New Developments in the US Patent System
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Desiderata
- Patent Office Fees
- Studies and Reports
- Human subject matter
- Tax Patents
- SIRs Repeal
- Minor Venue Change
- Biotechnology Obviousness
Current Regime

- Priority
  - First to Invent
  - Conception
  - Reduction to Practice
  - Diligence
- Interference
  - Claimed Invention
  - Geographic Limitations

Current Regime

- Novelty
  - Prior Art
  - Geographic Limitations
  - Category Limitations
- Statutory Bar
  - One Year Grace Period
  - Third Party Trigger
  - Party–specific Bar
First Inventor to File

- Effective Filing Date
  - Actual filing date
  - Priority date
- Unless Publicly Available
- One Year Grace Period
  - Inventor disclosure
  - Derivation
  - Secret prior art debate
- First Inventor to Disclose

Prior Art

- Categories Merged
  - Known or used by others abolished
  - Section 102(g) gone
- International Standard
  - Public Use
  - On Sale
- “Otherwise Available to the Public”
  - Modifies “public use” and “on sale?”
**Derivation**

- **Civil Suit**
  - Within one year of issue

- **PTO Proceedings**
  - Within one year of claim publication
  - Correction
  - Cancellation

- **Joint Inventorship**
  - Common ownership or assignment

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**Post-Grant Review**

- Third Party Review
- Any Invalidity Grounds
- Within 9 Months of Issue
- Preponderence
- Novel or Unsettled Question
- Barred or Stayed by Civil Action
Inter Partes Review

- Novelty or Non-obviousness Only
- Patents and Printed Publications
- Nine Months After Issue
- Termination of Post-Grant Review
- Reasonable Likelihood of Prevailing
- Barred or Stayed by Court Action

Best Mode

- Retained in Statute
  - Disclosure required
  - PTO examination
- Eliminated in Enforcement
  - Invalidity
  - Unenforceability
  - Cancellation
- Attorney Duties?
  - Conflicts with client
Thank You
Questions Welcome