

VERY IMPORTANT NEWS for U.S. PATENT APPLICANTS AND OWNERS

The Smith Leahy America Invents Act became law on Sept. 16, 2011. This is the most comprehensive change to U.S. patent law in 50 years. Selected highlights follow:

1. **First to file:** This changes the U.S. from its traditional “first to invent” policy to a “first to file” system, similar to most other jurisdictions, to be effective in 18 months, on March 16, 2013.
2. **Personal Grace Period:** Also effective March 16, 2013, as an exception to the first to file rule, Applicant’s own disclosures up to 1 year prior to the filing date will not count as prior art against it. This may or may not include sales and offers of sale up to one year prior to filing.
3. **USPTO Fee Schedule Changes:** A new fee schedule went into effect Sept. 26, 2011.
4. **Micro Entities:** Small entities continue to get a 50% reduction in fees. Effective Sept. 16, 2011, a new category of “micro entity” enjoys a 75% reduction in most fees. A “micro entity” is a small entity that was not a named inventor on more than 4 previously filed U.S. utility applications; did not have more than 3 times the median household income in the prior year; and has not assigned to an entity having more than 3 times the median household income in the prior year, or works for a college or university. There are additional details that may be applicable in specific cases.

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5. **Third Party Submissions of documents:** Effective Sept. 16, 2012, anyone can submit references or other documents to the Patent Office for consideration in a specific case at any time during the prosecution or “pendency” of the application.
6. **Assignees can file to start the application:** Effective Sept. 16, 2012, the inventor’s oath or declaration is still required before the patent is granted but can be submitted any time during the prosecution.
7. **New Post Grant Proceedings:** Supplemental Examination, Post-Grant Review, and Inter Partes Review are all new, will be effective Sept. 16, 2012, and will need further study.
8. **Best Mode:** Effective Sept. 16, 2011, disclosure of Best Mode is still a formal requirement of an application, but failure to disclose Best Mode is no longer a basis for invalidation of a patent.
9. **Patent Markings:** Virtual Marking by reference to an internet site is permitted. Expired patent markings are not a violation. Private suits for invalid markings must prove competitive injury.
10. **Tax Strategies:** Certain tax strategies are deemed to be within the prior art and therefore not patentable.
11. **Much More:** There are numerous other important changes of varying importance, depending on your particular situation and objectives.

Rest assured we are continuing to monitor and study this legislation and related new developments as they pertain to our clients and their patent portfolios. Please contact us if you have any questions or would like to discuss this further.
