



UNITED STATES PATENT AND TRADEMARK OFFICE

America Invents Act¹

Potential Items for Board of Patent Appeals and Interferences

This list is being provided to aid the public in focusing its comments to the Office regarding implementation of the America Invents Act. Please submit your comments to aia_implementation@uspto.gov, marked to the attention of Michael P. Tierney, Administrative Patent Judge, Board of Patent Appeals and Interferences, and captioned with the specific issue addressed in the comment. Each Roman numeral represents a specific issue.

- I. Inter Partes Review (IP Review), 35 U.S.C. 311-319.
 - A. Effective Date (pages 53 and 81): Takes effect 1 year from date of enactment. Petitions for IP Review may be filed on or after that date. Existing IP reexamination proceedings proceed as if the changes effective 1 year after enactment were not made. No new IP reexaminations may be filed on or after that date.
 - B. Proceedings conducted by administrative patent judges. No internal appeal.
 - C. Final decision by Board within 1 year period after institution of the review (extendable for good cause by 6 months).
 - D. Petitioner may only raise grounds under section 102 and 103 and only on the basis of prior art consisting of patents and printed publications.
 - E. All patents are subject to proceeding, regardless of their effective filing date.
 - F. Proceedings may be filed at any time on or after date that is 9 months after issue or reissuance, or if a post grant review is instituted, the date of termination of post grant review.

¹ H.R. 1249, passed June 23, 2011. Conforming changes to other sections are not identified

- G. Specific coordination with district court proceedings involving same patent and petitioner.

II. Post Grant Review (PGR), 35 U.S.C. 321-329.

- A. Effective Date (pages 70 and 81): Takes effect 1 year from date of enactment. Petitions may be filed on or after that date.
- B. Proceedings conducted by administrative patent judges. No internal appeal.
- C. Final decision by Board within 1 year period after initiation (extendable for good cause by 6 months).
- D. Petitioner may raise any ground that may be raised under paragraphs (2) or (3) of section 282(b).
- E. Generally limited to patents for which the first-inventor-to-file provisions apply.
- F. Proceeding must be filed within 9 months of issuance or, in certain cases, reissuance.
- G. Specific coordination with district court proceedings involving same patent and petitioner.

III. Transitional Program for Covered Business Method Patents (TPCBM), (section 18 of AIA).

- A. Effective Date (page 122): Takes effect 1 year from date of enactment. Applies to any petition for TPCBM. Repealed 8 years after effective date.
- B. Proceedings conducted by administrative patent judges. No internal appeal.
- C. Final decision by Board within the 1 year period after initiation (extendable for good cause by 6 months).
- D. Petitioner may raise any ground that may be raised under paragraphs (2) or (3) of section 282(b), unless patent is not subject to the first inventor to

file regime, in which cases certain prior art restrictions apply.

- E. Only patents for covered business method are subject to / eligible for TPCBM. Petitioner must have been sued for infringement of the patent or have been charged with infringement of that patent.
- F. Proceedings may be filed at any time, except for patents for which the first inventor to file provisions. Proceedings may not be file until expiration of the time period set in 35 U.S.C. 321(c) for patents subject to PGR.
- G. Specific coordination with district court proceedings involving same patent and petitioner.

IV. Derivations, 35 U.S.C. 135.

- A. Effective Date (page 23-4): Provides for effect 18 months after enactment, only applied to applications subject to first-inventor-to-file provisions. Older version of 35 U.S.C. 135 also applies provided the application contains claims subject to the repealed first-to-invent provisions.
- B. Petition requirements:
 - i. Petition must show basis for finding derivation.
 - ii. Petition must be filed within one year of first publication of a claim to an invention that is the same or substantially the same invention as earlier application's claim to the invention. 35 U.S.C. 135(a).
- C. Who may file:
 - i. Applicant for patent.