

PIPLA NEWS

The official newsletter of the Pittsburgh Intellectual Property Law Association

MARCH AWARDS DINNER & CLE

Wednesday, March 20, 2013

Wyndham Grand – King’s Garden, 2nd Floor
 600 Commonwealth Place
 Pittsburgh, PA 15222
 412-594-5124

5:30 p.m. – Registration (Cash Bar)
 6:00 p.m. – Dinner (Grand Buffet)
 6:45 p.m. – Awards Presentation
 7:15 p.m. – CLE

Payment Required - \$65-Dinner / *Free CLE courtesy of PIPLA*. Check payable to PIPLA. Mail to:

Ms. Pauline Moyles
 c/o The Webb Law Firm
 One Gateway Center, Ste. 1200
 420 Ft. Duquesne Blvd.
 Pittsburgh, PA 15222

OR Paypal via website: www.piplaonline.org (click on “March Awards Dinner & CLE”)

Speaker: Ms. Janet Gongola, USPTO Patent Reform Coordinator

Janet Gongola is the Patent Reform Coordinator and Associate Commissioner for Patent Examination Policy within the USPTO. The title of Ms. Gongola’s talk will be “*The New First To File Rules.*”

In her role as the Patent Reform Coordinator, Ms. Gongola manages all aspects of the agency’s implementation of the America Invents Act. In her role as the Associate Commissioner for Patent Examination Policy, Ms. Gongola is responsible for developing patent policy for the agency.

Previously, Ms. Gongola worked as an Associate Solicitor in the Office of the Solicitor at the USPTO where she provided legal advice to agency officials

and defended decisions of the Board of Patent Appeals and Interferences before the U.S. Court of Appeals for the Federal Circuit as well as district courts across the country.

Before joining the USPTO, Ms. Gongola served as a law clerk for Chief Judge Paul R. Michel at the Federal Circuit and for Chief Judge Sue L. Robinson in the U.S. District Court for the District of Delaware. In addition, Ms. Gongola worked as a patent attorney, patent agent, and research chemist at Eli Lilly and Company in Indianapolis, Indiana.

Ms. Gongola graduated summa cum laude with a J.D. from Indiana University School of Law—Indianapolis, and she received B.S. degrees in Chemistry and Mathematics from Muskingum University.

Ms. Gongola is an officer of the Giles S. Rich American Inn of Court. She is an adjunct professor at the George Mason University School of Law and the George Washington University Law School.

Upcoming: April 17, 2013 – Lunch Meeting (Duquesne Club)

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KEY AIA FIRST INVENTOR TO FILE ISSUES TO ADDRESS WITH CLIENTS

General:

- Changes in law may require changes in day-to-day procedures and strategies (*e.g.*, internal invention disclosure and patenting processes)
- New importance of filing date – clients must seek to identify and provide to counsel invention disclosures and other application materials in a timely manner; reasonable goals for filing deadlines must be set
- Applications governed by new, first-inventor-to-file laws will not be able to “swear behind” or antedate prior art
- Public uses, sales, offers for sale, etc. that take place anywhere in the world may now constitute prior art
- Published U.S. patent applications and PCT applications that designate the United States may be used as prior art against first-inventor-to-file applications as of the earliest priority date associated with the disclosure, rather than only as of the earliest effective U.S. filing date

New Critical Date:

- Applications filed until March 15, 2013 – critical date for determining patentability is the date of invention (*i.e.*, old rules), unless § 102(b) statutory bar date applies
- Applications filed on or after March 16, 2013 – critical date for determining patentability is the effective filing date (including effective foreign priority applications)
- Effective filing date is critical – Continuation and divisional applications may be subject to old laws if priority is claimed to an application filed before March 16, 2013
- Conversion of “old rules” application to “new rules” application:
 - Adding a single claim to new subject matter filed after March 16 (*e.g.*, in a

nonprovisional application or a CIP application)

- Adding claims to new matter
- Claiming priority to a first-inventor-to-file application
- (Deleting a claim to post 3/16 subject matter or the priority claim to a FITF application does **not** bring an application back under the old rules)

Strategic Considerations:

- For applications filed on or after 3/16 that have a priority date of 3/15 or earlier and that have additional subject matter beyond that disclosed in the priority application, the applicant may want to consider filing multiple applications to segregate claims within the two regimes (*i.e.*, claims with the pre-3/16 effective filing date may be segregated from those directed to the new material, such that the first to invent laws continue to govern the earlier subject matter)
- With importance of filing date, it may be worthwhile to streamline internal invention disclosure and patenting procedures to help ensure that the earliest filing date can be secured
- Importance of provisional applications – clients may wish to file multiple provisional applications as an invention is refined, thus locking in an early filing date for each major refinement of the invention. Provisionals may be better than public disclosure via publication, etc., because they allow the applicant to “undo” its disclosure (*i.e.*, the applicant can avoid publication of its invention by merely allowing the provisional application to expire). Further, if the applicant is interested in filing outside of the U.S., the provisional applications are preferable to publication, as many countries lack the “grace period” provisions of the U.S. patent law.

RECENTLY FILED IP CASES IN THE WESTERN DISTRICT OF PENNSYLVANIA

Case	Broadcast Music Inc. et al v. Bosa Nova LLC et al
Case Number:	2:13-cv-00335-MRH
Filed:	Thursday, March 07, 2013
Presiding Judge:	Judge Mark R. Hornak
Cause	Copyright Infringement

Case	Centria v. ATAS International Inc.
Case Number:	2:13-cv-00309-NBF
Filed:	Friday, March 01, 2013
Presiding Judge:	Judge Nora Barry Fischer
Cause	Patent Infringement

Case	Autosoft Inc. et al v. Autosoft DMS LLC et al
Case Number:	2:13-cv-00312-AJS
Filed:	Friday, March 01, 2013
Presiding Judge:	Judge Arthur J. Schwab
Cause	Trademark Infringement

Case	Purple Martin Conservation Association v. A. Paul Aranyos et al
Case Number:	1:13-cv-00057-SJM
Filed:	Friday, February 15, 2013
Presiding Judge:	Judge Sean J. McLaughlin
Cause	Trademark Infringement

Case	Excentus Corporation v. Giant Eagle Inc. et al
Case Number:	2:13-cv-00178-JFC
Filed:	Friday, February 01, 2013
Presiding Judge:	Judge Joy Flowers Conti
Cause	Patent Infringement

Case	Cold Steel Inc. v. RTZ Distribution LLC dba Hallmark Cutlery
Case Number:	2:13-cv-00141-JFC
Filed:	Tuesday, January 29, 2013
Presiding Judge:	Judge Joy Flowers Conti
Cause	Patent Infringement

Case	M.D.C. Romani Inc. v. Curtis Harvey et al
Case Number:	2:13-cv-00147-NBF
Filed:	Tuesday, January 29, 2013
Presiding Judge:	Judge Nora Barry Fischer
Cause	Trademark Infringement

FROM THE NEWSLETTER COMMITTEE

We hope you've enjoyed this issue of the 2012/2013 PIPLA News, an informative and hopefully entertaining look at the goings on in IP law. We invite our entire readership to contribute to this endeavor with articles, announcements, and job postings of your own. If you have something you would like included in PIPLA News or have questions about how you can contribute, please contact Matt Johnson at 412-394-9524 or at mwjohnson@jonesday.com.

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