



aws IPR for USA

US Patentrecht

Dr. Daniel Alge
Sonn & Partner, Wien
www.sonn.at



Das US-Patentrecht und seine Anwendung in der Praxis

Der "America Invents Act" und
neueste Entscheidungen des US
Supreme Court zum Patentrecht

Dr. Daniel Alge
Sonn & Partner, Wien
www.sonn.at

US Patentrecht

- Der "America Invents Act" (AIA)
- US Supreme Court: Interessante Entscheidungen zum Patentrecht

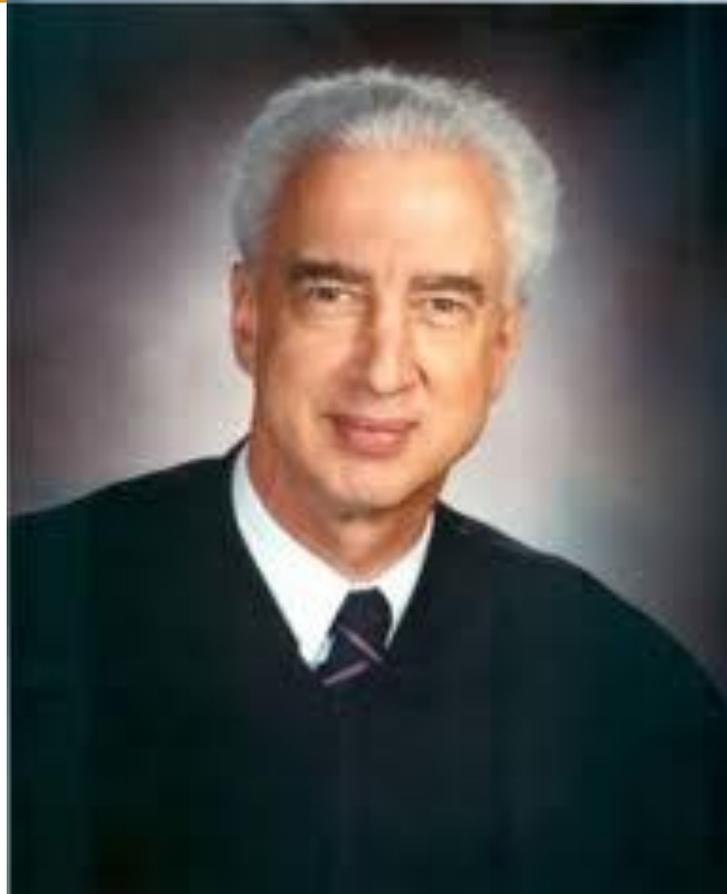


Der "America Invents Act" (AIA)

- „historical“
- „biggest law change in 60 years“
- „fundamental change“
- „uncertainty“
- „poorly written and ambiguous“



Der "America Invents Act" (AIA)

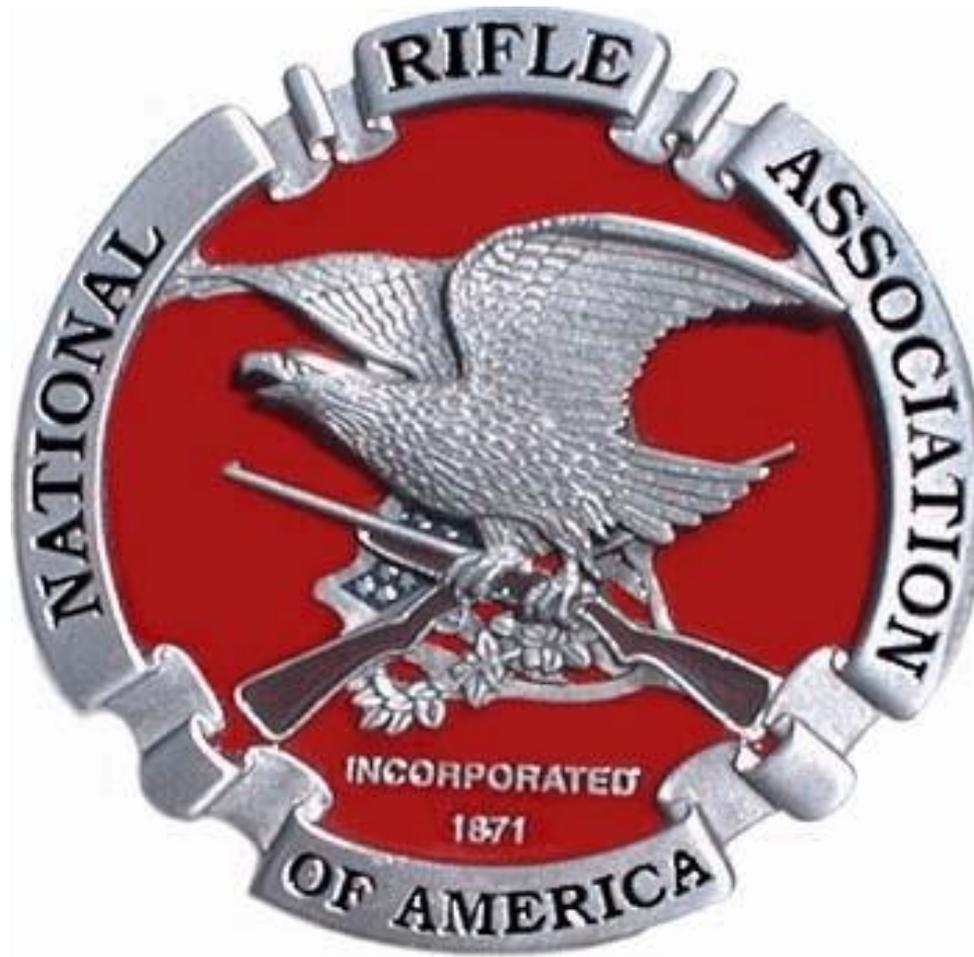


Der "America Invents Act" (AIA)

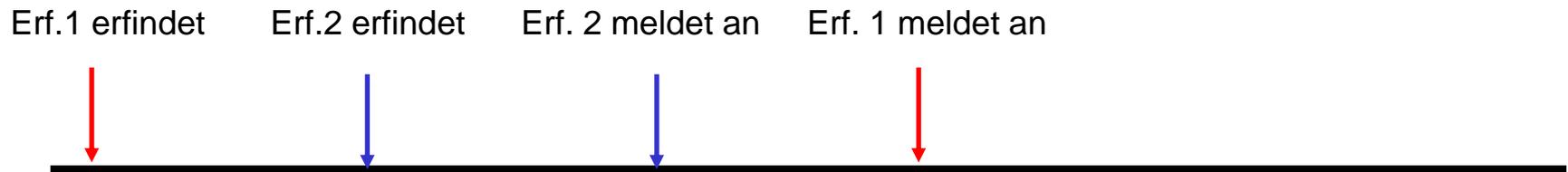
- „First inventor to file“
- First to invent → First to file
- Vom Ersterfinderprinzip zum Erstanmelderprinzip



Der "America Invents Act" (AIA)



First to invent



Erf. 1 erhält das Patent

Erf. 2 erhält gar nichts



Der "America Invents Act" (AIA)

- „First inventor to file“
- First to invent → First to file
- Vom Ersterfinderprinzip zum Erstanmelderprinzip



First inventor to file

Erf. 1 erfindet

Erf. 2 erfindet

Erf. 2 meldet an

Erf. 1 meldet an



Erf. 2 erhält das Patent

Erf. 1 erhält (mglw.) Vorben.-Recht



Der "America Invents Act" (AIA)

Sec. 3. First inventor to file.

Sec. 4. Inventor's oath or declaration.

Sec. 5. Defense to infringement based on prior commercial use.

Sec. 6. Post-grant review proceedings.

Sec. 7. Patent Trial and Appeal Board.

Sec. 8. Preissuance submissions by third parties.

Sec. 9. Venue.

Sec. 10. Fee setting authority.

Sec. 11. Fees for patent services.

Sec. 12. Supplemental examination.

Sec. 13. Funding agreements.

Sec. 14. Tax strategies deemed within the prior art.

Sec. 15. Best mode requirement.

Sec. 16. Marking.

Sec. 17. Advice of counsel.

Sec. 18. Transitional program for covered business method patents.

Sec. 19. Jurisdiction and procedural matters.

Sec. 20. Technical amendments.

Sec. 21. Travel expenses and payment of administrative judges.

Sec. 22. Patent and Trademark Office funding.

Sec. 23. Satellite offices.

Sec. 24. Designation of Detroit satellite office.

Sec. 25. Priority examination for important technologies.

Sec. 26. Study on implementation.

Sec. 27. Study on genetic testing.

Sec. 28. Patent Ombudsman Program for small business concerns.

Sec. 29. Establishment of methods for studying the diversity of applicants.

Sec. 30. Sense of Congress.

Sec. 31. USPTO study on international patent protections for small businesses.

Sec. 32. Pro bono program.

Sec. 33. Limitation on issuance of patents.

Sec. 34. Study of patent litigation.

Sec. 35. Effective date.

Sec. 36. Budgetary effects.

Sec. 37. Calculation of 60-day period for application of patent term extension.



Der "America Invents Act" (AIA)

Sec. 3. First inventor to file.

Sec. 4. Inventor's oath or declaration.

Sec. 5. Defense to infringement based on prior commercial use.

Sec. 6. Post-grant review proceedings.

Sec. 7. Patent Trial and Appeal Board.

Sec. 8. Preissuance submissions by third parties.

Sec. 9. Venue.

Sec. 10. Fee setting authority.

Sec. 11. Fees for patent services.

Sec. 12. Supplemental examination.

Sec. 13. Funding agreements.

Sec. 14. Tax strategies deemed within the prior art.

Sec. 15. Best mode requirement.

Sec. 16. Marking.

Sec. 17. Advice of counsel.

Sec. 18. Transitional program for covered business method patents.

Sec. 19. Jurisdiction and procedural matters.

Sec. 20. Technical amendments.

Sec. 21. Travel expenses and payment of administrative judges.

Sec. 22. Patent and Trademark Office funding.

Sec. 23. Satellite offices.

Sec. 24. Designation of Detroit satellite office.

Sec. 25. Priority examination for important technologies.

Sec. 26. Study on implementation.

Sec. 27. Study on genetic testing.

Sec. 28. Patent Ombudsman Program for small business concerns.

Sec. 29. Establishment of methods for studying the diversity of applicants.

Sec. 30. Sense of Congress.

Sec. 31. USPTO study on international patent protections for small businesses.

Sec. 32. Pro bono program.

Sec. 33. Limitation on issuance of patents.

Sec. 34. Study of patent litigation.

Sec. 35. Effective date.

Sec. 36. Budgetary effects.

Sec. 37. Calculation of 60-day period for application of patent term extension.



First to invent → First to file

- 35 U.S.C. § 102 (Neuheit):
 - (a) NOVELTY; PRIOR ART.—A person shall be entitled to a patent unless—
 - (1) the claimed invention was patented, described in a printed publication, or in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention; or
 - (2) the claimed invention was described in a patent issued under section 151, or in an application for patent published or deemed published under section 122(b), in which the patent or application, as the case may be, names another inventor and was effectively filed before the effective filing date of the claimed invention.
 - (b) EXCEPTIONS ...



First to invent → First to file

AIA: 35 U.S.C. § 102 (Neuheit):

(a) NOVELTY; PRIOR ART.—A person shall be entitled to a patent unless—

(1) the claimed invention was patented, described in a printed publication, or in public use, on sale, **or otherwise available to the public** before the effective filing date of the claimed invention; or

(2) ...

(b) EXCEPTIONS ...

Pre-AIA: 35 U.S.C. § 102 (Neuheit):

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication **in this or a foreign country** or in public use or on sale **in this country**, more than one year prior to the date of the application for patent in the United States, or ..



First inventor to file

Erf. 1 erfindet

Erf. 2 erfindet

Erf. 2 meldet an

Erf. 1 meldet an



Erf. 2 erhält das Patent

Erf. 1 erhält (mglw.) Vorben.-Recht



First to invent → First to file

AIA: 35 U.S.C. § 102 (Neuheit):

'(b) EXCEPTIONS.— '(1) DISCLOSURES MADE 1 YEAR OR LESS BEFORE THE EFFECTIVE FILING DATE OF THE CLAIMED INVENTION.—A disclosure made 1 year or less before the effective filing date of a claimed invention shall not be prior art to the claimed invention under subsection (a)(1) if—

(A) the disclosure was made by the inventor or joint inventor or by another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor; or

(B) the subject matter disclosed had, before such disclosure, been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor.

(2) DISCLOSURES APPEARING IN APPLICATIONS AND PATENTS.— A disclosure shall not be prior art to a claimed invention under subsection (a)(2) if—

(A) the subject matter disclosed was obtained directly or indirectly from the inventor or a joint inventor;

(B) the subject matter disclosed had, before such subject matter was effectively filed under subsection (a)(2), been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor; or

(C) the subject matter disclosed and the claimed invention, not later than the effective filing date of the claimed invention, were owned by the same person or subject to an obligation of assignment to the same person.

(c) COMMON OWNERSHIP UNDER JOINT RESEARCH AGREEMENTS.— Subject matter disclosed and a claimed invention shall be deemed to have been owned by the same person or subject to an obligation of assignment to the same person in applying the provisions of subsection (b)(2)(C) if—

(1) the subject matter disclosed was developed and the claimed invention was made by, or on behalf of, 1 or more parties to a joint research agreement that was in effect on or before the effective filing date of the claimed invention;

(2) the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement; and

(3) the application for patent for the claimed invention discloses or is amended to disclose the names of the parties to the joint research agreement.

(d) PATENTS AND PUBLISHED APPLICATIONS EFFECTIVE AS PRIOR ART.—For purposes of determining whether a patent or application for patent is prior art to a claimed invention under subsection (a)(2), such patent or application shall be considered to have been effectively filed, with respect to any subject matter described in the patent or application—

(1) if paragraph (2) does not apply, as of the actual filing date of the patent or the application for patent; or

(2) if the patent or application for patent is entitled to claim a right of priority under section 119, 365(a), or 365(b), or to claim the benefit of an earlier filing date under section 120, 121, or 365(c), based upon 1 or more prior filed applications for patent, as of the filing date of the earliest such application that describes the subject matter.

Pre-AIA: 35 U.S.C. § 102 (Neuheit): A person shall be entitled to a patent unless -

(c) he has abandoned the invention, or

(d) the invention was first patented or caused to be patented, or was the subject of an inventor's certificate, by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application for patent or inventor's certificate filed more than twelve months before the filing of the application in the United States, or

(e) the invention was described in - (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language; or

(f) he did not himself invent the subject matter sought to be patented, or

(g)(1) during the course of an interference conducted under section 135 or section 291, another inventor involved therein establishes, to the extent permitted in section 104, that before such person's invention thereof the invention was made by such other inventor and not abandoned, suppressed, or concealed, or (2) before such person's invention thereof, the invention was made in this country by another inventor who had not abandoned, suppressed, or concealed it. In determining priority of invention under this subsection, there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.



First to invent → First to file

AIA: 35 U.S.C. § 102 (Neuheit):

‘(b) EXCEPTIONS.— ‘(1) DISCLOSURES MADE 1 YEAR OR LESS BEFORE THE EFFECTIVE FILING DATE OF THE CLAIMED INVENTION.—

A disclosure made 1 year or less before the effective filing date of a claimed invention shall not be prior art to the claimed invention under subsection (a)(1) if—

(A) the disclosure was made by the inventor or joint inventor or by another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor; or

(B) the subject matter disclosed had, before such disclosure, been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor.

Pre-AIA: 35 U.S.C. § 102 (Neuheit): A person shall be entitled to a patent unless -

(d) the invention was first patented or caused to be patented, or was the subject of an inventor's certificate, by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application for patent or inventor's certificate filed more than twelve months before the filing of the application in the United States, or

(g)(1) during the course of an interference conducted under section 135 or section 291, another inventor involved therein establishes, to the extent permitted in section 104, that before such person's invention thereof the invention was made by such other inventor and not abandoned, suppressed, or concealed, or (2) before such person's invention thereof, the invention was made in this country by another inventor who had not abandoned, suppressed, or concealed it. In determining priority of invention under this subsection, there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

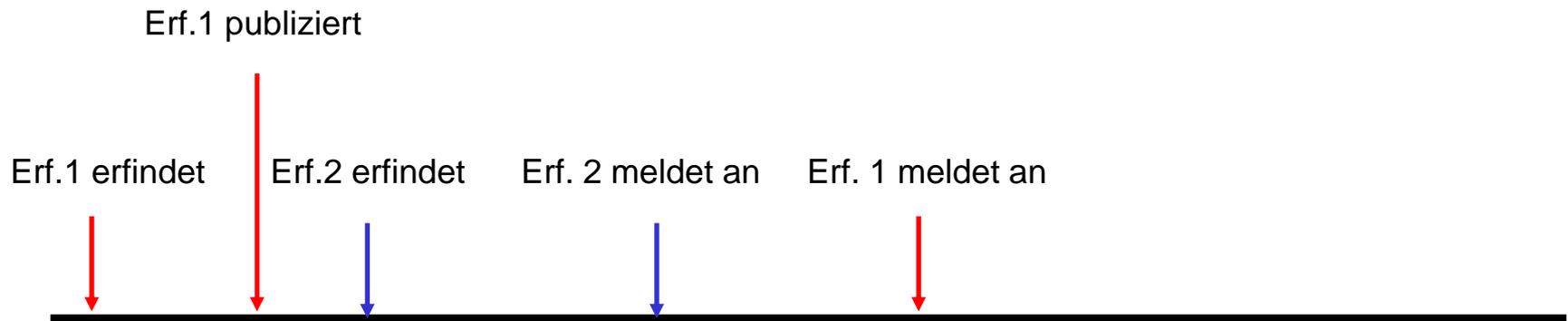


First to invent → First to file

- Neuheitsbegriff: vollkommen verändert, jedoch immer noch nicht europäisch
- Kein Interference-Verfahren mehr
- Conception → Reduction to Practice nicht mehr erforderlich (?)
- Grace Period: Erfinderschonfrist, jedoch ebenfalls verändert → „öffentliches“ Anbieten, Verkauf



First to invent → First to file



Erf. 1 erhält das Patent

Erf. 2 erhält gar nichts

1 Jahr



First to invent → First to file

- 35 U.S.C. § 103 („Nonobviousness“/Erfinderische Tätigkeit):
 - A patent for a claimed invention may not be obtained, notwithstanding that the claimed invention is not identically disclosed as set forth in section 102, if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains. Patentability shall not be negated by the manner in which the invention was made.



First to invent → First to file

AIA: 35 U.S.C. § 103 (Erfinderische Tätigkeit):

A patent for a claimed invention may not be obtained, notwithstanding that the **claimed invention** is not identically disclosed as set forth in section 102, if the differences between the claimed invention and the prior art are such that the **claimed invention** as a whole would have been obvious **before the effective filing date** of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains. Patentability shall not be **negated** by the manner in which the invention was made.

Pre-AIA: 35 U.S.C. § 102 (Nonobviousness):

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the **subject matter sought to be patented** and the prior art are such that the **subject matter** as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be **negated** by the manner in which the invention was made. Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.



First to invent → First to file

- Neuheitsbegriff: vollkommen verändert, jedoch immer noch nicht europäisch
- Kein Interference-Verfahren mehr
 - (f. Anspruch mit „effective date“ ab 16. März 2013)
- Conception → Reduction to Practice
 - nicht mehr erforderlich (?)
- Grace Period:
 - Erfinderschonfrist, jedoch ebenfalls verändert → „öffentliches“ Anbieten, Verkauf
- Vorbenutzungsrecht



First to invent → First to file

- Vorbenutzungsrecht
 - 35 U.S.C. § 273 AIA
 - Defense to infringement based on prior commercial use
 - “(a) IN GENERAL.—A person shall be entitled to a defense under section 282(b) with respect to subject matter consisting of a process, or consisting of a machine, manufacture, or composition of matter used in a manufacturing or other commercial process, that would otherwise infringe a claimed invention being asserted against the person if—



First to invent → First to file

AIA: § 273 Vorbenutzungsrecht:

“(a) IN GENERAL.—A person shall be entitled to a defense under section 282(b) with respect to subject matter consisting of a process, or consisting of a machine, manufacture, or composition of matter used in a manufacturing or other commercial process, that would otherwise infringe a claimed invention being asserted against the person if—

“(1) such person, acting in good faith, commercially used the subject matter in the United States, either in connection with an internal commercial use or an actual arm’s length sale or other arm’s length commercial transfer of a useful end result of such commercial use; and “(2) such commercial use occurred at least 1 year before the earlier of either—

“(A) the effective filing date of the claimed invention; or

“(B) the date on which the claimed invention was disclosed to the public in a manner that qualified for the exception from prior art under section 102(b). “(b) BURDEN OF PROOF.—A person asserting a defense under this section shall have the burden of establishing the defense by clear and convincing evidence.

“(c) ADDITIONAL COMMERCIAL USES.—

“(1) PREMARKETING REGULATORY REVIEW.—Subject matter for which commercial marketing or use is subject to a premarketing regulatory review period during which the safety or efficacy of the subject matter is established, including any period specified in section 156(g), shall be deemed to be commercially used for purposes of subsection (a)(1) during such regulatory review period.

“(2) NONPROFIT LABORATORY USE.—A use of subject matter by a nonprofit research laboratory or other nonprofit entity, such as a university or hospital, for which the public is the intended beneficiary, shall be deemed to be a commercial use for purposes of subsection (a)(1), except that a defense under this section may be asserted pursuant to this paragraph only for continued and noncommercial use by and in the laboratory or other nonprofit entity.

“(d) EXHAUSTION OF RIGHTS.—Notwithstanding subsection

(e)(1), the sale or other disposition of a useful end result by a person entitled to assert a defense under this section in connection with a patent with respect to that useful end result shall exhaust the patent owner’s rights under the patent to the extent that such rights would have been exhausted had such sale or other disposition been made by the patent owner.

(e) LIMITATIONS AND EXCEPTIONS.—

“(1) PERSONAL DEFENSE.—

“(A) IN GENERAL.—A defense under this section may be asserted only by the person who performed or directed the performance of the commercial use described in subsection (a), or by an entity that controls, is controlled by, or is under common control with such person.

“(B) TRANSFER OF RIGHT.—Except for any transfer to the patent owner, the right to assert a defense under this section shall not be licensed or assigned or transferred to another person except as an ancillary and subordinate part of a good-faith assignment or transfer for other reasons of the entire enterprise or line of business to which the defense relates.

“(C) RESTRICTION ON SITES.—A defense under this section, when acquired by a person as part of an assignment or transfer described in subparagraph (B), may only be asserted for uses at sites where the subject matter that would otherwise infringe a claimed invention is in use before the later of the effective filing date of the claimed invention or the date of the assignment or transfer of such enterprise or line of business.

“(2) DERIVATION.—A person may not assert a defense under this section if the subject matter on which the defense is based was derived from the patentee or persons in privity with the patentee.

“(3) NOT A GENERAL LICENSE.—The defense asserted by a person under this section is not a general license under all claims of the patent at issue, but extends only to the specific subject matter for which it has been established that a commercial use that qualifies under this section occurred, except that the defense shall also extend to variations in the quantity or volume of use of the claimed subject matter, and to improvements in the claimed subject matter that do not infringe additional specifically claimed subject matter of the patent.

“(4) ABANDONMENT OF USE.—A person who has abandoned commercial use (that qualifies under this section) of subject matter may not rely on activities performed before the date of such abandonment in establishing a defense under this section with respect to actions taken on or after the date of such abandonment.

“(5) UNIVERSITY EXCEPTION.—

“(A) IN GENERAL.—A person commercially using subject

matter to which subsection (a) applies may not assert a defense under this section if the claimed invention with respect to which the defense is asserted was, at the time the invention was made, owned or subject to an obligation of assignment to either an institution of higher education (as defined in section 101(a) of the Higher Education Act of 1965 (20 U.S.C. 1001(a)), or a technology transfer organization whose primary purpose is to facilitate the commercialization of technologies developed by one or more such institutions of higher education. “(B) EXCEPTION.—Subparagraph (A) shall not apply if any of the activities required to reduce to practice the subject matter of the claimed invention could not have been undertaken using funds provided by the Federal Government.

“(f) UNREASONABLE ASSERTION OF DEFENSE.—If the defense under this section is pleaded by a person who is found to infringe the patent and who subsequently fails to demonstrate a reasonable basis for asserting the defense, the court shall find the case exceptional for the purpose of awarding attorney fees under section

285.
“(g) INVALIDITY.—A patent shall not be deemed to be invalid under section 102 or 103 solely because a defense is raised or established under this section.

§ 23. öPatG

(1) Die Wirkung des Patentbesitzes tritt gegen denjenigen nicht ein, der bereits zur Zeit der Anmeldung im guten Glauben die Erfindung im Inland in Benutzung genommen oder die zu solcher Benutzung erforderlichen Veranstaltungen getroffen hat (Vorbenützer).

(2) Der Vorbenützer ist befugt, die Erfindung für die Bedürfnisse seines eigenen Betriebes in eigenen oder fremden Werkstätten auszunutzen.

(3) Dieses Befugnis kann nur zusammen mit dem Betrieb vererbt oder veräußert werden.

(4) Der Vorbenützer kann verlangen, dass seine Befugnis vom Patentinhaber durch Ausstellung einer Urkunde anerkannt wird. Wird diese Anerkennung verweigert, so hat auf Antrag das Patentamt über den erhobenen Anspruch in dem für den Anfechtungsprozess vorgesehenen Verfahren zu entscheiden. Die anerkannte Befugnis ist auf Ansuchen des Berechtigten in das Patentregister einzutragen.

First to invent → First to file

AIA: § 273 Vorbenutzungsrecht:

“(1) such person, acting in good faith, commercially used the subject matter in the United States, either in connection with an internal commercial use or an actual arm’s length sale or other arm’s length commercial transfer of a useful end result of such commercial use; and

“(2) such commercial use occurred at least 1 year before the earlier of either—
(A) the effective filing date of the claimed invention; or (B) the date on which the claimed invention was disclosed to the public in a manner that qualified for the exception from prior art under section 102(b).

(b) BURDEN OF PROOF.—A person asserting a defense under this section shall have the burden of establishing the defense by clear and convincing evidence.

(c) ADDITIONAL COMMERCIAL USES.—

(1) PREMARKETING REGULATORY REVIEW.—

(2) NONPROFIT LABORATORY USE.—

(d) EXHAUSTION OF RIGHTS.—

(e) LIMITATIONS AND EXCEPTIONS.—

(1) PERSONAL DEFENSE.—

(A) IN GENERAL.—

(B) TRANSFER OF RIGHT.—

(C) RESTRICTION ON SITES.—

(2) DERIVATION.—A person may not assert a defense under this section if the subject matter on which the defense is based was derived from the patentee or persons in privity with the patentee.

(3) NOT A GENERAL LICENSE.—

(4) ABANDONMENT OF USE.—

(5) UNIVERSITY EXCEPTION.—

(A) IN GENERAL.—

(f) UNREASONABLE ASSERTION OF DEFENSE.—

(g) INVALIDITY.—

§ 23. öPatG

(1) Die Wirkung des Patentbesitzes tritt gegen denjenigen nicht ein, der bereits zur Zeit der Anmeldung **im guten Glauben** die Erfindung im Inland **in Benützung genommen** oder die zu solcher Benützung **erforderlichen Veranstaltungen getroffen** hat (Vorbenützer).

(2) Der Vorbenützer ist befugt, die Erfindung für die Bedürfnisse seines eigenen Betriebes in eigenen oder fremden Werkstätten auszunützen.

(3) Dieses Befugnis kann nur zusammen mit dem Betrieb vererbt oder veräußert werden.

(4) Der Vorbenützer kann verlangen, dass seine Befugnis vom Patentinhaber durch Ausstellung einer Urkunde anerkannt wird. Wird diese Anerkennung verweigert, so hat auf Antrag das Patentamt über den erhobenen Anspruch in dem für den Anfechtungsprozess vorgesehenen Verfahren zu entscheiden. Die anerkannte Befugnis ist auf Ansuchen des Berechtigten in das Patentregister einzutragen.



Der "America Invents Act" (AIA)

- Best mode
- Anmeldung nicht nur mehr durch Erfinder möglich
- Viele finanzielle und institutionelle Änderungen hinsichtlich der Rolle und Funktion des US-PTO
- Geplante Studien und Impact-Untersuchungen
- Post-grant review proceedings: „Einspruch“, „Nichtigkeitsklage“, „Aberkennungsklage“



Post-grant review proceedings

- Inter partes review
 - Beschränkt auf §§ 102/103
 - Nach Ablauf von 9 Mo ab Erteilung
 - Discovery möglich
 - „reasonable likelihood“ (§§ 312-314)
- Post-grant review
 - Nicht beschränkt auf §§ 102/103
 - Innerhalb von 9 Mo ab Erteilung
 - Discovery möglich
 - „more likely than not“ (§ 324)



Post-grant review proceedings

- Inter partes review
 - „reasonable likelihood“
- Post-grant review
 - „more likely than not“
- 1. Instanz
- Beschwerde
- Kosten
- Auswirkung auf zivilgerichtliche Verfahren



Der "America Invents Act" (AIA)



Der "America Invents Act" (AIA)



US Patentrecht

- US Supreme Court: Interessante Entscheidungen zum Patentrecht



US Supreme Court



US Supreme Court

- US Supreme Court: Interessante Entscheidungen zum Patentrecht
 - Mayo Collaborative Services v. Prometheus Laboratories, Inc.
 - Bowman v. Monsanto
 - Association for Molecular Pathology v. Myriad Genetics
 - Alice Corp. v. CLS Bank International
- CAFC-Entscheidung
 - Ariad Pharmaceuticals, Inc. v. Eli Lilly and Co.



US Supreme Court

- Mayo Collaborative Services v. Prometheus Laboratories, Inc.
 - Diagnostische Verfahren
 - Ein Patent muss mehr sein als nur ein Naturgesetz wiederzugeben
 - Naturgesetze oder natürliche Phänomene sind nicht patentierbar
 - Große Auswirkungen auf die Patentierungspraxis; Rechtsunsicherheit



US Supreme Court

- Bowman v. Monsanto
 - Roundup Ready Soyabohne
 - Anwendung des Konzepts der Erschöpfung des Patentrechts auf selbstvermehrende Erfindungsgegenstände



US Supreme Court

- Association for Molecular Pathology v. Myriad Genetics
 - Patentierbarkeit von DNA-Sequenzen
 - cDNA
 - „law of nature exception“



US Supreme Court

- Neue Prüfungsrichtlinien beim USPTO nach Myriad und Prometheus (4. März 2014)





UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

MEMORANDUM

DATE: March 4, 2014

TO: Patent Examining Corps

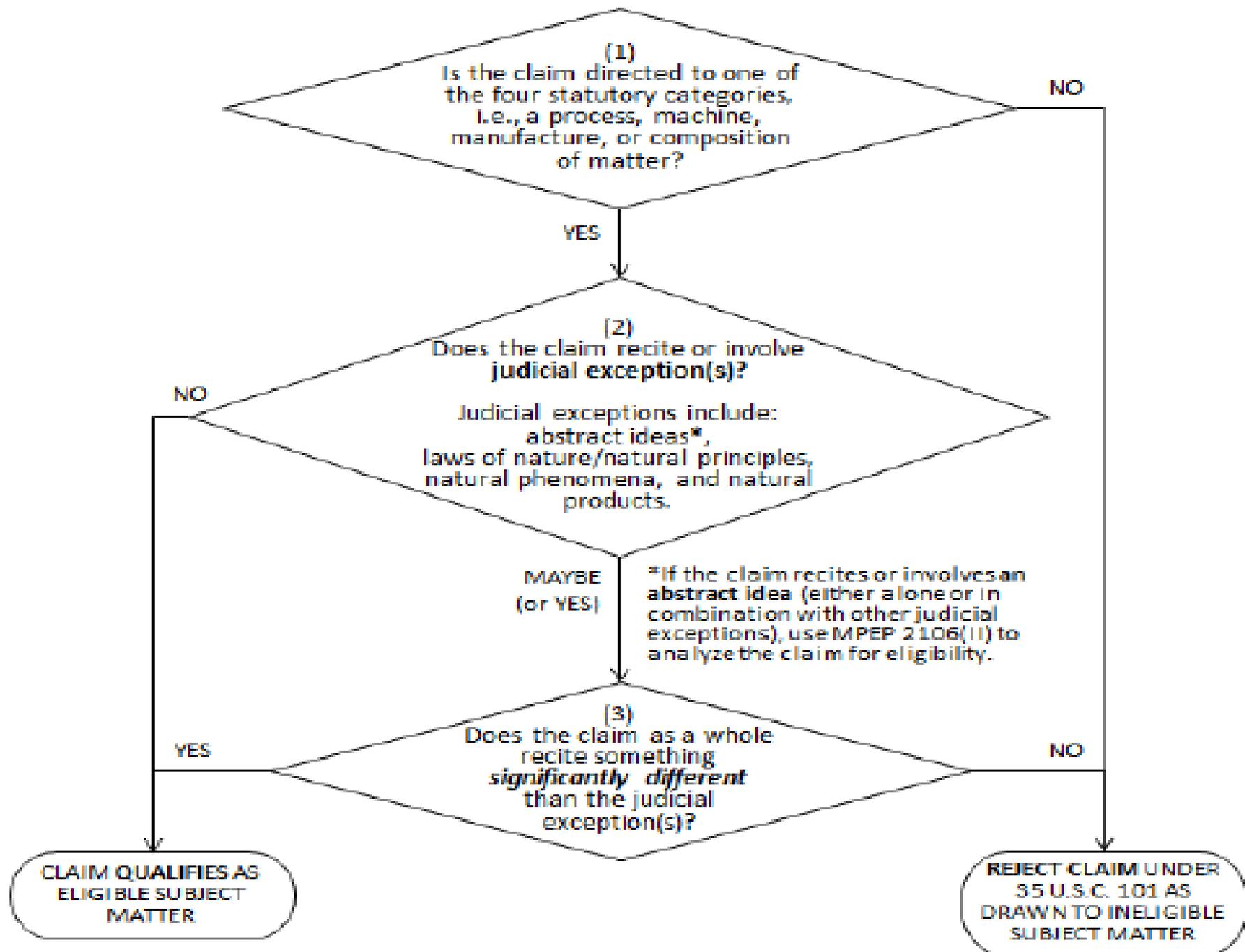
FROM: Andrew H. Hirshfeld
Deputy Commissioner
For Patent Examination Policy

SUBJECT: 2014 Procedure For Subject Matter Eligibility Analysis Of Claims Reciting Or Involving Laws Of Nature/Natural Principles, Natural Phenomena, And/Or Natural Products

The attached guidance memorandum titled *Guidance For Determining Subject Matter Eligibility Of Claims Reciting Or Involving Laws of Nature, Natural Phenomena, & Natural Products (Guidance)* implements a new procedure to address changes in the law relating to subject matter eligibility under 35 U.S.C. § 101 in view of recent court decisions including *Association for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. ___, 133 S. Ct. 2107, 2116, 106 USPQ2d 1972 (2013), and *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 566 U.S. ___, 132 S. Ct. 1289, 101 USPQ2d 1961 (2012).



SONN & PARTNER



US Supreme Court

- Neue Prüfungsrichtlinien beim USPTO nach Myriad und Prometheus (4. März 2014)
 - Fällt Erfindung unter die Ausnahmebestimmungen (abstrakte Idee; Naturgesetz, natürliches Phänomen, Naturprodukt)?
 - Unterscheidet sich Erfindung maßgeblich (“significant”) von der Ausnahmebestimmung?



US Supreme Court

- Alice Corp. v. CLS Bank International
 - Sind Computer-implementierte Erfindungen patentierbar?
 - Entscheidung 2014 erwartet



US Supreme Court

- CAFC: Ariad Pharmaceuticals, Inc. v. Eli Lilly and Co.
 - „Written Description Requirement“ ist ein eigenes Patentierbarkeitserfordernis, neben der ausreichenden Offenbarung („Enablement“)
 - Sehr praxisrelevant für das Abfassen von Patentanmeldungen





Das US-Patentrecht und seine Anwendung in der Praxis

Der "America Invents Act" und
neueste Entscheidungen des US
Supreme Court zum Patentrecht

Dr. Daniel Alge
Sonn & Partner, Wien
www.sonn.at