ベストモード開示要件

- ・発明者が最良と信じる発明の態様を記載しなければならない要件。出願時に発明者がベストモードを知っていたか、当業者が実施出来る程度にベストモードが記載されたかが判断される。
- ・拒絶理由としては残っているが、法改正により、特許後は、ベストモード要件違反が理由で無効になったり、権利行使不能になることは無くなった。

SEC. 15. BEST MODE REQUIREMENT.

- (a) IN GENERAL.—Section 282 of title 35, United States Code, is amended in the second undesignated paragraph by striking paragraph (3) and inserting the following:
- (3) Invalidity of the patent or any claim in suit for failure to comply with—
- (A) any requirement of section 112, except that the failure to disclose the best mode shall not be a basis on which any claim of a patent may be canceled or held invalid or otherwise unenforceable; or
- (B) any requirement of section 251.".
- (b) CONFORMING AMENDMENT.—Sections 119(e)(1) and 120 of title 35, United States Code, are each amended by striking "the first paragraph of section 112 of this title" and inserting "section 112(a) (other than the requirement to disclose the best mode)".
- (c) EFFECTIVE DATE.—The amendments made by this section shall take effect upon the date of the enactment of this Act and shall apply to proceedings commenced on or after that date.

宣誓書・宣言書の提出要件

- 提出期間が緩和 特許許可通知(Notice of Allowance)の発行まで(35 U.S.C. 115(f))
- 発明者が死亡した場合、法律上の行為能力喪失者である場合には、出願人による 代替供述書(Substitute Statement)の提出が認められる(35 U.S.C. 115(d))。改正 前は、法定代理人による宣誓だった。
- ・宣誓書/宣言書、代替供述書に関する問題が原因で特許が無効になったり、権利行 使不能になることは無い。

35 U.S.C. 115(d) SUBSTITUTE STATEMENT.—

- (1) IN GENERAL.—In lieu of executing an oath or declaration under subsection (a), the applicant for patent may provide a substitute statement under the circumstances described in paragraph (2) and such additional circumstances that the Director may specify by regulation.
- (2) PERMITTED CIRCUMSTANCES.—A substitute statement under paragraph (1) is permitted with respect to any individual who—
- (A) is unable to file the oath or declaration under subsection (a) because the individual—
- (i) is deceased;
- (ii) is under legal incapacity; or
- (iii) cannot be found or reached after diligent effort; or
- (B) is under an obligation to assign the invention but has refused to make the oath or declaration required under subsection (a).
- (3) CONTENTS.—A substitute statement under this subsection shall—
- (A) identify the individual with respect to whom the statement applies;
- (B) set forth the circumstances representing the permitted basis for the filing of the substitute statement in lieu of the oath or declaration under subsection (a); and
- (C) contain any additional information, including any showing, required by the Director.

35 U.S.C. 115(f) TIME FOR FILING.— A notice of allowance under section 151 may be provided to an applicant for patent only if the applicant for patent has filed each required oath or declaration under subsection (a) or has filed a substitute statement under subsection (d) or recorded an assignment meeting the requirements of subsection (e).

特許表示•虚偽表示

- •インターネットを通じたバーチャル表示も特許表示の対象(35 U.S.C. 287)
- ・虚偽表示に対する訴訟提起条件変更(マーキングトロール防止、35 U.S.C. 292) Qui Tam actionが出来る主体は合衆国政府のみ。

虚偽表示によって競争阻害された者は、損失補填の訴訟提起可

SEC. 16. MARKING.

- (a) VIRTUAL MARKING.—
- (1) IN GENERAL.—Section 287(a) of title 35, United States Code, is amended by striking "or when," and inserting "or by fixing thereon the word 'patent' or the abbreviation 'pat.' together with an address of a posting on the Internet, accessible to the public without charge for accessing the address, that associates the patented article with the number of the patent,

or when,".

- (2) EFFECTIVE DATE.—The amendment made by this subsection shall apply to any case that is pending on, or commenced on or after, the date of the enactment of this Act.
- (3) REPORT.—Not later than the date that is 3 years after the date of the enactment of this Act, the Director shall submit a report to Congress that provides—
- (A) an analysis of the effectiveness of "virtual marking", as provided in the amendment made by paragraph (1) of this subsection, as an alternative to the physical marking of articles;
- (B) an analysis of whether such virtual marking has limited or improved the ability of the general public to access information about patents;
 - (C) an analysis of the legal issues, if any, that arise from such virtual marking; and
- (D) an analysis of the deficiencies, if any, of such virtual marking.
- (b) FALSE MARKING.—
- (1) CIVIL PENALTY.—Section 292(a) of title 35, United States, Code, is amended by adding at the end the following: "Only the United States may sue for the penalty authorized by this subsection.".
- (2) CIVIL ACTION FOR DAMAGES.—Subsection (b) of section 292 of title 35, United States Code, is amended to read as follows:
- "(b) A person who has suffered a competitive injury as a result of a violation of this section may file a civil action in a district court of the United States for recovery of damages adequate to compensate for the injury."
- (3) EXPIRED PATENTS.—Section 292 of title 35, United States Code, is amended by adding at the end the following:
- "(c) The marking of a product, in a manner described in subsection (a), with matter relating to a patent that covered that product but has expired is not a violation of this section."
- (4) EFFECTIVE DATE.—The amendments made by this subsection shall apply to all cases, without exception, that are pending on, or commenced on or after, the date of the enactment of this Act.

先使用の抗弁拡大

- ・適用対象技術が、ビジネス方法特許から、総ての技術分野に拡大
- •基準日

改正前 クレーム主題の有効出願日よりも1年以上前 改正後 有効出願日 又は 102条(b)の例外規定に基づくクレーム主題公表日 のいずれか早い日から1年以上前

対象 米国内で、善意(日本の善意と同じでない)で且つ、商業的な 使用。

SEC. 5. DEFENSE TO INFRINGEMENT BASED ON PRIOR COMMERCIAL

USE. "(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.

特許法保護対象除外

税金対策に関する発明は、特許法の保護対象から除外。

SEC. 14. TAX STRATEGIES DEEMED WITHIN THE PRIOR ART.

- (a) IN GENERAL.—For purposes of evaluating an invention under section 102 or 103 of title 35, United States Code, any strategy for reducing, avoiding, or deferring tax liability, whether known or unknown at the time of the invention or application for patent, shall be deemed insufficient to differentiate a claimed invention from the prior art.
- (b) DEFINITION.—For purposes of this section, the term "tax liability" refers to any liability for a tax under any Federal, State, or local law, or the law of any foreign jurisdiction, including any statute, rule, regulation, or ordinance that levies, imposes, or assesses such tax liability.
- (c) EXCLUSIONS.—This section does not apply to that part of an invention that—
- (1) is a method, apparatus, technology, computer program product, or system, that is used solely for preparing a taxor information return or other tax filing, including one that records, transmits, transfers, or organizes data related to such filing; or
- (2) is a method, apparatus, technology, computer program product, or system used solely for financial management, to the extent that it is severable from any tax strategy or does not limit the use of any tax strategy by any taxpayer or tax advisor.
- (d) RULE OF CONSTRUCTION.—Nothing in this section shall be construed to imply that other business methods are patentable or that other business method patents are valid.
- (e) EFFECTIVE DATE; APPLICABILITY.—This section shall take effect on the date of the enactment of this Act and shall apply to any patent application that is pending on, or filed on or after, that date, and to any patent that is issued on or after that date.

人体組織を含む発明は、特許法の保護対象から除外。

SEC. 33. LIMITATION ON ISSUANCE OF PATENTS.

- (a) LIMITATION.—Notwithstanding any other provision of law, no patent may issue on a claim directed to or encompassing a human organism.
- (b) EFFECTIVE DATE.—
- (1) IN GENERAL.—Subsection (a) shall apply to any application for patent that is pending on, or filed on or after, the date of the enactment of this Act.
- (2) PRIOR APPLICATIONS.—Subsection (a) shall not affect the validity of any patent issued on an application to which paragraph (1) does not apply.

手数料設定

・米国特許商標庁(USPTO)に手数料の設定/変更する権限付与 (2011年9月16日から)

•主な手続の料金引き上げ(2011年9月26日から)

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出願手数料 $330 → $380
調査手数料 $540 → $620
審査手数料 $220 → $250
マルチディペンドクレーム $390 → $450
仮出願 $220 → $250
継続審査要求(RCE) $810 → $930
特許発行手数料 $1,510 → $1,740
特許維持費(3.5年) $980 → $1,130
特許維持費(7.5年) $980 → $1,130
特許維持日(11.5年) $4,110 → $4,730
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・電子出願の奨励、紙出願のペナルティ:\$400(2011年11月15日から)

2011年9月26日 施行

優先審査制度

- ・出願人が追加料金(\$4,800)を支払って申請することにより、他の出願に優先して審査が行われる。
- 独立請求項:4以下、総請求項数:30以下、マルチディペンドクレーム無しの条件。

2011年9月26日 施行

極小事業体への割引制度

・マイクロエンティティ(極小事業体)は、手数料が75%割引 米国出願件数が4件以下 年収が米国の平均世帯年収の3倍(\$150,000)を越えない者

補充審査制度 35 U.S.C. 257 Supplemental Examination

- ・先行技術文献、宣言書など、特許に関連する情報について補充審査 を請求出来る制度で、例えば、特許後に、不衡平行為(Inequitable Conduct)の治癒を求めることが出来る。
- 提出された情報について、特許性に関わる実質的に新たな問題 (Substantial New Question: SNQ)を提起するか否かについて、 請求日から3ヶ月以内に審査が完了する。
- •SNQが認められると、査定系再審査(Ex Parte Reexanimation)に 移行する。
- (a) REQUEST FOR SUPPLEMENTAL EXAMINATION.—A patent owner may request supplemental examination of a patent in the Office to consider, reconsider, or correct information believed to be relevant to the patent, in accordance with such requirements as the Director may establish. Within 3 months after the date a request for supplemental examination meeting the requirements of this section is received, the Director shall conduct the supplemental examination and shall conclude such examination by issuing a certificate indicating whether the information presented in the request raises a substantial new question of patentability.

第三者による異議申立制度

第三者による異議申立制度

- 2011年の改正前(2012年9月16日施行前)
- ①第三者情報提供(Third-Party Submission, 37 C.F.R. 1.99)
- ②プロテスト(Protest, 37 C.F.R. 1.291)
- ③査定系再審査(Ex Parte Reexamination, 35 U.S.C. 301-307) 特許付与後/特許・刊行物に基づく無効理由/第三者の参加制限有り
- ④当事者系再審査(Inter Parte Reexamination, 35 U.S.C. 311-318) 特許付与後/特許・刊行物に基づく無効理由、112条の無効理由

2011年の改正後(2012年9月16日施行後)

- ①第三者情報提供(Third-Party Submission, 新35 U.S.C. 122(e))
- ②査定系再審査(Ex Parte Reexamination, 35 U.S.C. 301-307)
- ③特許付与後レビュー(Post-grant review, 新35 U.S.C. 321-329)特許付与又は再発行から9月以内ベストモード要件以外の無効理由
- ④当事者系レビュー(Inter Partes review, 新35 U.S.C. 311-319) 特許発行後9月経過後、付与後レビュー終結後 特許・刊行物に基づく無効理由

先願主義への移行

・先発明主義から先願主義へ移行

有効出願日が施行日(2013年3月16日)以前の場合は、旧法が適用される。

施行日以前に出願された特許出願であっても、有効出願日が施行日以降となるクレームを1つでも包含した場合は、改正法が適用される。

グレースピリオド期間や、先行技術排除要件が他国と異なるので、似て非なる先願主義であることに注意。

- 発明の先後を争うInterference制度が無くなり、真の出願人を決定し 冒認出願を排除する為の手続(Derivation Proceedings)に代わる (新35 U.S.C. 135)。
- ・外国出願にも後願排除効が認められるようになり、ヒルマードクトリンの問題は解消。

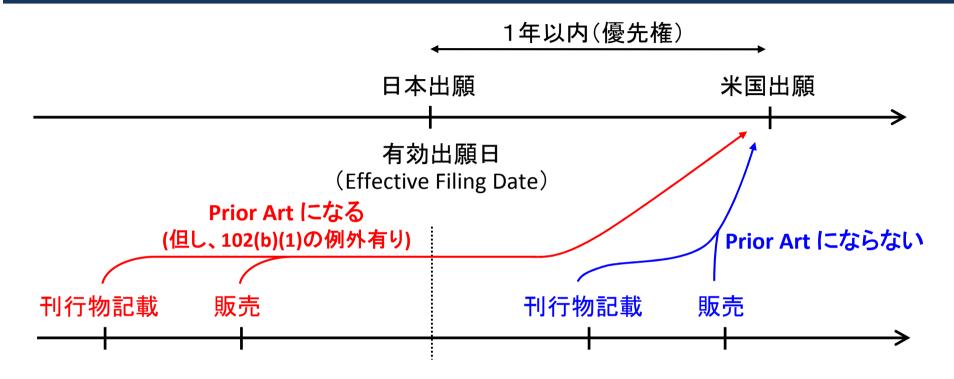
新規性の要件整理

時期/地域	項	新規性喪失行為	備考
有効出願日前	102(a)(1)	公開•公用•販売•公知	
地域限定無し	102(a)(2)	他人の出願にかかる公報	

時期/地域	項	新規性喪失の例外行為	備考
有効出願日前 1年以内 地域限定無し	102(b)(1)(A)	発明知得者による開示	102(a)(1)の例外
	102(b)(1)(B)	他人による開示(その前に、 発明知得者による開示有)	
有効出願日前 地域限定無し	102(b)(2)(A)	発明知得者による出願	102(a)(2)の例外
	102(b)(2)(B)	他人による出願(その前に、 発明知得者による開示有)	
	102(b)(2)(C)	譲渡義務者による出願	

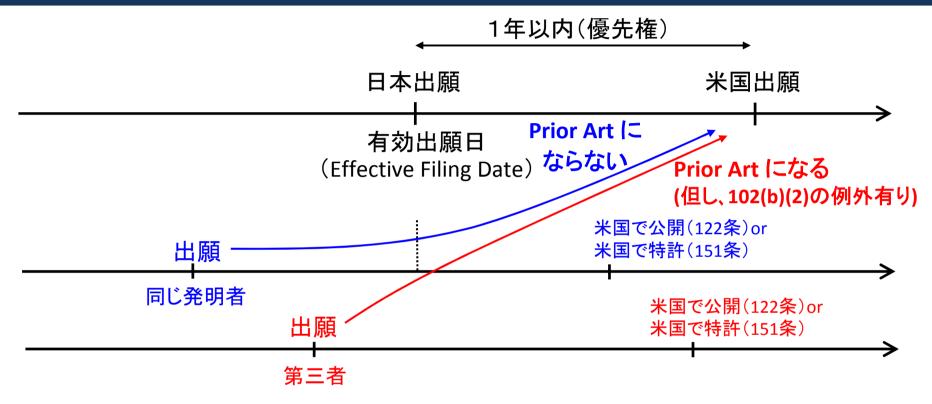
有効出願日が2013年3月16日以降のものに適用される。

35 U.S.C. 102(a)(1)



- (a) Noveltiy; Prior Art A person shall be entitled to a patent unless –
- (1) the clamed 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 クレームされた発明が、その発明の有効出願日よりも前に、特許されているか、印刷された刊行物 (printed publication)に記載されているか、公用された状態にあるか、販売されているか、公で使用可能な状態(available to the public)場合でなければ、特許される。

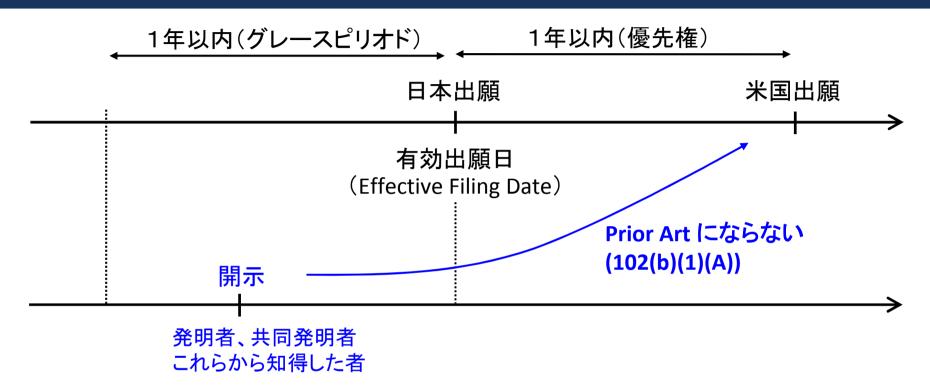
35 U.S.C. 102(a)(2)



- (a) Noveltiy; Prior Art A person shall be entitled to a patent unless –
- (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.

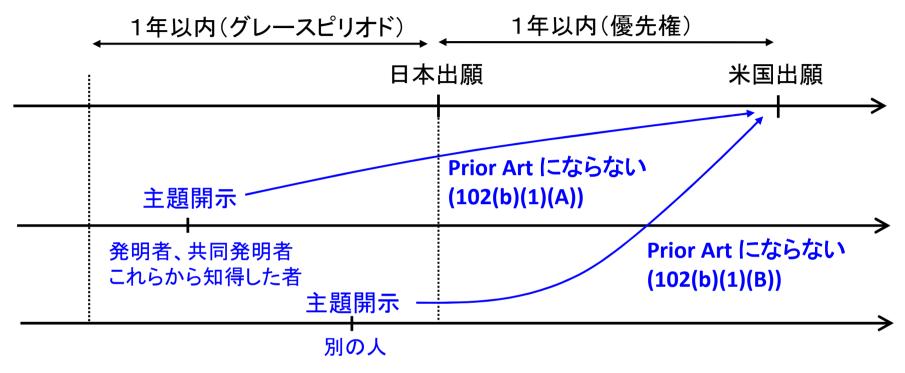
クレームされた発明が、151条に基づいて発行された特許か、122条(b)に基づいて発行されたか発行されたと見なされた特許出願であって、その特許や出願が事情に応じて他の発明者の名を付けたものであって、その発明の有効出願日よりも前に有効に出願されたものに記載された場合でなければ、特許される。

35 U.S.C. 102(b)(1)(A)



- (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 クレームされた発明の有効出願日前の1年以内になされた開示行為であって、発明者か、共同発明者か、発明者若しくは共同発明者から直接的若しくは間接的に開示された主題(subject matter)を得た他の者によってされた場合、かかる開示行為は、(a)(1)のprior artにならない。

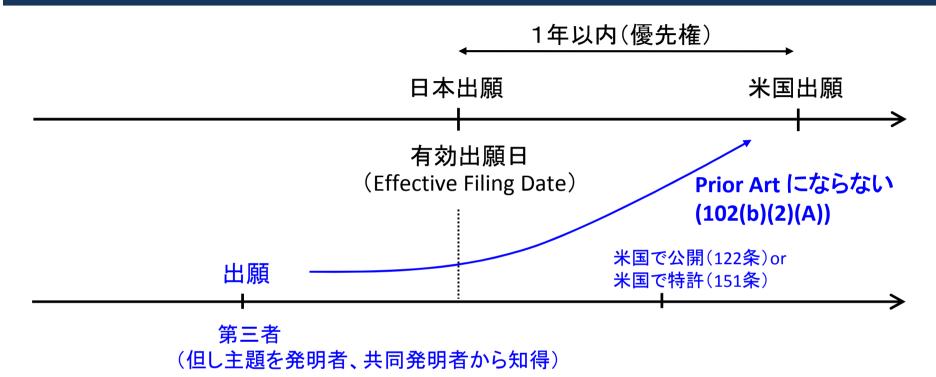
35 U.S.C. 102(b)(1)(B)



- (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 --
- (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.

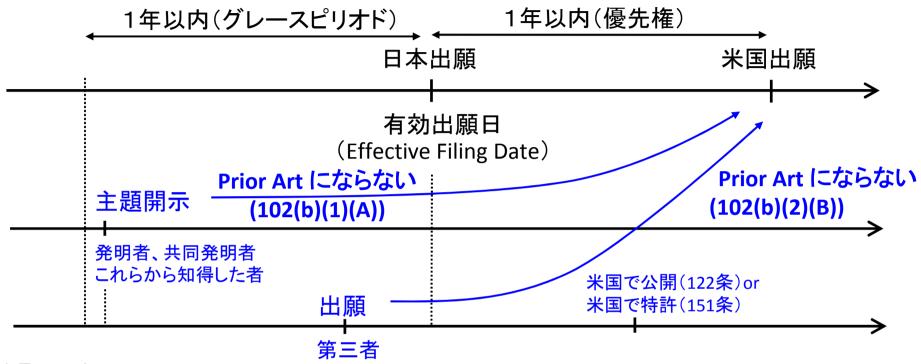
(第三者による)当該開示行為の前に、その開示された主題が、発明者か、共同発明者か、発明者若しくは共同発明者から直接的若しくは間接的に開示された主題(subject matter)を得た他の者によって公に開示された場合、かかる(第三者による)開示行為は、(a)(1)のprior artにならない。

35 U.S.C. 102(b)(2)(A)



- (b) Exceptions-
- (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 invention; (第三者の出願に基づいて)開示された主題が、発明者か共同発明者から直接的若しくは間接的に得られたものである場合、かかる開示行為は、(a)(2)のprior artにならない。

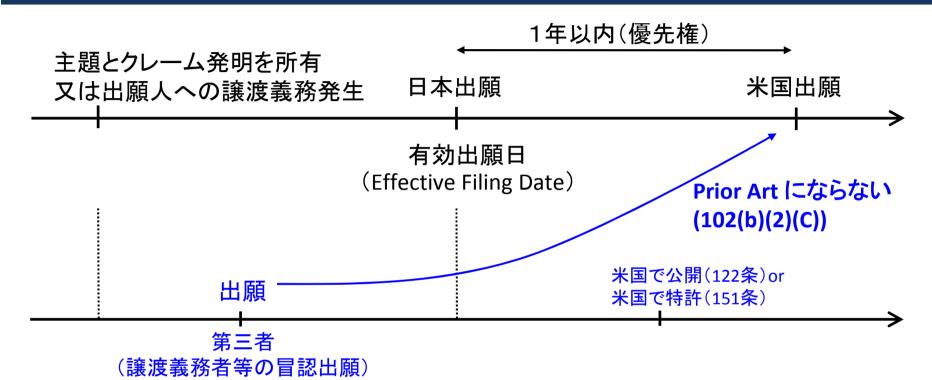
35 U.S.C. 102(b)(2)(B)



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

(第三者の出願に基づいて)開示された主題が、102条(a)(2)に基づいて有効に出願される前に、発明者か、共同発明者か、発明者若しくは共同発明者から直接的若しくは間接的に開示された主題を得た他の者によって公に開示された場合、かかる(第三者の出願に基づく)開示行為は、(a)(2)のprior artにならない。

35 U.S.C. 102(b)(2)(C)



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

(第三者の出願に基づいて)開示された主題やクレームされた発明が、クレームされた発明の有効出願日よりも遅くなく(つまり、先に)、(出願人と)同一人によって所有されていたか、又は(出願人と)同一人への譲渡義務が課せられていた場合、かかる(第三者の出願に基づく)開示行為は、(a)(2)のprior artにならない。