

US Patent Law reform – New Ways to Attack US Patents

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In this latest edition in our series of snap-shots of changes to US patent law, we look at the changes to procedures before the US Patent Office for attacking the validity of patents. These procedures now provide the US Patent Office with an opportunity to look at an issued patent again, as well as the opportunity to consider new information and reconsider information that had been considered during the original examination. The procedures also enable third parties to influence examination of a pending application.

What are the main changes?

The main changes are:

- | the introduction of a Post Grant Review (PGR) proceeding similar to opposition procedures in Europe and Australia,
- | introduction of Supplemental Examination which provides the opportunity to have the US Patent Office consider, reconsider or correct information believed to be relevant to the patent. While useful for correcting a number of potential flaws, it essentially gives a patent owner an additional avenue to satisfy the duty of disclosure after grant,
- | enhanced mechanism for third parties to lodge prior art at the US Patent Office.

The changes are summarized in the table below:

| Proceeding | Timing | Change/Improvement | Forum | Commences |
|---|--|---|-------------------------------|---|
| Prior art submissions by third parties before grant | Within six months of publication of the patent application OR before the date of the first examiner's report | Similar to existing proceedings but the submitting party can now include a summary as to the asserted relevance of each cited document. No longer a limitation to the total number of documents that can be submitted. | Examiner | 16 September 2012 (regardless of filing date) |
| Post-grant review (PGR) | Within nine months of grant | New procedure; all grounds of invalidity may be raised. Resolved within 12 to 18 months of initiation of proceedings | Patent Trial and Appeal Board | Applies to granted patents having an effective filing date of 16 March 2013 or later. |
| <i>Inter Partes</i> Review | Once the period for initiating a PGR has expired, or a PGR has concluded. | Only prior art grounds of invalidity may be raised. Replaces <i>inter partes</i> re-examination; intended to be resolved within 12 to 18 months from initiation | Patent Trial and Appeal Board | 16 September 2012 (regardless of filing date) |
| <i>Ex Parte</i> Re-examination | Anytime after the patent issues | Remains largely unchanged | Central Re-examination Unit | |
| Supplemental Examination | Anytime after the patent issues | New procedure available to patent owner to remedy potential problems with the patent and inoculate against allegation of inequitable conduct | Central Re-examination Unit | 16 September 2012 |

Other proceedings

A ground-breaking change to US patent law is the transition to a first to file system in March 2013. This eliminates convoluted interference proceedings, as the issue of determining the first inventors for competing patents will no longer

apply. In its place, are 'derivation proceedings' to address situations where a person files a patent application to an invention 'derived' from another without that person's permission. These proceedings must be initiated within 12 months of first publication of the claim covering the derived invention.

What does this mean for you?

For the first time, third parties will have the opportunity to challenge the validity of a patent on all grounds of invalidity via the PGR – not just the grounds of novelty and inventiveness in light of published documents. For Australians already familiar with Australian and European opposition proceedings, this new proceeding could be a welcome alternative to patent litigation, and a more flexible option than existing *ex parte* re-examination proceedings.

Allegedly, the new procedures of PGR and *Inter Partes* Review ought to be conducted more swiftly as the new procedures provide a time limit of 12 months, extendable to 18 months.

And for patent owners, the option to strengthen your patent against an allegation of inequitable conduct by supplemental examination is a valuable new tool to enable correction of patents after issuance.



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