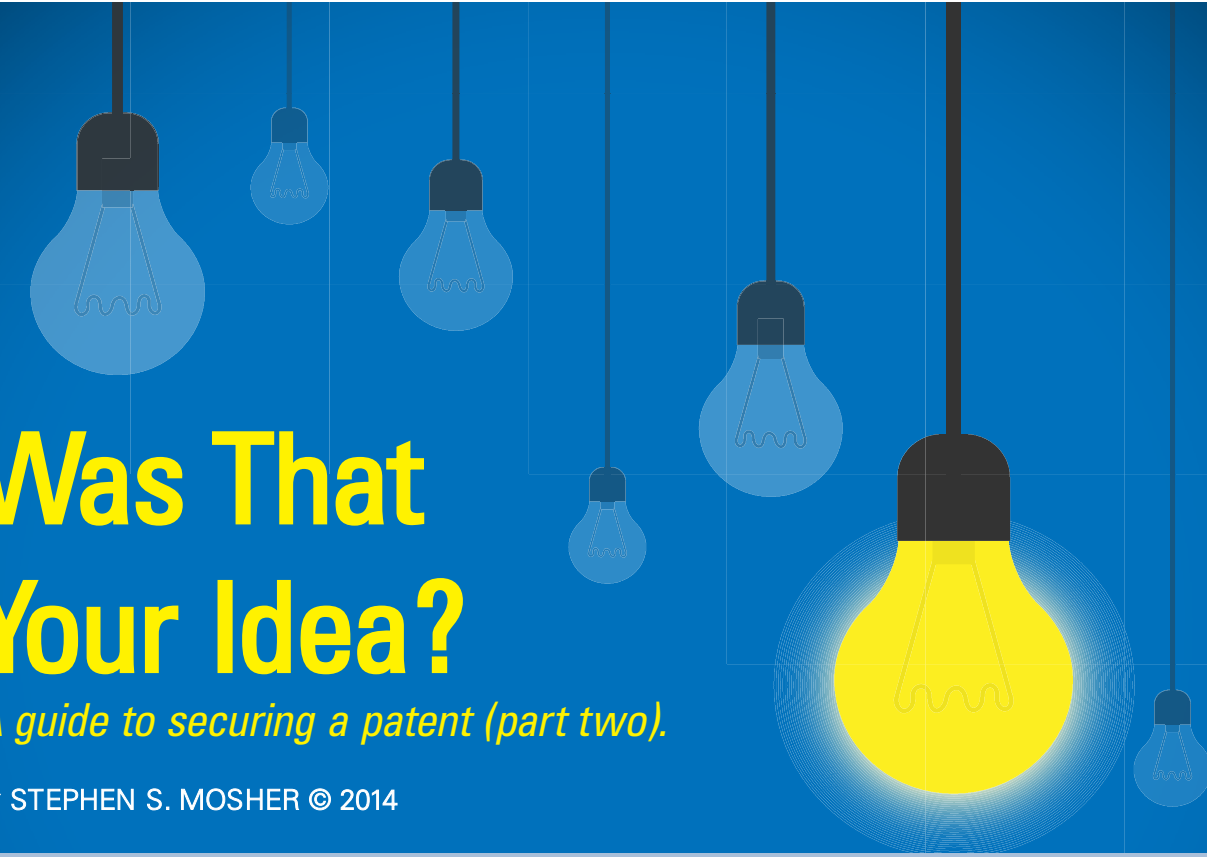




Was That Your Idea?

A guide to securing a patent (part two).

BY STEPHEN S. MOSHER © 2014

The long-anticipated America Invents Act made significant and comprehensive changes to the patent statute of the United States. The provisions of the act became fully effective March 16, 2013. This article will highlight some of the changes of most importance to inventors and their patent attorneys. *Disclaimer: The following paragraphs are not to be construed as legal advice or actual statements of the law. This discussion should be taken as an introduction to the statute. Specific questions should be referred to a patent attorney for consultation.*

THE FIRST-TO-FILE SYSTEM

A major provision of the AIA is to change the U.S. patent system from a “first-to-invent” system to a “first-inventor-to-file” system. This change harmonizes our country’s patent system with the rest of the developed world.

The first-inventor-to-file system presumes that the first person to file a patent application has the prior

claim to that invention. Under the old first-to-invent system, the presumption favored the first inventor who could demonstrate that he or she was the first person to create the invention. First-to-file and first-to-invent are substantially different concepts, which greatly affect the type of prior art that applies during the patent application examination.

PRIOR ART UNDER THE NEW SYSTEM

Under the new first-inventor-to-file system, effective prior art includes most kinds of prior art available to the public anywhere in the world, in any form, before the filing date of the applicant’s patent application.

One important conclusion drawn from this change is that inventors are strongly advised to (a) avoid disclosing

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Please consult an attorney regarding specific legal questions.

their invention to others before their application is filed, and (b) file a provisional patent application as soon as the concept is clearly defined and at least one embodiment of the concept is visualized so that it can be reduced to a sketch. A provisional patent application is quick and relatively inexpensive to file and establishes an original filing date for the invention. The applicant then has one year to submit a complete non-provisional patent application.

SUBJECT MATTER

Several new provisions in the AIA affect the kind of subject matter for which a patent may be obtained. In one provision, inventions for “any strategy for reducing, avoiding, or deferring tax liability, whether known or unknown at the time of the invention or application for patent, shall be deemed insufficient to differentiate a claimed invention from the prior art,” and are therefore prohibited.¹ In general, however, if a method applies an idea or algorithm in a specific application, it may be eligible for patenting.

To clarify these terms briefly, based on current case law, one may begin by considering whether a business method is merely a sequence of steps of a mental process—such as a list of instructions for performing a service. Such a technique is ephemeral—it is an abstraction that represents only the service. In contrast, if a method or process is performed by a particular machine or apparatus, such as a computer, or the method or process transforms a particular article or thing to provide a tangible result, the method or process may be patent-eligible. Even data—if it is changed in form to have a particular function or a different use—may be the subject transformed.

CONCLUSION

The first-inventor-to-file system implemented by the AIA effects sub-

stantial changes to the U.S. patent system, including (a) the determination of who has priority to an invention; (b) the effective date and the identity and location of prior art that pertains to an invention; (c) the strategies of an inventor before applying for a patent; and (d) several approaches to determining what subject matter may be patented. **TBJ**

NOTES

1. AIA, Sec. 14(a).



STEPHEN S. MOSHER

is a registered patent attorney and a partner in Whitaker Chalk Swindle & Schwartz in Fort Worth. He currently serves on the Dean's Advisory Council of Texas A&M University School of Law and in 2010 was honored as a distinguished alumnus by Texas Wesleyan University School of Law.

Vehicle Accidents

Has Your Client Made a Full Recovery?

Have you asked yourself: Is anything wrong with the vehicle's safety systems that may have caused your client's injury or death?



- ☐ Did you check if the airbag deployed late or not at all?
- ☐ Did you check the seatbelts for evidence of unlatching?
- ☐ Did you evaluate roof crush?
- ☐ Did you check to see if a door opened?
- ☐ Did the seats deform?
- ☐ Did the vehicle catch on fire?

Vehicle safety systems routinely fail during accidents and expose people to the risks of serious injuries and death. To ensure your clients' have obtained a full recovery, a crashworthiness evaluation of the vehicle must be conducted.

At the TRACY law firm, we constantly question how the vehicle's safety systems perform during an accident.

The TRACY law firm is a nationwide law practice dedicated to the issue of identifying vehicle safety systems that violate the principles of crashworthiness.

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214-324-9000

5473 Blair Rd, Ste . 200, Dallas, Texas 75231