

# USPTO Implementation of the America Invents Act



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# Status of Rulemakings

- 20 provisions related to USPTO operations to implement
- 7 provisions implemented
- 9 provisions addressed in Notices of Proposed Rulemaking (NPRMs) to issue on 12 Month Timeline
- 2 provisions in progress on 17 Month Timeline
- 2 provisions to begin work on 18 Month Timeline
  - First-inventor-to-file
  - Repeal of statutory invention registration



# Implemented Provisions

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

	<b>AIA Provision</b>	<b>Implementation Documents</b>
<b>1</b>	Change in inter partes reexamination standard	Revision of Standard for Granting an Inter Partes Reexamination Request, 76 Fed. Reg. 59055 (Sept. 23, 2011)
<b>2</b>	Tax strategies are deemed within the prior art	Memo to Examiners, Sept. 20, 2011
<b>3</b>	Best mode	Memo to Examiners, Sept. 20, 2011
<b>4</b>	Human organism prohibition	Memo to Examiners, Sept. 20, 2011
<b>5</b>	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)
<b>6</b>	15% transition surcharge	Notice of Availability of Patent Fee Changes Under the Leahy-Smith America Invents Act, 76 Fed. Reg. 59115 (Sept. 23, 2011)
<b>7</b>	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: Implemented (Effective September 26, 2011)

- Original utility or plant patent application for expedited examination if:
  - \$4,800 fee, reduced by 50% for small entity;
  - no more than 4 independent claims, 30 total claims, and no multiple dependent claims; and
  - must file application electronically (utility application)
- Does not apply to international, design, reissue, or provisional applications or in reexamination proceedings; may be requested for a continuing application
- USPTO goal for final disposition (e.g., mailing notice of allowance, mailing final office action) is on average 12 months from date of prioritized status



# Prioritized Examination: Implemented (Data as of 1/3/12)

- 1,694 petitions filed
  - 40.8 days on average from filing to petition decision
  - 98.9% grant rate
- 648 prioritized applications received a first Office action
  - 30.7 days on average from grant of petition to first Office action
- 23 Notices of Allowance and 3 Final Rejections issued
  - 39.2 days on average from grant of petition to Notice of Allowance
  - 34.3 days to final rejection
- 1<sup>st</sup> patent issued in 101 days
  - Filed September 30, 2011
  - Issued January 10, 2012



# Implementation Ongoing: 12 Month Timeline

(Effective on September 16, 2012)

	<b>AIA Provision</b>	<b>Notice of Proposed Rulemaking</b>
<b>1</b>	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
<b>2</b>	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
<b>3</b>	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
<b>4</b>	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
<b>5</b>	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

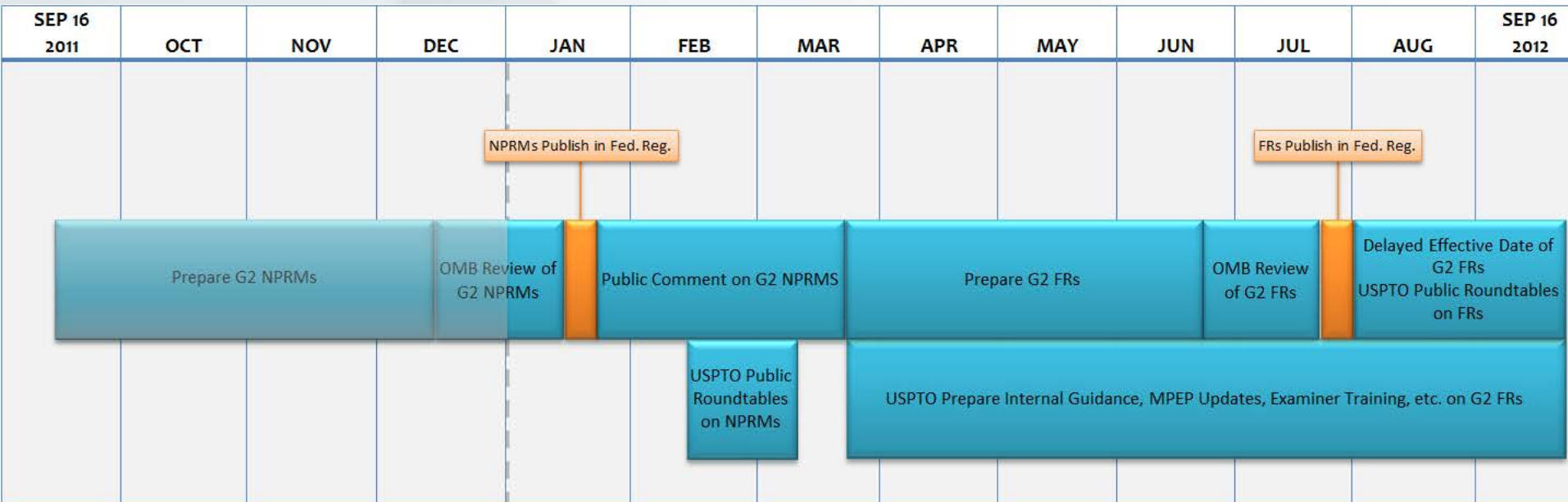


# Implementation Ongoing: 12 Month Timeline (cont.) (Effective on September 16, 2012)

	<b>AIA Provision</b>	<b>Notice of Proposed Rulemaking</b>
<b>6</b>	Inter partes review	In progress
<b>7</b>	Post-grant review	In progress
<b>8</b>	Transitional program for covered business method patents	In progress
<b>9</b>	Derivation (effective on March 16, 2013)	In progress



# 12 Month Timeline







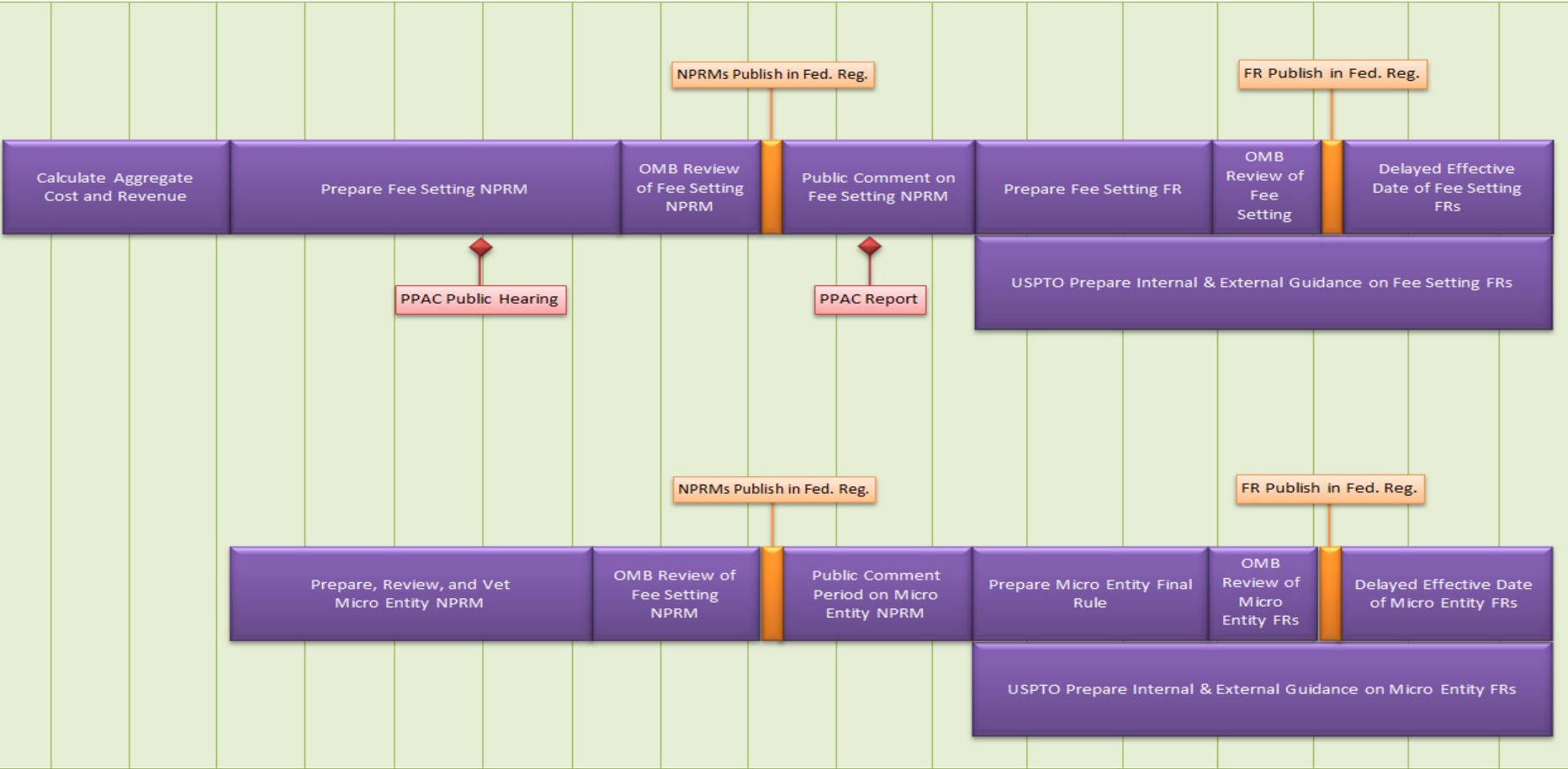
# 17 Month Timeline

SEPT 16, 2011

JAN 2012

JAN 2013

OCT NOV DEC FEB MAR APR MAY JUNE JULY AUG SEPT OCT NOV DEC FEB

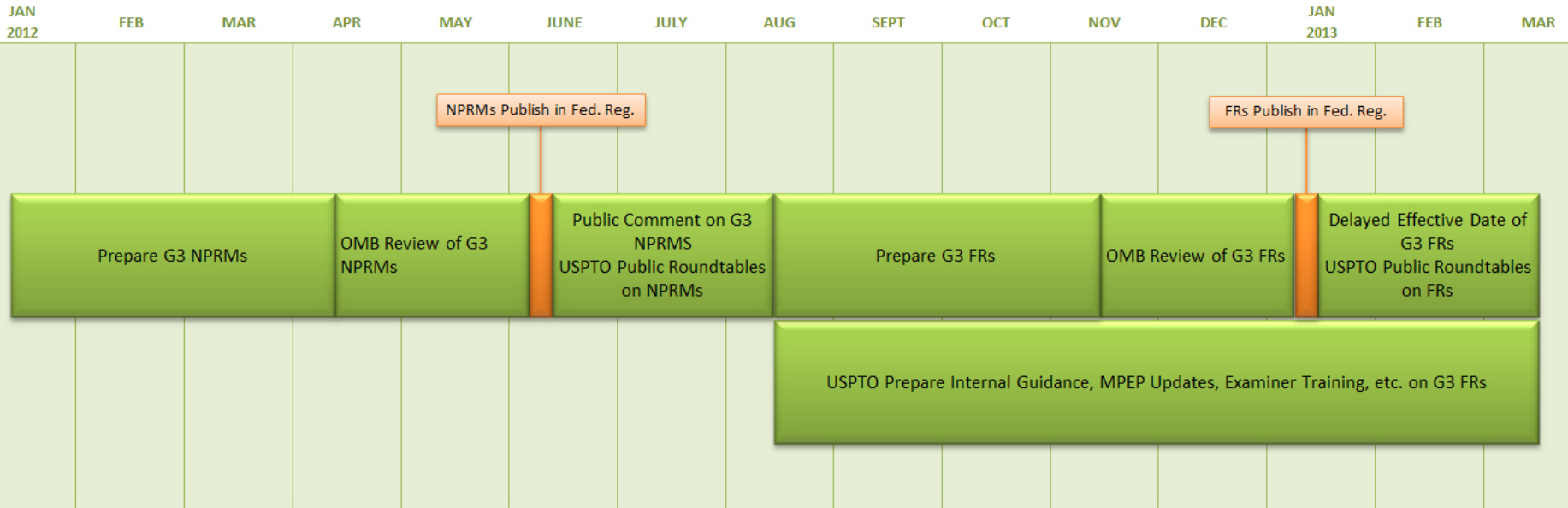


USPTO Prepare Internal & External Guidance on Fee Setting FRs

USPTO Prepare Internal & External Guidance on Micro Entity FRs



# 18 Month Timeline





# Progress Report: Studies

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



# Progress Report: Programs

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



# AIA Micro-Site

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

## Implementation Information

- Patent Examination
- Inter Partes Disputes
- Fees and Budgetary Issues
- AIA Studies and Reports
- Programs
- Miscellaneous

AIA Resources

AIA Informational Videos

AIA Press Releases and Speeches

AIA Frequently Asked Questions

AIA Comments

AIA Blog

## Announcements and Upcoming AIA Events

Tuesday, September 20, 2011 @ 2:10pm:  
Commissioner Robert L. Stoll  
The 21st AI Ohio Annual Institute on  
Intellectual Property  
Cleveland, OH

Wednesday, September 21, 2011 @ 2:10pm:  
Commissioner Robert L. Stoll  
The 21st AI Ohio Annual Institute on  
Intellectual Property  
Cincinnati, OH

Friday, September 23, 2011 @ 1:00pm:  
Commissioner Robert L. Stoll  
Virginia State Bar IP Law Section  
Arlington, VA

Tuesday, September 27, 2011 @ 1:00pm:  
Commissioner Robert L. Stoll  
American Conference Institute  
America Invents Act Webinar  
<https://www2.gotomeeting.com/register/127501938>  
Registration is complimentary

## Leahy-Smith America Invents Act Implementation



President Barack Obama signs the America Invents Act September 16, 2011, at Thomas Jefferson High School for Science and Technology in Alexandria, Va.

### Message from Director David Kappos

On September 16, 2011, President Barack Obama signed into law the Leahy-Smith America Invents Act, which will foster innovation and spur job creation in the United States. This Act sets into motion the most comprehensive overhaul to our nation's patent system since 1836.

The new law will afford more certainty for patent applicants and owners, and provide the USPTO the resources needed to operate efficiently and issue high-quality patents. Implementation of the new law will occur over a period of months, and our USPTO team will seek input and provide updates all along the way. I strongly encourage you to use this site to regularly track progress pertaining to the agency's implementation efforts.

All of us at USPTO look forward to working together with the innovation community to tackle the exciting challenges of rolling-out this historic law. Here are a few documents to get started:

- [America Invents Act Signing Ceremony](#)
- [White House chat on the America Invents Act](#)
- [Press Release: President Obama signs America Invents Act](#)
- [Leahy-Smith America Invents Act](#)
- [America Invents Act Effective Dates](#)
- [USPTO Fee Schedule](#)

### Timeline: Major Milestones



# AIA Roadshows



Date	Venue	Location
Friday, February 17	<a href="#">USPTO Campus</a>	Alexandria, VA
Friday, February 24	<a href="#">Sunnyvale Public Library</a>	Sunnyvale, CA
Monday, February 27	<a href="#">Marriott Library, University of Utah</a>	Salt Lake City, UT
Wednesday, February 29	<a href="#">Dallas Public Library</a>	Dallas, TX
Friday, March 2	<a href="#">Broward County Main Library</a>	Ft. Lauderdale, FL
Monday, March 5	<a href="#">Boston Public Library</a>	Boston, MA
Wednesday, March 7	<a href="#">Chicago Public Library</a>	Chicago, IL



# America Invents Act

## USPTO Patent Reform Coordinator

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