

USPTO Implementation of the America Invents Act



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America Invents Act

Goals of Patent Reform Legislation

- Encourage innovation and job creation
- Support USPTO's efforts to improve patent quality and reduce backlog
- Establish secure funding mechanism
- Provide greater certainty for patent rights
- Provide less costly, time-limited administrative alternatives to litigation



Progress Report: Rulemakings

- 19 provisions related to USPTO operations to implement
- 7 Group 1 provisions implemented
- 7 Group 2 provisions addressed in Notices of Proposed Rulemaking (NPRMs) to issue in mid- to late January 2012 on 12 Month Timeline
- 2 Group 1 provisions in progress on 17 Month Timeline
- 3 Group 3 provisions to begin work on 18 Month Timeline



Implemented Provisions

(Group 1; Effective on September 16, 2011 or within 60 days)

	AIA Provision	Implementation Documents
1	Change in inter partes reexamination standard	Revision of Standard for Granting an Inter Partes Reexamination Request, 76 Fed. Reg. 59055 (Sept. 23, 2011)
2	Tax strategies are deemed within the prior art	Memo to Examiners, Sept. 20, 2011
3	Best mode	Memo to Examiners, Sept. 20, 2011
4	Human organism prohibition	Memo to Examiners, Sept. 20, 2011
5	Prioritized examination	Changes to Implement Prioritized Examination Track (Track I) of the Enhanced Examination Timing Control Procedures Under the Leahy-Smith America Invents Act, 76 Fed. Reg. 59050 (Sept. 23, 2011)
6	15% transition surcharge	Notice of Availability of Patent Fee Changes Under the Leahy-Smith America Invents Act, 76 Fed. Reg. 59115 (Sept. 23, 2011)
7	Electronic filing incentive	Notice of Availability of Patent Fee Changes Under the Leahy-Smith America Invents Act, 76 Fed. Reg. 59115 (Sept. 23, 2011); and Fee for Filing a Patent Application Other than by the Electronic System, 79 Fed. Reg. 70651 (Nov. 15, 2011)



Prioritized Examination Stats

(as of 12/15/11)

Fiscal Year	Pending	Granted	Dismissed	Total
FY2011	98	748	6	852
FY2012	462	331	6	799

Examination Status	First Action on Merits mailed	Final Dispositions mailed	Number of Allowances of Final Dispositions
Number of Track 1 applications	421	13	9



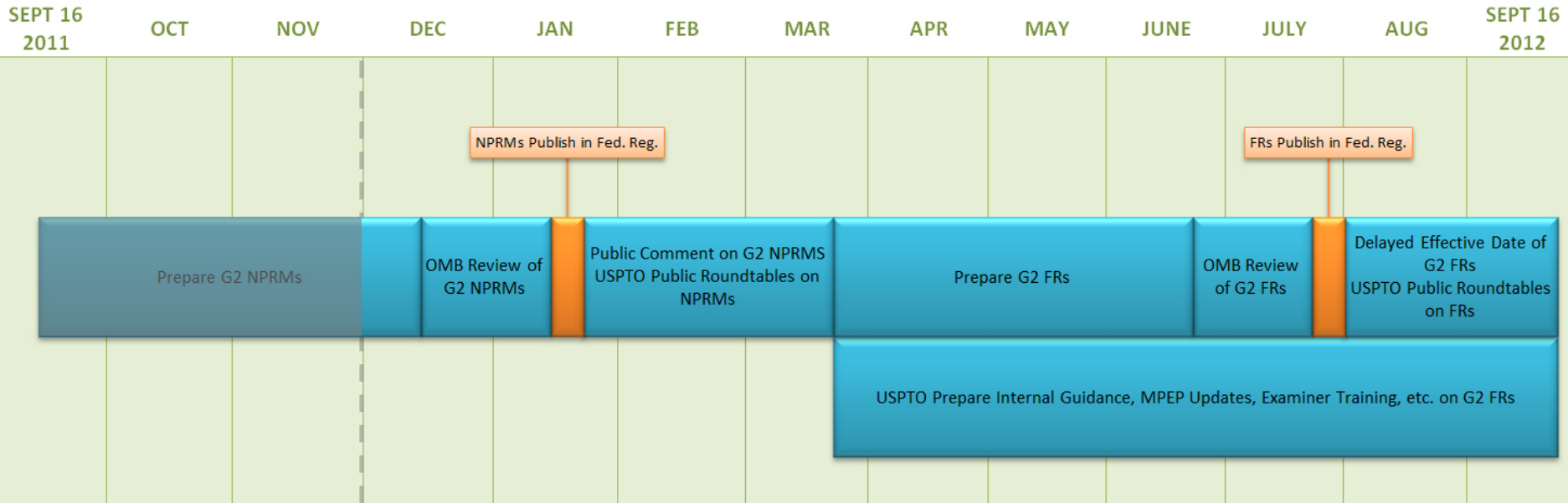
Implementation Ongoing: 12 Month Timeline

(Group 2; Effective on September 16, 2012)

1. Inventor's oath/declaration
2. Third party submission of prior art in a patent application
3. Supplemental examination
4. Citation of prior art in a patent file
5. Inter partes review
6. Post-grant review
7. Transitional program for covered business method patents



12 Month Timeline





Inventor's Oath/ Declaration

(Effective September 16, 2012)

- Patent granted on application filed by assignee must be to the *real party in interest*
- Individual under obligation of assignment may include required statements in executed assignment and need not file separate oath/declaration
- Applicant's citizenship no longer required
- Deceptive intent eliminated from 35 U.S.C. §§ 116, 251, 253, and 256



Citation of Prior Art in a Patent Application

(Effective September 16, 2012)

- Allows third parties to submit printed publications of potential relevance to examination if certain conditions are met:
 - must provide explanation of relevance of submitted documents;
 - must pay associated fees; and
 - must include statement by the third party making the submission affirming that submission is being made in compliance with new 35 U.S.C. 122(e)



Supplemental Examination

(Effective September 16, 2012)

- Patent owner may request **supplemental examination** of patent to “*consider, reconsider, or correct information*” believed to be relevant to the patent; if a validity issue is raised within 3 months from request, USPTO will reexamine the patent.
- Prompt elimination of invalid patent claims.
- **No inequitable conduct allegations** can be based upon information **considered, reconsidered, or corrected** during supplemental examination.
- Provides an alternative to having court consider misconduct and validity issues in later patent infringement litigation.



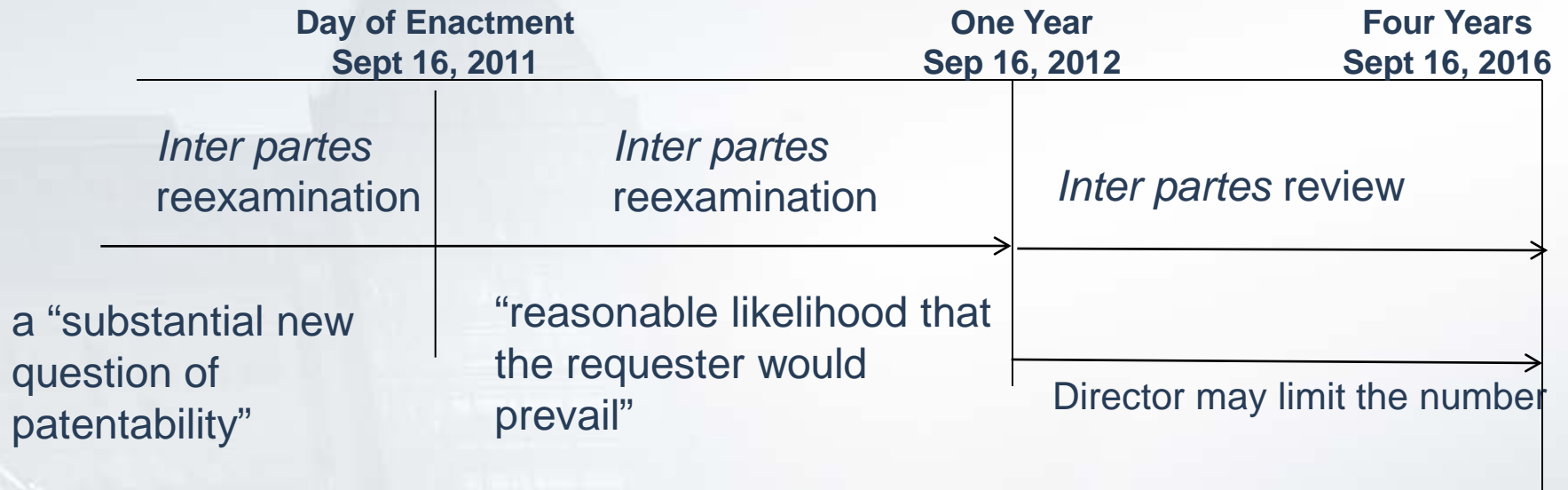
Contested Case Proceedings

(Effective September 16, 2012)

- *Inter partes* reexamination
 - Modified by AIA
 - Phasing out
- *Inter partes* review
 - Will replace *inter partes* reexams, but there will be overlap for years
- Post-grant review (PGR)
- Transitional program for business method patents



Inter Partes Review





Post-Grant Review Proceedings

- Creates nine-month window in which patentability of a patent can be reviewed.
- Requires threshold showing that it is “**more likely than not**” that at least one of the claims challenged is unpatentable.
- Petitioner may raise invalidity of the patent or any claim.
- Generally limited to patents for which first-to-file provisions apply.



Transitional Program for Covered Business Methods (Effective September 16, 2012)

- Sunsets in 8 years
- Follows paradigm for PGR
- Applies to any covered business method patent pending on September 16, 2012:
 - Not drawn to technological invention; and
 - Asserted in pending litigation



Implementation Ongoing: 17 Month Timeline (Group 1)

- Fee Setting Authority
 - Authority to set or adjust fees became effective on September 16, 2011
 - Authority to be exercised by rulemaking
- Micro-entity
 - Micro-entity status became effective on September 16, 2011
 - 75% discount is not available until USPTO exercises fee setting authority

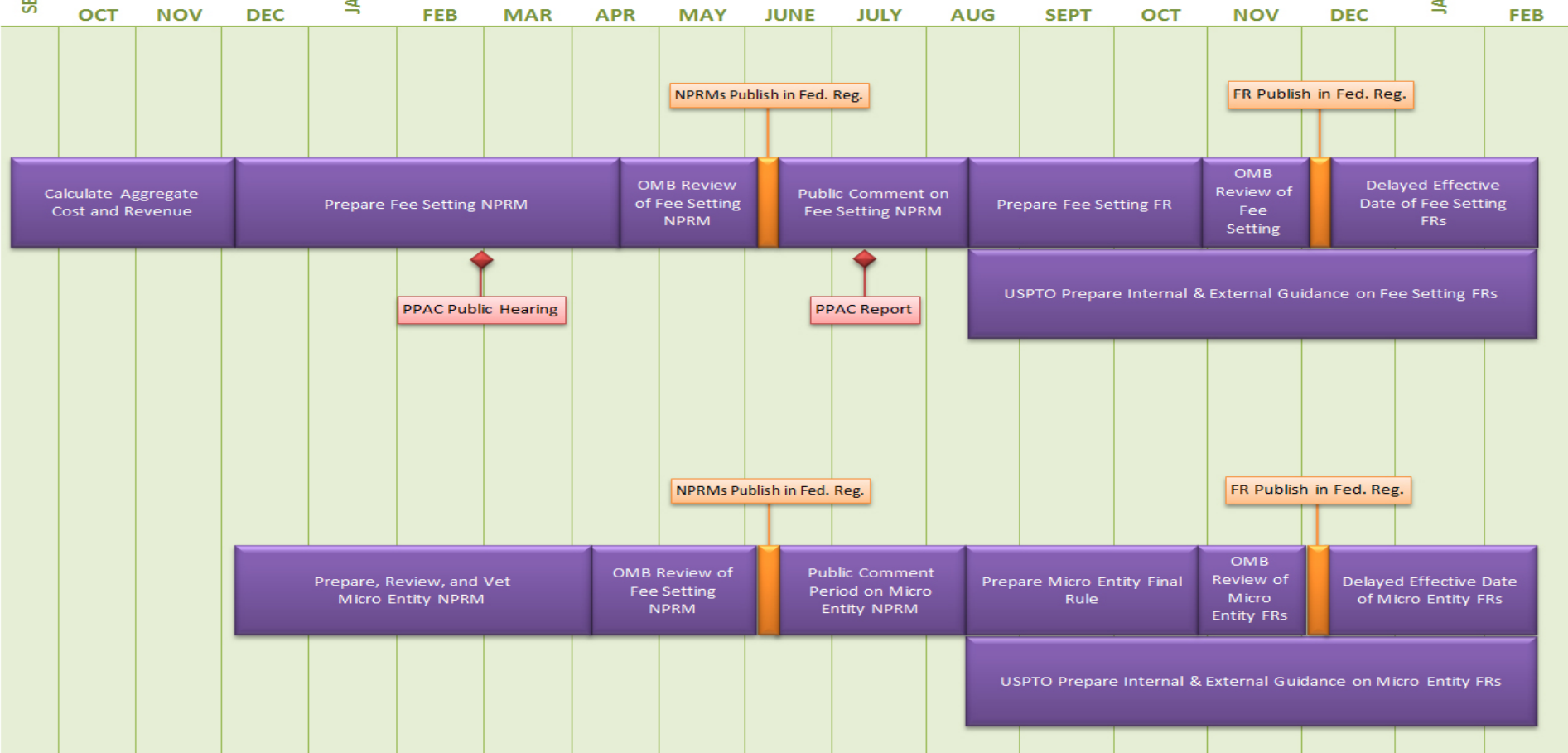


17 Month Timeline

SEPT 16, 2011

JAN 2012

JAN 2013



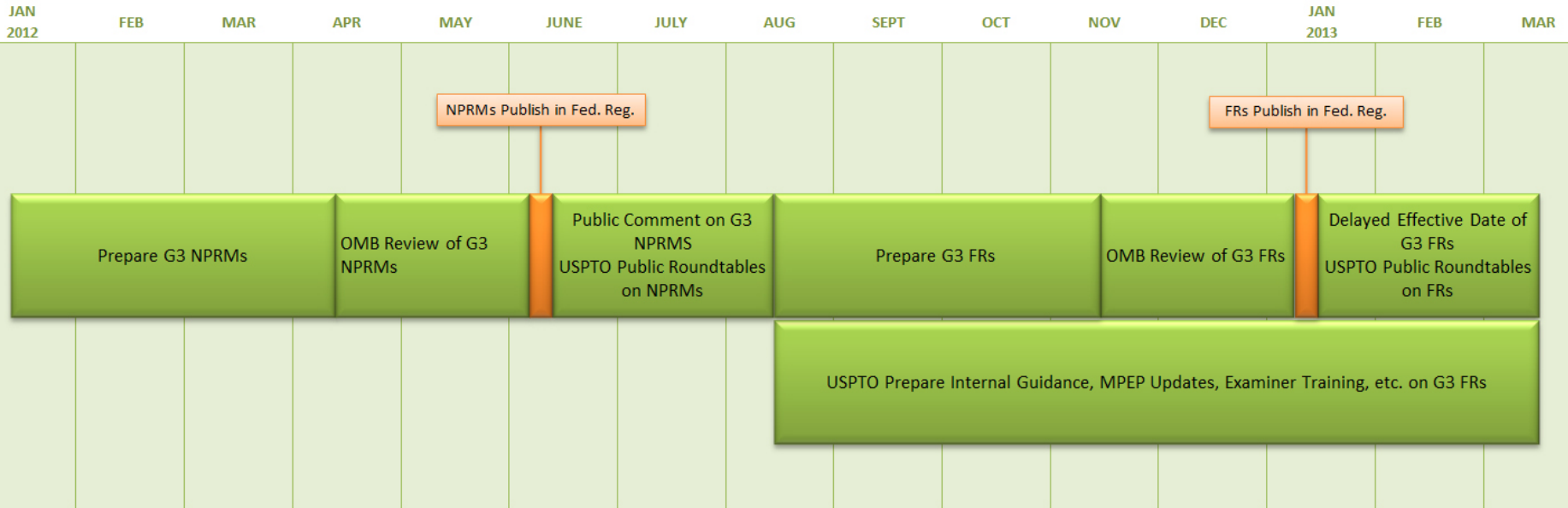


Implementation in Future: 18 Month Timeline* (Group 3; Effective on March 16, 2013)

1. First-to-File
2. Derivation proceedings
3. Repeal of Statutory Invention Registration



18 Month Timeline*





Progress Report: Studies

- 7 studies for USPTO to conduct as lead
- 2 studies in progress

Topic	Due Date
International Patent Protection for Small Businesses	January 16, 2012
Prior User Rights	January 16, 2012
Genetic Testing	June 16, 2012
Misconduct Before the Office	Every 2 years
Satellite Offices	September 16, 2014
Virtual Marking	September 16, 2014
Implementation of AIA	September 16, 2015



Progress Report: Programs

Topic	Due Date from Enactment
Pro Bono	Immediately
Diversity of Applicants	6 months
Patent Ombudsman for Small Businesses	12 months
Satellite Offices	3 years



AIA Micro-Site

The USPTO website devoted to America Invents Act legislation

One-stop shopping for all America Invents Act information.

The full text of the bill and summary documents, including all the legislative history

Implementation plans

Announcements

Contact Information



<http://www.uspto.gov/AmericaInventsAct>

Thank You

