

USPTO Implementation of the America Invents Act



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Major Milestones Thus Far

September 26, 2011:
Prioritized
Examination and
15% Surcharge
Effective

January 13, 2012:
2 Study Reports
Delivered to
Congress
-International Patent
Protection
-Prior User Rights

January 8, 2012:
4 Patent Related
Notices of
Proposed
Rulemaking
(NPRM)
Published

January 26, 2012:
Supplemental
Examination NPRM
Published



Major Milestones Thus Far (cont.)

February 9 and 10, 2012: 7 NPRMs related to New Administrative Trials Published

March 16, 2012: Delivery of Diversity Methodology

March 5 and 6, 2012: Public Comment Period Closed for Patent Related NPRMs

April 9 and 10, 2012: Public Comment Period Closed for New Administrative Trial NPRMs



Implementation in Progress

(Effective September 16, 2012)

- Inventor's oath / declaration
- Preissuance submission of prior art
- Supplemental examination
- Citation of a patent owner statement in a patent file
- Inter partes review
- Post grant review
- Transitional program for covered business methods
- Derivation (effective March 16, 2013)



Rulemaking Process

PATENT RULES

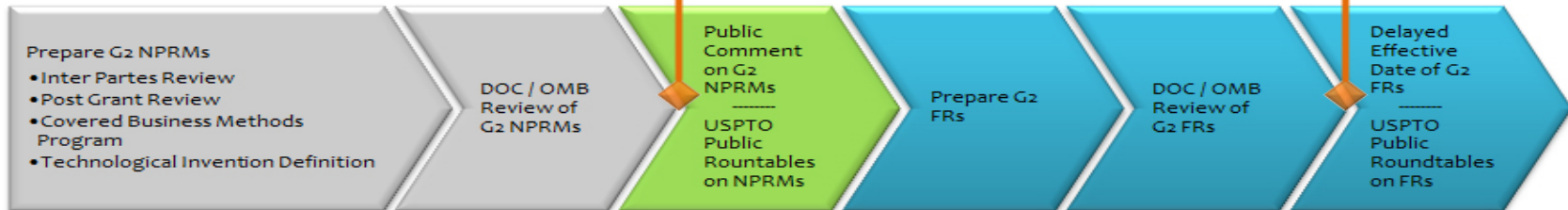
SEP 16, 2011



SEP 16, 2012

BOARD RULES

SEP 16, 2011



SEP 16, 2012

Completed
 In Progress
 Not Started



Inventor's Oath/Declaration

- Inventor's oath/declaration must include statements that:
 - affiant/declarant believes himself to be the **original** inventor
 - application was made or authorized to be made by the affiant/declarant; and
- Inventor's oath/declaration no longer has to include statements that:
 - affiant/declarant believes himself to be the **first** inventor;
 - citizenship of the inventor;
 - statement that the application is made without deceptive intent



Inventor's Oath/Declaration: Use of Assignment and Timing

- Assignment may include the statements required in an oath/declaration
- Notice of Allowance may be issued only if
 - inventor's oath/declaration filed;
 - substitute statement filed; or
 - assignment containing the inventor's oath/declaration recorded



Preissuance Submissions

(Effective September 16, 2012)

- Allows third parties to submit printed publications of potential relevance to examination if certain conditions are met:
 - must provide, in writing, an explanation of the relevance of the submitted documents;
 - must pay the fee set by the Director;
 - must include a statement by the third party making the submission affirming that the submission is compliant with statutory requirements; and
 - must meet timing requirements

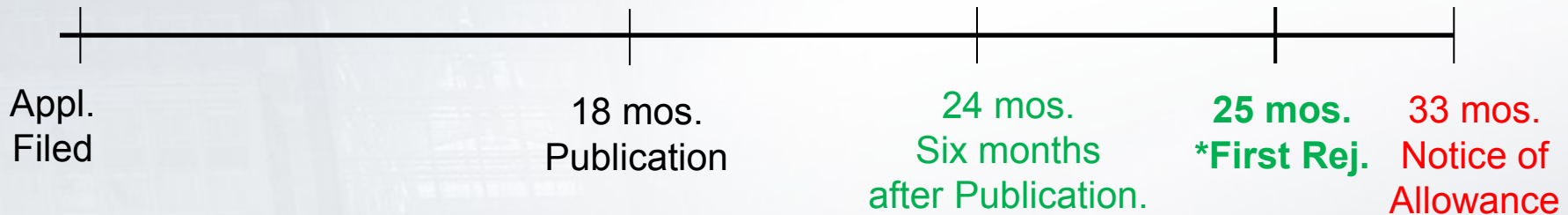


Preissuance Submissions (cont.)

- Submission must be made before the earlier of:
 - (A) date a notice of allowance under 35 U.S.C. § 151 is given or mailed in the application; or
 - (B) the later of
 - 6 months after the date on which the application is first published; or
 - date of the first rejection of any claim in the application



Preissuance Submissions Timing Example #1



* Preissuance submission must be filed before this date



Supplemental Exam

(Effective September 16, 2012)

- Patent owner may request supplemental examination of a patent to “consider, reconsider, or correct information” believed to be relevant to the patent
- “Information” that forms the basis of the request is not limited to patents and printed publications
- Purpose is to immunize the patent against an allegation of inequitable conduct for the information considered, reconsidered, or corrected during supplemental examination



Supplemental Exam (cont.)

- USPTO must decide whether the information in the request raises a “substantial new question of patentability” within 3 months from the request
- Supplemental examination concludes with a supplemental reexamination certificate indicating whether any item of information raised an SNQ
- If a substantial new question of patentability is raised by one or more items of information in the request, then *ex parte* reexamination will be ordered



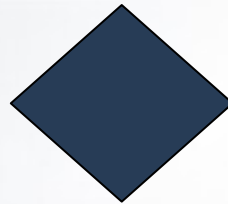
Supplemental Exam (cont.)

Patent Owner
Request



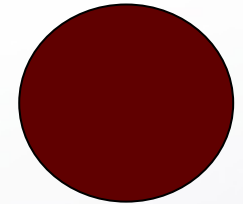
3 months

Decision on Patent
Owner Request:
Standard Triggered?



YES

Ex Parte
Reexamination



NO

Supplemental
Examination
Complete



Administrative Trials

(Effective September 16, 2012)

Proceeding	Petitioner	Available	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 	From patent grant to 9 months from patent grant or reissue	More likely than not OR Novel or unsettled legal question important to other patents/ applications	101, 102, 103, 112, double patenting but not best mode
Inter Partes Review (IPR)	<ul style="list-style-type: none"> Must identify real party in interest 	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	Reasonable likelihood	102 and 103 based on patents and printed publications



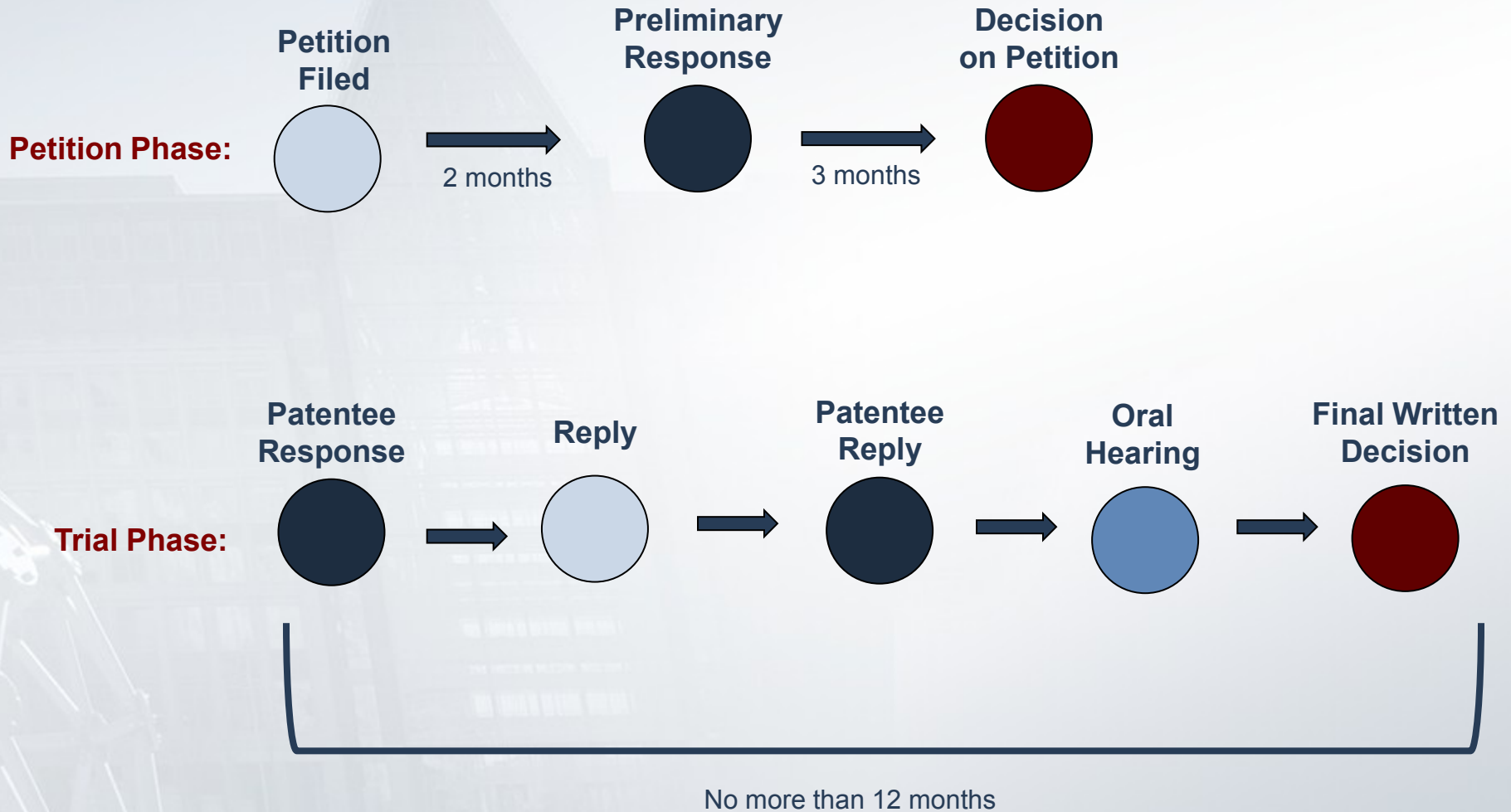
Administrative Trials

(Effective September 16, 2012)

Proceeding	Applicable	Estoppel	Timing
Post Grant Review (PGR)	Patent issued under first-inventor-to-file	<ul style="list-style-type: none">• Raised or reasonably could have raised• Applied to subsequent USPTO/district court/ITC action	Must be completed within 12 months from institution, with 6 months good cause exception possible
Inter Partes Review (IPR)	Patent issued under first-to-invent or first-inventor-to-file		



Administrative Trials





Notices of Proposed Rulemaking

	AIA Provision	Notice	Comments Received
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)	28
2	Preissuance Submissions	Changes to Implement the Preissuance Submissions by Third Parties Provision of the Leahy-Smith America Invents Act, 77 Fed. Reg. 448 (Jan. 5, 2012)	29
3	Citation of Patent Owner Statement 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)	16
4	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)	5



Notices of Proposed Rulemaking

	AIA Provision	Notice	Comments Received
1	Inter partes review	Changes to Implement Inter Partes Review Proceedings, 77 Fed. Reg. 7041 (Feb. 12, 2012)	
2	Post-grant review	Changes to Implement Post Grant Review Proceedings, 77 Fed. Reg. 7060 (Feb. 12, 2012)	
3	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)	
4	Derivation	Changes to Implement Derivation Proceedings, 77 Fed. Reg. 7028 (Feb. 12, 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)	



Implementation Forthcoming

- First-inventor-to-file
- Fee setting
- Micro-entity



First-inventor-to-file

(Effective March 16, 2013)

- Transitions the U.S. to a first-inventor-to-file patent system from first-to-invent system
- Maintains 1-year grace period for inventor disclosures
 - If an inventor makes a disclosure during the 1-year period before its U.S. filing date, then that disclosure is excepted from being patent defeating prior art



First-inventor-to-file (cont.)

- Broadens prior art:
 - Prior public use or prior sale anywhere qualifies as prior art
 - U.S. patents and patent application publications are effective as prior art as of their “effective filing date,” provided that the subject matter relied upon is disclosed in the priority application
 - Effective filing date = (i) actual filing date; or (ii) filing date of the earliest application for which a right of priority is sought



First-inventor-to-file (cont.)

- 18 month timeline
- Few proposed rules; to issue in late June 2012
- Mainly implemented by agency guidance and revisions to the Manual of Patent Examining Procedure, also to issue in late June 2012



Fee Setting Authority

(Effective September 16, 2011)

- Authorizes the USPTO to set or adjust patent and trademark fees by rule for 7 years
- Patent/trademark fees may be set to recover only the aggregate estimated cost of patent/trademark operations, including administrative costs





USPTO Fee Setting Principles

- Accelerate USPTO's progress in reducing the backlog of unexamined patent applications and reducing patent application pendency;
- Realign the fee structure to add processing options during patent application prosecution; and
- Put USPTO on a path to financial sustainability



USPTO Fee Setting Process

- 17 month timeline
- USPTO released preliminary proposed patent fees
- Patent Public Advisory Committee (PPAC) conducted two hearings and collected written comments in February 2012
- PPAC will issue report to USPTO tentatively by early June 2012



Fee Setting Process (cont.)

- USPTO will publish proposed fees in Federal Register in June 2012
 - 60-day public comment period triggered
- USPTO will implement final fees in February 2013



Micro-entity

(Effective September 16, 2011)

- New size-based entity status
- Entitled to a 75% discount on fees for “filing, searching, examining, issuing, appealing, and maintaining” patent applications/patents, once the USPTO exercises its fee setting authority
- Discount not available until USPTO exercises fee setting authority
- 2 alternative definitions



Micro-entity

(Effective September 16, 2011)

- 4 part general definition for “applicant” who certifies that he/she/it:
 1. qualifies as a small entity;
 2. has not been named as an inventor on more than 4 previously filed patent applications;
 3. did not have a gross income exceeding 3 times the median household income in the calendar before the applicable fees is paid; and
 4. has not assigned, granted, conveyed a license or other ownership interest (and is not obligated to do so) in the subject application to an entity that exceeds the gross income limit



Micro-entity (cont.)

- Alternative definition for “applicant” who:
 - certifies that his/her employer is an institution of higher education as defined in section 101(a) of the Higher Education Act of 1965; **or**
 - has assigned, or is obligated to assign, ownership to that institute of higher education

Thank You



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