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US Patent Reform Act (AIA)

Selected amendments of the AIA compared to European Regulations

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AIA first-inventor-to-file ./. EP first-to-file

Similarities

- Generally the right to the patent belongs to the person having the earlier priority (filing or priority date) for the same invention
- Worldwide state of the art, comprising printed publications, use and miscellaneous publications, is relevant (no “swearing behind”)
- Inventor from whom the inventive idea is taken/derived may request invalidation/derivation procedure for nullification

AIA first-inventor-to-file ./. EP first-to-file

Differences

AIA

- Earlier but post-published US applications relevant for both novelty and obviousness
- Grace period of one year for state of the art (i) represented by information originating from the inventor or (ii) other disclosure following inventor's disclosure of the invention

EP

- Earlier but post-published EP applications relevant for novelty only
- No grace period

AIA first-inventor-to-file ./. EP first-to-file Differences

AIA

- Derivation-Procedure
 - Only available for applicant of application with later priority

EP

- Opposition-/Revocation-Procedure
 - Available for inventor irrespective of own application
- DE-“Vindikationsklage”
 - Plaintiff may request transfer of right to the patent

AIA Post grant review ./ EP Opposition Similarities

- Time limit for request is 9 months after grant
- Grounds for revocation are violations of patentability requirements
- Appeal possible
- No broadening of scope of protection
- Oral hearing in case one party requests it

AIA Post grant review ./ EP Opposition Differences (I)

AIA

- Identify the real party in interest
- Estoppel provisions may apply on subsequent following infringement/revocation proceedings

EP

- Straw man may oppose
- German: No prejudice on infringement/revocation proceedings
- Additional grounds for revocation: inadmissible extension of disclosure and fraudulent abstraction “widerrechtliche Entnahme”

AIA Post grant review ./. EP Opposition Differences (II)

AIA

- Does not appear that PTAB will conduct own independent investigation
- Procedure may generally be terminated by settlement
- Discovery

EP

- Office may conduct investigation on its own
- No termination by parties possible
- Generally no discovery proceedings

AIA Post grant review ./. EP Opposition Differences (III)

AIA

- Higher degree of substantiation (“more likely than not”) for initiation of review
- Patent Trial and Appeal Board (PTAB) decides
- PTAB has time limit of one year for decision

EP

- Lower degree of substantiation (“conclusiveness”) for admissibility
- Patent office decides
- No strict time limit for decision

AlA Inter-partes review ./ German Nullity action Similarities

- Request may be filed later than 9 months after grant or filed after closing of post grant review/opposition
- Grounds of revocation:
 - Lack of novelty / inventiveness
- Estoppel provisions apply also for nullification parties in Germany
- No broadening of scope of protection
- Procedure may be closed by settlement of parties

AIA Inter-partes review ./. DE Nullity action Differences

AIA

- State of the art are solely patent documents and printed publications
- Only lack of novelty or inventiveness are revocation grounds
- Admissibility threshold of “reasonable likelihood of success”

EP

- Complete state of the art
- Additional grounds for revocation as for opposition procedure
- No admissibility threshold with regard to likelihood of success

AlA Supplemental examination ./ EP Limitation Similarity

- Proceedings that may lead to a restriction of the scope of protection and that may be requested by patent owner
- Broadening of scope of protection inadmissible

AIA Supplemental examination ./ EP Limitation Differences

AIA

- Purpose is to let the office consider, reconsider, or correct information believed to be relevant to the patent
- Two stage procedure: (i) office decides whether provided information raise substantial new question of patentability, (ii) “ex-parte reexamination” in case new question raised

EP

- Purpose is to voluntarily restrict scope of European patent in central procedure for all designated states
- Only examination on formal requirements of request and whether provided amended documents restrict scope of protection

AIA Supplemental examination ./ EP Limitation Differences

AIA

- Information probably raising new question of patentability have to be provided
- During “ex-parte reexamination” phase own investigation of office

EP

- No new information on patentability (e.g. state of the art) necessary
- No own investigation of the office

AIA Prior art submission/.EP Third party Observation Similarities

- Submission/Observation possible from publication of application on
- Person filing submission/observation does not become party of the examination proceedings
- Submission/Observation has to be substantiated
- No prejudice, straw man may file

AIA Prior art submission ./ EP Third party Observation Differences (I)

AIA

- Only written publications citable
- Has to be filed before the earlier of (A) notice of allowance; or (B)(1) the later of 6 months after publication or (2) date of first rejection
- Submissions (prior art and statements on scope of claims by patent owner) filed pre- or post-issuance (outside time frame) become part of the official file

EP

- Complete state of the art citable
- Also observations filed in opposition procedure after grant of the patent are considered by examiner(s)

AIA Derivation ./. EP Fraudulent abstraction

- Aim is the (partial) revocation of the patent
- Substantiation is examined

AIA Derivation ./. EP Fraudulent abstraction Differences (I)

AIA

- Only applicant of later application legitimized
- Time line of one year after publication of the derived claim in application/patent
- Decision on admissibility not appealable

EP

- Every inventor is legitimized
- Timely restriction due to time lines for revocation proceedings
- Decision on admissibility appealable

AIA Derivation ./ EP Fraudulent abstraction Differences (II)

AIA

- Derivation proceedings may be entered during examination procedure at the USPTO
- Derivation proceedings may be entered after grant at a civil court

EP

- Revocation ground admissible not earlier than after grant during opposition procedure
- Germany: Revocation ground admissible in nullity procedure

AIA Prior use ./ DE Prior use Similarities

- Defense in infringement litigation
- Use needs to take place in the respective territory (USA/DE)

AIA Prior use ./. DE Prior use Differences

AIA

- Beside using party also affiliated enterprise may use this defense but defense limited to the site where the existing commercial use occurred
- Use has to be commercial (including admission procedure)
- Defense not admissible against Universities
- Use occurred in the US at least one year before effective filing date or public disclosure

EP

- Defense is admissible only for party that has prepared or started the use and binding to enterprise
- The ownership of the invention and the preparation of the use are sufficient
- Use/preparation of use occurred before priority date

Conclusion

- To have the opportunity of a derivation procedure the filing of own applications in the US is necessary
- US Post grant review/Inter partes review allows accelerated pro active attack of legal validity – anyhow effects of Estoppel provisions will need to be considered
- EP Opposition procedure allows pro active attack of patentability with significant reduced Estoppel effect in comparison to US
- (Third party) submission of prior art or of statements of patent owner regarding scope of claims filed in a proceeding before a federal court or USPTO might be recommendable as pro active action
- Attack of legal validity by post grant review avoids jury trial decision on legal validity and opens additional revocation grounds beside lack of novelty or inventiveness

Many thanks for your attention !
Questions ?



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