

Patent Public Advisory Committee Meeting Implementing the America Invents Act



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Patent Reform Coordinator
February 14, 2012



Implementation Ongoing: 12 Month Timeline (Effective on September 16, 2012)

	AIA Provision	Notice of Proposed Rulemaking
1	Inventor's oath/declaration	Changes to Implement the Inventor's Oath or Declaration Provisions of the Leahy-Smith America Invents Act, 77 Fed. Reg. 982 (Jan. 6, 2012) ---Comment period closes March 6, 2012
2	Preissuance submissions by third party	Changes to Implement the Preissuance Submissions by Third Parties Provision of the Leahy-Smith America Invents Act, 77 Fed. Reg. 448 (Jan. 5, 2012) ---Comment period closes March 5, 2012
3	Citation of prior art in a patent file	Changes to Implement Miscellaneous Post Patent Provisions of the Leahy-Smith America Invents Act, 77 Fed. Reg. 442, (Jan. 5, 2012) ---Comment period closes March 5, 2012
4	OED Statute of Limitations (effective September 16, 2011)	Implementation of the Statute of Limitations Provisions for Office Disciplinary Proceedings, 77 Fed. Reg. 457 (Jan. 5, 2012) ---Comment period closes March 5, 2012
5	Supplemental Examination	Changes to Implement the Supplemental Examination Provisions of the Leahy-Smith America Invents Act and to Revise Reexamination Fees, 77 Fed. Reg. 3666 (Jan. 25, 2012) ---Comment period closes March 25, 2012



Implementation Ongoing: 12 Month Timeline (cont.) (Effective on September 16, 2012)

	AIA Provision	Notice of Proposed Rulemaking
6	Inter partes review	Changes to Implement Inter Partes Review Proceedings, 77 Fed. Reg. 7041 (Feb. 12, 2012) ---Comment period closes April 10, 2012
7	Post-grant review	Changes to Implement Post Grant Review Proceedings, 77 Fed. Reg. 7060 (Feb. 12, 2012) ---Comment period closes April 10, 2012
8	Transitional program for covered business method patents	Changes to Implement Transitional Program for Covered Business Method Patents, 77 Fed. Reg. 7080 (Feb. 12, 2012); Transitional Program for Covered Business Method Patents—Definition of Technological Invention, 77 Fed. Reg. 7095 (Feb. 12, 2012) ---Comment period closes April 10, 2012
9	Derivation (effective on March 16, 2013)	Changes to Implement Derivation Proceedings, 77 Fed. Reg. 7028 (Feb. 12, 2012) ---Comment period closes April 10, 2012
		Rules of Practice for Trials Before the Patent Trial and Appeal Board and Judicial Review of Patent Trial and Appeal Board Decisions, 77 Fed. Reg. 6879 (Feb. 11, 2012); Practice Guide for Proposed Trial Rules, 77 Fed. Reg. 6868 (Feb. 11, 2012) ---Comments period closes April 9, 2012



Input into Proposed Rules

- 171 public comments considered in building proposed rules
- Feedback incorporated from:
 - POPA
 - PPAC
 - Department of Commerce
 - Office of Management and Budget

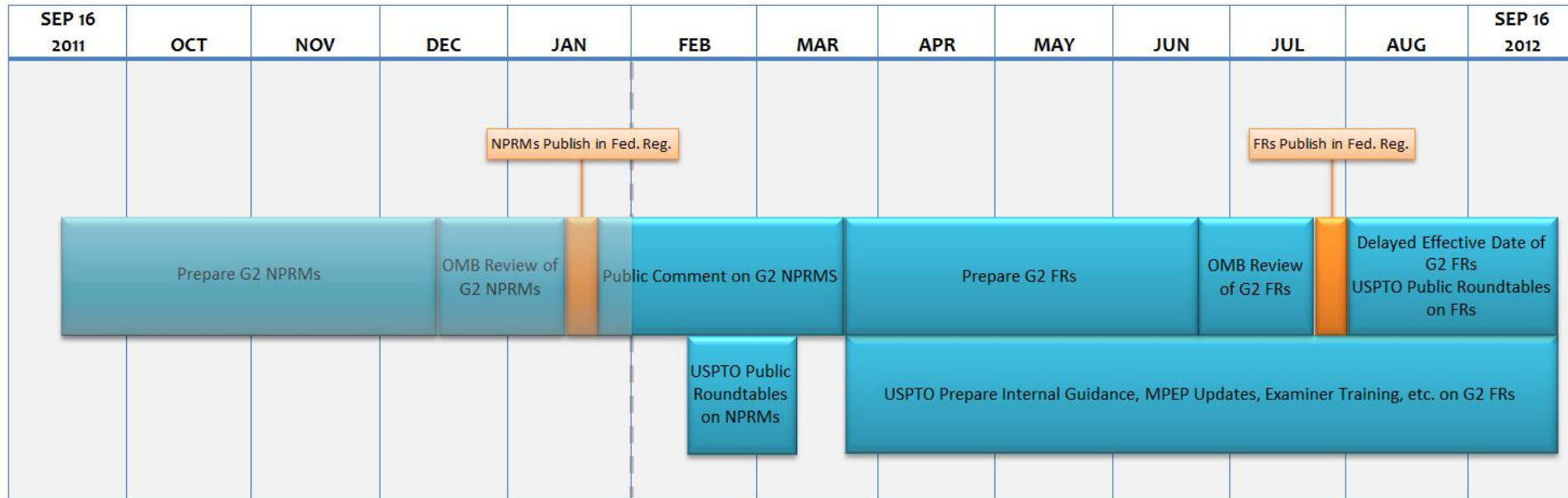


Fee Methodology Employed for Proposed Rules

- Fees set under 35 U.S.C. § 41(d)(2) for cost recovery and not under Section 10 of the AIA
- May later be adjusted when USPTO exercises Section 10 fee setting authority



12 Month Timeline





Fee Setting Authority Under Section 10 of the AIA

- USPTO authorized to set or adjust patent and trademark fees by rule
 - Patent/trademark fees may be set to recover only the aggregate estimated cost of patent/trademark operations, including administrative costs
 - 17 Month Timeline



PPAC Fee Setting Hearing

- Required by section 10 of the AIA
- Patent Public Advisory Committee Public Hearings on the Proposed Patent Fee Schedule, 77 Fed. Reg. 4509 (Jan. 20, 2012)
 - Hearings:
 - Wednesday, February 15, 2012 @ USPTO
 - Thursday, February 23, 2012 @ Sunnyvale, CA
 - Written comments due by February 29, 2012
- Fee information on AIA microsite; PPAC questions regarding USPTO proposed fees on PPAC website



Progress Report: Studies

	Topic	Due Date from Enactment	Status
1	International Patent Protection for Small Businesses	4 months	Complete
2	Prior User Rights	4 months	Complete
3	Genetic Testing	9 months	Ongoing
4	Misconduct Before the Office	Every 2 years	Future
5	Satellite Offices	3 years	Future
6	Virtual Marking	3 years	Future
7	Implementation of AIA	4 years	Future



Int'l Patent Protection for Small Businesses Study

- USPTO studied how the USPTO and other federal agencies can best financially help small businesses with patent protection overseas
- USPTO consulted with the Department of Commerce and the Small Business Administration
- Report (33 pages) timely submitted to Congress on January 13, 2012



Int'l Patent Protection Report Recommendations

- Engage in diplomacy and harmonization to reduce the costs associated with filing foreign patent applications (e.g., via small entity discounts);
- Expand IP education and training for U.S. small businesses;
- Engage industry regarding how to best support U.S. small business efforts to patent internationally (e.g., corporate venture capital); and
- Collect more information and conduct further study regarding governmental financial assistance to U.S. small businesses (e.g., loan versus grant)



Prior User Rights Study

- USPTO studied the operation of prior user rights (PUR) in other industrialized countries
- USPTO consulted with the United States Trade Representative, Secretary of State, and Attorney General
- Report (60 pages) timely submitted to Congress on January 13, 2012



Prior User Rights Report Recommendations

- PUR defense in the AIA is consistent with that offered by major trading partners;
- No substantial evidence that PUR defense in the AIA will have a negative impact on innovation, venture funding, small businesses, universities, or independent inventors;
- U.S. should re-evaluate economic impact of PUR defense in “Implementation of AIA” report due to Congress in 2015;
- PUR defense is appropriate balance between trade secret protection and patent law; and
- U.S. patent law should provide for a PUR defense to address inequity inherent in a first-inventor-to-file system



Congressional PUR Hearing

- House Subcommittee on Intellectual Property, Competition and the Internet held a PUR hearing on February 1, 2012
- Director Kappos to testify on PUR Report



Genetic Testing Study

- USPTO to report on effective ways to provide independent, confirming genetic diagnostic tests where:
 - gene patents; and
 - exclusive licensing for primary genetic diagnostic tests
- Request for Comments and Notice of Public Hearings on Genetic Diagnostic Testing, 77 Fed. Reg. 3748 (Jan. 25, 2012)
 - Hearings:
 - February 16, 2012 @ USPTO
 - March 9, 2012 @ San Diego
 - Written comments due by March 26, 2012
- Report due by June 16, 2012



Progress Report: Programs

	Topic	Due Date from Enactment	Status
1	Pro Bono	Immediately	Complete
2	Diversity of Applicants	6 months	Ongoing
3	Patent Ombudsman for Small Businesses	12 months	Ongoing
4	Satellite Offices	3 years	Ongoing



Satellite Offices

- USPTO required to open 3 satellite offices in three years
- Initial office planned for Detroit; opening 2012
 - 300 River Place Dr. = former home to Parke-Davis Laboratories and the Stroh's Brewery Headquarters
- Comment period closed on January 30, 2012, for suggestions on the locations of the two other satellite offices
 - 626 comments received



AIA Roadshows and Hearings

www.uspto.gov/AmericanInventsAct

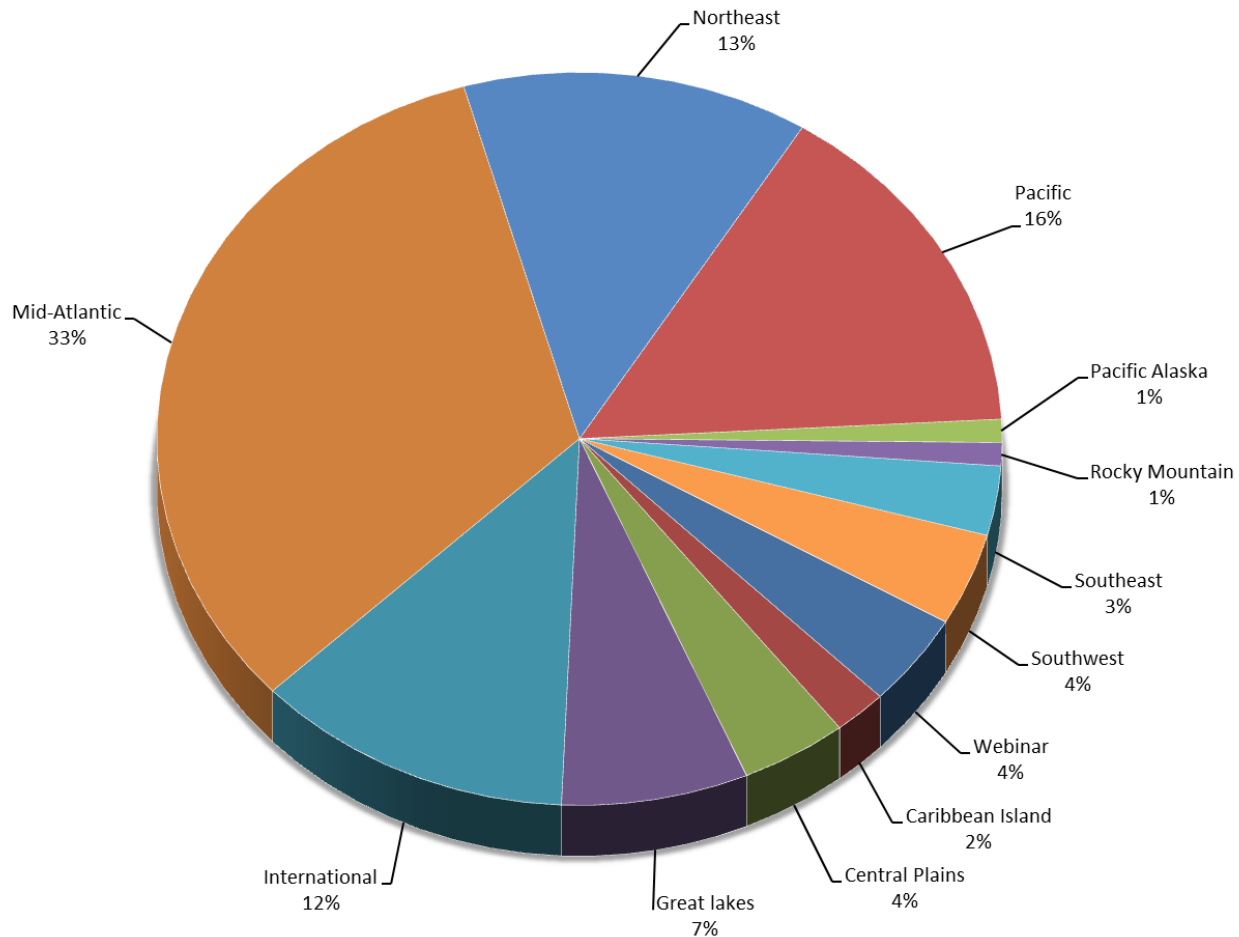
Roadshow and Hearing Schedule 2012

Date	Event	Venue	Location
Wednesday, February 15	PPAC Fee Setting Hearing*	USPTO Campus	Alexandria, VA
Thursday, February 16	Genetic Testing Hearing*	USPTO Campus	Alexandria, VA
Friday, February 17	Roadshow*	USPTO Campus	Alexandria, VA
Thursday, February 23	PPAC Fee Setting Hearing*	Sunnyvale Public Library	Sunnyvale, CA
Friday, February 24	Roadshow*	Sunnyvale Public Library	Sunnyvale, CA
Monday, February 27	Roadshow	Marriott Library, University of Utah	Salt Lake City, UT
Wednesday, February 29	Roadshow	Dallas Public Library	Dallas, TX
Friday, March 2	Roadshow	Broward County Main Library	Ft. Lauderdale, FL
Monday, March 5	Roadshow	Boston Public Library	Boston, MA
Wednesday, March 7	Roadshow	Chicago Public Library	Chicago, IL
Friday, March 9	Genetic Testing Hearing*	University of San Diego	San Diego, CA



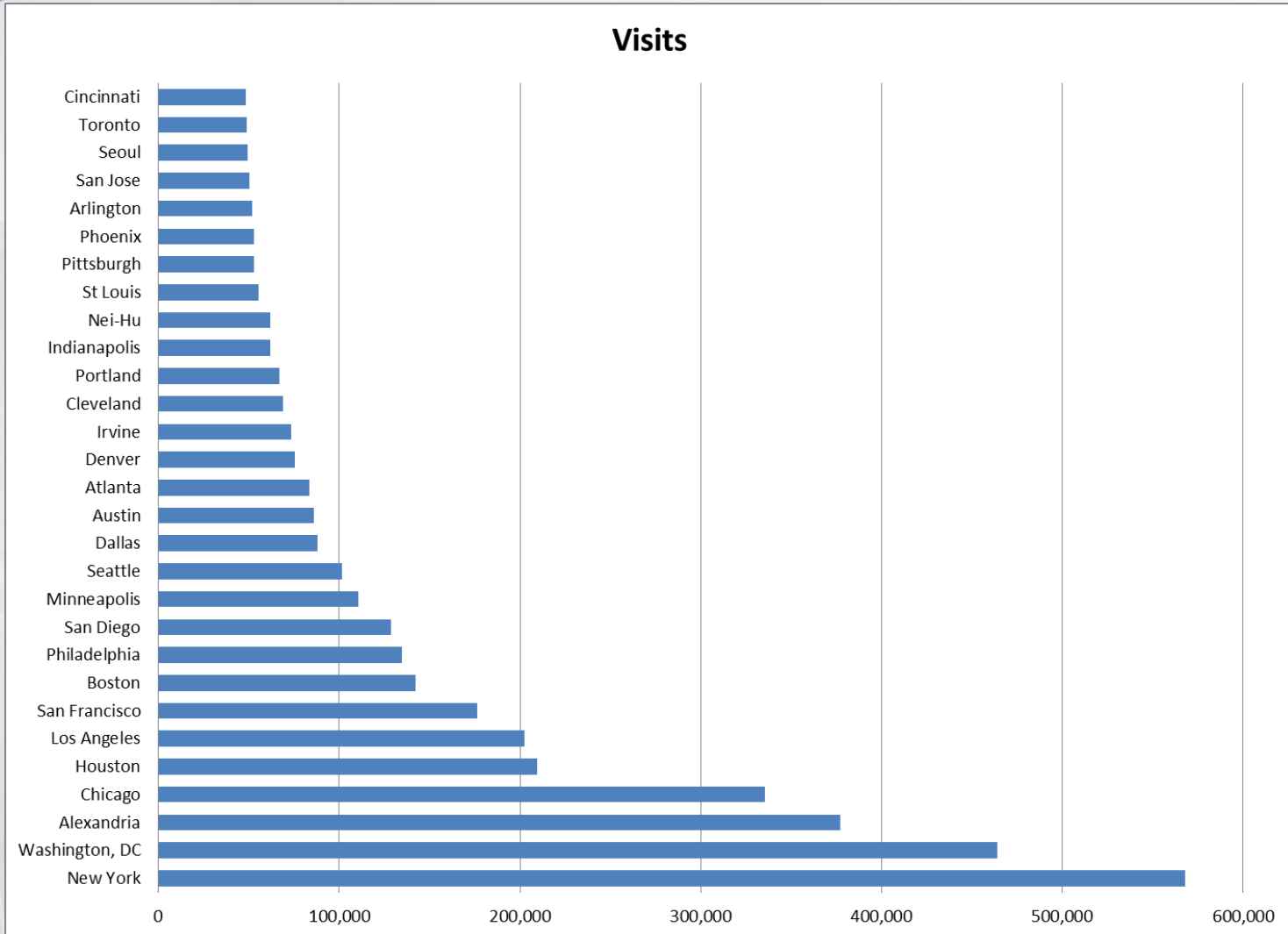
Other Public Outreach

AIA Speaking Engagements by Region





Micro-Site Utility



Thank You



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