



AMERICA INVENTS ACT

IMPLEMENTATION

Welcome

America Invents Act Public Forum

Friday, March 15, 2013

Public Forum Agenda

Time	Topic
1:00 PM to 1:15 PM	Opening Remarks <i>Acting Under Secretary of Commerce for Intellectual Property and Acting Director of the USPTO Teresa Stanek Rea</i>
1:15 PM to 2:30 PM	First Inventor to File Final Rules and Guidance <i>Mary Till, Senior Legal Advisor Kathleen Fonda, Senior Legal Advisor Office of Patent Legal Administration</i>
2:30 AM to 2:45 AM	BREAK
2:45 PM to 3:55 PM	Micro Entity and Patent Fees: Final Rules <i>James Engel, Senior Legal Advisor Office of Patent Legal Administration Michelle Picard, Senior Advisor for Financial Management Office of the Chief Financial Officer</i>
3:55 PM to 4:00 PM	Closing Remarks





AMERICA INVENTS ACT

IMPLEMENTATION

Introductory Remarks

*Acting Under Secretary of Commerce for Intellectual
Property and Acting Director of the USPTO
Teresa Stanek Rea*



AMERICA INVENTS ACT

IMPLEMENTATION

Status Report

Janet Gongola
Patent Reform Coordinator

AIA Enactment Timeline

Day of Enactment
Sept 16, 2011

Reexamination transition for threshold

Tax strategies are deemed within prior art

Best mode

Human organism prohibition

OED statute of limitations

10 Days
Sept 26, 2011

Prioritized Examination

15% transition Surcharge

Oct 1, 2011

Reserve Fund

60 Days
Nov 15, 2011

Electronic filing incentive

12 Months
Sept 16, 2012

Inventor's oath/declaration

Preissuance submission

Supplemental examination

Citation of prior art in a patent file

Inter partes review

Post-grant review

Transitional post-grant review program for covered business method patents

18 Months
Mar 2013

First inventor to file

Derivation proceedings

Repeal of statutory invention registration

New patent fees

Micro entity discount

← **Provisions are enacted**



Prioritized Exam Statistics

(Data from Sept 26, 2011 to Feb19, 2013)

Petitions Filed	% of Decided Petitions Granted	Days from Petition Grant to First Office Action	Average Days to Final Disposition
8,554	94%	55	168

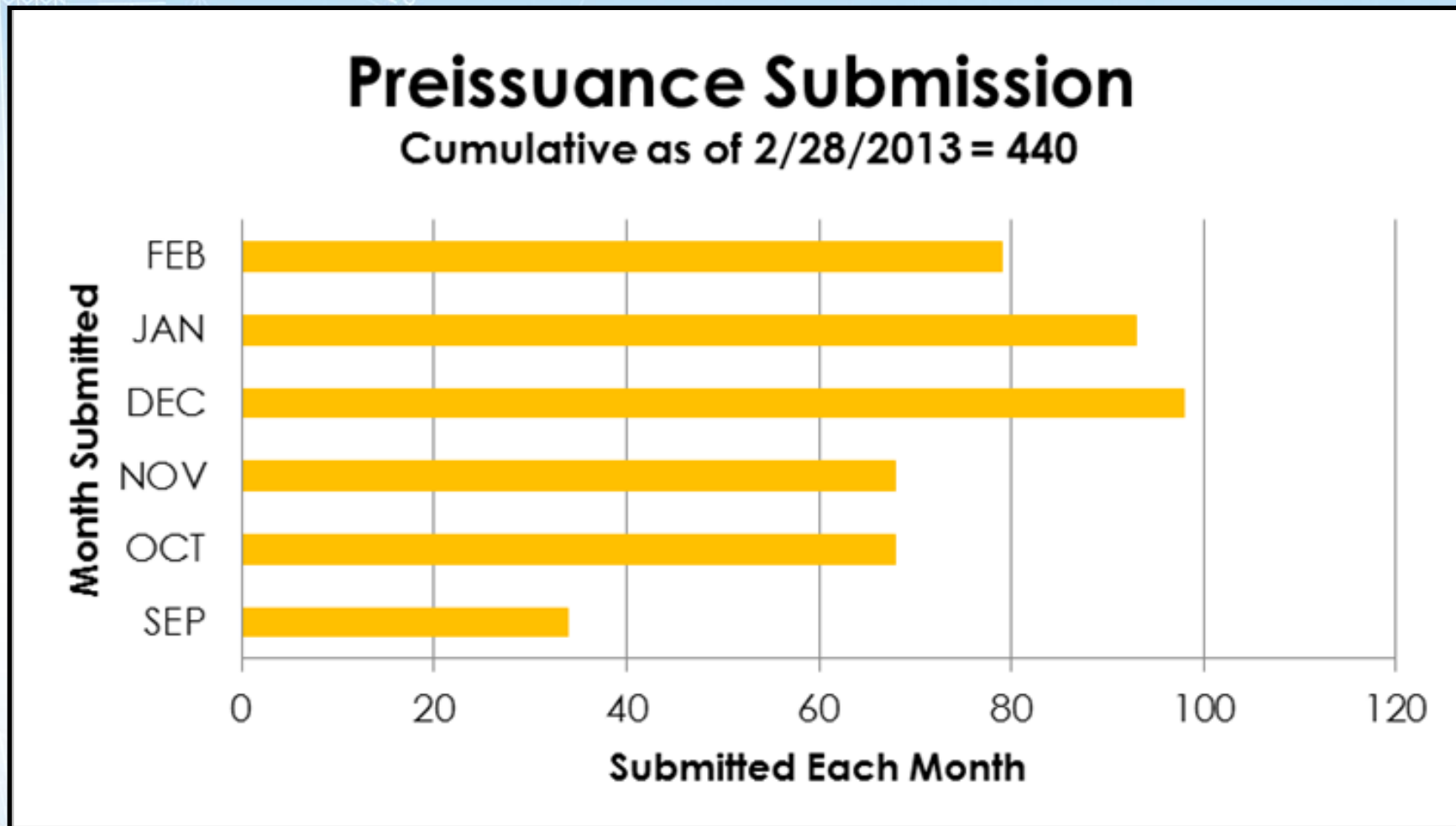
First Action on Merits Mailed	Final Dispositions Mailed	Allowances Mailed	Percent of Petitions From Small Entities
5,503	3,667	1,828	43%



Preissuance Submissions

(Data from Sept 16, 2012 to Feb 28, 2013)

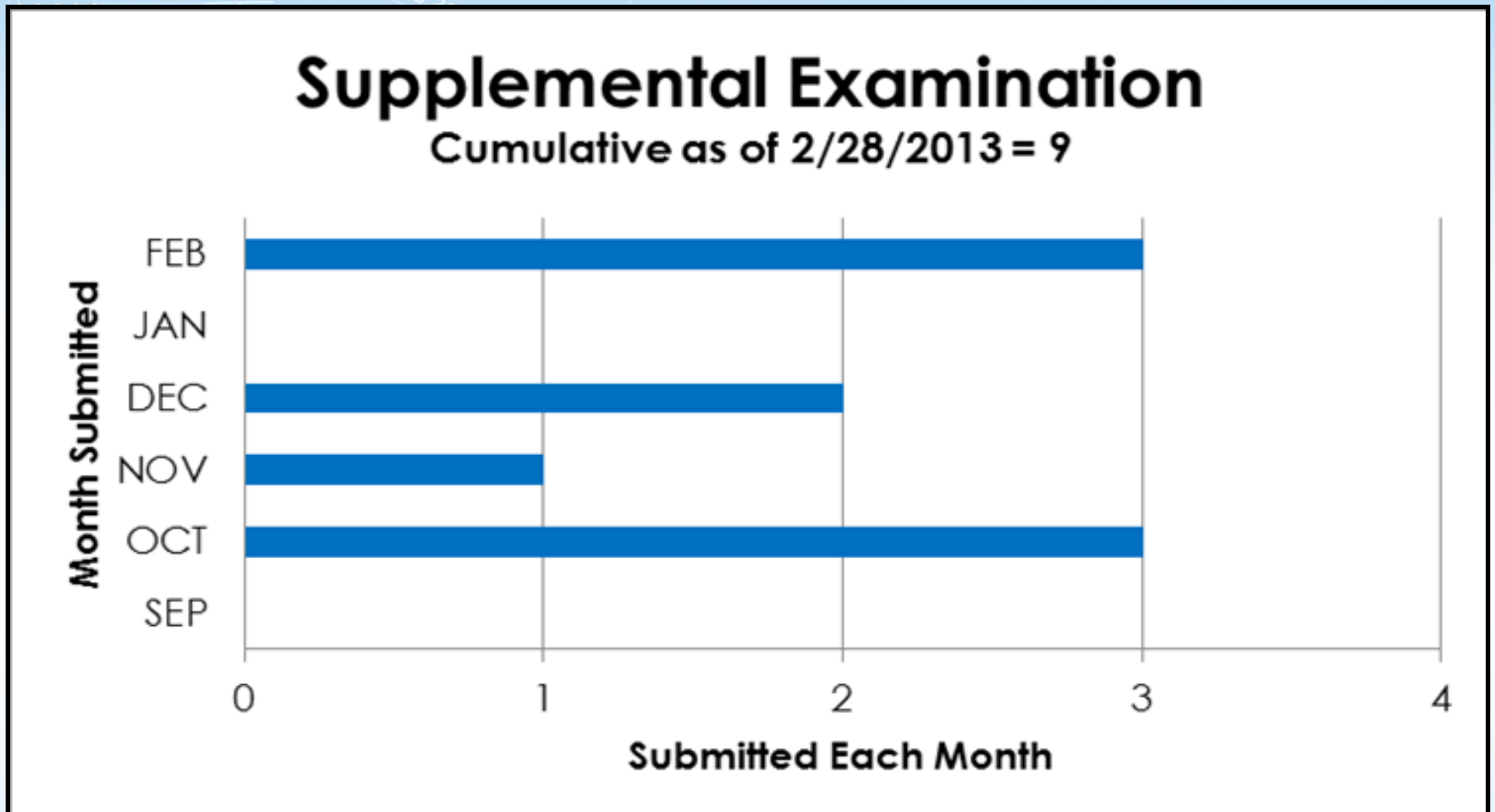
http://www.uspto.gov/aia_implementation/statistics.jsp



Supplemental Examination

(Data from Sept 16, 2012 to Feb 28, 2013)

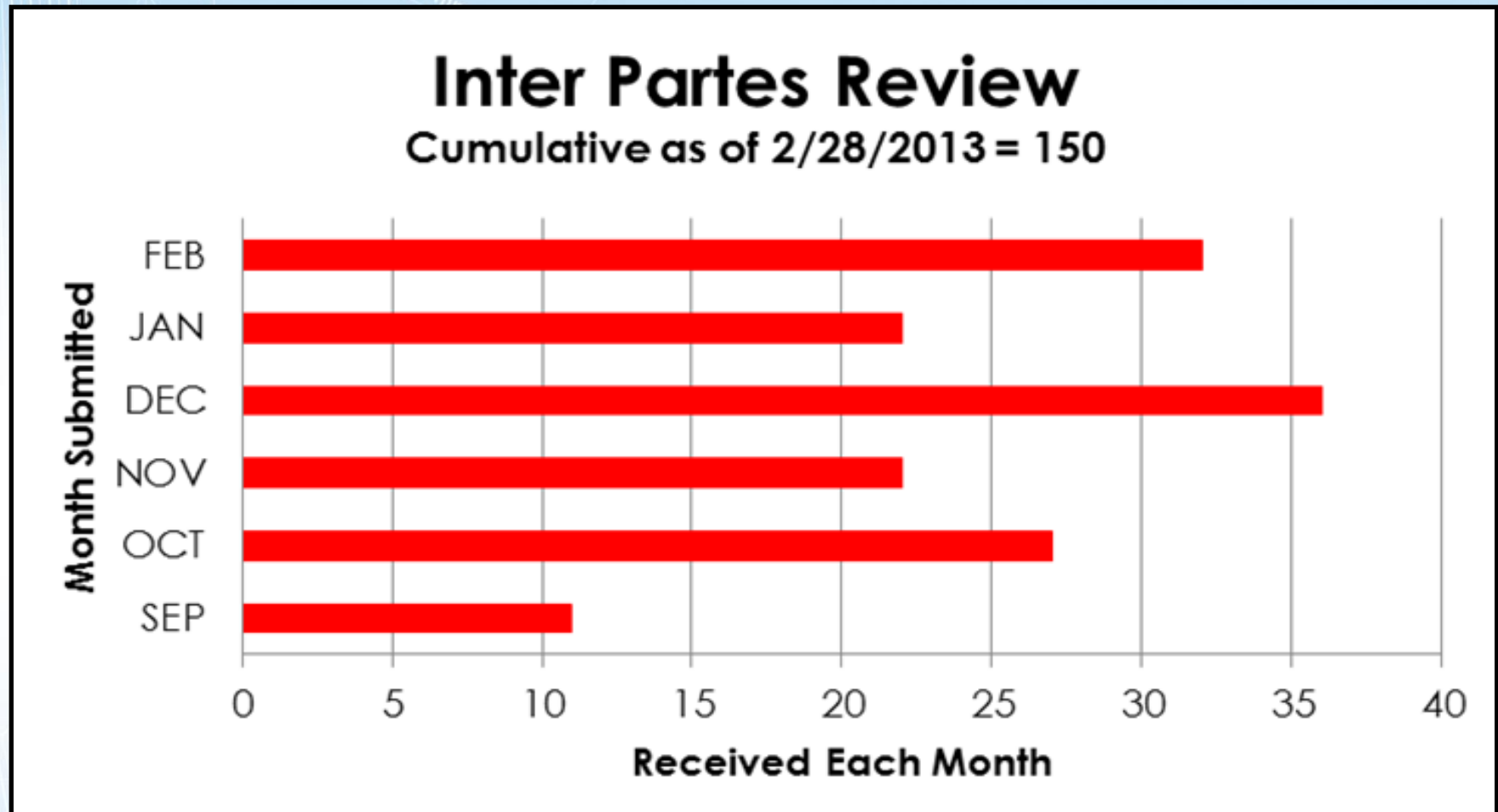
http://www.uspto.gov/aia_implementation/statistics.jsp



Inter Partes Review

(Data from Sept 16, 2012 to Feb 28, 2013)

http://www.uspto.gov/aia_implementation/statistics.jsp



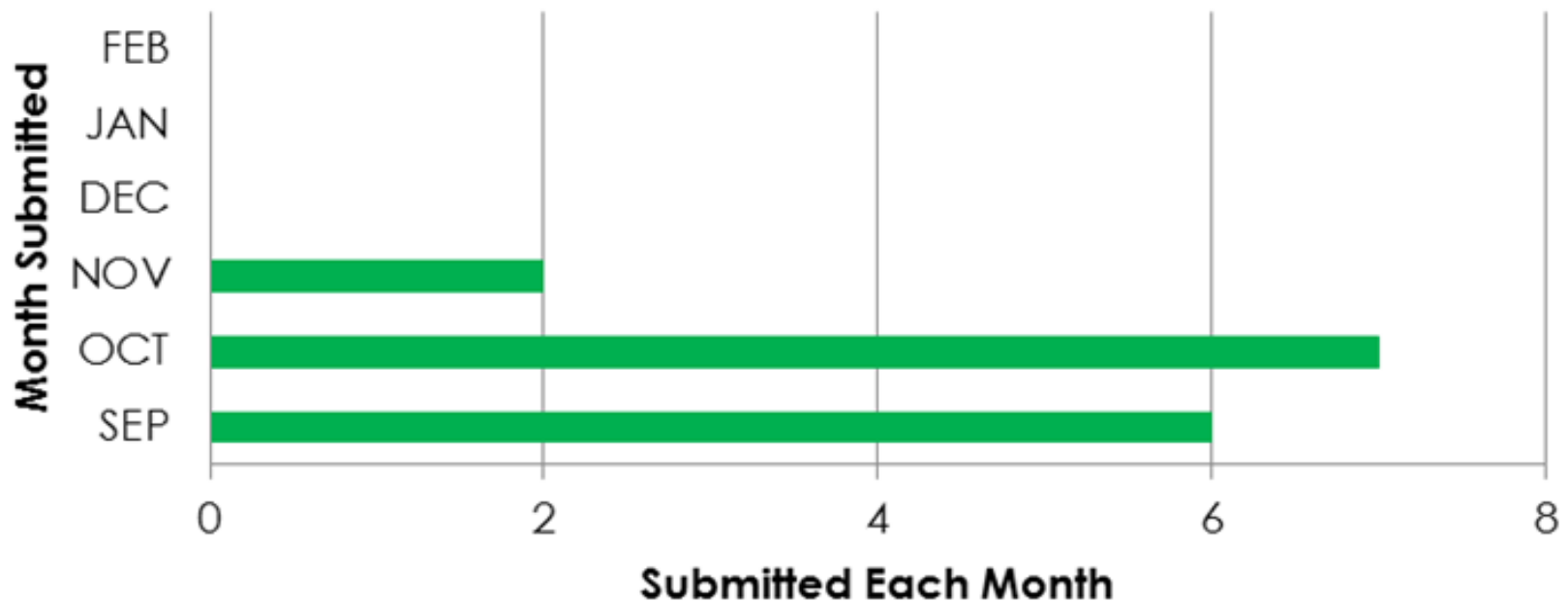
Covered Business Method Review

(Data from Sept 16, 2012 to Feb 28, 2103)

http://www.uspto.gov/aia_implementation/statistics.jsp

Covered Business Methods

Cumulative as of 2/28/2013 = 15



AIA Micro-site: New Features

www.uspto.gov/AmericaInventsAct

- Statistics showing number of filing for new AIA proceedings
- Landing page blogs to share information about strengths and points for improvement for new AIA proceedings
- Frequently Asked Questions for FITF, micro-entity, and new patent fees





AMERICA INVENTS ACT

IMPLEMENTATION

First Inventor to File Final Rules and Guidelines

Overview

Part 1: Examiner Training and AIA Indicators

Part 2: Guidelines

- Statutory framework and comparison
- 35 U.S.C. 102(a)(1) prior art and 102(b)(1) exceptions
- 35 U.S.C. 102(a)(2) prior art and 102(b)(2) exceptions

Part 3: Rules

- 37 C.F.R. 1.55 and 1.78
 - filing certified copy of foreign priority document
 - statements in transitional applications
- 37 C.F.R. 1.130
 - attribution exception
 - prior public disclosure exception



Summary of Examiner Training

- Three-part overview training (March-April 2013)
 - Introductory Video: background for overview training
 - Live Training: >20 training sessions
 - Follow-up Video: statutory review and illustrations
- Comprehensive training (June-July 2013)
- Just-in-time training as needed (March-July 2013)



AIA Indicators

- Applicants can view PAIR to find out whether an application is being examined under the AIA or under pre-AIA law
- Certain USPTO forms received with Office actions also will include an AIA indicator
- Examiners will have indicators in our internal IT systems (i.e., eDAN and PALM) to show whether an application has been identified as subject to the AIA or to pre-AIA law



AIA Indicator in PAIR

Patent Application Information Retrieval

[Order Certified Application As Filed](#)
[Order Certified File Wrapper](#)
[View Order List](#)

10/xxx,xxx **WIDGET** **34977**

[Select New Case](#)
[Application Data](#)
[Transaction History](#)
[Image File Wrapper](#)
[Patent Term Adjustments](#)
[Continuity Data](#)
[Foreign Priority](#)
[Fees](#)
[Published Documents](#)
[Address & Attorney/Agent](#)
[Display References](#)

Bibliographic Data

Application Number:	10/xxx,xxx	Customer Number:	-
Filing or 371 (c) Date:	03-17-2003	Status:	Patented Case
Application Type:	Utility	Status Date:	01-25-2006
Examiner Name:	Examiner, Pat N.	Location:	ELECTRONIC
Group Art Unit:	2500	Location Date:	-
Confirmation Number:	5711	Earliest Publication No:	US 2004-xxxxxxx A1
Attorney Docket Number:	34977	Earliest Publication Date:	01-15-2004
Class / Subclass:	134/058.00D	Patent Number:	6,xxx,xxx
First Named Inventor:	Doe, John	Issue Date of Patent:	02-14-2006
Entity Status:	Micro	AIA (First Inventor to File):	No

Title of Invention: WIDGET

↙
 'Yes' if FITF; 'No' if not FITF; '-' (hyphen) if not ready for examination



AIA Indicator on Office Action Summary

Office Action Summary	Application No. [REDACTED]	Applicant(s) [REDACTED]
	Examiner [REDACTED]	Art Unit [REDACTED]

AIA (First Inventor to File) Status
 Yes/No

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE [REDACTED] MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on [REDACTED].
 A declaration(s)/affidavit(s) under **37 CFR 1.130(b)** was/were filed on [REDACTED].

2a) This action is **FINAL**. 2b) This action is non-final.

3) An election was made by the applicant in response to a restriction requirement set forth during the interview on [REDACTED]; the restriction requirement and election have been incorporated into this action.

4) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

5) Claim(s) [REDACTED] is/are pending in the application.
 5a) Of the above claim(s) [REDACTED] is/are withdrawn from consideration.

6) Claim(s) [REDACTED] is/are allowed.

7) Claim(s) [REDACTED] is/are rejected.

8) Claim(s) [REDACTED] is/are objected to.

9) Claim(s) [REDACTED] are subject to restriction and/or election requirement.



AIA Indicator on Notice of Allowability

[Redacted] Notice of Allowability	Application No. [Redacted]	Applicant(s) [Redacted]
	Examiner [Redacted]	Art Unit [Redacted]

AIA (First Inventor to File) Status
Yes/No

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. This communication is responsive to [Redacted].
 A declaration(s)/affidavit(s) under 37 CFR 1.130(b) was/were filed on [Redacted].
2. An election was made by the applicant in response to a restriction requirement set forth during the interview on [Redacted]; the restriction requirement and election have been incorporated into this action.
3. The allowed claim(s) is/are [Redacted]. As a result of the allowed claim(s), you may be eligible to benefit from the **Patent Prosecution Highway** program at a participating intellectual property office for the corresponding application. For more information, please see http://www.uspto.gov/patents/init_events/pph/index.jsp or send an inquiry to PPHfeedback@uspto.gov.
4. Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

Certified copies:

- a) All b) Some *c) None of the:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. [Redacted].
 3. Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: [Redacted].

Interim copies:

- a) All b) Some c) None of the: Interim copies of the priority documents have been received.





AMERICA INVENTS ACT

IMPLEMENTATION

Guidelines

Examination Guidelines for Implementing the
First Inventor to File Provisions of the Leahy-Smith America
Invents Act , 78 Fed. Reg. 11059
(February 14, 2013)

Effective Date: March 16, 2013

Critical Date for Claimed Invention

- Pre-AIA: date of invention
- AIA: effective filing date



35 U.S.C. 100(i)(1):

New Definition for Effective Filing Date

Effective filing date of a claimed invention under examination is the earlier of:

- the actual filing date of the patent or application containing a claim to the invention;

or

- the filing date of the earliest application for which the patent or application is entitled to a right of **foreign priority or domestic benefit** as to such claimed invention



AIA Impact on pre-AIA 35 U.S.C. 102

Pre-AIA 35 U.S.C. 102 A person shall be entitled to a patent unless—	AIA 35 U.S.C. 102 Concordance
(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or	102(a)(1)
(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or	102(a)(1)
<p>(c) Abandonment of invention</p> <p>(d) Premature foreign patenting</p>	No corresponding provision
<p>(e) The invention was described in</p> <p>(1) An application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or</p> <p>(2) A patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except than an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language, or</p>	102(a)(2)
(f) He did not	101 and 115
<p>(g) Prior invention by another</p> <p>(1) during the term of the patent or</p> <p>(2) before the date of the abandonment</p>	No corresponding provision



AlA Statutory Framework

Prior Art 35 U.S.C. 102(a) (Basis for Rejection)	Exceptions 35 U.S.C. 102(b) (Not Basis for Rejection)	
102(a)(1) Disclosure with Prior Public Availability Date	102(b)(1)	(A) Grace Period Disclosure by Inventor or Obtained from Inventor
		(B) Grace Period Intervening Disclosure by Third Party
102(a)(2) U.S. Patent, U.S. Patent Application, and PCT Application with Prior Filing Date	102(b)(2)	(A) Disclosure Obtained from Inventor
		(B) Intervening Disclosure by Third Party
		(C) Commonly Owned Disclosure



35 U.S.C. 102(a)(1): Prior Public Disclosures as Prior Art

- 35 U.S.C. 102(a)(1) precludes a patent if a claimed invention was, before the effective filing date of the claimed invention:
 - patented;
 - described in a printed publication;
 - **in public use**;
 - **on sale**; or
 - **otherwise available to the public**



In Public Use or On Sale

- Does not include pre-AIA geographic limitation
 - Use or sale may occur anywhere in the world
- Does not include pre-AIA treatment of secret sale as prior art
 - Sale activity must have been available to the public



“Otherwise Available to the Public”

- Introduced by the AIA; no corresponding language in pre-AIA 35 U.S.C. 102
- Catch-all to account for other means of making an invention publicly available



Two Exceptions to 35 U.S.C. 102(a)(1) Prior Art

In brief–

- 102(b)(1)(A): A grace period disclosure of the inventor's work is not prior art to the inventor
- 102(b)(1)(B): A disclosure of the inventor's work shields the inventor from the prior art effect of a third party's subsequent grace period disclosure

Note that the 102(b)(1) exceptions pertain to the 102(a)(1) disclosures, which may be prior art as of the date they are publicly available



35 U.S.C. 102(b)(1)(A) Exception: Grace Period Disclosure of Inventor's Work

First exception: A disclosure made one year or less before the effective filing date of the claimed invention shall not be prior art under 35 U.S.C. 102(a)(1) if:

the disclosure was made by:

- the inventor or joint inventor; or
- another who obtained the subject matter directly or indirectly from the inventor or joint inventor



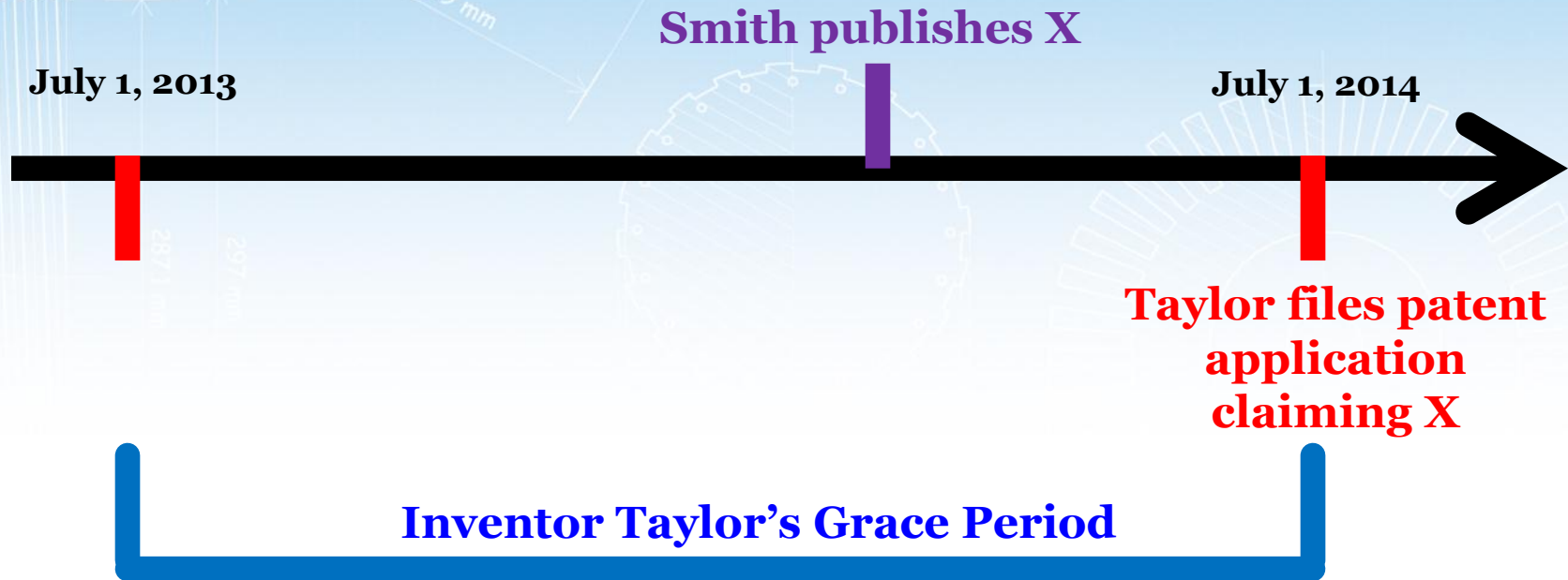
Example 1: Exception in 102(b)(1)(A)



- Taylor's publication is not available as prior art against Taylor's application because of the exception under 102(b)(1)(A) for a grace period disclosure by an inventor.



Example 2: Exception in 102(b)(1)(A)



- Smith's publication would be prior art to Taylor under 102(a)(1) if it does not fall within any exception in 102(b)(1).
- However, if Smith obtained subject matter X from Taylor, then it falls into the 102(b)(1)(A) exception as a grace period disclosure obtained from the inventor, and is not prior art to Taylor.



35 U.S.C. 102(b)(1)(B) Exception: Grace Period Intervening Disclosure by Third Party

Second exception: A disclosure made one year or less before the effective filing date of the claimed invention shall not be prior art under 35 U.S.C. 102(a)(1) if:

the subject matter disclosed was, before such disclosure, publicly disclosed by:

- the inventor or joint inventor; or
- another who obtained the subject matter directly or indirectly from the inventor or joint inventor

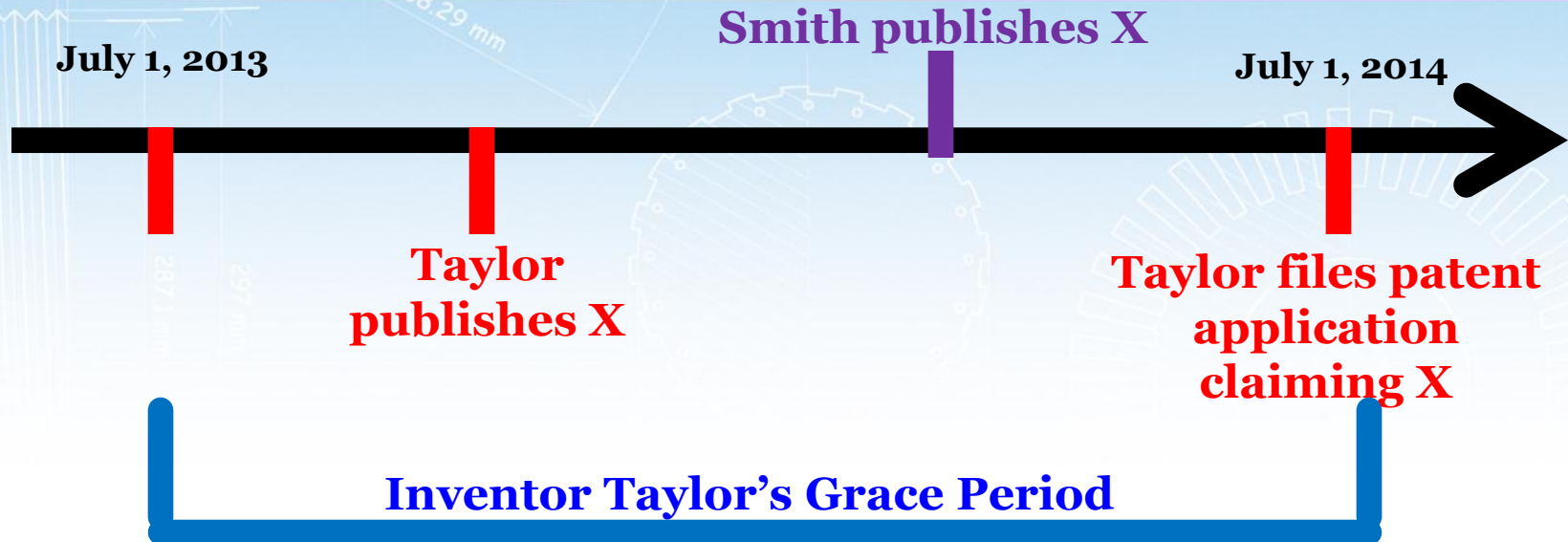


“The Subject Matter”

- For the 35 U.S.C. 102(b)(1)(B) exception to apply:
 - the subject matter in the prior disclosure must be the same as that which is later publicly disclosed
 - the mode of prior disclosure by the inventor need not be the same as the mode of later disclosure by another
 - verbatim disclosures are not required



Example 3: Exception in 102(b)(1)(B)



- Smith's publication is not prior art because of the exception under 102(b)(1)(B) for a grace period intervening disclosure by a third party.
- Taylor's publication is not prior art because of the exception under 102(b)(1)(A) for a grace period disclosure by the inventor.
- If Taylor's disclosure had been before the grace period, it would be prior art against his own application. However, it would still render Smith inapplicable as prior art.



AlA Statutory Framework

Prior Art 35 U.S.C. 102(a) (Basis for Rejection)	Exceptions 35 U.S.C. 102(b) (Not Basis for Rejection)	
102(a)(1) Disclosure with Prior Public Availability Date	102(b)(1)	(A) Grace Period Disclosure by Inventor or Obtained from Inventor
		(B) Grace Period Intervening Disclosure by Third Party
102(a)(2) U.S. Patent, U.S. Patent Application, and PCT Application with Prior Filing Date	102(b)(2)	(A) Disclosure Obtained from Inventor
		(B) Intervening Disclosure by Third Party
		(C) Commonly Owned Disclosure



35 U.S.C. 102(a)(2): U.S. and PCT Patent Documents Are Prior Art as of the Date They Are “Effectively Filed”

35 U.S.C. 102(a)(2) precludes a patent if a claimed invention was described in a:

- U.S. Patent;
- U.S. Patent Application Publication; or
- PCT Application Publication designating the U.S.

that names another inventor and was **effectively filed** before the effective filing date of the claimed invention



35 U.S.C. 102(d): Determining the Date that a U.S. or PCT Patent Document Is “Effectively Filed”

- Date that a U.S. or PCT patent document being applied as a reference is **effectively filed** is the earlier of:
 - the actual filing date of the U.S. patent or published application;or
 - the filing date of the earliest application to which the U.S. patent or published application is entitled to claim a right of foreign priority or domestic benefit which describes the subject matter
- Date that a patent document used as a reference is effectively filed may be different depending on whether the application under examination is subject to AIA or pre-AIA law



Three Exceptions to 35 U.S.C. 102(a)(2) Prior Art

In brief—

- 102(b)(2)(A): A disclosure of the inventor's work in a U.S. patent document or PCT publication by another is not prior art to the inventor
- 102(b)(2)(B): A disclosure of the inventor's work shields the inventor from the prior art effect of a subsequent disclosure in a U.S. patent document or PCT publication
- 102(b)(2)(C): A disclosure is not prior art to the inventor if it was commonly owned with the claimed invention not later than the inventor's effective filing date

Note that the 102(b)(2) exceptions pertain to the 102(a)(2) patent documents, which may be prior art as of the date that they are effectively filed. Grace period is not relevant.



35 U.S.C. 102(b)(2)(A) Exception: Disclosure Obtained from Inventor

First exception: A disclosure in an application or patent shall not be prior art under 35 U.S.C. 102(a)(2) if:

the disclosure was made by another who obtained the subject matter directly or indirectly from the inventor or joint inventor



Example 4: Exception in 102(b)(2)(A)

**Smith files
patent application
disclosing X**

April 1, 2014

July 1, 2014

**Smith's
application
publishes**

October 1, 2015

**Taylor files
patent application
claiming X**

- Smith's patent application publication is not prior art if Smith obtained X from Inventor Taylor because of the exception under 102(b)(2)(A) for a disclosure obtained from the inventor



35 U.S.C. 102(b)(2)(B) Exception: Intervening Disclosure by Third Party

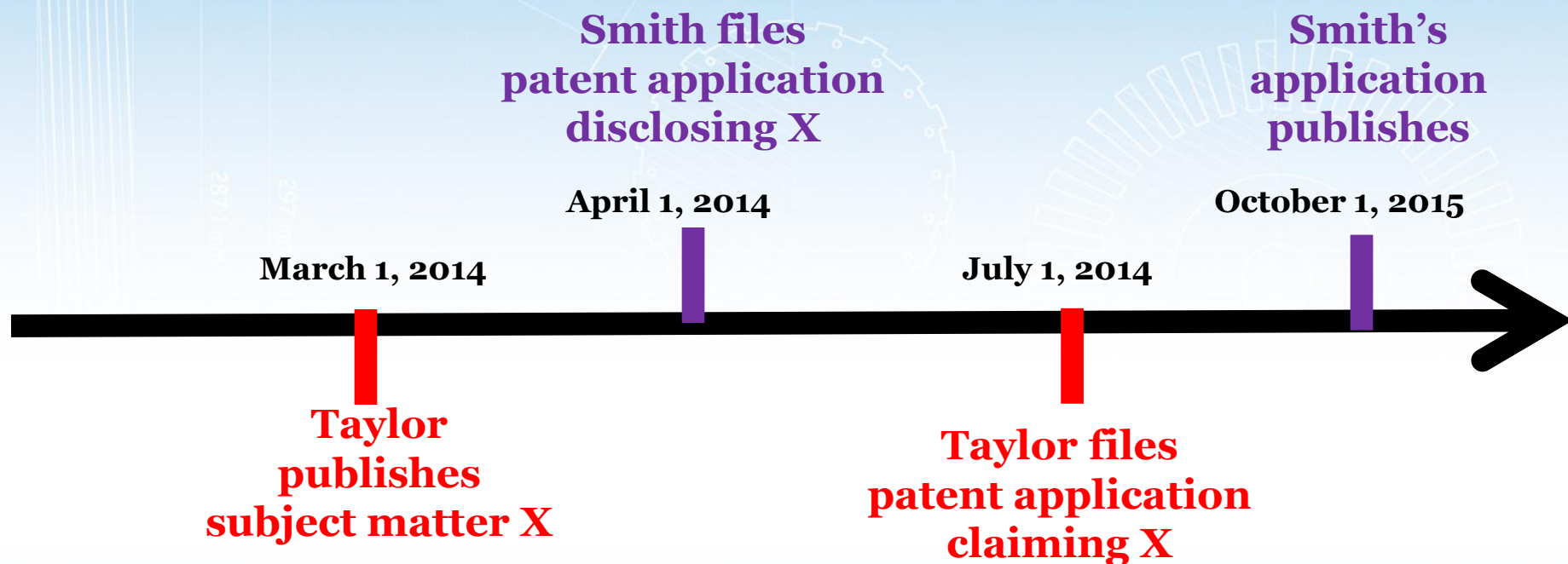
Second exception: A disclosure in an application or patent shall not be prior art under 35 U.S.C. 102(a)(2) if:

the subject matter disclosed was, before such subject matter was effectively filed, publicly disclosed by:

- the inventor or joint inventor; or
- another who obtained the subject matter directly or indirectly from the inventor or joint inventor



Example 5: Exception in 102(b)(2)(B)



- Smith's patent application publication is not prior art against Taylor's application because of the exception under 102(b)(2)(B) for an intervening disclosure by a third party.



35 U.S.C. 102(b)(2)(C) Exception: Commonly Owned Disclosure

Third exception: A disclosure made in an application or patent shall not be prior art under 35 U.S.C. 102(a)(2) if:
the subject matter and the claimed invention were
commonly owned or subject to an obligation of assignment to the same person not later than the effective filing date of the claimed invention

Resembles pre-AIA 35 U.S.C. 103(c), but applies to both novelty and obviousness, whereas pre-AIA disqualified art only for obviousness

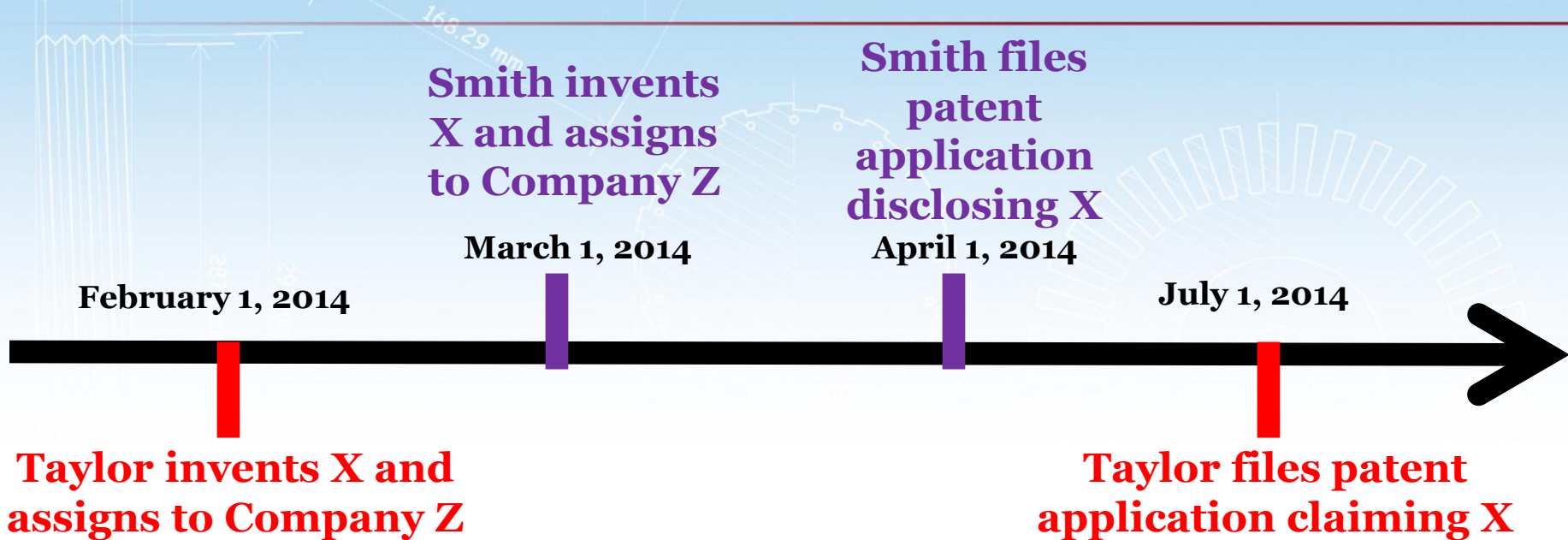


Commonly Owned or Subject to Obligation of Assignment

- Applicant can establish common ownership or obligation of assignment by making a clear and conspicuous statement
- Corroborating evidence is not required



Example 6: Exception in 102(b)(2)(C)



- Smith's patent application publication is not prior art because of the exception under 102(b)(2)(C) for a commonly owned disclosure.
- There is no requirement that Smith's and Taylor's subject matter be the same in order for the common ownership exception to apply.





AMERICA INVENTS ACT

IMPLEMENTATION

Rules

Changes to Implement the First Inventor to File Provisions of the Leahy-Smith America Invents Act, 78 Fed. Reg. 11024 (February 14, 2013)

Effective Date: March 16, 2013

Important Rules for AIA Applications

- 37 C.F.R. 1.55 and 1.78
 - filing certified copy of foreign priority document
 - statements in transitional applications
- 37 C.F.R. 1.130
 - attribution exception
 - prior public disclosure exception



Rule 1.55(a), (b), (d), and (e): Foreign Priority in a 35 U.S.C. 111(a) Application

- To take advantage of the new definition of “effective filing date” which includes a foreign filing date, applicant must:
 - claim foreign priority within the later of:
 - 4 months from the actual filing date of the application; or
 - 16 months from the filing date of the foreign priority application
- and
 - include the foreign priority in an application data sheet (ADS)
- Foreign priority claimed is waived if omitted from the ADS
- Unintentionally delayed claim may be accepted by petition



Rule 1.55(f): Certified Copy of Foreign Priority Document

- **Certified copy of any foreign priority application** must be filed within the later of:
 - 4 months from the actual filing date; or
 - 16 months from the filing date of the prior foreign application unless an exception applies
- Certified copy is needed since U.S. patents and U.S. patent application publications have prior art effect as of the date that they are effectively filed, which might be the foreign priority date



Rule 1.55(f)-(i): Three Ways to Satisfy the Time Limit Requirement to File the Certified Copy

- Applicant files a certified copy of the foreign priority document with the Office within the 4/16 time period
- Applicant authorizes Office to retrieve a copy of the foreign priority application through the Office's Priority Document Exchange Program (PDX)
- Applicant files interim copy of the foreign priority within the 4/16 time period
- In order to perfect foreign priority, the certified copy of the foreign priority document or a copy retrieved via PDX, must be received by the Office no later than patent grant



Rule 1.55(j), 1.78(a)(6), or 1.78(c)(6): Statements in Transitional Applications

- Nonprovisional applications that are:
 - filed on or after March 16, 2013;
 - and
 - claim foreign priority or domestic benefit of an application filed before March 16, 2013,are called **transitional applications**
- If a transitional application has ever included a claim to an invention having an effective filing date on or after March 16, 2013, applicant must provide a statement to that effect



Rule 1.55(j), 1.78(a)(6), or 1.78(c)(6): Statements in Transitional Applications

Filed before
March 16, 2013;
Priority/Benefit
claim before
March 16, 2013



No statement required;
pre-AIA application

Filed on or after
March 16, 2013;
Priority/Benefit
claim before
March 16, 2013



Statement required if the
application ever included a
claim to an invention having
an effective filing date on or
after March 16, 2013;
transitional application

Filed after
March 16, 2013;
Priority/Benefit
claim after
March 16, 2013



NO statement required;
AIA application



Rule 1.55(j), 1.78(a)(6), or 1.78(c)(6): Statements in Transitional Applications

- Applicant is **not** required to identify how many or which claims have an effective filing date on or after March 16, 2013
- A statement is **not** required if applicant reasonably believes that the application does not, and did not at any time, contain a claim that has an effective filing date on or after March 16, 2013
- A statement is **not** required for transitional applications that add unclaimed subject matter, which if claimed would have an effective filing date on or after March 16, 2013



Rule 1.55(j), 1.78(a)(6), or 1.78(c)(6): Timing of Statements for Transitional Applications

Statements must be filed within the later of:

- 4 months from the actual filing date of the later-filed application;
- 4 months from the date of entry into the national stage;
- 16 months from the filing date of the prior-filed application from which benefit or priority is sought;

or

- the date that a first claim having an effective filing date on or after March 16, 2013, is presented in the later-filed application.



Rule 1.130 Affidavits or Declarations

- Revised rule 1.130 provides a mechanism for an applicant or patent owner to provide information relevant to certain prior art exceptions:
 - affidavit or declaration of **attribution** under 1.130(a), to invoke the 102(b)(1)(A) or 102(b)(2)(A) exception
 - affidavit or declaration of **prior public disclosure** under 1.130(b), to invoke the 102(b)(1)(B) or 102(b)(2)(B) exception



Rule 1.130(a): Affidavit or Declaration of Attribution

- In response to a rejection based on a disclosure, applicant or patent owner may submit an affidavit or declaration of **attribution** attesting that 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 joint inventor
- Declaration or affidavit may be used to overcome a rejection based on 102(a)(1) or 102(a)(2) prior art by invoking the 102(b)(1)(A) or 102(b)(2)(A) exception, respectively



Rule 1.130(b): Affidavit or Declaration of Prior Public Disclosure

- In response to a rejection based on a disclosure, applicant or patent owner may submit an affidavit or declaration of prior public disclosure attesting that a **prior public disclosure** of the subject matter was made
 - by the inventor or joint inventor
 - or
 - by another who obtained the subject matter disclosed directly or indirectly from the inventor or joint inventor
- Declaration or affidavit may be used to overcome a rejection based on 102(a)(1) or 102(a)(2) prior art by invoking the 102(b)(1)(B) or 102(b)(2)(B) exception, respectively



Rule 1.130(c): Affidavit or Declaration Not Available

- An affidavit or declaration is not available to overcome a rejection if:
 - the rejection is based on a disclosure made more than one year before effective filing date of claimed invention
- An affidavit or declaration under rule 1.130 may not available to overcome a rejection if:
 - the affidavit or declaration contends that the inventor named in prior art U.S. patent or U.S. patent application publication derived the claimed invention



Resources

- Statutory Framework Chart: http://www.uspto.gov/aia_implementation/FITF_card.pdf
- FAQs: http://www.uspto.gov/aia_implementation/faqs_first_inventor.jsp
- Examiner Introductory Video: http://helix-1.uspto.gov/asxgen/AIA_Close_Cpt.wmv
- Examiner Overview Training Slides: (available on AIA micro-site soon)
- Examiner Follow-up Video: (available on AIA micro-site soon)





AMERICAN INVENTS ACT

IMPLEMENTATION

Questions?



AMERICA INVENTS ACT

IMPLEMENTATION

Micro Entity

Changes to Implement Micro Entity Status for Paying Patent Fees, 77 Fed. Reg. 75019 (December 19, 2012)

Effective March 19, 2013

Benefits

- 75% discount on fees for “filing, searching, examining, issuing, appealing, and maintaining” patent applications/patents
- Discount does not apply to fees paid by a third party (e.g., administrative trials)



Establishing Micro entity Status: Option 1

- Applicant must certify that the applicant:
 - Qualifies as a small entity;
 - Has not been named as an inventor on more than 4 previous patent applications;
 - Did not have a gross income exceeding 3 times the median household income in the preceding calendar year;and
 - Did not convey a license or other ownership interest in the application to an entity that had a gross income exceeding 3 times the median household income in the preceding calendar year (and not obligated to do so)



Option 1: Application Filing Limit

- Each inventor and each applicant is limited to “**four** previously filed patent applications” in which he or she was “named as the inventor or a joint inventor”

Applications Included <i>Count all Pending, Patented, and Abandoned:</i>	Applications Excluded
U.S. Nonprovisional (New, Continuing, and Divisional)	Foreign
Utility and Design	Provisional
National Stage (PCT)	PCT International Stage - if U.S. national stage filing fee not paid
Reissue	<u>Section 1.29(b) exclusion:</u> Application in which “all ownership rights” were assigned or are obligated to be assigned by the inventor or non-inventor applicant “as the result of” the inventor’s or applicant’s “previous employment”



Option 1: Gross Income Limit

- If the application names joint inventors:
 - Income requirement applies to each applicant's and each inventor's income separately
- Any licensee or assignee must also meet the income requirement



Example 1: Disqualification Under Option 1

- Joint inventor in a pending patent application was named as an inventor in:
 - 3 abandoned U.S. nonprovisional patent applications;
 - 1 U.S. patent; and
 - 1 U.S. reissue application
- Result = Applicant does not qualify for micro entity status because joint inventor was named as an inventor on more than “four previously filed patent applications”



Example 2: Disqualification under Option 1

- Joint inventor assigned rights in the invention to a corporation with revenue exceeding \$2 billion per year
- Result = applicant does not qualify for micro entity status under Option #1 because joint inventor assigned rights in the invention to an entity that exceeds the gross income limit
- If assignee corporation has under 500 employees, applicant might be entitled to small entity status



Establishing Micro entity Status: Option 2

Applicant must certify that:

- Applicant qualifies as a small entity;

AND

- Applicant's **employer**, from which he/she obtains the majority of his/her income, is an institution of higher education; **OR**
- Applicant has **conveyed** a license or other ownership interest in the application to such an institution of higher education (or is obligated to do so)



Option 2: Institution of Higher Education

- Defined in section 101(a) of the Higher Education Act of 1965
 - “Institution of higher education” must, among other requirements:
 - be located in a “**State**;”
 - be a public or other nonprofit institution legally authorized within such “State;”
- and
- provide a post-secondary educational program that:
 - Awards a bachelor’s degree or provides not less than a 2 year program acceptable for full credit toward such a degree, or
 - Awards a degree that is acceptable for admission to a graduate or professional degree program



Example 3: Qualification under Option 2

- University meeting “institution of higher education” criteria uses a separate research foundation for technology transfer
- 2 of the 3 inventors obtain the majority of their income as **employees** of the university
- Third inventor is an uncompensated undergraduate student
- 3 inventors are identified as the applicant
- Each inventor assigned their rights in the application to the research foundation
- Result = Applicant would qualify for micro entity status if:
 - (1) the undergraduate student can qualify under option #1, and
 - (2) the research foundation is a small entity and meets the gross income limit of option #1



Example 4: Disqualification under Option 2

- Same as Example #3, except that one of the inventors leaves the university and refuses to cooperate with the research foundation
- Research foundation files the application as the applicant
- Result = Unless the research foundation can qualify under Option #1, micro entity status is not available, because the research foundation is not an employee of the university and has not conveyed to the university



Example 5: Option 2 Qualification

- All inventors conveyed their rights in the subject application to a university meeting the “institution of higher education” criteria
- Inventors are named as the applicant
- No party that does not qualify as a small entity has rights in the application
- One inventor’s gross income for the calendar year preceding payment of the filing fee is 10 times the median household income
- Result = Applicant qualifies for micro entity status because gross income is not relevant to Option #2



Micro Entity Certification

- Micro entity certification must be filed in an application with or before fees may be paid in the micro entity amount
- Separate micro entity certification is required for each application



Who can sign the certification?

- A micro entity certification must be signed by:
 - registered patent practitioner;
 - inventor named as the sole inventor **and** identified as the applicant;or
 - all inventors named as the joint inventors **and** identified as the applicant
- Micro entity certification for a juristic applicant (assignee-applicant) must be signed by a registered patent practitioner



Micro Entity Certification Forms: Option 1

Document Description: Certification of Micro Entity Status (Gross Income Basis) PTO/SB/15A (03-13)

CERTIFICATION OF MICRO ENTITY STATUS (GROSS INCOME BASIS)	
Application Number or Control Number (If applicable):	Patent Number (If applicable):
First Named Inventor:	Title of Invention:
<p>The applicant hereby certifies the following—</p> <p>(1) SMALL ENTITY REQUIREMENT - The applicant qualifies as a small entity as defined in 37 CFR 1.27.</p> <p>(2) APPLICATION FILING LIMIT - Neither the applicant nor the inventor nor a joint inventor has been named as the inventor or a joint inventor on more than four previously filed U.S. patent applications, excluding provisional applications and international applications under the Patent Cooperation Treaty (PCT) for which the basic national fee under 37 CFR 1.492(a) was not paid, and also excluding patent applications for which the applicant has assigned all ownership rights or is obligated to assign all ownership rights as a result of the applicant's previous employment.</p> <p>(3) GROSS INCOME LIMIT ON APPLICANTS AND INVENTORS - Neither the applicant nor the inventor nor a joint inventor, in the calendar year preceding the calendar year in which the applicable fee is being paid, had a gross income, as defined in section 61(a) of the Internal Revenue Code of 1986 (26 U.S.C. 61(a)), exceeding the "Maximum Qualifying Gross Income" reported on the USPTO website at http://www.uspto.gov/patents/law/micro_entity.jsp which is equal to three times the median household income for that preceding calendar year, as most recently reported by the Bureau of the Census.</p> <p>(4) GROSS INCOME LIMIT ON PARTIES WITH AN "OWNERSHIP INTEREST" - Neither the applicant nor the inventor nor a joint inventor has assigned, granted, or conveyed, nor is under an obligation by contract or law to assign, grant, or convey, a license or other ownership interest in the application concerned to an entity that, in the calendar year preceding the calendar year in which the applicable fee is being paid, had a gross income, as defined in section 61(a) of the Internal Revenue Code of 1986, exceeding the "Maximum Qualifying Gross Income" reported on the USPTO website at http://www.uspto.gov/patents/law/micro_entity.jsp which is equal to three times the median household income for that preceding calendar year, as most recently reported by the Bureau of the Census.</p>	
SIGNATURE by a party set forth in 37 CFR 1.33(b)	
Signature	
Name	
Date	Telephone
	Registration No.
<input type="checkbox"/>	There is more than one inventor and I am one of the inventors who are jointly identified as the applicant. Additional certification form(s) signed by the other joint inventor(s) are included with this form.



Micro Entity Certification Form: Option 2

Document Description: Certification of Micro Entity Status (Education Basis) PTO/SB/15B (03-13)

CERTIFICATION OF MICRO ENTITY STATUS (INSTITUTION OF HIGHER EDUCATION BASIS)			
Application Number or Control Number (if applicable):		Patent Number (if applicable):	
First Named Inventor:		Title of Invention:	
CERTIFICATION ON THE BASIS OF EMPLOYMENT BY AN INSTITUTION OF HIGHER EDUCATION			
The applicant hereby certifies the following—			
The applicant qualifies as a small entity as defined in 37 CFR 1.27.			
The applicant's employer, from which the applicant obtains the majority of the applicant's income, is an institution of higher education as defined in section 101(a) of the Higher Education Act of 1965 (20 U.S.C. 1001(a)).			
SIGNATURE by a party set forth in 37 CFR 1.33(b)			
Signature			
Name			
Date	Telephone	Registration No.	
<input type="checkbox"/>	There is more than one inventor and I am one of the inventors who are jointly identified as the applicant. Additional certification form(s) signed by the other joint inventor(s) are included with this form.		
CERTIFICATION ON THE BASIS OF ASSIGNMENT OR OBLIGATION TO ASSIGN TO AN INSTITUTION OF HIGHER EDUCATION			
The applicant hereby certifies the following—			
The applicant qualifies as a small entity as defined in 37 CFR 1.27.			
The applicant has assigned, granted, conveyed, or is under an obligation by contract or law, to assign, grant, or convey, a license or other ownership interest in the particular application to an institution of higher education as defined in section 101(a) of the Higher Education Act of 1965 (20 U.S.C. 1001(a)).			
SIGNATURE by a party set forth in 37 CFR 1.33(b)			
Signature			
Name			
Date	Telephone	Registration No.	
<input type="checkbox"/>	There is more than one inventor and I am one of the inventors who are jointly identified as the applicant. Additional certification form(s) signed by the other joint inventor(s) are included with this form.		

NOTE: A signed copy of this "institution of higher education basis" micro entity certification form (PTO/SB/15B) filed together with a signed copy of the "gross income basis" micro entity certification form (PTO/SB/15A) will be taken to be a representation that any inventor or person applying for a patent as provided in 37 CFR 1.46 not qualifying on the "gross income basis" qualifies on the "institution of higher education basis."



Micro Entity Certification

- Separate micro entity certification is not required for each fee payment
 - But applicant must be entitled to micro entity status whenever a fee is paid in the micro entity amount
- Applicant should evaluate entitlement to micro entity status each time a fee payment is made



Loss of Entitlement

- Notice of loss of micro entity status must be made in writing
 - Payment of a small or large entity fee is not sufficient notification
 - Notification of loss of micro entity status is not treated as notice of loss of small entity status



Example 6: Loss of Entitlement under Option 1

- Sole inventor applicant filed a patent application in 2013 accompanied by a certification of micro entity status
- Applicant had gross income in 2012 below the “Maximum Qualifying Gross Income” reported on the USPTO website when filing, search, and examination fees were paid in the micro entity amounts
- Applicant filed a petition for extension of time in 2014 and was required to pay an extension of time fee
- Applicant’s gross income in 2013 was above the “Maximum Qualifying Gross Income” reported on the USPTO website at the time the extension of time fees were required
- Result = Applicant no longer qualifies for micro entity status because applicant exceeded the gross income limit at the time of payment of the extension of time fee



Example 7: Loss of Entitlement under Option 2

- As sole inventor and applicant, a professor established entitlement to micro entity status upon filing his application in September of 2013
- To escape the typical summer boredom he feels after each spring semester ends, he decided to find a summer job in 2014
- Professor earned more money working his summer job than he does as university professor
- Result = Applicant lost micro entity status because the majority of professor's income was not from the "institution of higher education"



Deficiency Payments

- Fee deficiency payment will correct a good faith erroneous payment of fees in the micro entity amount
- Fee deficiency payment will be treated as a notification of loss of entitlement to micro entity status





AMERICA INVENTS ACT

IMPLEMENTATION

Setting & Adjusting Patent Fees

(Section 10 Fee Setting)

Setting and Adjusting Patent Fees
78 Fed. Reg. 4212 (January 18, 2013)

Fee Setting Goals and Strategies

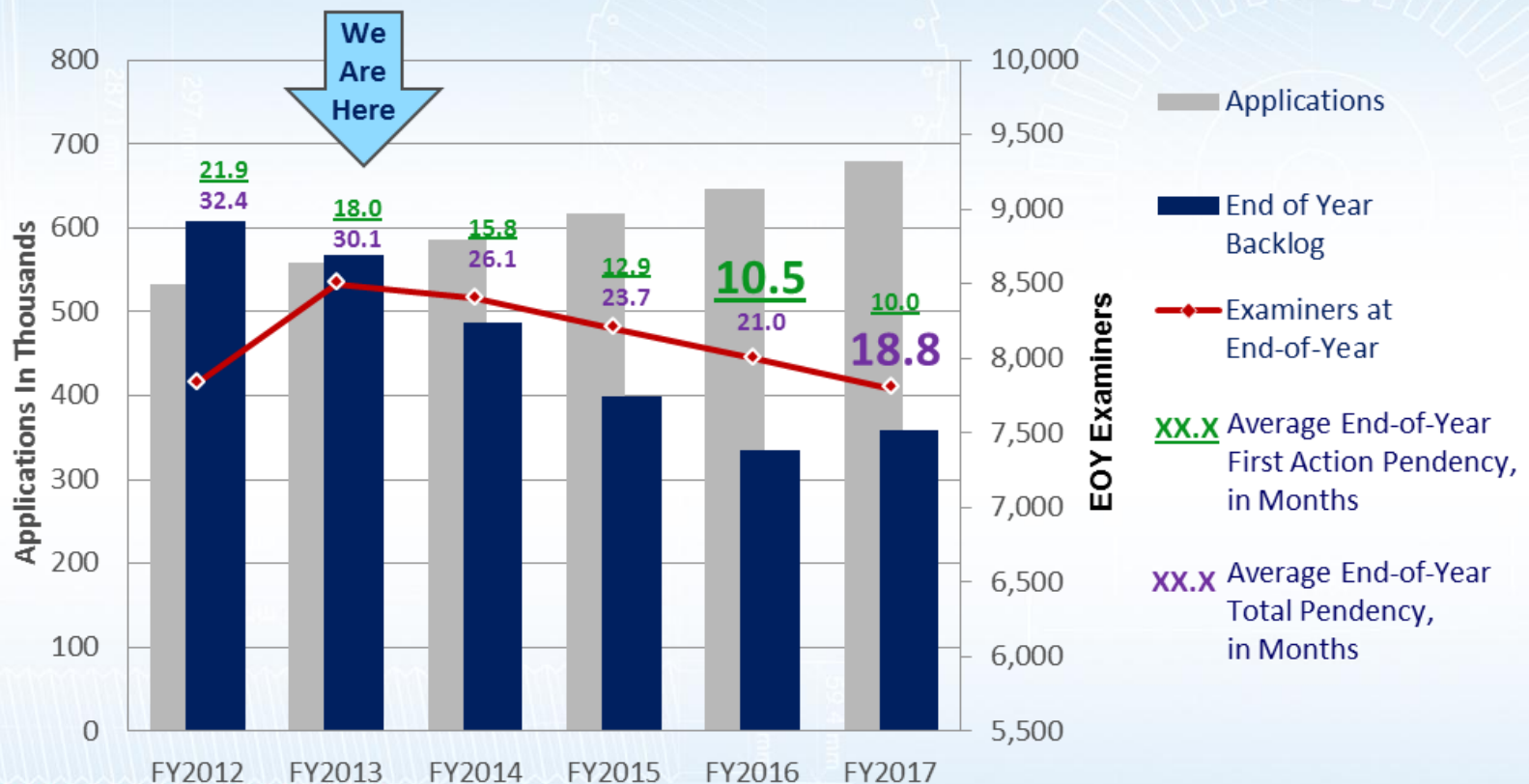
- Ensure the patent fee schedule generates sufficient aggregate revenue to recover the aggregate cost to achieve two significant USPTO Goals:
 - Optimize patent timeliness and quality; and
 - Implement a sustainable funding model for operations
- Set individual fees to further key policy considerations:
 - Fostering innovation;
 - Facilitating the effective administration of the patent system; and
 - Offering patent prosecution options to applicants



Optimize Patent Timeliness and Quality

Timeliness: Decreasing Patent Pendency and Backlog

Reduce total patent application pendency by more than 11 months and provide for a significant increase in the average value of a patent of over a five-year period (FY 2013 to FY 2017).



Optimize Patent Timeliness and Quality

Improving Patent Quality Through:

- Comprehensive training for examiners;
- Expanded and enhanced Ombudsman program;
- Reengineering the examination process;
- Guidelines for examiners to address clarity in patent applications; and
- Encouraging and facilitating examiner-applicant interviews



Sustainable Funding Model

Operating Reserve Estimates



Annual Operating Reserve Target

End of Year Operating Reserve Balances:

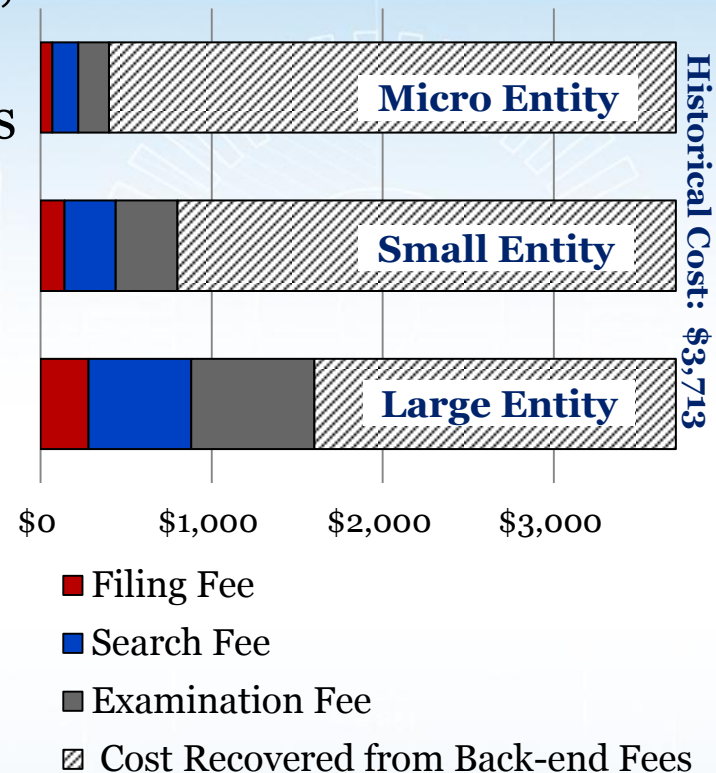
- NPRM Proposal
- Final Rule



Policy Factors Contemplated

Fostering Innovation

- Setting basic “front-end” fees (e.g., filing, search, and examination) below the actual cost of carrying out these activities
- Providing fee reductions for small (50%) and micro (75%) entity innovators
 - Setting these fees below cost requires other fees to be set above cost
- Setting basic “back-end” fees (e.g., issue and maintenance) above cost to recoup the revenue not collected by “front-end” and small and micro entity fees



Policy Factors Contemplated

Facilitating the Effective Administration of the Patent System

- Encourage the submission of applications or other actions that enable examiners to provide prompt and quality interim and final decisions;
- Encourage the prompt conclusion of prosecution of an application, which results in pendency reduction, faster dissemination of information, and certainty in patented inventions; and
- Help recover the additional costs imposed by some applicants' more intensive use of certain services



Policy Factors Contemplated

Offering Patent Prosecution Options to Applicants

- Prioritized examination offers applicants a choice for greater control over the timing of examination by choosing a “fast track” examination for an additional fee
- Multi-part fees for requests for continued examination (RCE)
- Multi-part fees for *ex parte* appeals
- Multi-part fees for administrative trial proceedings (*inter partes* review and post grant review/covered business methods)



Fee Reductions in Response to Public Comments

Description (Large Entity)	Final Fee Amount	From Hearing to NPRM	From NPRM to Final
Filing, Search, and Exam. of a Utility Patent	\$1,600	✓	
Request for Continued Exam. – 1 st and 2 nd	\$1,200; \$1,700	✓	
Appeal Fees – Notice and Forwarding	\$800; \$2,000	✓	✓
Excess Claims – ind >3; total >20; multiple dep.	\$420; \$80; \$780	✓	
Maintenance Fees – 3 rd stage	\$7,400	✓	
Ex Parte Reexamination	\$12,000	✓	✓
Supplemental Examination	\$16,500	✓	✓
Correct Inventorship Fees	\$600*	✓	✓
Inter Partes Review – Request and Institution	\$9,000; \$14,000	✓	
PGR/CBM – Request and Institution	\$12,000; \$18,000	✓	

* Required to be paid after the Office action on the merits has been given or mailed in the application, unless the request is accompanied by a statement that the request to correct or change the inventorship is due solely to the cancelation of claims in the application.



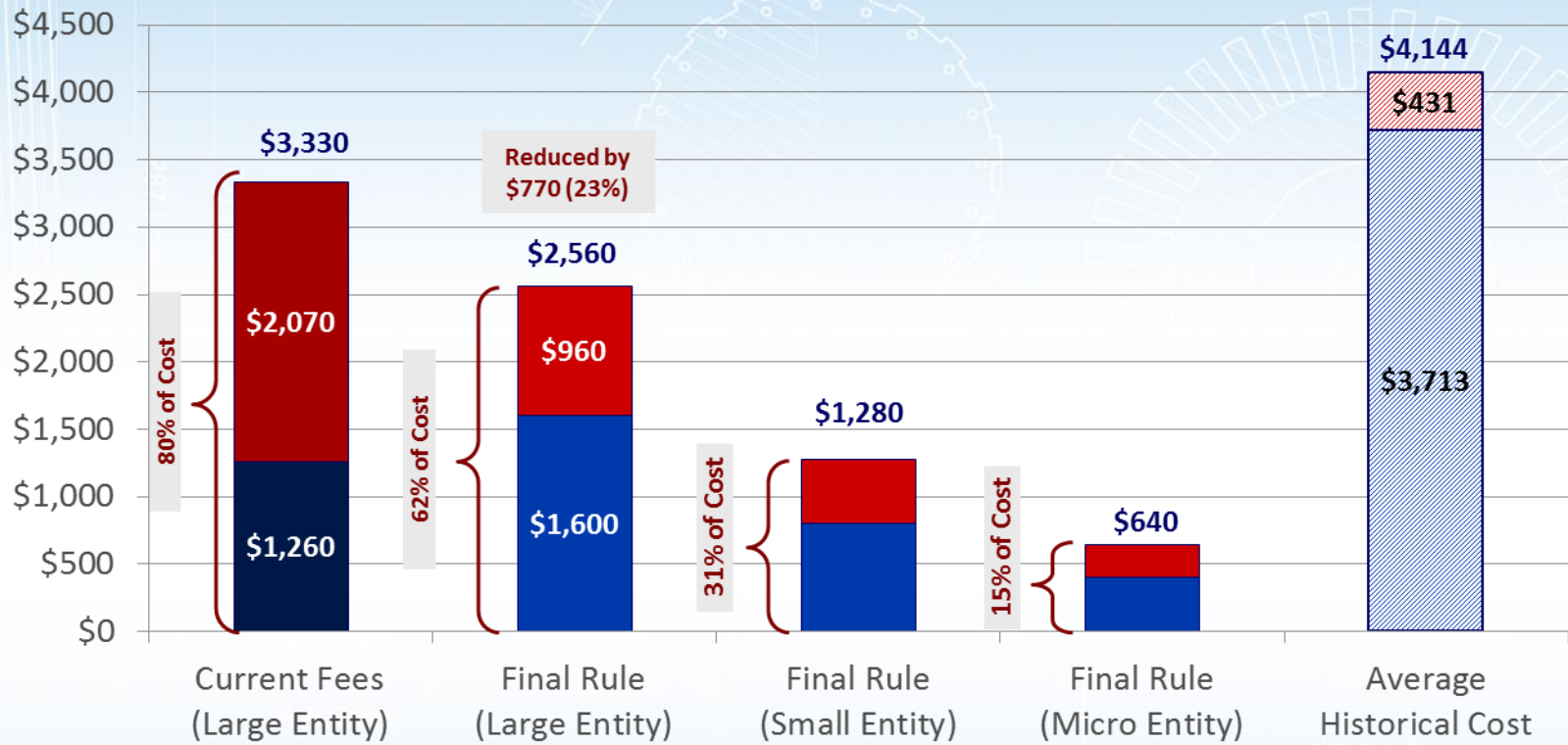
Effective Dates for Fee Changes

- Effective March 19, 2013:
 - All fee changes, except for those listed below.
 - A complete fee schedule is available at:
<http://www.uspto.gov/web/offices/ac/qs/ope/fee031913.htm>
- Effective January 1, 2014:
 - Patent issue and publication fees.
 - Fee for recording a patent assignment electronically.
 - International application filing, processing, search, and transmittal fees.
 - Including the new small and micro entity fees.



Comparison of the Final Fee Schedule to Current Fees

From Filing through Issue



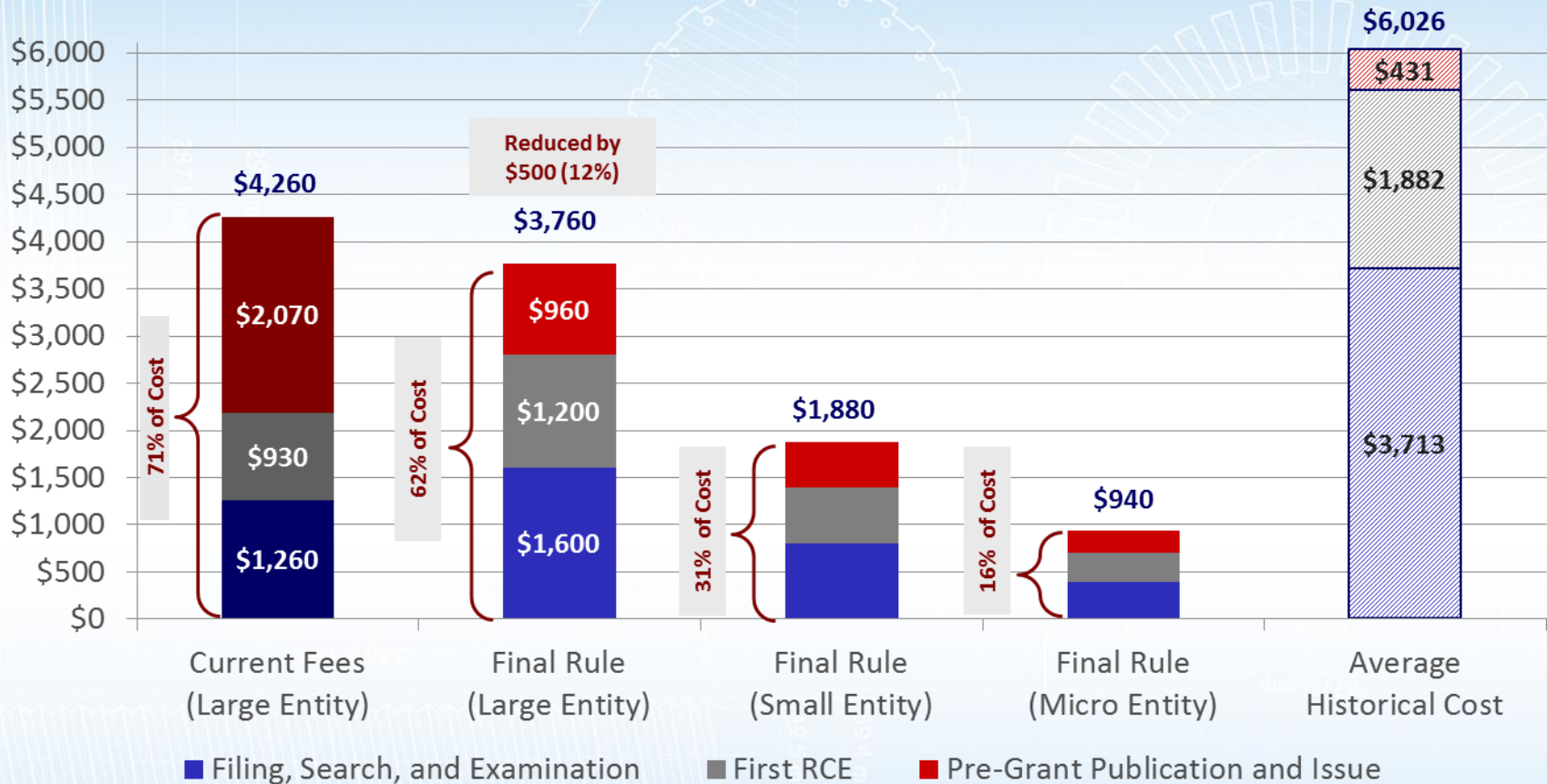
■ Filing, Search, and Examination ■ Pre-Grant Publication and Issue

Note: In each scenario, from the Current to the final fee structure, the fees paid could also increase by (a) \$170 for each independent claim in excess of 3; (b) \$18 for total claims in excess of 20; and (c) \$320 for each multiple dependent claim.



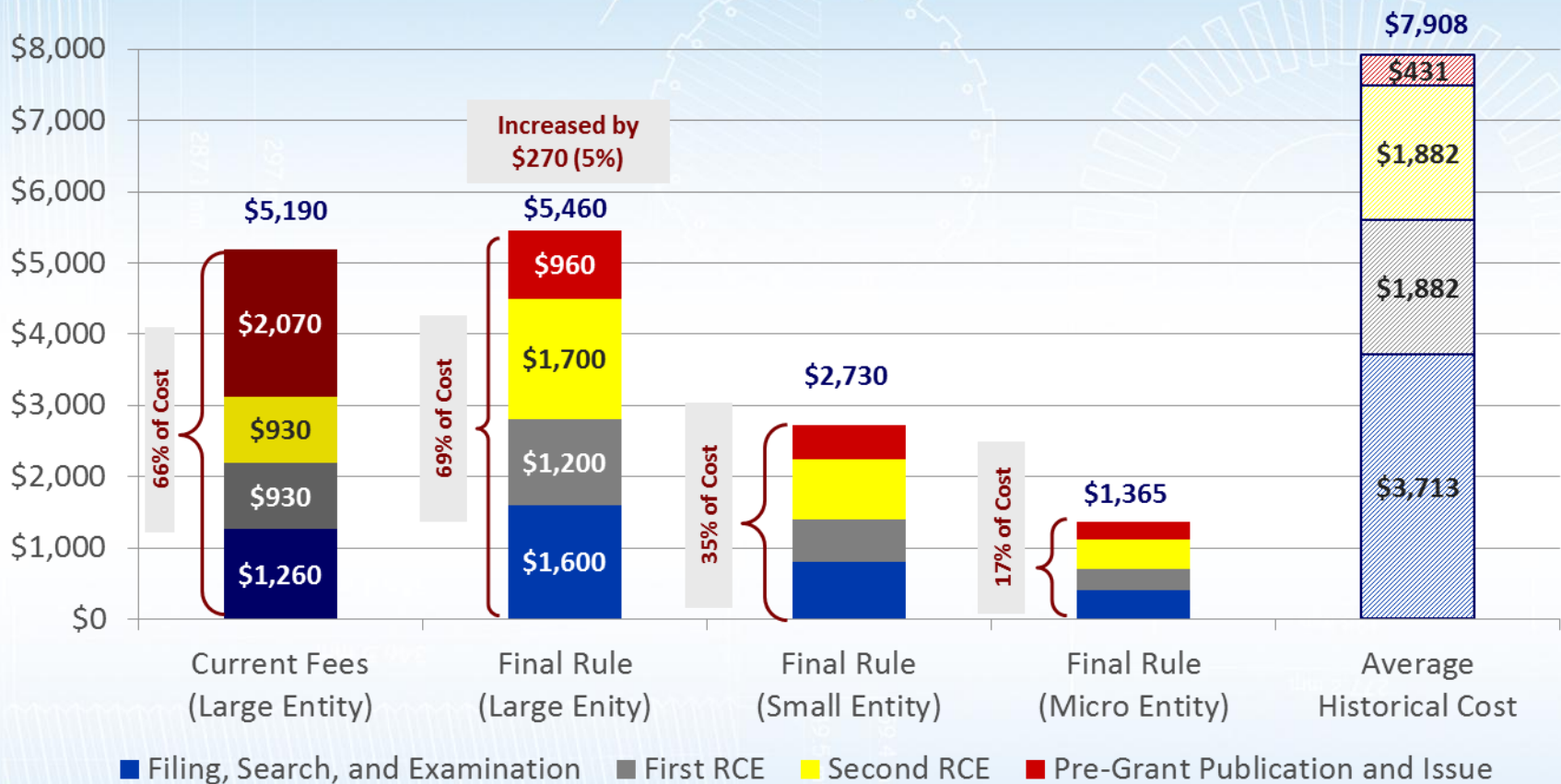
Comparison of the Final Fee Schedule to Current Fees

From Filing through Issue, with One RCE



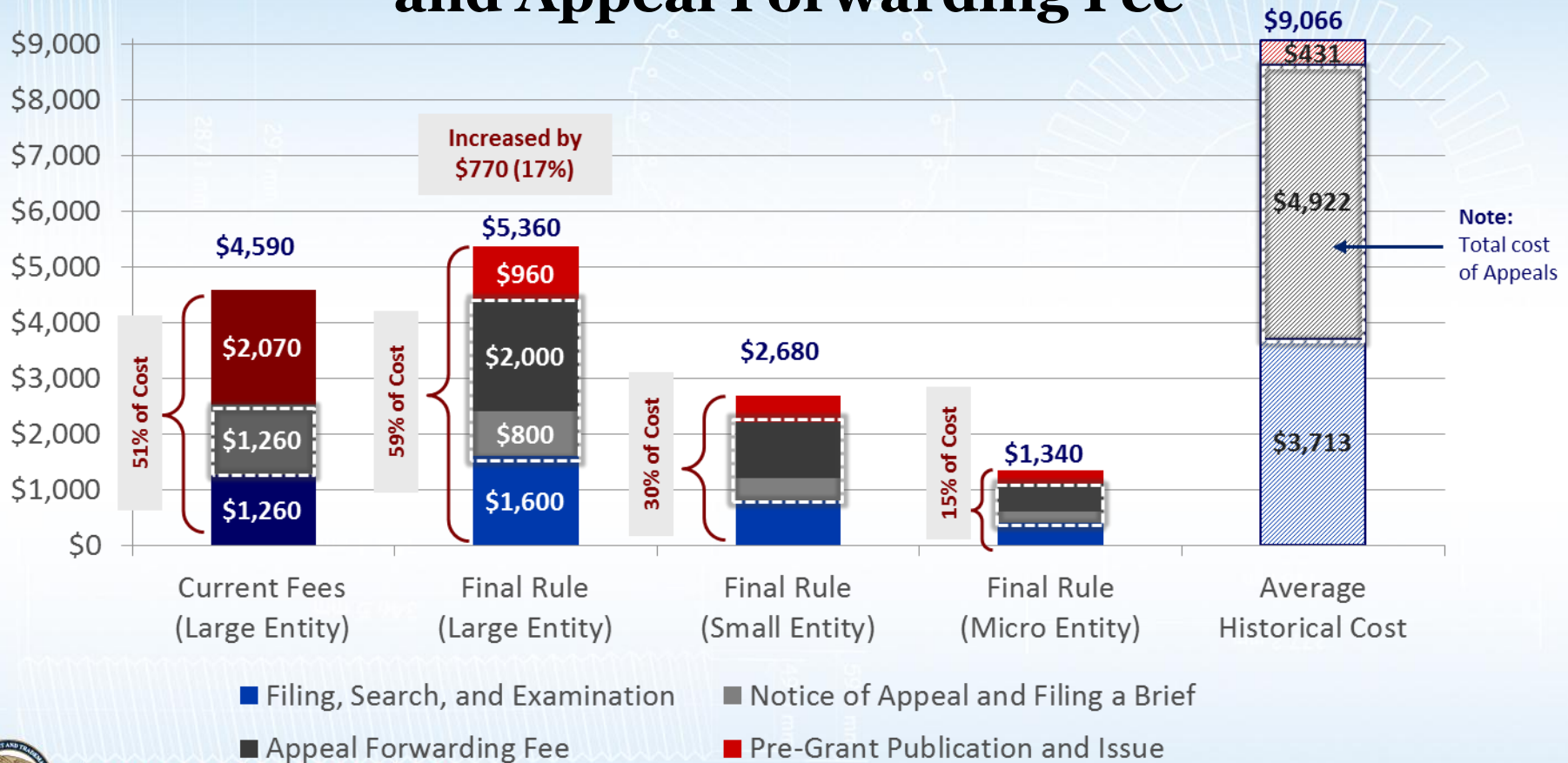
Comparison of the Final Fee Schedule to Current Fees

From Filing through Issue, with Two RCEs



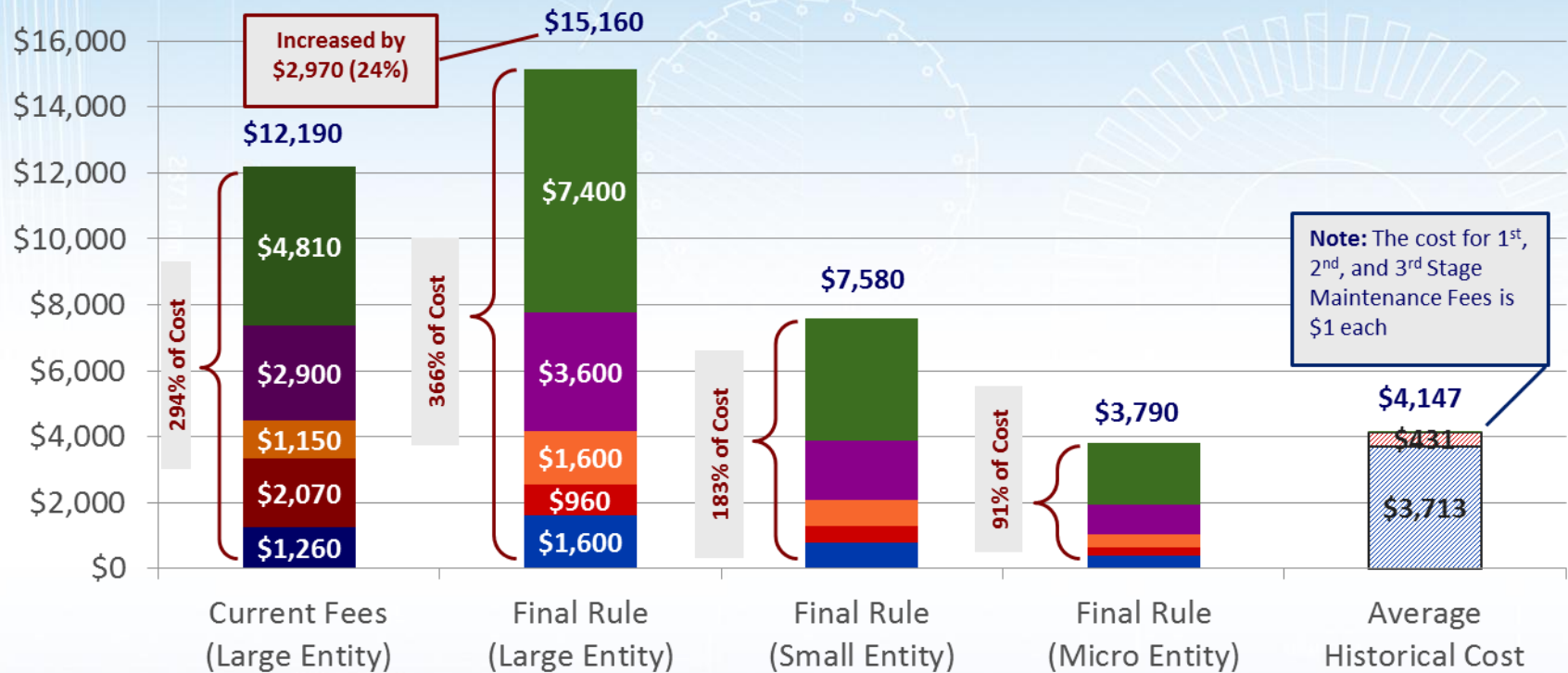
Comparison of the Final Fee Schedule to Current Fees

From Filing through Issue, with a Notice of Appeal and Appeal Forwarding Fee



Comparison of the Final Fee Schedule to Current Fees

From Filing through 3rd Stage Maintenance



- Filing, Search, and Examination
- 1st Stage Maintenance – 3.5 years
- 2nd Stage Maintenance – 7.5 years
- 3rd Stage Maintenance – 11.5 years
- Pre-Grant Publication and Issue



Inter Partes Review Fee Changes

Description	Current Fee	NPRM Proposal	Final Rule
IPR – up to 20 claims	\$27,200	<i>See Below</i>	<i>See Below</i>
IPR Request – up to 20 claims	<i>See Above</i>	\$9,000	\$9,000
IPR Post Institution – up to 15 claims	<i>See Above</i>	\$14,000	\$14,000
IPR per claim > 20 claims	\$600	<i>See Below</i>	<i>See Below</i>
IPR Request per claim > 20 claims	<i>See Above</i>	\$200	\$200
IPR Post Institution per claim > 15 claims	<i>See Above</i>	\$400	\$400



Post Grant Review/Covered Business Methods Fee Changes

Description	Current Fee	NPRM Proposal	Final Rule
PGR/CBM – up to 20 claims	\$35,800	<i>See Below</i>	<i>See Below</i>
PGR/CBM Request – up to 20 claims	<i>See Above</i>	\$12,000	\$12,000
PGR/CBM Post Institution – up to 15 claims	<i>See Above</i>	\$18,000	\$18,000
PGR/CBM per claim > 20 claims	\$800	<i>See Below</i>	<i>See Below</i>
PGR/CBM Request per claim > 20 claims	<i>See Above</i>	\$250	\$250
PGR/CBM Post Institution per claim > 15 claims	<i>See Above</i>	\$550	\$550





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Questions?

AIA Help

- 1-855-HELP-AIA (1-855-435-7242)
- HELPAIA@uspto.gov
- www.uspto.gov/AmericaInventsAct





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Thank You