

A Primer on the USPTO's Activities and Initiatives



Sue A. Purvis

*Innovation and Outreach Coordinator
Greater New York Region*



Satellite Office Program

Dallas-
Fort Worth

Denver

Detroit

Silicon Valley

● historic expansion ● regional job growth ● an innovation ecosystem ● concepts of operation

2/25/2013

2



Expanded Outreach in NYC



- U.S. Department of Commerce partners with Cornell University to provide commercialization support to the innovation community in New York City as a part of the Cornell NYC Tech Campus.



Cornell NYC Tech – Roosevelt Island





AIA Enactment Timeline

Day of enactment
Sept 16, 2011

Reexamination transition for threshold

Tax strategies are deemed within prior art

Best mode

Human organism prohibition

Virtual and false marking

Venue change from DDC to EDVA for suits brought under 35 U.S.C. §§ 32, 145, 146, 154 (b)(4)(A), and 293

OED Statute of Limitations

Fee Setting Authority

Establishment of micro-entity

10 Days
Sept 26, 2011

Prioritized Examination

15% transition Surcharge

Oct 1, 2011

Reserve Fund

60 Days
Nov 15, 2011

Electronic Filing Incentive

12 Months
Sept 16, 2012

Inventor's oath/declaration

Third party submission of prior art for patent application

Supplemental examination

Citation of prior art in a patent file

Priority examination for important technologies

Inter partes review

Post-grant review

Transitional post-grant review program for covered business method patents

18 Months
Mar 16, 2013

First-to-File

Derivation proceedings

Repeal of Statutory Invention Registration

Provisions are enacted





Inventor's Oath/Declaration: 35 U.S.C. 118

- Permits an assignee, person to whom there is an obligation to assign, or person with a sufficient proprietary interest in the claimed invention to be the applicant
- Term “applicant” is no longer synonymous with the inventor
- Each inventor must still be named



Inventor's Oath/Declaration: 35 U.S.C. 115

- 35 U.S.C. 115 requires for each inventor:
 - Oath/declaration executed by the inventor;
 - Substitute statement with respect to the inventor; or
 - Assignment that contains the statements required for an oath/declaration by the inventor



Inventor's Oath/Declaration: Timing of Submission

- Oath/declaration may be postponed until the application is otherwise in condition for allowance provided that a signed Application Data Sheet (ADS) has been submitted:
 - identifying each inventor by his or her legal name; and
 - with a mailing address and residence for each inventor
- Oath/declaration must still be provided for a reissue application prior to examination
- Current surcharge is still required when the oath/declaration is not present on filing



Inventor's Oath/Declaration: Best Practices

- Submit a signed ADS for every application
 - Identify inventors and assignee (if applicable)
 - Present domestic benefit claims and foreign priority claims (except for national stage applications) in an ADS
- Re-execute a new oath/declaration in a child application filed after September 16, 2012
- Submit combination assignment-statement on the same day to avoid a surcharge



Inventor's Oath/Declaration: Pitfalls to Avoid

- Do not use the new inventor declaration form in an application entering the national stage on or after September 16, 2012, where the PCT application was filed prior to September 16, 2012
- Do not submit papers signed by a juristic entity
- Do not make substantive changes to the application that would constitute new matter after the inventor's oath or declaration has been executed



Inventor's Oath/Declaration: Forms

- <http://www.uspto.gov/forms/>
 - Oath/declaration
 - Substitute statement
 - Power of Attorney
 - Application data sheet
- No form for combination assignment-statements
- Quick reference guide for how to file an inventor's oath/declaration available on AIA micro-site
 - http://www.uspto.gov/aia_implementation/inventors-oath-or-declaration-quick-reference-guide.pdf



Preissuance Submission: 35 U.S.C. 122(e)

- Any third party may submit printed publications of potential relevance to the examination of an application for consideration and inclusion in the record of the application
- Must be timely made in writing and include:
 - Concise description of asserted relevance of each document;
 - Fee; and
 - Statement of compliance with statute



Preissuance Submission: Statutory Timing

- Must be made before the later of:
 - 6 months after the date on which the application is first published by the Office; or
 - date of first rejection of any claim by the examiner

AND

- Must be made before the date a notice of allowance is given or mailed



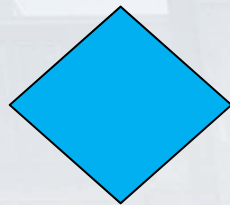
Preissuance Submission: Fee

Service	Fee
Every 10 documents listed or fraction thereof	\$180 fee
First submission of 3 or fewer total documents submitted	No fee



Preissuance Submission: Processing

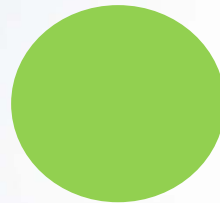
USPTO Reviews
Submission for
Compliance with 35
U.S.C. § 122(e) and
§ 1.290



Compliant



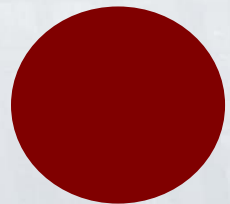
Submission Made of
Record and
Considered by
Examiner



Patent Applicant
Notified if E-Office
Action Participant



Non-compliant



Submission
Discarded



Third Party
Notified if
Email Address
Available

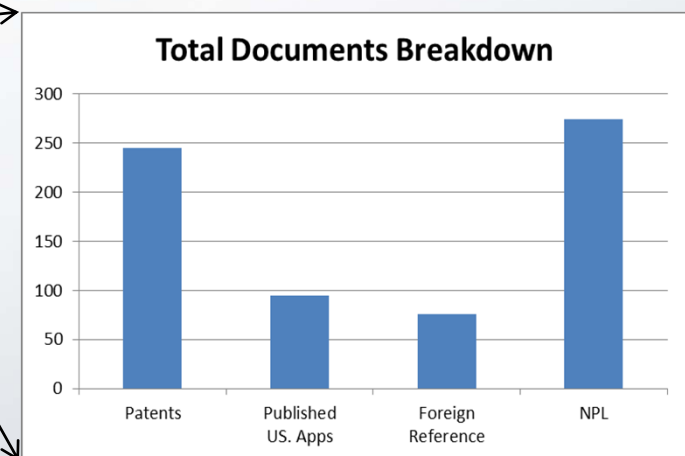
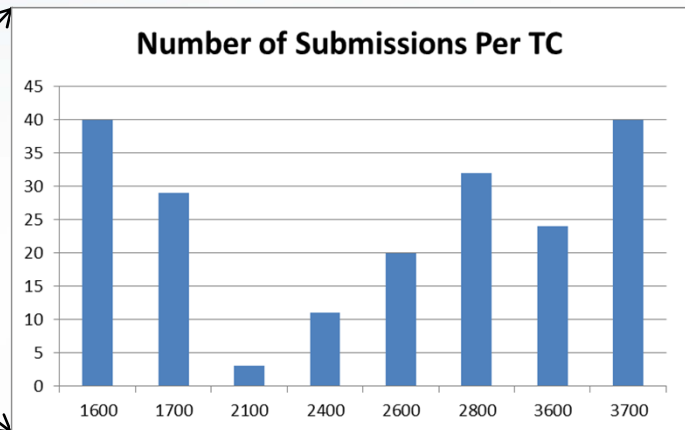


Preissuance Submission: Statistics (Data as of November 30, 2012)

3rd Party Submissions	
Proper	135
Improper (including 26 resubmissions and 6 that were not 3rd party)	60
Not Yet Reviewed	10
Total	205

Total Documents Breakdown w/o resubmissions	
Patents	245
Published US. Apps	95
Foreign Reference	76
NPL	274
Total Documents	690

Stack Exchange	
# days the Ask Patents website has been active	72
# questions asked on the site	254
# questions answered	230
# questions with the "prior art" tag	90
# prior art submissions to the USPTO	0
# references used in Office Actions by examiners (rejections & cited as relevant)	TBD





Preissuance Submissions: Best Practices

- File electronically via the third-party submissions interface in EFS-Web
- Check for timeliness before filing
- List each printed publication for consideration separately
- Provide a complete citation for each printed publication listed
- Concise description of relevancy must explain factually how printed publication is of potential relevance to the examination of the application



Preissuance Submissions: Pitfalls to Avoid

- Do not file a preissuance submission in a provisional or reissue application, issued patent, or reexamination proceeding
- Do not submit documents which have not been published
- Do not submit follow-on papers via the preissuance submission interface in EFS-Web
- Do not forget fee to resubmit a submission after receiving a non-compliance notification



Supplemental Examination: 35 U.S.C. 257

- Patent owner may request supplemental examination of a patent to consider, reconsider, or correct information believed to be relevant to the patent
- Request may address 35 U.S.C. 101, 102, 103, and 112, and double-patenting
- Item of information must be in writing and is not limited to patents and printed publication
- 12 items of information per request, but multiple parallel requests allowed



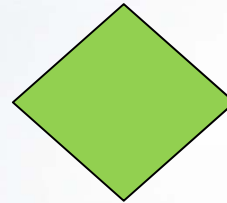
Supplemental Examination: Processing

Patent Owner
Request



3 months

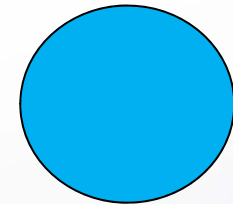
Decision on Patent Owner
Request: Substantial New
Question of Patentability
Standard Triggered?



YES



Supplemental
Examination Concluded
and Ex Parte
Reexamination Initiated



NO



Supplemental
Examination
Concluded



Administrative Trials: Features

Proceeding	Petitioner	Petitioner Estoppel	Standard	Basis
Post Grant Review (PGR)	<ul style="list-style-type: none"> Person who is not the patent owner and has not previously filed a civil action challenging the validity of a claim of the patent 	<ul style="list-style-type: none"> Raised or reasonably could have raised Applied to subsequent USPTO/district court/ITC action 	<p>More likely than not OR</p> <p>Novel or unsettled legal question important to other patents/applications</p>	<p>101, 102, 103, 112, double patenting but not best mode</p>
Inter Partes Review (IPR)	<ul style="list-style-type: none"> Must identify real party in interest 		<p>Reasonable likelihood</p>	<p>102 and 103 based on patents and printed publications</p>

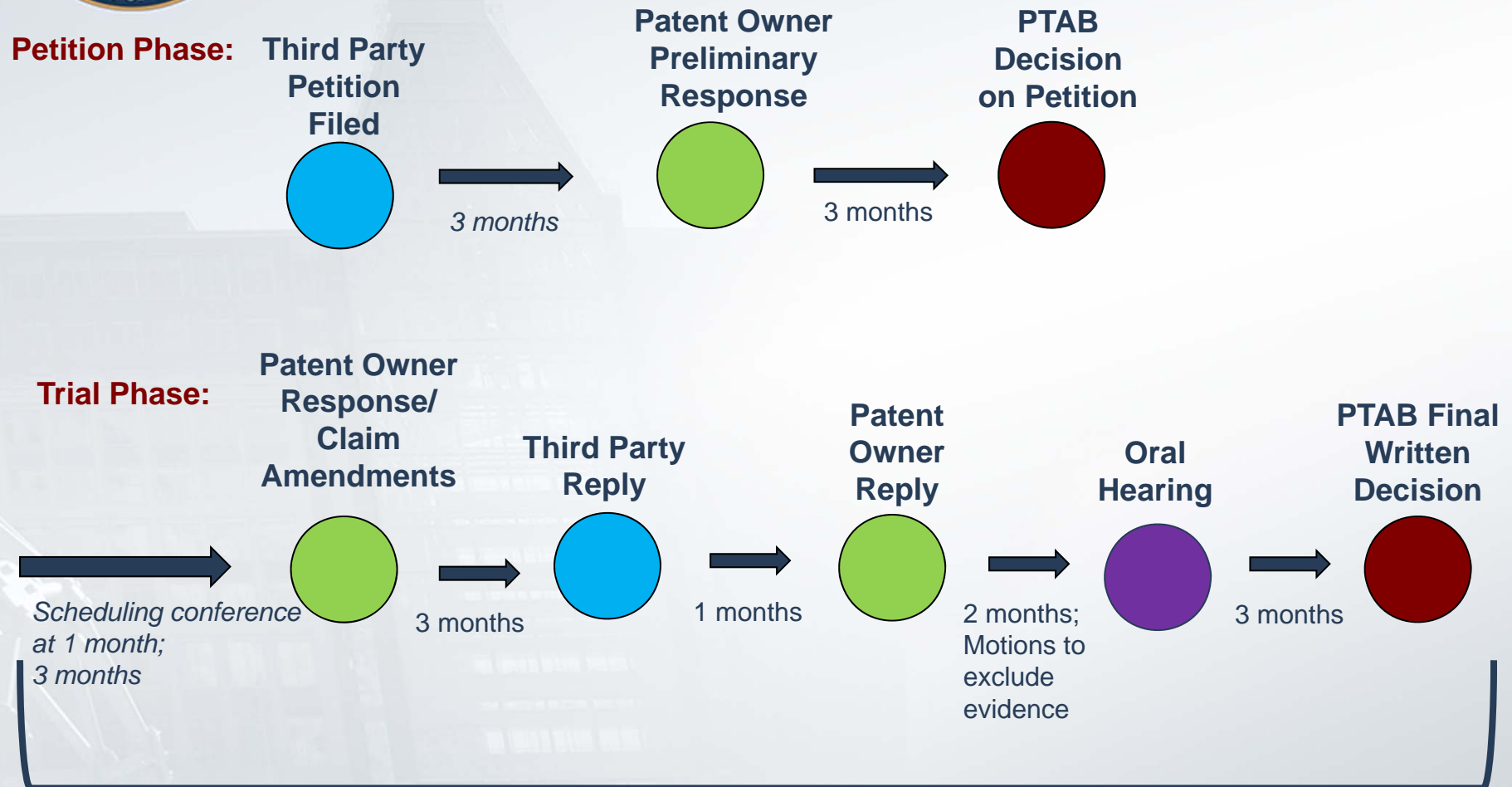


Administrative Trials: Features (cont.)

Proceeding	Available	Applicable	Timing	Fees
Post Grant Review (PGR)	From patent grant to 9 months from patent grant or reissue	Patent issued under first-inventor-to-file	Must be completed within 12 months from institution, with 6 months good cause exception possible	\$35,000 for 20 or fewer claims; \$800 for each additional claim
Inter Partes Review (IPR)	From the later of: (i) 9 months after patent grant or reissue; or (ii) the date of termination of any post grant review of the patent	Patent issued under first-to-invent or first-inventor-to-file		\$27,200 for 20 or fewer claims; \$600 for each additional claim



Administrative Trials: Process



Sequenced discovery;
No more than 12 months



Administrative Trials: Filing a Petition

- Use PRPS Electronic Filing System
 - <https://ptabtrials.uspto.gov/>
 - PRPS Telephone Help Line: 571-272-PTAB
 - E-mail: Trials@USPTO.gov
- Users must register before filing any papers
 - Registration is only available for practitioners with a USPTO registration number
- Quick Start Guide available to walk through filing process
 - http://www.uspto.gov/ip/boards/bpai/prps_quick_start_guide.pdf
- PTAB Website: <http://www.uspto.gov/ptab>



Administrative Trial: Statistics

(Data as of November 19, 2012)

- Administrative trials = 65 petitions
 - 51 inter partes review
 - 14 covered business method
 - No preliminary patent owner responses
- 75% electrical; 25% chemical/biotech/mechanical
- Majority of challenged patents are currently or previously subject to district court litigation



Motion for Pro Hac Vice Admission: Timing

- *Motorola Mobility LLC v. Arnouse*, Case IPR 2013-00010 (MPT); Patent 7,516,484, Paper 6, October 15, 2012 (expanded PTAB panel)
- File no sooner than 21 days after service of the petition; opposition due no later than one week after opening motion



Motion for Pro Hac Vice Admission: Contents

- Statement of facts showing there is good cause for admission
- Affidavit or declaration of the individual seeking to appear attesting to:
 - Good standing membership of at least 1 state bar
 - No suspensions or disbarments
 - No application to appear before any court to administrative tribunal ever denied
 - No sanctions or contempt citations
- Agreement to comply with the Patent Trial Practice Guide and Rules of Practice for Trials
- Recognition of being subject to USPTO Code of Professional Conduct
- Familiarity with subject matter of proceeding



First Inventor to File: Ongoing Rulemaking

- Effective Date: March 16, 2013
- Comment Period closed November 5, 2012
- Roundtable on First-Inventor-to-File Provision held September 6, 2012 at USPTO headquarter in Alexandria, VA



First Inventor to File: Goals

- Provide guidance to examiners and the public on changes to examination practice in light of the AIA
- Address examination issues raised by the AIA
- Provide the Office with information to readily determine whether the application is subject to the AIA's changes to 35 U.S.C. 102 and 103



First Inventor to File

- Transitions the U.S. to a first-inventor-to-file patent system while maintaining a 1-year grace period for inventor disclosures
- Prior public use or prior sale anywhere qualifies as prior art (prior public use and sale is no longer limited to the U.S.)



First Inventor to File

- U.S. patents and patent application publications are effective as prior art as of their priority date (no longer limited to U.S. priority date), provided that the subject matter relied upon is disclosed in the priority application
- Applies to:
 - Claim with an effective filing date on or after March 16, 2013; and
 - Claim for benefit to an application that ever had a claim with an effective filing date on or after March 16, 2013



Framework

Prior Art	Exceptions	Label
102(a)(1)	102(b)(1)(A)	Grace Period Inventor Disclosures & Grace Period Non-inventor Disclosures
	102(b)(1)(B)	Grace Period Intervening Disclosures
102(a)(2)	102(b)(2)(A)	Non-inventor Disclosures
	102(b)(2)(B)	Intervening Disclosures
	102(b)(2)(C)	Commonly Owned Disclosures



Fee Setting: Ongoing Rule Making

- Fee Setting
 - Patent Fees Proposed Rule (77 Fed. Reg. 55028, September 6, 2012)
- Comment period closed November 5, 2012



Fee Setting: Goals and Strategies

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

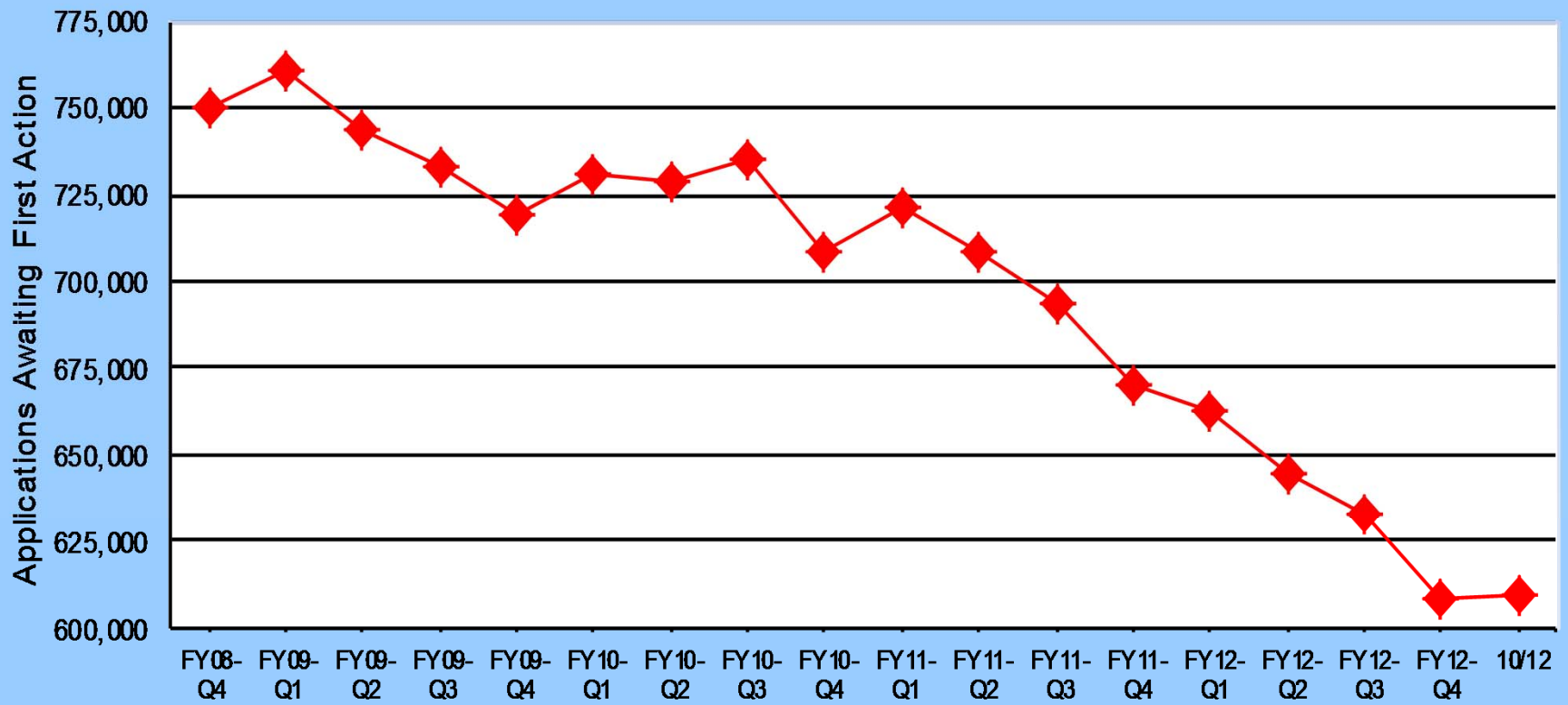


AIA Help

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



Unexamined Patent Application Backlog FY 2009 – FY 2013 (through October 18)

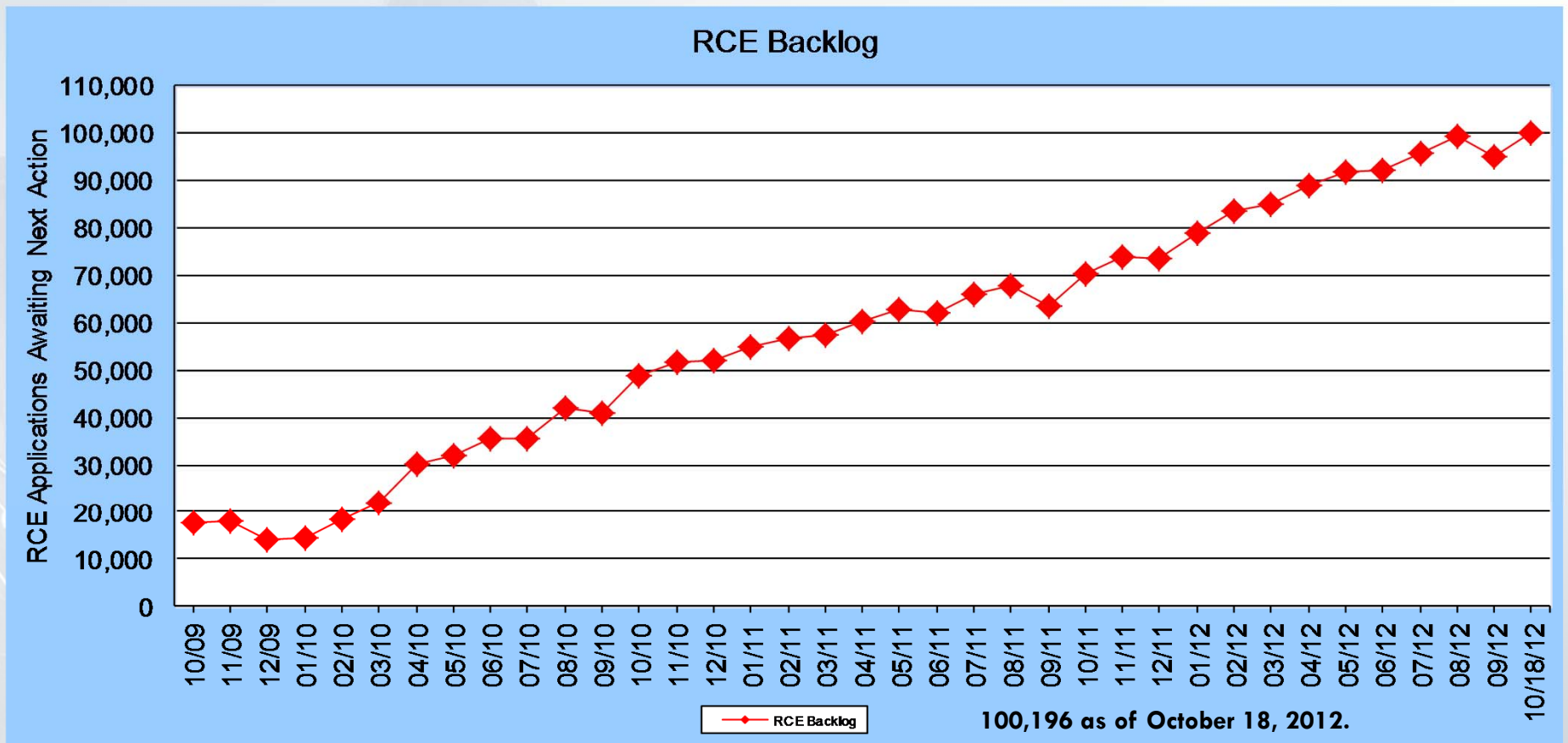


608,651 Excess Unexamined Applications as of October 18, 2012.

End of Fiscal Year 2012 backlog was 608,283.



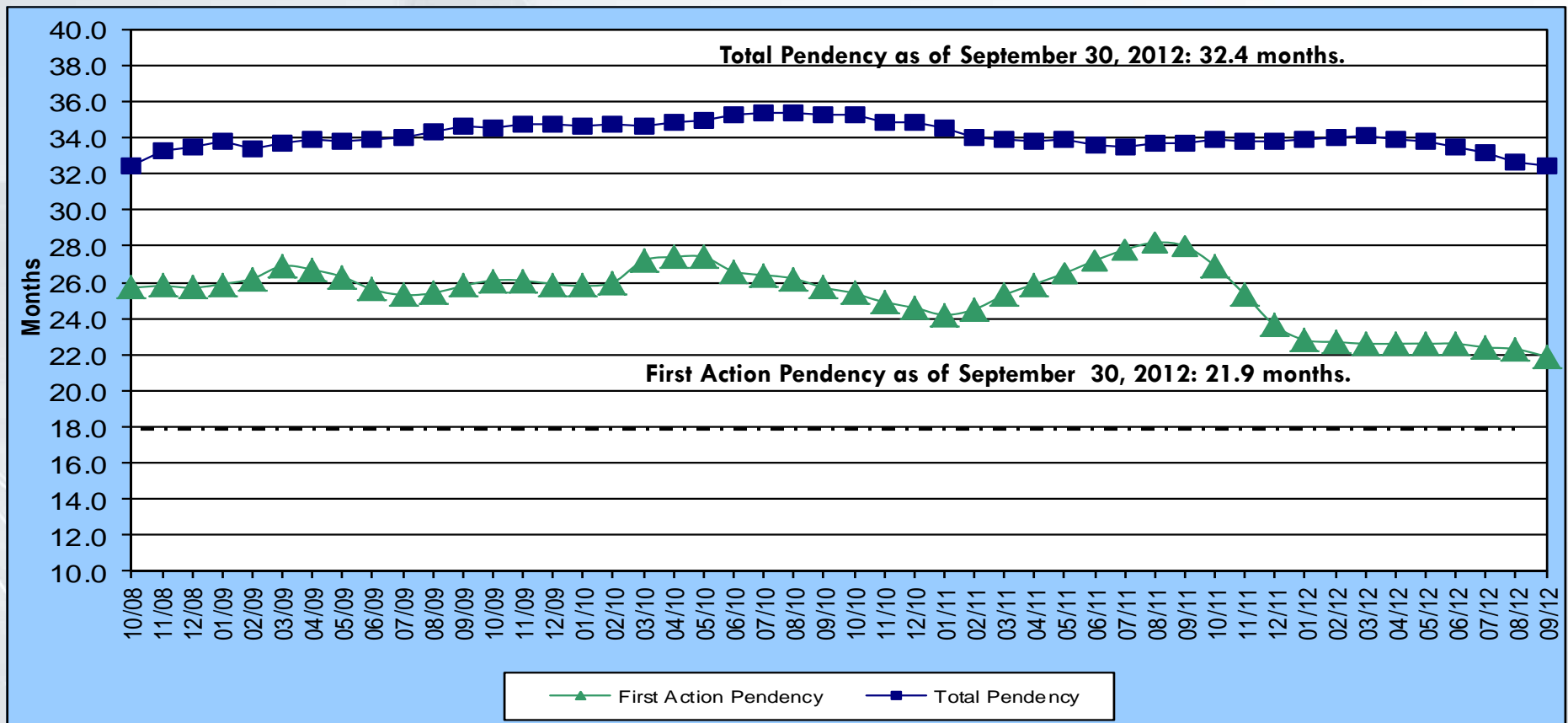
RCE Backlog FY 2010 – FY 2013 (through October 18)



End of Fiscal Year RCE backlog was 95,200.



First Action Pendency and Total Pendency FY 2009 – FY 2012



Average Total Pendency FY 2012 Target: 34.7 months. Actual result: 32.4 months.

Average First Action Pendency FY 2012 Target: 22.5 months. Actual result: 21.9 months.

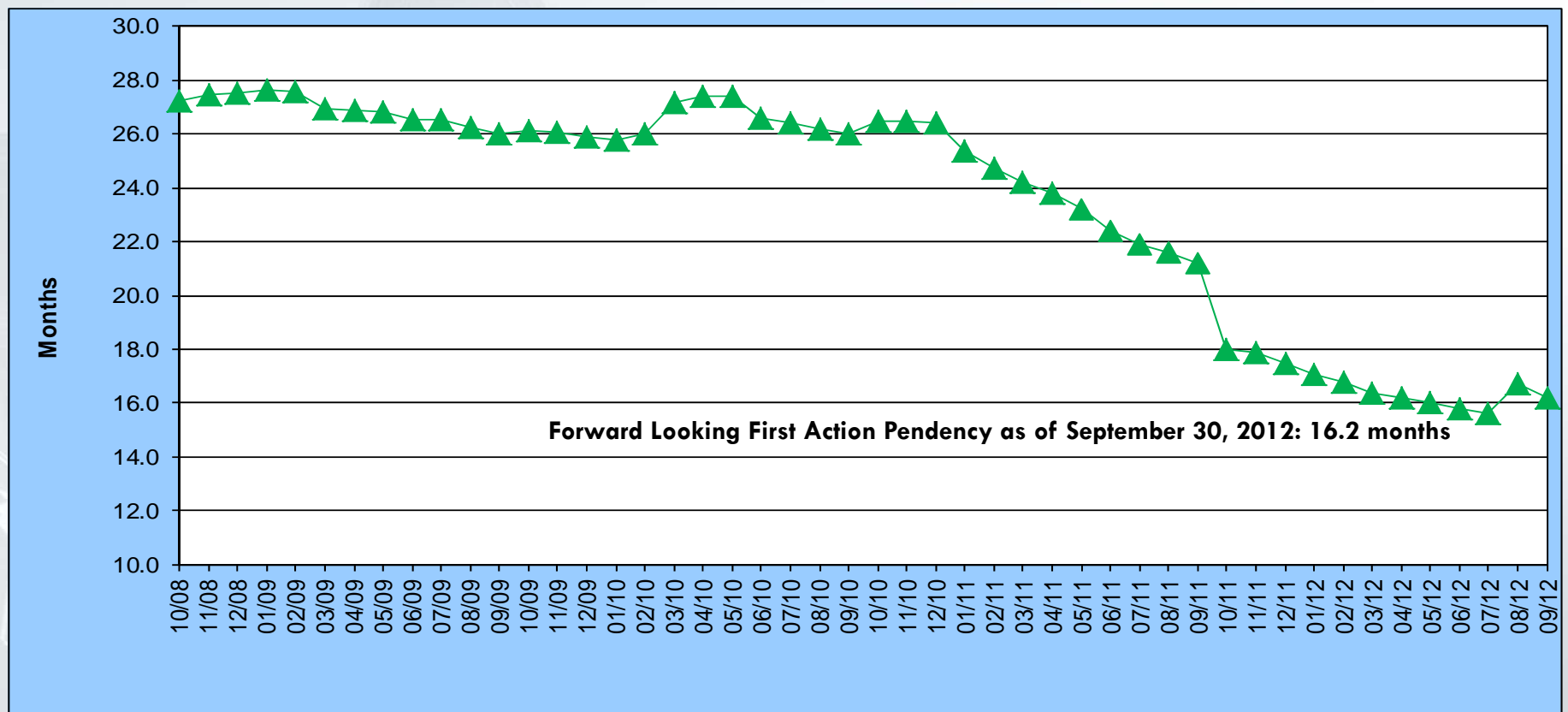
FY 2013 Targets:

--- Average First Action Pendency: 18.0 months.

--- Average Total Pendency: 30.1 Months.



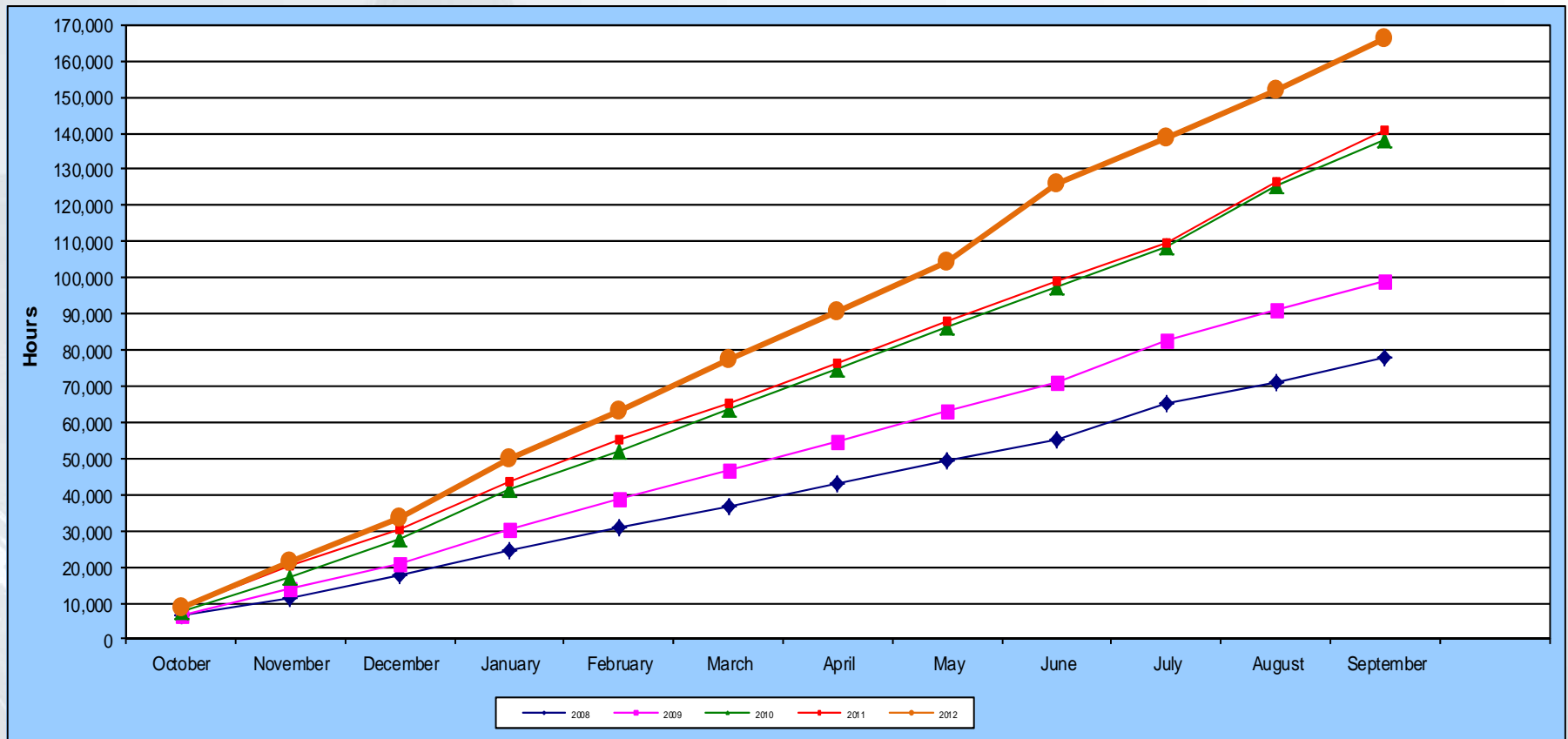
Forward Looking First Action Pendency FY 2009 – FY 2012



Forward Looking Pendency represents an estimate of the average number of months it would take to complete a first Office action under current and projected workload and resource levels for an application filed at the given date.



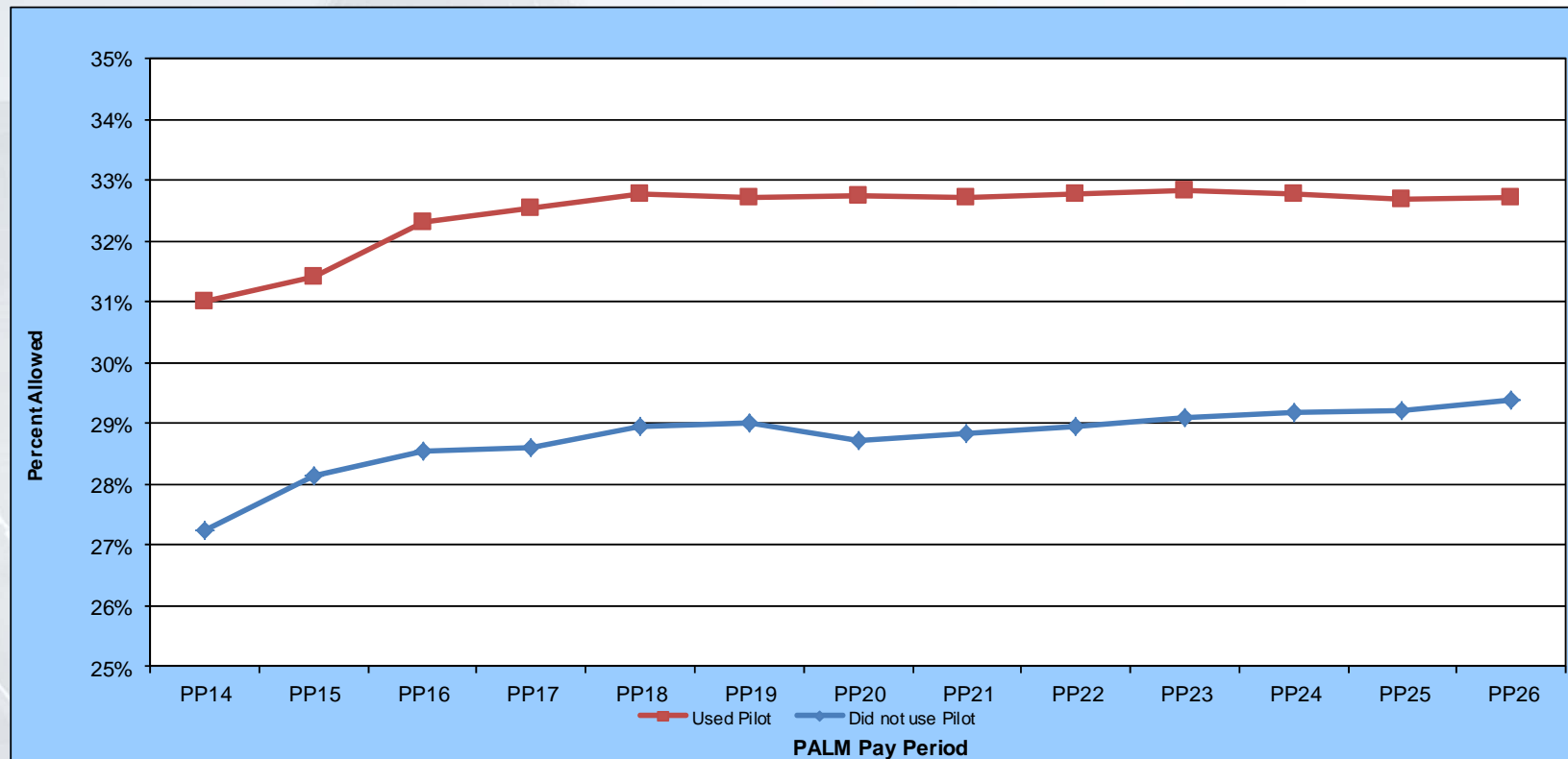
Interview Time FY 2008 – FY 2012 (through September 22)



166,090 hours as of September 22, 2012, compared with 140,692 hours in FY 2011. 20,102 FY 12 interview hours have been charged through the AFCP program.



After Final Consideration Pilot Cumulative Data for Pay Periods 1214 - 1226





Quick Path Information Disclosure Statement (QPIDS)

QPIDS	Fiscal Year 12										FY 2013		TOTALS
	PP 17	PP 18	PP 19	PP 20	PP 21	PP 22	PP 23	PP 24	PP 25	PP 26	PP 1	PP 2 (Current)	
Total Number filed	11	51	67	45	61	45	58	33	47	95	7	28	548
Total QPIDS completed process		9	31	36	37	45	34	61	35	53	10	27	378
• # Corrected NOA's mailed		4	26	29	29	41	29	54	29	50	9	23	323
• Total # RCE's process		5	5	7	8	4	5	7	6	3	1	4	55
# RCE's need to be processed due to QRCE (by examiner)		1	3	7	7	4	5	7	5	3	1	4	47
# non-compliant QPIDS request		4	2	0	1	0	0	0	1	0	0	0	8

* 170 remaining cases are either awaiting action or not processed correctly.



Track One Statistics *as of November 26, 2012*

Petitions Filed	% of Decided Petitions Granted	Days from Petition to first Office action	Average Days to final disposition
6,766	95%	49.3	158

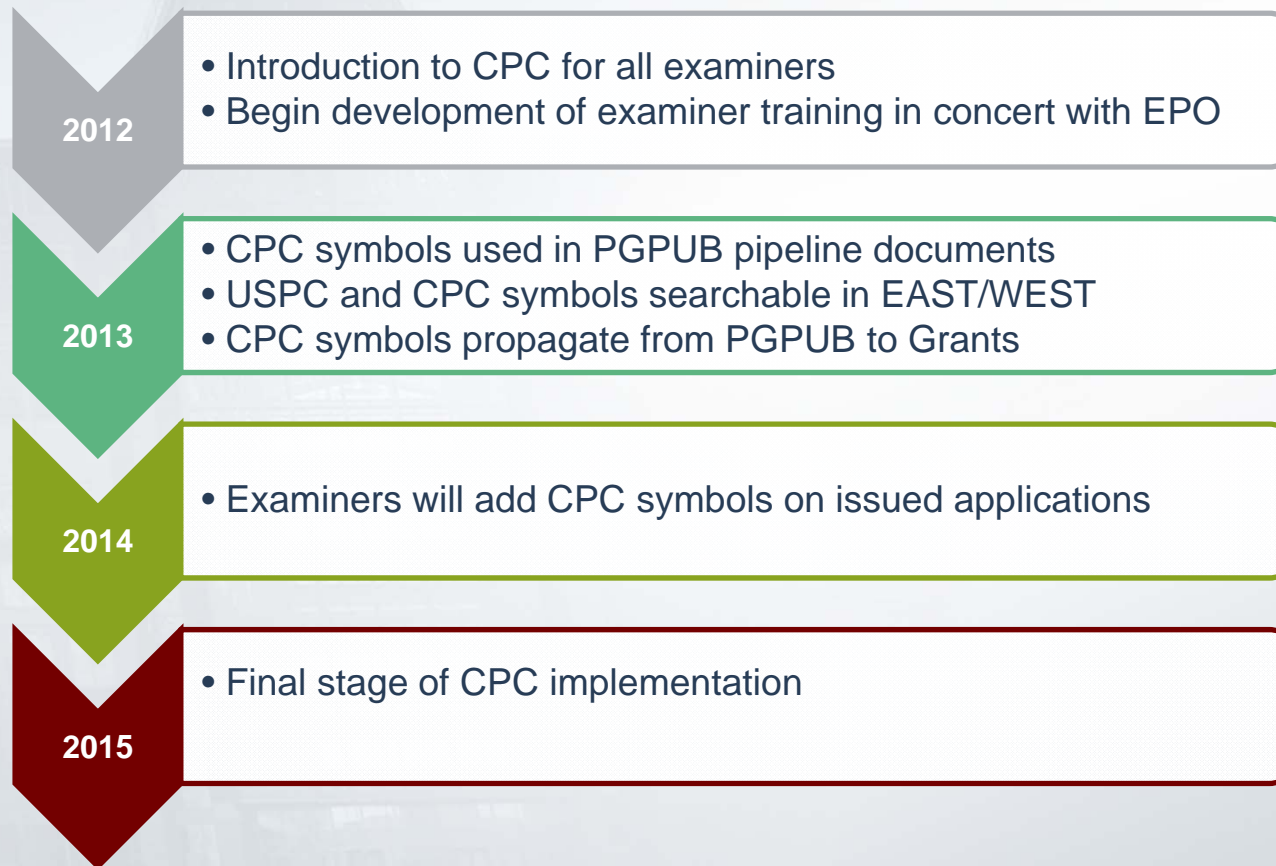
First Action on Merits mailed	Final Dispositions mailed	Allowances Mailed
4,515	2,658	1,379



Cooperative Patent Classification



CPC Implementation Timeline





Real-Party-in-Interest Roundtable

The USPTO is considering promulgating regulations that would require greater public transparency concerning the ownership of patent applications and patents by requiring the provision of real-party-in-interest information during patent prosecution and at certain times post-issuance.

- The roundtable will be held on **Friday, January 11, 2013**, beginning at 8:30 a.m. and ending at 12:00 p.m. EDT.



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
- Previous Hearings held:
 - February 16, 2012 @ USPTO
 - March 9, 2012 @ San Diego
- Hearing to be held **January 10, 2013** at the USPTO in Alexandria.

Thank You

