

IMPLEMENTING THE AMERICA INVENTS ACT

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Leahy-Smith America Invents Act

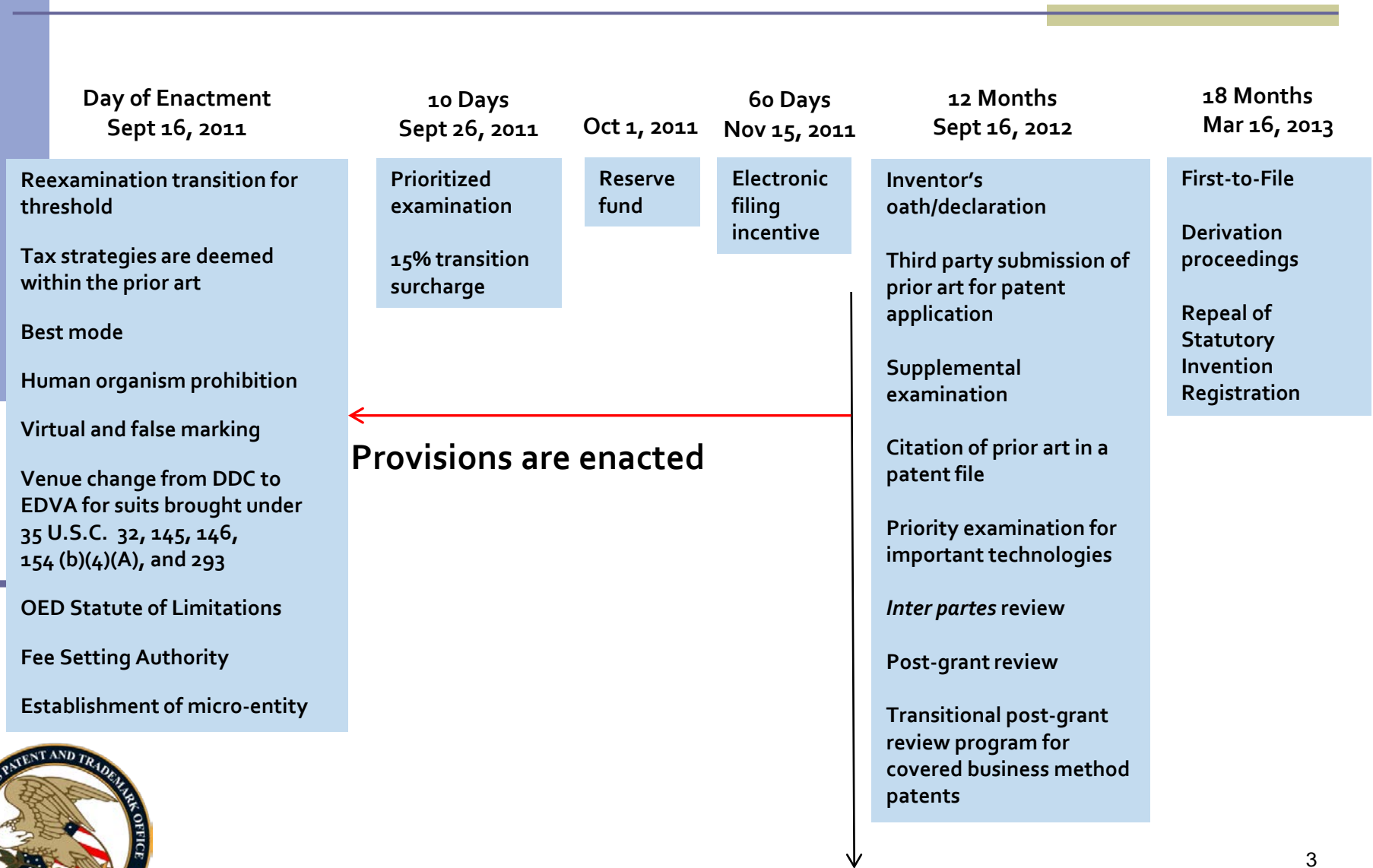
On September 16, 2011, President Barack Obama signed into law the Leahy-Smith America Invents Act.

Important Provisions

- First to file provision
- Fee setting authority
- 15% Surcharge
- Prioritized Examination (Track I)
- Changes to *Inter Partes* Reexamination
- Supplemental Examination
- Post-Grant Review
- *Inter Partes* Review
- Best Mode Requirement
- Preissuance Submission by 3rd Parties



Enactment Timeline



Day of Enactment Provisions

- Fee setting authority
- Best mode
- Virtual and false marking



12 Months from Enactment

- 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

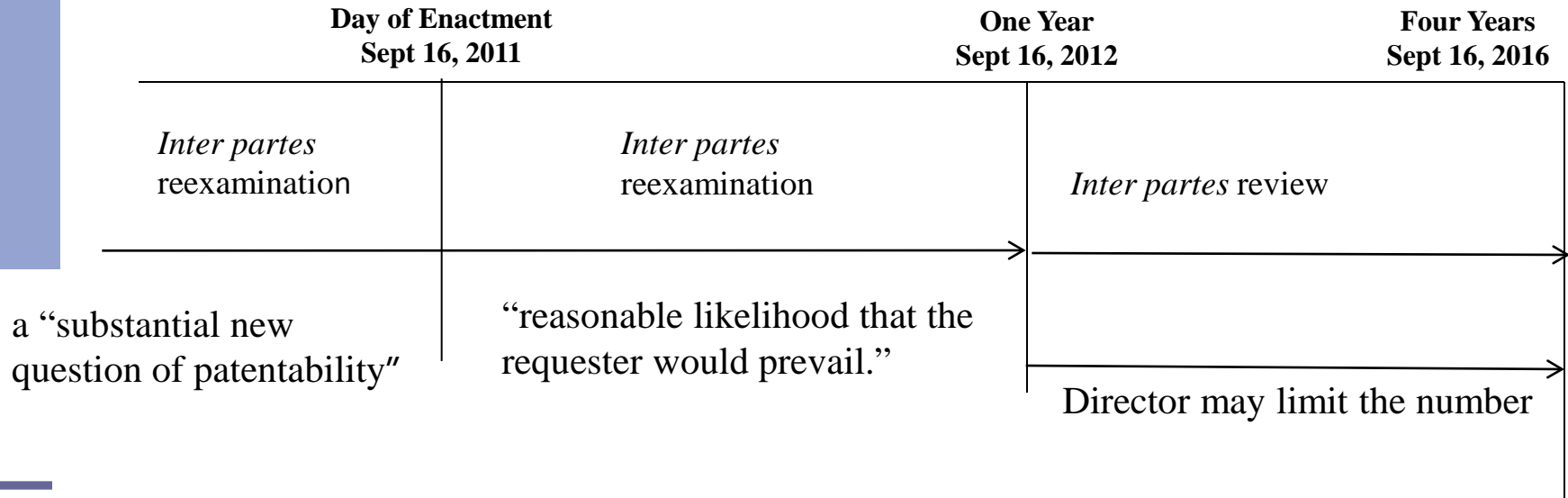


Supplemental Examination

- The patent owner may request supplemental examination of a patent to “*consider, reconsider, or correct*” information believed to be relevant to the patent.
- Two-Step Process
- Deviations from *ex parte* procedure
- Inoculation from IC charge
- Fraud on the PTO
- 10 items of information each
- \$5,180 plus \$16,116 (refund)
- Must be filed by all owners
- Supplemental Examination v. *Ex Parte* Reexamination



Inter Partes Review



Inter Partes Review

- 9/16/12--*inter partes* reexamination will be replaced by “*inter partes* review” and adjudicated by the Patent Trial and Appeal Board
- Applies to any petition filed on or after 9/16/12 – both first-to-invent and first-to-file patents
- Petitioner may only raise grounds under 35 U.S.C. 102 and 103 and only on the basis of prior art consisting of patents and printed publications.
- Any third party may petition—if they have not previously filed a civil action challenging the validity of a claim of the patent
- Timing after the later of: 9 months from issuance of the patent or termination of a post-grant review of the patent
- Standard for Institution – reasonable likelihood of prevailing
- One motion to amend after institution
- Completed within 1 year from institution
- The Director may limit the number of petitions to institute IP review during the first 4 years



Inter Partes Review

- Petition must:
 - Be accompanied by a fee.
 - Identify all real parties in interest.
 - Identify all claims challenged and grounds on which the challenge to each claim is based.
 - Provide a claim construction and show how the construed claim is unpatentable based on the grounds alleged
 - Identify the exhibit number of the supporting evidence relied upon to support the challenge and state the relevance of the evidence.
 - Provide copies of evidence relied upon.



Inter Partes Review

- Preliminary response is due 2 months from petition docketing date.
- General rule is that preliminary response may present evidence except for testimonial evidence.
- Where IPR standards are met, the Board will institute the trial on: 1) claim-by-claim basis; and 2) ground-by-ground basis.
- Fee for up to 20 claims - \$27,200.



Similarities of PGR and IPR

- Most aspects of PGR and IPR are effectively the same.
 - Petition – the requirements for a petition are essentially the same.
 - Preliminary Patent Owner Response – requirements are essentially the same. Due 2 months from petition docketing date.
 - Institution – within 3 months of Preliminary Patent Owner Response.
 - Patent Owner Response (after institution) - requirements are essentially the same.
 - Amendments – requirements are essentially the same.
 - Estoppel—claim by claim basis.



Post-Grant Review

- Applies to first-inventor-to-file patents (filed on or after 3/16/2013).
- PGR allows challenges based on §§ 101, 102, 103 and 112, except best mode.
- Must be filed within 9 months of grant or issuance of a reissue patent.
- More likely than not (*i.e.*, a higher threshold than IPR) that at least one of the claims challenged in the petition is unpatentable.
- Fee up to 20 claims - \$35,800



Covered Business Methods

- Differences between a covered business method review and a post grant review include:
 - Cannot file CBM review during time a PGR could be filed, *i.e.*, 9 months after issuance of a patent.
 - Petitioner must be sued or charged with infringement.
 - Available 9/16/12
 - Must be a business method patent and not a technological invention for performing data processing or other operations for financial product or service.



Fee Setting

- Section 41
- Section 10 of the AIA
- PPAC Hearings and Report
- NPRM
- Final Rule

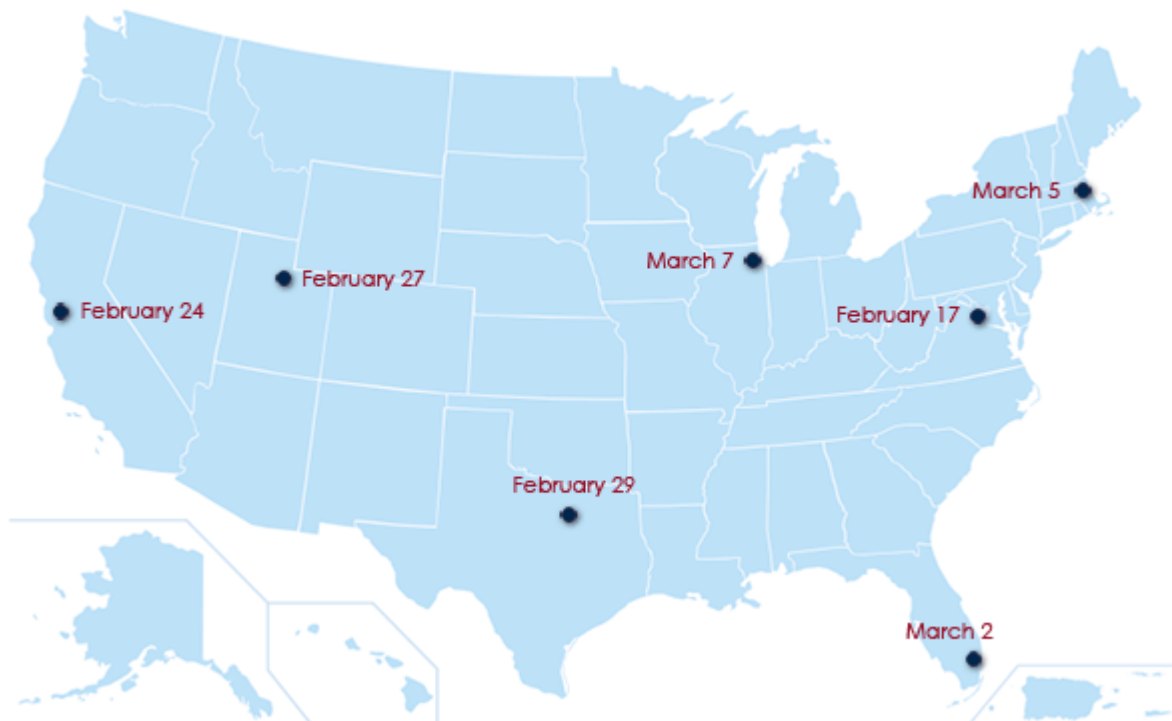


18 Months from Enactment

- First-to-File
- Derivation proceedings



AIA Roadshow



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
- Implementation plans
- Announcements
- Contact information



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

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



Thank You

