

A Primer on the USPTO's Activities and Initiatives



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*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

1/16/2013

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 Implementation

Group 2 Rulemaking (Effective September 16, 2012)

Patent Related

- Inventor's oath / declaration
- Preissuance submission
- Supplemental examination
- Citation of patent owner claim scope statements

Administrative Trials

- Inter partes review
- Post grant review
- Covered business method review



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**
 - Identity 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



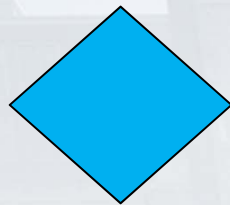
Preissuance Submission: Fee

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

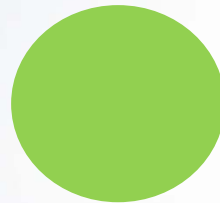
USPTO Reviews
Submission for
Compliance with 35
U.S.C. § 122(e) and
§ 1.290



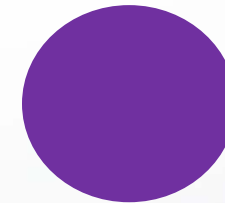
Compliant



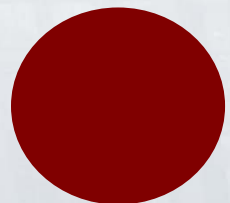
Submission Made of
Record and
Considered by
Examiner



Patent Applicant
Notified if E-Office
Action Participant



Non-compliant



Submission
Discarded



Third Party
Notified if
Email Address
Available

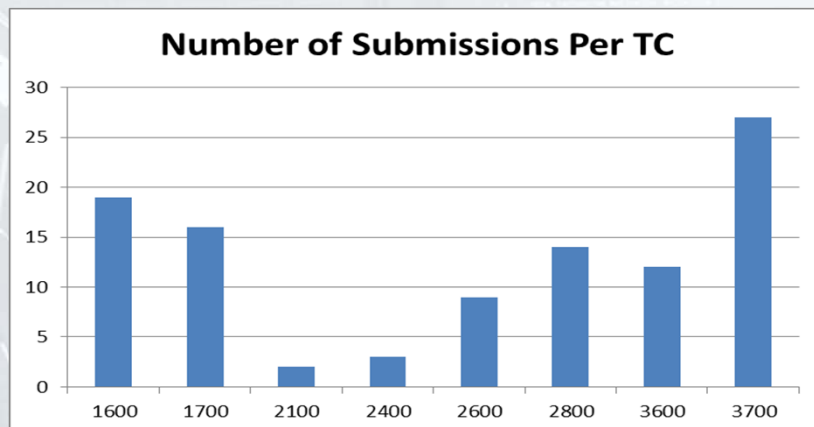


Preissuance Submission: Statistics

(Data as of October 31, 2012)

Status	Number
Proper	73
Improper	39
Not Yet Reviewed	13
TOTAL	125

Printed Publication	Number
Patent	160
Published U.S. Patent Application	52
Foreign Reference	41
Non-patent literature	174
TOTAL	427





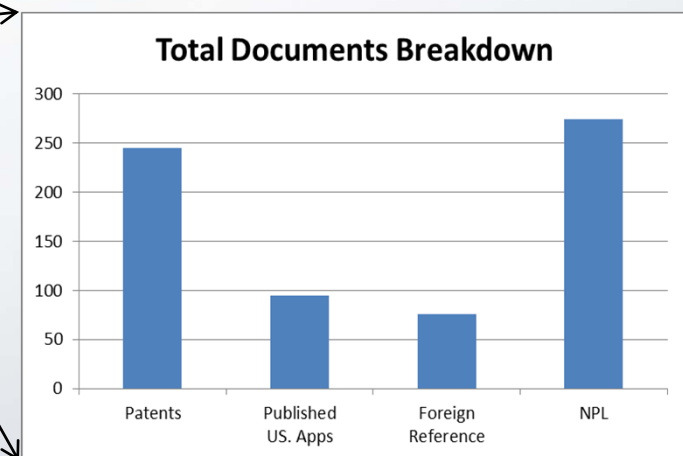
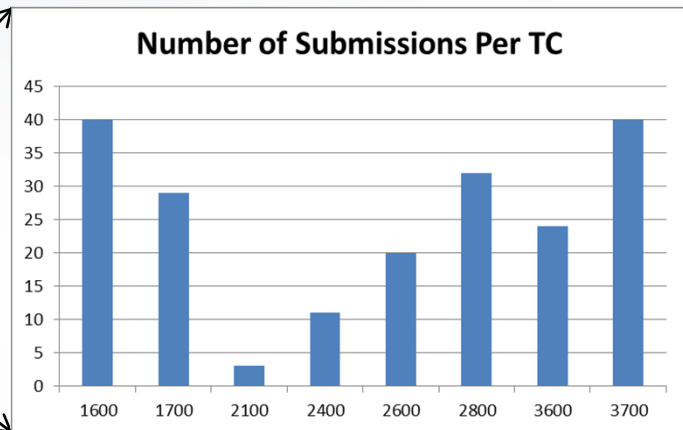
Preissuance Submission: Statistics

(Sept 16th-Nov 30th)

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 Submission: Concise Description of Relevance Example

Compliant

Publication X and Publication Y both disclose machines that perform the same function as the machine recited in claim 1.

In the first embodiment depicted in Figure 2 and discussed on page 5, the machine of publication X expressly includes element A of claim 1. See lines 7-14 on page 5 of publication X.

Publication Y teaches a machine having element B of claim 1. See lines 1-3 on page 6 of publication Y.

Non-compliant

Same with the following concluding sentence:

Accordingly, claim 1 is obvious in view of the combination of Publication X and Publication Y.



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: Fee

Service	Fee
Filing fee (for processing and treating a request for supplemental examination) Plus any applicable document size fees for processing and treating, in a supplemental examination proceeding, a non-patent document over 20 sheets in length	\$ 5140
Reexamination fee (for ex parte reexamination ordered as a result of supplemental examination)	\$16,120
TOTAL	\$21,260



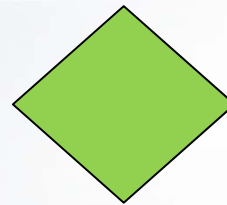
Supplemental Examination: Processing

Patent Owner
Request



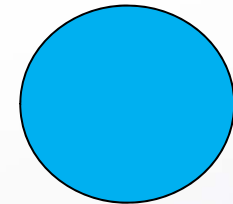
3 months

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 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>

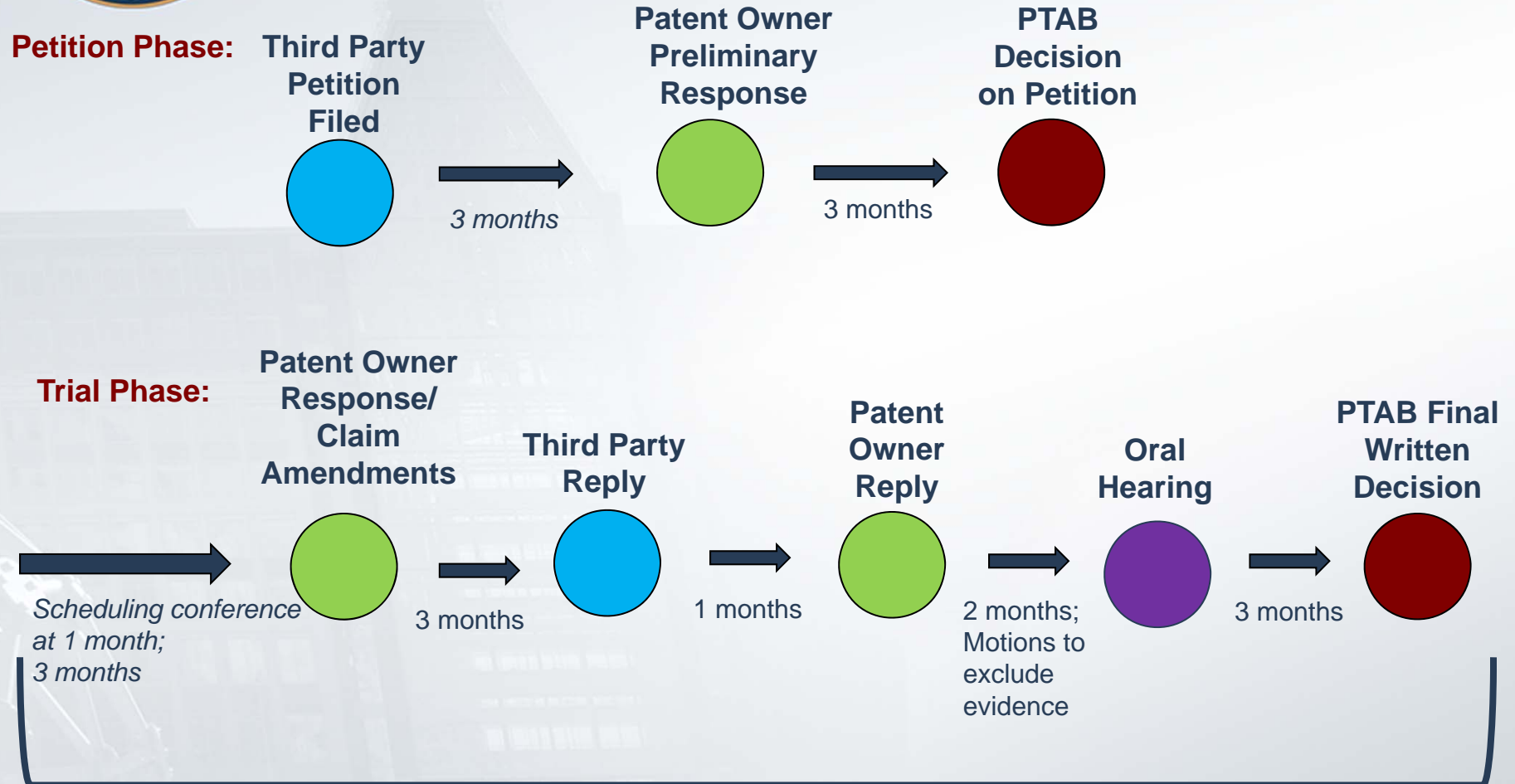


Administrative Trials: Features (cont.)

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/>
- 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



Administrative Trial: Statistics

(Data as of October 31, 2012)

- Administrative trials = 52 petitions
 - 39 inter partes review
 - 13 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



Administrative Trials: Best Practices for Petitions

- Avoid redundancy
- Present complete analysis per claim per ground to show how requisite standard is met



Administrative Trials: Pitfalls to Avoid for Petitions

- Do not mismatch exhibit numbers with exhibit list
- Do not improperly mark exhibits
 - Petitioner: 1000-1999
 - Patent owner: 2000-2999



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



Technology Breakdowns of AIA Petitions

As of December 31, 2012, the Office received a Total of 112 AIA Petitions: 15 CBMs and 97 IPRs

Technology	Number of Petitions	Percentage
Electrical/Computer	83	74.12%
Mechanical	3	2.68%
Chemical	16	14.29%
Bio/Pharma	9	8.04%
Design	1	.89%

Majority of challenged patents are currently or previously subject to district court litigation.



AIA Help

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



Ongoing Rulemakings

- **First-inventor-to-file**
 - Comments due November 5, 2012
 - fitf_rules@uspto.gov
 - fitf_guidance@uspto.gov
- **Patent service fees**
 - Comments due November 5, 2012
 - fee.setting@uspto.gov



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



AIA Help

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



FY 2012 Patents Performance Overview

- **Patent Application Backlog = 608,283**
- **Total UPR Applications Pending = 1,208,983**
- **Total UPR Filings = 533,308**
- **UPR Patents Issued = 247,868**
- **UPR Patent Examiners Onboard = 7,837**

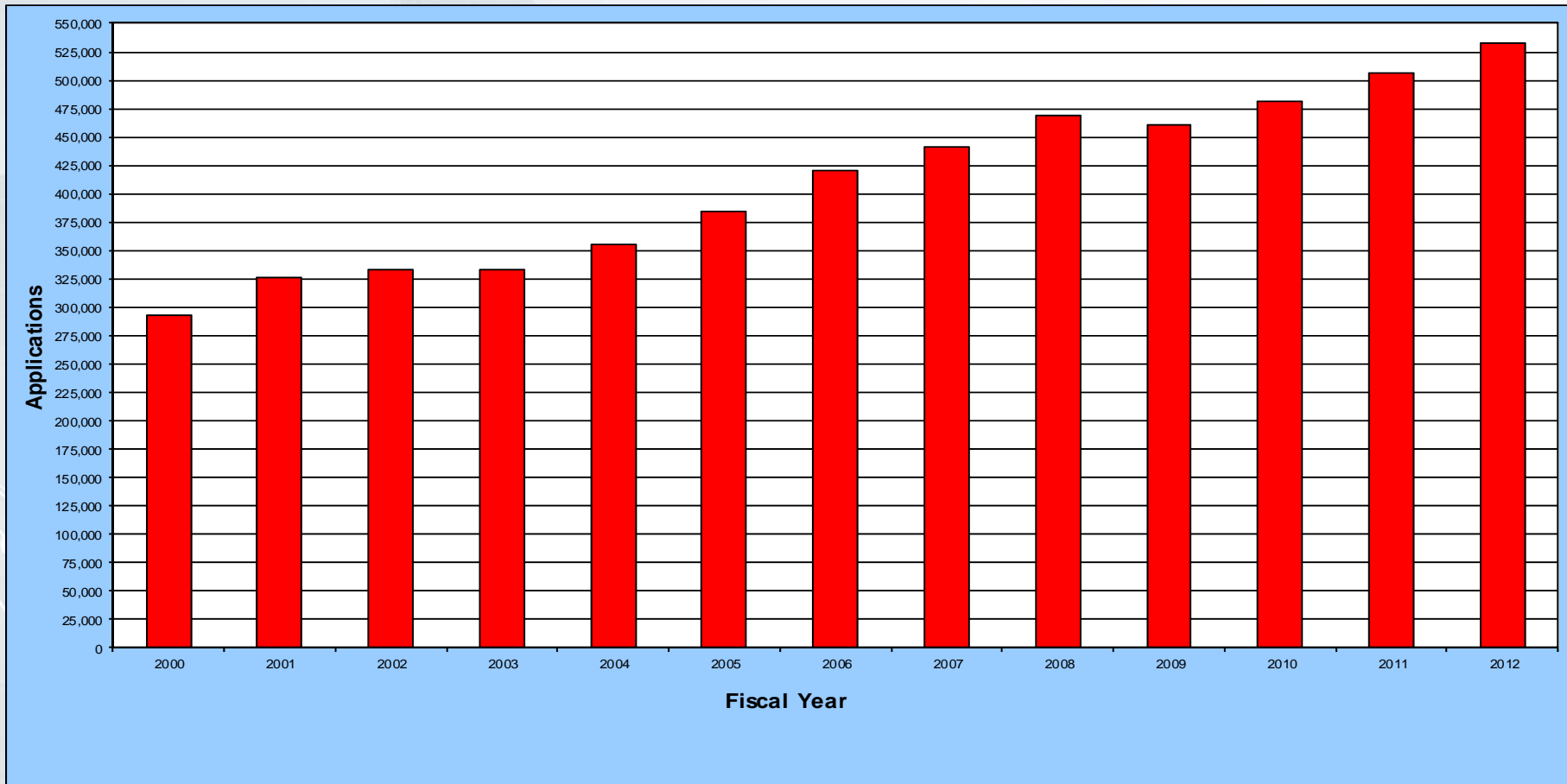


FY 2012 Patents Performance Overview (continued)

- **Pendency**
 - **First Action Pendency = 21.9 months**
 - **Total Pendency = 32.4 months**
 - **Forward Looking First Action Pendency = 16.2 months**
- **Quality:**
 - **Quality Composite Score = 72.4**
 - **External Quality Survey = 9.4 (over 9 positive responses for every 1 negative response)**
 - **Internal Quality Survey = 5.2**



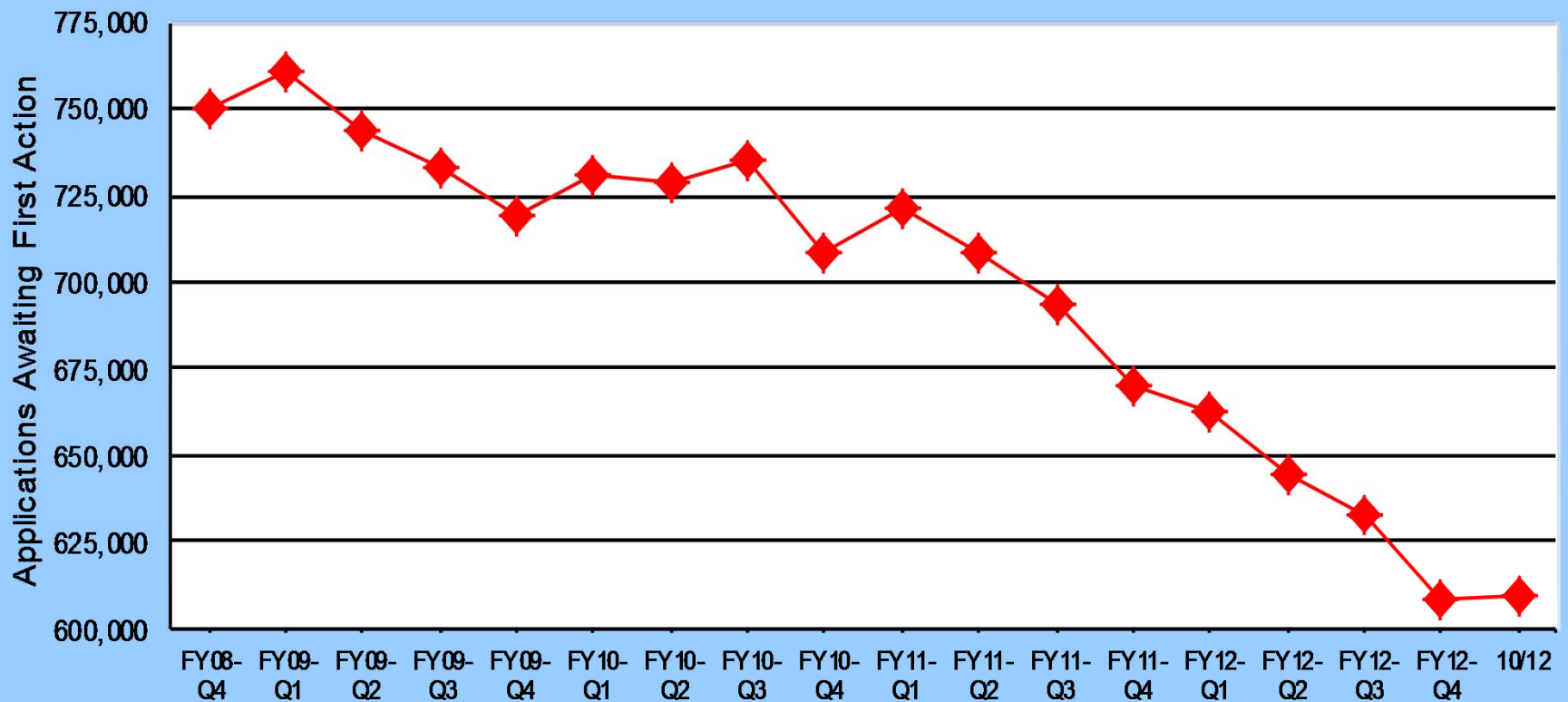
Total UPR Filings (FY 2000 – FY 2012)



Fiscal Year 2012 UPR Filings = 533,308



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

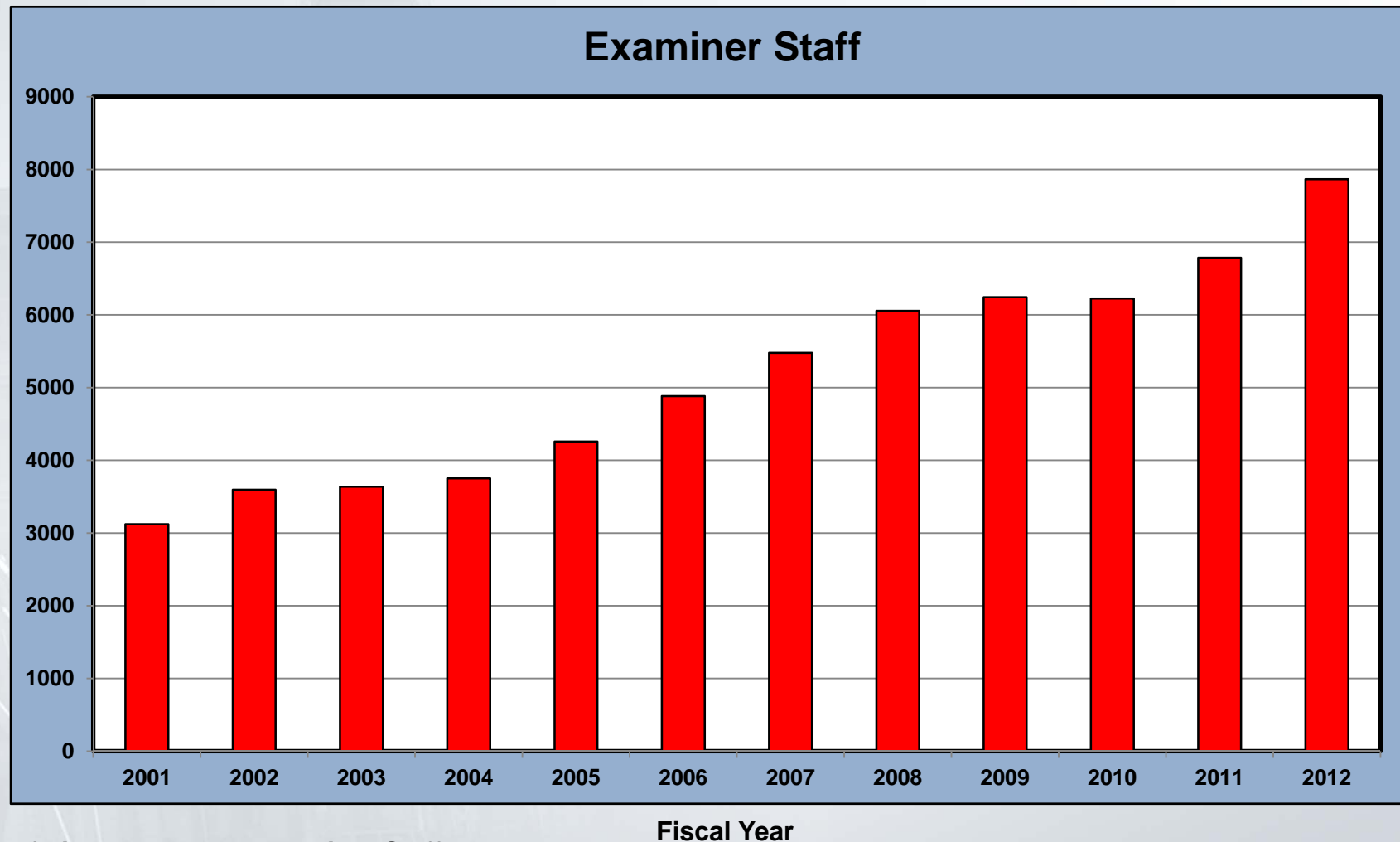


608,651 Excess Unexamined Applications as of October 18, 2012.

End of Fiscal Year 2012 backlog was 608,283.



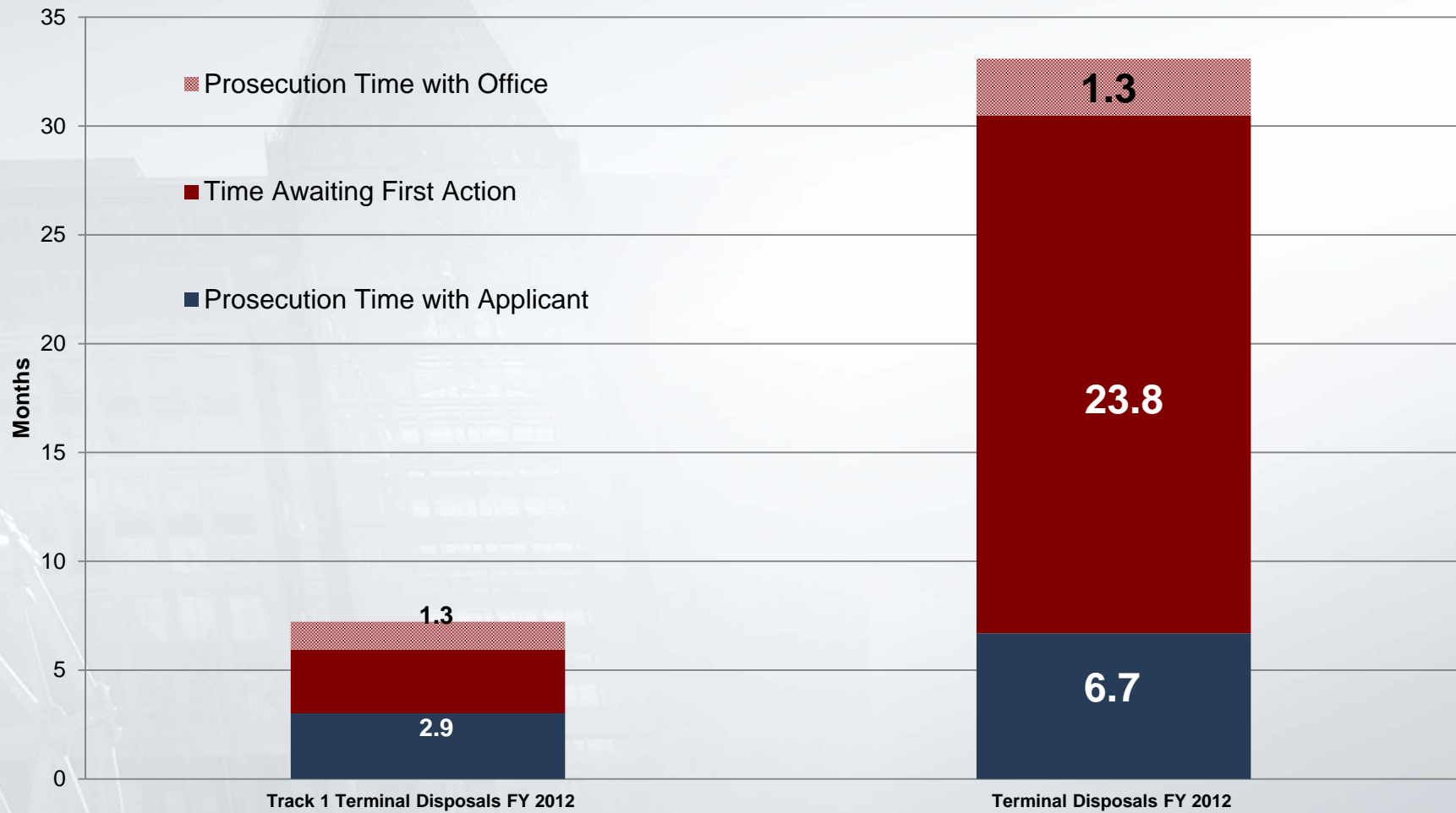
Patent Examiner Staffing FY 2001 – FY 2012



End of Fiscal Year 2012 Examiner Staff = 7,837

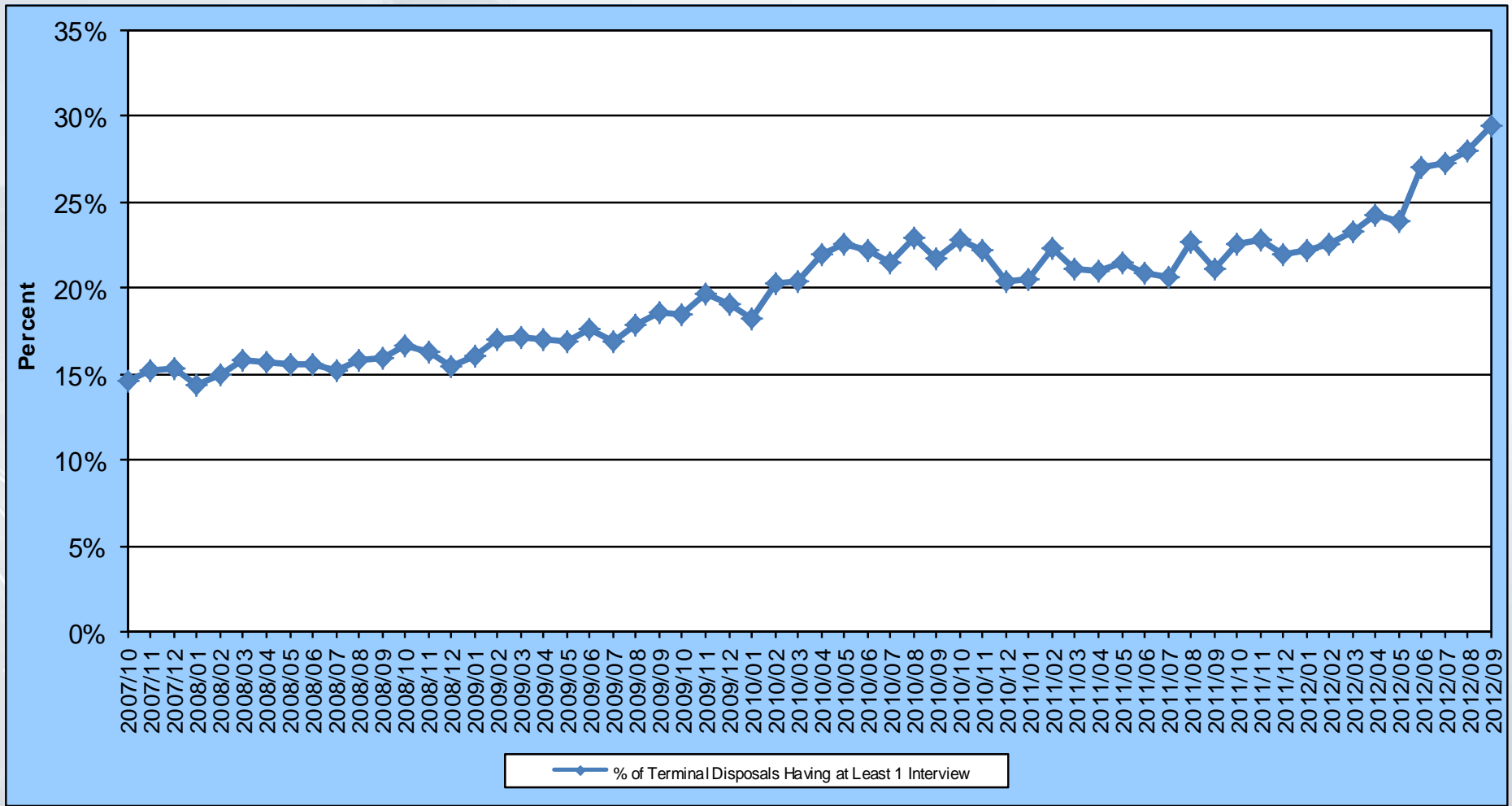


Track 1 Total Pendency vs. Total Pendency





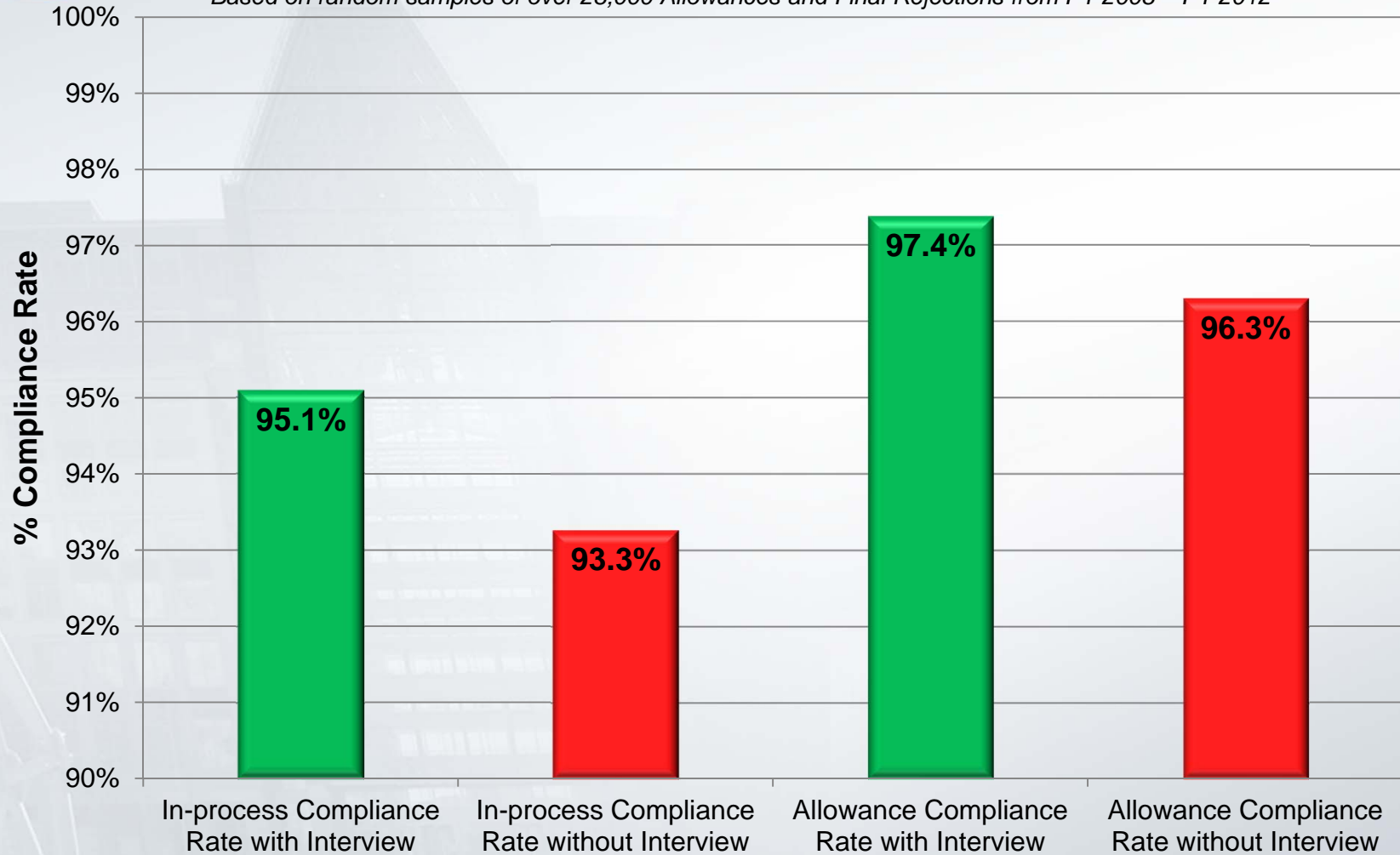
Percent of Serial Disposals Having at Least One Interview FY 2008 – FY 2012





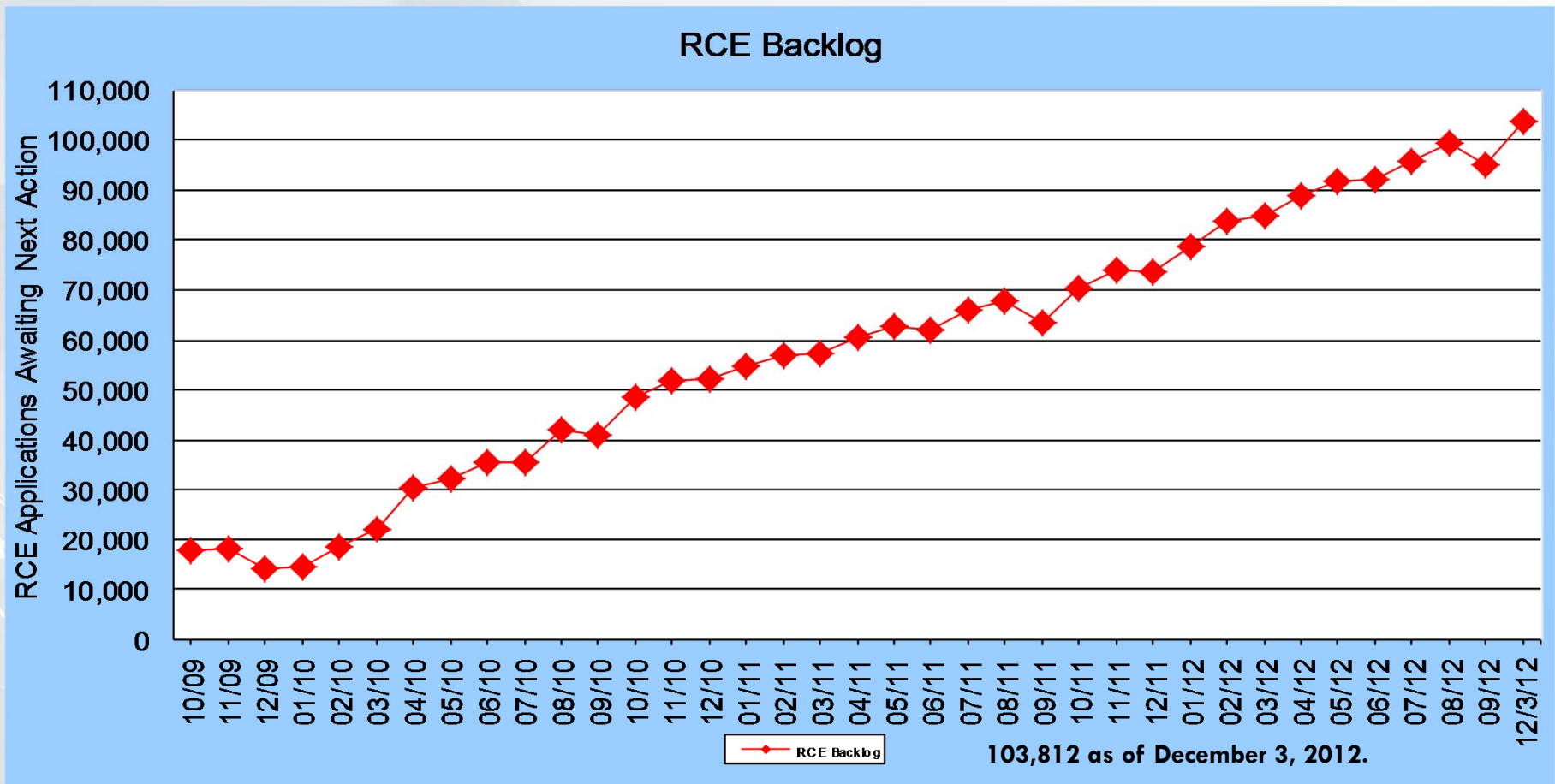
Influence of Interviews on Compliance Rate

Based on random samples of over 28,000 Allowances and Final Rejections from FY 2008 – FY 2012





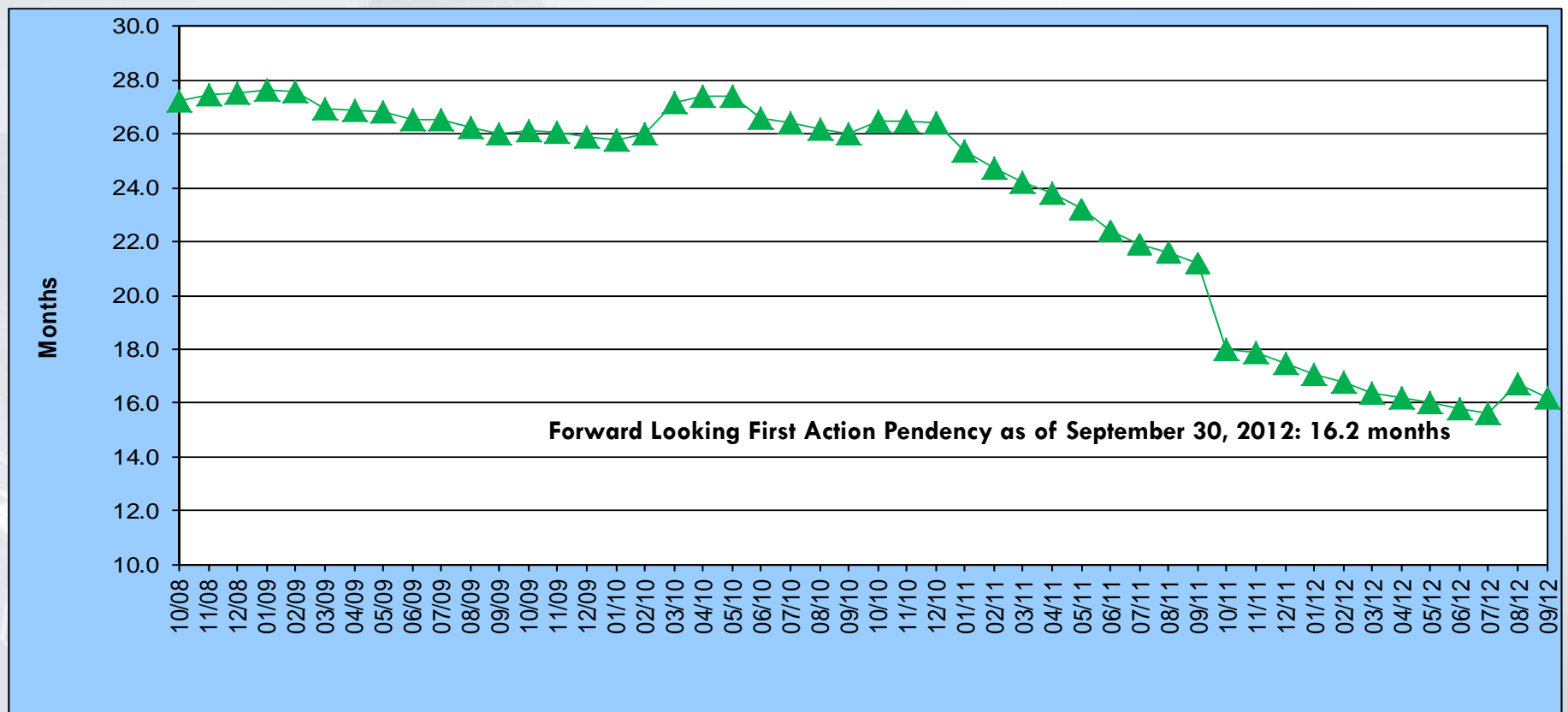
RCE Backlog



End of Fiscal Year 2012 RCE backlog was 95,200.



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.



RCE Outreach Process





Communication Plan

- **Federal Register Notice**
 - **Soliciting feedback to better understand factors that impact the decision to file an RCE**
 - **Call for comments in response to questions**
 - **Comments due February 4, 2013**
- **Feedback**
 - **Submission of written comments**
 - **IdeaScale® web-based collaboration tool**
 - **Roundtables**
- http://www.uspto.gov/patents/init_events/rce_outreach.jsp



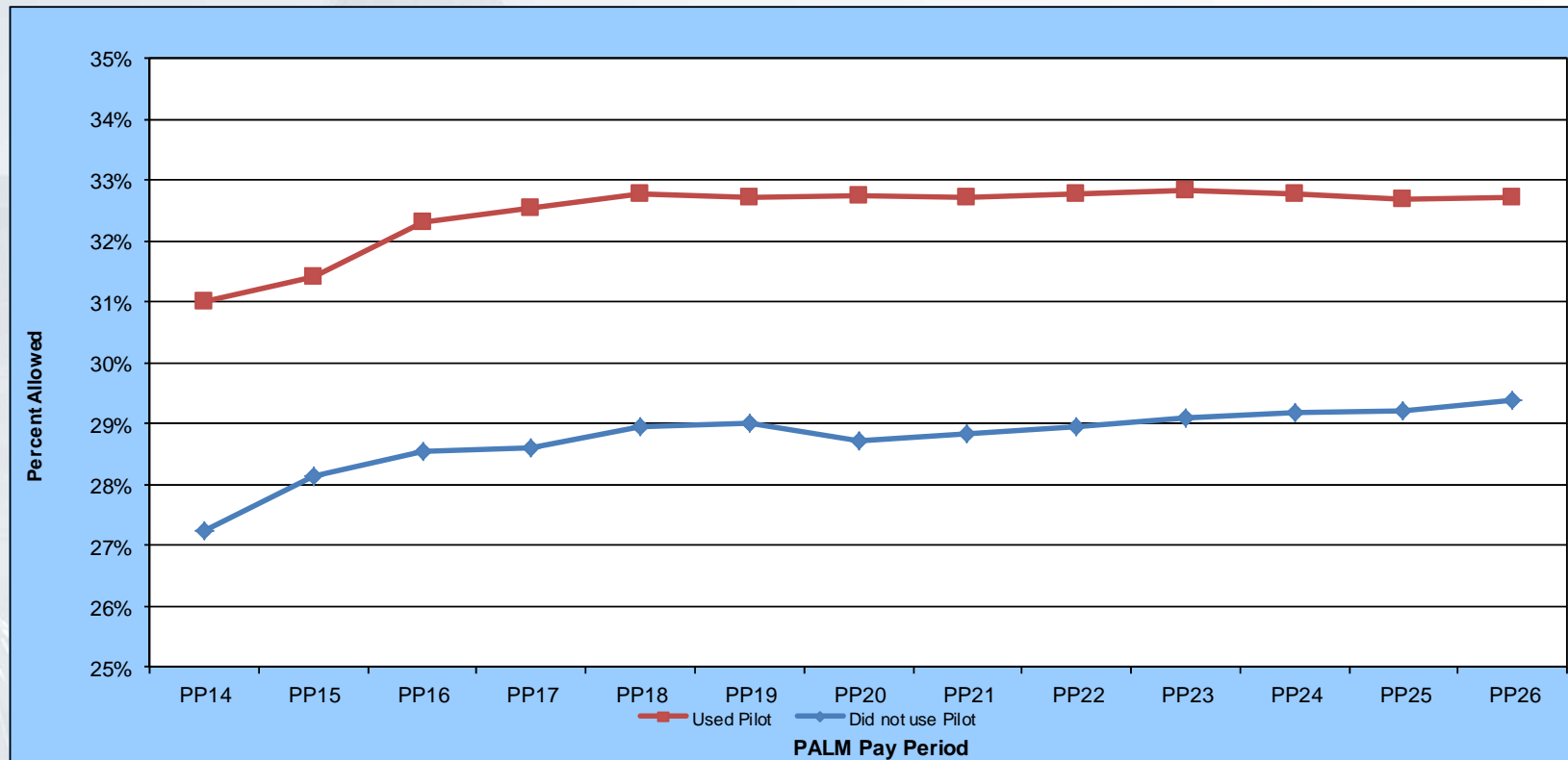
Deliverables

The Office plans to use the information it obtains to design additional programs and initiatives aimed at reducing RCE filings and the RCE Backlog:

- **Internal and external practice**
- **New programs to pilot**
- **Modifications to existing programs, e.g., AFCP and QPIDS.**
- **Modifications to internal examination processes**



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



http://www.uspto.gov/patents/init_events/afcp.jsp



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.

http://www.uspto.gov/patents/init_events/qpids.jsp



Impact of AIA on Harmonization

- **AIA created the best opportunity in decades to further harmonization efforts**
- **AIA adopts international norms related to:**
 - First-to-file
 - Prior user rights
 - Broadening the definition of prior art
 - Eliminating the *Hilmer* doctrine
 - Removes best mode as a basis to challenge patentability
- **Significant remaining issues:**
 - Prior Art Effect of Secret Prior Art
 - Grace Period



Grace Period

- The grace period is an essential part of a 21st century patent system
- AIA provides for a 1 year grace period from the earliest effective filing date for disclosures by inventor or a party who obtained the information from the inventor
- The grace period is user- and business-friendly
 - Matches rate & pace of modern business cycles
 - SMEs can pursue funding without losing access to patent rights
 - Enables protection, commercialization and prompt disclosure of university research



Harmonization Efforts

- Tegernsee Group
- Key areas for potential harmonization
 - Grace Period
 - 18 Month Publication
 - Conflicting Applications
 - Prior User Rights





PPH Today

- Growth continues; PCT-PPH is a huge success which has superseded Paris route programs
 - Europe increasing use
 - US proposal to integrate into PCT system
- Making headway towards a unified PPH scheme based on PPH 2.0 and Mottainai principles
- The USPTO is interested to hear of strategic usage by IP owners



IP5 Today

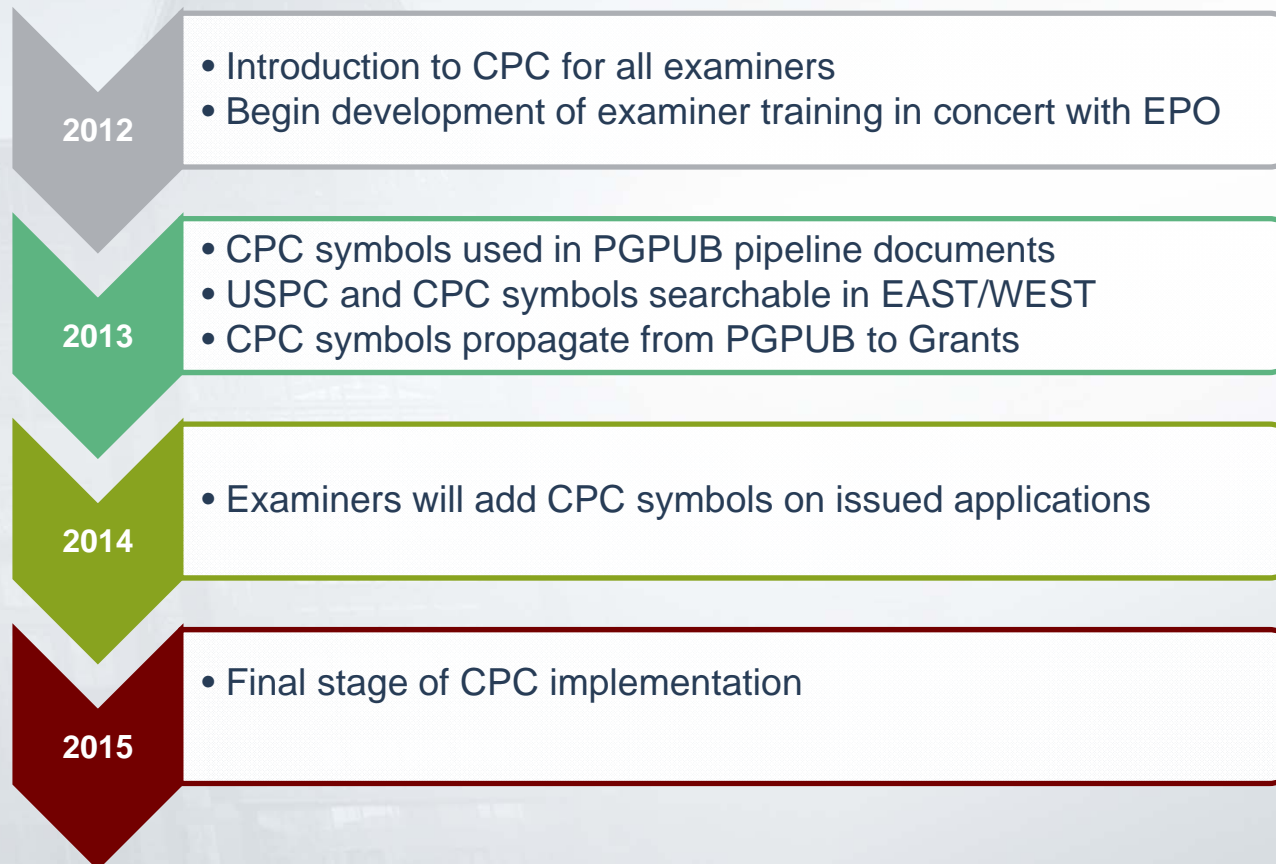
- Global Dossier Initiative
 - Global, one stop shop for global patent filers
 - Open initiative to include any and all interested IPOs and their stakeholders
- IP5 realignment of all projects underway for more efficient and effective operations
 - Focus on delivering products based on stakeholder needs
 - Create a true, global worksharing environment



Cooperative Patent Classification



CPC Implementation Timeline





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 held on **January 10, 2013** at the USPTO in Alexandria.



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.



Additive Manufacturing Partnership Meeting

Additive manufacturing is used in the fields of jewelry, footwear, architecture, engineering and construction, automotive, aerospace, dental and medical industries, education, geographic information systems, civil engineering, and many others. Representatives from 3D Systems, Sratasys and MakerBot will also be on site to provide an overview of the application of additive manufacturing in different technologies and demonstrations of 3D printers.

- The meeting will be held on **Wednesday, January 23, 2013**, beginning at 1 p.m. and ending at 5:00 p.m. EDT.



Software Patent Roundtable

The United States Patent and Trademark Office (USPTO) seeks to form a partnership with the software community to enhance the quality software-related patents (Software Partnership).

- A meeting will be held in New York City on **Wednesday, February 27, 2013**, beginning at 9 a.m. and ending at 12:00 p.m. EDT.
- The New York City event will be held at: New York University, Henry Kaufman Management Center, Faculty Lounge, Room 11-185, 44 West 4th St., New York, NY 10012.

Thank You

