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U.S. Patent Reform: What Already Has Changed, What Lies Ahead

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On September 16, 2011, President Obama signed the Leahy-Smith America Invents Act into law, making the most sweeping changes to U.S. patent law since at least the 1950's. Many of the provisions can be broadly classified into those that serve the goal of international harmonization (first-inventor-to-file), those that target patent quality concerns (pre-issuance submissions, inter partes review, post grant review), and those that seek to rein in litigation costs (limitations on joinder). This article provides a brief overview of the many different changes, their effective dates, and the USPTO's rulemaking process.

America Invents Act Effect Dates

Different provisions of the Act take effect at different times, with some effective immediately and some not taking effect until March 16, 2013. The “default” effective date is September 16, 2012, with changes applicable to patents *issued* on or after that date.

The following provisions took effect **September 16, 2011**:

- Ban On Tax Strategy Patents—applicable to **pending** applications.
- Ban On Patents To A Human Organism—applicable to **pending** applications.
- Change to Inter Partes Reexamination standard from “substantial new question of patentability” to “a reasonable likelihood that the requestor would prevail” with respect to at least one of the challenged claims.
- Appeal of Board decisions in ex parte reexamination to Federal Circuit only—applicable to **pending** and future Board appeals.
- Changes to requirements for standing to bring False Marking cases and marking requirements—applicable to **pending** proceedings.
- Limitations on joinder of defendants in infringement actions—applicable to all actions commenced on or after September 16, 2011.
- Best Mode violation no longer a basis for invalidating a patent—applicable to proceedings commenced on or after September 16, 2011.
- Changes to Prior Use Defense—applicable to any patent **issued** on or after September 16, 2011.

The following changes took effect on **September 26, 2011**:

- A 15% surcharge was added to most patent-related fees, including patent maintenance fees.
- A “Track I” program was implemented for [fee-based expedited examination](#). (This program has since been extended to applications in which a [Request for Continued Examination](#) has been filed.)

The following changes took effect on **November 15, 2011**:

- An “electronic filing incentive” was implemented to charge a \$400 fee for new U.S. applications (but not PCT national stage applications) that are **not** filed electronically.

The following changes will take effect on **September 16, 2012**, most with **retroactive** effect:

- Filing By “Applicant”—applicable to any application **filed** on or after September 16, 2012.
- Preissuance Submissions by third parties—applicable to any **pending** application.
- Citation of Prior Art and Written Statements in patent files
- Revised Ex Parte Reexamination procedures
- New Inter Partes Review procedures (replacing current Inter Partes Reexamination procedures)
- Transitional Post-Grant Review procedures for Business Method Patents—applicable to specifically defined “covered business method patents.”
- Elimination of requirement for no “deceptive intent” to correct errors in inventorship, to correct errors in a reissue application, or to obtain a retroactive foreign filing license—applicable to all proceedings commenced on or after September 16, 2012.

The following changes take effect **March 16, 2013**:

- First-Inventor-To-File—applicable to any application with a **single patent claim** that has an effective filing date of March 16, 2012 or later, and to all applications that claim priority to such applications.
- New Post-Grant Review procedures — available for any patent encompassed by the new first-inventor-to-file provisions.
- Phasing out of Interference proceedings in favor of new Derivation proceedings—only the new derivation proceedings will be available to applications where **all** patent claims have an earliest effective filing date of March 16, 2013 or later.

The USPTO Rulemaking Process

While the America Invents Act sets forth the new law, the USPTO will promulgate regulations that will set forth detailed requirements and procedures to implement the many different changes. As set forth on the USPTO’s [America Invents Act Implementation website](#), the USPTO will issue

proposed rules and solicit written comments from the public during [90-day comment periods](#). The USPTO will take the written comments into consideration, and will issue “final” rules at least 30 days before the relevant statutes and rules take effect. This “notice and comment” period is somewhat unique to U.S. administrative law, and gives the public an important opportunity to shape the rules that will govern U.S. patent practice for years to come.

The USPTO has issued its proposed rules to implement a number of the changes that take effect on September 16, 2012, including:

- Changes to the requirements for the “Inventor’s Oath or Declaration”
- Rules to implement procedures for “Preissuance Submissions by Third Parties”
- Rules to implement procedures for the “Citation of Prior Art and Written Statements” in patent files
- Rules to implement procedures for “Supplemental Examination” by the patent owner

(You can find my articles providing detailed summaries of these proposed rules at [PharmaPatentsBlog.com](#))

The USPTO has yet to issue proposed rules to implement the new Inter Partes Review and Post-Grant Review proceedings, but is expected to do so very soon. The USPTO is expected to issue proposed rules to implement the First-Inventor-To-File and Derivation provisions later in 2012.

The Months Ahead

The recent and upcoming changes to U.S. patent law are far-reaching, and will impact filing, prosecution, litigation and licensing strategies. While the international patent community can look to U.S. colleagues for guidance, international stakeholders should not wait to understand the changes that lie ahead, and should begin now to develop strategies for pursuing and protecting their U.S. patent rights under the new regime.

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