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The America Invents Act Five Years Later: Reality, Consequences and Perspectives



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September 6, 2016

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President Obama signs the America Invents Act into Law, September 16, 2011.

At exactly 11:42am on September 16, 2011, President Barak Obama signed the America Invents Act into law. As President Obama put his pen down he said: “All

right guys, congratulations, the bill is signed.” It was at this precise moment that U.S. patent laws dramatically changed forever. See [*The Bill is Signed: President Signs America Invents Act*](#) and [*Brave New World: First to File Becomes Law*](#).

There had been much debate and discussion about the U.S. moving from a first to invent system to a first to file system. Under a first to invent regime, which was peculiar to the United States, it was possible for someone to be entitled to receive a patent if they could demonstrate they invented the core concepts first even if they filed a patent application after another party had already applied. Over the years it became increasingly difficult, if not practically impossible, for a second filer to demonstrate entitlement to a patent over a first filer. So the change was made to make America a first to file country. In so doing the grace period was substantially changed to the point where today it is hard to imagine a real world situation where it could be useful for an inventor.

As much focus and energy that was placed on the change from first to invent to first to file, without a doubt the biggest change to U.S. patent practice was the creation of the Patent Trial and Appeal Board (PTAB) and the simultaneous creation of three new opportunities for challengers to invalidate patent claims at the Patent Office. Inter Partes Review (IPR); Covered Business Method (CBM) Review and Post Grant Review (PGR) have been extraordinarily controversial. Indeed, it seems that many of the new Administrative Patent Judges (APJs) believe they were hired to invalidate patent claims rather than call balls and strikes in an impartial manner. It is impossible to ignore that the procedural and substantive deck has been substantially stacked against patent owners from the beginning.

Even today, overwhelmingly applications are still examined under first to file rules for two reasons: (1) First to file did not go into effect until March 16, 2013; and (2) If all claims in an application are entitled to priority from on or before March 15, 2013, the application will be examined under first to invent rules, which means it is still possible today to file applications that will be examined under first to invent rules. This is significant because the great majority of stakeholders have not felt the major substantive changes to the law ushered into being by first to file. Once this changes and applications are increasingly examined under first to file rules, the fact that foreign filed patent applications will be prior art in most cases as of their foreign filing dates will easily go down as the biggest change to the U.S. patent system once applications are examined under AIA first to file rules.



These and other issues deserve far more attention as we look back five years after the fact. With this in mind, over the next two weeks we will be examining the AIA in great detail in a special AIA 5th Anniversary series. I've invited a number of guests to comment, discuss and/or editorialize about the AIA. Below is a sneak peak of some of the contributions already received. As articles are published this preview article will be updated with links to the entire series.