

March 18-20, 2012 | The Ritz Carlton | Amelia Island | FL

Nath Law Group: Planning Your IP Strategies Ahead of the America Invents Act



Gary Nath of The Nath Law Group, a law firm attending the upcoming **marcusevans IP Law Summit Spring 2012**, shares his insights on the America Invents Act.

Interview with: Gary Nath, President & Managing Partner, The Nath Law Group

FOR IMMEDIATE RELEASE

Ahead of the full implementation of the America Invents Act in March 2013, **intellectual property** (IP) counsel should prepare for new proceedings and start strategizing on how they will take advantage of the changes without losing the benefits of the present laws, says Gary Nath, President & Managing Partner, The **Nath Law Group**.

From an IP law firm attending the upcoming **marcusevans IP Law Summit Spring 2012**, taking place in Amelia Island, Florida, March 18-20, Mr. Nath turns the spotlight on the America Invents Act and how **IP Counsel** could plan ahead.

What does the new America Invents Act cover, and how should corporate IP Counsel prepare?

Gary Nath: The Act imposes many responsibilities on the patent office and the applicants themselves. For example, some of the new responsibilities given to the patent office by the Act include new post-grant and supplemental examination procedures, an enhanced inter-partes review, and the establishment of at least three satellite offices. For applicants, the Act makes a major move towards harmonization with **patent laws** around the world, for example requiring a move from a first-to-invent to a first-to-file concept, which is routine around the world.

At this stage, counsel should immediately start strategizing how they plan to implement and take advantage of the various new proceedings provided for in the new law, while not losing some of the benefits of the present laws. Several systems will be replaced. Over the transition period, counsel should determine which system, old or new, is in the best interest of their client in order to give recommendations accordingly.

What are the major changes to the US patent laws based on the Act?

Gary Nath: The transition to a first-to-file system is the biggest change. It will eliminate the perception that one could work on an invention for years before filing it. The new law will

force everyone to race to the patent office to get their invention on file.

The new law also remedies a number of instances that occurred in litigation that placed a cloud over the patent system. Now, one has to disclose the best mode in their patent application in order to get an enforceable patent granted, the absence of which was able to be used as a way to invalidate a patent. This procedure is now limited under the new law. In addition, advice of counsel is no longer needed to avoid a charge of willful infringement.

What options will be available for challenging a patent besides litigation?

Gary Nath: At the moment we have an ex-parte Re-examination procedure that will be eliminated by 2012. Through the phase in period, the standards of proof have changed and a third party can now raise positions and arguments that were not necessarily available before.

The Act also creates an entirely new post-grant review process, to be implemented on September 16, 2012, whereby a third party can challenge a patent at the USPTO within nine months after it has been granted. This procedure is intended to mirror the Opposition procedure before the EPO. USPTO rules should be forthcoming shortly to provide more guidance as to how this new procedure will be implemented.

In addition, a new inter-partes review procedure will be implemented on September 16, 2012 to replace the current inter-partes reexamination. This new inter-partes review will allow prior art to be used to invalidate one or more claims under a reasonable likelihood to prevail standard. Such proceedings may be requested nine months from a patent's issuance or after termination of a post-grant review.

Another option is the Supplemental examination procedure, whereby a patent owner is able to bring information to the patent officer's attention that may have been misstated or inconsistently raised before in other cases, which will apply to patents filed before, on or after the law's effective date.

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Any final comments?

Gary Nath: The USPTO has been authorized to raise fees and institute a 15 per cent transaction surcharge. The additional costs for obtaining patents and enforcing them could hinder small start-ups or sole inventors, but be of benefit to larger organizations that want to put stumbling blocks in front of their competitors and potential licensees.

IP Counsel need to adopt a strategy based upon their organization's business objectives, to maximize the return that the company will receive from its **IP rights**. The strategy will not necessarily be the same for all technologies. For some new products, they may want to take alternative routes to perhaps slow down competitive development efforts or enable readily enforceable technologies to be rapidly granted that have a higher chance of success in the court systems.

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About the IP Law Summit Spring 2012

This unique forum will take place at The Ritz Carlton, Amelia Island, Florida, March 18-20, 2012. Offering much more than any conference, exhibition or trade show, this exclusive meeting will bring together esteemed industry thought leaders and solution providers to a highly focused and interactive networking event. The Summit includes presentations on safeguarding IP, developing sustainable brand protection strategies, global IP portfolio management and maintaining competitiveness with IP litigation.

For more information please send an email to info@marcusevanscy.com or visit the event website at www.iplawsummit.com

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Please note that the summit is a closed business event and the number of participants strictly limited.

About Nath Law Group

The Nath Law Group, founded in 1993, is a medium sized law firm specializing in patent and trademark prosecution, licensing and enforcement, as well as general business matters. Located in the Washington DC area as well as San Diego, California, The Nath Law Group's scientific expertise spans all technical disciplines with particular emphasis on biotechnology, biomedical, chemical, pharmaceutical and electrical and mechanical inventions.

For more information: www.nathlaw.com

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