LEGAL UPDATES

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Only Four Weeks Left to Take Advantage of the Outgoing Patent System

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Companies having inventions to patent should seriously consider filing their patent applications at the U.S. Patent and Trademark Office on or before Friday, March 15 – the "Ides of March." This is the final day that entirely new applications can be filed and still be treated under the current patent system. There are five, simple reasons why you might want to meet the deadline:

1. An applicant under the current system is entitled to prove a date of "invention" that is earlier than the application filing date. The earlier the date of invention, the more likely it is that you will be able to overcome some prior art references or to win a priority contest against a later inventor who filed an earlier application.

2. Because the definition of "prior art" changes under the America Invents Act, prior art that can be cited against patent applications with an effective filing date after March 15, 2013, generally expands in scope. Unless that prior art derives from the applicant, it cannot be overcome except in narrow circumstances. Often, such prior art is not known until it arises in patent litigation. If the patent has an effective filing date before March 16, 2013, then the patent owner can attempt to overcome some of the prior art on the basis of dates of invention.

3. Likewise, for entirely new applications filed after March 15, 2013, the America Invents Act weakens the "grace period" that applicants would otherwise have enjoyed. Although the duration remains the same – 12 months – additional steps may be needed to trigger the grace period, and even then it provides only narrow protection. In the past, an applicant had 12 months after

an adverse disclosure within which to file a patent application, without having to do anything to secure the protection during those 12 months. Under the new provisions, the adverse disclosure is almost insuperable.

4. Patents granted under the new system will be subject to "post grant review" for nine months after they are issued. During that time, anyone other than the patent owner can petition to have the Patent Office consider the patentability of the claims on any basis that can be raised in patent litigation. Patents under the old system are subject to only re-examination with limited bases for challenging the patent.

5. Applicants, attorneys and examiners will be getting used to the new system for some time. The learning curve cannot but add to the expenses and frustrations of the patent application process.

These new provisions operate on a going-forward basis only, so patents resulting from applications filed before March 16, 2013, will generally enjoy the advantages of the old patent system. Little time remains to prepare and file patent applications before the new provisions become effective.

If filing after March 15, 2013, is unavoidable, using the Husch Blackwell attorneys who have studied the new system and are prepared for the change will help you navigate the new environment.

What This Means to You

These changes affect patents in all areas of technology and companies of all sizes. They affect the ability to get a patent to protect your investment of capital and human resources in improving your technology. Patent counsel, inventors and research and development managers should identify new technologies that are ready to go and can be documented at this time and work with patent counsel to file patent applications by March 15 if that is the right course for a particular technology.

Contact Information

For additional information about these or any other intellectual property issues, please contact your Husch Blackwell attorney or Edward Manzo at 312.526.1535.

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