

UNITED STATES OF AMERICA

Status as of May 2005

FEATURES	STATUS	CHANGES IN LAWS SINCE 1990
Types of protection for inventions	<ul style="list-style-type: none"> • Patents • Trade secrets • Design patents 	N.A
Term of protection	<ul style="list-style-type: none"> • Patents: 20 years from the filing date • Trade secrets: indefinite • Design patents: 14 years from the date of grant • Extension of patent term is possible on the following grounds: <ul style="list-style-type: none"> - Regulatory approval for pharmaceuticals - Patent Office delay 	June 8, 1995 – The patent term was changed from 17 years from the date of issue to 20 years from the filing date.
Subject matters excluded from patentability or not considered to be inventions	<ul style="list-style-type: none"> • The following subject matters are not considered to be inventions: <ul style="list-style-type: none"> - Scientific theories/mathematical methods - Mental acts - Presentation of information - Traditional knowledge 	No
Filing language	<ul style="list-style-type: none"> • Filing an application in languages other than an official language is possible. The time limit to provide translation into an official language is 2 months. 	No
Certain requirements relating to filing	<ul style="list-style-type: none"> • The inventor rarely waives his right to be mentioned in the patent. 	June 8, 1995 – The option to file provisional applications was introduced.
	<ul style="list-style-type: none"> • It is possible to file provisional applications. An applicant may convert a provisional application to a non-provisional application and may claim priority to an earlier-filed provisional application. The life cycle of the provisional application is one year. 	
	<ul style="list-style-type: none"> • The most frequent route used by foreign applicants to file patent applications is the Paris Convention. 	

Link between different inventions in the same application	<ul style="list-style-type: none"> • The applicable law permits the Patent Office to restrict the claims in a patent application to a single invention only, and allows that the claims in a patent application filed under the PCT relate to a group of inventions according to the unity of invention standard. 	January 14, 1993 – Regulations amended to conform to amended PCT Rule 13.
Publication	<ul style="list-style-type: none"> • The information related to the application is published or open for public access 18 months from the filing date or from the priority date and when the patent is granted. 	November 2, 1999 – Introduction of a pre-grant publication system. Before that date, the information related to the application was published only after the grant of the patent.
Classification system	<ul style="list-style-type: none"> • The patent classification system used is the national patent classification system. 	N.A
Search and examination	<ul style="list-style-type: none"> • The applicable law establishes a substantive search and examination system. • Search and examination are combined. The filing of an application automatically implies an examination for both patents and design patents. • During the examination procedure, the following criteria are examined: For patents: - Novelty - Inventive step/non obviousness - Industrial applicability/utility - Written description - Enablement - Best mode - Definiteness of claims For design patents: - Novelty - Inventive step/non obviousness - Ornamentality - Enablement - Definiteness of claims 	No

<p>Specific legal provision regarding ownership of patents derived from public (government) research funding</p>	<ul style="list-style-type: none"> ● Yes – The Bayh-Dole Act promotes the utilization of inventions arising from federally supported research or development, and the collaboration between commercial concerns and non profit organizations, including universities. 	<p>No</p>
<p>Exceptions to exclusive rights conferred by a patent</p>	<ul style="list-style-type: none"> ● There are exceptions to the exclusive rights conferred by a patent as follows: <ul style="list-style-type: none"> - Compulsory licenses - Governmental use - Research and/or experimental exception - Clinical trials for the purpose of obtaining a generic drug’s regulatory approval - Prior user’s right 	<p>November 29, 1999 – Introduction of the prior user’s right exception (First Inventor Defense).</p>
<p>Options to challenge a patent</p>	<ul style="list-style-type: none"> ● There are different options to challenge a patent as follows: <ul style="list-style-type: none"> - Post-grant administrative/quasi judicial procedure (reexamination) within the validity period of the patent - Court procedure 	<p>November 2, 2002 – Amendment of the reexamination statute to expand the basis for reexamination. The change in the law permits third party requestors dissatisfied with the decision in an appeal to the Board of Patent Appeals and Interferences to appeal to the Court of Appeals for the Federal Circuit. Moreover, the 2002 change in law permits raising a substantial new question of patentability even where supported by a patent or printed publication previously cited by or to the Office or considered by the Office.</p> <p>November 29, 1999 – Introduction of the “inter partes” reexamination in addition to the “ex-partes” option.</p>