
The next wave of U.S. patent reform changes embodied in the America Invents Act takes effect on September 16, 2012. The following is a list of some key changes. Please contact us for more information on these and other specific changes that may impact your U.S. patent portfolio.

I. PATENT PROSECUTION CHANGES

A. For U.S. patent applications filed on/after September 16, 2012

• Prosecution By Assignee
  An assignee (or party to whom the inventors are obligated to assign the invention) can act as the applicant. In such cases, the assignee (not the inventors) should execute a power of attorney document.

• Inventor Oath/Declaration
  The executed inventor oath/declaration can be submitted at the close of prosecution, in response to a Notice of Allowability, as long as the inventor information is provided in an Application Data Sheet at the time the application is filed or within the Missing Parts/Missing Requirements response period.
  The inventor oath/declaration must include new statements but need no longer include other currently required statements.
  The inventor oath/declaration statements can be included in a combined assignment/declaration document.
  The inventor oath/declaration for a continuing application filed on or after September 16, 2012 must satisfy the new rules; thus, a new oath/declaration may be required for a continuing application if the parent application was filed before September 16, 2012

• Reissue Application Practice
  The requirements for the reissue oath/declaration are simplified, but include a new requirement to identify a claim that the application seeks to broaden, if the reissue application is a broadening reissue application.

B. For all U.S. patent applications pending on/after September 16, 2012

• Correction Of Inventorship
  The requirements for correction of inventorship and changing the order of inventors are simplified.

- Preissuance Submissions By Third Parties
  Third parties can submit any patent, published patent application, or other printed publication of potential relevance to the examination of an application. The submission must be filed within a strict time period, generally before the earliest of a first Office Action on the merits or Notice of Allowance.

II. POST-GRANT CHANGES

A. For all U.S. patents in force on/after September 16, 2012

- Supplemental Examination
  Patent owners can request a supplemental examination proceeding to obtain consideration, reconsideration, or correction of information believed to be relevant to the patent. Under certain circumstances, pursuing supplemental examination can shield the patent from unenforceability arising out of inequitable conduct charges surrounding the information at issue.

- Third Party Requests for Ex Parte Reexamination
  Third party requesters must certify that their request is not barred by statutory estoppel arising out of an inter partes review or post-grant review proceeding.

- Inter Partes Review
  Inter partes review replaces inter partes reexamination, which is no longer available.

- Submission of Written Statements Of Patent Owner
  Third parties may submit in the file of a granted patent certain written statements filed by the patent owner in a Federal court or USPTO proceeding in which the patent owner took a position on the scope of any claim in the patent.

B. For certain business method patents

- Post grant review
  Certain business method patents are subject to post grant review by parties who have been charged with infringement.

III. USPTO CHANGES

- The “Board of Patent Appeals and Interferences” is redesignated as the “Patent Trial and Appeal Board” and will be conducting the new inter partes review and post grant review proceedings.