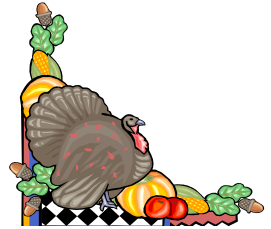




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*Happy Thanksgiving!*



## “Tip of the Month”

### The America Invents Act – Several Major Changes Now in Effect

The U.S. patent system has recently undergone the most significant reform since its formation. Many provisions of the Leahy-Smith America Invents Act of 2011 went into effect on September 16, 2012. These provisions streamlined the patent application process and introduced new procedures to ensure patent quality. Some of the new rules include (1) three new administrative trial provisions, (2) the supplemental examination provision, (3) the inventor’s oath, and (4) the citation of prior art.

The new administrative trial provisions include inter partes (multiple party) review, post-grant review and the transitional program for covered business method patents. These administrative trial provisions offer third parties timely, cost-effective alternatives to US District Court litigation to challenge the validity of an issued patent. The provisions, however, are not without significant costs of their own.

The supplemental examination provision allows applicants to submit additional information relevant to the patentability of an issued patent to the US Patent Office. This new procedure may protect the patent from an inequitable conduct charge when an applicant discovers a relevant prior art reference in its files after a patent has issued.

The inventor’s oath and declaration provision has been drastically changed. For the first time, an assignee may file a patent application. The inventor(s) are still required to file an oath and declaration, but with reduced legal effect. For instance, the inventor no longer must declare that he/she is the first inventor of the invention, a change that reflects the upcoming switch to a first-to-file system. The inventor(s) also are not required to state that they have reviewed and understand the contents of the application, including the claims.

The citation of prior art and written statements provision enables the US Patent Office to treat the claims in a patent consistent with how a patent owner represents its claims to the courts or in other Office proceedings. This will provide consistency in claim scope between arguments put forth by the applicant/patent owner in the new administrative trials and in infringement litigation.

The remaining provisions of the America Invents Act will go into effect on March 16, 2013. Most notably, the key provision that shifts the current first-to-invent system to a first-inventor-to-file system, which will harmonize the US system with most industrialized nations. For applications filed on or after that date, an applicant will no longer be able to assert a date of invention that is prior to the date of a reference in order to eliminate that reference from being considered as prior art against the applicant’s invention.

If you need help understanding the new patent procedures and how they will affect your company's patent rights, the patent attorneys at Mesmer & Deleault are here to help. For more information, please do not hesitate to call our patent attorneys at 603-668-1971 or contact us by email at *mailbox @ biz-patlaw.com*.

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