

## I. Default Effective Date & Retroactivity

Default effective date: Enactment + 1 year (E+1 yr.), with exceptions

Default retroactivity: provisions apply to “any patent issued on or after” effective date, with exceptions

## II. Prior Art & First-to-File or Disclose\*

### A. 35 U.S.C. § 102(a)

- (a) “NOVELTY; PRIOR ART.—A person shall be entitled to a patent unless—
- (1) the claimed invention was **patented, described in a printed publication, or in public use, on sale, or otherwise available to the public** before the effective filing date of the claimed invention; or
  - (2) the claimed invention was described in a **patent** issued under section 151, or in an **application** for patent **published** or deemed published under section 122(b), in which the patent or application . . . names another inventor and was **effectively filed before the effective filing date** of the claimed invention.” (E+18 mos.)

Notes
“effective filing date,” not date of “invention by the applicant” (also for § 103)
“public use, on sale, or otherwise available” (“ <del>in this country</del> ”)

### B. 35 U.S.C. § 102(b)

- (b) “EXCEPTIONS.
- (1) DISCLOSURES MADE 1 YEAR OR LESS BEFORE THE EFFECTIVE FILING DATE OF THE CLAIMED INVENTION.—A **disclosure made 1 year or less before** the effective filing date of a claimed invention shall not be prior art to the claimed invention under subsection (a)(1) if—
    - (A) the disclosure was **made by the inventor** or joint inventor or by another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor; or
    - (B) the subject matter disclosed had, **before such disclosure**, been **publicly disclosed by the inventor** or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor.
  - (2) DISCLOSURES APPEARING IN APPLICATIONS AND PATENTS.—A disclosure shall not be prior art to a claimed invention under subsection (a)(2) if—
    - (A) the subject matter disclosed was obtained directly or indirectly from the inventor or joint inventor; or
    - (B) the subject matter disclosed had, before such subject matter was effectively filed under subsection (a)(2), been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor; or
    - (C) the subject matter disclosed and the claimed invention, not later than the effective filing date of the claimed invention, were owned by the same person or subject to an obligation of assignment to the same person.” (E+18 mos.)

### C. 35 U.S.C. § 102(c)

- (c) COMMON OWNERSHIP UNDER JOINT RESEARCH AGREEMENTS.
- ▶ Basic requirements to avoid prior art effect
    - Disclosed subject matter and claimed invention were both **made by, or on behalf of**, one or more **parties** to a joint research agreement;
    - Joint research agreement **in effect** on or before **effective filing date**
    - Claimed invention made as result of activities **within scope** of joint research agreement
    - Application for claimed invention discloses or is amended to **disclose names of parties** to joint research agreement. (E+18 mos.)

### D. 35 U.S.C. § 102(d)

- (d) “PATENTS AND PUBLISHED APPLICATIONS EFFECTIVE AS PRIOR ART.—For purposes of determining whether a patent or application for patent is prior art to a claimed invention . . . , such patent or application **shall be considered to have been effectively filed**, with respect to any subject matter described [therein]—
- (1) if paragraph (2) does not apply, as of the **actual filing date** of the parent or application for patent; or
  - (2) if the patent or application for patent is entitled to claim a right of priority . . . or to claim the benefit of an earlier filing date . . . , as of the filing date of the **earliest such application that describes the subject matter.**” (E+18 mos.)

## III. Pre-Issuance Provisions

### A. Third Party Involvement

35 USC § 122(e): Patent, published application or publication + “concise statement of asserted relevance” for “consideration” (timing: 6 mos. after application “first published,” with exceptions)

### B. Oath or Declaration & Filing of Application

35 USC § 115: Substitute statement in lieu of oath or declaration where inventor unable, or refuses, to sign

35 USC § 118: Application may be filed by non-inventor with proprietary interest where “appropriate” to preserve rights

### C. Derivation Proceedings

35 U.S.C. § 135: If derivation found, PTAB may correct inventor name(s) in application or patent (E+18 mos.) (applies to applications and patents that ever contained claim with effective filing date “on or after” 18 mos. from E)

### D. Interferences

Sec. 3(n)(2): Provisions of §§ 102(g), 135 & 291, in effect 1 day before effective date, apply to each claim of application, and patent “any patent issued thereon,” for which amended sections “also apply” if application or patent ever contained claim having effective filing date before effective date (E+18 mos.)

### E. Pending Interferences

Sec. 6(f)(3)(A): Interferences commenced before effective date (E+18 mos.) may (i) be dismissed without prejudice to petitioning for post-grant review, or (ii) proceed as if Act not enacted

### F. Fees

35 USC § 41(i): 15% surcharge on fees (E+10 days)

35 USC § 123: 75% fee reduction (E; sunset: 7 years) for Inst. Higher Educ. & micro-entities

35 USC § 123(h): \$400/200 additional for non-electronic filing non-provisional utility applications (E+60 days)

Event	Calendar Date
Enactment	September 16, 2011
Enactment + 10 days	September 26, 2011
Enactment + 60 days	November 15, 2011
Enactment + 1 year	September 16, 2012
Enactment + 18 months	March 16, 2013

(as provided by PTO)

## G. Prioritized Examination

35 USC § 41(h): add \$4,800/2,400 for original utility or plant application (E+10 days) (30 claims, 4 independent)  
35 USC § 2(b)(2)(G): PTO may permit for technologies “important” to national [i] economy or [ii] competitiveness

## H. Miscellaneous

35 USC § 157: Statutory invention registration repealed (E+18 mos.)  
Sec. 23: PTO to establish 3+ satellite offices for examination (< E+3 yrs.)

## IV. Appeals or Civil Actions taken from PTO

35 USC § 141(a) Examinations—civil action in district court (§ 145) or Federal Circuit  
35 USC § 141(b)-(c) Reexaminations, post-grant & *inter partes* reviews—Federal Circuit  
35 USC § 141(d) Derivation—civil action in district court (§ 146) or Federal Circuit (unless adverse party elects (§ 146))  
35 USC §§ 32, 145-46, 154(b)(4)(A) Civil action venue—E.D. Va., not D.D.C. (E) (actions “commenced on or after” E)

## V. Post-Issuance Provisions

### A. Supplemental Examination

35 U.S.C. § 257: Consideration, reconsideration or correction of relevant info; concluded within 3 mos.; exceptions to remedial effect (supp. exam complete before suit; no prior IC allegation)

### B. Third-Party Submissions

35 USC § 301: May now submit patent owner’s statements regarding claim scope (limited use)

### C. Post-Grant Review

35 USC §§ 321-29: Claims canceled if petitioner shows unpatentability by preponderance; final determination within 1 year of PTO noticing review (extendable for joinder or up to 6 mos. for “good cause”); discovery “limited to evidence directly related to factual assertions”; patent owner may move to amend claims once as of right, more than once for good cause or by consent; petitioner at least 1 opportunity to file written comments after petition

### D. Inter Partes Review

35 USC §§ 311-19: Claims canceled if petitioner shows unpatentability by preponderance; final determination within 1 year of PTO noticing review (extendable for joinder or up to 6 mos. for “good cause”); discovery limited to “deposition[s] of witnesses submitting affidavits or declarations” and what is “otherwise necessary in the interest of justice”; patent owner may move to amend claims once as of right, more than once for good cause or by consent; petitioner at least 1 opportunity to file written comments after petition

### E. Avoidance of Duplication

35 USC § 325(d): “Director may [consider] whether, and reject the petition [for post-grant or *inter partes* review] or request [for reexam] because, the same or substantially the same prior art or arguments previously were presented” to PTO

### F. Determinations Not Appealable

35 U.S.C. §§ 135(a), 314(d), 324(e): Determination (to institute post-grant or *inter partes* review or derivation proceeding or not) is final & non-appealable

### G. Miscellaneous

35 USC § 202(c)(7)(E)(i): Percentage of excess royalty income paid to federal government - 75% → 15% (E)  
35 USC § 156(d)(1): 60-day period post-FDA permission calculated based on next business day receipt if after 4:30 p.m. ET (E) (application pending on or filed after E, or as to which decision is subject to judicial review on E)

## VI. Litigation-Related Provisions

### A. Prior Commercial User Rights

35 U.S.C. § 273: accused infringer may avoid liability by proving, by clear & convincing evidence, that it commercially used its “process, . . . machine, manufacture, or composition of matter used in a manufacturing or other commercial process” at least 1 year before (i) effective filing date of claimed invention, or (ii) public disclosure that qualified for new § 102(b) exception; premarketing regulatory review and nonprofit lab use deemed “commercial”; generally not assertable against institutions of higher education (E) (applies to patents issued on or after E)

### B. Best Mode

35 U.S.C. § 282(3): “failure to disclose the best mode shall not be a basis on which any claim of a patent may be canceled or held invalid or otherwise unenforceable” (applies to patents issued on or after E)

### C. Virtual Marking

35 U.S.C. § 287(a): patentee may give notice with “patent”/“pat.” + publicly-accessible Internet address of posting associating patented article with patent number

### D. False Marking

35 U.S.C. § 292: No more *qui tam* actions; only US may sue under 35 U.S.C. § 292(a); person competitively injured may sue for compensatory damages under § 292(b) (E) (applies to any case “pending on, or commenced on or after” E)

### E. Advice of Counsel

35 U.S.C. § 298: Failure to obtain or present advice may not be used to prove intent to induce or willfulness

### F. Joinder of Accused Infringers

35 U.S.C. § 299: Accused infringers may be joined in one action as defendants only if (i) same transaction/occurrence or series thereof, and (ii) common questions of fact will arise (civil actions “commenced on or after” E)

### G. Stays

35 U.S.C. §§ 315, 325: if post-grant or *inter partes* review pending, infringer’s civil action stayed automatically upon filing civil action challenging validity (with exceptions)

## VII. Subject Matter-Dependent Provisions

### A. Human Organism Patents

“[N]o patent may issue on a claim directed to or encompassing a human organism.” (applies to “any application . . . that is pending on, or filed on or after [enactment] date”; “shall not affect the validity of any patent” issued before E)

### B. Tax Reduction Strategies

Insufficient to differentiate claimed invention from prior art, except those solely for preparing tax return or financial management (E) (applies to applications pending, filed on or after E, and patents issued on or after E)

### C. Post-Grant Review of Covered Business Method Patents

Post-grant review provisions generally apply; covers “method or . . . apparatus for performing data processing . . . in the practice . . . of a financial product or service, except . . . for technological inventions”; provisions dictate factors for staying litigation and permit immediate interlocutory review of stay decision; ATM exception for venue

# America Invents Act of 2011

	<i>Inter Partes</i> Reexam	Post-Grant Review	Transitional Post-Grant Review -- Covered Business Method Patents	<i>Inter Partes</i> Review	Supplemental Examination
<b>Filer/ Standing</b>	Anyone but patent owner	Anyone but patent owner (who has not previously filed civil action challenging validity)	Anyone sued for, or charged with, infringement of patent claiming method or apparatus "for performing data processing or other operations used in the practice, administration, or management of a financial product or service," except for "patents for technological inventions"	Anyone but patent owner	Patent owner
<b>Timing of Initial Petition/ Request</b>	Any time during life of the patent	Within 9 months after patent issue (except reissue review is barred if (i) challenged claim is identical to or narrower than original claim, and (ii) 9-month limit for original patent expired)	Any time (post-grant review limit of 9 months after issue expressly inapplicable) except when a patent could be subject to standard post-grant review	Any time (i) during life of patent, or (ii) after later of (a) time for filing a post-grant review petition, or (b) termination of post-grant review, but not > 1 year after suit for infringement	Any time during life of the patent
<b>Scope</b>	§§ 102 and 103 using only patents and printed publications	Any invalidity ground under §§ 101, 102, 103, 112 (or 251 for reissues)		§§ 102 and 103 using only prior art patents and printed publications	To consider, reconsider, or correct information believed to be relevant to the patent
			Except that challenges under old §§ 102 or 103 may be supported "only on the basis of" prior art—(i) under old section 102(a); or (ii)(a) that discloses the invention more than 1 year before the application date in US, and (b) would be described by old section 102(a) if disclosure had been made by another before the invention thereof by the applicant		
<b>Threshold for Granting Request or Petition</b>	Requested on/after 9/16/11: reasonable likelihood petitioner would prevail against at least 1 claim Requested before 9/16/11: substantial new question of patentability	(1) reasonable likelihood petitioner would prevail against at least 1 claim ( <i>prima facie</i> ), or (2) novel or unsettled legal question important to other patents/applications		Reasonable likelihood that petitioner would prevail against at least 1 claim (upon consideration of all evidence)	No substantial new question of patentability
<b>Preclusive or Remedial Effect</b>	Requested on/after 9/16/11: requestor barred from raising, in any subsequent USPTO, district court or ITC proceeding, any ground of invalidity that actually was raised or reasonably could have been raised Requested before 9/16/11: requestor barred from asserting, in a civil action, invalidity ground that was raised or could have been raised	Petitioner barred from raising, in any subsequent USPTO, district court or ITC proceeding, any ground of invalidity that actually was raised or reasonably could have been raised	Petitioner barred from raising, in any subsequent USPTO, district court or ITC proceeding, any ground of invalidity that actually was raised	Petitioner is barred from raising, in any subsequent USPTO, district court or ITC proceeding, any ground of invalidity that actually was raised or reasonably could have been raised	Information considered, reconsidered or corrected cannot be basis for unenforceability, unless (1) inequitable conduct allegations (a) pled with particularity in civil action or (b) made in ¶ IV letter, before request, or (2) supplemental exam or resulting reexam incomplete before civil action filed
<b>Effective Date(s)</b>	Enactment	Enactment + 1 year		Enactment + 1 year	
			Sunset: enactment + 9 years		
<b>Retroactive Effect</b>	Applies only to requests for <i>inter partes</i> reexam filed on or after enactment date, but applies to patents issued before, on or after enactment date	Applies to patents issued from applications containing, at any time, claim(s) with effective filing date on or after enactment + 18-months		Applies to "any patent issued before, on, or after . . . effective date"	