

Primers

DIFFERENCES IN U.S. AND INTERNATIONAL PATENT LAWS

Several differences exist between the patent laws of the United States and other countries. In recent years, several differences have been removed to bring international patent laws into harmony. However, the remaining differences can have a substantial impact of the prosecution of your client's application in the U.S. Below, please find a brief summary of some of the most frequently encountered differences.

ONE YEAR GRACE PERIOD

All other countries require absolute novelty. This means that if the invention has become publicly available in any way before the patent application was filed, the application will be rejected. "Publicly available" includes selling the invention, giving a lecture about it, showing it to an investor, describing it in a trade journal, selling a product, or the like. It does not make a difference whether the person making it publicly available is the inventor or third party.

U.S. Patent law provides a one-year grace period. This means that the inventor can freely publish his invention without losing patent rights, so long as he files an application within the one-year grace period.

FIRST TO INVENT

When two people apply for a patent on the same invention in any other country in the world, the first person to have filed his application will get the patent. This holds even if the second person did in fact come up with the invention first. However, in the United States, patents are awarded to the "first inventor" which means that even though one is the first to file their application, they may not be entitled to the patent. In the event of conflicting patents applications claiming the same subject matter, the USPTO will conduct an interference proceeding to determine who the first inventor is. While it is relatively uncommon, this determination can involve examining laboratory notebooks, establishing dates for working prototypes, and so on.

INVENTIVE STEP AND NONOBVIOUSNESS

The requirements of inventive step and non-obviousness are directed toward the same general patentability requirement that an invention should be sufficiently inventive — i.e., non-obvious — in order to be patented.

The expression "inventive step" is predominantly used under the European Patent Convention (EPC), while the expression

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"non-obviousness" is used in United States patent law. Although the basic principle is roughly the same, the assessment of the inventive step and non-obviousness varies from one country to another and can change independently of one another. For more information on the current state of obviousness law in the United States, please feel free to contact one of our attorneys.

BEST MODE REQUIREMENT

U.S. patent law requires the inventor to include the best way to practice the invention in the patent application. This requirement seeks to prevent an inventor from obtaining a patent while maintaining his preferred method of carrying out the invention as a trade secret.

In contrast, European patent law has no such requirement. European law requires that one way of practicing the invention be included, but there is no requirement that this be the best way or even a good way of practicing the invention.

RESTRICTION PRACTICE

Internationally, patent applications are required to meet the unity of invention requirement. This requirement ensures that a patent application can only relate to one invention or a group of closely related inventions.

In the United States, patent applications are subject to restriction practice. This requires that patent applications that claim more than one distinct invention may be subject to restriction to a single invention with the right to prosecute the remaining invention(s) being preserved through the right to file a divisional application(s).

Applicants may select which standard will apply to their application when filing in the U.S. with priority to a PCT application. By nationalizing a PCT application in the U.S., the unity of invention requirement is applied. However, if a continuation application claiming priority to the PCT is filed, restriction practice will be applied by the USPTO.

OPPOSITION AFTER GRANT

Internationally, opposition proceeding vary. For instance, in Europe a party can oppose the grant of a patent within 9 months of its granting. The parties then present evidence and arguments in an adversarial proceeding, and the European Patent Office will render a decision on the appropriateness of the patent grant.

In the U.S., a reexamination proceeding exists for challenging the validity of an issue patent under certain circumstances. In a reexamination, anyone can present reasons and evidence to the U.S. Patent Office to challenge the validity of a granted patent. However, this evidence is restricted to prior art patent and printed publications. Evidence of prior use or sale can only be used to invalidate a patent in U.S. District Court.

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