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Patent Refresher– July 8, 2014

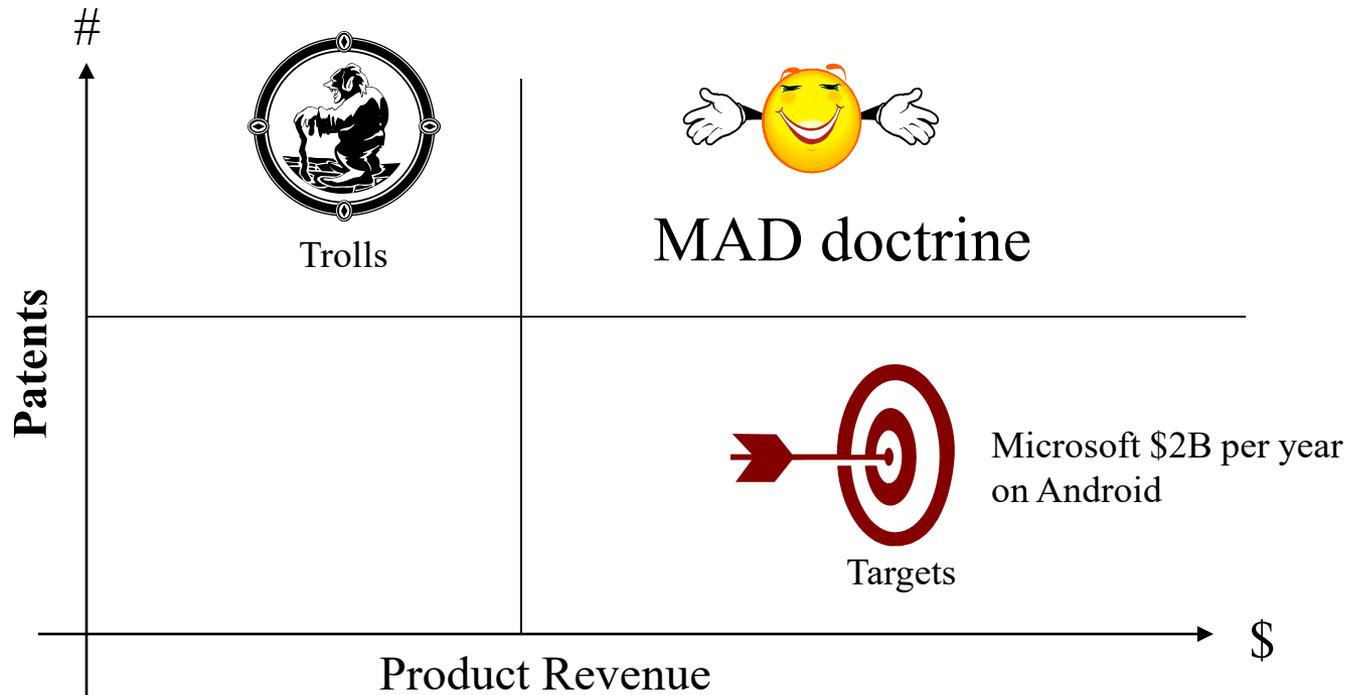
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Agenda

- Why are patents important to Oracle
- Background on NEW Patent Law
- What is patentably “New” under AIA
- Public Disclosure as prior art
- AIA: First to ~~Invent~~ File
- AIA: Exceptions to First to File
- Oracle Patent Process
- Summary

Why are Patents Important to Oracle?



Note1: There is a 3-4 year lead time from filing to issue

Note2: An issued patent is presumed valid over all prior art

Background

- **Leahy-Smith America Invents Act (AIA)** signed into law on September 16, 2011 with most significant provisions taking effect on March 16, 2013
- The law represents the most significant change to the U.S. patent system since the Patent Act of 1952
- One major goal was to harmonize U.S. patent law with the rest of the world
 - Changes from a "first-to-invent" to a "first-to-file" system
 - Modifies certain U.S.-centric provisions – expanded prior art

What is Patentable Under AIA?

- An invention must be **new** (102 – AIA changed significantly) **and non-obvious** (103, basically the same)
- **102(a): [New, i.e., Not Prior Art] A person shall be entitled to a patent unless—**
 - 1) **Public Disclosures (worldwide)**: issued patents, patent application publications, published papers, or in public use, on sale, or otherwise available to the public **before the effective filing date** of the claimed invention; or
 - 2) **U.S. patent filings by others** that are eventually published or issued (but, non-public for 18 months) filed **before the effective filing date** of the claimed invention.

Example: Printed Publication as prior art



Analysis under the OLD rules

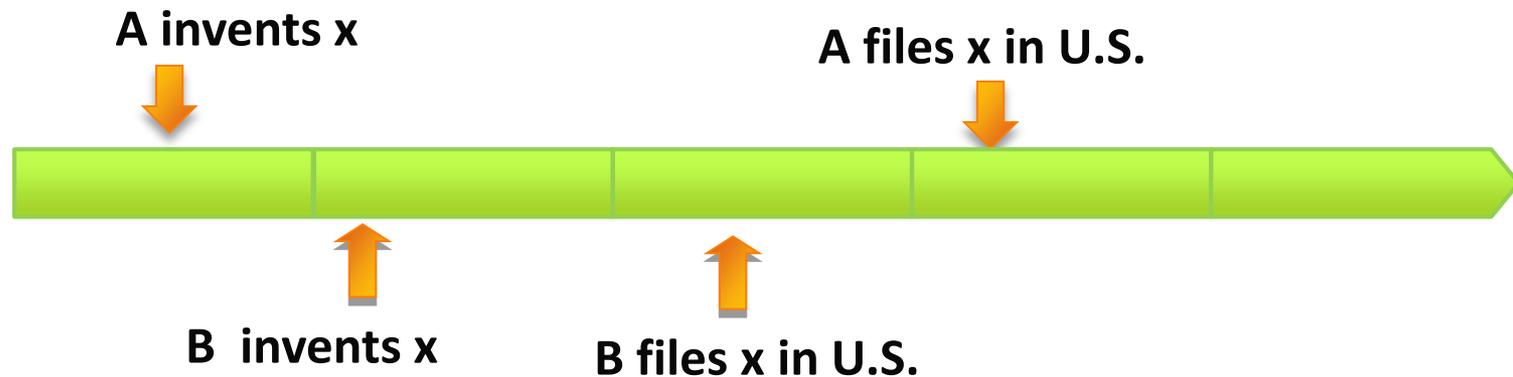
- 3rd party's public disclosure is prior art to A under 102(a). [USPTO in examining, searches for prior art published before filing date]
- A gets patent because A invented before third party publication. [A can "swear behind" 3rd party's publication as A filed within 1 year of third party's disclosure]

Analysis under the NEW rules

- A cannot file patent application under 102(a)(1) because third party publication is before A's filing.
- "swear behind" has been eliminated as filing date not invention date is critical
- **A LOSES**

FIRST TO ~~INVENT~~ FILE (35 U.S.C. 102)

A invents first, but B files first



Analysis under the OLD law

- A invented first
- **A WINS** and gets the patent

Analysis under the NEW law

- B filed first
- Invention Date no longer matters
- B's filing is prior art to A
- **B WINS** and gets the patent

Exceptions to First-to-File

- **The inventor still has a one year grace period for the inventor's own public disclosure**
 - **Repealed: potential one year grace period for public disclosures by others**
- **The exception on first-to-publish is mythical**
 - **Rule: an inventor's public disclosure before another's public disclosure or patent filing may be preclusive**
 - **More of a trap than an exception**
- **While taking of another's idea and patenting it should not be allowed, practically, in the software field under the new law, it is difficult to prove**

Example of Rule: Publication Before Filing



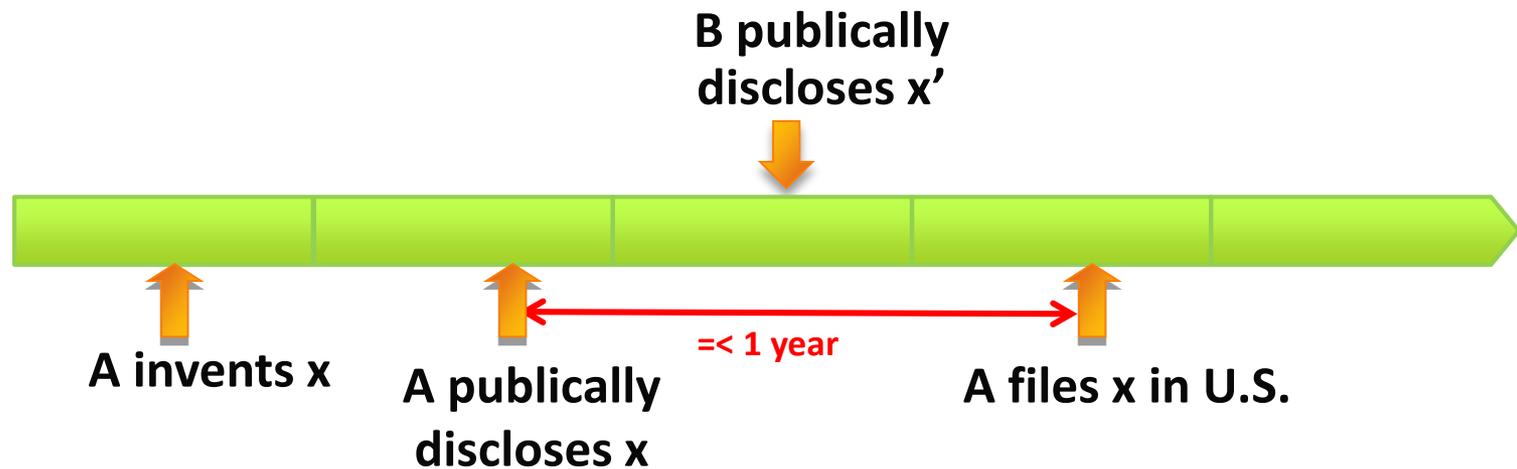
Analysis under the OLD rules

- B's public disclosure is prior art to A under 102(a), as A's public disclosure is prior art to B under 102(a).
- **A wins** because A invented first, as invention date trumps B's disclosure date

Analysis under the NEW rules

- B's paper is prior art to A's filing
- **B wins** because B has 1 year grace period from B's public disclosure to file application under 102(b)(1)(A) and B published before A files under 102(b)(2)(B)
- **B WINS**

Example of First-to-Publish Myth: Obvious variation Disclosed by Third party



Analysis under the OLD rules

- Although B's disclosure maybe presumed to be prior art to A's filing by the USPTO, as A invented first, A can swear behind B's disclosure
- A gets patent

Analysis under the NEW rules

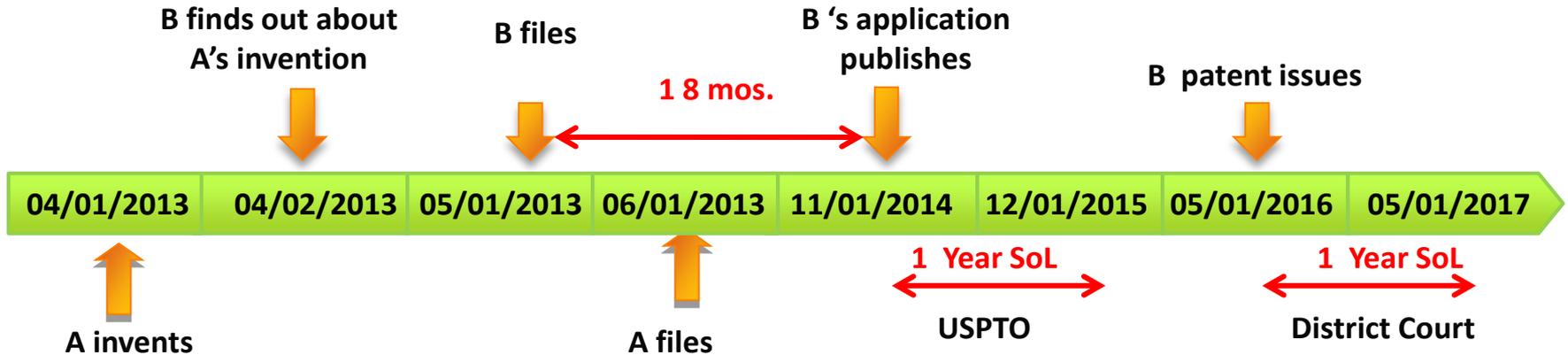
- B's disclosure of x' serves as prior art to A's filing of x
- if x is obvious over x' , then x is not patentable to A



Does the Inventor's Disclosure Shield the Claimed Invention from the Third Party's Intervening Disclosure under 102(b)(1)(B)?

inventor's prior public disclosure	third party's intervening disclosure	Does the inventor's prior public disclosure act as a shield?
X (e.g., a flat-head screw)	General category that includes X (e.g., a screw)	<u>Yes</u> . Rejection cannot be based on third party's disclosure of a general category that includes X.
X (e.g., a flat-head screw)	List of species that includes X (e.g., flat-head screw, Phillips head screw, and hex head screw)	<u>Partially</u> . Rejection can be based on third party's disclosure of other species, but not on the disclosure of X.
General category (e.g., screws)	A species within the general category (e.g., flat-head screw)	<u>No</u> . Rejection can be based on third party's disclosure of the species.

Example: Even a taker can win



Analysis under the OLD rules

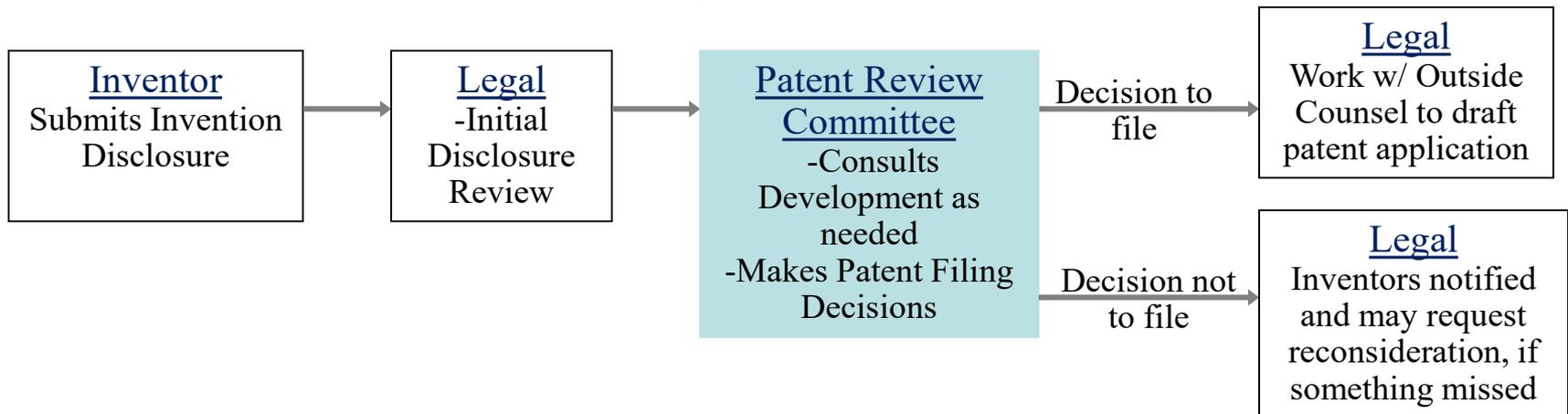
- Under 102(f), B did not invent, so his patent is invalid
- A Wins as first and true inventor

Analysis under the NEW rules

- Under 102(a)(2) B's filing is prior art to A's filing
- Under 35 USC 135 & 291, A must file derivation proceedings w/in 1 year of B's publication or w/in 1 year of B's patent issuing
- B wins as first to file, if A misses 1 year deadlines

Oracle Patent Process

- Inventor identifies Patentable Candidate
- Inventor's fills in Invention disclosure wizard at <http://www.oracle.com/webapps/token/fip>
- Patent Review Committee reviews and rates disclosures
- Outside Patent Attorney interview inventor(s) and writes up and files patent application
- Inventor receives monetary award

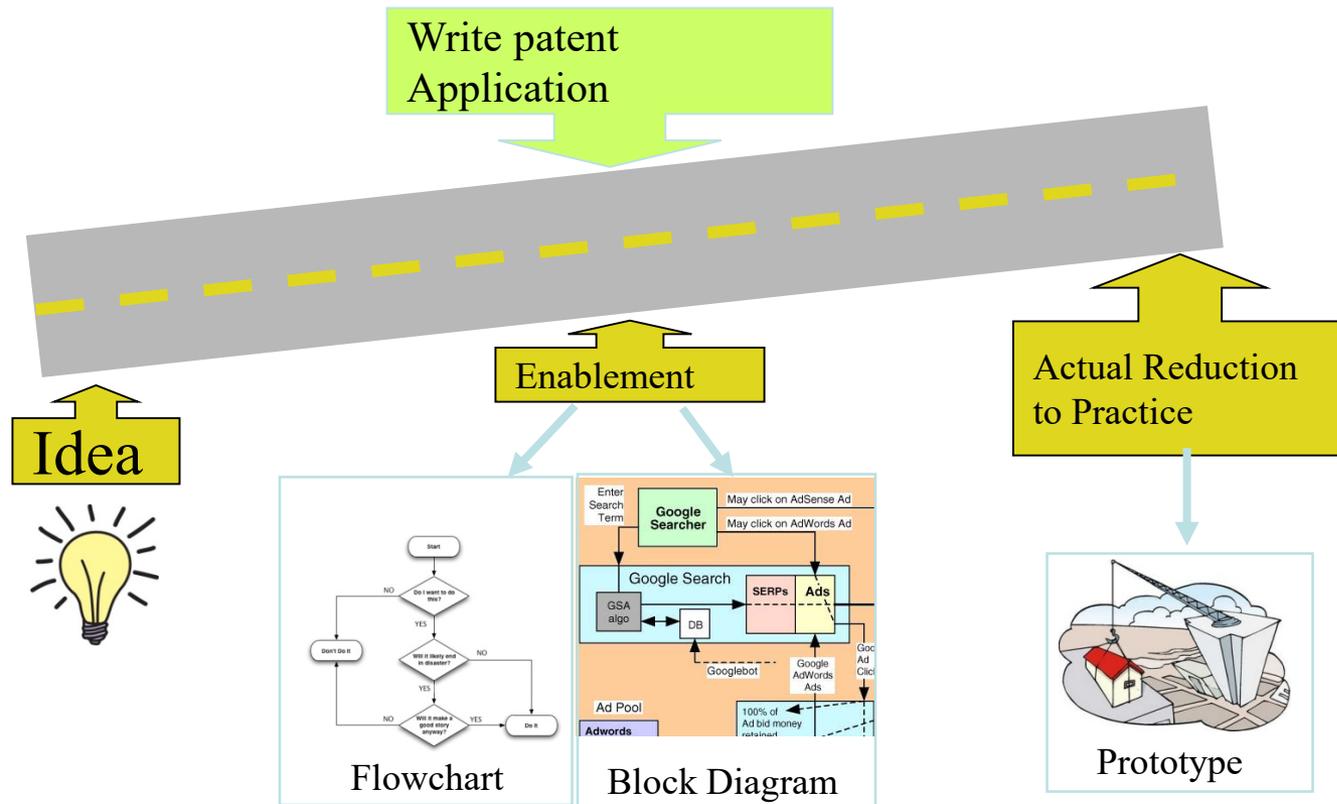


Test to Identify Patent Candidate

A candidate is a feature or an implementation of a feature. If the answers to all the questions below are yes, then your invention is a patent candidate. This information is at the request of Oracle Patent Counsel, who will perform a legal review for patentability.

- To your knowledge, is the candidate either new or an improvement over known industry solutions? [new]
- To your knowledge, is there a significant technical difference between the candidate and the prior industry solutions? [non-obvious]
- Do you have enough information to explain to a colleague how to build your invention, at least, at the functional level? [enabling]
- Does the candidate significantly add or enhance functions or features or significantly improve performance? [business value]

Enabling [or How Much Detail is Needed?]



When Must You File Your Patent?

- For the United States:
 - Within one year of your (not third party) first :
 - Public publication (e.g., journals, white papers, manuals) of the invention
 - Public use (e.g., trade shows, demos) of the invention
 - Sale of (or offer to sell) the invention
- In most other Foreign Countries:
 - Before any public publication or public use of the invention

Patent Bonus Program

- \$1500 per inventor upon filing of the utility patent application
 - Cap of \$4500 per patent application (e.g., for an application with 4 inventors, per inventor bonus becomes \$1125)
 - Subject to local law and Patent department discretion
- New Oracle Bonus program starts for applications filed after October 1, 2011.

Summary

- Old regime:
 - ❑ First inventor gets the patent, even if a later inventor files a patent application first, as long as the first inventor can prove earlier invention date and diligence (no unreasonable delay in filing)
 - ❑ Reliance on internal documentation (design specs, notebooks, invention disclosures, etc.) to show earlier invention date
- New regime (effective March 16, 2013):
 - ❑ **First patent filer gets the patent; date of invention is irrelevant**
 - Does not matter who thought of idea first
 - Practically, does not matter if someone took your idea and filed first
 - ❑ Third party public disclosures and patent filings before our filing can preclude or significantly limit what we can file
 - ❑ **Race to U.S. Patent Office – thus ...**
 - **Need to submit Invention Disclosures early**, so we can file patent applications early
 - For high valued ideas, file before third-party disclosure (even under NDA)

Q U E S T I O N S
&
A N S W E R S

Invention Disclosure Wizard:

<http://www.oracle.com/webapps/token/fip>