



The Evolving IP Landscape in the United States

America Invents Act 《美国发明法案》

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FINNEGAN

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FIRST-INVENTOR-TO-FILE SYSTEM

发明人先申请体系

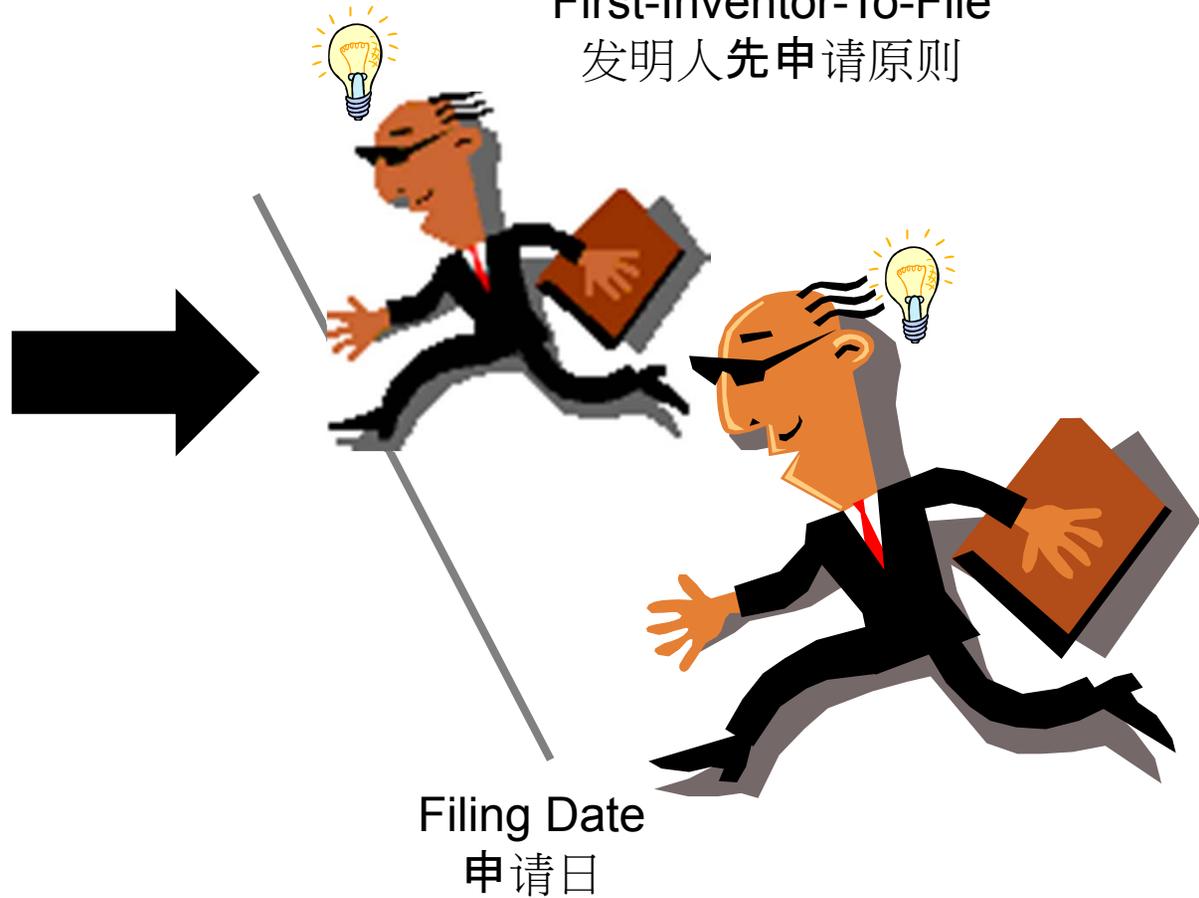
First-Inventor-To-File

发明人先申请原则

First-To-Invent
先发明原则



First-Inventor-To-File
发明人先申请原则



New Section 102(a)

新条款102(a)

- Significant Changes
 - Effective filing date
 - No geographical limitations
- 重大变更
 - 有效申请日
 - 没有地理限制



New Section 102(b)

新条款102(b)

- Grace period: Disclosure made 1 year or less before effective filing date is not prior art if:
 - Made by inventor or another who obtained subject matter from inventor, or
 - Subject matter was previously disclosed by inventor or another who obtained subject matter from inventor
- 宽限期：在以下情况下，在有效申请日前一年或更短时间内所进行的披露，不构成在先技术，如果：
 - 是发明人或从发明人那里取得主题的人所进行的披露，或
 - 主题由发明人或从发明人那里取得的主题的人进行了提前披露



Why First-**Inventor**-To-File v. First-To-File?

为什么**发明人**先申请 v. 先申请?

- Relief for true inventors against derivation
- **Derivation proceedings** in USPTO and district court
- Time limit: Imposes obligation to monitor publications or risk losing patent to a deriving “inventor”
- 依据源头，提供给真实发明人的救济
- 美国专利商标局和地区法院中的**源头程序**
- 期限：规定义务，进行监控出版物或冒着源头“发明人”丧失专利的风险



PRE-ISSUANCE THIRD-PARTY SUBMISSIONS

授予前第三方提交

AIA Third-Party Submissions

美国发明法第三方提交

- Effective date: September 16, 2012
- Apply to any application filed before, on, or after September 16, 2012
- USPTO Rules: published July 17, 2012

- 生效日：2012年9月16日
- 适用于2012年9月16日之前，当日或之后所提出的任何申请
- 美国专利商标局规则：2012年7月17日颁布

POST-GRANT REVIEW

专利授予后审查

Post-Grant Review

专利授予后审查

- Effective date: September 16, 2012
- Apply to any patents issuing from applications subject to first-inventor-to-file provisions of the AIA
- USPTO Rules: published August 14, 2012

- 生效日：2012年9月16日
- 适用于基于美国发明法下发明人先申请条款的申请所授予的任何专利
- 美国专利商标局规则：2012年8月14日公布

Post-Grant Review (PGR)—Introduction

专利授予后审查（PGR）—引言

- Allows challenge within 9 months of grant
 - Can be based on **any** invalidity ground
 - Prior art
 - Utility and patent eligibility
 - Enablement, written description, definiteness
 - Broader grounds than current reexam or new inter partes review
-
- 在专利授予后的9个月内允许提出异议
 - 可以基于**任何**无效性理由
 - 在先技术
 - 实用性和专利适格性
 - 赋能、书面描述、明确性
 - 比当前复审或新的双方审查更广泛的理由

PGR—Conduct of Proceedings

专利授予后审查—执行程序

- The **Patent Trial and Appeal Board** will conduct PGR
 - May allow for discovery
 - Protective Orders
 - Oral hearing
 - Provide petitioner at least one opportunity to file written comments
- Patentee may amend claims but cannot enlarge scope
- Final determination within 1 year after initiation
 - For good cause, PTO may extend determination by 6 months
- Either party may appeal to the Federal Circuit
- **专利审理和上诉委员会**将实施专利授予后审查
 - 可能允许取证
 - 保护令
 - 口头审理
 - 给予请求人至少一次的机会递交书面意见
- 专利权人可以修改权利要求，但不能扩大范围
- 在发起后一年内做出最终决定
 - 有适当理由，专利局可能延期6个月做出决定
- 任何一方能向联邦巡回上诉法院提出上诉

PGR—Estoppel

专利授予后审查—禁反言

- PTO: May not request or maintain proceeding on ground petitioner **raised or reasonably could have raised** in PGR resulting in final written decision
- Civil action/ITC:
 - May not assert ground that petitioner **raised or reasonably could have raised** during PGR resulting in final written decision
- “Final written decision” ≠ settlement
- 专利局: 不能基于请求人在导致最终书面决定的专利授予后审查中**提出或者应该合理提出**的理由, 请求或者维持程序
- 民事诉讼/国际贸易委员会:
 - 不能主张请求人在导致最终书面决定的专利授予后审查中所**提出或应该合理提出**的主张
- “最终书面决定” ≠ 和解



PGR—Pros v. Cons

专利授予后审查 — 优势 v. 劣势

- Advantages
 - Broader grounds than current reexam or new inter partes review
 - Lower burden of proof than litigation
 - Lower cost than litigation
 - Final determination within 1-1½ years
- Disadvantages
 - Must identify real parties in interest
 - Estoppel effect
- 优势
 - 比当前复审或新的双方审查具有更广泛的理由
 - 比诉讼更低的举证责任
 - 比诉讼更低的成本
 - 1-1½ 年内做出最终裁决
- 劣势
 - 必须确认真实利害关系方
 - 禁止反言后果

INTER PARTES REVIEW

双方审查

Inter Partes Review

双方审查

- Effective date: September 16, 2012
- Apply to any patent issued before, on, or after September 16, 2012
- USPTO Rules: published August 14, 2012
- 生效日：2012年9月16日
- 适用于2012年9月16日之前，当日或之后所授予的任何专利
- 美国专利商标局规则：2012年8月14日

Inter Partes Review (IPR)—Introduction

双方审查（IPR）—引言

- May be filed the later of either:
 - 9 months after grant, or
 - If PGR instituted, then termination of PGR
- Based only on patents and printed publications (like current reexam)
- Will eventually replace inter partes reexam
- 可能提起，时间以以下较迟者为准：
 - 专利授予后9个月，或者
 - 如果发起专利授予后审查，那么，专利授予后审查终止日
- 仅仅基于专利和印刷出版物（如同当前复审）
- 将最终代替双方复审

IPR—Conduct of Proceeding (Same as PGR)

双方审查—执行程序（同于专利授予后审查）

- The Board will conduct each proceeding
 - May allow for discovery
 - Protective Orders
 - Oral hearing
 - Provide petitioner at least 1 opportunity to file written comments
- Patentee may amend claims but cannot enlarge scope
- Final determination within 1 year after initiation
 - For good cause, USPTO may extend determination by 6 months
- Either party may appeal to the Federal Circuit

- 委员会将实施程序
 - 可能允许取证
 - 保护令
 - 口头审理
 - 给予请求人至少一次的机会递交书面意见
- 专利权人可以修改权利要求，但不能扩大范围
- 在发起后的一年内做出最终决定
 - 有适当理由，专利局可能延期6个月做出决定
- 任何一方能向联邦巡回上诉法院提出上诉

IPR—Estoppel

双方审查—禁反言

- USPTO: May not request or maintain proceeding on ground petitioner **raised or reasonably could have raised** in IPR resulting in final written decision
- Civil action/ITC: May not assert ground that petitioner **raised or reasonably could have raised** during IPR resulting in final written decision
- “final written decision” ≠ settlement
- 专利局：不能基于请求人在导致最终书面决定的双方审查中所**提出或者应该合理提出**的理由，请求或者维持程序
- 民事诉讼/国际贸易委员会：不能主张请求人在导致最终书面决定的双方复审中所**提出或者应该合理提出**的主张
- “最终书面决定” ≠ 和解



IPR—Pros v. Cons

双方审查—优势 v.劣势

- Advantages
 - Lower burden of proof than litigation
 - Lower cost than litigation
 - Final determination within 1-1½ years
- Disadvantages
 - Must identify real parties in interest
 - Estoppel effect
- 优势
 - 比诉讼更低的举证责任
 - 比诉讼更低的费用
 - 1-1½年内做出最终裁决
- 劣势
 - 必须确认真实的利害关系方
 - 禁止反言后果

Strategy Considerations

战略考虑

- Benefits & Considerations
 - Cost (compared to district court) & Speed (~1 year)
 - Limitations on availability/evidence/grounds (PGR vs IPR)
 - Discovery opportunities (but limited)
 - Decision maker (Appeal to Fed. Cir)
 - Broadest reasonable interpretation (USPTO) versus judicial claim construction (district court)
 - Preponderance of the Evidence (USPTO) versus Clear and Convincing (Presumption of validity in district court)
- 利益及考虑
 - 成本 相较于地区法院) & 速度 (1年)
 - 对可供性/证据/理由的限制 (授予后复审对双方复审)
 - 取证机会 (但有限制)
 - 决策者 (向联邦巡回法院上诉)
 - 最广泛合理解释 (专利局) 对司法权利要求解释 (地区法院)
 - 证据优先 (专利局) 对明确和确凿的 (地区法院假定有效)

Strategy Considerations

战略考虑

- Beware
 - Cost (much higher than EPO opposition)
 - Estoppel effects
 - Threshold for entry
 - Requires QUICK and EARLY action

- 提防
 - 成本（大大高于欧洲专利局异议）
 - 禁止反言效果
 - 进入门槛
 - 要求迅速和提早行动

PRIORIZED EXAMINATION

优先审查

Prioritized Examination

优先审查

- Took effect on September 26, 2011
 - “Track 1” examination – goal of “final disposition” within 12 months
 - 88% grant rate in the first four months!
 - No more than four independent claims or 30 total claims
 - Limit of 10,000 applications per fiscal year
 - Petition fee: \$4800
-
- 于2011年9月26日生效
 - “一号路径”审查 – “最终处置”的目标是在12个月内完结
 - 前四个月的授予率是88%!
 - 不多于四个独立权利要求或全部30个权利请求
 - 每财政年不超过10,000件申请
 - 请求费: \$4800



Prioritized Examination

优先审查

- Procedure for prioritized examination does not apply to:
 - international applications that have not entered the national stage under 35 U.S.C. 371;
 - design applications;
 - reissue applications;
 - provisional applications; or
 - reexamination proceedings

- 优先审查程序不适用于：
 - 在美国法典35号第371条规定下，还未进入国家阶段的国际申请；
 - 外观设计申请；
 - 重新颁证申请；
 - 临时性申请；或
 - 复审程序

Questions?

问题

Thank You

谢谢



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 - Former patent examiner at the U.S. Patent and Trademark Office in the materials science and engineering areas
-
- 本事务所Palo Alto分所管理合伙人
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 - 经常就专利和商业秘密法发表演讲
 - 曾担任美国专利及商标局材料科学及工程范畴的专利审查员

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