GenomeQuest

THE *AMERICA INVENTS ACT* AND IP SEQUENCE SEARCHING

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On September 16, 2011, President Obama signed the America Invents Act (AIA) into law. This law globalizes the U.S. patent system, transforming it from a first-to-invent to a first-inventor-to-file system, and is effective as of March 16, 2013. The law has dramatic implications to intellectual property strategy and such implications broadly apply to the intellectual property of biological sequences.

First and foremost, any inventor who wants to take advantage of the expiring first-to-invent law must file urgently to beat the March 16, 2013 deadline. A corporate-wide patentability search across the organization's sequence IP should be performed promptly, with particular examination of the oldest unpatented sequences that have been discovered as these will be at greatest risk following the change to a first-to-file system.

On and after March 16, 2013, even if your organization may have been first to invent, competitors can claim inventions as their own if they are first to file that invention. While you will be able to file derivation proceedings to combat, the strict one-year time limitation to file such proceedings demands a step-up in the regularity of freedom-to-operate searches. It is widely recommended that broad-based freedom-to-operate searches should be performed on all biological sequences relating to active commercial endeavors.

The AIA also changes laws around prior art, which will no longer have geographical restrictions. U.S. patent applications that claim some foreign priority date will be prior art as of the filing date of the foreign application. This means that previous biological sequence prior art searches in the U.S. patent body need to be revisited as priority dates may have shifted due to foreign prior art.

Finally, the new laws also allow for challenges to granted patents on any patentability grounds, from obviousness to fraud to incorrect inventorship. This is a dramatic change from the past, where granted patents could only be challenged with newly discovered prior art. Such challenges, or petitions for review, must be filed within nine months after the patent grant. During this time, challenged patents are not considered granted. This has strong implications both for offensive and defensive strategies.

Overall, the AIA stands to normalize our patent system with the rest of the world and should benefit the life sciences by providing more objective predictability, transparency, and efficiency. But just as these improvements benefit biotechnology, they will in one moment permanently alter the contour of IP landscape of patented biological sequences and beyond. GenomeQuest's GQ-Pat database can help organizations to map the new landscape.

CONTACT

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