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America Invents Act Boot Camp – How to Apply the New Law

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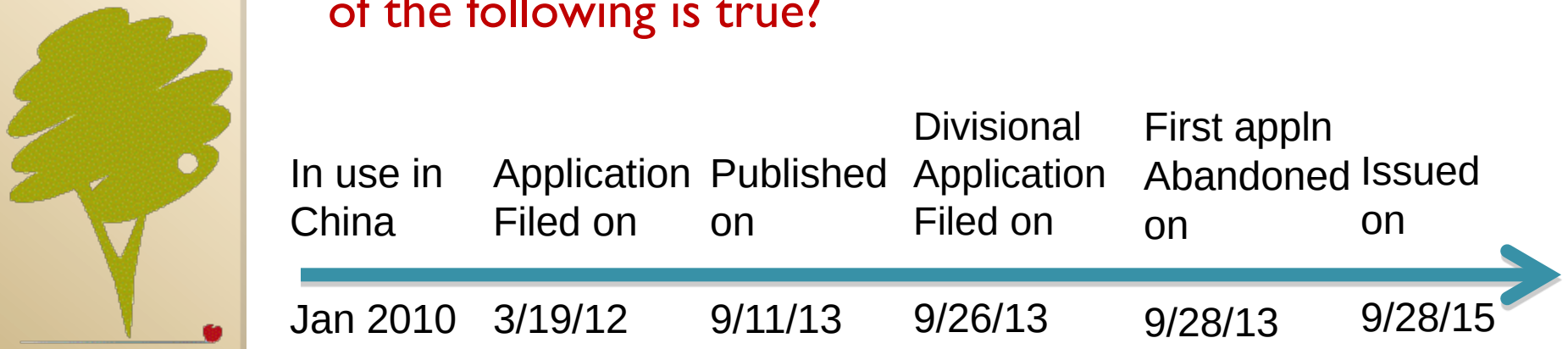
Question 1

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?



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.

Answer is

- Answer: B
- Applications that have claims that are entitled to an effective filing date prior to March 16, 2013, claiming priority under 35 USC §120 and is supported by a parent application filed prior to March 16, 2013 are judged under the old rule. Under the old rule, a use must be "in this country", i.e. in the USA, to be prior art. However, under the new rule, the use may be made anywhere in the world.

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?

In use in China	Application Filed on	Published on	CIP Filed on	First application 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 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.

Answer

- Answer: B. If the claims are supported by the parent application that was filed before March 15, 2013, it is under the old rule.

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.

35 U.S.C. 102(a)(1): Prior Public Disclosures as Prior Art

- 35 U.S.C. 102(a)(1) precludes a patent if a claimed invention was, before the effective filing date of the claimed invention:
  - patented;
  - described in a printed publication;
  - **in public use**;
  - **on sale**; or
  - **otherwise available to the public**

Answer

- Answer: A.
- 35 USC§102(a)(1), precludes a patent if a claimed invention was patented, described in a printed publication, or in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention. Effective filing date is the actual filing date or the earliest claimed priority application filing date. There is no geographical limitation, the use or sale may occur anywhere in the world. The sale activity must be public.

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.

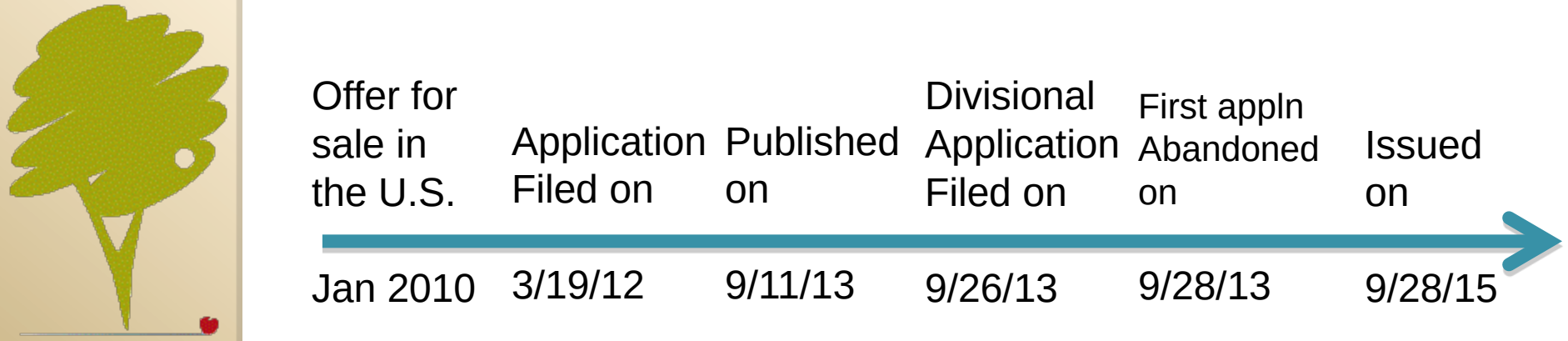
(E) The Leason patent is judged under the new 35 USC§102 because the application was published after March 15, 2013.

Answer

- Answer: 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.

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?



Answer is…

(A) The Leason patent is invalid because, under the new AIA, a domestic 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.

Answer

- Answer: C.
- The Leason patent is judged under the old 35 USC § 102 because the divisional application is entitled to an effective filing date from the patent application filed prior to March 16, 2013. The Leason patent is invalid due to the offer for sale in the U.S.

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 the filing date of the Leason application.

35 U.S.C. 102(a)(1): Prior Public Disclosures as Prior Art

- 35 U.S.C. 102(a)(1) precludes a patent if a claimed invention was, before the effective filing date of the claimed invention:
  - patented;
  - described in a printed publication;
  - **in public use**;
  - **on sale**; or
  - **otherwise available to the public**

35 U.S.C. 102(b)(1)(A) Exception: Grace Period Disclosure of Inventor's Work

First exception: A disclosure made one year or less before the effective filing date of the claimed invention shall not be prior art under 35 U.S.C. 102(a)(1) if:

the disclosure was made by:

- the inventor or joint inventor; or
- another who obtained the subject matter directly or indirectly from the inventor or joint inventor

Answer is

- Answer: C
- The application is filed after March 15, 2013 and is under the new rule, 35 USC § 102(a)(1). Mr. Ellis' publication is not a prior art because it falls under the exception, 35 USC § 102(b)(1)(A) where a grace period disclosure of the inventor's work is not prior art to the inventor. Mr. Ellis obtained the subject matter directly or indirectly from the inventor.

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.

Answer is

- Answer: A
- The Leason patent is judged under the new 35 USC§102 because Mr. Ellis come up with the same invention independently from Mr. Leason and no exception under 35 USC§102(b)(1)(A) is applicable.

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 the filing date of the Leason application.

Answer is

- Answer: B. Old rule 102(a) precludes a patent if the invention was printed in a publication in this or foreign country, before the invention by the applicant for patent.

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 the filing date of the Leason application.

35 U.S.C. 102(b)(1)(B) Exception: Grace Period Intervening Disclosure by Third Party

Second exception: A disclosure made one year or less before the effective filing date of the claimed invention shall not be prior art under 35 U.S.C. 102(a)(1) if:

the subject matter disclosed was, before such disclosure, publicly disclosed by:

- the inventor or joint inventor; or
- another who obtained the subject matter directly or indirectly from the inventor or joint inventor

Answer is

- Answer: D
- Mr. Ellis' publication is not prior art because of the exception under 102(b)(1)(B) where a disclosure of Leason's work shields Leason from the prior art effect of Ellis' publication. Mr. Leason's publication is not prior art to the Leason application because of the exception under 102(b)(1)(A) for a one year grace period disclosure by the inventor.

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. The Leason publication is prior art under 35 USC § 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). The Leason publication is prior art under 35 USC § 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). The Leason publication is prior art under 35 USC § 102(a)(1).

(E) The Ellis publication is prior art under the new rule, 35 USC § 102(a)(1), because it is publically available prior the filing date of the Leason application. The Leason publication is prior art under 35 USC § 102(a)(1).

Answer is

- Answer: D. Leason publication is prior art against the Leason Application under 35 USC § 102(a)(1). Leason publication is made more than one year before the effective filing date of the claimed Leason application. No exceptions applied. Ellis publication is inapplicable as prior art against Leason application because the Leason publication shields the prior art effect of the Ellis publication , 35 USC §102(b)(1)(B) applies.

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.

35 U.S.C. 102(a)(2): U.S. and PCT Patent Documents Are Prior Art as of the Date They Are "Effectively Filed"

35 U.S.C. 102(a)(2) precludes a patent if a claimed invention was described in a:

- U.S. Patent;
- U.S. Patent Application Publication; or
- PCT Application Publication designating the U.S.

that names another inventor and was **effectively filed** before the effective filing date of the claimed invention

35 U.S.C. 102(b)(2)(A) Exception: Disclosure Obtained from Inventor

First exception: A disclosure in an application or patent shall not be prior art under 35 U.S.C. 102(a)(2) if:

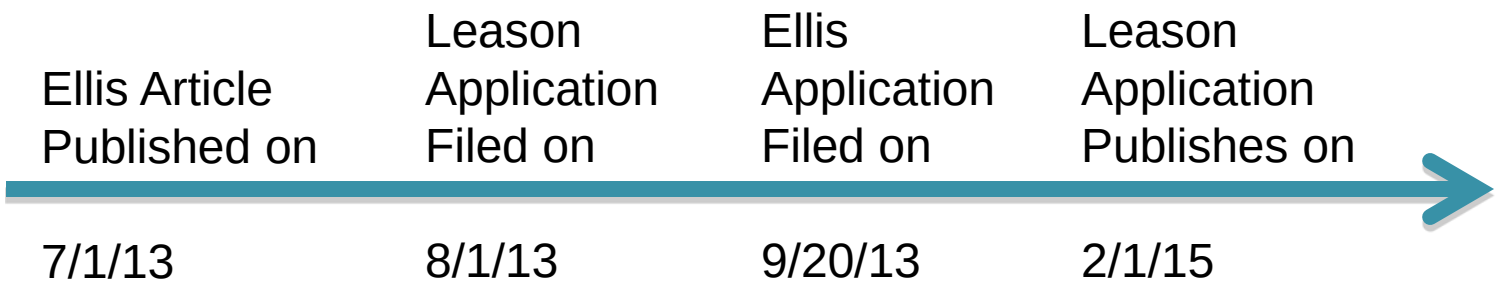
the disclosure was made by another who obtained the subject matter directly or indirectly from the inventor or joint inventor

Answer is

- Answer: C
- New rule 35 USC 102(a)(2) applies to the Ellis application. Under exception 35 USC §102(b)(2)(A), a disclosure of the inventor's work in a U.S. patent document or PCT publication by another is not prior art to the invention if the disclosure was made by another who obtained the subject matter directly or indirectly from the inventor or joint inventor. Thus, if Mr. Leason obtained the invention from Mr. Ellis or if Mr. Leason is a joint inventor in Mr. Ellis' application, exception 35 USC §102(b)(2)(A) applies and the Leason published application is not a prior art.

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 date 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.

35 U.S.C. 102(b)(2)(B) Exception: Intervening Disclosure by Third Party

Second exception: A disclosure in an application or patent shall not be prior art under 35 U.S.C. 102(a)(2) if:

the subject matter disclosed was, before such subject matter was effectively filed, publicly disclosed by:

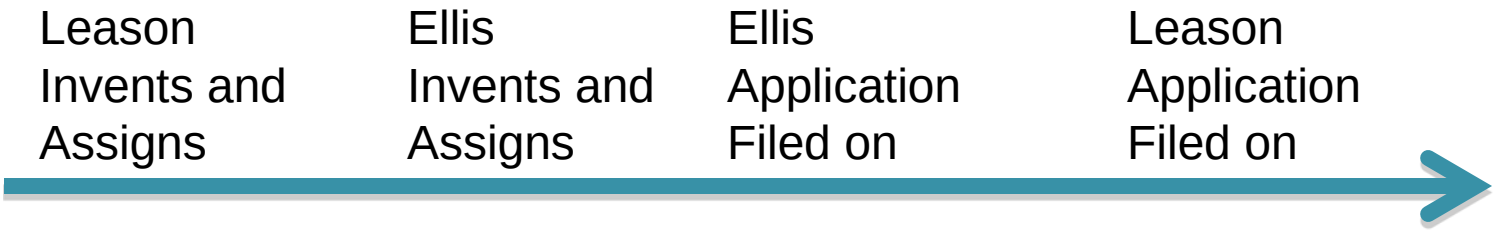
- the inventor or joint inventor; or
- another who obtained the subject matter directly or indirectly from the inventor or joint inventor

Answer is

- Answer: A
- New rule 35 USC 102(a)(2) applies to the Ellis application. Under exception 35 USC §102(b)(2)(B), a disclosure of the inventor's work shields the inventor from the prior art effect of a subsequent disclosure in a U.S. patent document or PCT publication. Mr. Leason's publication is not prior art under 35 USC 102(a)(2) if before the effective filing date of Ellis application, Ellis publicly disclosed the subject matter. This exception applies if the publication on July 1, 2013 is made by Mr. Ellis or a joint inventor with Mr. Ellis, or by another who obtained the subject matter directly or indirectly from Mr. Ellis or his joint inventor.

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 consider 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.

35 U.S.C. 102(b)(2)(C) Exception: Commonly Owned Disclosure

Third exception: A disclosure made in an application or patent shall not be prior art under 35 U.S.C. 102(a)(2) if:

> the subject matter and the claimed invention were **commonly owned or subject to an obligation of assignment** to the same person not later than the effective filing date of the claimed invention

Resembles pre-AIA 35 U.S.C. 103(c), but applies to both novelty and obviousness, whereas pre-AIA disqualified art only for obviousness

Answer is

- Answer: D
- 35 U.S.C.102(a)(2) precludes a patent if a claimed invention was described in a U.S. Patent , application or publication or PCT application publication designating the U.S. that names another inventor and was effectively filed before the effective filing date of the claimed invention. Under exception 35 USC §102(b)(2)(C), Ellis application is not prior art to Leason if it was commonly owned with the claimed invention not later than the inventor's effective filing date. If Leason assigns the invention to company after Leason's effective filing date or if Ellis assigns his invention after Leason's effective filing date, the Ellis application would be a prior art.

Question 14

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

(A) Inventor's oath or declaration

(B) Substitute statement

(C) Assignment

(D) Application data sheet

(E) All of the above

Answer is

- Answer: E
- Under 35 USC§115, each inventor must execute an oath or declaration, substitute statement with respect to the inventor or assignment that contains the statements required for an oath or declaration by the inventor. ADS provides the names of all inventors but is not the only document that identify the inventor of a claimed invention. Inventor must state in oath or declaration that application was made or was authorized to be made by the person executing the oath or declaration; and person executing the oath or declaration believes he is the original inventor or an original joint inventor of a claimed invention in the application. Non-inventor may file a substitute statement if the inventor is deceased, incapacitated, cannot be found or refuses to sign an oath or declaration.

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 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) File a combination of some, but not all seven, prior art references to show anticipation and obviousness in preissuance submission

(D) File 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

Answer is

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- If preissuance submission (A)(B) or (C) chosen:
  - Advantages: low cost method to submit prior art for examiner to review during prosecution of Company Alpha's process application and there is no estoppel
  - Disadvantages: no arguments on patentability are permitted; if Company Alpha obtains patent over prior art submitted by Leason Ellis, presumption of validity must be overcome in later challenge based on same prior art
- If ex parte reexamination (D) chosen:
  - Advantages: low cost to submit prior art for reexamination of Company Alpha's patent compared to court litigation and there is no estoppel
  - Disadvantages: no participation permitted by Leason Ellis in reexamination proceeding and decision on petition may take years
- If post grant review or inter partes review (E) or (F) chosen:
  - Advantages: lower cost compared to court litigation and USPTO required to complete proceeding and issue decision within one year
  - Disadvantage: Leason Ellis must be willing to give up future validity challenges against Company Alpha's patent because of expansive estoppel

Question 16

- Leason Ellis is a small biotech company with a biological candidate, Candidate X, in clinical trials. Leason Ellis has published articles 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

Answer is

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- If ex parte reexamination (A) chosen:
  - Advantages: low cost to submit prior art for reexamination of Company Alpha's patent compared to court litigation and there is no estoppel
  - Disadvantages: no participation permitted by Leason Ellis in reexamination proceeding and decision on reexamination may take years; Company Alpha could file a lawsuit and district court may not stay lawsuit pending reexamination
- If post grant review or inter partes review (B) or (C) chosen:
  - Advantages: lower costs compared to court litigation; USPTO required to complete proceeding and issue decision within one year; if Company Alpha files a lawsuit after petition filed at USPTO, district court likely to stay lawsuit pending post grant review or inter partes review
    - Note – have to wait until 9 months after Company Alpha's patent issues before filing inter partes review
  - Disadvantage: Leason Ellis must be willing to give up future validity challenges against Company Alpha's patent because of expansive estoppel
- If post grant or inter partes review petition/declaratory action (F) or (H) chosen:
  - Advantages: Leason Ellis will receive post grant or inter partes review decision within one year; Leason Ellis will select venue of district court; district court likely to stay lawsuit pending post grant or inter partes review ; settlement available for the inter partes review (not the post grant review) and lawsuit
    - Note – have to wait until 9 months after Company Alpha's patent issues before filing inter partes review
  - Disadvantage: Leason Ellis must be willing to give up future validity challenges against Company Alpha's patent because of expansive estoppel
- Answers (E) and (G) are not options – cannot file a post grant or inter partes review petition after filing a civil 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, two of which support anticipation and three 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, then seek a stay of the lawsuit

(B) File post grant review petition, then seek a stay of the lawsuit

(C) File inter partes review petition, then seek a stay of the lawsuit

(D) File counterclaim for declaratory judgment in district court challenging validity

(E) File counterclaim for declaratory judgment action 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

Answer is

LEASON ELLIS
INTELLECTUAL PROPERTY ATTORNEYS

- If ex parte reexamination (A) chosen:
  - No participation permitted by Leason Ellis in reexamination proceeding and decision on reexamination may take years, but no estoppel; Company Alpha could file a lawsuit and district court may not stay lawsuit pending reexamination
- If inter partes review (C) chosen:
  - Advantages: USPTO required to complete proceeding and issue decision within one year; district court likely to stay lawsuit pending post grant review or inter partes review; settlement available for the inter partes review and lawsuit
  - Disadvantage: Leason Ellis must be willing to give up future validity challenges against Company Alpha's patent because of expansive estoppel
- If inter partes review petition/declaratory action (F) chosen:
  - Advantages: Leason Ellis will receive inter partes review decision within one year; Leason Ellis will select venue of district court; district court likely to stay lawsuit pending inter partes review ; settlement available for the inter partes review and lawsuit
  - Disadvantage: Leason Ellis must be willing to give up future validity challenges against Company Alpha's patent because of expansive estoppel
- Answer (B) is not an option – cannot file a post grant review petition because Company Alpha's patent issued more than nine months ago
- Answer (E) is not an option – cannot file an inter partes review petition after filing a civil action challenging validity

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Supplemental Materials

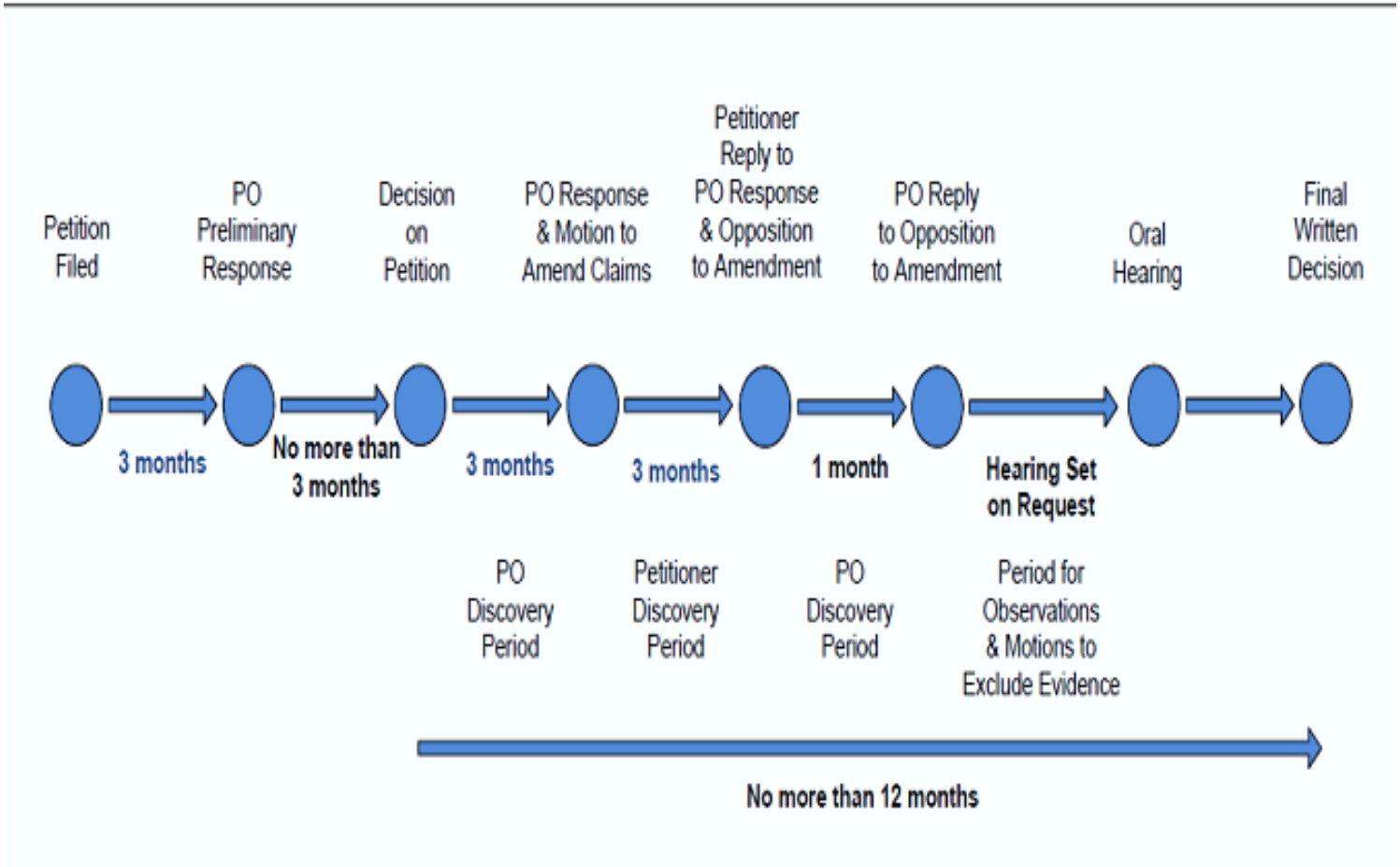
FIRST-INVENTOR-TO-FILE LAW SUMMARY

Prior Art 35 U.S.C. 102(a) (Basis for Rejection)	Exceptions 35 U.S.C. 102(b) (Not Basis for Rejection)	
102(a)(1) Precludes patent if the invention was already: Patented, described in printed publication, in public use, on sale, or otherwise publicly available. Prior art as of the date they are publicly available.	**102(b)(1)**	**(A)** Disclosure made one year or less (grace period) by Inventor or Obtained from Inventor, if disclosure was made by the [joint] inventor, or another who obtained the subject matter [in]directly from [joint] inventor.
		(B) Intervening disclosure made one year or less (grace period) by Third Party before the effective filing date of the claimed invention-if the subject matter disclosed was, before such disclosure, publically disclosed by the [joint] inventor, or another obtained the subject matter [in]directly from [joint] inventor. A disclosure of the inventor's work shields the inventor from the prior art effect of a third party's subsequent grace period disclosure.
102(a)(2) Precludes patent if the invention was described in a: US Patent, US Patent Application, or PCT Application designating the US that names another and was effectively filed before the effective filing date of the claimed invention	**102(b)(2)**	**(A)** Disclosure Obtained from Inventor -if disclosure was made by another who obtained the subject matter[in]directly from the [joint] inventor.
		(B) Intervening Disclosure by Third Party -if the subject matter disclosed was, before such subject matter was effectively filed, publicly disclosed by [joint] inventor or another obtained [in]directly from [joint] inventor. A disclosure of the inventor's work shields the inventor from the prior art effect of a subsequent disclosure in a U.S. patent document or PCT publication.
		(C) Subject matter and claimed invention were commonly owned or subject to an obligation of assignment to the same person not later than the effective filing date of the claimed invention.

COMPARISION OF METHODS TO CHALLENGE VALIDITY AT USPTO

Preissuance Submissions	Ex Parte Reexamination	Post Grant Review	Inter Partes Review
When to File?			
Must submit prior to the earlier of either: 1. date a notice of allowance is given or mailed; or 2. later of: 6 months after date of publication of application by USPTO, or date of first rejection of any claim	Any time during period of enforceability of the patent: From grant of patent to expiration of patent plus six years under statute of limitations for bringing an infringement action	Within 9 months of either: Grant of patent, or Grant of broadening reissue patent	After later of: 9 months after patent issues (for 1st to file patent) Termination of any Post Grant Review Grant of patent (for pre-AIA first to invent patent)
What Evidence May be Submitted?			
Patents, published patent applications and printed publications	Patents and printed publications Anticipation and obviousness	Any evidence All invalidity grounds except best mode	Patents and printed publications Anticipation and obviousness
Estoppel Effects?			
No estoppel	No estoppel	Final written decision triggers estoppel as to subsequent Office proceedings and civil actions on any ground the petitioner raised or reasonably could have raised in the Post Grant Review	Final written decision triggers estoppel as to subsequent Office proceedings and civil actions on any ground the petitioner raised or reasonably could have raised in the Inter Partes Review
Other Limitations?			
Provide concise description of how publication is of potential relevance to examination of application No arguments on patentability of claims permitted	Requester not permitted to respond to any filings submitted after request Parties cannot settle	Only available for first to file patents Not available after filing civil action challenging validity Parties cannot settle	Must file within one year after being served with an infringement complaint Not available after filing civil action challenging validity Note: parties may jointly move to settle inter partes review

USPTO INTER PARTES REVIEW AND POST-GRANT REVIEW TRIAL PROCEEDINGS TIMELINE



PO = Patent Owner
Source: USPTO, 77 Fed. Reg. 48756, 48757