

The Innovation Race: What Scientists Should Know About the New Patent Laws

By Jennifer Hanzlicek

There are a growing number of issued patents in the United States, with over 250,000 patents granted in 2012 and more than 275,000 granted in 2013. In today's business culture, determining whether to file a patent application should be part of the research and development process. However, with all of the recent changes in patent law, it may be difficult for scientists to navigate through the new rules and prepare strategies for protecting their intellectual property. The Leahy-Smith America Invents Act, also known as the AIA, was enacted into law on Sept. 16, 2011. The AIA provides a first-inventor-to-file system in the U.S. for patent applications filed after March 16, 2013, negating any earlier claims to priority, such as first to invent.

Under the first-inventor-to-file system, the filing date would determine who had priority for two independent inventors having the same invention. The first individual to file a patent at the U.S. Patent and Trademark office would receive priority, even if the first-inventor-to-file actually invented later than the other inventor. The recently implemented first-inventor-to-file system is more consistent with the intellectual property law around the world, but now creates a push in the scientific community to file patent applications as soon as possible.

In order to file first, scientists must be prepared to provide all of the information needed for a patent application. An alternative to filing a traditional (non-provisional) application is to file a provisional patent application. Provisional applications are not examined, but will provide a priority (first filing) date for an invention and allow scientists to continue to experiment and develop their innovation for an extra year. Because provisional applications are not publicly disclosed, foreign applications may also be filed within one year. However, once a provisional application is filed, the corresponding non-provisional application needs to be filed within one year, or the application will be

abandoned. Typically, preparing and filing a provisional application costs less than a non-provisional application because they have fewer application requirements than non-provisional applications. Provisional applications only require a written specification sufficiently detailing the invention, and a drawing (if applicable). No claims are required for provisional applications, but a claim or multiple claims may be included. By filing a provisional application, an invention can also claim "patent pending" status during the 12 month pendency period of the provisional application. Although a provisional application can be a valuable method for obtaining priority, it must provide a sufficient description of the invention in order to secure the earlier filing date. In other words, the subject matter and detailed description provided in the non-provisional application must also be disclosed in the provisional application. Therefore, scientists should describe as much of their invention as possible.

Under the AIA, there are also several key provisions for scientists to observe. Some include prior art definition changes, laboratory notebook documentation, and competitive challenges. First, the AIA simplifies the requirements for prior art. The current AIA definition of prior art under 35 U.S.C. § 102(a)(1) looks at whether the claimed invention was "otherwise available to the public before the effective filing date." Prior art may now include both printed and non-printed disclosures, including oral disclosures, made available to the public anywhere in the world. This change may have implications for trade show exhibits, technical papers, scientific presentations made anywhere in the world, Internet videos, and material found on websites. Second, records of any experimentation in a laboratory notebook should still be maintained. Under the old patent rules, you could provide laboratory notebooks to prove you were the first-to-invent even if you did not



Since 2010, The University of Akron has inducted over 70 members into the National Academy of Inventors.

Nearly 400 issued patents have been assigned to The University of Akron, with several hundred additional inventions patent pending.

file first. With the change to a first-inventor-to-file system, the need to keep detailed accounts of experiments may seem irrelevant. However, continued recordkeeping may be essential for providing substantial evidence for derivation proceedings (derivation proceedings may arise when a petitioner claims an inventor named in an earlier application derived the claimed invention from the petitioner). Still, keeping a laboratory notebook may also be important in documentation for quality systems. Third, opportunities may exist to oppose the patents or patent applications of any competitors. You can submit prior art in a preissuance submission for a competitor's application after its publication, or request a review within nine months after their patent has issued.

Determining how to protect inventions is an integral part of the research process. Under the AIA, scientists should understand how changes may impact their research and diligently guard their intellectual property. ■



Jennifer works as an intellectual property attorney, helping individuals and companies bring their inventions to market through drafting and prosecuting patent and trademark applications. Prior to joining the law firm of Brouse McDowell, Jennifer worked as a chemist for a major international commercial and retail coatings manufacturer. She is a member of the board of trustees for Greenleaf Family Center and serves as the treasurer for the Southeast Mothers of Twins Club. She received a Juris Doctor from Cleveland-Marshall College of Law and an MBA from Cleveland State University in 2006. She received her Master of Science in Polymer Science from UA (go Zips!) in 2004 and completed her undergraduate degree, a Combined Science Bachelor of Science in Chemistry and Biology, at Youngstown State in 1994. Jennifer enjoys golfing, running and traveling. She and her husband and their twins (son and daughter, age 9) reside in Hudson, Ohio. Jennifer can be reached at jhanzlicek@brouse.com or 330-535-5711. ■