



SHIMOKAJI & ASSOCIATES, P.C.

Intellectual Property Lawyers
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NEWSLETTER

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We specialize in the litigation and registration of patent, trademark, and copyright matters. The clients we serve range from start-ups to Fortune 500 companies, government entities, and universities. Though located in the US, our expertise and representation has an emphasis in Asia.

— LATEST NEWS & EVENTS —

New AIA Third Party Preissuance Submissions

Starting September 16, third parties can submit for another's application prior art of patents, patent publications, and printed publications before the earlier of a notice of allowance or six months after publication.

More information can be obtained at info@shimokaji.com



New USPTO Post Grant Proceedings to Become Effective September 16, 2012

As part of the America Invents Act ("AIA"), various post grant proceedings will be effective next month in September. Included are inter partes review proceeding, post-grant review proceeding, and transitional post-grant review proceeding for covered business method patents.

Inter Partes Review

This applies to patents issued before, on, or after September 16, 2012. Patentability can only be challenged on a ground under Sections 102 (novelty) or 103 (obviousness). The only prior art can be patents or printed publications. A third party who is not the patent owner can file a petition for review after the later of 1) nine months after the patent grant or 2) completion of post grant review if instituted. The petitioner must show a reasonable likelihood that it would prevail on at least one claim for a proceeding to be instituted. A final determination is to be issued within one year of institution.

Post Grant Review

This applies to patents issuing from the AIA first-inventor-to-file provisions. Patentability can be challenged on bases broader than inter partes review and include those grounds under Section 282(b)(2),(3) (non-patentable subject matter, novelty, obviousness, written description). A petition must be filed within nine months of the patent grant. The petitioner must show that it is more likely than not that at least one claim is unpatentable. If a proceeding is instituted, it must be concluded within one year.

Business Method Patent Review

This is similar to post grant review and applies to patents issuing from the AIA first-inventor-to-file provisions. The patent must claim a method or apparatus for performing data processing or other operations for a financial product or service. The petitioner must have been sued for infringement or charged with infringement.

PRACTICE POINT:

First consider post grant review for its broader applicability.

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