

America Invents Act

09.23.11

The Leahy-Smith America Invents Act was signed into law by President Obama on September 16, 2011. The Act makes numerous changes to the U.S. Patent system.

First-Inventor-to-File System:

- Transitions from a first-to-invent system to a first-inventor-to-file system. Effective March 16, 2013.
- Maintains a one-year grace period for inventors to file a patent application.
- Replaces interference proceedings with derivation proceedings, which determine whether an earlier application was derived from an inventor named in the petitioner's application without authorization.

Fee Changes:

- 15% increase in most USPTO fees. Effective September 26, 2011.
- 75% reduction in most fees for micro entities, as defined under 35 U.S.C. 123(a). Institutions of higher education are considered to be micro entities in most cases. Effective September 16, 2011.
- \$400 fee for applications (excluding design, plant, and provisional applications) not filed electronically. Effective 60 days after enactment.
- Prioritized Examination fee - \$4800.

Post-Grant Review:

- A person who is not the owner of a patent may petition for post-grant review within 9 months after the date the grant of the patent.
- The petition must demonstrate that it is more likely than not that at least one of the claims challenged in the petition is unpatentable.

Patentable Subject Matter:

- No patent may issue on a claim directed to or encompassing a human organism.
- Strategies for reducing, avoiding, or deferring tax liability are deemed insufficient to differentiate an invention from the prior art.

Litigation:

- Prior Commercial Use Defense: A prior commercial use defense may be used against patents issued on or after the date of enactment.
- Willful Infringement: Failure to obtain the advice of counsel cannot be used to prove willful infringement (35 U.S.C. 298).
- Best Mode: Failure to disclose the best mode cannot be a basis for holding any claim of a patent invalid or otherwise unenforceable.
- False Marking: False marking claims can only be filed by the United States or a person who has suffered a competitive injury as a result of a violation.
- Joinder: Joinder of accused infringers is permitted only if the act of infringement arises out of the same series of transactions or occurrences.

Contacts:

Lekha Gopalakrishnan | 214.745.5356 | lgopalakrishnan@winstead.com

Cathryn Berryman | 214.745.5172 | cberryman@winstead.com

Disclaimer: *Content contained within this news alert provides information on general legal issues and is not intended to provide advice on any specific legal matter or factual situation. This information is not intended to create, and receipt of it does not constitute, a lawyer-client relationship. Readers should not act upon this information without seeking professional counsel.*