

The Impact of Leahy-Smith AIA on Scientific Research and Product Development - A Primer from a Scientist to a Scientist

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The Leahy–Smith America Invents Act (AIA) is a US federal statute that was signed into law by President Barack Obama on September 16, 2011 and fully implemented on March 16, 2013. The law represents the most significant change to the U.S. patent system since 1952. It is undoubtedly that the US is the biggest biotech/pharma market in the world and the AIA impact was felt globally. As a consequent, AIA is affecting the way how knowledge generation, innovation management, IP protection and technology commercialization works.

Some, but not all, of the key provisions of the AIA and its impact will be discussed in this presentation: (1) transitioning the first-to-invent to a first-inventor-to-file system; (2) enhanced grace period for inventors to safeguard patent rights against disclosures made by inventors made before the effective filing date, which allows inventors to engage in crucial negotiations with potential buyers or investors without fear of losing their right to a patent; (3) consistent with international norms, the definition of prior art now includes non-printed disclosures, including oral disclosures, made available to the public anywhere in the world; (4) providing prior art effect to US patent applications as of their foreign priority dates; (5) eliminating the requirement for inventors to set forth the best mode to carry out the invention as a defense in infringement actions or in post grant review.

The intended goals of the AIA is to encourage innovation and job creation, improve patent quality and reduce backlog, provide greater clarity around patent rights, less costly, time-limited administrative alternatives to litigation. As such, the AIA drastically changes the patent application procedure, prosecution and examination procedure, post-grant review procedure as well as future patent infringement litigation procedure. As a scientist heavily involved in the process of generating new knowledge/technology, protection of the invention, and doing business related to the biggest market in the world, you should aware of all the rules affecting your invention.