



AMERICA INVENTS ACT

IMPLEMENTATION

Welcome

America Invents Act Second Anniversary Forum

September 16, 2013

Agenda

| Time | Topic |
|--------------------|---|
| 1:00 PM to 1:15 AM | Opening Remarks |
| 1:15 PM to 2:45 PM | Patents Presentation <ul style="list-style-type: none">• Prioritized Examination (aka Track One)• Preissuance Submission (aka Third-Party Submissions)• Inventor's Oath/Declaration• Micro-entity Status/Discount• Supplemental Examination |
| 2:45 PM to 3:30 PM | First-Inventor-to-File Workshop Demonstration |
| 3:30 PM to 3:45 PM | BREAK |
| 3:45 PM to 4:55 PM | Administrative Trials Panel Discussion |
| 4:55 PM to 5:00 PM | Closing Remarks |



AMERICA INVENTS ACT

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Introductory Remarks



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Patents Presentations



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Prioritized Examination (aka Track One)

Effective September 26, 2011

Features

- Available for utility, plant, and continuing patent applications and requests for continued examination
 - Not available for international, design, reissue, or provisional applications or in reexamination proceedings
- Requirements:
 - application must be complete on filing;
 - no more than 4 independent claims, 30 total claims, and no multiple dependent claims;
 - electronically file (utility application); and
 - pay fee

Final Disposition

- USPTO goal for final disposition (e.g., final rejection, allowance, abandonment) is an average of 12 months from when the request is granted
- Prioritized exam is terminated without a refund of fee if applicant:
 - petitions for an extension of time to file a reply or to suspend action; or
 - amends the application to exceed the claim restrictions

Filings

(As of September 7, 2013)

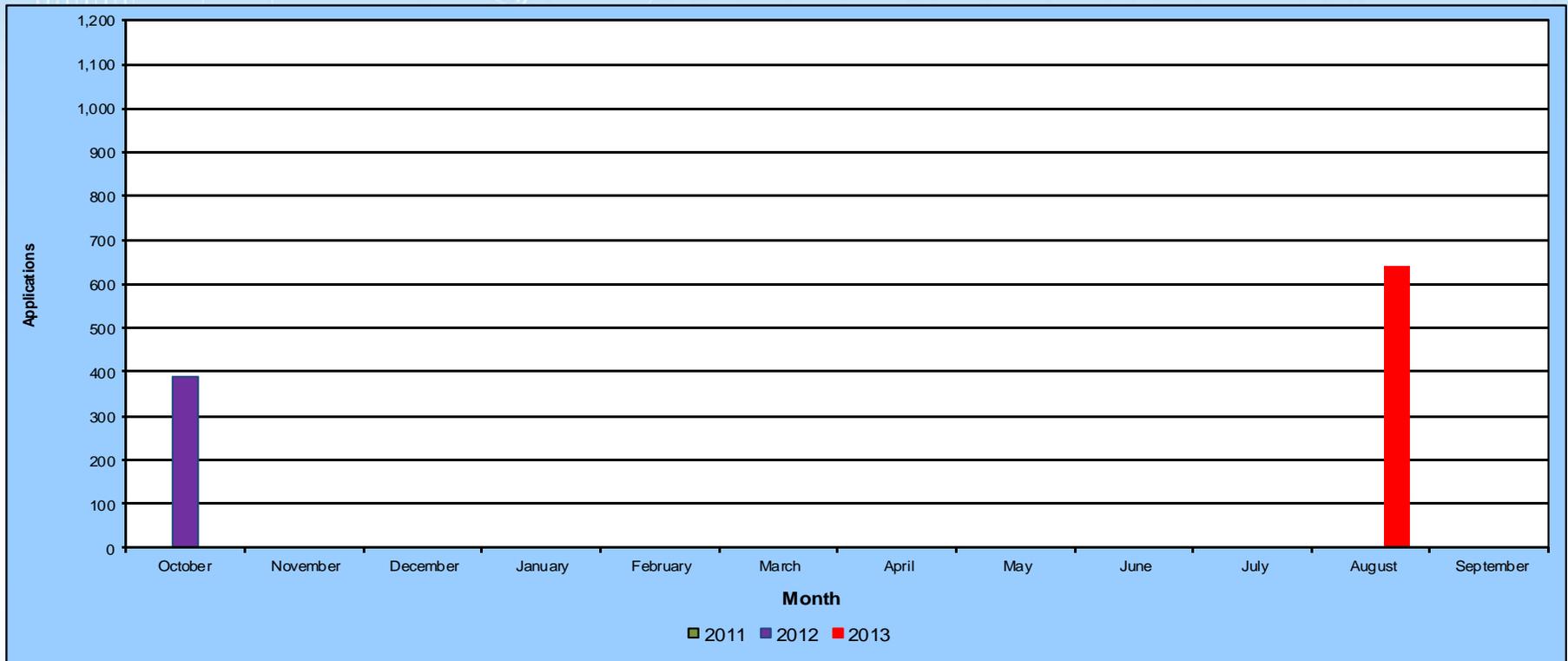
| Petitions Received | October | November | December | January | February | March | April | May | June | July | August | September | Total |
|--------------------|---------|----------|----------|---------|----------|-------|-------|-----|------|------|--------|-----------|-------|
| FY 11 | | | | | | | | | | | | 855 | 855 |
| FY 12 | 390 | 302 | 285 | 292 | 371 | 442 | 457 | 516 | 436 | 470 | 517 | 559 | 5,037 |
| FY 13 | 505 | 512 | 576 | 504 | 469 | 1,030 | 400 | 509 | 530 | 586 | 641 | 33 | 6,295 |

| Percent of Petitions From Small Entities | Number of Micro Entity Applications | Average Days to Petition Decision | % of Decided Petitions Granted | Track One Requests Filed After RCE | % of Track One Serial Disposals Having at Least One Interview |
|--|-------------------------------------|-----------------------------------|--------------------------------|------------------------------------|---|
| 48.4% | 135 | 48.6 | 94% | 786 | 51% |

| First Actions Completed | Average Days from Petition Grant to First Office action | Final Rejections | Issues | Number of Abandonments | Number of Allowances | Number of Appeal Briefs Filed | Average Days From Petition Grant to Allowance | Average Days From Petition Grant to Final Disposition |
|-------------------------|---|------------------|--------|------------------------|----------------------|-------------------------------|---|---|
| 8,796 | 62 | 3,238 | 2,781 | 130 | 3,125 | 147 | 150 | 184 |

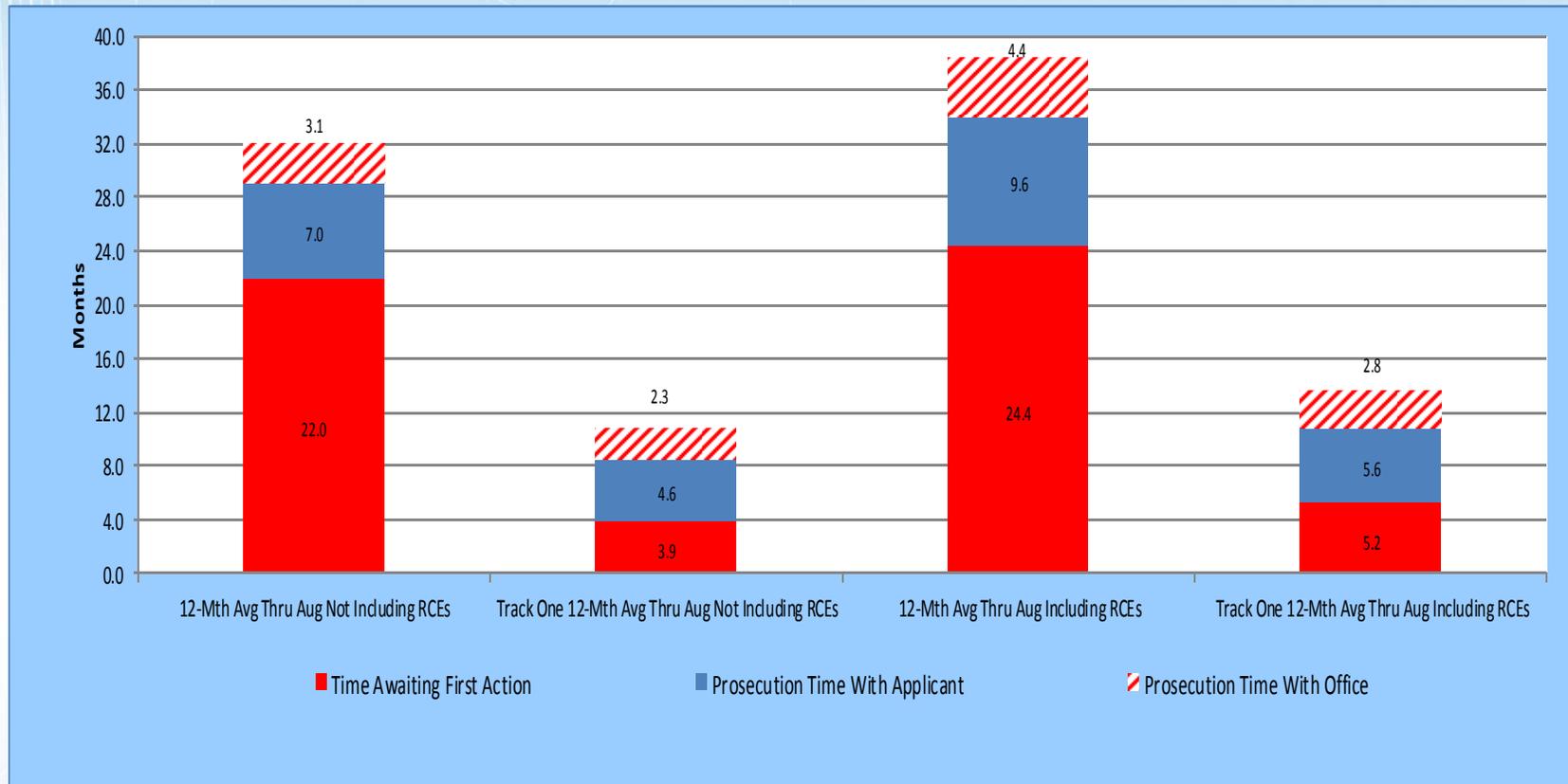
Filings by Month

(As of September 7, 2013)



First Patent Issued on January 10, 2012 from a September 30, 2011 Prioritized Examination filing

Track One Office Time/Applicant Time: Track One vs. Total Pendency (12-month Rolling Average through August 2013)



Top 3 Reasons for Dismissal

- Missing or defective oath/declaration on the date of filing
- Claims in excess of either 4 independent or 30 total claims
- Unpaid fees as of filing date

.....we are currently considering changes to the Program to address these dismissal reasons



Comparison of Fast Examination Options

| Track One Prioritized Examination | Accelerated Examination | Patent Prosecution Highway | | | | | | | | | | | | | | | | | | |
|--|---|--|-----------|-----|-----------|------|---|----------|-------------------|----|-----|-----------|------|---|----------|-------------------|-----|------|-----------|------|
| \$4000 fee \$2000 small entity fee, \$1000 micro entity fee | \$140 petition fee \$70 small entity fee, \$35 micro entity fee | No additional fee | | | | | | | | | | | | | | | | | | |
| Limited to four independent claims and no more than 30 total claims | Limited to three independent claims and no more than 20 total claims (no multiple dependent claims) | No claim limit (Normal excess claim fees apply) | | | | | | | | | | | | | | | | | | |
| No examination support documents required | Requires preexamination search documents and an examination support document | Entry based upon at least one allowable claim in counterpart foreign application | | | | | | | | | | | | | | | | | | |
| Follows normal interview practice | Examiner interview required before issuing an Office Action | Follows normal interview practice | | | | | | | | | | | | | | | | | | |
| Continuations and RCEs are eligible for the program | Continuations are eligible for the program | Continuations are eligible for the program (before first action is issued) | | | | | | | | | | | | | | | | | | |
| Number of applications admitted to the program limited to 10,000 per fiscal year | No limit on number of applications admitted to the program per year | No limit on number of applications admitted to the program per year | | | | | | | | | | | | | | | | | | |
| <p>FY13 First Action Pendency (Months)</p> <table border="1"> <thead> <tr> <th>Category</th> <th>Pendency (Months)</th> </tr> </thead> <tbody> <tr> <td>Track One</td> <td>3.9</td> </tr> <tr> <td>All Cases</td> <td>18.4</td> </tr> </tbody> </table> | Category | Pendency (Months) | Track One | 3.9 | All Cases | 18.4 | <p>FY13 First Action Pendency (Months)</p> <table border="1"> <thead> <tr> <th>Category</th> <th>Pendency (Months)</th> </tr> </thead> <tbody> <tr> <td>AE</td> <td>4.9</td> </tr> <tr> <td>All Cases</td> <td>18.4</td> </tr> </tbody> </table> | Category | Pendency (Months) | AE | 4.9 | All Cases | 18.4 | <p>FY13 First Action Pendency (Months)</p> <table border="1"> <thead> <tr> <th>Category</th> <th>Pendency (Months)</th> </tr> </thead> <tbody> <tr> <td>PPH</td> <td>13.1</td> </tr> <tr> <td>All Cases</td> <td>18.4</td> </tr> </tbody> </table> | Category | Pendency (Months) | PPH | 13.1 | All Cases | 18.4 |
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| Category | Pendency (Months) | | | | | | | | | | | | | | | | | | | |
| AE | 4.9 | | | | | | | | | | | | | | | | | | | |
| All Cases | 18.4 | | | | | | | | | | | | | | | | | | | |
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| PPH | 13.1 | | | | | | | | | | | | | | | | | | | |
| All Cases | 18.4 | | | | | | | | | | | | | | | | | | | |





AMERICA INVENTS ACT

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Preissuance Submissions (aka Third-Party Submissions)

Effective September 16, 2012

Common Pitfalls of Non-Compliant Submissions

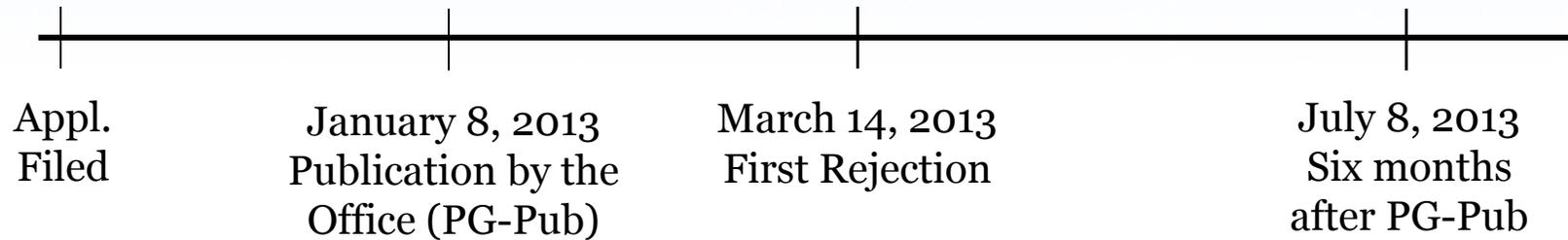
- Timing
- Publications
- Evidence of Publication (Affidavits/Declarations)
- Concise Description of Relevance
- Signature

Timing

- Must submit prior to the earlier of:
 - date a notice of allowance is given or mailed; or
 - later of:
 - 6 months after the date on which the application is first published by the Office; or
 - The date of first rejection of any claim by the examiner

Timing Example

Must make submission on or before July 7, 2013



Publications

- Do not submit documents that do not qualify as publications (e.g., unpublished internal documents of a corporation intended to be confidential, e-mail correspondence not widely disseminated to the public)
- Refer to MPEP § 2128 for guidance regarding “printed publications”

Evidence of Publication

- Affidavits/declarations supporting publication must comply with formal requirements set forth in MPEP § 715.04(II)
- Limit to facts establishing why a submitted document qualifies as a publication:
 - Explain how the affiant/declarant has personal knowledge of the facts described therein
 - Be specific to document(s) submitted for consideration
 - Do not use as a mechanism to place information not pertinent to establishing the document as a publication before the examiner

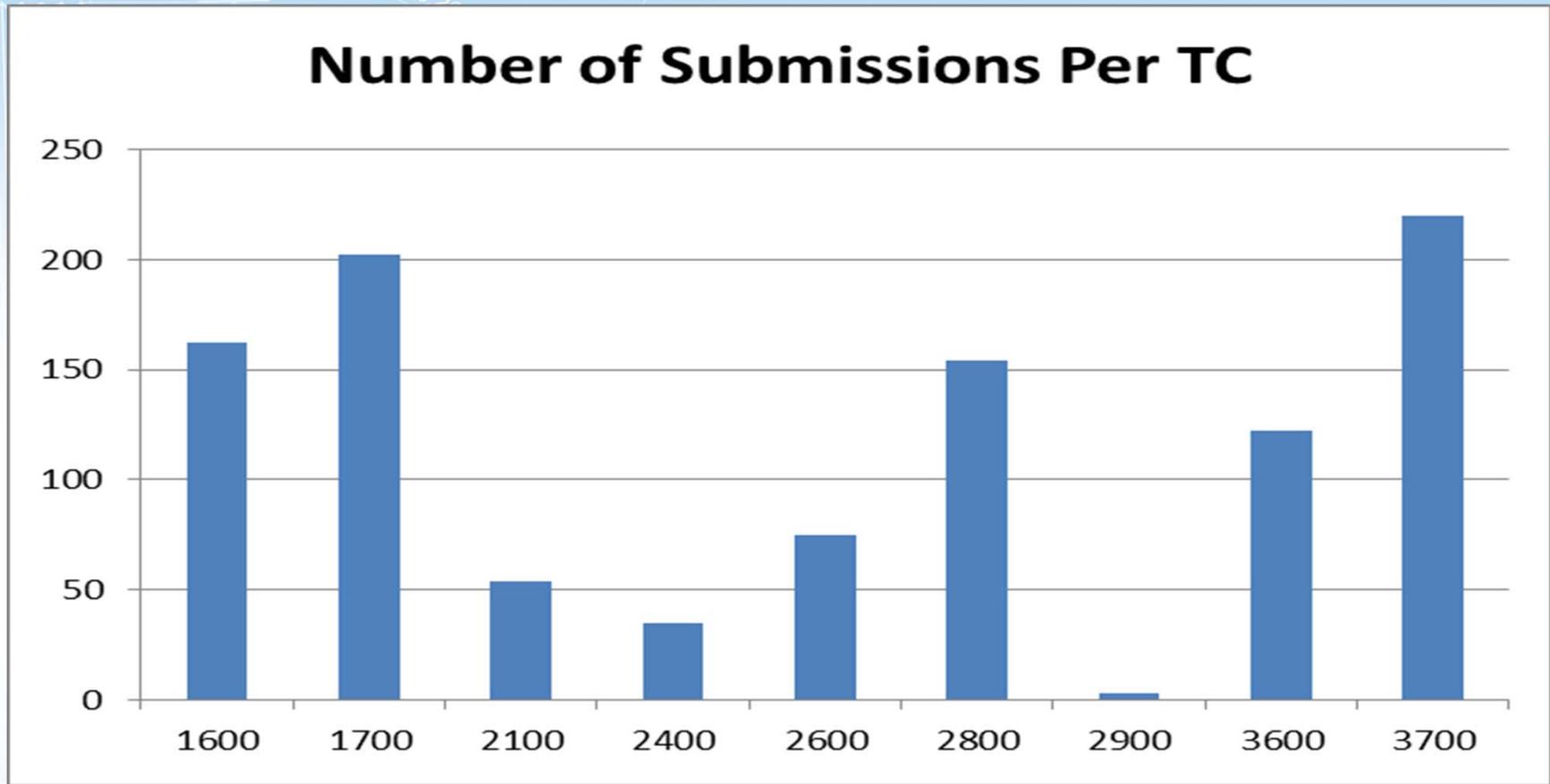
Concise Description of Relevance

- Concise description should explain how the publication is of potential relevance to the examination of the application:
 - Do not include arguments against patentability or set forth conclusions regarding whether one or more claims are patentable
 - Provide more than a bare statement

Signature

- Submission must be signed by the submitter
- Real party in interest can remain anonymous by having someone else make the third-party submission for them, but the submitter cannot remain anonymous:
 - Example: “/Anonymous/” would not be proper

Number of Submissions (As of August 30, 2013)



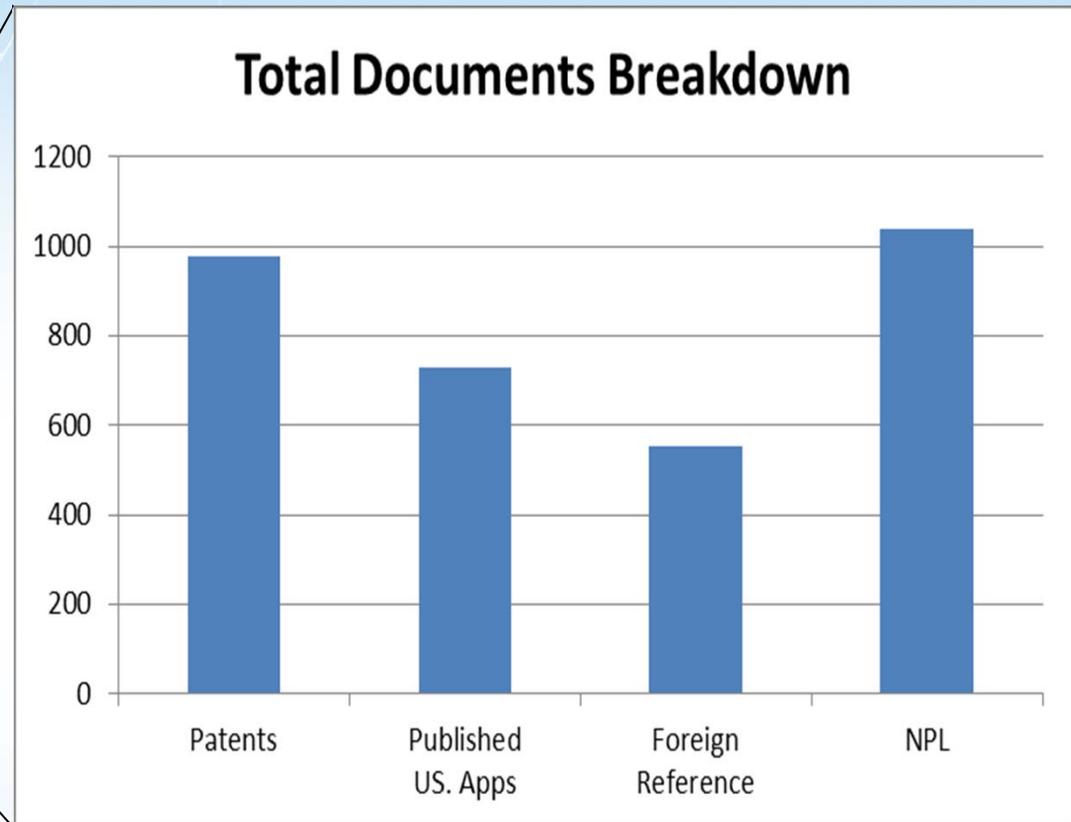
Total 3rd Party Submissions

1050



Composition of Submissions (As of August 30, 2013)

| Total Documents | |
|------------------------|-------------|
| Patents | 978 |
| Published US Apps | 730 |
| Foreign Reference | 552 |
| NPL | 1038 |
| Total Documents | 3298 |

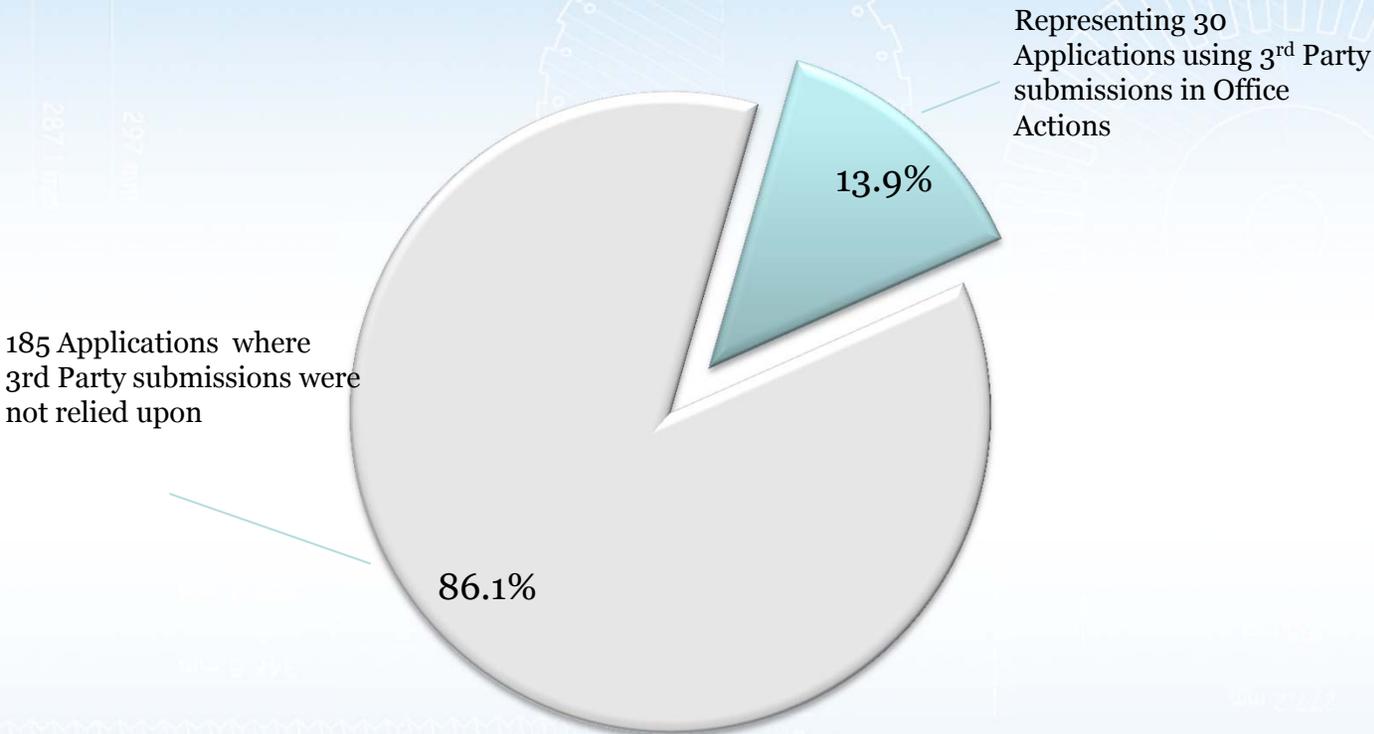


Compliance of Submissions (As of August 30, 2013)



Submissions Resulting in Rejections (As of August 30, 2013)

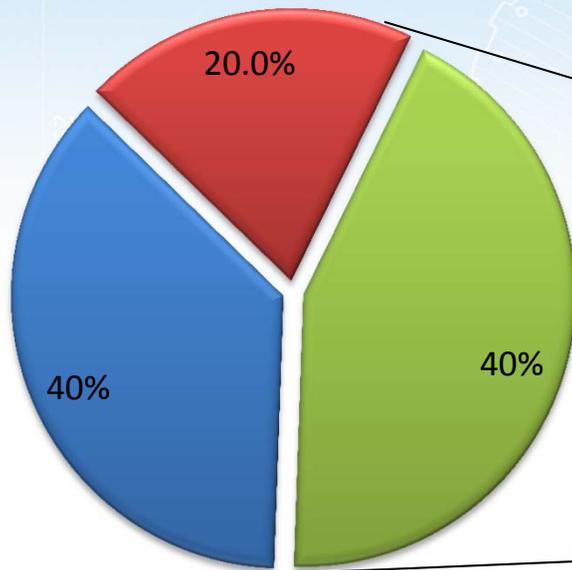
Applications w/Office Actions Generated after Receipt of Proper Third Party Submissions



Current Through 9/3/2013

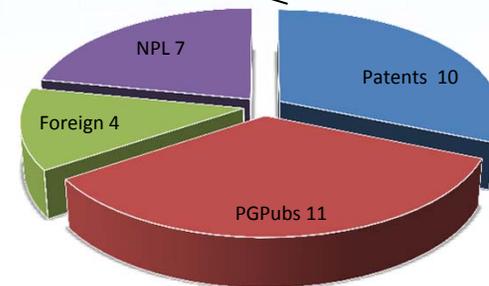
Use of Submissions (As of August 30, 2013)

Applications having Rejections (by Statute) & Using Third Party Submissions



- 103 Rejections Based Actions
- 102 Rejections Based Actions
- Both 102 & 103 Rejections Based Actions

Current Through 8/16/2013

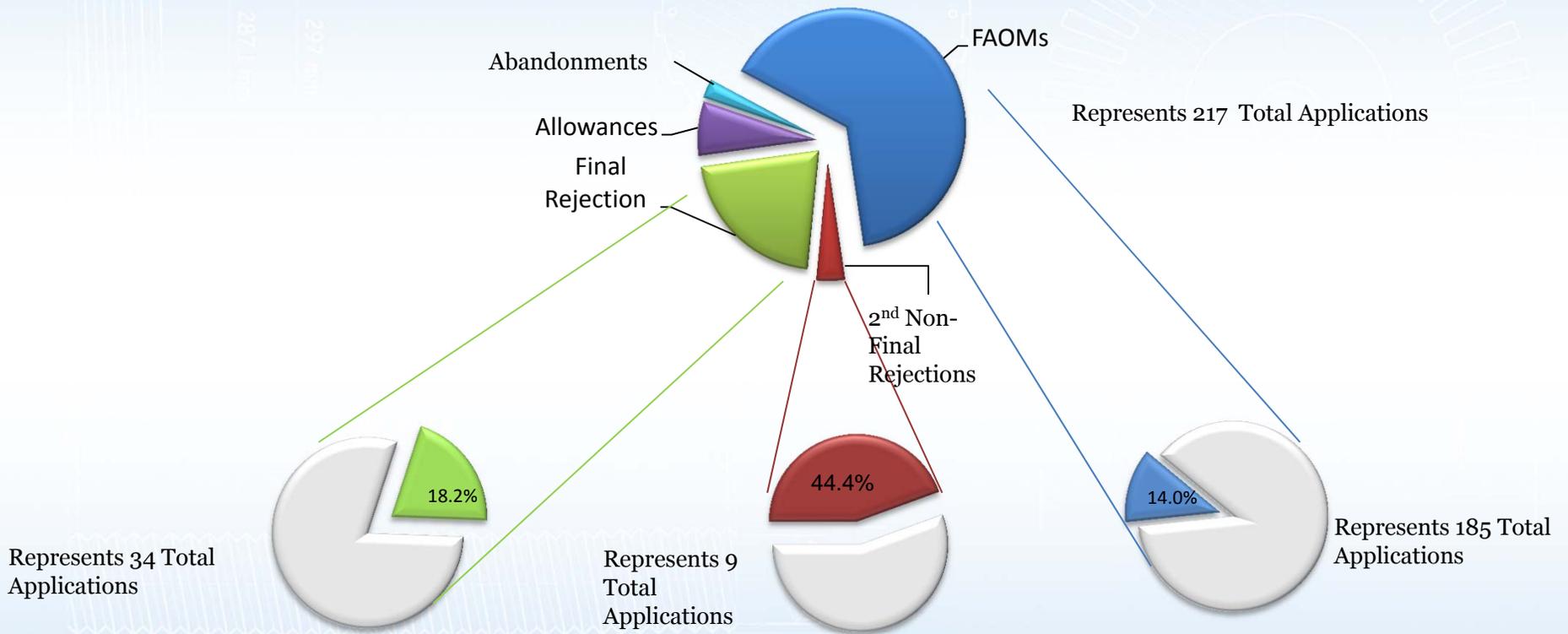


Number of References Used (by type)

Represents 30 Total Applications

Submissions Resulting in Mailed Rejections (As of August 30, 2013)

Applications w/Mailed Office Actions (by type) following Proper Third Party Submissions



Examiner Survey: Usefulness of Submissions

(As of August 30, 2013)

Question: Overall, to what extent were the submissions by the third party useful during the examination of your application?

- **52% rated Great to Moderately useful**
- **48% rated Limited to Not Useful**

Examiner Survey: Helpfulness of Submissions

(As of August 30, 2013)

Question: Overall, to what extent were the concise explanations helpful in identifying pertinent parts of the submissions?

- **63.5% rated Great to Moderately Useful**
- **36.5% rated Limited to Not Useful**



AMERICA INVENTS ACT

IMPLEMENTATION

Inventor's Oath/Declaration

Effective September 16, 2012

Topics

- Substitute Statement
- Application Data Sheet
- Power of Attorney
- Correction of Inventorship

Substitute Statement Question

- Sometimes when I file a nonprovisional application, I discover that I will not be able to obtain a signature on the oath or declaration from at least one of the inventors:
 - so I think that I need to file a substitute statement (Form PTO/AIA/02 or an equivalent)
- **Question**: Under what conditions can a substitute statement be submitted, and who can sign a substitute statement?

Substitute Statement Answer

- **Joint inventors** (who are the applicant):
 - On behalf of one or more inventors who refuse to sign or cannot be found or reached
 - Each participating inventor needs to:
 - sign the substitute statement on behalf of the non-signing inventor, and
 - execute a declaration for themselves
- **Assignee, obligated assignee, or sufficient proprietary interest party** (if named as the applicant (*e.g.*, in an ADS submitted on filing)):
 - On behalf of an inventor who refuses, cannot be found or reached, is deceased or is legally incapacitated
- **Legal representative** (who is the applicant):
 - On behalf of a deceased or legally incapacitated inventor

Substitute Statement and Juristic Entity Applicant Notes

- Where the substitute statement is signed by a **juristic entity** applicant (e.g., a corporation as assignee), the signer must either:
 - List a title that carries apparent authority (President, Vice President, Secretary, etc.); or
 - Make a statement of authorization to act
 - Form PTO/AIA/02 now includes this statement
- As the signer will be an authorized individual acting on behalf of the juristic entity, the juristic entity applicant should also be identified
 - Form PTO/AIA/02 now includes a box for this information

Application Data Sheet Question

- I filed a continuation of a nonprovisional application. Like I have always done, I made the benefit claim in the first sentence of the specification of the continuation:
 - but the benefit claim was not listed on our filing receipt.
- **Question**: Why didn't the USPTO pick up the benefit claim?

Application Data Sheet Answer

- For an application filed under 35 U.S.C. 111(a) on/after September 16, 2012:
 - benefit claims (and foreign priority claims) must be made in an application data sheet to be effective; and
 - benefit claims must be submitted within the later of 4 months from filing or 16 months from the earlier application's filing date

Application Data Sheet Notes

- If an ADS containing a benefit claim is not timely submitted:
 - a petition to accept an unintentionally delayed benefit claim and fee is necessary
- Although the USPTO will not recognize the benefit claim(s) presented in the first sentence(s) of the specification:
 - express incorporation by reference statements are still made in the specification (e.g., first sentence). See current 37 CFR 1.57(b)

Power of Attorney Question

- My client, the assignee, wants me to file and prosecute the application:
 - but the assignee does not want to be identified as the applicant
- **Question**: Can the assignee continue to file a power of attorney (POA) supported by a statement under 37 CFR 3.73(c) to appoint me?

Power of Attorney Answer

- No. For an application filed on/after September 16, 2012:
 - POA can be signed only by the applicant
 - If the assignee is not the named applicant, then the USPTO will not accept a POA signed by the assignee
- To give a POA where the inventors are the applicant, the assignee must become the applicant by filing **a request to change the applicant** (37 CFR 1.46(c)), which must include:
 - **Corrected ADS** specifying the applicant in the applicant information section (with markings to show the changes); and
 - **Statement under 37 CFR 3.73(c)**

Power of Attorney Notes

- Power of attorney rule, 37 CFR 1.32, provides that a power of attorney can be signed by the applicant for patent or the patent owner
- However, “patent owner” refers to where a patent has already issued (i.e., reissue applications, reexamination proceedings, and supplemental examination proceedings)

Power of Attorney Notes (cont.)

- Where there is an assignee:
 - Office recommends that the assignee be identified as the applicant on the ADS at the time of filing and provide a power of attorney (using Form PTO/AIA/82 or an equivalent):
 - This will reduce practitioner conflicts of interest as to the identity of the client
 - Office is required to issue the patent to the real party in interest, and:
 - 37 CFR 1.46 requires notification of any change in the real party in interest no later than payment of the issue fee

Correction of Inventorship Question

- I filed a nonprovisional application in 2010 and paid small entity fees. I responded to a first Office action.
- The examiner is ready to allow some, but not all, of the claims:
 - I need to cancel some claims, and
 - I must delete an inventor because she is not an inventor for the allowable claims.
- **Question:** How do I delete the inventor, and do I have to pay the \$70 (37 CFR 1.17(i)(1)) fee required by 37 CFR 1.48(a) AND the \$300 (37 CFR 1.17(d)) fee required by 37 CFR 1.48(c)?

Correction of Inventorship Answer

- To delete the inventor, file:
 - request under 37 CFR 1.48(a) to change the inventorship;
 - corrected ADS that identifies each inventor by his or her legal name (with markings to show the change(s));
 - \$70 processing fee (37 CFR 1.17(i)(1)); and
 - statement that the request is due solely to the cancellation of claims in the application

- \$300 fee in 37 CFR 1.17(d) that is specified in 37 CFR 1.48(c) (effective March 19, 2013) is not required if the statement accompanies the request to change the inventorship

Correction of Inventorship Notes

- Any request to correct inventorship filed on/after September 16, 2012 must comply with revised 37 CFR 1.48, regardless of the application filing date
- If adding an inventor in an application filed before September 16, 2012, the declaration must comply with former 37 CFR 1.63
- All changes to inventorship or inventor names in a provisional application should be filed under 37 CFR 1.48(d):
 - includes correcting or updating the name of an inventor
 - 37 CFR 1.48(f) is limited to nonprovisional applications



AMERICA INVENTS ACT

IMPLEMENTATION

Micro-entity Status/Discount

Effective March 19, 2013

Topics

- Previous Application Limit
- Gross Income Threshold
- Assignment
- Research Foundation
- University Location

Gross Income Definition

- 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 (i.e., **previous application limit**);
 - Did not have a gross income exceeding 3 times the median household income in the preceding calendar year (i.e., **gross income threshold**);
- 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) (e.g., **assignment**)

Previous Application Limit Question

- Inventor-applicant has 5 previous applications but has not claimed micro entity status in any of them
- Inventor-applicant otherwise meets the “gross income” micro entity definition
- **Question**: Can inventor-applicant claim micro entity status under the “gross income” micro entity definition?

Previous Application Limit Answer

- No, inventor-applicant may not validly claim micro entity status under the “gross income” micro entity definition
- 35 U.S.C. 123(a)(2) requires that applicant not have been named as an inventor on more than 4 previously filed patent applications (with certain exceptions)
 - Previously filed applications in which micro entity status was not, or could not have been, claimed are not included in the exception

Gross Income Threshold Question

- Inventor-applicant's spouse has a gross income exceeding the "gross income" threshold, and they filed a joint tax return for the previous calendar year
- Inventor-applicant otherwise meets the "gross income" micro entity definition
- **Question:** Can inventor-applicant claim micro entity status under the "gross income" micro entity definition?

Gross Income Threshold Answer

- Yes, inventor-applicant may validly claim micro entity status under the “gross income” micro entity definition
- “Gross income” limit in 35 U.S.C. 123(a)(3) pertains to inventor-applicant, and not to inventor-applicant’s spouse
- “Gross income” limit in 35 U.S.C. 123(a)(3) applies to the amount of income that inventor-applicant would have reported as gross income if inventor-applicant had filed a separate tax return, regardless whether inventor-applicant actually filed a joint tax return and not a separate tax return

Assignment Question

- Inventor-applicant assigned rights in the patent application to an entity that does not qualify for micro entity status, but all rights in the patent application were subsequently re-transferred back to inventor-applicant
- Inventor-applicant otherwise meets the “gross income” micro entity definition
- **Question:** Can inventor-applicant claim micro entity status under the “gross income” micro entity definition?

Assignment Answer

- No, inventor-applicant may not validly claim micro entity status under the “gross income” micro entity definition
- 35 U.S.C. 123(a)(4) requires that inventor-applicant not have assigned, granted, or conveyed, and not be 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 does not meet the micro entity gross income limit
- 35 U.S.C. 123(a)(4) does not contain an exception for applications in which the rights were subsequently re-transferred back to inventor-applicant

University Definition

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)

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

Research Foundation Question

- University utilizes a separate research foundation for technology transfer
- Research foundation qualifies as a small entity as defined in 37 CFR 1.27
- Inventor (not a university employee) has assigned his/her invention directly to the research foundation, and the research foundation provides the university (an IHE) a non-exclusive, non-transferrable, royalty-free license for research use to the technology
- **Question:** Can applicant (research foundation) claim micro entity status under the “university” micro entity definition?



Research Foundation Answer

- Yes, applicant (research foundation) may validly claim micro entity status under the university micro entity definition
- 35 U.S.C. 123(d)(2) requires that applicant (research foundation) have 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 applications 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)), which the research foundation has done
- 37 CFR 1.29(d)(1) requires that applicant qualify as a small entity, which the research foundation is

University Location Question

- Inventor is an employee of a university located outside of the United States but which offers classes on line in a manner that make classes available in the United States
- Inventor receives the majority of his/her income from the university
- **Question:** Can applicant (university employee) claim micro entity status under the “university” micro entity definition?

University Location Answer

- No, applicant (university employee) may not validly claim micro entity status under the “university” micro entity definition
- Section 101(a) of the Higher Education Act of 1965 requires that the institution of higher education be located in a “State”



AMERICA INVENTS ACT

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Supplemental Examination

Effective September 16, 2012

Purpose

- Provide patentees with a mechanism to immunize a patent from allegations of inequitable conduct, subject to certain limitations
- Patent owner may request supplemental examination of a patent to “consider, reconsider, or correct information” believed to be relevant to the patent

Standard

- Within 3 months from the filing date of the request, Office will determine whether any of the item(s) of information raises a substantial new question of patentability (SNQ) affecting a claim of the patent
- If SNQ is raised, ex parte reexamination will be ordered in due course
- If no SNQ is raised:
 - ex parte reexamination will not be ordered; and
 - reexamination fee for supplemental examination will be refunded



Conclusion of Proceeding

- Supplemental examination proceeding will conclude with the electronic issuance of the supplemental examination certificate, which will be viewable in Public PAIR
- Certificate will indicate the result of Office's determination whether any item of information filed with the request raises a SNQ

Advantages

- No involvement by third parties permitted
- Fast determination made by Office
- “Information” is not limited to patents and publications
- Useful to have claims reconsidered in light of recent court decision(s) (e.g., KSR, Bilski, Ultramercial, Myriad)

Statistics

(As of August 28, 2013)

- 22 requests have received a filing date
- 18 requests have been decided
- 14 of the decided supplemental examination requests have resulted reexamination order because SNQ raised
- 4 requests raised no SNQ

Request Requirements

- Primary components are comparable to request requirements for ex parte reexamination
- Identification of the number of the patent, and each claim of the patent, for which supplemental examination is requested
- List of the items of information requested to be considered, reconsidered, or corrected
 - Information is not limited to patents and printed publications
 - Maximum of 12 items of information per request

Request Requirements (cont.)

- Separate, detailed explanation of the relevance and manner of applying each item of information to each claim of the patent for which supplemental examination is requested
- Summary of the relevant portions of any submitted document, other than the request, that is over 50 pages in length

Helpful Hints in Filing a Request

- Use Transmittal Form PTO/SB/59
 - Located at <http://www.uspto.gov/forms/sb0059.pdf>
- Make sure every item of information is listed in the request, preferably on Part B of PTO/SB/59
- Provide a **complete** copy of the patent for which supplemental examination is requested, including all certificates or disclaimers
- Use **claim charts** to provide the explanations required by 37 CFR 1.610(b)(5)

Helpful Hints in Filing a Request (cont.)

- Ensure that every item of information is clearly applied to at least 1 claim for which supplemental examination is requested
- Confirm that every claim for which supplemental examination is requested is discussed with regard to at least 1 item of information
- Make sure the request does not discuss any claim for which supplemental examination is not requested, or any disclosure that is not listed as an item of information

More Helpful Hints

- Prior to filing, consult:
 - December 19, 2012 blog on the AIA microsite:
<http://www.uspto.gov/blog/aia/>
 - Best Practices document posted at:
http://www.uspto.gov/aia_implementation/Best_Practices_to_Meet_Certain_Supplemental_Examination_Filing_Requirements_12_19_12.pdf; and
 - Frequently Asked Questions posted at:
http://www.uspto.gov/aia_implementation/faqs-supplemental-exam.jsp

More Helpful Hints

- Prior to filing, review requests that have received a filing date, e.g.:
 - 96/000,032 – request for a design patent
 - 96/000,021 – a request for a chemical/biotech patent
 - 96/000,007 – a request for an electrical patent
 - 96/000,028 – a request for a mechanical patent

Advice About Notice of Non-Compliant Request

- If you file a request that is not compliant with filing date requirements, you will receive a notice informing you of the defects and a time to correct the request:
 - Call the number on the notice if you have any questions on how to correct the noted defects
 - File the corrected request as a follow on paper and use the **same control number** (e.g., 96/000,xxx)
 - Do NOT file as a “new” proceeding



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Questions?



AMERICA INVENTS ACT

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First Inventor to File

Effective September 16, 2012

Examiner Training Plan

- Overview Phase (March-April 2013)
- Comprehensive Phase (June-August 2013)
- Follow-On Phase (August 2013 - ?)

For the uncommon situations (usually prioritized examination) in which examination under the AIA was required before the comprehensive phase was available, one-on-one training with a lead FITF point of contact from the examiner's technology center was provided.

Examiner Training: Overview Phase

- Preliminary video
 - alert examiners to upcoming changes in examination practice
 - inform examiners about upcoming training
- Live lecture
 - explain AIA indicators in USPTO systems
 - introduce effective filing date per 35 U.S.C. 100(i)
 - introduce new anticipation provisions and their exceptions per 35 U.S.C. 102(a) and 102(b)
- Follow-up video
 - review effective filing date per 35 U.S.C. 100(i)
 - discuss how to identify 102(a)(1) and 102(a)(2) prior art

Examiner Training: Comprehensive Phase

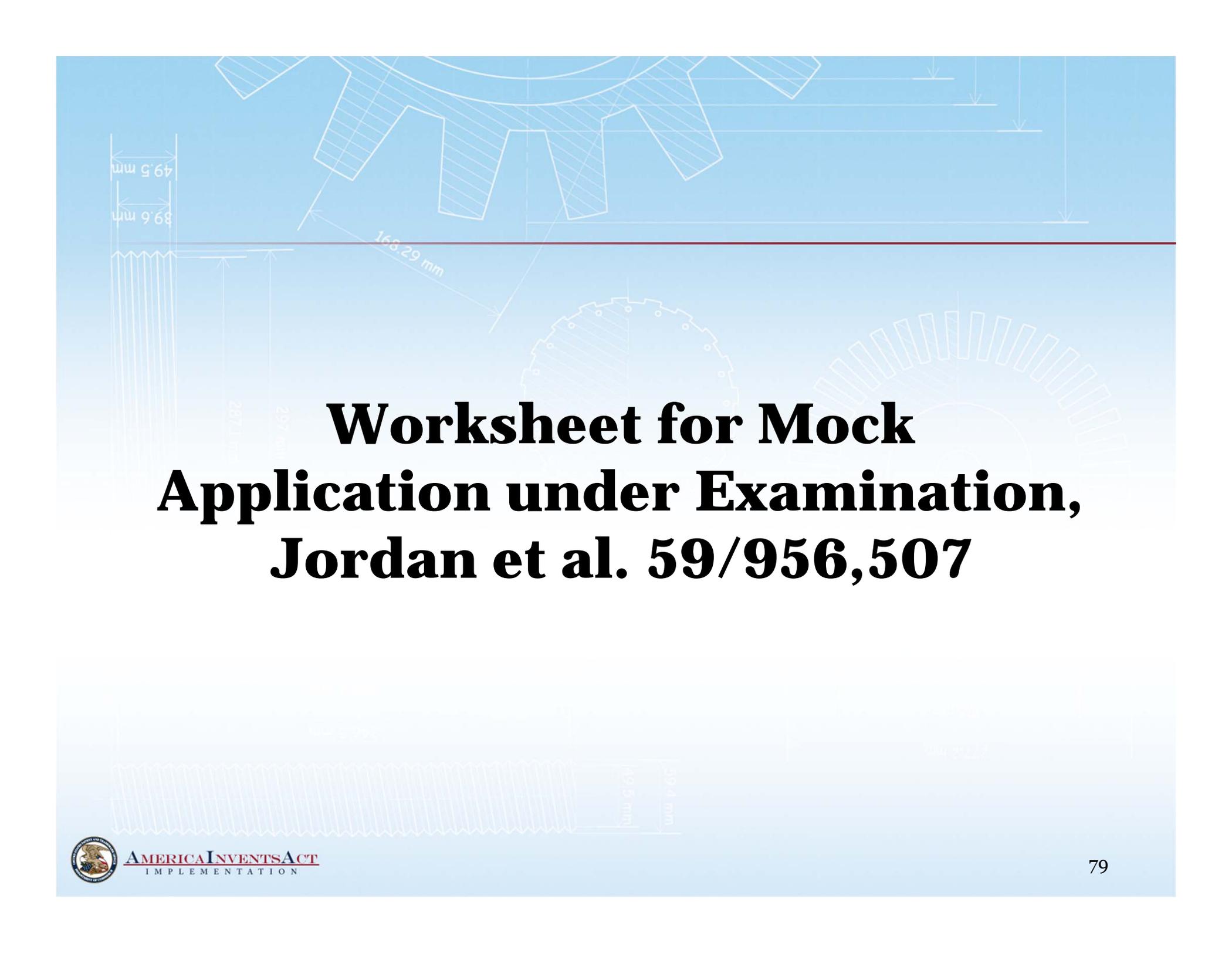
- Preliminary videos
 - remind examiners about non-FITF provisions of the AIA
 - define terms needed to understand FITF provisions
- Live lecture
 - discuss foreign priority and distinctions between pre-AIA and AIA meaning of "effective filing date"
 - explain 35 U.S.C. 102(a)(1) and 102(a)(2) and their exceptions in depth, using examples and timelines
 - introduce declarations under 37 CFR 1.130 to invoke exceptions
 - discuss changes to 35 U.S.C. 103

Examiner Training: Follow-on Phase

- Hands-On Workshop
 - use a mock application to practice determining inventors, dates, and other non-technology-specific information relevant to examination
 - use a mock application to practice evaluating potential prior art
- Follow-up videos and computer-based training (forthcoming)
 - discuss how to evaluate declarations under 37 CFR 1.130 and other means of invoking exceptions under 35 U.S.C. 102(b)
 - consider how FITF applies to reissue applications

Hands On Workshop

- Excerpts from a mock AIA application under examination (Jordan et al. 59/956,507)
 - Filing receipt
 - First page of specification
 - IDS – 1 reference cited
 - PTO-892 – 5 references cited
 - First page of all 6 references
- Worksheet for application under examination (mock AIA application Jordan et al. 59/956,507) with timeline
- Worksheets for potential prior art references
- Timelines (blank) for potential prior art references



**Worksheet for Mock
Application under Examination,
Jordan et al. 59/956,507**



Worksheet for Mock Application under Examination, Jordan et al. 59/956,507

Office Action Workshop: Worksheet for Application under Examination

Fill in the chart about the Jordan et al. mock application under examination. Indicate the relevant dates on the timeline. Show the grace period.

| Application under examination 59/956,507 | |
|---|--|
| 1. Who is the applicant? | |
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Filing Receipt in Mock Application under Examination, Jordan et al. 59/956,507



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www.uspto.gov

| APPLICATION NUMBER | FILING or 371(c) DATE | GRP ART UNIT | FIL FEE REC'D | ATTY DOCKET NO | TOT CLAIMS | END CLAIMS |
|--------------------|-----------------------|--------------|---------------|----------------|------------|------------|
| 59/956,507 | 02/03/2014 | 3773 | 1260 | 45456-0102 | 12 | 1 |

CONFIRMATION NO. 7285

12346

FILING RECEIPT



*OC00000057605684

Inventor(s)

Charles Jordan, Sr. Brooklyn, NY
Alexander Robert Thompson, New York, NY
Kwan Jian Pak Seoul, KOREA, REPUBLIC OF,

Applicant(s)

VICTOR PEST CONTROL COMPANY

Assignment For Published Patent Application
VICTOR PEST CONTROL COMPANY

Power of Attorney: The patent practitioners associated with Customer Number 12346.

Domestic Priority data as claimed by applicant

NONE

Foreign Applications for which priority is claimed (You may be eligible to benefit from the Patent Prosecution Highway program at the USPTO. Please see <http://www.uspto.gov> for more information.)

REPUBLIC OF KOREA 12-2013-004567892 10/2/2013

Foreign application information must be provided in an Application Data Sheet in order to constitute a claim to foreign priority. See 37 CFR 1.55 and 1.76.



AMERICA INVENTS ACT
IMPLEMENTATION

Worksheet for Mock Application under Examination, Jordan et al. 59/956,507

Office Action Workshop: Worksheet for Application under Examination

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Filing Receipt in Mock Application under Examination, Jordan et al. 59/956,507



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AMERICA INVENTS ACT
 IMPLEMENTATION

Worksheet for Mock Application under Examination, Jordan et al. 59/956,507

Office Action Workshop: Worksheet for Application under Examination

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Filing Receipt in Mock Application under Examination, Jordan et al. 59/956,507



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AMERICA INVENTS ACT
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Worksheet for Mock Application under Examination, Jordan et al. 59/956,507

Office Action Workshop: Worksheet for Application under Examination

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Timeline for Mock Application under Examination, Jordan et al. 59/956,507

Jordan et al.

application 59/956,507

U.S. application filing date February 3, 2014



Worksheet for Mock Application under Examination, Jordan et al. 59/956,507

Office Action Workshop: Worksheet for Application under Examination

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Filing Receipt in Mock Application under Examination, Jordan et al. 59/956,507



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CONFIRMATION NO. 7285

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Mary Catherine Cebulak, Esq.
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AMERICA INVENTS ACT
IMPLEMENTATION

Worksheet for Mock Application under Examination, Jordan et al. 59/956,507

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Filing Receipt in Mock Application under Examination, Jordan et al. 59/956,507



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Filing Receipt in Mock Application under Examination, Jordan et al. 59/956,507



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AMERICA INVENTS ACT
IMPLEMENTATION

Worksheet for Mock Application under Examination, Jordan et al. 59/956,507

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| 5. Is there a foreign priority claim? If yes, answer questions 5a and 5b. | Yes |
| 5a. What is the claimed foreign priority date? | October 2, 2013 |
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Timeline for Mock Application under Examination, Jordan et al. 59/956,507

Jordan et al.
application 59/956,507

Korean priority
application filing date
October 2, 2013

U.S. application filing
date February 3, 2014



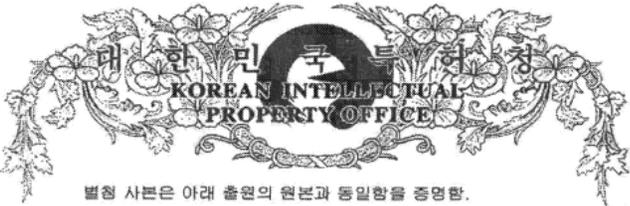
Worksheet for Mock Application under Examination, Jordan et al. 59/956,507

| | |
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Certified Copy of Foreign Priority Application for Mock Application under Examination, Jordan et al. 59/956,507

Issue Number: [REDACTED]



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KOREAN INTELLECTUAL
PROPERTY OFFICE

별첨 사본은 아래 출원의 원본과 동일함을 증명함.

This is to certify that the following application annexed hereto
is a true copy from the records of the Korean Intellectual
Property Office.

출원 번호 : [REDACTED]
Application Number

출원 년 월 일 : [REDACTED]
Filing Date

출원인 : 주식회사 동부하이텍
Applicant(s)

[REDACTED]

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Issue Date : [REDACTED] 1/1

Translation Statement for Mock Application under Examination, Jordan et al. 59/956,507

The present application, 59/956,507 filed on February 3, 2014, is an accurate and true translation of the foreign priority document, a copy of which was submitted with the filing of the application in the United States Patent and Trademark Office on February 3, 2014.

Signed,

/Kyung Park/

Kyung Park
Korean Translator

Worksheet for Mock Application under Examination, Jordan et al. 59/956,507

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Timeline for Mock Application under Examination, Jordan et al. 59/956,507

Jordan et al.

application 59/956,507

35 USC 119(a)-(d) priority

Korean priority
application filing date
October 2, 2013

U.S. application filing
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Worksheet for Mock Application under Examination, Jordan et al. 59/956,507

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| 6. What is the effective filing date? | |



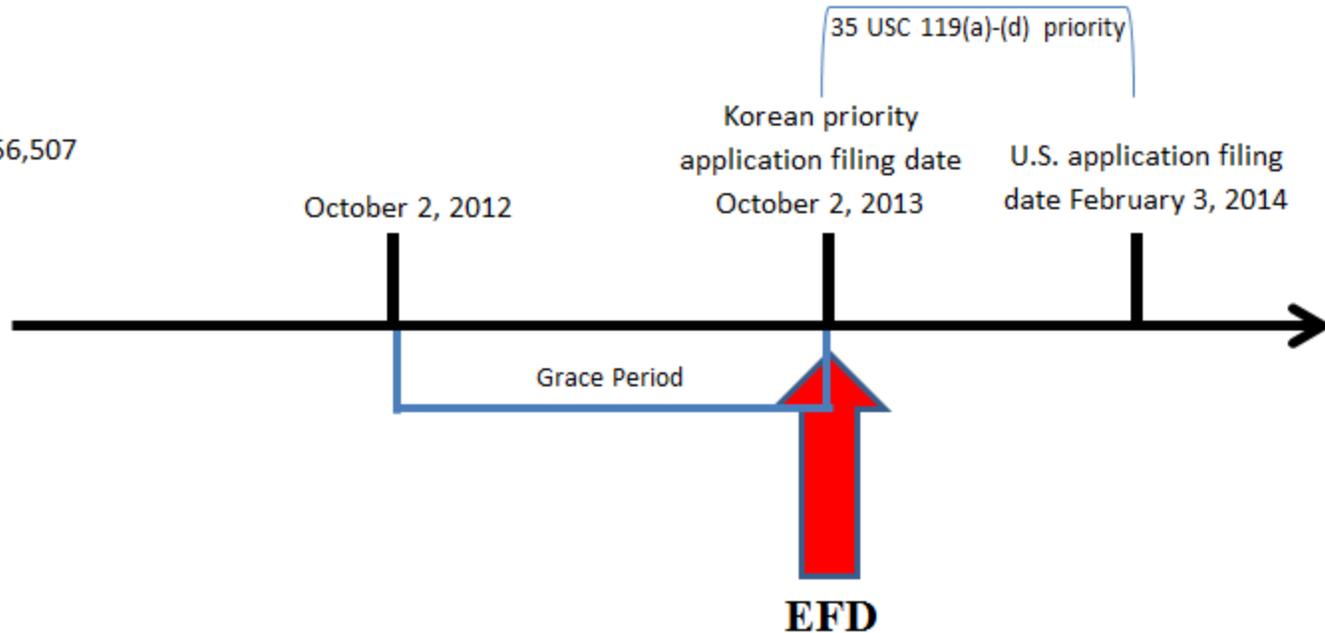
Worksheet for Mock Application under Examination, Jordan et al. 59/956,507

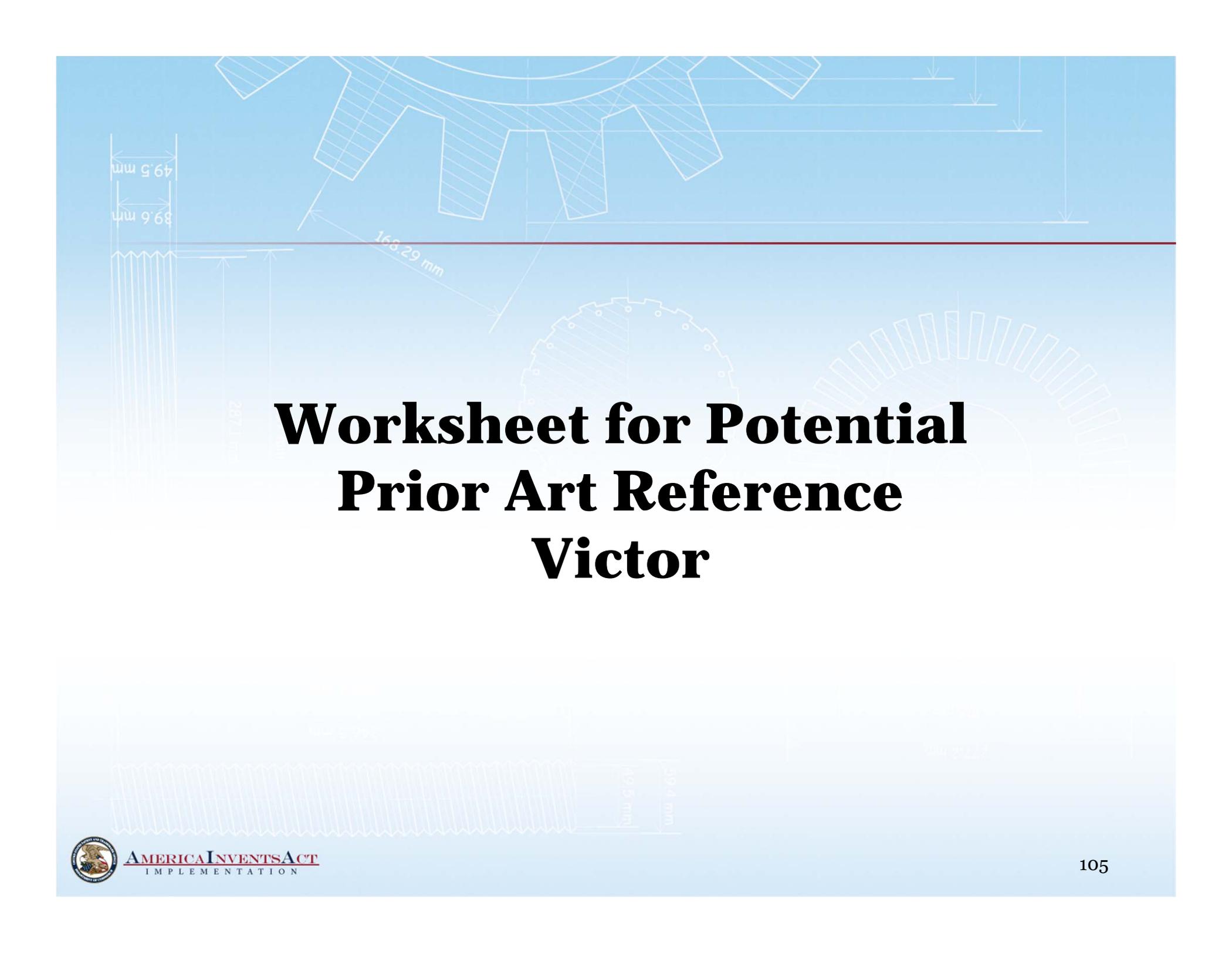
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Timeline for Mock Application under Examination, Jordan et al. 59/956,507

Jordan et al.
application 59/956,507





The background features a technical drawing of a gear and a spring. The gear has a diameter of 168.29 mm. The spring has a height of 49.5 mm and a diameter of 89.6 mm. Other dimensions include 287.1 mm, 41.5 mm, 59.4 mm, and 168.29 mm.

Worksheet for Potential Prior Art Reference Victor



Worksheet for Potential Prior Art Reference Victor

Office Action Workshop: Worksheet for Victor and Jordan, Sr. references

Fill in the chart about the Victor and Jordan Sr. references based on the information provided in the mock application file.

| | Victor reference | Jordan, Sr. reference |
|---|------------------|-----------------------|
| 1. Who is the inventor or author? | | |
| 2. Is the reference a U.S. patent document? If yes, answer questions 2a, 2b, and 2c. | | |
| 2a. What is the actual U.S. filing date? | | |
| 2b. What is the claimed domestic benefit or foreign priority date, if any? | | |
| 2c. What is the effectively filed date? | | |
| 3. What is the public availability date? | | |
| 4. Does the reference meet 102(a)(1)? If so, answer questions 4a and 4b. | | |
| 4a. Does the 102(b)(1)(A) exception apply? | | |
| 4b. Does the 102(b)(1)(B) exception apply? | | |



Potential Prior Art Reference

Victor

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| 4b. Does the 102(b)(1)(B) exception apply? | | |



Worksheet for Potential Prior Art Reference Victor

Office Action Workshop: Worksheet for Victor and Jordan, Sr. references

Fill in the chart about the Victor and Jordan Sr. references based on the information provided in the mock application file.

| | Victor reference | Jordan, Sr. reference |
|---|-----------------------------|-----------------------|
| 1. Who is the inventor or author? | Victor Pest Control Company | |
| 2. Is the reference a U.S. patent document? If yes, answer questions 2a, 2b, and 2c. | No | |
| 2a. What is the actual U.S. filing date? | | |
| 2b. What is the claimed domestic benefit or foreign priority date, if any? | | |
| 2c. What is the effectively filed date? | | |
| 3. What is the public availability date? | | |
| 4. Does the reference meet 102(a)(1)? If so, answer questions 4a and 4b. | | |
| 4a. Does the 102(b)(1)(A) exception apply? | | |
| 4b. Does the 102(b)(1)(B) exception apply? | | |



Worksheet for Potential Prior Art Reference Victor

Office Action Workshop: Worksheet for Victor and Jordan, Sr. references

Fill in the chart about the Victor and Jordan Sr. references based on the information provided in the mock application file.

| | Victor reference | Jordan, Sr. reference |
|---|-----------------------------|-----------------------|
| 1. Who is the inventor or author? | Victor Pest Control Company | |
| 2. Is the reference a U.S. patent document? If yes, answer questions 2a, 2b, and 2c. | No | |
| 2a. What is the actual U.S. filing date? | n/a | |
| 2b. What is the claimed domestic benefit or foreign priority date, if any? | n/a | |
| 2c. What is the effectively filed date? | n/a | |
| 3. What is the public availability date? | | |
| 4. Does the reference meet 102(a)(1)? If so, answer questions 4a and 4b. | | |
| 4a. Does the 102(b)(1)(A) exception apply? | | |
| 4b. Does the 102(b)(1)(B) exception apply? | | |



Potential Prior Art Reference

Victor

 **FREE Ground Shipping** On ALL Orders Over \$69.99!*



Victor® Electronic Rat Trap

model #: M240 | M240CAR

Average Ratings and Reviews

 (55) [Read All 55 Reviews »](#) [Write A Review »](#)

 Like

Best Used For:

Quick, humane kill of rats or mice. Highly economical, the trap kills 50 rats per set of batteries. Can be used anywhere in the home. [read full product details »](#)

\$59.99 | Qty: [ADD TO CART](#)

US Availability: In-Stock

Canada Availability: In-Stock

Eligible for Free Shipping

Product Images



[Upload Your Own Image »](#)

Description

Specs

Special Offers

Reviews

Victor® Electronic Rat Trap

Known for the most innovative rodent control products on the market, **Victor®** presents the **Electronic Rat Trap** - the only rat trap with a patented 3-plate design to prevent escapes.

<http://www.victorpest.com/store/rat-control/m240>

3/27/2013

Potential Prior Art Reference Victor as listed in IDS

| | | | | | |
|--|------|------------------------|------------|--------------------------|--------------------|
| Substitute for form 1449/PTO INFORMATION DISCLOSURE STATEMENT BY APPLICANT <i>(Use as many sheets as necessary)</i> | | | | <i>Complete if Known</i> | |
| | | | | Application Number | Concurrently Filed |
| | | | | Filing Date | February 3, 2014 |
| | | | | First Named Inventor | Jordan Sr. et al. |
| | | | | Art Unit | to be assigned |
| | | | | Examiner Name | to be assigned |
| Sheet 1 | of 1 | Attorney Docket Number | 45456-0102 | | |

| NON PATENT LITERATURE DOCUMENTS | | | |
|---------------------------------|-----------------------|---|----------------|
| Examiner Initials* | Cite No. ¹ | Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published. | T ² |
| | | Website print out of "Victor Electronic Rat Trap," www.victorpest.com/store/rat-control/m240, print out date, March 27, 2013 | |



Worksheet for Potential Prior Art Reference Victor

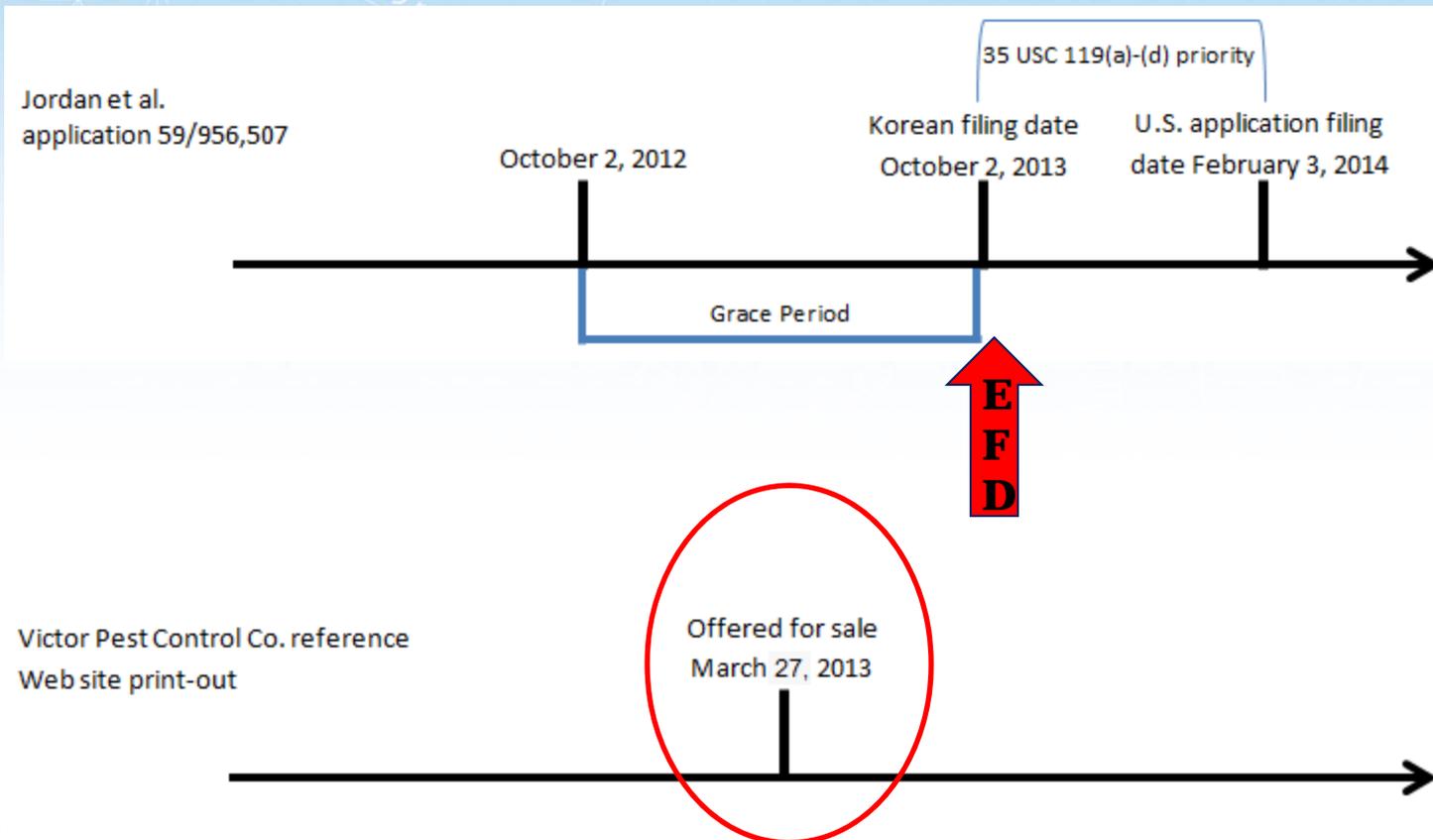
Office Action Workshop: Worksheet for Victor and Jordan, Sr. references

Fill in the chart about the Victor and Jordan Sr. references based on the information provided in the mock application file.

| | Victor reference | Jordan, Sr. reference |
|---|---|-----------------------|
| 1. Who is the inventor or author? | Victor Pest Control Company | |
| 2. Is the reference a U.S. patent document? If yes, answer questions 2a, 2b, and 2c. | No | |
| 2a. What is the actual U.S. filing date? | n/a | |
| 2b. What is the claimed domestic benefit or foreign priority date, if any? | n/a | |
| 2c. What is the effectively filed date? | n/a | |
| 3. What is the public availability date? | March 27, 2013 (earliest evidence of public availability) | |
| 4. Does the reference meet 102(a)(1)? If so, answer questions 4a and 4b. | | |
| 4a. Does the 102(b)(1)(A) exception apply? | | |
| 4b. Does the 102(b)(1)(B) exception apply? | | |



Timeline for Potential Prior Art Reference Victor



Worksheet for Potential Prior Art Reference Victor

Office Action Workshop: Worksheet for Victor and Jordan, Sr. references

Fill in the chart about the Victor and Jordan Sr. references based on the information provided in the mock application file.

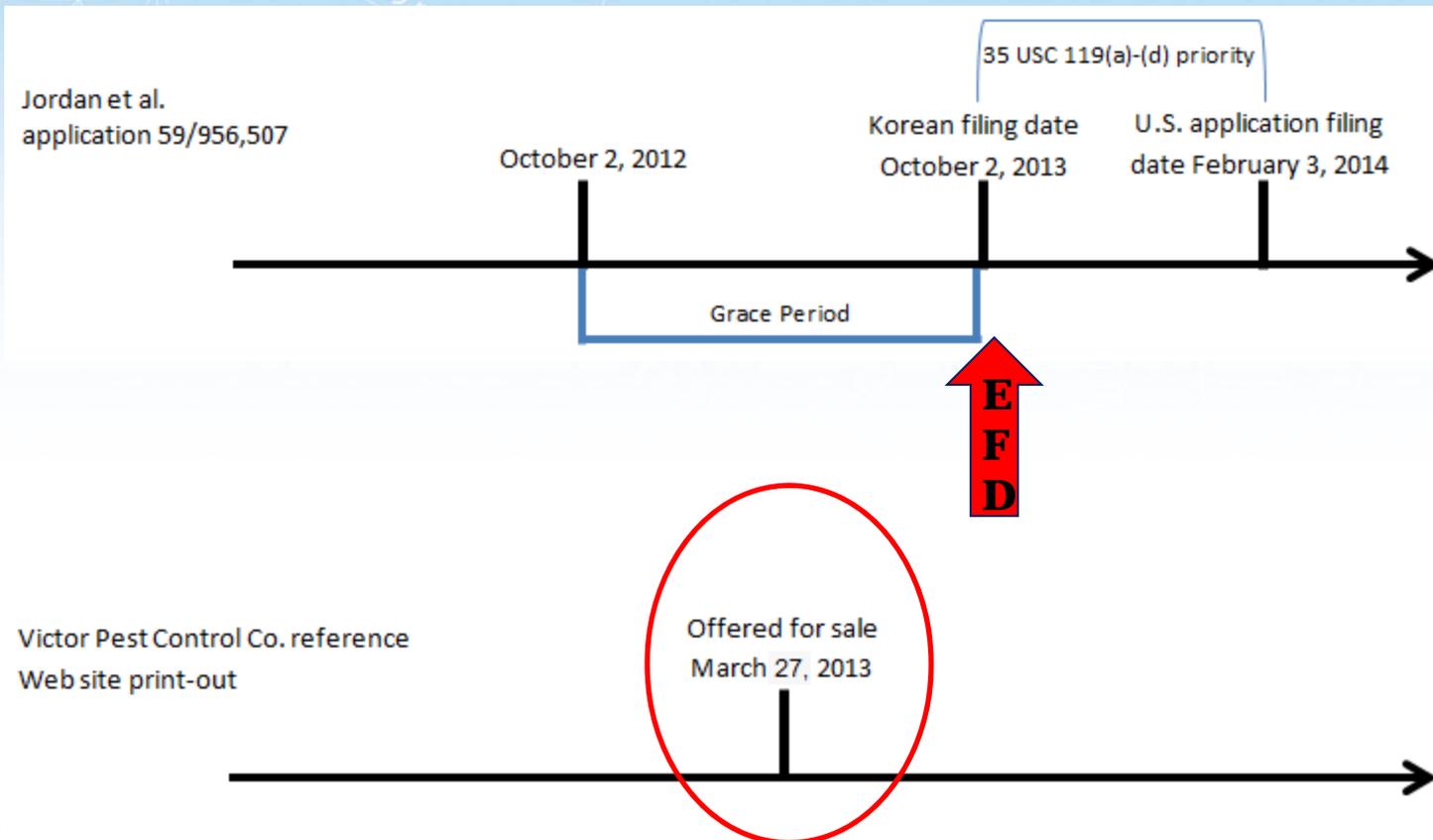
| | Victor reference | Jordan, Sr. reference |
|---|---|-----------------------|
| 1. Who is the inventor or author? | Victor Pest Control Company | |
| 2. Is the reference a U.S. patent document? If yes, answer questions 2a, 2b, and 2c. | No | |
| 2a. What is the actual U.S. filing date? | n/a | |
| 2b. What is the claimed domestic benefit or foreign priority date, if any? | n/a | |
| 2c. What is the effectively filed date? | n/a | |
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| 4a. Does the 102(b)(1)(A) exception apply? | | |
| 4b. Does the 102(b)(1)(B) exception apply? | | |



AIA 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, Published U.S. Patent Application, and Published PCT Application with Prior Filing Date | 102(b)(2) | (A) Disclosure Obtained from Inventor |
| | | (B) Intervening Disclosure by Third Party |
| | | (C) Commonly Owned Disclosures |

Timeline for Potential Prior Art Reference Victor



Worksheet for Potential Prior Art Reference Victor

Office Action Workshop: Worksheet for Victor and Jordan, Sr. references

Fill in the chart about the Victor and Jordan Sr. references based on the information provided in the mock application file.

| | Victor reference | Jordan, Sr. reference |
|---|---|-----------------------|
| 1. Who is the inventor or author? | Victor Pest Control Company | |
| 2. Is the reference a U.S. patent document? If yes, answer questions 2a, 2b, and 2c. | No | |
| 2a. What is the actual U.S. filing date? | n/a | |
| 2b. What is the claimed domestic benefit or foreign priority date, if any? | n/a | |
| 2c. What is the effectively filed date? | n/a | |
| 3. What is the public availability date? | March 27, 2013 (earliest evidence of public availability) | |
| 4. Does the reference meet 102(a)(1)? If so, answer questions 4a and 4b. | Yes | |
| 4a. Does the 102(b)(1)(A) exception apply? | | |
| 4b. Does the 102(b)(1)(B) exception apply? | | |

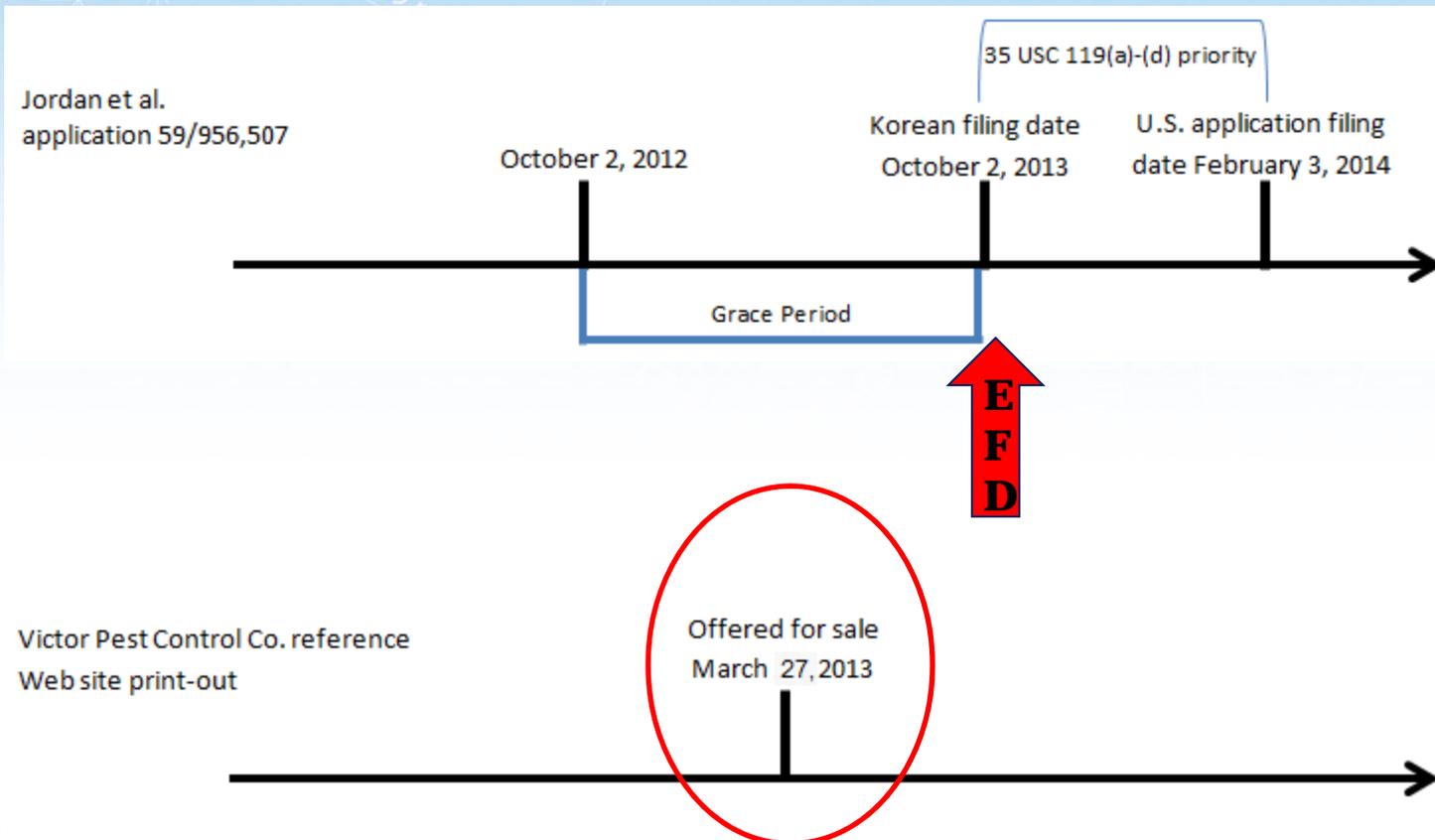


AIA Statutory Framework

| 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, Published U.S. Patent Application, and Published PCT Application with Prior Filing Date | 102(b)(2) | (A) Disclosure Obtained from Inventor |
| | | (B) Intervening Disclosure by Third Party |
| | | (C) Commonly Owned Disclosures |



Timeline for Potential Prior Art Reference Victor



Recognizing a 102(b)(1)(A) or 102(b)(1)(B) Exception to a Potential 102(a)(1) Reference

One of the 102(b)(1) exceptions applies when:

- there is an appropriate affidavit or declaration under 37 CFR 1.130(a) (attribution) or 1.130(b) (prior public disclosure), **or**
- authorship of the potential reference disclosure only includes one or more joint inventor(s) or the entire inventive entity of the application under examination, **or**
- specification of the application under examination identifies the potential prior art disclosure as having been made by or having originated from one or more members of the inventive entity, in accordance with 37 CFR 1.77(b)(6)

Excerpt from the First Page of the Specification of Mock Application under Examination Jordan et al. 59/956,507

TRAPPING DEVICE

FIELD OF THE INVENTION

[0000] This application and its related parts have been developed for educational purposes in the Patent Training Academy and for First Inventor To File workshop training and are intended for internal use only. This material is based on published application US 2006/0032110 A1 but has been modified and adapted for training purposes.

STATEMENT REGARDING PRIOR DISCLOSURES BY THE INVENTOR OR A JOINT INVENTOR UNDER 37 C.F.R. 1.77(b)(6)

[0002] A prior developed trapping device, a predecessor model to the present invention, was offered for sale on March 27, 2013 by the Victor Pest Control Company (Victor) as shown on their website, www.victorpest.com/store/rat-control/m240. Victor Pest Control Company obtained the prior developed trapping device from two of the present inventors, Charles Jordan Sr. and Alexander Robert Thompson who, during the course of their employment, developed the trapping device that their employer began selling on March 27, 2013. A copy of a print out of the website offering the trapping device for sale is provided on a concurrently filed Information Disclosure Statement pursuant to the guidance of 78 Fed. Reg. 11076 (Feb. 14, 2013).



Worksheet for Potential Prior Art Reference Victor

Office Action Workshop: Worksheet for Victor and Jordan, Sr. references

Fill in the chart about the Victor and Jordan Sr. references based on the information provided in the mock application file.

| | Victor reference | Jordan, Sr. reference |
|---|---|-----------------------|
| 1. Who is the inventor or author? | Victor Pest Control Company | |
| 2. Is the reference a U.S. patent document? If yes, answer questions 2a, 2b, and 2c. | No | |
| 2a. What is the actual U.S. filing date? | n/a | |
| 2b. What is the claimed domestic benefit or foreign priority date, if any? | n/a | |
| 2c. What is the effectively filed date? | n/a | |
| 3. What is the public availability date? | March 27, 2013 (earliest evidence of public availability) | |
| 4. Does the reference meet 102(a)(1)? If so, answer questions 4a and 4b. | Yes | |
| 4a. Does the 102(b)(1)(A) exception apply? | Yes. The reference is within the grace period of the application under examination, and there is a statement under 37 C.F.R. 1.77(b)(6) in specification about this prior public disclosure being obtained from at least one member of the inventive entity. | |
| 4b. Does the 102(b)(1)(B) exception apply? | | |



Worksheet for Potential Prior Art Reference Victor

| | Victor reference | Jordan, Sr. reference |
|---|--|-----------------------|
| 1. Who is the inventor or author? | Victor Pest Control Company | |
| 2. Is the reference a U.S. patent document? If yes, answer questions 2a, 2b, and 2c. | No | |
| 2a. What is the actual U.S. filing date? | n/a | |
| 2b. What is the claimed domestic benefit or foreign priority date, if any? | n/a | |
| 2c. What is the effectively filed date? | n/a | |
| 3. What is the public availability date? | March 27, 2013 (earliest evidence of public availability) | |
| 4. Does the reference meet 102(a)(1)? If so, answer questions 4a and 4b. | Yes | |
| 4a. Does the 102(b)(1)(A) exception apply? | Yes. The reference is within the grace period of the application under examination, and there is a statement under 37 C.F.R. 1.77(b)(6) in specification about this prior public disclosure being obtained from at least one member of the inventive entity. | |
| 4b. Does the 102(b)(1)(B) exception apply? | No. Although the reference is within the grace period of the application under examination, there is no evidence that there was a shielding prior public disclosure by one or more joint inventors. | |
| 5. Does the reference meet 102(a)(2)? If so, answer questions 5a, 5b, and 5c. | | |



AIA 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, Published U.S. Patent Application, and Published PCT Application with Prior Filing Date | 102(b)(2) | (A) Disclosure Obtained from Inventor |
| | | (B) Intervening Disclosure by Third Party |
| | | (C) Commonly Owned Disclosures |



Worksheet for Potential Prior Art Reference Victor

| | Victor reference | Jordan, Sr. reference |
|---|--|-----------------------|
| 1. Who is the inventor or author? | Victor Pest Control Company | |
| 2. Is the reference a U.S. patent document? If yes, answer questions 2a, 2b, and 2c. | No | |
| 2a. What is the actual U.S. filing date? | n/a | |
| 2b. What is the claimed domestic benefit or foreign priority date, if any? | n/a | |
| 2c. What is the effectively filed date? | n/a | |
| 3. What is the public availability date? | March 27, 2013 (earliest evidence of public availability) | |
| 4. Does the reference meet 102(a)(1)? If so, answer questions 4a and 4b. | Yes | |
| 4a. Does the 102(b)(1)(A) exception apply? | Yes. The reference is within the grace period of the application under examination, and there is a statement under 37 C.F.R. 1.77(b)(6) in specification about this prior public disclosure being obtained from at least one member of the inventive entity. | |
| 4b. Does the 102(b)(1)(B) exception apply? | No. Although the reference is within the grace period of the application under examination, there is no evidence that there was a shielding prior public disclosure by one or more joint inventors. | |
| 5. Does the reference meet 102(a)(2)? If so, answer questions 5a, 5b, and 5c. | No | |



Worksheet for Potential Prior Art Reference Victor

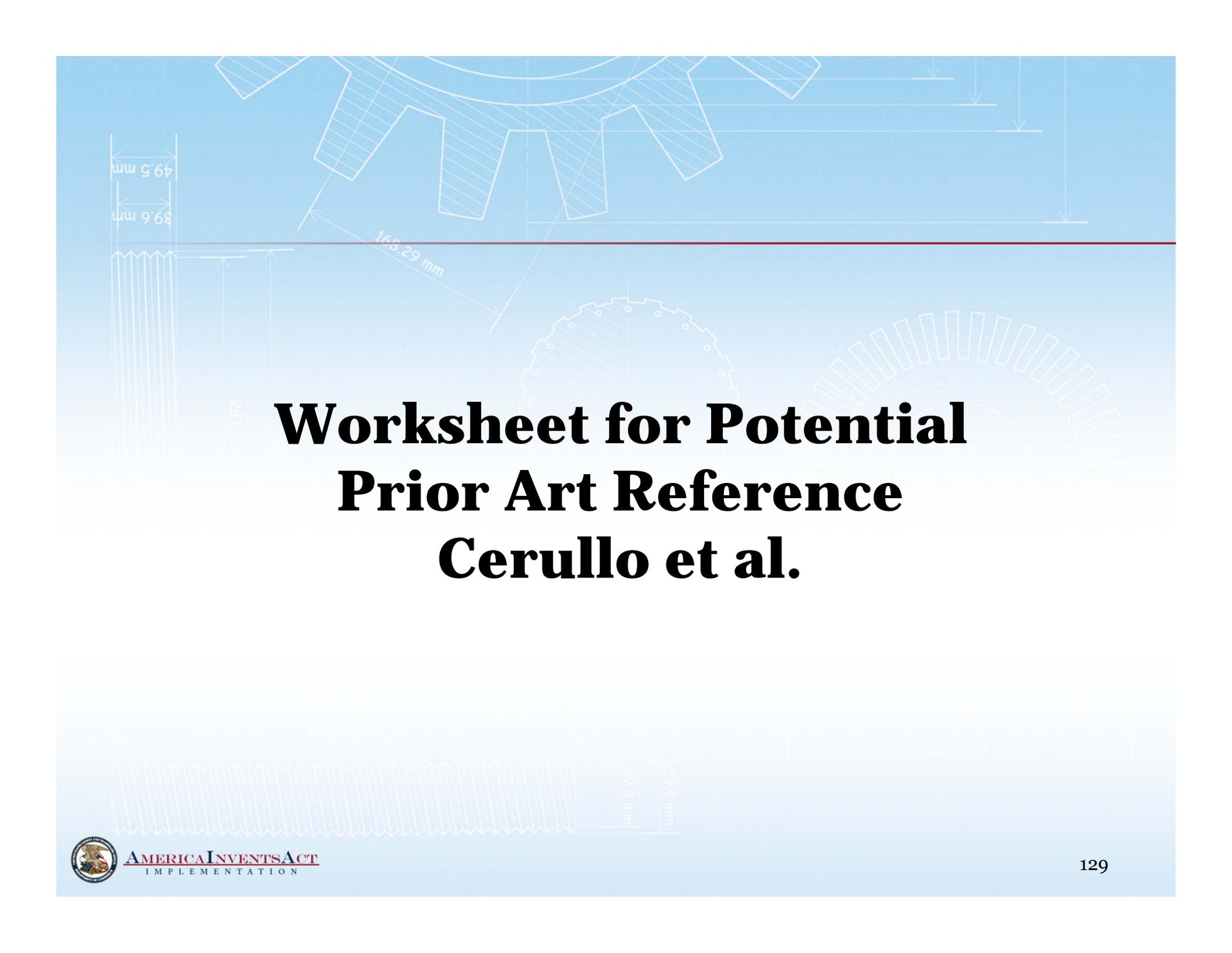
| | Victor reference | Jordan, Sr. reference |
|---|---|-----------------------|
| 1. Who is the inventor or author? | Victor Pest Control Company | |
| 2. Is the reference a U.S. patent document? If yes, answer questions 2a, 2b, and 2c. | No | |
| 2a. What is the actual U.S. filing date? | n/a | |
| 2b. What is the claimed domestic benefit or foreign priority date, if any? | n/a | |
| 2c. What is the effectively filed date? | n/a | |
| 3. What is the public availability date? | March 27, 2013 (earliest evidence of public availability) | |
| 4. Does the reference meet 102(a)(1)? If so, answer questions 4a and 4b. | Yes | |
| 4a. Does the 102(b)(1)(A) exception apply? | Yes. | |
| 5. Does the reference meet 102(a)(2)? If so, answer questions 5a, 5b, and 5c. | No | |
| 6. What rejection(s) could be made in view of the dates of the reference (assuming appropriate teachings)? | | |



Worksheet for Potential Prior Art Reference Victor

| | Victor reference | Jordan, Sr. reference |
|--|---|-----------------------|
| 1. Who is the inventor or author? | Victor Pest Control Company | |
| 2. Is the reference a U.S. patent document? If yes, answer questions 2a, 2b, and 2c. | No | |
| 2a. What is the actual U.S. filing date? | n/a | |
| 2b. What is the claimed domestic benefit or foreign priority date, if any? | n/a | |
| 2c. What is the effectively filed date? | n/a | |
| 3. What is the public availability date? | March 27, 2013 (earliest evidence of public availability) | |
| 4. Does the reference meet 102(a)(1)? If so, answer questions 4a and 4b. | Yes | |
| 4a. Does the 102(b)(1)(A) exception apply? | Yes. | |
| 5. Does the reference meet 102(a)(2)? If so, answer questions 5a, 5b, and 5c. | No | |
| 6. What rejection(s) could be made in view of the dates of the reference (assuming appropriate teachings)? | None , for either anticipation or obviousness. The 102(b)(1)(A) exception applies. | |





**Worksheet for Potential
Prior Art Reference
Cerullo et al.**



Worksheet for Potential Prior Art Reference Cerullo et al.

Office Action Workshop: Worksheet for Adams and Cerullo references

Fill in the chart about the Adams and Cerullo references based on the information provided in the mock application file.

| | Adams reference | Cerullo et al. reference |
|--|-----------------|--------------------------|
| 1. Who is the inventor or author? | | |
| 2. Is the reference a U.S. patent document? If yes, answer questions 2a, 2b, and 2c. | | |
| 2a. What is the actual U.S. filing date? | | |
| 2b. What is the claimed domestic benefit or foreign priority date, if any? | | |
| 2c. What is the effectively filed date? | | |
| 3. What is the public availability date? | | |
| 4. Does the reference meet 102(a)(1)? If so, answer questions 4a and 4b. | | |
| 4a. Does the 102(b)(1)(A) exception apply? | | |
| 4b. Does the 102(b)(1)(B) exception apply? | | |



Potential Prior Art Reference

Cerullo et al.

(19) **United States**

(12) **Patent Application Publication** (10) **Pub. No.: US 2014/XXXXXX8 A1**
Cerullo et al. (43) **Pub. Date: Mar. 28, 2014**

(54) **PORTABLE ELECTRIC MOUSE TRAP**

(71) **Applicants:** Mariano Cerullo, 00060 S. Maria Di
Galeria (Province of Rome), IT
Alexander Robert Thompson,
Brooklyn, NY (US)

(72) **Inventors:** Mariano Cerullo, 00060 S. Maria Di
Galeria (Province of Rome), IT
Alexander Robert Thompson,
Brooklyn, NY (US)

(21) **Appl. No.:** 14/XXX,XXX

(22) **Filed:** November 14, 2012

(30) **Foreign Application Priority Data**

August 13, 2012 (IT)

XXX XX XXX

(52) **U.S. Cl.**
CPC.....*A01M 23/12* (20130101)
USPC..... 43/61; 43/139

(57) **ABSTRACT**

An air-tight vermin trap includes a lower section containing a disinfectant liquid, an upper section sealingly mounted on the lower section and a cover sealingly covering the upper section. The upper section defines an entrance opening having a cover flap which can sealingly close the entrance opening. A drop floor which is activated by an electromechanical system operates to drop a vermin into the lower section upon actuation of a sensor flap by the vermin. Vermin access elements extend upwardly along the lower section and the upper section to the entrance body.



Worksheet for Potential Prior Art Reference Cerullo et al.

Office Action Workshop: Worksheet for Adams and Cerullo references

Fill in the chart about the Adams and Cerullo references based on the information provided in the mock application file.

| | Adams reference | Cerullo et al. reference |
|--|-----------------|---|
| 1. Who is the inventor or author? | | Mariano Cerullo and Alexander Robert Thompson |
| 2. Is the reference a U.S. patent document? If yes, answer questions 2a, 2b, and 2c. | | |
| 2a. What is the actual U.S. filing date? | | |
| 2b. What is the claimed domestic benefit or foreign priority date, if any? | | |
| 2c. What is the effectively filed date? | | |
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Worksheet for Potential Prior Art Reference Cerullo et al.

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Fill in the chart about the Adams and Cerullo references based on the information provided in the mock application file.

| | Adams reference | Cerullo et al. reference |
|--|-----------------|---|
| 1. Who is the inventor or author? | | Mariano Cerullo and Alexander Robert Thompson |
| 2. Is the reference a U.S. patent document? If yes, answer questions 2a, 2b, and 2c. | | Yes |
| 2a. What is the actual U.S. filing date? | | |
| 2b. What is the claimed domestic benefit or foreign priority date, if any? | | |
| 2c. What is the effectively filed date? | | |
| 3. What is the public availability date? | | |
| 4. Does the reference meet 102(a)(1)? If so, answer questions 4a and 4b. | | |
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Potential Prior Art Reference

Cerullo et al.

(19) **United States**

(12) **Patent Application Publication** (10) **Pub. No.: US 2014/XXXXX8 A1**
Cerullo et al. (43) **Pub. Date: Mar. 28, 2014**

(54) **PORTABLE ELECTRIC MOUSE TRAP**

(71) **Applicants:** Mariano Cerullo, 00060 S. Maria Di
Galeria (Province of Rome), IT
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(72) **Inventors:** Mariano Cerullo, 00060 S. Maria Di
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(21) **Appl. No.:** 14/XXX,XXX

(22) **Filed:** November 14, 2012

(30) **Foreign Application Priority Data**

August 13, 2012 (IT)

XXX XX XXX

(52) **U.S. Cl.**
CPC.....*A01M 23/12* (20130101)
USPC..... 43/61; 43/139

(57) **ABSTRACT**

An air-tight vermin trap includes a lower section containing a disinfectant liquid, an upper section sealingly mounted on the lower section and a cover sealingly covering the upper section. The upper section defines an entrance opening having a cover flap which can sealingly close the entrance opening. A drop floor which is activated by an electromechanical system operates to drop a vermin into the lower section upon actuation of a sensor flap by the vermin. Vermin access elements extend upwardly along the lower section and the upper section to the entrance body.



Worksheet for Potential Prior Art Reference Cerullo et al.

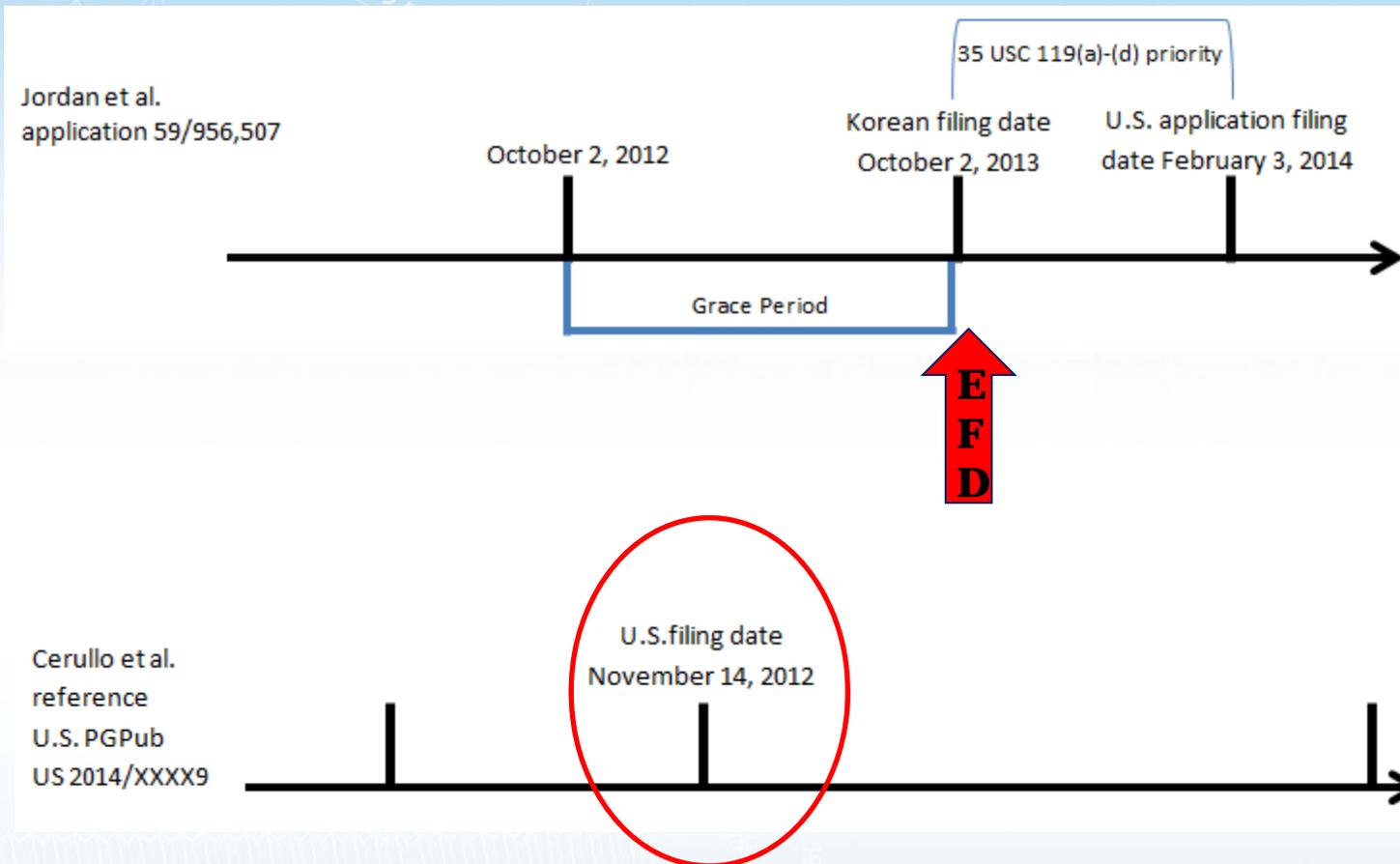
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Fill in the chart about the Adams and Cerullo references based on the information provided in the mock application file.

| | Adams reference | Cerullo et al. reference |
|--|-----------------|---|
| 1. Who is the inventor or author? | | Mariano Cerullo and Alexander Robert Thompson |
| 2. Is the reference a U.S. patent document? If yes, answer questions 2a, 2b, and 2c. | | Yes |
| 2a. What is the actual U.S. filing date? | | November 14, 2012 |
| 2b. What is the claimed domestic benefit or foreign priority date, if any? | | |
| 2c. What is the effectively filed date? | | |
| 3. What is the public availability date? | | |
| 4. Does the reference meet 102(a)(1)? If so, answer questions 4a and 4b. | | |
| 4a. Does the 102(b)(1)(A) exception apply? | | |
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Timeline for Potential Prior Art Reference Cerullo et al.



Worksheet for Potential Prior Art Reference Cerullo et al.

Office Action Workshop: Worksheet for Adams and Cerullo references

Fill in the chart about the Adams and Cerullo references based on the information provided in the mock application file.

| | Adams reference | Cerullo et al. reference |
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| 1. Who is the inventor or author? | | Mariano Cerullo and Alexander Robert Thompson |
| 2. Is the reference a U.S. patent document? If yes, answer questions 2a, 2b, and 2c. | | Yes |
| 2a. What is the actual U.S. filing date? | | November 14, 2012 |
| 2b. What is the claimed domestic benefit or foreign priority date, if any? | | |
| 2c. What is the effectively filed date? | | |
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| 4a. Does the 102(b)(1)(A) exception apply? | | |
| 4b. Does the 102(b)(1)(B) exception apply? | | |



Potential Prior Art Reference

Cerullo et al.

(19) **United States**

(12) **Patent Application Publication** (10) **Pub. No.: US 2014/XXXXXX8 A1**
Cerullo et al. (43) **Pub. Date: Mar. 28, 2014**

(54) **PORTABLE ELECTRIC MOUSE TRAP**

(71) **Applicants:** Mariano Cerullo, 00060 S. Maria Di
Galeria (Province of Rome), IT
Alexander Robert Thompson,
Brooklyn, NY (US)

(72) **Inventors:** Mariano Cerullo, 00060 S. Maria Di
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Alexander Robert Thompson,
Brooklyn, NY (US)

(21) **Appl. No.:** 14/XXX,XXX

(22) **Filed:** November 14, 2012

(30) **Foreign Application Priority Data**

August 13, 2012 (IT)

XXX XX XXX

(52) **U.S. Cl.**
CPC.....*A01M 23/12* (20130101)
USPC..... 43/61; 43/139

(57) **ABSTRACT**

An air-tight vermin trap includes a lower section containing a disinfectant liquid, an upper section sealingly mounted on the lower section and a cover sealingly covering the upper section. The upper section defines an entrance opening having a cover flap which can sealingly close the entrance opening. A drop floor which is activated by an electromechanical system operates to drop a vermin into the lower section upon actuation of a sensor flap by the vermin. Vermin access elements extend upwardly along the lower section and the upper section to the entrance body.



Worksheet for Potential Prior Art Reference Cerullo et al.

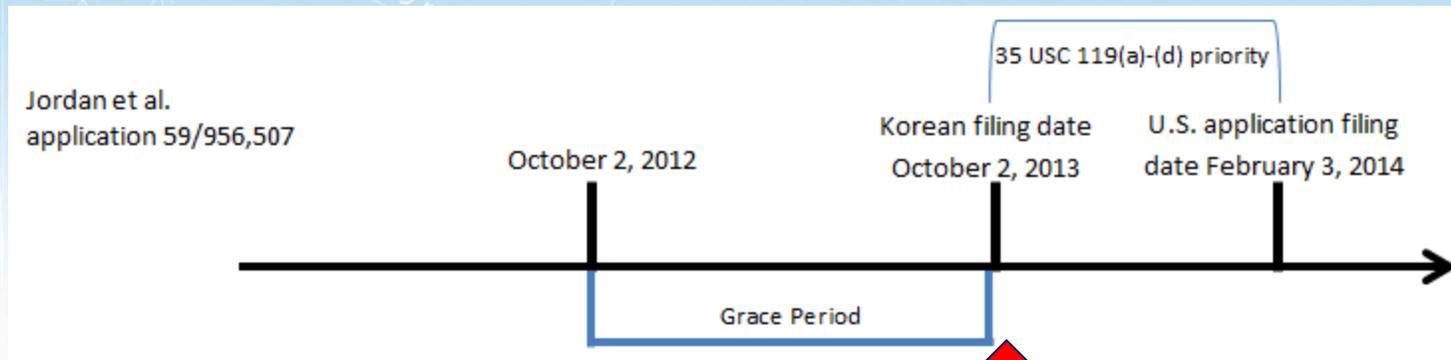
Office Action Workshop: Worksheet for Adams and Cerullo references

Fill in the chart about the Adams and Cerullo references based on the information provided in the mock application file.

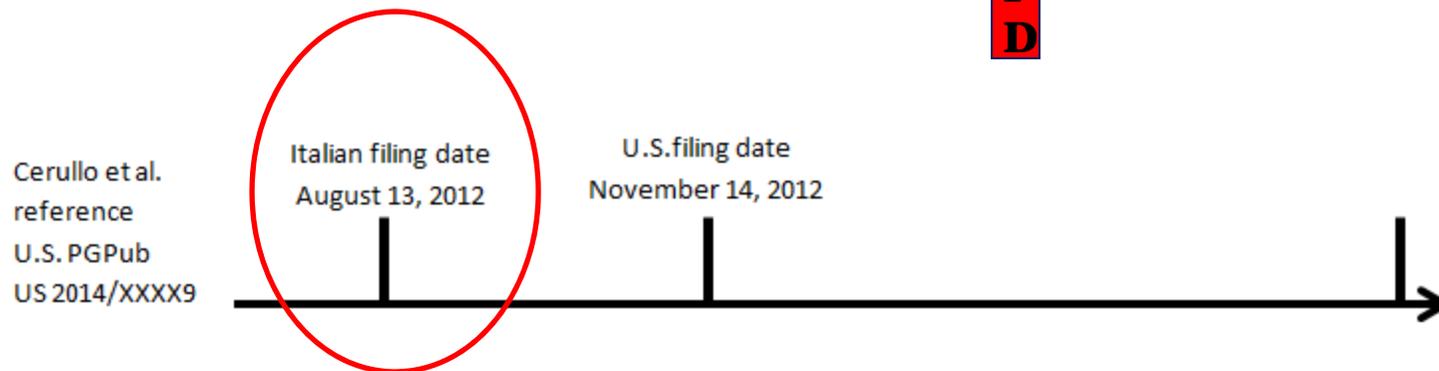
| | Adams reference | Cerullo et al. reference |
|--|-----------------|---|
| 1. Who is the inventor or author? | | Mariano Cerullo and Alexander Robert Thompson |
| 2. Is the reference a U.S. patent document? If yes, answer questions 2a, 2b, and 2c. | | Yes |
| 2a. What is the actual U.S. filing date? | | November 14, 2012 |
| 2b. What is the claimed domestic benefit or foreign priority date, if any? | | August 13, 2012 |
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| 3. What is the public availability date? | | |
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Timeline for Potential Prior Art Reference Cerullo et al.



**E
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D**



Worksheet for Potential Prior Art Reference Cerullo et al.

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Potential Prior Art Reference

Cerullo et al.

(19) **United States**

(12) **Patent Application Publication** (10) Pub. No.: US 2014/XXXXXX8 A1
Cerullo et al. (43) Pub. Date: Mar. 28, 2014

(54) PORTABLE ELECTRIC MOUSE TRAP

(71) Applicants: Mariano Cerullo, 00060 S. Maria Di
Galeria (Province of Rome), IT
Alexander Robert Thompson,
Brooklyn, NY (US)

(72) Inventors: Mariano Cerullo, 00060 S. Maria Di
Galeria (Province of Rome), IT
Alexander Robert Thompson,
Brooklyn, NY (US)

(21) Appl. No.: 14/XXX,XXX

(22) Filed: November 14, 2012

(30) **Foreign Application Priority Data**

August 13, 2012 (IT) XXXX XX XXXX

Publication Classification

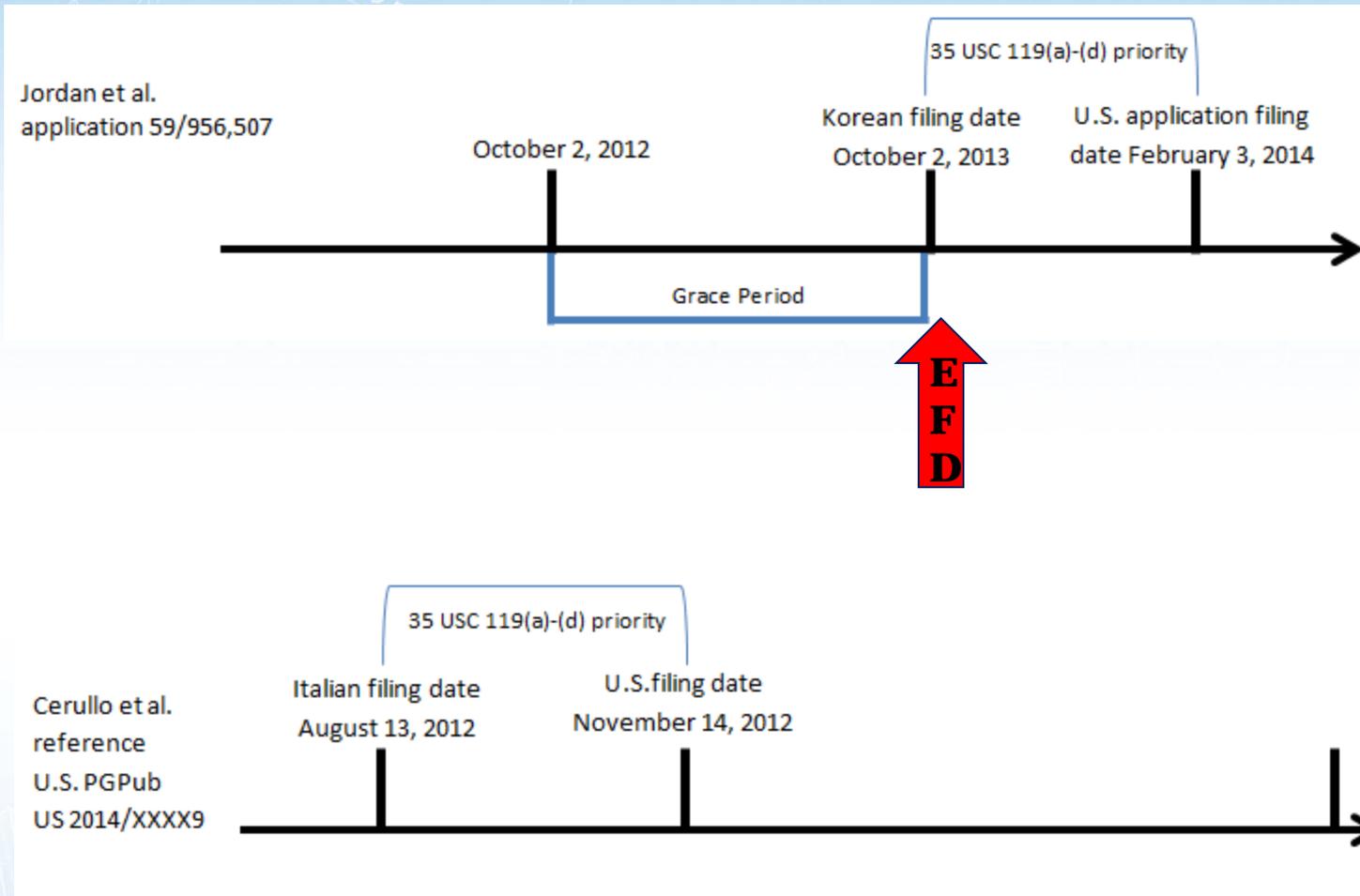
(52) U.S. Cl.
CPC.....A01M 23/12 (20130101)
USPC..... 43/61; 43/139

(57) **ABSTRACT**

An air-tight vermin trap includes a lower section containing a disinfectant liquid, an upper section sealingly mounted on the lower section and a cover sealingly covering the upper section. The upper section defines an entrance opening having a cover flap which can sealingly close the entrance opening. A drop floor which is activated by an electromechanical system operates to drop a vermin into the lower section upon actuation of a sensor flap by the vermin. Vermin access elements extend upwardly along the lower section and the upper section to the entrance body.

The IT foreign priority document is identical to this PG Publication to Cerullo et al.

Timeline for Potential Prior Art Reference Cerullo et al.



Worksheet for Potential Prior Art Reference Cerullo et al.

| | Adams reference | Cerullo et al. reference |
|--|-----------------|--|
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Potential Prior Art Reference

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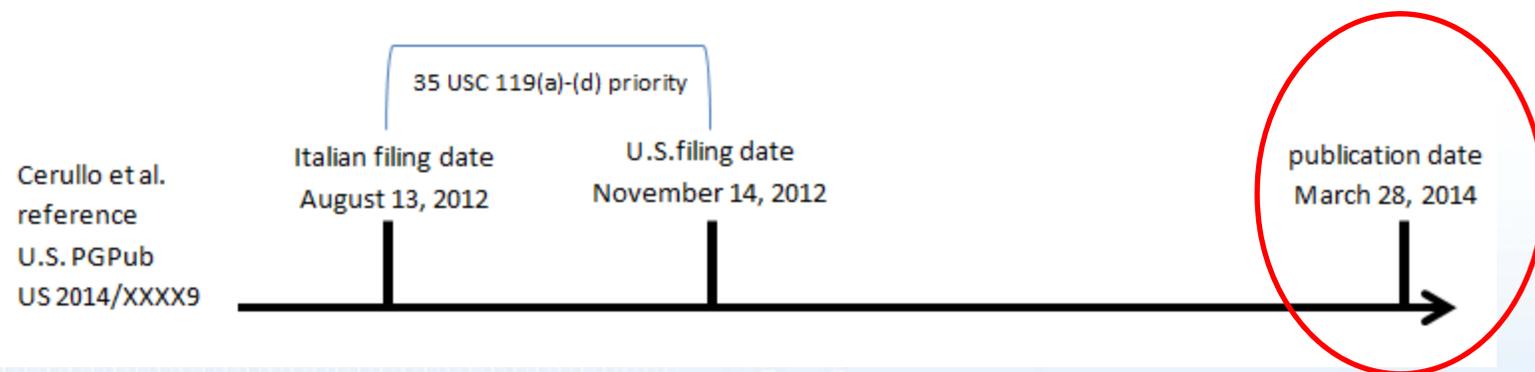
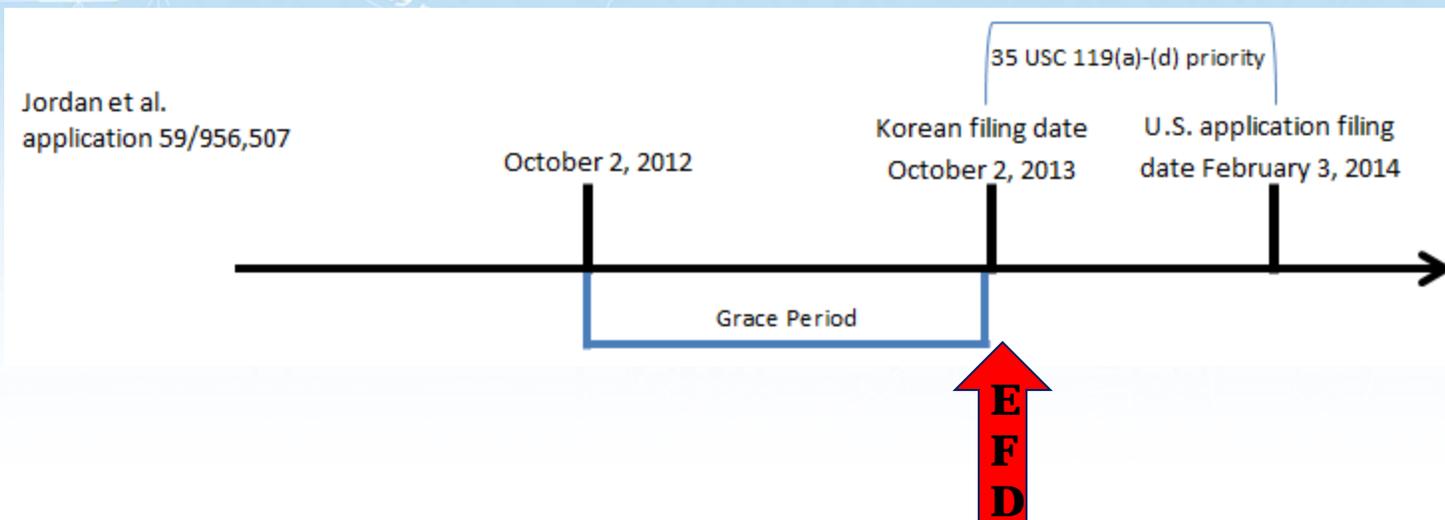


Worksheet for Potential Prior Art Reference Cerullo et al.

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Timeline for Potential Prior Art Reference Cerullo et al.



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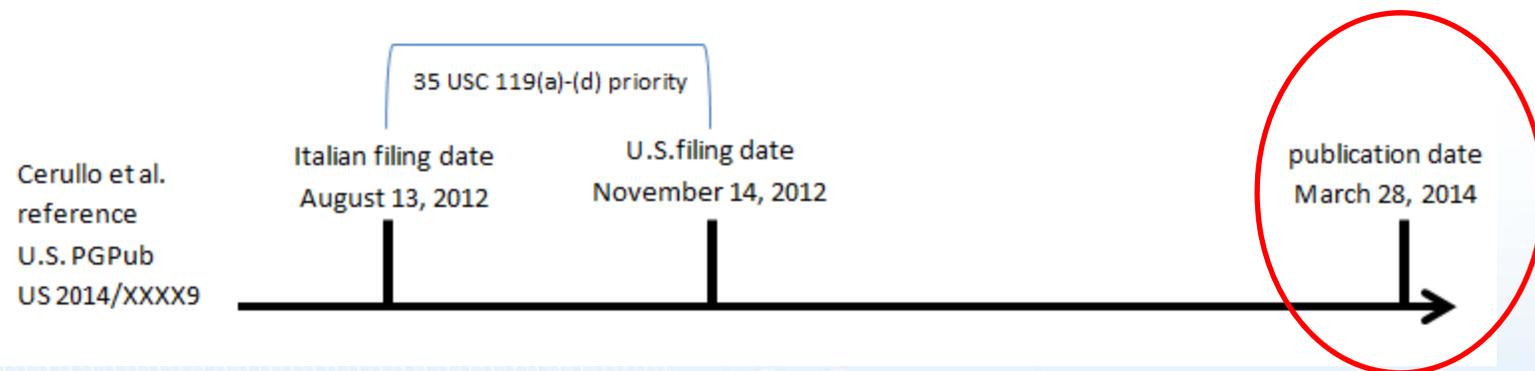
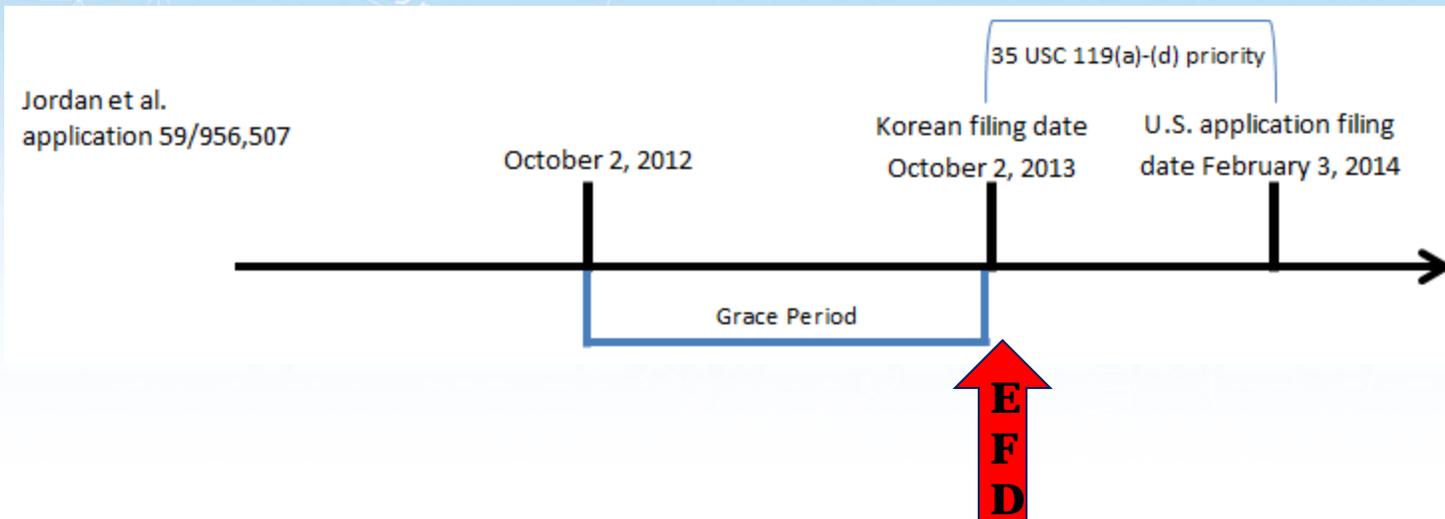


AIA Statutory Framework

| 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, Published U.S. Patent Application, and Published PCT Application with Prior Filing Date | 102(b)(2) | (A) Disclosure Obtained from Inventor |
| | | (B) Intervening Disclosure by Third Party |
| | | (C) Commonly Owned Disclosures |



Timeline for Potential Prior Art Reference Cerullo et al.



Worksheet for Potential Prior Art Reference Cerullo et al.

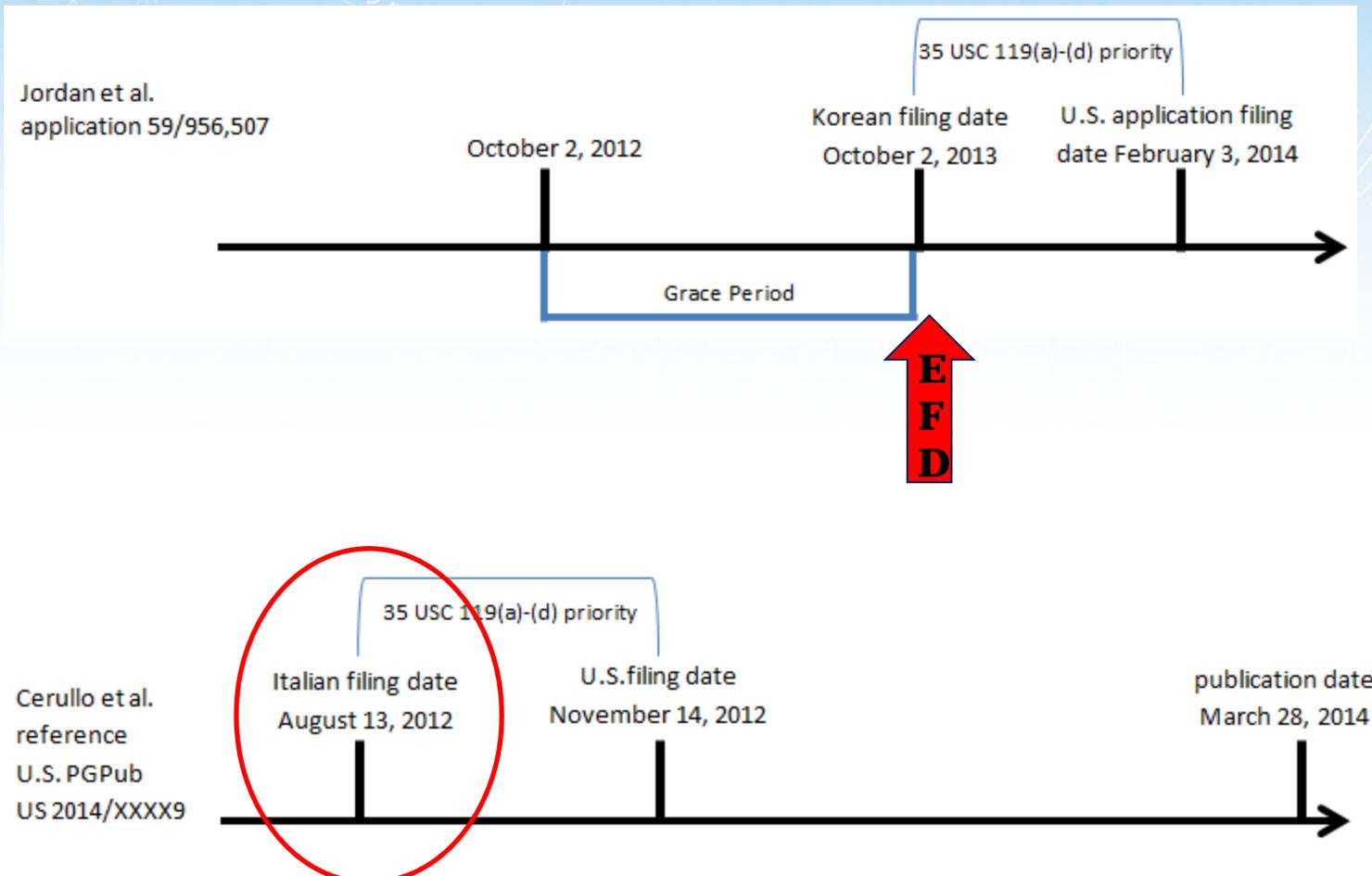
| | | |
|---|--|-----|
| 4. Does the reference meet 102(a)(1)? If so, answer questions 4a and 4b. | | No |
| 4a. Does the 102(b)(1)(A) exception apply? | | n/a |
| 4b. Does the 102(b)(1)(B) exception apply? | | n/a |
| 5. Does the reference meet 102(a)(2)? If so, answer questions 5a, 5b, and 5c. | | |



AIA Statutory Framework

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|--|--|--|
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| | | (B) Intervening Disclosure by Third Party |
| | | (C) Commonly Owned Disclosures |

Timeline for Potential Prior Art Reference Cerullo et al.



Worksheet for Potential Prior Art Reference Cerullo et al.

| | | |
|---|--|-----|
| 5. Does the reference meet 102(a)(2)? If so, answer questions 5a, 5b, and 5c. | | Yes |
| 5a. Does the 102(b)(2)(A) exception apply? | | |
| 5b. Does the 102(b)(2)(B) exception apply? | | |
| 5c. Does the 102(b)(2)(C) exception apply? | | |



AIA Statutory Framework

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Worksheet for Potential Prior Art Reference Cerullo et al.

| | | |
|---|--|---|
| 5. Does the reference meet 102(a)(2)? If so, answer questions 5a, 5b, and 5c. | | Yes |
| 5a. Does the 102(b)(2)(A) exception apply? | | No. No evidence that the subject matter was obtained directly or indirectly from an inventor or joint inventor. If a declaration under 37 CFR 1.130(a) is later submitted attributing Cerullo's knowledge of the relevant subject matter to one or more of the joint inventors of the application under examination, then the exception would apply. |
| 5b. Does the 102(b)(2)(B) exception apply? | | No. There is no evidence of a prior public disclosure to shield the application under examination from any part of the Cerullo reference as prior art. |
| 5c. Does the 102(b)(2)(C) exception apply? | | No. There is no statement of common ownership not later than the effective filing date of the application under examination. |

Worksheet for Potential Prior Art Reference Cerullo et al.

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| 5. Does the reference meet 102(a)(2)? If so, answer questions 5a, 5b, and 5c. | | Yes |
| 6. What rejection(s) could be made in view of the dates of the reference (assuming appropriate teachings)? | | The reference qualifies only under 102(a)(2). An anticipation or obviousness rejection could be made. |





AMERICA INVENTS ACT

IMPLEMENTATION

Questions?



AMERICA INVENTS ACT

IMPLEMENTATION

Break



AMERICA INVENTS ACT

IMPLEMENTATION

Administrative Trials (Inter Partes Review, Covered Business Method Review, and Post Grant Review)

Effective September 16, 2012

Board Expansion

- Since October 2011
 - Reviewed nearly 1,700 applicant records
 - Interviewed more than 300 candidates
 - Selected 90 highly qualified candidates to become new Judges
 - We stand at 170 Judges as of August 12, 2013
- Opportunities at Detroit/Denver/Dallas/Silicon Valley Satellite Offices (for now)
 - Selecting candidates from previous postings now
- Goal for FY2013 - add more judges



Board Expansion (cont.)

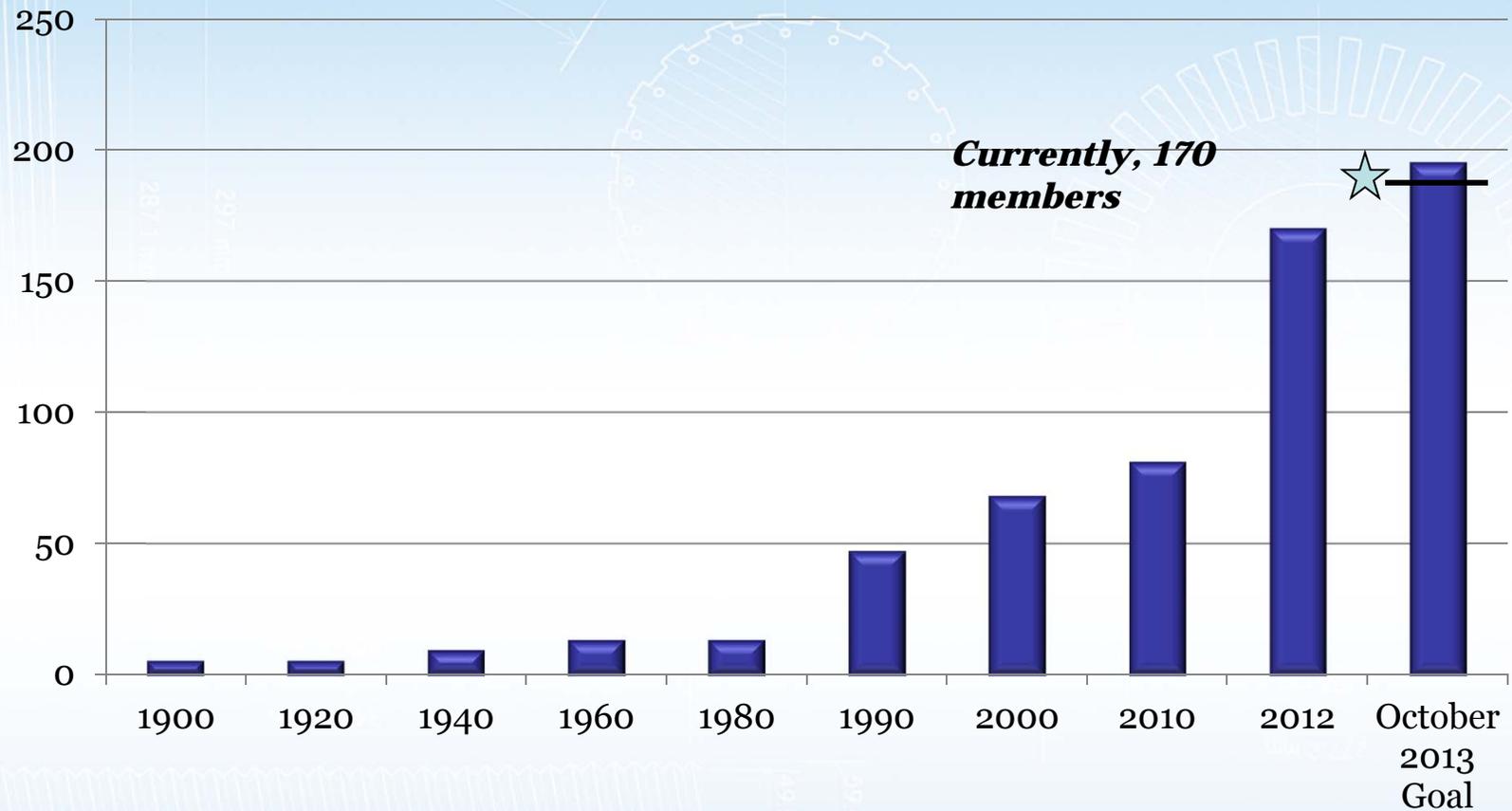
- Selectees have come from the following:
 - USPTO Patent Examining Corps, Office of the General Counsel, and the PTAB
 - International Trade Commission and Department of Justice
 - Private Practice (solo to very large)
 - All types of industries



Training

- Training Committee conducts formal training for all members of the Board
- For newer judges, Training Committee provides:
 - initial guidance to ease the transition to the Board's unique mission and culture; and
 - tools and techniques on how to deal with issues we see on a regular basis
- For all judges, Training Committee provides regular training on:
 - evolving case law; and
 - new trial proceedings implemented by the America Invents Act
- Agenda is developing continually, based on member-input, as we constantly strive to look for new ways to more effectively and efficiently fulfill our mission

Members of the Board



***Currently, 170
members***



Alexandria & Arlington, Virginia



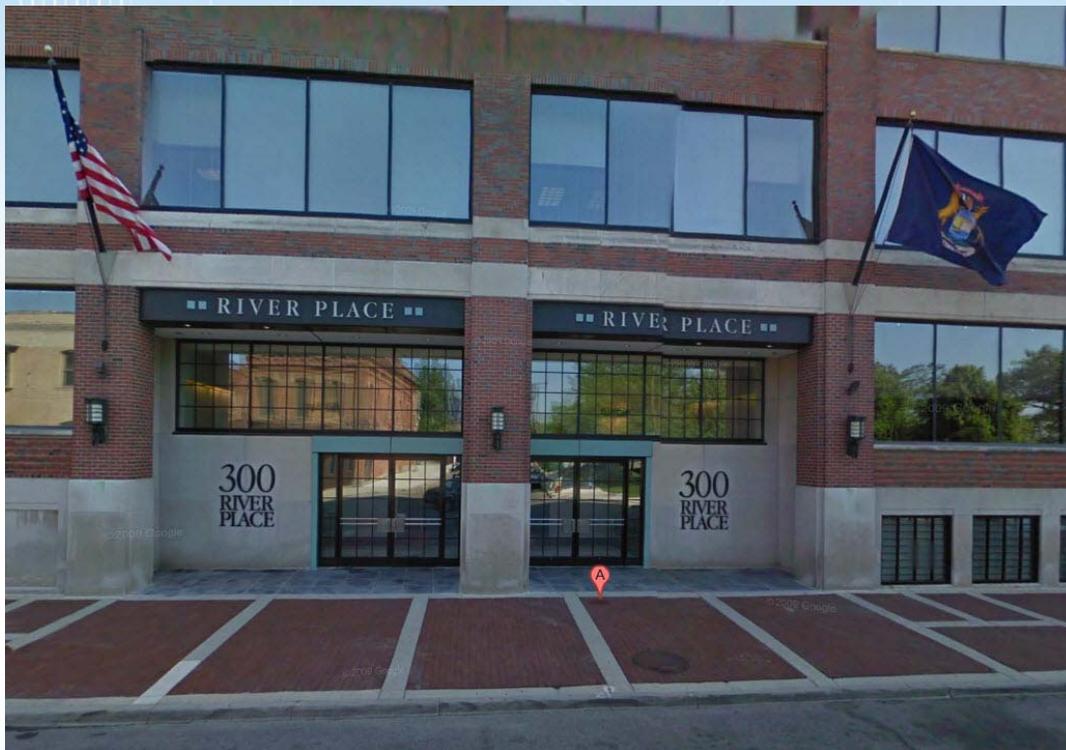
United States Patent and Trademark Office

600 Dulany Street
Alexandria, Virginia 22314

2800 South Randolph Street
Arlington, Virginia 22206

141 Administrative Patent
Judges

Detroit, Michigan



Elijah J. McCoy
United States Patent
and Trademark Office

300 River Place South
Suit 2900
Detroit, Michigan 48207

Opened July 13, 2012

10 Administrative Patent Judges

Denver, Colorado



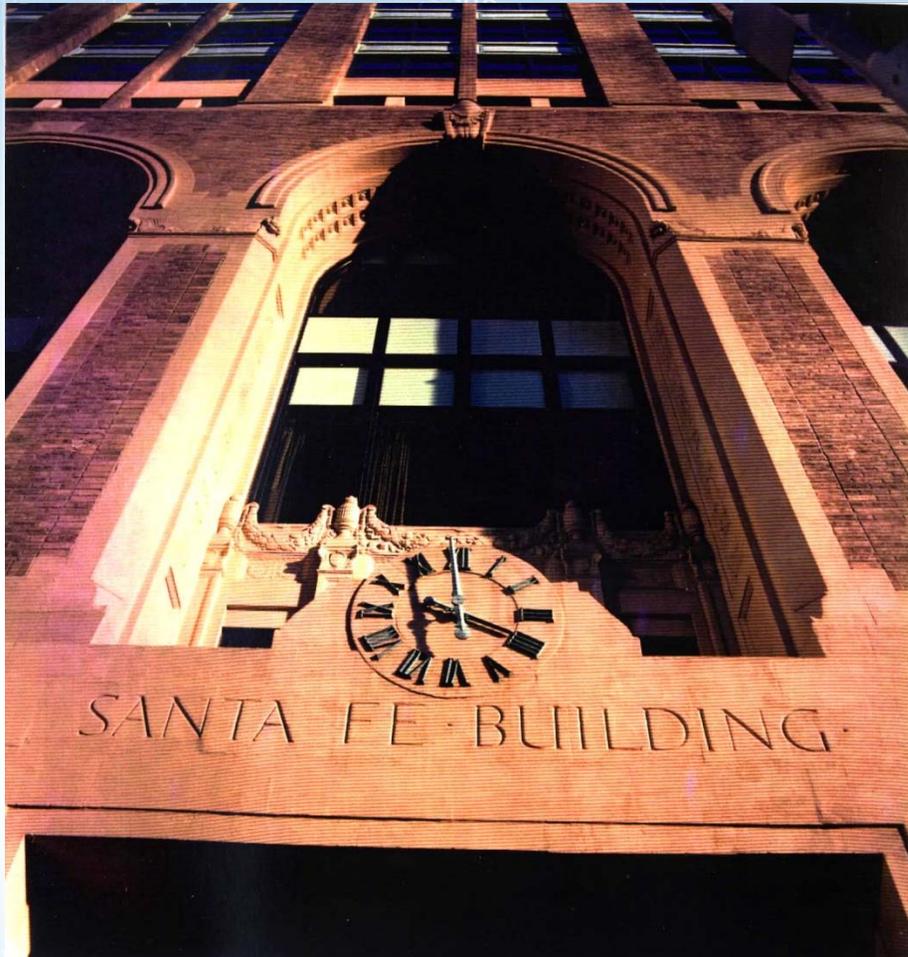
Denver Federal Center

B20/D1000
W 6th Ave & Kipling Street
Lakewood, Colorado 80225

Opened January 2, 2013

8 Administrative Patent
Judges

Dallas, Texas



Santa Fe Building

1114 Commerce Street
Suite 705
Dallas, TX 75202

Opened March 18, 2013

5 Administrative Patent Judges



Menlo Park, California

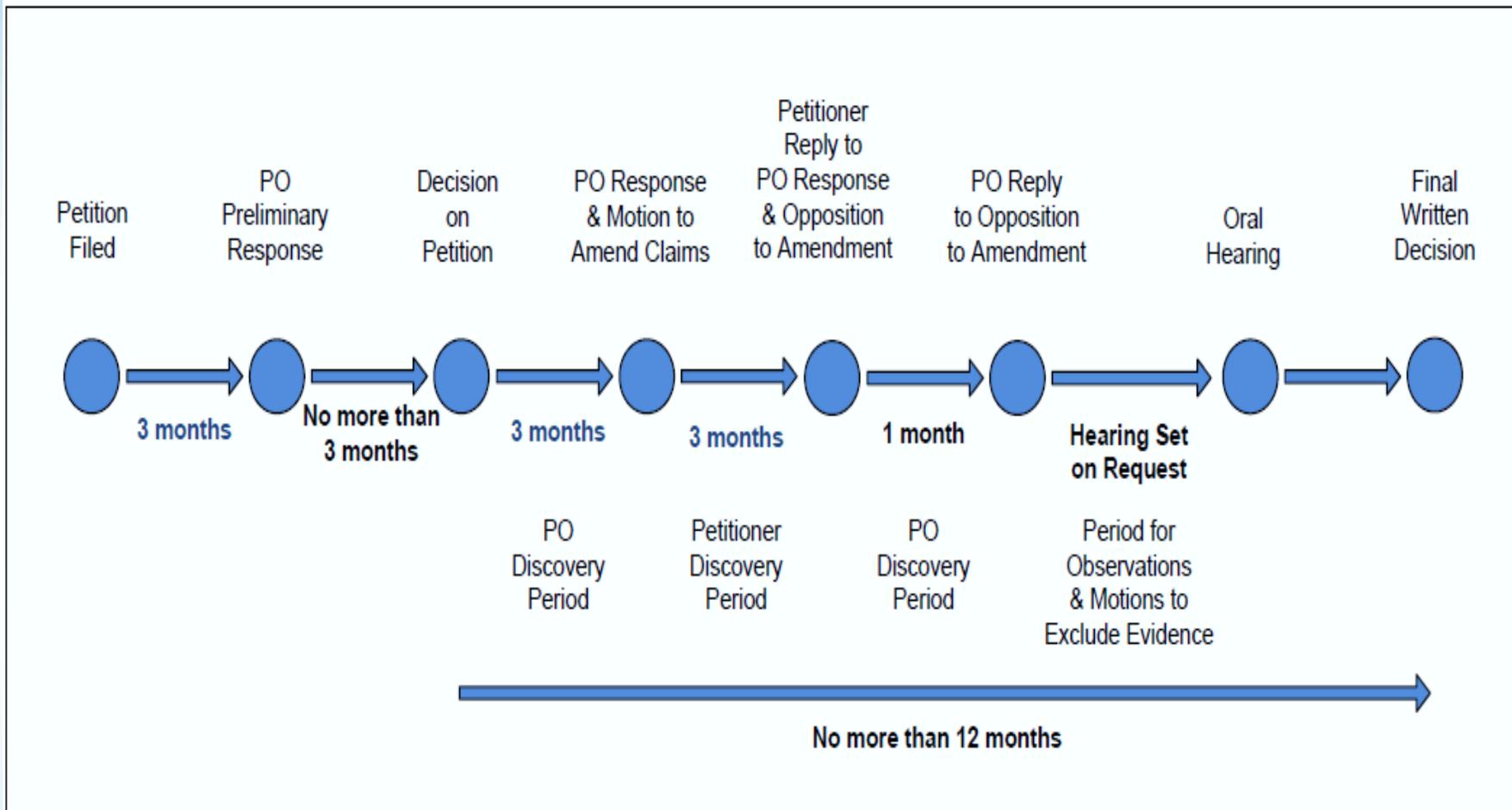


U.S. Geological Survey Building

345 Middlefield Road
Menlo Park, CA 94025

Opened April 15, 2013
6 Administrative Patent Judges

Trial Proceedings



Petitions

(As of September 3, 2013)

NUMBER OF AIA PETITIONS

| Total | IPR | CBM | DER |
|-------|-----|-----|-----|
| 517 | 468 | 48 | 1 |

Petitions by Technology

(As of September 3, 2013)

AIA PETITION TECHNOLOGY BREAKDOWN

| Technology | Number of Petitions | Percentage |
|---------------------|---------------------|------------|
| Electrical/Computer | 352 | 68.1% |
| Mechanical | 71 | 13.7% |
| Chemical | 50 | 9.7% |
| Bio/Pharma | 40 | 7.7% |
| Design | 4 | 0.8% |

Patent Owner Preliminary Responses

(As of September 3, 2013)

NUMBER OF PATENT OWNER PRELIMINARY RESPONSES

| | Filed | Waived |
|-----|-------|--------|
| IPR | 199 | 44 |
| CBM | 25 | 2 |

Trials Instituted and Settlements (As of September 3, 2013)

AIA TRIALS INSTITUTED/SETTLEMENTS/FINAL WRITTEN DECISIONS

| | Instituted Trials | Denials | Joinders | Total Number of Decisions on Institution | Settlements | Final Written Decisions |
|-----|-------------------|---------|----------|--|-------------|-------------------------|
| IPR | 146 | 22 | 7 | 175 | 36 | 1* |
| CBM | 12 | 3 | | 15 | 2 | 1 |

*Judgment on request for adverse judgment



Top Districts for Patent Litigation

- Eastern District of Texas 1266
- District of Delaware 995
- **PTAB** **517**
- Central District of California 514
- Northern District of California 260

FY 2012 data used for District Courts

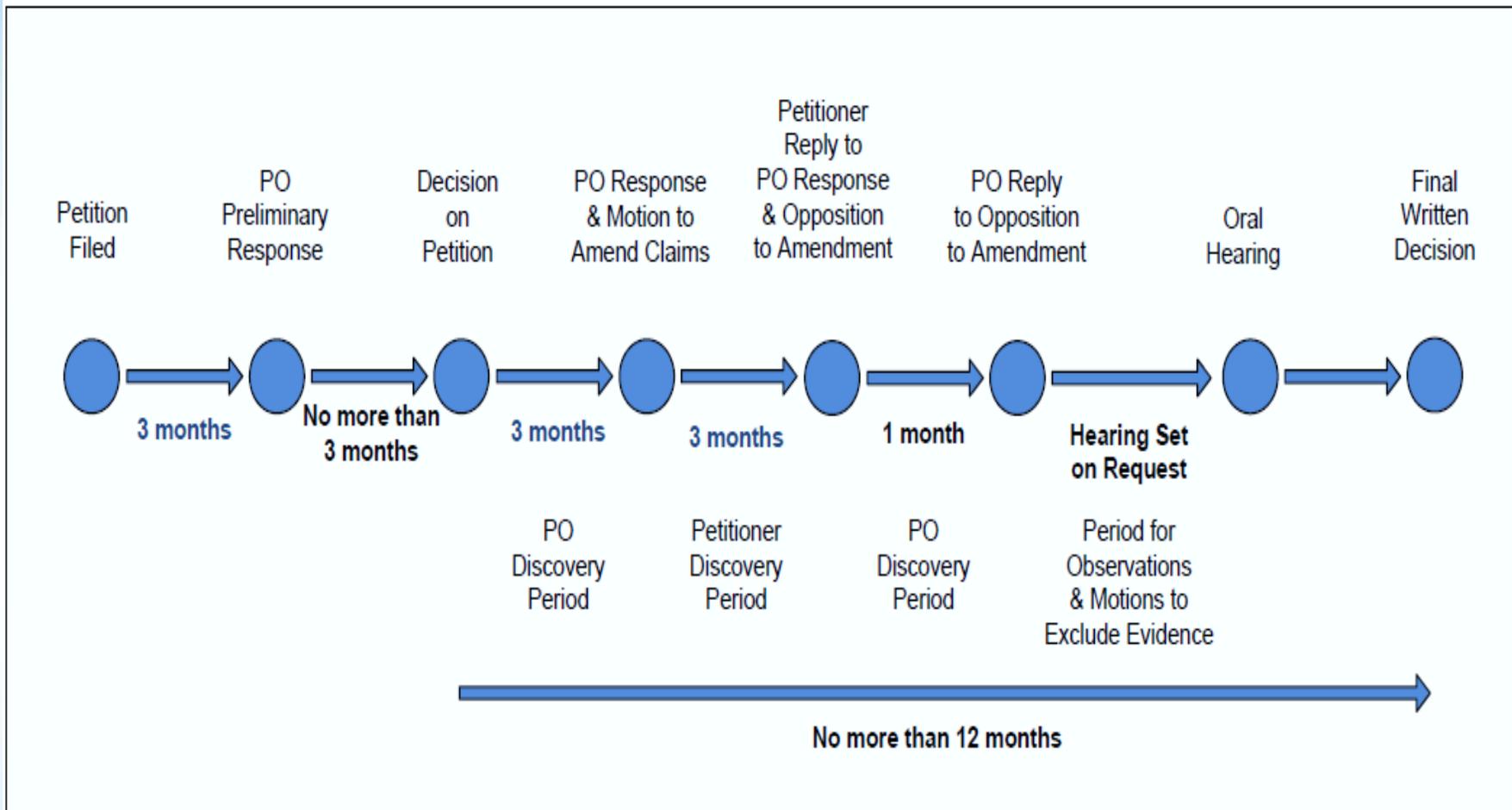
PTAB data is for September 16, 2012 to September 3, 2013

Resources

- Board and specific trial procedures:

<http://www.uspto.gov/ip/boards/bpai/index.jsp>

Trial Proceedings



Lessons Learned on Petitions

- Conclusions need to be supported by:
 - Sound legal analysis
 - Citations to evidentiary record
- Better to provide detailed analysis for limited number of challenges than identify large number of challenges for which little analysis is provided



Lessons Learned on Claim Charts

- Use standard two-column format
- Claim charts are not sufficient by themselves, they must be explained
- Charts should contain pinpoint references to the supporting evidence



Lessons Learned on Claim Construction

- Claim constructions should be supported by citations to the record that justify the proffered construction and analysis provided as to why the claim construction is the broadest reasonable construction. 37 C.F.R. 42.104(b)(3)
- An example of a failure to provide a sufficient claim construction occurs where claim terms are open to interpretation, but party merely restates claim construction standard to be used, e.g.,
 - A claim subject to inter partes review receives the “broadest reasonable construction in light of the specification of the patent in which it appears.” 37 C.F.R. § 42.100(b).

Lessons Learned on Experts

- Tutorials are helpful especially for complex technologies
- Expert testimony without underlying facts or data is entitled to little or no weight. 37 C.F.R. 42.65(a) *See* IPR2013-00022, Paper 43 (denying petition)
- Avoid merely “expertizing” your claim charts



Lessons Learned on Obviousness

- Question of obviousness is resolved based on underlying factual determinations identified in *Graham*, including differences between claimed subject matter and the prior art
- Address the specific teachings of the art relied upon rather than rely upon what others have said, e.g.,

Examiner found that all limitations of the challenged claims except X were present in AAA, BBB and CCC. Additional reference DDD teaches X. Thus, the challenged claims are unpatentable as obvious over prior art references AAA, BBB, CCC and DDD



Lessons Learned on Obviousness (cont.)

- Parties are to address whether there is a reason to combine art and avoid conclusory statements such as:
 - It would have been obvious at the time of the priority date of the challenged patent to incorporate a widget as disclosed by references AAA, BBB, CCC, DDD or EEE into FFF's wadget. See MPEP § 2143(A), (C)



Lessons Learned on Discovery

- Requests for specific documents with a sufficient showing of relevance are more likely to be granted whereas requests for general classes of documents are typically denied
 - Mere possibility exists that discovery request will lead to something useful is insufficient to meet necessary interests of justice standard. 35 USC 316(a)(5)
 - Requests must not be overly burdensome given expedited nature of trials
 - Board will take into account whether party seeking information can reasonably obtain the information sought without need for discovery



Lessons Learned on Discovery (cont.)

- Five factor test to consider in evaluating requests for additional discovery (IPR2012-00001, *Garmin v. Cuozzo*, Paper 26):
 - More than a possibility and mere allegation that something useful might be found
 - Is the request merely seeking early identification of opponent's litigation position
 - Can party requesting discovery generate the information
 - Interrogatory questions must be clear
 - Are requests overly burdensome to answer

Lessons Learned on Depositions

- Federal Rules of Evidence apply
- Objections to admissibility waived
- Follow the Testimony Guidelines (Practice Guide Appendix D)
 - No “speaking” objections or coaching
 - Instructions not to answer are limited



Lessons Learned on Joinder

- Must be a like review proceeding
- Requires filing a motion and petition
- File within one month of institution
- Impact on schedule important





AMERICA INVENTS ACT

IMPLEMENTATION

Questions?

AIA Micro-Site

www.uspto.gov/AmericaInventsAct

uspto.GOV

The United States Patent and Trademark Office
an agency of the Department of Commerce

search for patents | search for trademarks

Search our site



PATENTS | TRADEMARKS | IP LAW & POLICY | PRODUCTS & SERVICES | INVENTORS | NEWS & NOTICES | FAQs | ABOUT US

[Home Page](#) » [America Invents Act](#) » Implementation Information

Implementation Information

- Patent Examination
- Inter Partes Disputes
- Fees and Budgetary Issues
- AIA Studies and Reports
- Programs
- Implementation Status

AIA Resources

AIA Informational Videos

AIA Press Releases and Speeches

AIA Frequently Asked Questions

AIA Comments

AIA Blog

AIA Roadshow

Global Impacts of AIA

Leahy-Smith America Invents Act Implementation



President Barack Obama signs the America Invents Act September 16, 2011, at Thomas Jefferson High School for Science and Technology in Alexandria, VA.

MESSAGE FROM JANET GONGOLA, PATENT REFORM COORDINATOR: Date Change for Public Forum to Discuss First-Inventor-to-File, Micro Entity, and Patent Fee Final Rules

The USPTO is hosting a public forum on Friday, March 15th in the Madison Auditorium on the USPTO's Alexandria campus



AMERICA INVENTS ACT
IMPLEMENTATION

AIA Help

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





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IMPLEMENTATION

Thank You