Patent Public Advisory Committee Meeting

Implementing the America Invents Act

Drew Hirshfeld
Deputy Commissioner for Patent Examination Policy
September 27, 2012
**Patent and Board Final Rulemakings**

- **PATENT RULES**
  - **SEP 16, 2011**
    - Prepare G2 NPRMs
      - Inventor's Oath/Declaration
      - Pre-issuance Submission for a Patent Application
      - Supplemental Examination
      - Citation in Patent File
    - DOC / OMB Review of G2 NPRMs
    - Public Comment on G2 NPRMs
      - USPTO Public Roundtables on NPRMs
    - Prepare G2 FRs
    - DOC / OMB Review of G2 FRs
      - Delayed Effective Date of G2 FRs
      - USPTO Public Roundtables on FRs

- **BOARD RULES**
  - **SEP 16, 2011**
    - Prepare G2 NPRMs
      - Inter Partes Review
      - Post Grant Review
      - Covered Business Methods Program
      - Technological Invention Definition
      - Derivation Proceedings
    - DOC / OMB Review of G2 NPRMs
    - Public Comment on G2 NPRMs
      - USPTO Public Roundtables on NPRMs
    - Prepare G2 FRs
    - DOC / OMB Review of G2 FRs
      - Delayed Effective Date of G2 FRs
      - USPTO Public Roundtables on FRs

- **NPRMs Publish in Fed. Reg.**
  - Dec - Jan
  - Feb

- **FRs Publish in Fed. Reg.**
  - Jul - Aug

**Timeline:**
- **SEP 16, 2011**
- **SEP 16, 2012**
PRPS Electronic Filing System

- Used for administrative trial filings
- Instructional video available on AIA micro-site
### Statistics on Filings
(Statistics as of September 24, 2012)

<table>
<thead>
<tr>
<th>Provision</th>
<th>Number of Filings</th>
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<tbody>
<tr>
<td>1 Preissuance Submissions</td>
<td>35</td>
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<tr>
<td>2 Supplemental Examination</td>
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<tr>
<td>3 Inter Partes Review</td>
<td>13</td>
</tr>
<tr>
<td>4 Covered Business Method Review</td>
<td>6</td>
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</table>
Examiner AIA Training

• 2 computer-based training videos:
  • Preissuance Submission and Inventor’s Oath/Declaration for all examiners
  • Supplemental Examination for Central Reexamination Unit
AIA Questions
(Statistics as of September 24, 2012)

• AIA Call Center established at USPTO
  • AIA Telephone Line: 1-855-HELPAIA
• AIA Dedicated Email: HELP@USPTO.GOV
• AIA Examiner Dedicated Email
• Inventor’s Oath or Declaration Quick Reference Guide
• 549 calls/emails received
• Frequently Asked Questions updated bi-monthly on AIA micro-site
First-Inventor-to-File Rulemaking

**NPRM and Draft Guidance**
- June - July 2012

**FR and Final Guidance**
- by February 16, 2013

**Timeline**
- SEP 16, 2011
  - Prepare FITF NPRM and Draft Guidance
- DOC / OMB Review of FITF NPRM and Draft Guidance
- Public Comment on FITF NPRM and Draft Guidance
- USPTO Public Roundtable on NPRM and Draft Guidance
- Prepare FITF FR and Final Guidance
- DOC / OMB Review of FITF FR and Final Guidance
- Delayed Effective Date of FITF FR
- USPTO Public Roundtable on FR and Final Guidance
- MAR 16, 2013
First-Inventor-to-File Notice of Proposed Rulemaking

• Changes to Implement the First Inventor to File Provisions of the Leahy-Smith America Invents Act, 77 Fed. Reg. 43742 (July 26, 2012)


• Public comments due by October 5, 2012
First-Inventor-to-File Roundtable

- Held on September 7, 2012
- 12 presenters
- Webcast; slides available on AIA micro-site; transcript currently in production
Patent Fee Setting Rulemaking

Fee Setting

- **SEP 16, 2011**
  - Calculate Aggregate Cost and Revenue
  - Prepare Fee Setting NPRM
  - OMB/DOC Review of Fee Setting NPRM
  - Public Comment on Fee Setting NPRM
  - Prepare Fee Setting FR
  - OMB/DOC Review of Fee Setting FR
  - Delayed Effective Date of Fee Setting FR

July - Aug 2012

Jan 2013

- **PPAC Fee Setting Hearing**
  - Feb 2012

- **PPAC Report**
  - Summer 2012
Patent Fee Setting Notice of Proposed Rulemaking


- Regulatory Flexibility Analysis and other fee related materials available on AIA micro-site

- Public comments due by November 5, 2012

- PPAC Fee Setting Report released on September 24, 2012 on PPAC micro-site and AIA micro-site
Roadshows on Final and Proposed Rules

2012 Fall Roadshow Schedule

- Los Angeles, CA
  - September 14
- Minneapolis, MN
  - September 10
- New York, NY
  - September 28
- Detroit, MI
  - September 20
- Alexandria, VA
  - September 12
- Atlanta, GA
  - September 24
- Houston, TX
  - September 26
- Denver, CO
  - September 17
Roadshow Report

• Topics include all final rules for patent and Board related provisions and proposed rules for first-inventor-to-file and patent fee setting provisions

• 7 cities complete; 1 city remaining (New York, NY)

• 3 roadshows webcast; video production in progress and to be posted on AIA micro-site

• Roadshow highlights by city on AIA micro-site
# AIA Studies

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<tr>
<th>Topic</th>
<th>Due Date from Enactment</th>
<th>Status</th>
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<tbody>
<tr>
<td>1 International Patent Protection for Small Businesses</td>
<td>4 months (January 16, 2012)</td>
<td>Complete</td>
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<tr>
<td>2 Prior User Rights</td>
<td>4 months (January 16, 2012)</td>
<td>Complete</td>
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<tr>
<td>3 Genetic Testing</td>
<td>9 months (June 16, 2012)</td>
<td>Extended</td>
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<tr>
<td>4 Misconduct Before the Office</td>
<td>Every 2 years</td>
<td>Future</td>
</tr>
<tr>
<td>5 Satellite Offices</td>
<td>3 years</td>
<td>Future</td>
</tr>
<tr>
<td>6 Virtual Marking</td>
<td>3 years</td>
<td>Future</td>
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<tr>
<td>7 Implementation of AIA</td>
<td>4 years</td>
<td>Future</td>
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Genetic Testing Study

• Letter to Congress on August 28, 2012, explaining that further review, discussion, and analysis are needed for USPTO to produce report

• USPTO plans to conduct a third hearing in late Fall 2012
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<tr>
<th></th>
<th>Topic</th>
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<td>1</td>
<td>Pro Bono</td>
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<td>2</td>
<td>Diversity of Applicants</td>
<td>6 months (March 16, 2012)</td>
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<td>3</td>
<td>Patent Ombudsman for Small Businesses</td>
<td>12 months (September 16, 2012)</td>
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<tr>
<td>4</td>
<td>Satellite Offices</td>
<td>3 years</td>
<td>Ongoing</td>
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<td></td>
<td>-Detroit opened on July 13, 2012</td>
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<td></td>
<td>-Denver site identified and slated to open in</td>
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<td></td>
<td>November 2013</td>
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<td>-Site selection ongoing in Dallas-Forth Worth</td>
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<td></td>
<td>and San Jose</td>
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Detroit Satellite Office

Examiner’s office

Public Search Room

Virtual Interview Room

Examiners Training Academy
Patent Ombudsman for Small Business Program

• 2 components of program:
  
  • Office of Innovation Development
    » Services include information on filing a patent application, scam prevention, pro se and pro bono programs, and educational materials

  • Patent Ombudsman
    » Services include assistance with application processing issues, for example, advancement of prosecution

• White Paper published on AIA micro-site on September 10, 2012
Thank You