

UPDATE

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IN THIS ISSUE

- 1 Rules for America Invents Act Provisions
- 5 Tools to Protect Your Rights and Brands During gTLD Evaluations
- 9 Federal Circuit Reaffirms Patent Eligibility of Isolated DNA Molecules
- 11 Seeing Red: Recent Developments in the Trademark Functionality Doctrine
- 14 Federal Circuit Reverses *Marine Polymer* Decision

RULES FOR AMERICA INVENTS ACT PROVISIONS



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On September 16, 2012 certain provisions of the America Invents Act (AIA) went into effect. Below is an overview of several notable provisions effective on September 16, 2012.

PREISSUANCE SUBMISSIONS

Preissuance submissions allow a third party, anonymously or otherwise, to submit relevant art to the United States Patent and Trademark Office during examination of a patent application. Each preissuance submission must be submitted within a statutorily defined period and include: a list of patents, published patent applications or other printed publications being submitted; a concise description of the relevancy of the submitted documents; and a fee.

The USPTO determines the sufficiency of the concise description on a case-by-case basis. A brief narrative or simple statement would be acceptable. However, a bare statement that “the art is relevant” would be unacceptable. A submission must be filed before the mailing

date of a Notice of Allowance; or the later of 1) six months from the first publication date; or 2) the first office action rejecting any claim. The submission fee is \$180 for every ten documents. The fee is waived for a first submission of three or fewer documents accompanied by a party’s statement that this is their “first and only” submission in the application. Relevant documents uncovered by the party after such a submission may still be submitted. A third party’s participation in the prosecution of the subject application ends with the submission.

CITATION OF WRITTEN STATEMENTS

Any person, anonymously or otherwise, may submit to the USPTO patent owner statements that impact the scope of patent claims. Previously, only submission of patents and printed publications were permitted. Now certain patent owner statements may be submitted. The submission must be served upon the patent owner. The relevance of the submission to a claim(s) must be explained. Only statements filed in a proceeding before a Federal court or the USPTO, in which the patent owner took a position on the scope of any claim in the patent, can be submitted, but must be accompanied by any other [MORE](#) ▶

[AIA PROVISIONS, FROM PAGE 1]

pleadings or evidence from the proceedings that address the statement(s). A patent owner submitter may also include an explanation of patentability in view of their claim scope statement. The USPTO can use these statements in *Inter Partes* Review, Post Grant Review, and *Ex Parte* Reexamination to determine claim scope.

CHANGES TO OATH OR DECLARATION

Changes to the inventor's oath or declaration (declaration) requirements allow filing by the assignee as the applicant, postponing filing until the application is otherwise in condition for allowance, reuse of previous declarations, and provide an alternative to the declaration in situations where the declaration cannot be executed. The declaration can now be made in an inventor's assignment recorded with the USPTO.

SUPPLEMENTAL EXAMINATION

Supplemental examination allows a patent owner to request the USPTO to consider, reconsider, or correct information believed to be relevant to a patent. The USPTO must conduct the supplemental examination within three months of the request and determine whether a substantial new question of patentability (SNQP) exists. A patent cannot be held unenforceable based on conduct relating to information used during the supplemental examination. This immunity does not apply to allegations made before the request and pled with particularity in a civil or ITC action, or a Hatch-Waxman Para. IV notice.

The supplemental examination request must identify the patent, list up to twelve items of information which the USPTO must consider, and specify all claims of the patent to be

Substituting the declaration with a statement is now permitted when an inventor is deceased, legally incapacitated, cannot be reached, or refuses to sign.

Substituting the declaration with a statement is now permitted when an inventor is deceased, legally incapacitated, cannot be reached, or refuses to sign. The substituted statement can only be signed by the inventor's legal representative, assignee, and a party to whom the inventor is under obligation to assign or who otherwise has a sufficient proprietary interest.

In a reissue declaration, the USPTO now requires applicants to specifically identify any broadening of a patent claim. A claim broadened in any respect would be treated as a broadened claim, even though the claim may be narrowed in another respect.

examined, all issues raised by the information, and the relevance of the information to the specified claims and raised issues. In addition to patents and printed publications, the information may include transcripts of audio and video recordings. If the supplemental examination raises a SNQP then the USPTO will order *ex parte* reexamination and issue a reexamination certificate at its conclusion. If no SNQP has been raised, then the USPTO will issue a supplemental examination certificate.

If during the supplemental examination, the USPTO becomes aware of material fraud involving the subject patent, the USPTO shall confidentially refer the matter to the U.S. Attorney General.

INTER PARTES REVIEW

Inter Partes Review (IPR) provides a new trial proceeding before the Patent Trial and Appeal Board (Board) (which replaces the Board of Patent Appeals and Interferences) to review patents. IPR replaces *Inter Partes* reexamination. A third party may petition for a review of the patentability of a claim only under 35 U.S.C. §§ 102 or 103 based on prior art patents or printed publications. IPR is available for all patents issued on, before or after September 16, 2012.

A party that has filed a declaratory judgment action challenging the validity of a patent claim may not thereafter initiate a PGR.

A petition identifying the challenged claim(s), grounds for the challenge to each challenged claim, and other supporting evidence may be filed the later of (i) nine months after the grant or reissue of a patent, or (ii) after the termination of an initiated post grant review proceeding. A third party that seeks a declaratory judgment challenging the validity of a patent may not thereafter initiate an IPR. A third party sued for patent infringement must file an IPR within one year of the service of the complaint. The patent owner is guaranteed the opportunity to respond to the petition.

The Board may initiate an IPR if the petitioner establishes a reasonable likelihood that the petitioner will prevail with respect to at least one of the challenged claims. Discovery, depositions, and motion practice that permits a patent owner to move to cancel, amend or substitute claims are allowed in an IPR. A preponderance of the evidence standard governs challenges to the patentability of a claim. A final determination from the Board will issue within 1 year of its initiation (extendable for good cause by 6 months).

Estoppel attaches to the requester or real party in interest by a prior IPR decision with respect to any ground that was raised or could have been raised.

POST-GRANT REVIEW

Post grant review (PGR) allows the Board to review the patentability of a patent claim on any invalidity ground that could be raised under 35 U.S.C. § 282(b)(2) or (3), except best mode. With the exception of business method patents and pending interferences, PGR is available only for patents that issue with a

priority date on or after March 16, 2013.

PGR begins with a petition identifying the challenged claim(s), grounds for the challenge to each claim, and other supporting evidence. Unlike an IPR, a PGR is not limited to patents and printed publications. Thus, a petition for PGR may be based on evidence of public use, on-sale activity or other public disclosure, as well as failure to comply with written description, enablement, or patentable subject matter requirements. The petition must be filed within nine months after the grant or reissue of a patent. A party that has filed a declaratory judgment action challenging the validity of a patent claim may not thereafter initiate a PGR. The patent owner is permitted a preliminary response setting forth why a PGR should not be initiated.

Discovery may be allowed only for “evidence directly related to factual assertions advanced by either party in the proceeding.” A preponderance of the evidence standard governs challenges to the patentability of a claim in a PGR. A final determination from the Board will issue within 1 year of its initiation (extendable for good cause by 6 months).

[MORE ▶](#)

[AIA PROVISIONS, FROM PAGE 3]

Estoppel attaches to the requester or real party in interest by a prior PGR decision with respect to any ground that was raised or could have been raised.

TRANSITIONAL PROGRAM FOR COVERED BUSINESS METHOD PATENTS

The Transitional Program for Covered Business Method Patents, (TPCBMP) provides for a new post grant review option for any “covered

person or real party in interest or its privy that has been sued for or charged with infringement under a covered business method patent may file a petition for a TPCBM. A covered business method patent may be challenged under the same procedures and standards applied in PGR proceedings. The TPCBMP is called transitional because it is scheduled to end eight years from implementation.

A “covered business method patent” is defined as “a patent that claims a method or corresponding apparatus for performing data processing or other operations used in the practice, administration, or management of a financial product or service, except that the term does not include patents for technological inventions.”

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Estoppel arising following a TPCBMP proceeding is different from estoppel following a PGR. Following a TPCBMP proceeding, estoppel is only limited to issues actually raised during the proceeding. ■

DONALD W. BANNER DIVERSITY SCHOLARSHIP FOR LAW STUDENTS

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Law students who meet the selection criteria and have entered into a JD program at an ABA-accredited law school in the United States are eligible to apply for the scholarship. Applicants may not be a current or past employee of Banner & Witcoff, or directly related to a current employee of Banner & Witcoff.

Application materials are now available for the 2013 scholarship award. Please visit www.bannerwitcoff.com/diversity for more information.



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