The act moves the U.S. from a first-to-invent to a first-inventor-to-file system where, generally, any public disclosure of an invention before the effective filing date of the application is filed will constitute prior art. Conversely, the current law allows applicants to “swear behind” some prior art references if they can prove a date of invention before the effective prior art date of the reference. The method of disqualifying prior art will no longer be available for patent applications filed on or after March 16, 2013. Applications filed before the effective date and some applications filed on or after March 16, 2013, must be considered before final disposition by the office, which is not possible under the current rules. Further, inter partes review will be conducted under a stricter standard wherein a requestor must show that it is more than likely that at least one of the claims being challenged will be unpatentable in view of the prior art submitted. Important other features of inter partes review is that the parties can settle before a final disposition by the office, which is not possible under the current rules. Further, any patent can be reviewed under the inter partes review system, not those filed after Nov. 29, 1999, as the current inter partes re-examination rules state. As the proposed minimum fees for requesting an inter partes review are to increase from $8,800 to about $27,200 (large entity), filing any contemplated inter partes re-examination requests before Sept. 16 would be best.

MONITOR YOUR COMPETITOR’S PATENT ACTIVITY. The act changes the way third parties can submit prior art to the office for consideration. As in the current rules, a third party can submit prior art for consideration against pending patent applications so long as the disclosures are made within five years after issuance. If the request is accepted, the office will review the patent in light of most forms of prior art, not just patents and printed publications.

DISCLOSURES OF YOUR INVENTION MAY HURT YOU. The act maintains the one-year grace period currently provided by U.S. patent law. More specifically, an applicant’s disclosure of their invention will not qualify as prior art so long as the disclosure was less than one year before the filing date of an application directed to the disclosed invention. However, unlike the current rules, a third party public disclosure occurring in the one-year window, which was not derived from the inventor, will not qualify as prior art so long as the disclosure was made within a predefined time period, which the act has extended. However, prior art submissions must now include a concise explanation of the relevance of the prior art as it relates to the claims, which is not currently required. The effective date of this portion of the act is Sept. 16.

CHALLENGE YOUR COMPETITOR’S RECENTLY ISSUED PATENTS. The act will allow challenges to newly issued patents. Effective Sept. 16, but only applicable for patent applications filed on or after March 16, 2013, a third party can request a post-grant review of the patent for nine months after issuance. If the request is accepted, the office will review the patent in light of most forms of prior art, not just patents and printed publications.

CHANGES IN ENFORCEMENT. The act also changes how patents are enforced. For example, the “best mode” defense has been abolished. Further, failure to obtain advice of counsel regarding possible infringement cannot be used to prove willful infringement. False marking litigations have been limited and joinder of multiple defendants in a lawsuit has been restricted. This article only touches on a handful of the important points of the act. Again, Sept. 16 and March 16, 2013, are very important implementation dates. For a copy of a USPTO table showing the act’s effective dates, visit http://www.uspto.gov/aia_implementation/resources.jsp. You may also visit the office information site at http://www.uspto.gov/aia_implementation/index.jsp.

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