

# Want a patent? New law gives inventors reason to file fast

**EDITOR'S NOTE:** This is the latest in a series of stories this year about patent law in South Florida.

BY PAJUL BRINKMAN

Scripps Florida, one of South Florida's biggest patent generators, is among the many companies and institutions gearing up for "first to file" changes in U.S. patent law, which go into effect March 16.

Many law firms are also dealing with more questions and patent applications in advance of the change.

The changes, under the 2011 Leahy-Smith America Invents Act, are designed to reduce

patent litigation and harmonize U.S. law with global practices.

The new law awards patents to the first qualified applicant to seek a patent on an invention, rather than the more ambiguous "first to invent" that's historic in the U.S. Until now, the U.S. has been unique in not having a "first to file" system.

### 'AN IMPORTANT STEP FORWARD'

In some ways, big research groups like Scripps already aimed for "first to file" status because they wanted their patents to be enforceable worldwide.

But Scripps is mounting an internal educa-

tion campaign to inform researchers about the impact of the change, said Thomas Fitting, chief patent counsel for the Scripps Research Institute in La Jolla, Calif.

"First of all, the new law may be controversial, but it's an important step forward," he said in an interview. "I'm very much in favor of it generally."

However, there is some concern that U.S. scientists must now be more careful about publishing purely scientific papers on the re-



Fitting

search they are conducting, he said.

In the past, scientists in the U.S. could publish purely scientific research without significant fear that others would use those findings to apply for specific patents. Now, however, there is a greater risk that someone could beat Scripps – or any research institution – to the patent office.

"Scientists at Scripps are pretty knowledgeable, but there are inadvertent mistakes where you don't realize your research is seminal," Fitting said.

The new law also beefs up the ability to challenge patents based on "prior art" or prior descriptions of an invention, but most scientific research publications are geared more toward pure science, he said.

And it's not just scientific papers that could leak valuable information. Scientists will have to be on guard when they announce interesting research via lectures, posters or even Facebook and Twitter.

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## THE DETAILS

# Bracing for the changes

South Florida law firms are blasting out the information about patent law changes:

■ Chicago-based Amstein & Lehr patent attorney David Newman authored an email alert about "first to file," encouraging anyone with a patent idea to come in quickly for advice.

■ William Trueba, of Miami-based Espinosa Trueba, said many research and development companies operating only in the U.S. have often waited until they are ready to go commercial to file patents, to maximize the time products are covered by a patent while on the market. Now, some companies will rush to the patent office to be first to file.

■ Alan Weisberg, of Fort Lauderdale-based Christopher & Weisberg, who is handling a "mini-rush" of patent filings, said: "We have some independent inventors who are sensitive to it, and want to deal with filing now. But most of our clients are large, institutional clients, where they have disclosures in-house, and they want to file everything first and deal with whether there's merit to the idea later."



Newman



Trueba



Weisberg