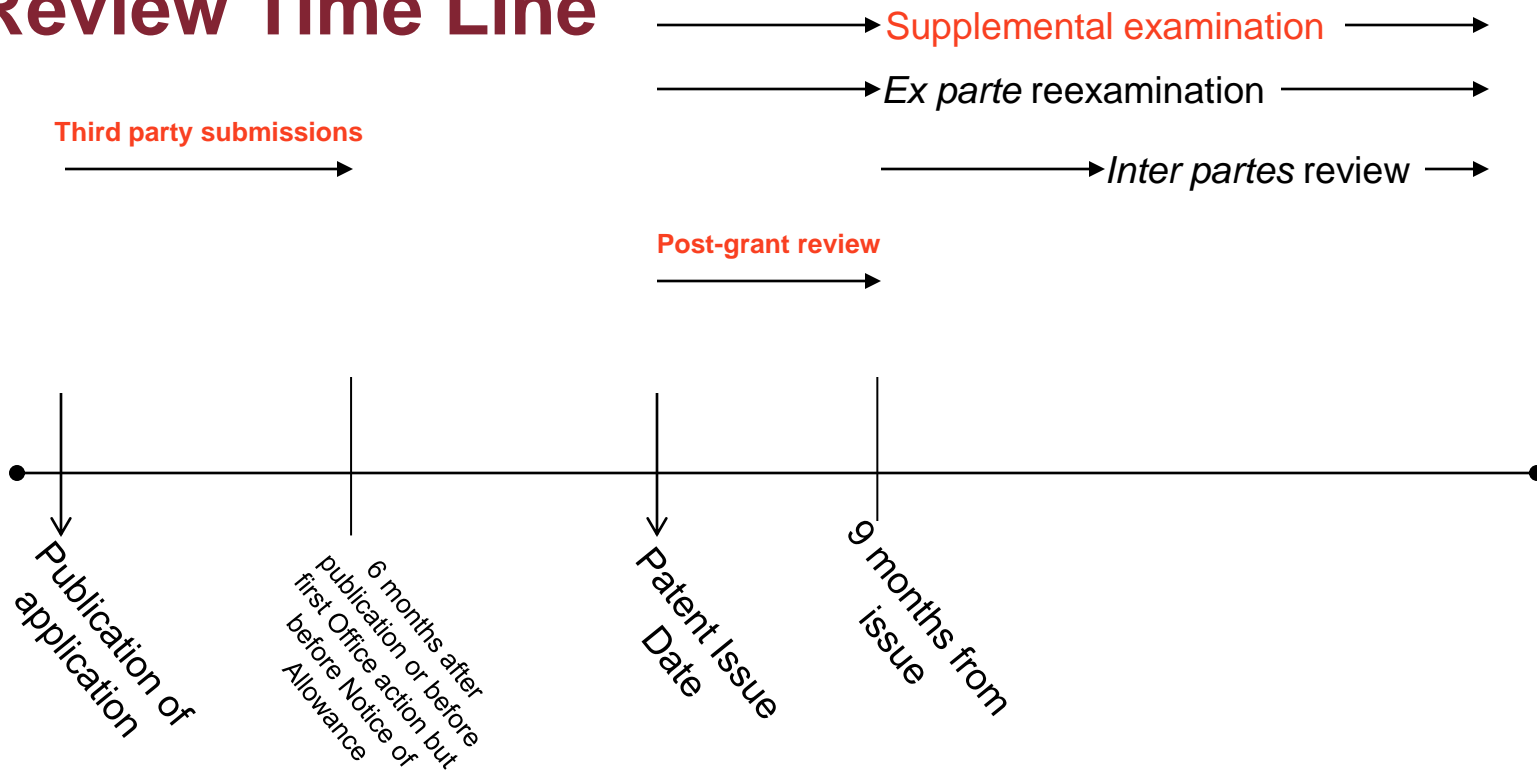
Michael H. Brodowski, Ph.D.

www.klgates.com

America Invents Act – Overview

- Pre- and Post-Patent Grant Review Proceedings
- Litigation Aspects
- Patent Office Funding, Fees and Miscellaneous Changes
- First-Inventor-To-File Patent Priority System
 - Notebooks
 - “Disclosures” and One Year Grace Period
 - Practical Advice

Review Time Line

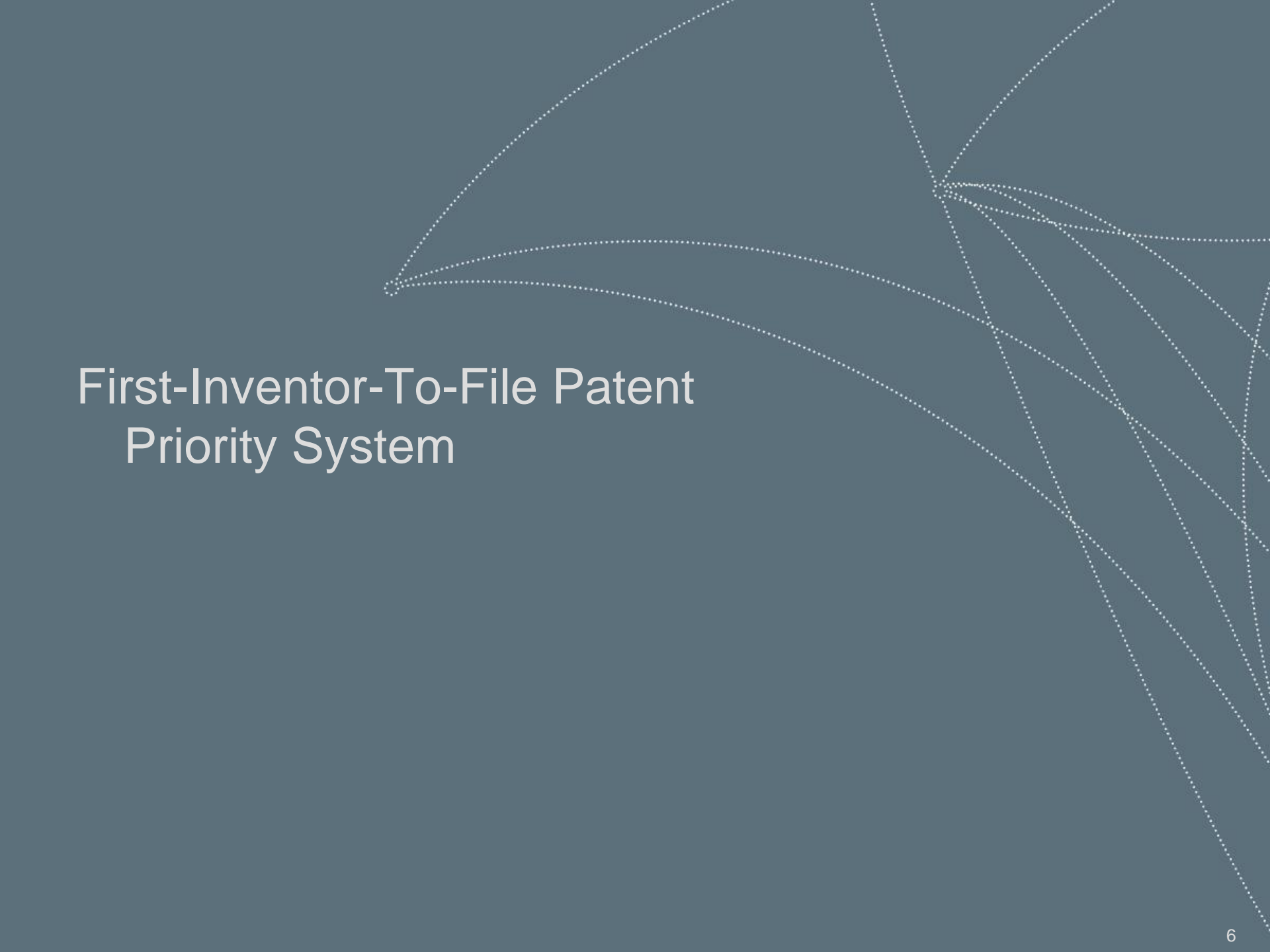


Litigation Aspects

- Prior Commercial Use - Expanded Defense to Infringement
- Best Mode No Longer Available to Invalidate Patent
- Virtual Patent Marking With Reference to Internet Address
- False Patent Marking Suit Requires Competitive Injury
- Joinder of Parties Limited
- Advice of Counsel Rule Codified

Patent Office Funding, Fees and Miscellaneous

- Patent and Trademark Fee Reserve Fund created to collect fees received above annual appropriation but requires Congress to appropriate back to Office
 - Any real change?
- Fees
 - Increased 15% on September 26, 2011
 - “Institution of higher education” qualifies as microentity entitled to a 75% discount on fees compared to 50% for small entities
- Track 1 Accelerated Examination
- Satellite Patent Offices
 - Three in next 3 years; first in Detroit



First-Inventor-To-File Patent Priority System

First-Inventor-To-File Patent Priority System

- Effective for applications filed after March 15, 2013
- “Effective filing date” determines priority and what constitutes prior art
- Expansion of prior art
 - Prior use and on sale anywhere in the world
 - Patents and published applications as of their effective filing date
 - Includes foreign priority dates
 - Available for novelty and obviousness purposes
 - Harsher than corresponding European rule

First-Inventor-To-File Patent Priority System

- Exceptions to prior art
 - One year to file in the U.S. after disclosure by inventor(s) or disclosure obtained from inventor(s)
 - But no grace period outside of U.S.
 - Patent or published application not considered prior art as of effective filing date where commonly-owned or under joint research agreement
 - But is prior art as of its publication date
- Derivation Proceedings
 - Replace interferences

“Disclosures” and One Year Grace Period

- If interested in rights outside U.S., then already should be filing before disclosure
- One year grace period should be backstop for inadvertent pre-filing disclosure
- “Disclosure,” like other new terms, to be defined by the courts
- Sufficiency of disclosure
 - Teach skilled artisan how to make and use
- Evidence of disclosure
- **FILE FIRST!**

Notebooks

- Inventor notebooks continue to be relevant
 - Valuable history of work and activities
 - Can be useful evidence in derivation proceedings
 - Can be useful evidence in prior commercial use defense
 - Corroboration (co-signature) not necessarily needed, but strengthens evidentiary proof
- Consider documenting transfer of information outside of company; e.g., what, to whom and when, and whether under confidentiality agreement

First-Inventor-To-File - Considerations

- Rush to file?
- Need to develop and describe invention sufficient for patentability before file application
- Provisional applications with follow-ons within one year to secure early effective filing date for new discoveries or improvements
 - Consider 18 month publication date to avoid own prior art

Considerations for New Patent Laws

- Proactive patent portfolio management
 - Review invention disclosures regularly
 - Determine diligently commercial potential and development timeline
 - Talk with patent counsel about ripeness for filing or if disclosure to occur, e.g., journal publication
 - If concerned with patent rights outside U.S., already think “file before disclose”
- Monitor competitors’ patenting activity

Thank you for your time

- Questions and Answers
- If not now, please contact me at:

Michael H. Brodowski, Ph.D.

K&L Gates LLP

State Street Financial Center

One Lincoln Street

Boston, MA 02111-2950

(617) 261-3113 (direct)

(617) 261-3175 (fax)

michael.brodowski@klgates.com

www.klgates.com

The webinar presentation, accompanying slides, and Question and Answer session do not contain legal advice, should not be relied upon as legal advice, do not create an attorney-client relationship, and the viewers, listeners and readers should consult with legal counsel in regard to their particular circumstances.