

America Invents Act Boot Camp – How to Apply the New Rules September 25, 2013

Susie S. Cheng, Ph.D., Esq.

Elizabeth M. Barnhard, Esq.

Leason Ellis LLP


Intellectual Property Attorneys

<http://www.leasonellis.com>

Question 1

Inventor Leason filed a US application on March 19, 2012. The application was published September 11, 2013 and the application is abandoned September 28, 2013. On September 26, 2013, a divisional application is filed which leads to allowance of the application and issuance in September 26, 2015. The claims in the divisional application are fully supported by the parent application. The invention was in use in China in January 2010. Which of the following is true?

In use in China	Application Filed on	Published on	Divisional Application Filed on	First appln Abandoned on	Issued on
Jan 2010	3/19/12	9/11/13	9/26/13	9/28/13	9/28/15

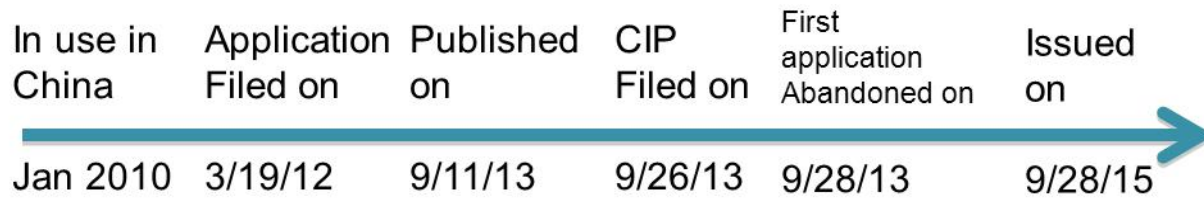


Answer is...

- a) The Leason patent is invalid because, under the new AIA, a foreign use is prior art.
- b) The Leason patent is valid and is judged under the old 35 USC §102, because the claims of the application are entitled to an effective filing date from the parent application filed prior to March 16, 2013.
- c) The Leason patent is judged under the old 35 USC §102 because a divisional application is automatically entitled to an effective filing date from the parent application filed prior to March 16, 2013.
- d) The Leason patent is judged under the new 35 USC §102 because the application was filed after March 15, 2013.
- e) The Leason patent is judged under the new 35 USC §102 because the application was published after March 15, 2013.

Question 2

Inventor Leason filed a US application on March 19, 2012. The application was published September 11, 2013 and the application is abandoned September 28, 2013. On September 26, 2013, a CIP is filed which leads to allowance of the application and issuance in September 26, 2015. The claims in the CIP are fully supported by the parent application. The invention was in use in China in January 2010. Which of the following is true?




Answer is...

- a) The Leason patent is invalid because, under the new AIA, a foreign use is prior art.
- b) The Leason patent is valid and is judged under the old 35 USC §102, because the claims of the application are entitled to an effective filing date from the parent application filed prior to March 16, 2013.
- c) The Leason patent is judged under the old 35 USC §102 because a CIP application is automatically entitled to an effective filing date from the parent application filed prior to March 16, 2013.
- d) The Leason patent is judged under the new 35 USC §102 because the application was filed after March 15, 2013.
- e) The Leason patent is judged under the new 35 USC §102 because the application was published after March 15, 2013.

Question 3

Inventor Leason filed a US application on March 19, 2012. The application was published September 11, 2013 and the application is abandoned September 28, 2013. On September 26, 2013, a CIP application is filed which leads to allowance of the application and issuance in September 26, 2015. The invention was in use in China in January 2010. A preliminary amendment was filed the same day adding new claims that are not supported by the parent application. What is the outcome?

In use in China	Application Filed on	Published on	CIP Application Filed on	Preliminary Amendment Filed on	First appln Abandoned on	Issued on
Jan 2010	3/19/12	9/11/13	9/26/13	9/26/13	9/28/13	9/28/15



Answer is...

- a) The Leason patent is invalid because, under the new AIA, a foreign use is prior art.
- b) The Leason patent is valid and is judged under the old 35 USC §102, because the claims of the application are entitled to an effective filing date from the parent application filed prior to March 16, 2013.
- c) The Leason patent is judged under the old 35 USC §102 because a CIP application is automatically entitled to an effective filing date from the parent application filed prior to March 16, 2013.
- d) The Leason patent is judged under the new 35 USC §102 because the application was filed after March 15, 2013.
- e) The Leason patent is judged under the new 35 USC §102 because the application was published after March 15, 2013.

Question 4

Inventor Leason filed a US application on March 19, 2012. The application was published September 11, 2013 and the application is abandoned September 28, 2013. On September 26, 2013, a **divisional application** is filed which leads to allowance of the application and issuance in September 26, 2015. The claims in the divisional application are fully supported by the parent application. The invention was in use in China in January 2010. A **preliminary amendment** was filed the next day having claims that are supported by the parent application. What is the outcome?

In use in China	Application Filed on	Published on	Divisional Application Filed on	Preliminary Amendment Filed on	First appln Abandoned on	Issued on
Jan 2010	3/19/12	9/11/13	9/26/13	9/27/13	9/28/13	9/28/15


Answer is...

- a) The Leason patent is invalid because, under the new AIA, a foreign use is prior art.
- b) The Leason patent is valid and is judged under the old 35 USC §102, because the claims of the application are entitled to an effective filing date from the parent application filed prior to March 16, 2013.
- c) The Leason patent is judged under the old 35 USC §102 because a divisional application is automatically entitled to an effective filing date from the parent application filed prior to March 16, 2013.
- d) The Leason patent is judged under the new 35 USC §102 because the application was filed after March 15, 2013.
- e) The Leason patent is judged under the new 35 USC §102 because the application was published after March 15, 2013.

Question 5

Inventor Leason filed a US application on March 19, 2012. The application was published September 11, 2013 and the application is abandoned September 28, 2013. On September 26, 2013, a divisional application is filed which leads to allowance of the application and issuance in September 26, 2015. The claims in the divisional application are fully supported by the parent application. The invention was offered for sale in the U.S. Which of the following is true?

Offer for sale in the U.S.	Application Filed on	Published on	Divisional Application Filed on	First appln Abandoned on	Issued on
Jan 2010	3/19/12	9/11/13	9/26/13	9/28/13	9/28/15



Answer is...

- a) The Leason patent is invalid because, under the new AIA, a foreign use is prior art.
- b) The Leason patent is valid and is judged under the old 35 USC §102, because the claims of the application are entitled to an effective filing date from the parent application filed prior to March 16, 2013.
- c) The Leason patent is invalid and is judged under the old 35 USC §102 because the divisional application is entitled to an effective filing date from the parent application filed prior to March 16, 2013.
- d) The Leason patent is judged under the new 35 USC §102 because the application was filed after March 15, 2013.
- e) The Leason patent is judged under the new 35 USC §102 because the application was published after March 15, 2013.

Question 6

Mr. Leason filed an application on March 18, 2013 claiming subject matter X. Mr. Leason's co-worker Mr. Ellis is not an inventor of the application but learned about Mr. Leason's invention and published an article in the Journal of Amazing World on subject matter X on April 18, 2012. Which of the following is true?



Answer is...

- a) The Leason application is under the new rule, 35 USC § 102(a)(1), the Ellis publication is prior art.
- b) The Leason application is under the old rule, 35 USC §102(a), the publication can be overcome because it is published after the invention of the subject matter X.
- c) The Leason application is under the new rule, 35 USC § 102(a)(1), the Ellis publication is not prior art because it falls under the exception 35 USC §102(b)(1)(A).
- d) The Leason application is under the new rule, 35 USC § 102(a)(1), the Ellis publication is not prior art because it falls under the exception 35 USC §102(b)(1)(B).
- e) The Ellis publication is prior art under the new rule, 35 USC § 102(a)(1), because it is publically available prior to the filing date of the Leason application.

Question 7

Mr. Leason filed an application on March 18, 2013 claiming subject matter X. Mr. Ellis is not an inventor of the application but has come up with the same invention **independently** from Mr. Leason and published the subject matter X in the Journal of Amazing World on April 18, 2012. Which of the following is true?



Answer is...

- a) The Leason application is under the new rule, 35 USC §102(a)(1), the Ellis publication is prior art.
- b) The Leason application is under the old rule, 35 USC §102(a), the publication can be overcome because it is published after the invention of the subject matter X.
- c) The Leason application is under the new rule, 35 USC §102(a)(1), the Ellis publication is not prior art because it falls under the exception 35 USC §102(b)(1)(A).
- d) The Leason application is under the new rule, 35 USC §102(a)(1), the Ellis publication is not prior art because it falls under the exception 35 USC §102(b)(1)(B).
- e) The Ellis publication is prior art under the new rule, 35 USC §102(a)(2), because it is publically available prior to the filing date of the Leason application.

Question 8

Mr. Leason **invented subject matter X on February 12, 2012** and **filed an application on March 12, 2013** claiming subject matter X. Mr. Leason's co-worker Mr. Ellis, is not an inventor of the application but learned about Mr. Leason's invention and published an article in the Journal of Amazing World on subject matter X on April 18, 2012. Which of the following is true?



Answer is...

- a) The Leason application is under the new rule, 35 USC §102(a)(1), the Ellis publication is prior art.
- b) The Leason application is under the old rule, 35 USC §102(a), the publication can be overcome because it is published after the invention of the subject matter X.
- c) The Leason application is under the new rule, 35 USC §102(a)(1), the Ellis publication is not prior art because it falls under the exception 35 USC §102(b)(1)(A).
- d) The Leason application is under the new rule, 35 USC §102(a)(1), the Ellis publication is not prior art because it falls under the exception 35 USC §102(b)(1)(B).
- e) The Ellis publication is prior art under the new rule, 35 USC §102(a)(1), because it is publically available prior to the filing date of the Leason application.

Question 9

Mr. Leason filed an application on March 18, 2013 claiming subject matter X. Mr. Leason's co-worker Mr. Ellis, is not an inventor of the application but has come up with the same invention **independently** from Mr. Leason and published an article in the Journal of Amazing World on subject matter X on April 18, 2012. Mr. Leason **published on April 1, 2012**. Is the Ellis publication prior art?



Answer is...

- a) The Leason application is under the new rule, 35 USC §102(a)(1), the Ellis publication is prior art.
- b) The Leason application is under the old rule, 35 USC §102(a), the publication can be overcome because it is published after the invention of the subject matter X.
- c) The Leason application is under the new rule, 35 USC §102(a)(1), the Ellis publication is not prior art because it falls under the exception 35 USC §102(b)(1)(A).
- d) The Leason application is under the new rule, 35 USC §102(a)(1), the Ellis publication is not prior art because it falls under the exception 35 USC §102(b)(1)(B).
- e) The Ellis publication is prior art under the new rule, 35 USC §102(a)(1), because it is publically available prior to the filing date of the Leason application.

Question 10

Mr. Leason filed an application on March 18, 2013 claiming subject matter X. Mr. Leason's co-worker Mr. Ellis, is not an inventor of the application but has come up with the same invention **independently** from Mr. Leason and published an article in the Journal of Amazing World on subject matter X on April 18, 2012. **Mr. Leason published on March 15, 2012.** Are the Leason and/or Ellis publications prior art?



Answer is...

- a) The Leason application is under the new rule, 35 USC §102(a)(1), the Ellis publication is prior art. Leason publication is prior art under 102(a)(1).
- b) The Leason application is under the old rule, 35 USC §102(a), the publication can be overcome because it is published after the invention of the subject matter X.
- c) The Leason application is under the new rule, 35 USC §102(a)(1), the Ellis publication is not prior art because it falls under the exception 35 USC §102(b)(1)(A). Leason publication is prior art under 102(a)(1).
- d) The Leason application is under the new rule, 35 USC §102(a)(1), the Ellis publication is not prior art because it falls under the exception 35 USC §102(b)(1)(B). Leason publication is prior art under 102(a)(1).
- e) The Ellis publication is prior art under the new rule, 35 USC §102(a)(1), because it is publicly available prior to the filing date of the Leason application. Leason publication is prior art under 102(a)(1).

Question 11

Mr. Leason filed a patent application on subject matter X on August 1, 2013, the application publishes on February 1, 2015. Mr. Ellis files a patent application claiming X on September 20, 2013. Mr. Leason obtained the information from Mr. Ellis. Is Mr. Leason's application publication prior art to Mr. Ellis' application? Which of the following is true?

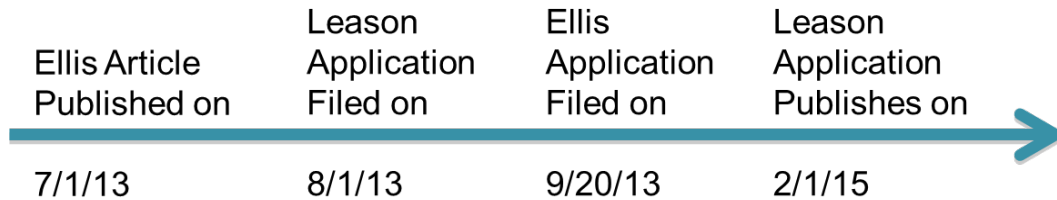


Answer is...

- a) Leason published application is not a prior art if Mr. Leason obtained the invention X from Mr. Ellis under exception 35 USC §102(b)(2)(B).
- b) Leason published application is a prior art because it is filed prior to Ellis' application under the new rule, 35 USC §102(a)(2) even if Mr. Leason obtained the invention X from Mr. Ellis.
- c) Leason published application is not a prior art if Mr. Leason obtained the invention X from Mr. Ellis under exception 35 USC §102(b)(2)(A).
- d) Leason published application is a prior art because it is filed prior to Ellis' application under the new rule, 35 USC §102(a)(2) even if Mr. Leason is a joint inventor in Mr. Ellis' application.
- e) Leason published application is a prior art because in a first to file system, Leason has the right to the patent.

Question 12

Mr. Leason filed a patent application on subject matter X on August 1, 2013, the application publishes on February 1, 2015. Mr. Ellis files a patent application claiming X on September 20, 2013. Mr. Ellis published subject matter X on July 1, 2013. Is Mr. Leason's application publication prior art to Mr. Ellis' application? Which of the following is true?

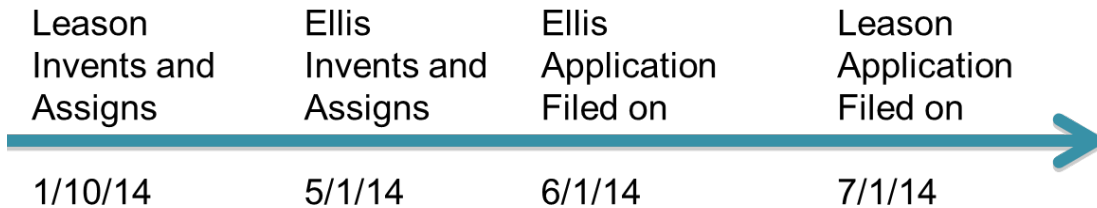


Answer is...

- a) Leason published application is not a prior art because Mr. Ellis published the invention X before Mr. Leason's effective filing under exception 35 USC §102(b)(2)(B).
- b) Leason published application is a prior art because it is filed prior to Ellis' application under the new rule, 35 USC § 102(a)(2) even if Mr. Leason obtained the invention X from Mr. Ellis.
- c) Leason published application is not a prior art if Mr. Leason obtained the invention X from Mr. Ellis under exception 35 USC §102(b)(1)(B).
- d) Leason published application is a prior art because it is filed prior to Ellis' application under the new rule, 35 USC §102(a)(2) even if Mr. Leason is a joint inventor in Mr. Ellis' application.
- e) Leason published application is a prior art because in a first to file system, Leason has the right to the patent.

Question 13

Mr. Leason invents subject matter X and assigns to Company (Leason Ellis) on January 10, 2014. Leason files patent application claiming X on July 1, 2014. Ellis invents X and assigns to Company (Leason Ellis) on May 1, 2014. Ellis files patent application disclosing X on June 1, 2014. Is Ellis' application prior art to Leason's application? Which of the following is true?



Answer is...

- a) Ellis application is prior art because in a first-to-file system, Ellis is the first to file the application disclosing X.
- b) Ellis application is not prior art because it is filed less than one year prior to Leason's application.
- c) Ellis application is not prior art only if Leason and Ellis are joint inventors.
- d) Ellis application is not prior art because of the exception for a commonly owned disclosure.
- e) Ellis application is prior art because Leason assigns to the company before Ellis assigns the invention to Company.

Question 14

Which of the following documents identify the inventor of a claimed invention?

Answer is...

- a) Inventor's oath or declaration
- b) Substitute statement
- c) Assignment
- d) Application data sheet
- e) All of the above.

Question 15

Leason Ellis is a small biotech company with an early stage biological candidate, Candidate X. Company Alpha filed an application on March 19, 2013, which describes a process that Leason Ellis is using to make Candidate X. Company Alpha's application was published on September 20, 2013. Leason Ellis has found seven prior art references, two of which support anticipation and five of which support obviousness of the process.

Leason Ellis is planning a new fundraising campaign to raise money from investors. Leason Ellis does not want to have Company Alpha's application deter investors by raising a potential risk of infringement, but has limited funds to challenge Company Alpha. What is the best method for Leason Ellis to challenge the validity of Company Alpha's invention?

Answer is...

- a) File one or two anticipating prior art references in preissuance submission
- b) File one to five obviousness prior art references in preissuance submission
- c) Fill a combination of some, but not all seven, prior art references to show anticipation and obviousness in preissuance submission
- d) Fill all seven prior art references in preissuance submission
- e) Wait for patent to issue and file ex parte reexamination petition
- f) Wait for patent to issue and file post grant review petition
- g) Wait for patent to issue and file inter partes review petition

Question 16

Leason Ellis is a small biotech company with a biological candidate, Candidate X, in clinical trials. Leason Ellis has published articles about Candidate X and presented information about Candidate X at scientific meetings. Limited information about the process for making Candidate X has been published.

Company Alpha filed an application on March 19, 2013, which describes a process that Leason Ellis is using to make Candidate X. Company Alpha's application was published on September 20, 2013, and a patent issued on July 2015. Leason Ellis has found five prior art references that were not cited during prosecution of Company Alpha's application, one of which supports anticipation and four of which support obviousness of the process.

It is six months since the process patent was issued to Company Alpha. Company Alpha has sent a cease and desist letter to Leason Ellis, but has not yet filed a patent infringement lawsuit against Leason Ellis. Leason Ellis believes that Company Alpha's process patent is invalid, but has limited funds to challenge the validity of Company Alpha's patent. What is the best method for Leason Ellis to challenge the validity of Company Alpha's invention?

Answer is...

- a) File ex parte reexamination petition
- b) File post grant review petition
- c) File inter partes review petition
- d) File declaratory judgment action in district court challenging validity
- e) File declaratory judgment action in district court challenging validity, then file post grant review petition
- f) File post grant review petition, then file declaratory judgment action challenging validity
- g) File declaratory judgment action in district court challenging validity, then file inter partes review petition
- h) File inter partes review petition, then file declaratory judgment action challenging validity

Question 17

Leason Ellis is a small biotech company with a biological candidate, Candidate X, in clinical trials. Leason Ellis has published articles about Candidate X and presented information about Candidate X at scientific meetings. Limited information about the process for making Candidate X has been published.

Company Alpha filed an application on March 19, 2013, which describes a process that Leason Ellis is using to make Candidate X. Company Alpha's application was published on September 20, 2013, and a patent issued on July 2015. Leason Ellis has found five prior art references that were not cited during prosecution of Company Alpha's application, one of which supports anticipation and four of which support obviousness of the process.

It is ten months since the process patent was issued to Company Alpha. Company Alpha has filed a patent infringement lawsuit against Leason Ellis in federal district court. Leason Ellis believes that Company Alpha's process patent is invalid, but has limited funds to defend the lawsuit and challenge the validity of Company Alpha's patent. What is the best strategy for Leason Ellis to challenge the validity of Company Alpha's invention?

Answer is...

- a) File ex parte reexamination petition and then seek a stay of the lawsuit
- b) File post grant review petition and then seek a stay of the lawsuit
- c) File inter partes review petition and then seek a stay of the lawsuit
- d) File counterclaim for declaratory judgment in district court challenging validity
- e) File counterclaim for declaratory judgment in district court challenging validity, then file inter partes review petition and seek a stay of the lawsuit
- f) File inter partes review petition, then file counterclaim for declaratory judgment in district court challenging validity and seek a stay of the lawsuit

Contact Information

Susie S. Cheng, Ph.D, Esq.

914-821-3077

Cheng@LeasonEllis.com

Elizabeth Barnhard, Esq.

914-821-3074

Barnhard@LeasonEllis.com

LEASON ELLIS LLP

Intellectual Property Attorneys

One Barker Avenue, Fifth Floor – White Plains, NY 10601

Main: (914) 288-0022

Fax: (914) 288-0023

Web: www.leasonellis.com