

America Invents Act (AIA): What CWRU Inventors Need to Know

1. All patents filed after March 16, 2013, are subject to the new rules of the Leahy-Smith America Invents Act also known as “AIA.”
 2. Moving to a first-to-file system from the former first-to-invent system, harmonizes the U.S. patent system with the rest of the world’s patent system.
 3. The new U.S. patent reform establishes a first-to-file patent system. Under the first-to-file system, the first inventor to file an application on an invention “wins” the race to the patent office (assuming all other aspects of patentability are met).
- **Inventors** may still take advantage of a **one year grace period** for **public disclosures** (US patents only). This grace period ensures that the inventor’s own disclosure and/or disclosures of others deriving their invention from the inventor are not used as **prior art** against the inventor, so long as they occur within one year of the effective **filing date** of the invention. However, such public disclosures by the inventor will still preclude the inventor from seeking foreign protection (as most countries will not recognize this “grace period”).
 - Public disclosures and patent filings of others within the one year grace period of the inventor’s public disclosure that were not derived from the inventor’s public disclosure will be considered prior art against an inventor’s subsequently filed patent application.

Take home message:

If you have an invention with potential commercial value, please disclose the invention thoroughly to the Technology Transfer Office through an invention disclosure form and discuss with us BEFORE any public disclosure occurs (i.e.: publication, external presentation, discussion with companies, etc).

Other points of interest under the AIA:

- Under the first-to-file system, the only situation in which an inventor who files an application later in time may contest an earlier-filed application is if they believe the inventorship of the earlier-filed application was in fact derived from their work. Therefore, good record keeping by inventors is still important.
- AIA expands the definition of prior art to include use and sale of the invention by another outside of the U.S. Foreign filed patent applications are now prior art as of the date they were filed in the foreign country.
- Any third party public disclosure, patent filing, or public use of an invention that occurred before your filing date (albeit after your invention date) remains as prior art.
- Under the new rules, universities acquire “micro-entity” status and are entitled to lower patent filing fees than larger entities.
- The AIA provides for a new post-grant review mechanism wherein for a 9-month period after a first-to-file patent issues, third parties will be able to challenge a patent’s validity on any ground (at a lower cost than litigation).

Definitions:

Inventor: an inventor is one who conceives an invention and is able to clearly describe it in a way that would enable a skilled person in your field to re-create or make the invention without extensive research or undue experimentation.

grace period: a period of time, prior to the filing of a patent application, during which any disclosures, intentional or unintentional, deriving from the inventor or a subsequent owner of the invention, are unconditionally excused from consideration as prior art against the application.

public disclosure: any written (poster, journal article, thesis, etc) or oral presentation (seminar, meeting talk, public discussion) of an invention that when presented offers enough information that another skilled person in your field could produce the invention themselves from the information given. Public use or sale of an invention also counts as a public disclosure.

prior art: all information (including but not limited to publications, patents, or presentations) that has been disclosed to the public in any form about an invention before a given date.

filing date: the date a patent is first filed with the U.S. Patent and Trademark Office.

Further references:

http://sciencecareers.sciencemag.org/career_magazine/previous_issues/articles/2012_02_03/caredit.a1200013

<http://www.fastcompany.com/1822846/untangling-real-meaning-first-file-patents>

<http://www.wired.com/design/2013/03/america-invents-act/>