

CHANGES TO PATENT LAW EFFECTIVE (September 2012)

Critical changes to U.S. Patent law under the America Invents Act take effect September 16, 2012. Several of the most important changes are discussed below.

New applications can now be filed in either the name of the inventor or the assignee. A “separate declaration” is required for each inventor in contrast to the old declarations which included a single declaration form with spaces for multiple inventors. The filing of the inventors’ oath and declaration may be postponed until the application is in condition for allowance.

Another change addresses inventors who refuse to sign or cannot be found. The new process does away with the fees, petitions and statements, in favor of a single form which can be signed by a co-inventor or assignee. Therefore having executed assignments from each inventor is recommended. Otherwise employers may want to include assignment clauses in employment contracts as well as independent consulting agreements in order to satisfy the substitute statement requirements. Filing continuation, divisional, or continuation-in-part applications is advisable by September 15, 2012 if inventors are no longer available and there is no evidence or written obligation to assign.

Several procedures for review of pending patent applications and issued patents have been implemented. Pre-Issuance Submissions may be submitted by a third party in current and future pending applications. Supplemental Examination may be requested by a patent owner to consider, reconsider, or correct information believed to be relevant to a patent’s validity. Inter Partes Review is available for a patent that has been issued for at least nine months, is not subject to pending Post Grant Review, and is not the subject of a patent infringement complaint filed more than one year before the Inter Partes Review.