Certainty + More Prior Art: While I'm concerned about the effect of first-to-file on small inventors, I am pleased that the rule will expand the universe of art that might invalidate obvious patents. Too often, art found within a year of filing is rendered uncertain because the defendant does not know the date of invention. By fixing the cutoff date at filing, the universe of prior art not only grows, but the administrative cost of asserting that art is also decreased. To be sure, some of the obviousness art may come after the invention date, but I'm not so worried about that; after all, simultaneous invention is a consideration for obviousness, so close in time inventions, even if after the patentee's, do not present a great harm to a system that is supposed to reward nonobvious advances. - Professor Michael Risch, Villanova University School of Law

Impact on NPEs: Early reports say that the new law will "do nothing" to impact NPEs. They are wrong. The law will forbid the NPE tactic of naming unrelated companies in a single lawsuit, and the economies of scale it produces. Innocent early infringement done in private, under certain circumstances, won't be penalized anymore. A follow-up study on prior user rights and the impact of NPE litigation are called for. The PTO has expanded fee-setting authority, and the public, a greater right to chime in on questionable patents. As the economics of litigation change, so, necessarily, will the business models based on them. - Professor Colleen Chien, Santa Clara University School of Law

Deceptive Intent: There has been little commentary on the new law's rather quiet removal of all seven occurrences of "without deceptive intention" from the statute. These are for: Inventorship changes (Secs. 116 and 256); reissue (Sec. 251); filing a disclaimer (Sec. 253); suing on a patent containing an invalid claim (Sec. 288); and foreign filing without a license (Secs. 184, 185). It was probably not done to encourage deceptive conduct, but to limit fights over mental state in these areas. - Professor Paul M. Janicke, University of Houston Law Center

Natural Experiment: As someone who practiced patent law for over 10 years before entering academics, I am ambivalent at best about the passage of the America Invents Act. Unfortunately, we missed an opportunity to meaningfully address fee diversion from the Patent Office, one of the most important issues facing the patent system. With a backlog of over 700,000 applications, the Patent Office needs to retain all the fees it collects. As an outside academic observer of the patent system, however, there is a benefit to the America Invents Act. Changing the patent laws provides me and others the chance to empirically evaluate the effects, if any, of legal changes on the patent system. – Professor David L. Schwartz, IIT Chicago-Kent College of Law

Date of Public Disclosure: The Congressional language about "first-to-file system" is somewhat misleading. The text of the bill, and floor remarks of Sen. Kyl, make clear that the key date is either an inventor's filing date or an inventor's earlier public disclosure date, provided the
disclosing inventor follows up by filing within a year of the disclosure. In the latter event, the patent would not go to the first to file, but to the first to publicly disclose. - Professor Paul M. Janicke, University of Houston Law Center

Value of Secrecy: Information about new inventions is critical to technological progress. By increasing the value of secrecy as an option for monetizing inventions, the Leahy-Smith America Invents Act represents a step backwards in terms of information dissemination. The prior user defense created by the Act recalibrates inventors' decision between secrecy and patenting so as to favor the choice of secrecy. This shift has the potential to reduce the number of patents that are filed on secret inventions (and the mandatory disclosures that accompany those patents), as well to encourage inventors to direct their investments in research towards secret inventions as opposed to those that require patents to monetize. – Professor Jason Rantanen, University of Iowa College of Law

Inequitable Conduct: The doctrine of inequitable conduct exists in part to encourage patent applicants to internalize some of the costs of the patent system and ensure applicant candor. The Federal Circuit in Therasense recently took aggressive steps to relieve patent applicants of some of these obligations. The Leahy-Smith America Invents Act pushes in the same direction. With two limited exceptions, it provides that "A patent shall not be held unenforceable on the basis of conduct relating to information that has not been considered, was inadequately considered, or was incorrect in a prior examination of a patent if the information was considered...during a supplemental examination of a patent." New 35 U.S.C. § 257(c)(1). This provision appears to effectively empower patent owners with the ability to strategically manipulate disclosures to the PTO. – Professors Lee Petherbridge, Loyola Law School Los Angeles and Jason Rantanen, University of Iowa College of Law