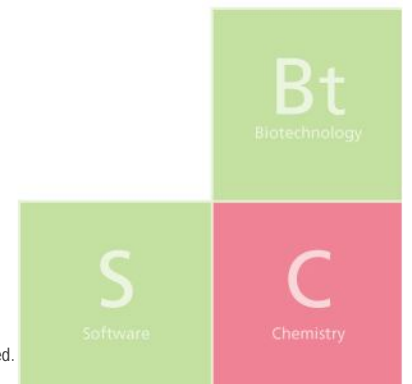


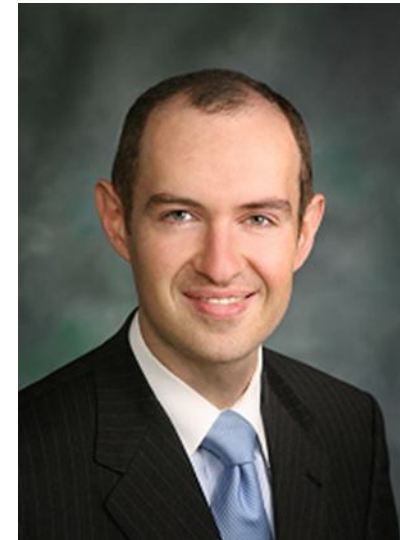
AIA Highlights for Startups

A Practitioner's Perspective
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Who Is This Talk For?

- Changes from the America Invents Act
- Targeted to small businesses
 - Primarily university based startups
- New company, new technology
 - No deep pockets
 - Skipping post grant (sorry biotech)
- Point you in the right direction, not providing legal advice
 - Paraphrased for clarity

What Does This Talk Cover?

- First to file
 - Bayh-Dole Changes
- Universities and the Expanded Prior User Defense
- Oaths and Assignments
- 3rd Party Pre-Issuance Submissions
- Micro-Entity Discount
- Priority Examination
 - Other ways to prioritize your application
- Pro Bono Program

First to File

- You have to decide whether to pursue a patent much sooner
- Can use provisional patent applications to hedge your bets
 - Presently, \$125 for a small entity
 - Gives you a year to decide
 - Can file a series of provisionals

Bayh Dole Act Issues

- Since 1980, funding recipients (e.g., startups and universities) can own what they invent during research
 - The Government gets a license
 - The recipient has to try to commercialize the invention
- A non-profit “government-owned-contractor-operator facility” can pay fewer royalties to the government – 35 USC 202(c)(7)(E)
- Reporting dates are harmonized with first to file

Universities and Prior Users

- This is a long trail of exceptions ...
- Prior to the AIA, a “prior user” defense to patent infringement only existed against certain business method patents
- AIA expands this defense to be available against processes or things used in processes
- Unless the invention, when made, was owned or subject to assignment to, a university or tech transfer office
 - Unless this could not be funded by the government

Oaths and Assignments I

- Prior to the AIA, inventors were required to sign a lot of documents to file a patent application
- A person to whom the inventor has assigned or is under an obligation to assign the invention may make an application for patent. A person who otherwise shows sufficient proprietary interest in the matter may make an application for patent on behalf of and as agent for the inventor on proof of the pertinent facts and a showing that such action is appropriate to preserve the rights of the parties. If the Director grants a patent on an application filed under this section by a person other than the inventor, the patent shall be granted to the real party in interest and upon such notice to the inventor as the Director considers to be sufficient.

Oaths and Assignments II

- Can use a “substitute statement” instead of an oath where the inventor(s):
 - is deceased;
 - is under legal incapacity;
 - cannot be found or reached after diligent effort; or
 - is under an obligation to assign the invention but has refused to make the oath or declaration required under subsection (a).
 - If they ask for more money, are they in breach of your assignment document?

3rd Party Pre-Issuance Submissions

- Prior to the AIA, very limited and rarely used
- Much longer window to submit
- Can state the relevance of the references
- Can submit more than once
 - Please be nice to the Examiner

Micro-Entity Discount

- Often 75% discount
- Institutes of higher education are automatic
- Or
 - No more than 4 previous U.S. non-provisional patent applications
 - Gross income not exceeding 3x the median income
- “has not assigned, granted, or conveyed, and is not under an obligation by contract or law to assign, grant, or convey, a license or other ownership interest in the application concerned to” a non-micro entity

Priority Examination

- \$2400 for a small entity
- No need for support documents
- As of January 3, 2012, 1,694 priority examination petitions have been filed

- Other options:

http://www.uspto.gov/patents/process/file/accelerated/comp_chart_dom_accel.pdf

- Accelerated Examination

- The prosecution is accelerated too
 - Need a support document

- Age or Health

Pro Bono Program

- First one is in Minnesota, other regions expected
- Other opportunities
 - Law schools
 - Law firms
- There are usually income cut-offs

Additional Resources

- USPTO resources
 - Inventor Assistance Center
<http://www.uspto.gov/inventors/iac/index.jsp>
 - IP Assessment tool
<http://www.uspto.gov/inventors/assessment/index.html>
 - IP Training
<http://www.uspto.gov/ip/events/index.jsp>
- Future Webinars
http://center.ncet2.org/index.php?option=com_content&view=article&id=448&Itemid=88