

The Smith-Leahy Act, also known as the America Invents Act, was signed by President Obama on Friday, September 16th and will become fully in effect in about 18 months. Importantly, the “first to file” system and the race to the patent office will come in to effect on or around March 15, 2013.

Question: How will this change in patent law affect me if I have an invention?

Answer: The major shift in US patent law from “first to invent” to “first to file” as it affects you is very much tied to the revised definition of prior art. Prior art is ALL information in the public domain prior to the actual filing date of your patent application that anticipate the novelty and non-obviousness of your invention. All information includes journal references, patent applications (whether or not yet published), patents, websites, blogs, student theses, and dissertations in the library and more. Before, under the old regime, when someone else filed for patent protection on something the same or very similar to your invention then it was possible to argue (with well kept lab books in hand) that you had invented first and if successful (because you keep great lab books) have the patent issued to you. This practice was called “swearing behind a reference” and led to interference proceedings. Under this new regime, this practice no longer applies. Instead we will have “Derivation Proceedings” whereby we may petition (so long as we do so within a year from the date the patent application publishes) the patent office showing that an earlier filed application claiming the same invention as ours was “derived” from us – which is code for someone stealing our ideas. Similarly, others can petition the Patent Office if our invention is considered to be derived or “stolen.” The intricacies of how all this will work is not yet clear but your keeping good laboratory notebooks will remain an important practice.

Question: Do I still have the one year grace period to file for patent protection after I have published or disclosed my invention?

Answer: Yes, under the new rules you still have the right to file a patent application for up to a one year period after public disclosure in the US (but only in the US). This is unlike anywhere else in the World where absolute novelty is a requirement. This is a false security because even though the right to file remains, if someone else working in a very similar field as yourself files a patent application claiming a similar invention before you, then the patent might issue first to them and not to you. It is not possible to know if someone else has filed a patent application until 18 months after the application has been filed, but if you are able, your odds are better if a patent application is filed before you publish or disclose.

Question: What can I do to protect the patentability of my invention?

Answer: Two things: First, start talking to OCCD about your ideas or inventions as early as possible so that if OCCD needs to file for patent protection we can do so as quickly as possible. The caveat here is that it is still a requirement under patent law that a patent application actually teach (one of ordinary skill in the art) how to make/use your invention. OCCD staff can help you with determining the level of detail needed in order to file a patent application that will withstand future scrutiny. Generally, a draft of a manuscript or a grant proposal makes for a good starting point for providing this level of detail. Second, before OCCD has filed a patent application or your research describing your invention has published, you will need to have a non-disclosure or confidentiality agreement in place before you begin sharing your ideas and inventions with non OSU people.

Question: Does “first to file” mean that other people can take my ideas and file for patent protection?

Answer: No. First to file does not mean that anyone could claim your invention just because they got to the patent office first. Inventors are still inventors. You must be an inventor to claim inventorship. Other people who steal your ideas and claim them as their own are frauds. Patents can be held invalid for fraudulent inventorship.

Question: What changes will OCCD be making as the new patent rules come on-line?

Answer: An on-line invention disclosure system is now available.

<http://oregonstate.edu/research/occd/submit-invention>

Once submitted, your invention disclosure is pipelined into an Invention Disclosure Review portal. This portal was created with the goal of a) providing you with fast and informed feedback about your invention (in terms of its scientific/technical merit, stage of development, proprietary position, commercial potential and avenues of commercialization) and b) quickly connecting you with appropriate industry partners who could be interested/willing in taking your invention to the next stage, whether that be through licensing, providing additional funding for your research, or working with you to start a company. Other changes will be a streamlining of the process of putting a non-disclosure agreement in place.