

# The America Invents Act:

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## Recent Changes to U.S. Patent Law

John R. Hlavka

[jhlavka@tarolli.com](mailto:jhlavka@tarolli.com)

Tarolli, Sundheim, Covell & Tummino LLP  
ASGE National Conference June 3, 2014

# TYPES OF INTELLECTUAL PROPERTY

- Patents
- Trademarks
- Copyrights
- Trade Secrets

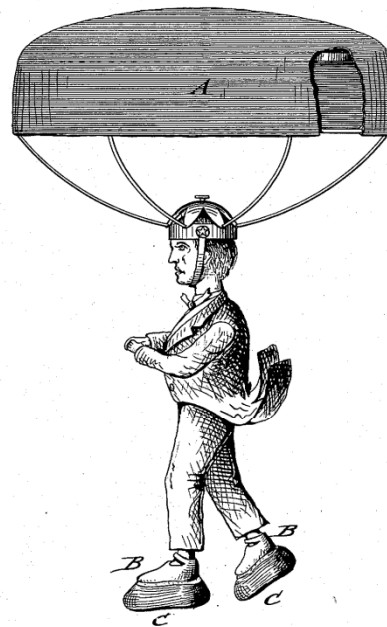
# What Is A Patent ?

A patent is a property right granted to an inventor by the government to exclude others from making, using or selling his/her invention. A patent does not give the inventor an absolute right to make or use the invention!

B. B. OPPENHEIMER.  
Fire-Escape.

No. 221,855.

Patented Nov. 18, 1879.



WITNESSES:

*Henry N. Miller*  
*C. Badger*

INVENTOR:

*B. B. Oppenheimer*  
BY *Munn & Co*  
ATTORNEYS.

# What Is A Trademark?

A word, logo, phrase, etc., used by a manufacturer to identify its goods and distinguish them from those of competitors. A trademark serves to identify the source or origin of goods.





United States Patent and Trademark Office

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# AGA

**Word Mark**

AGA

**Goods and Services** IC 035. US 100 101 102. G & S: Association services, namely, promoting the interests of natural gas companies. FIRST USE: 19380000. FIRST USE IN COMMERCE: 19380000**Standard****Characters Claimed****Mark Drawing Code** (4) STANDARD CHARACTER MARK**Serial Number** 85938740**Filing Date** May 21, 2013**Current Basis** 1A**Original Filing Basis** 1A**Published for Opposition** October 22, 2013**Registration Number** 4462166**Registration Date** January 7, 2014**Owner** (REGISTRANT) American Gas Association CORPORATION DELAWARE 400 North Capital Street Washington D.C. 20001**Attorney of Record** P. Jay Hines**Prior Registrations** 2350083;2554600;3930777**Type of Mark** SERVICE MARK**Register** PRINCIPAL**Live/Dead Indicator** LIVE



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<b>Word Mark</b>	AGA
<b>Goods and Services</b>	IC 035, US 100 101 102. G & S: Association services, namely, promoting the interests of natural gas companies. FIRST USE: 20100518. USED IN ANOTHER FORM The mark was first used anywhere in a different form other than that sought to be registered at least as early as 00/00/1938. FIRST USE IN COMMERCE: 20100518
<b>Mark Drawing Code</b>	(3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS
<b>Design Search Code</b>	01.15.03 - Fire (flames), other than emanating from objects, words, numbers, fireplaces or candles; Flames, other than flames emanating from objects, words, numbers, fireplaces or candles
<b>Serial Number</b>	85050198
<b>Filing Date</b>	May 28, 2010
<b>Current Basis</b>	1A
<b>Original Filing Basis</b>	1A
<b>Published for Opposition</b>	December 28, 2010
<b>Registration Number</b>	3930777
<b>Registration Date</b>	March 15, 2011
<b>Owner</b>	(REGISTRANT) American Gas Association CORPORATION DELAWARE 400 North Capitol Street, N.W. Washington D.C. 20001
<b>Attorney of</b>	

# What Is A Copyright?

A form of protection which prevents others from copying original works of authorship.



# What Is A Trade Secret?

Valuable business information that gives a business a commercial advantage.

# Types Of Patents

## Utility Patent

Protects a new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement. A utility patent can provide broad protection and may preclude others from making functional equivalents of the patentee's invention.

# United States Patent [19]

Kupperman et al.

[11] 4,195,707

[45] Apr. 1, 1980

## [54] COMMUNICATING DEVICE

[75] Inventors: Sam Kupperman, Chicago; Dennis Kupperman, Glenview, both of Ill.

[73] Assignee: RB Toy Development Co., Skokie, Ill.

[21] Appl. No.: 878,674

[22] Filed: Feb. 17, 1978

[51] Int. Cl.<sup>2</sup> ..... G08B 1/00

[52] U.S. Cl. .... 181/138

[58] Field of Search ..... 181/138, 162; 46/33

## [56] References Cited

### U.S. PATENT DOCUMENTS

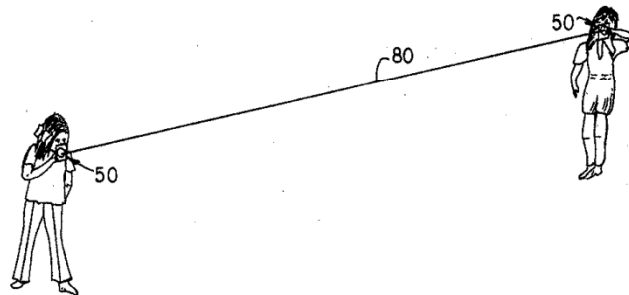
3,082,838 3/1963 Gajdosik ..... 181/138

Primary Examiner—Stephen J. Tomskey  
Attorney, Agent, or Firm—Vogel, Dithmar, Stotland,  
Stratman & Levy

## [57] ABSTRACT

A device for communicating in which a hollow frustum extending outwardly from a flat base has tabs at the ends thereof for holding a relatively rigid diaphragm having spaced apart apertures therein. A pair of these devices are interconnected by a cord or string, whereby conversation or sound projected into one of the devices is reproduced at the other device. Two devices are molded as a single integral unit and merchandised as an in-pack item with children's breakfast cereals.

9 Claims, 8 Drawing Figures



**United States Patent** [19]  
**Geddie**

[11] **Patent Number:** **4,681,244**  
[45] **Date of Patent:** **Jul. 21, 1987**

[54] **PORTABLE BAR**

[76] **Inventor:** John D. Geddie, 832 Walnut St.,  
Charlotte, Mich. 48813

[21] **Appl. No.:** 857,264

[22] **Filed:** Apr. 30, 1986

[51] **Int. Cl.<sup>4</sup>** ..... B67D 1/00

[52] **U.S. Cl.** ..... 222/144.5; 222/145;

222/175; 248/148; 248/181; D2/248

[58] **Field of Search** ..... 222/175, 144.5, 145,  
222/132, 129.1; 224/148, 181; 137/606, 607;  
D2/248, 246; D7/70, 71, 301, 305; 2/183

[56] **References Cited**

**U.S. PATENT DOCUMENTS**

D. 283,268 4/1986 Rebiskie et al. .... 224/181 X  
494,061 3/1893 Day ..... 222/145 X  
1,879,269 9/1932 Hutchinson ..... 222/145  
2,120,865 6/1938 Kleman ..... 222/145 X

4,191,183 3/1980 Mendelson ..... 222/145 X  
4,439,871 4/1984 Plastino ..... 2/183 X  
4,544,087 10/1985 Modig ..... 224/148  
4,607,755 8/1986 Andreozzi ..... 224/148 X

*Primary Examiner*—Joseph J. Rolla

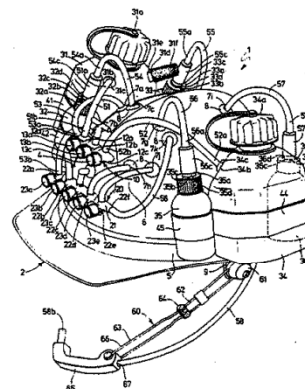
*Assistant Examiner*—Nils Pedersen

*Attorney, Agent, or Firm*—John H. Calhoun, Jr.

[57] **ABSTRACT**

A portable mix bar comprising a hard hat having a plurality of drink containers and a pair of mixing chambers for mixing drinks mounted thereon wherein the flow of drinks to and from the mixing chambers is controlled by a plurality of valves. Also provided is a plurality of tubes for carrying drinks from the drink containers to the valves and mixing chambers and between valves and mixing chambers and from the mixing chambers to the mouth of a user.

**2 Claims, 3 Drawing Figures**



**United States Patent** [19]  
de Canecaude

[11] Patent Number: **4,697,656**  
[45] Date of Patent: **Oct. 6, 1987**

[54] **DEVICE FOR WEIGHING INDIVIDUALS ON A TOILET SEAT**

[76] Inventor: **Emmanuel de Canecaude**, 4 bis, rue Albert Joly, F-78000 Versailles, France

[21] Appl. No.: **810,384**

[22] PCT Filed: **Apr. 1, 1985**

[86] PCT No.: **PCT/FR85/00071**

§ 371 Date: **Apr. 9, 1986**

§ 102(e) Date: **Apr. 9, 1986**

[87] PCT Pub. No.: **WO85/04472**

PCT Pub. Date: **Oct. 10, 1985**

[30] **Foreign Application Priority Data**

Apr. 2, 1984 [FR] France ..... 84 05171  
Dec. 17, 1984 [FR] France ..... 84 19294

[51] Int. Cl.<sup>4</sup> ..... **G01G 19/52; G01G 5/04**

[52] U.S. Cl. .... **177/144; 177/209**

[58] Field of Search ..... **177/144, 209, 262**

[56] **References Cited**

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2,057,024 10/1936 Gunnison ..... 177/144  
3,949,432 4/1976 Ginsburg .  
4,056,156 11/1977 Dayton .  
4,489,799 12/1984 Menon .

**FOREIGN PATENT DOCUMENTS**

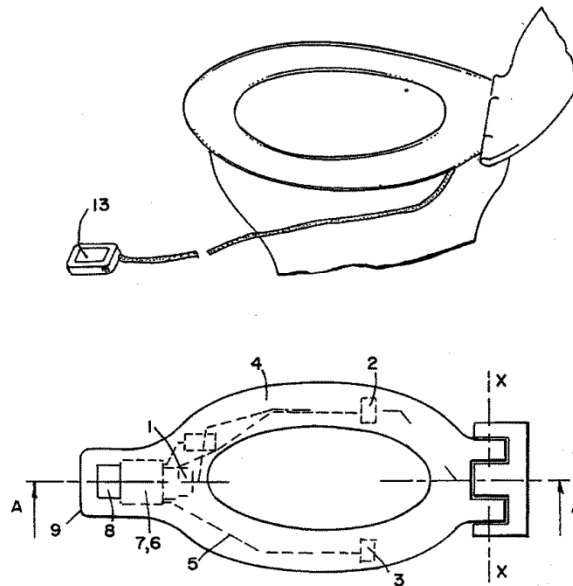
356397 4/1980 Austria .  
2219108 10/1973 Fed. Rep. of Germany ..... 177/144  
2452348 5/1976 Fed. Rep. of Germany ..... 177/144

*Primary Examiner*—George H. Miller, Jr.  
*Attorney, Agent, or Firm*—Browdy and Neimark

[57] **ABSTRACT**

The weighing device comprises at least a force sensor (1,2,3) integrated in a toilet seat (4) resting on the upper edge of the bowl (11); the sensor works with an electronic unit (6) comprising means for formatting the measurement signal that drives a means (8) for displaying the user's weight, said means (8) being placed on an extension (9) of seat (4); the hinge along the XX axis comprises an oblong hole to avoid affecting the measurement.

**10 Claims, 9 Drawing Figures**







US007255155B2

(12) **United States Patent**  
**O'Donnell et al.**

(10) **Patent No.:** **US 7,255,155 B2**  
(45) **Date of Patent:** **Aug. 14, 2007**

(54) **HEAT EXCHANGER TUBE WITH  
INTEGRAL RESTRICTING AND  
TURBULATING STRUCTURE**

(75) Inventors: **Michael J. O'Donnell**, Rocky River,  
OH (US); **Terrance C. Slaby**, North  
Royalton, OH (US)

(73) Assignee: **Beckett Gas, Inc.**, North Ridgeville, OH  
(US)

(\*) Notice: Subject to any disclaimer, the term of this  
patent is extended or adjusted under 35  
U.S.C. 154(b) by 257 days.

(21) Appl. No.: **10/721,682**

(22) Filed: **Nov. 25, 2003**

(65) **Prior Publication Data**  
US 2004/0104015 A1 Jun. 3, 2004

**Related U.S. Application Data**

(60) Division of application No. 10/234,807, filed on Sep.  
4, 2002, now Pat. No. 6,688,378, which is a continu-  
ation of application No. 09/799,268, filed on Mar. 5,  
2001, now abandoned, which is a continuation-in-part  
of application No. 09/205,955, filed on Dec. 4, 1998,  
now abandoned.

(51) **Int. Cl.**  
**F28F 13/12** (2006.01)  
**F28D 7/02** (2006.01)

(52) **U.S. Cl.** ..... **165/109.1; 165/179**

(58) **Field of Classification Search** ..... **165/109.1,**  
**165/177, 179, 163, 910, 135, 48.1; 138/40,**  
**138/44; 126/116 R**

See application file for complete search history.

(56) **References Cited**

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514,338 A 2/1894 Row  
910,192 A 1/1909 Grouvelle et al.

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(Continued)

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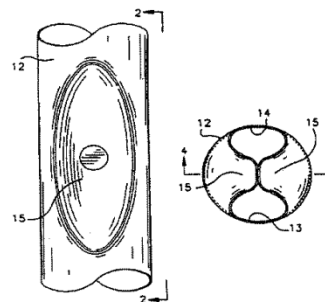
(Continued)

*Primary Examiner*—Tho Duong  
(74) *Attorney, Agent, or Firm*—Tarolli, Sundheim, Covell &  
Tummino, LLP

(57) **ABSTRACT**

A heat exchanger tube having an integral restricting and  
turbulating structure consisting of dimples formed by con-  
fronting indentations pressed into the sides of the heat  
exchanger tube. The dimples are comprised of indentations  
disposed in pairs which extend into the tube to such a depth  
as is necessary to significantly reduce the cross sectional  
area of the heat exchanger tube and provide a pair of  
converging, diverging flow nozzles to promote turbulence of  
the flue gases. The turbulence characteristics of the tube can  
be controlled by varying the size of the aperture of the  
nozzles. In certain applications, the dimples are located  
along the sides of the heat exchanger tube, thereby providing  
unobstructed drainage for liquids even when the tube is bent  
into a serpentine shape.

**6 Claims, 4 Drawing Sheets**



## Types Of Patents (continued)

### Design Patent

Protects new, original and ornamental designs for an article of manufacture.

A design patent only protects the appearance (as opposed to the function) of a product.



US00D427158S

**United States Patent** [19]  
**Sadowski et al.**

[11] **Patent Number:** **Des. 427,158**  
[45] **Date of Patent:** **\*\* Jun. 27, 2000**

[54] **ROCKER SWITCH ACTUATOR**

[75] Inventors: **Walter A. Sadowski**, Newington;  
**Joseph L. LeClair**, Waterbury, both of  
Conn.; **Jamie T. Sasser**, Apex; **Ray T.**  
**Schenck**, Sanford, both of N.C.

[73] Assignees: **Carlingswitch, Inc.**, Plainville, Conn.;  
**Caterpillar, Inc.**, Peoria, Ill.

[\*\*] Term: **14 Years**

[21] Appl. No.: **29/085,814**

[22] Filed: **Mar. 31, 1998**

[51] **LOC (7) Cl.** ..... **13-03**

[52] **U.S. Cl.** ..... **D13/174**

[58] **Field of Search** ..... D13/158, 169,  
D13/173, 174; 200/329, 332, 335, 339,  
556, 561, 61.27

[56] **References Cited**

**U.S. PATENT DOCUMENTS**

2,073,319 3/1937 Rosay ..... 200/553 X  
3,716,682 2/1973 Wizemann ..... 200/61.27

*Primary Examiner*—Alan P. Douglas  
*Assistant Examiner*—Lavone Tabor  
*Attorney, Agent, or Firm*—McCormick, Paulding & Huber  
LLP

[57] **CLAIM**

The ornamental design for a rocker switch actuator, as  
shown and described.

**DESCRIPTION**

FIG. 1 is a front elevational view of an electrical switch  
actuator showing our new design, the broken line showing  
the switch case which is included for purposes of illustrating  
environmental details only and forming no part of the  
claimed design.

FIG. 2 is a left end elevational view thereof.

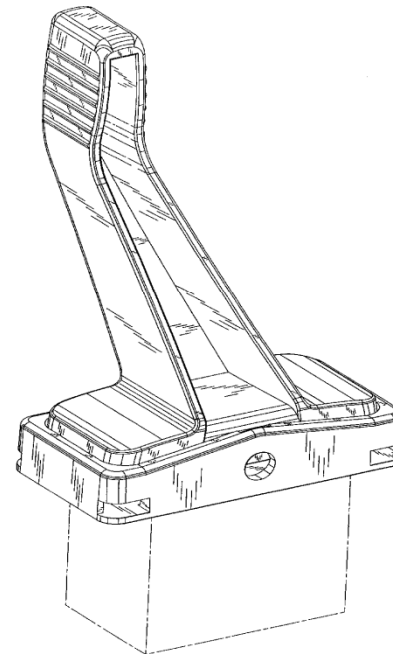
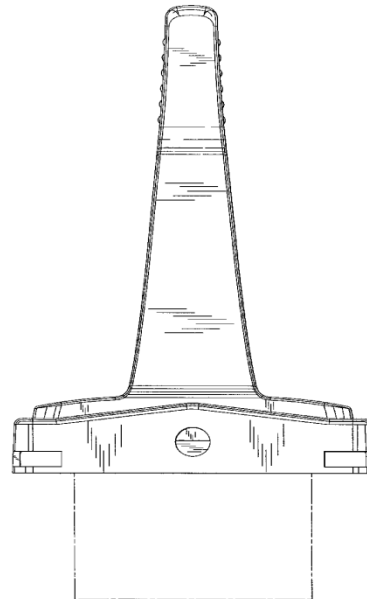
FIG. 3 is right end elevational view thereof.

FIG. 4 is a top plan view thereof.

FIG. 5 is a front upper left perspective view thereof; and,  
FIG. 6 is a vertical section through the actuator to better  
show the pivoted portion of the actuator and with other  
internal features omitted as forming no part of the claimed  
design.

No claim is made to the bottom of the actuator.

**1 Claim, 6 Drawing Sheets**



# Types of Patents (continued)

## Plant Patent

Protects distinct and new varieties of plants, including cultivated sports, mutants, hybrids and newly found seedlings other than a tuber propagated plant or a plant found in an uncultivated state.

# Why Should Patents be Obtained?

- Provides competitive advantage since only patent owner can make the product covered by the patent.
- May have value as a sales tool.



# Why Should Patents be Obtained? (cont.)

- Prevents competitor from making an outright copy.
- Potential for generating a royalty income or to obtain a cross-license to obtain rights in a third party patent.

# Why Should Patents be Obtained? (cont.)

- Use as a bargaining tool should patentee find itself charged with infringement
- May be used to protect patentee's parts business.

# American Inventors Protection Act of 1999

- A. Applies to all U.S. patent applications filed on or after November 29, 2000.
- B. U.S. applications are now published 18 months after filing and public now has access to published applications while applications are being prosecuted.



US 20130048764A1

(19) **United States**

(12) **Patent Application Publication**  
**O'Donnell**

(10) **Pub. No.: US 2013/0048764 A1**

(43) **Pub. Date: Feb. 28, 2013**

(54) **INSHOT GAS BURNER**

**Publication Classification**

(75) Inventor: **Michael J. O'Donnell**, Avon, OH (US)

(51) **Int. Cl.**  
**F23D 11/38**

(2006.01)

(73) Assignee: **Beckett Gas, Inc.**, North Ridgeville, OH (US)

(52) **U.S. Cl.** ..... **239/589**

(21) Appl. No.: **13/599,488**

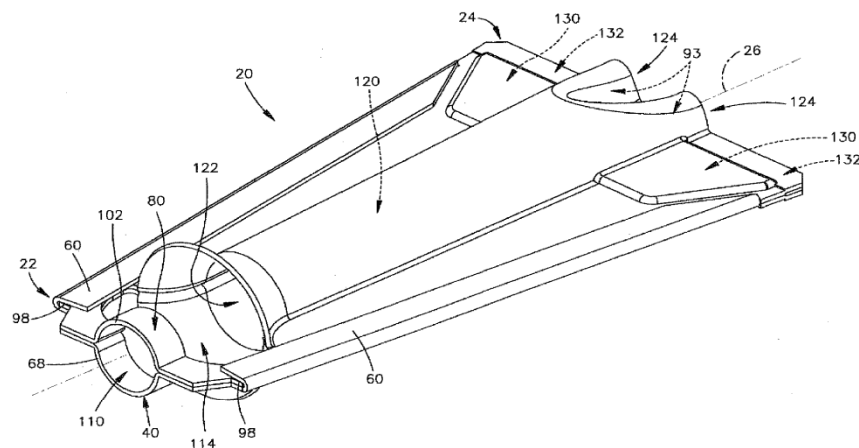
(22) Filed: **Aug. 30, 2012**

**Related U.S. Application Data**

(60) Provisional application No. 61/529,478, filed on Aug. 31, 2011.

**ABSTRACT**

A burner nozzle for use in burning a gas/air mixture includes a tubular member that extends along a centerline and has a mixture supply passage extending from an inlet end that receives air and gas to an outlet end. The outlet end includes a plurality of exit portions in fluid communication with the inlet end. The exit portions are positioned on opposing sides of cooperating dimples formed in the tubular member. The dimples are configured to shape the exit portions into nozzles having a cross-sectional area that decreases in a direction towards the outlet end.

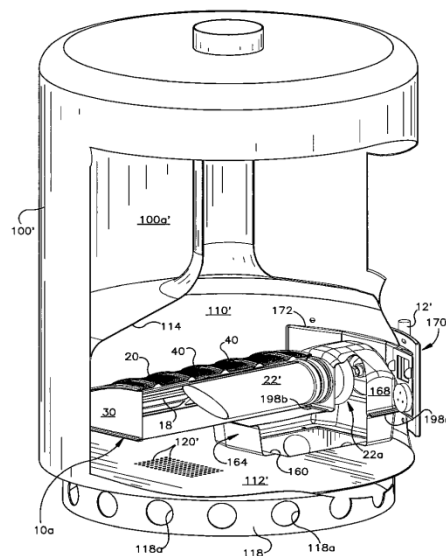




US 20050172915A1

(19) **United States**(12) **Patent Application Publication** (10) **Pub. No.: US 2005/0172915 A1****O'Donnell et al.**(43) **Pub. Date:****Aug. 11, 2005**(54) **BURNER**(75) Inventors: **Michael O'Donnell**, Avon, OH (US);  
**Richard D. Cook**, North Ridgeville,  
OH (US)Correspondence Address:  
**WATTS HOFFMANN CO., L.P.A.**  
**P.O. Box 99839**  
**Cleveland, OH 44199-0839 (US)**(73) Assignee: **Beckett Gas, Inc.**(21) Appl. No.: **11/051,755**(22) Filed: **Feb. 4, 2005****Related U.S. Application Data**(60) Provisional application No. 60/542,150, filed on Feb.  
5, 2004.**Publication Classification**(51) Int. Cl.<sup>7</sup> ..... **F24H 1/00; F23L 1/00**(52) U.S. Cl. .... **122/17.1**(57) **ABSTRACT**A gas burner for a gas fired heating appliance, such as a  
water heater. The gas burner is located within a combustion

chamber and includes an inlet conduit through which combustible gas and primary air are received. An air scoop shrouds the inlet conduit and at least partially defines a flow path of primary air, substantially isolated from the combustion chamber and which extends from the inlet end of the inlet conduit to a primary air port that communicates with a source of primary air located outside the combustion chamber. The combustion chamber also includes at least one port through which secondary combustion air is admitted into the combustion chamber. A flow path transition member is located within the combustion chamber and is in fluid communication with the primary air port. The transition member also forms part of the isolated primary air flow path and sealingly engages the air scoop when the burner is installed into the combustion chamber. The transition member is provided with at least one flange that is engaged by a complementally shaped lip defined by the air scoop, as the burner is moved into its operative position through an access opening. A door or bulkhead closes off the opening through which the burner is installed and the door is adapted to mount a gas orifice through which combustible gas is discharged into the air scoop. The transition member is mounted to a base plate of the water heater and overlies a port communicating with a region below the water heater which serves as the source of primary air. The air scoop is mounted to the bulkhead/access door in a region having a predetermined profile that is unrelated to the radius of the access opening.





# The AIA

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- Recent changes
  - First-inventor-to-file
  - Derivation proceedings
  - Validity and infringement defenses
  - Third-party intervention
  - Supplemental examination
  - PTO practice, operations, and fees

# The AIA

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## First-Inventor-to-File (FITF)

It is now a race to the patent office...

# The AIA

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- Old regime – First-to-Invent
  - Conception and diligent reduction to practice mattered, giving inventor a “priority date” of conception
  - One-year grace period from any public disclosure
  - First-to-file had prima facie priority, but:
    - swearing behind could eliminate certain references
    - interference proceeding determined first-to-invent facts, including conception and reduction
  - Any application with an effective filing date prior to 3/16/13 falls under first-to-invent system

# The AIA

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- New regime – First-inventor-to-File
  - Two classes of prior art:
    - patents and published patent applications; and
    - all other public disclosures , which could include public use or sales outside US
  - Prior art inquiry now keyed to effective filing date rather than date of invention
    - first-to-file, not first-to-invent

# The AIA

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- FITF – grace period
  - Provides two exceptions to prior art:
    - one-year grace period for filing if inventor or assignee makes public disclosure
    - a company's own applications are not prior art against its later applications
      - if applications filed pursuant to joint research agreement are not prior art against each other
  - Similar to current system, but protects only against inventor's own disclosures or patent applications



# The AIA

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- FITF – grace period (con't.)
  - There may be practical difficulties to produce information sufficient to detail the right to rely on grace period.
  - Other FITF Considerations
    - Once an inventor discloses invention, that disclosure may be used as a shield against later disclosures and patent filings provided that an application is filed on the disclosed invention within the one year grace period
    - The disclosure can be an absolute novelty bar to inventions by others that are filed later

# The AIA

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- FITF – Obviousness:
  - Now assessed from before the effective filing date of the claimed invention (instead of time of the invention)
- Open Prior Art Issue: Will “public disclosures” encompass sales or public use?
  - Prudent to assume that private sales and offers-for-sale will continue to have prior art effect

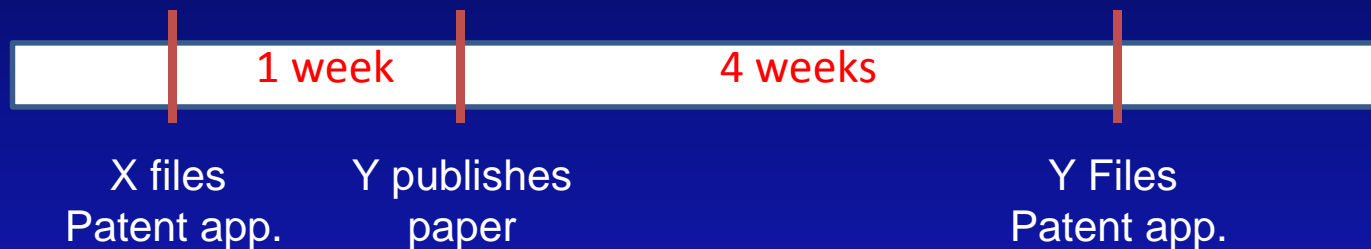
# The AIA

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- FITF – Timing
  - All applications filed on or after 3/16/13
  - Later-filed continuations or divisionals claiming priority to earlier applications are governed by first-to-invent system
    - CIPs are different!
    - *E.g.*, all claims of a CIP filed after 3/16/13 fall under FITF
  - To keep application in the old system, do not add new matter. File separate CIP or new application (if appropriate) to new matter and any improvements.

# The AIA

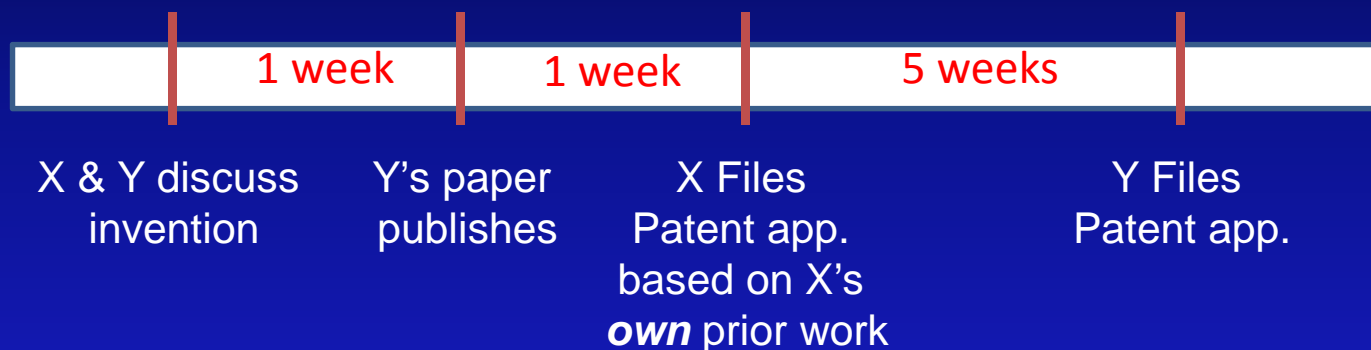
## Example 1 – assume no derivation



- X's application is prior art against Y's application
- Y's paper is not prior art against either application

# The AIA

## Example 2 – assume no derivation



- Who gets priority? *NO ONE!*
- X's application is prior art against Y's application
- Y's paper is prior art against X's application
  - Y should have filed a provisional before publication

# The AIA

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## Derivation Proceedings



# The AIA

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- Derivation proceedings in the USPTO
  - A later applicant may assert that an earlier applicant derived the claimed invention and filed without authorization
  - Effectively replaces interference proceedings
    - question now centers on single act of invention rather than competing acts of invention
  - Remedy is cancellation/refusal of derived claims
  - Petition must be filed within one year of publication of a competitor's application

# The AIA

## Example 3 – assume derivation exists



- X's patent is prior art against Y
- Even though X derived its work from Y, too late to file derivation proceeding b/c more than one year passed since Y's publication
- Also too late for Y to sue X for derivation b/c more than one year passed since issue of X's patent

# The AIA

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## Validity and Infringement Defenses

# The AIA

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- Best mode
  - No longer available as basis for invalidity or unenforceability of an issued patent
  - Obligation to disclose best mode in applications remains
  - Applies to all proceedings filed on or after enactment

# The AIA

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- Patent marking
  - False patent marking greatly curtailed
    - response to recent surge in *qui tam* litigation
    - marking a product with expired patent number that once covered product is not a violation
  - Virtual marking permitted
    - marking may be achieved by posting patent information Online

# The AIA

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- Prior user rights
  - Defense to infringement if:
    - defendant had been commercially using a patented invention
    - at least one year before patentee's effective filing date or earlier publication (*i.e.*, grace period)
  - No longer just for business methods
  - “University exception” – eliminates prior user rights when the “claimed invention...was, at the time the invention was made, owned or subject to an obligation of assignment to either an institution of higher education...or a technology transfer organization”



# The AIA

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- Prior user rights (con't.)
  - Regulatory review periods and non-profit laboratory use count as commercial use
  - Defense is personal and can be transferred only with transfer of entire enterprise or line of business protected by defense
    - scope of defense is limited after transfer
  - Downstream purchasers of accused product protected by patent exhaustion

# The AIA

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## Third Party Intervention

# The AIA

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- Preissuance submission (inexpensive)
- Post-grant review (expensive)
- *Inter partes* review (expensive)
- *Ex parte* reexam (expensive)

# The AIA

	<i>Ex Parte</i> Reexam	<b>Preissuance Submission</b>	Post Grant Review	<i>Inter Partes</i> Review
Who can file?	anyone	anyone	third party only	third party only
Basis	patents and printed publications	patents and printed publications	any grounds	patents and printed publications
Threshold	substantial new question of patentability	preponderance of the evidence	(1) more likely than not or (2) novel or unsettled legal question	reasonable likelihood
Timing	any time after grant	earlier of allowance or later of 6 mo. after publication or first claim rejection	within 9 months from patent grant	later of 9 months after grant or date of termination of a Post Grant Review
Estoppel	none	none	yes – issues that were or could have been raised	yes – issues that were or could have been raised
Cost	\$17,750	first submission ≤ 3 docs = free; or \$180 for every 10 docs submitted	\$35,800	\$27,200

# The AIA

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- Preissuance submission
  - Any person may submit patents and printed publications for review before the earlier of:
    - date of allowance; or
    - later of:
      - six months after the patent application publishes, or
      - first rejection of any claim

# The AIA

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- Preissuance submission
  - Publications that can be submitted include:
    - patents;
    - published patent applications; and
    - other printed publications (*e.g.*, journal articles, emails, posters, etc.)
    - that are of potential relevance to the examination of the application



# The AIA

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- Preissuance submission (con't.)
  - Concise description of asserted relevance
    - a statement of facts explaining how the document is of potential relevance to the examination of the application (e.g., claim chart)
    - not an invitation to participate in the prosecution of the application, and must not include proposed rejections of the claims or arguments relating to an Office Action or an applicant's reply

# The AIA

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- Post-grant review
  - A third-party may petition the USPTO to institute post-grant review of a patent
  - Petitioner may request cancellation of claims as unpatentable on virtually any ground (*e.g.*, prior art, written description, enablement, utility, or patentable subject matter)
  - Petition must be filed within 9 months of patent grant
  - Applies only to patents subject to FITF rules

# The AIA

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- *Inter partes* review
  - Challenges to validity based on patents or printed publication only
  - Replaces *inter partes* reexamination
  - Not available if petitioner previously filed a lawsuit challenging the validity of the patent
  - Not available if the petition is filed more than 12 months after petitioner is sued for infringement of the patent

# The AIA

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## Supplemental Examination

# The AIA

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- New procedure for patentees
- Patentees may request examination to consider, reconsider, or correct information relevant to patentability
- USPTO must conduct examination within three months to determine whether substantial new question of patentability is raised
- Newly disclosed information may not be used as a basis for asserting inequitable conduct

# The AIA

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- Protection from inequitable conduct claim does not apply:
  - to allegations pleaded with particularity in litigation before examination request is filed
  - if patentee files patent infringement suit before supplemental examination is concluded
- Can be applied retroactively to existing patents



# The AIA

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## PTO Practice, Operations, Fees and Funding

# The AIA

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## ■ Prioritized examination

- The USPTO is to provide “for prioritization of examination of applications for products, processes, or technologies that are important to the national economy or national competitiveness without recovering the aggregate extra cost of providing such prioritization”
- Additional \$4800 fee (50% discount for small entities)
- Goal is to provide a first substantive response from the USPTO within 12 months of patent application filing

# The AIA

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- PTO fees
  - Gives permission for the USPTO to set and adjust its fees
  - Effective 9/26/11, there was a 15% surcharge on almost all fees, including maintenance fees, and another ~10% on March 19, 2013
  - Implements a \$400 fee for non-electronic filing

# The AIA

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- Micro-entity status

- A micro-entity is entitled to a 75% discount of many USPTO fees
- A micro-entity is generally a person who is employed by an institution of higher education, or has not been named on more than 4 prior applications and meets certain income requirements
- May be able to get micro-entity status if assign or license to institute of higher education

# Take Aways

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## What to do now?

- Capture inventions in-house as soon as possible
- Timely review invention disclosures and decide whether or not to file
- Quickly approve and file patent applications

# Take Aways

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## What to do now? (con't.)

- Implement “absolute novelty” practices (*e.g.*, filing provisional before disclosure, mindful of marketing materials)
- Keep good records (*i.e.*, inventorship, meetings)
- Monitor patents and published applications for derivation concerns

# TAROLLI, SUNDHEIM, COVELL & TUMMINO LLP

## Intellectual Property Law



John R. Hlavka, Partner  
216.621.2234, Ext. 136  
[jhlavka@tarolli.com](mailto:jhlavka@tarolli.com)

### **Practice Areas**

Mechanical and electrical patents, trademarks and litigation

Mr. Hlavka has more than 35 years of experience in patent, trademark and copyright prosecution and litigation. He is registered to practice before the U.S. Patent and Trademark Office. His patent experience includes counseling clients on the domestic and international protection of their inventions and the prosecution of domestic and international patent applications. He has litigated patent infringement issues on behalf of both patent owners and accused infringers.

Mr. Hlavka manages several large international trademark portfolios for his clients. He counsels clients on the protection, registration and enforcement of trademarks. Mr. Hlavka regularly provides trademark clearance opinions, conducts trademark audits and represents clients in U.S. and foreign trademark opposition proceedings.

Mr. Hlavka also advises clients on copyright issues and prosecutes copyright applications. He has represented clients in copyright infringement litigation.

Mr. Hlavka regularly conducts patent and trademark talks at his clients' facilities and has spoken at local Bar Associations on the subject of patents, trademarks and copyrights.

### **Education:**

- B.S.M.E. with Honors, Case Western Reserve University, 1971
- J.D., Magna cum laude, Cleveland Marshall College of Law, 1976