

The America Invents Act: Major Revisions to U.S. Patent Law

On September 16, 2011, President Obama signed the America Invents Act, enacting the first major legislative changes to the U.S. Patent Act in nearly 60 years. The subject of six years of Congressional debate and negotiation, the America Invents Act changes multiple facets of the patent system. These include:

First-to-File: Converting the U.S. from a “first to invent” to a “first to file” patent system. As in most other countries, the first inventor to file for the patent—not the first to conceive the claimed invention—will get the patent.

Pre-Grant Challenges: Establishing procedures for third parties to submit and explain potentially invalidating prior art during prosecution proceedings in the Patent Office.

Post-Grant Challenges: Establishing additional procedures for challenging patent validity in the Patent Office after a patent issues.

Supplemental Examination: Allowing patentees to present to the Patent Office post-issuance prior art and other information relevant to patentability not submitted, incorrectly presented, or insufficiently considered during prosecution of a patent (a procedure intended to enable patentees to head-off inequitable conduct claims prior to litigation).

"On Sale" and Public Use Defenses: Expanding “on sale” and prior public use defenses to infringement to include any pre-filing date “on sale” or public use activity anywhere in the world, and any commercial use at least one year before the filing date.

Best Mode Defense: Eliminating the patentee’s failure to disclose the best mode of practicing the invention as a basis for invalidating the patent.

Advice Of Counsel-Willful Infringement: Codifying that an accused infringer’s failure to obtain a non-infringement opinion or other advice of counsel cannot be used to prove willful or induced infringement.

Patent Marking: Allowing “virtual marking” at a website or other



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Internet address in lieu of physically marking patented products, eliminating private party “qui tam” false marking litigation, and curtailing troll-type false marking litigation by requiring proof of competitive injury.

The America Invents Act addresses numerous other facets of the patent system. Some of its provisions take effect immediately. Others—including most of the changes noted in this Alert—become effective 12 or 18 months after the Act’s September 16, 2011, effective date.

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