
IP SAVVY

THE Newsletter for the Intellectual Property Community

APRIL 2013

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SPECIAL ISSUE: THE AIA

You've probably read various reports concerning the America Invents Act which changed our patent laws from a first to invent system to a first to file system and which introduced several new methods for reviewing patent claims at the Patent Office.

After attending numerous conferences concerning the AIA and reviewing the Patent Offices' recent proposed rules implementing the Act, we offer the following quick analysis to guide you through the AIA chatter.

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FIRST TO FILE

In general, the first filer will now obtain the patent. And yet, the one year grace period is still in effect in the United States. That is, an invention can be publicly disclosed and a U.S. patent application can be filed up to one year later. But, there has never been a grace period in foreign patent offices. So, clients who anticipate foreign patent protection will need to continue to file a U.S. a patent application (at least a US provisional) before any disclosure rather than disclose the invention and then file a patent application up to a year later.

Even if no foreign filings are contemplated, however, there are possible problems associated with publicly disclosing an invention (or offering it for sale) and then filing a patent application.

Because of these potential problems, we advocate, as before, filing early and often using a strategy wherein a given project or product is protected by at least a few focused patents covering different aspects of an invention. In the world of patents, more is definitely better.

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CHALLENGING PATENT CLAIMS

Regarding the ways to challenge a patent claim, they are now as follows under the AIA:

- Third party submission of prior art
- Reexamination
- Interparties Review
- Covered Business Method Review
- Post Grant Review
- Federal District Court Litigation
- Supplemental Examination

Most types of challenge are subject to numerous restrictions, may be extremely expensive, and are subject to different standards.

Also, challenging a patent claim at the Patent Office usually allows the patent owner to amend the patent claims and to seek protection of new patent claims. For example, if I have a patent, you challenge it, and I know who you are and what your product is, I may be able to amend my patent claims to cover your product and yet still convince the Patent Office my amended claims are patentable despite whatever "prior art" you throw at me. This may provide the patent owner with an advantage over the challenger.

Still, there are times when one or more of the various challenge methods may be beneficial.

The good news is we have substantial experience with patent "reexaminations" and most of the new challenge methods follow the previous practices concerning reexamination.

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CONCLUSION

In conclusion, not much has changed for most of our clients who previously filed internationally. For those who do not, file early and often and try not to count on the one year grace period.

If your patent is challenged or you want to challenge someone else's patent, let's discuss the specifics of the situation and decide on the best course of action to expeditiously and cost-effectively meet your business needs and goals. We will continue to update you if Patent Office rules or Court rulings affect IP strategy.

Finally, we are available, free of charge, to participate in educational sessions at your place of business regarding any aspect of IP law.

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