

# USPTO Implementation of the America Invents Act

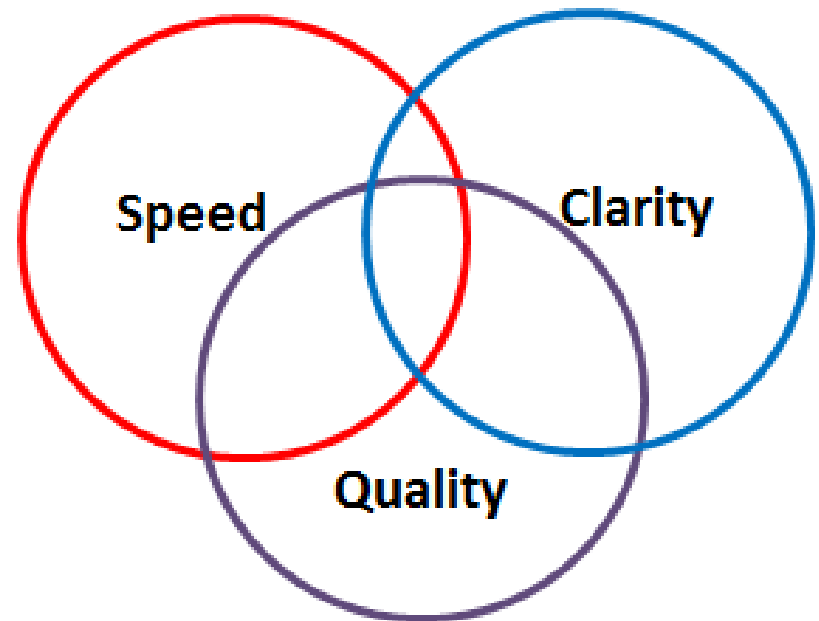


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# Three Pillars of the AIA

- 20 provisions related to USPTO operations to implement over next 12 to 18 months
  - 7 provisions implemented to date
  - 9 provisions under implementation now
  - 4 provisions for future implementation





# Speed

- Prioritized examination
  - Implemented
- Fee setting authority / micro-entity
  - Under development now



# Prioritized Exam

(Effective September 26, 2011)

- Utility, plant, and continuing patent applications and requests for continued examination may qualify 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



# Prioritized Exam (cont.)

- 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 exam is terminated without a refund of prioritized exam fee if patent applicant:
  - petitions for an extension of time to file a reply or to suspend action; or
  - amends the application to exceed the claim restrictions
- USPTO may not accept more than 10,000 requests for prioritized exam per fiscal year



# Prioritized Exam (cont.)

(Data as of 2/24/12)

<b>Fiscal Year</b>	<b>Pending</b>	<b>Granted</b>	<b>Dismissed</b>	<b>Total</b>
FY2011	24	819	12	855
FY2012	638	854	24	1516

	<b>First Action on the Merits Mailed</b>	<b>Final Dispositions Mailed</b>	<b>Number of Allowance of Final Dispositions</b>
Prioritized Applications	1135	122	99



# 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 Process

- USPTO will follow APA rulemaking process under a 17 month timeline
- USPTO released preliminary proposed patent fees:
  - USPTO Transmittal Letter to PPAC for Patent Fee Proposal
  - USPTO Executive Summary: Patent Fee Proposal
  - USPTO Detailed Appendices: Patent Fee Proposal
  - USPTO Table of Patent Fee Changes
  - USPTO Aggregate Revenue Calculations
  - Aggregate Revenue Calculations (Excel version)





# Fee Setting Process (cont.)

- Patent Public Advisory Committee (PPAC) conducted two hearings and collected written comments
- PPAC tentatively will issue report to USPTO by early June 2012
- 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



# 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



# Proposed Fee Structure - Summary of Significant Changes

Description	Current Large Entity Fee (Alternative)	Proposed Large Entity Fee	Dollar Change	Percent Change	Rationale
Utility--Basic Filing, Search, and Exam (total)	\$1,250	\$1,840	\$590	47%	More closely aligns fee revenue with cost of service.
Request for prioritized exam (Track 1)	\$4,800	\$4,000	(\$800)	-17%	Encourages greater program participation and aligns the large entity fee with cost of service.
Excess claims (Independent in Excess of 3)	\$250	\$460	\$210	84%	Encourages applicants to file compact and carefully devised applications.
Excess claims (Total in Excess of 20)	\$60	\$100	\$40	67%	
Application size	\$310	\$400	\$90	29%	
Extensions for Response within 1st Month	\$150	\$200	\$50	33%	
Extensions for Response within 2nd Month	\$560	\$600	\$40	7%	Encourages efficient prosecution and assists in reducing patent pendency.
Extensions for Response within 3rd Month	\$1,270	\$1,400	\$130	10%	
Extensions for Response within 4th Month	\$1,980	\$2,200	\$220	11%	
Extensions for Response within 5th Month	\$2,690	\$3,000	\$310	12%	
Request for continued examination (RCE)	\$930	\$1,700	\$770	83%	Achieves cost recovery and continues to offer applicants a viable option to dispute a final rejection when the applicant believes the examiner has erred.
Notice of Appeal *	\$620	\$1,500	\$880	142%	Better aligns services with costs and reduces fee burdens associated with examiner withdrawal of final rejections.
Filing a Brief in Support of an Appeal	\$620	\$0	(\$620)	-100%	
Filing an Appeal	\$0	\$2,500	\$2,500	102%	
Supplemental Examination	\$5,180/\$16,120	\$7,000/\$20,000	\$5,700	27%	Encourages applicants to submit complete applications with all relevant information during prosecution.
Combined Pre-grant publication and Issue	\$2,040	\$960	(\$1,080)	-53%	Combined to streamline the fee structure; reduced to promote public information to encourage follow-on innovation and reduce initial costs to patent owners who may not know the value of their invention immediately.
Maintenance - 1st Stage	\$1,130	\$1,600	\$470	42%	Increased to achieve goals and better align front-end and back-end fees; early stage fees are lower in recognition of the uncertainty of patent value; as time goes on, an inventor can better measure the value of an invention and determine whether maintenance is truly worthwhile.
Maintenance - 2nd Stage	\$2,850	\$3,600	\$750	26%	
Maintenance - 3rd Stage	\$4,730	\$7,600	\$2,870	61%	

\* The Office is also proposing a \$0 issue fee when the examiner withdraws final rejection before the applicant pays the filing of an appeal fee.



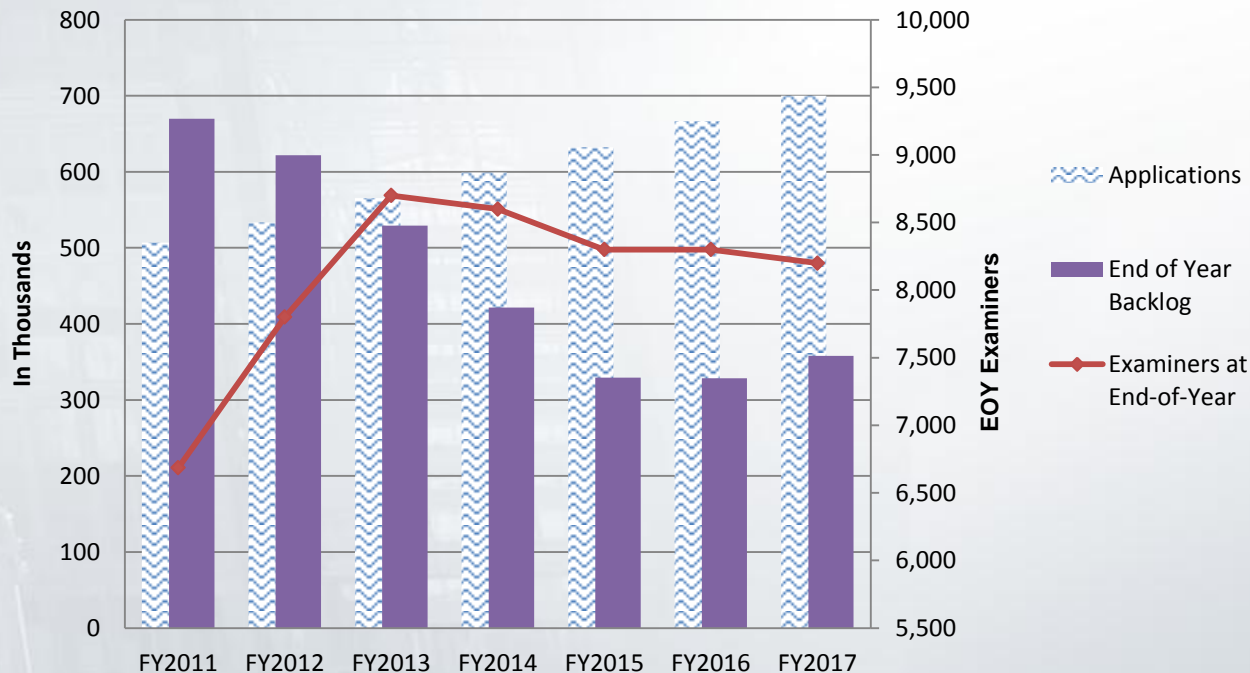
# Projected FY 2013 Aggregate Cost Revenue Balance With Preliminary Proposed Fees

- USPTO estimates that its aggregate patent operational costs, including administrative costs, will total \$2.549 billion
- USPTO anticipates collecting \$2.686 billion in patent fee revenue
  - \$2.549 billion directed to paying for known costs
  - \$137 million placed in an operating reserve for long-term financial stability



# Projected Impact of Preliminary Proposed Fee Schedule on Backlog

- Reduce the backlog of patent applications
  - from 669,625 applications at the end of FY 2011
  - to 329,500 at the end of FY 2015





# Projected Impact of Preliminary Proposed Fees on Pendency

- Reduce:
  - average first action pendency from 28 months at the end of FY 2011 to 10.1 months in FY 2015
  - average total pendency from 33.7 months at the end of FY 2011 to 18.3 months in FY 2016

Utility, Plant and Reissue	FY2011	FY2012	FY2013	FY2014	FY2015	FY2016	FY2017
Applications	506,924	533,300	565,300	599,200	632,200	666,900	700,300
Growth Rate	5.3%	5.2%	6.0%	6.0%	5.5%	5.5%	5.0%
Production Units	502,488	539,700	620,600	671,900	694,200	645,200	656,200
End of Year Backlog	669,625	621,800	529,100	421,600	329,500	328,400	358,000
<b>Performance Measures</b>							
Inventory Position (Months)	21.2	17.9	12.9	9.5	7.3	8.3	9.2
Avg. First Action Pendency (Months)	28.0	22.5	16.9	15.9	10.1	9.4	9.4
Avg. Total Pendency (Months)	33.7	34.7	30.1	24.6	22.9	18.3	18.1
Examiners at End-of-Year	6,685	7,800	8,700	8,600	8,300	8,300	8,200



# Projected Impact of Preliminary Proposed Fees on Operating Reserve

- Builds operating reserve to the optimal level of three months of operating expenses

Description	FY 2012	FY 2013	FY 2014	FY 2015	FY 2016	FY 2017
3 Months Operating Expense	\$562 M	\$637 M	\$675 M	\$702 M	\$712 M	\$736 M
Estimated End of Year Balance	\$121 M	\$277 M	\$459 M	\$756 M	\$712 M	\$736 M



# Micro-entity

(Effective September 16, 2011)

- General 4-part definition for an “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;
    - Applicants are not considered to be named on a previously filed application if he/she has assigned, or is obligated to assign, ownership as a result of previous employment





# Micro-entity (cont.)

- General definition for an “applicant” who certifies that he/she/it (cont.):
  3. Did not have a gross income exceeding 3 times the median household income in the calendar preceding the calendar year in which the applicable fees is paid; and
  4. Has not assigned, granted, conveyed a license or other ownership interest (and is not under an obligation to do so) in the subject application to an entity that exceeds the gross income limit



# Micro-entity (cont.)

- Micro-entity automatically includes an “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



# Micro-entity (cont.)

- Institution of higher education under the Higher Education Act of 1965 means an educational institution, among other things, that:
  - is located in any State (i.e., no foreign universities);
  - admits persons having a certificate of graduation from a secondary education school;
  - awards a bachelor's degree; and
  - is public or non-profit



# Micro-entity (cont.)

- Director may impose additional limits as are “reasonably necessary to avoid an undue impact on other patent applicants or owners or are otherwise reasonably necessary and appropriate”
- 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
- USPTO engaged in rulemaking under 18 month timeline



# Quality

- Electronic filing incentive
  - Implemented
- Preissuance submissions
  - Proposed rules issued
- Citation of a patent owner statement
  - Proposed rules issued
- Supplemental examination
  - Proposed rules issued



# Electronic Filing Incentive (Effective November 15, 2011)

- Establish a \$400 fee, reduced by 50% for small entities, for all original (non-reissue) applications filed by non-electronic means
- Fee does not apply to design, plant, or provisional applications
- Fee must be deposited in a general account at Treasury and is not available for the PTO to spend in appropriations account



# Preissuance Submissions

(Effective September 16, 2012)

- New 35 U.S.C. § 122(e)
- 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; and
  - must include a statement by the third party making the submission affirming that the submission is compliant with statutory requirements. § 122(e)(1) & (2)



# Preissuance Submissions (cont.)

- Submission must be made before the earlier of:
  - date a notice of allowance under 35 U.S.C. § 151 is given or mailed in the application; or
  - 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. § 122(e)(1)(A) & (B)





# Preissuance Submissions Timing Example #1



\* Preissuance submission must be filed before this date





# Preissuance Submissions (cont.)

- Proposed rule 290(d): recites contents of submission and consists of 5 parts including:
  - list of documents being submitted;
  - description of the relevance of each document; and
  - copy of each document, except a U.S. patent or U.S. patent application publication



# Preissuance Submissions (cont.)

- Proposed rule 290(g): requires fee for submission as set forth in current rule 1.17(p) (*i.e.*, fee for Rule 99 submission)
  - Three or fewer documents are free if first preissuance submission by third party;
  - \$180 for 1 to 10 documents; and
  - \$360 for 11 to 20 documents



# Preissuance Submissions (cont.)

- Proposed rule 290(h): applicant has no duty to respond to the submission
  - Third party not required to serve the submission on the applicant, 77 Fed. Reg. at 449; and
  - USPTO will not notify the applicant of entry of the submission into an application, 77 Fed. Reg. at 450
- Examiners will acknowledge the submission in a manner similar to an IDS submission, 77 Fed. Reg. at 450



# Preissuance Submissions (cont.)

- Changes to Implement the Preissuance Submissions by Third Parties Provision of the Leahy-Smith America Invents Act, 77 Fed. Reg. 448 (Jan. 5, 2012)
- [preissuance\\_submissions@uspto.gov](mailto:preissuance_submissions@uspto.gov)
- Comment period originally closed March 5, 2012, but extended by 1 week to March 12, 2012



# Citation of Patent Owner Statement

(Effective September 16, 2012)

- Amends 35 U.S.C. § 301
- Expands the information that can be submitted in the file of an issued patent to include written statements made by a patent owner before a Federal court or the Office regarding the scope of any claim of the patent. § 301(a)(2)
- Requires documentation of statement. § 301(c)
- Limits the Office's use of such written statements to determining the meaning of a patent claim in *ex parte* reexamination proceedings that have already been ordered and in *inter partes* review and post grant review proceedings that have been instituted. § 301(d)



# Citation of Patent Owner Statement (cont.)

- Proposed rule 501(a)(2):
  - Permits submission of patent owner claim scope statement in patent file;
  - Statement must be accompanied by documentation of statement; and
  - Patent owner claim scope statement made outside of a proceeding not permitted
- Proposed rule 501(b)(1): must explain the pertinence and manner of applying any submission
- Proposed rule 501(b)(2): if citation made by the patent owner, may include an explanation how the claims differ from patent owner claim scope statement





# Citation of Patent Owner Statement (cont.)

- Submitter's identity may be kept confidential upon request. § 301(e)
  - Proposed rule 501(d): submission may be made anonymously
- Proposed rule 501(e): submission must be served on patent owner or a bona fide attempt at service demonstrated



# Citation of Patent Owner Statement (cont.)

- Changes to Implement Miscellaneous Post Patent Provisions of the Leahy-Smith America Invents Act, 77 Fed. Reg. 442 (Jan. 5, 2012)
- [Post\\_patent\\_provisions@uspto.gov](mailto:Post_patent_provisions@uspto.gov)
- Comment period originally closed March 5, 2012, but extended by 1 week to March 12, 2012



# Supplemental Exam

(Effective September 16, 2012)

- New 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. § 257(a)
  - Proposed rule 601(a): Request must be filed by owner of the entire right, title, and interest in the patent
  - Proposed rule 601(c): Third party participation is prohibited



# Supplemental Exam (cont.)

- “Information” that forms the basis of the request is not limited to patents and printed publications. § 257(a)
  - Proposed rule 605(a): Number of items of information is limited to 10 per request
  - Proposed rule 605(a): Unlimited number of requests may be filed at any time



# Supplemental Exam (cont.)

- Proposed rule 610: Recites contents of a request and consists of 12 parts including:
  - list of each item of information and its publication date;
  - identification of each issue raised by each item of information; and
  - identification of how each item of information is relevant to each aspect of the patent to be examination and how each item of information raises each identified issue



# 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. § 257(a)
  - Proposed rule 620 (a): SNQ decision “will generally be limited to” review of the issue identified in the request as applied to the patent claims
  - Proposed rule 620(e): No interviews in supplemental examination, but possible if ex parte reexamination instituted
  - Proposed rule 620(f): No claim amendment in supplemental examination, but possible if ex parte reexamination instituted



# Supplemental Exam (cont.)

- Supplemental examination concludes with a supplemental reexamination certificate indicating whether any item of information raised an SNQ. § 257(a)
  - If SNQ, then the Director must order an *ex parte* reexamination. § 257(b)
  - Proposed rule 625(a): certificate will be electronic



# Supplemental Exam (cont.)

- *Ex parte* reexamination conducted under 35 U.S.C. chapter 30 and 37 CFR 1.510 et seq. (the *ex parte* reexamination statute and rules), except:
  - Patent owner does not have the right to file a statement; and
  - USPTO will address each SNQ without regard to whether it is raised by a patent or printed publication.  
§ 257(b)





# Supplemental Exam (cont.)

- Inequitable conduct immunization, § 257(c)
  - Information considered, reconsidered, or corrected during supplemental examination cannot be the basis for rendering a patent unenforceable so long as the supplemental exam and any ordered ex parte reexamination are finished before the civil action is brought, § 257(c)(1) & (c)(2)(B)
  - But does not apply to information raised in a civil action brought before supplemental exam sought. § 257(c)(2)(A)



# Supplemental Exam (cont.)

Service	Cost
Proposed rule 20(k)(1): filing fee (for processing and treating a request for supplemental examination)	\$ 5180
Proposed rule 20(k)(2): reexamination fee (ordered as a result of supplemental examination)	\$16,120
<b>TOTAL</b>	<b>\$21,300</b>
Proposed rule 26(c): refund if the Office decides not to order an ex parte reexamination proceeding	\$16,120



# Supplemental Exam (cont.)

- If Director learns of “material fraud” committed in connection with the patent subject to supplemental exam, the Director:
  - must confidentially refer the matter to the Attorney General; and
  - may take other action. § 257(e)
- Office regards “material fraud” to be narrower in scope than inequitable conduct as defined in *Therasense*. 77 Fed. Reg. at 3667



# Supplemental Exam (cont.)

- 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)
- [Supplemental\\_examination@uspto.gov](mailto:Supplemental_examination@uspto.gov)
- Comment period closes March 26, 2012



# Contested Cases

- 4 kinds:
  - Inter partes review: new 35 U.S.C. 311 to 319
  - Post grant review: new 35 U.S.C. 321 to 329
  - Covered business method review
  - Derivation: new 35 U.S.C. 135



# Contested Cases (cont.)

## (Effective September 16, 2012)

Proceeding	Petitioner	Available	Standard	Basis
<b>Post Grant Review (PGR)</b>	<ul style="list-style-type: none"> <li>Person who is not the patent owner and has not previously filed a civil action challenging the validity of a claim of the patent</li> </ul>	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
<b>Inter Partes Review (IPR)</b>	<ul style="list-style-type: none"> <li>Must identify real party in interest</li> </ul>	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



# Contested Cases (cont.)

(Effective September 16, 2012)

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



# Administrative Trials: Petition Phase

- Initiated by third party petition
- Petition must include among other things:
  - fee, [Proposed rules 42.15; 42.103](#);
  - identification of real parties in interest, [Proposed rule 42.8](#);
  - identification all challenged claims and grounds for challenge, [Proposed rule 42.104\(b\)](#); and
  - claim construction and showing how the construed claim is unpatentable based on the grounds alleged, [Proposed rule 42.104\(b\)](#)





# Contested Cases: Petition Phase (cont.)

- Patentee may file preliminary response to petition,  
Proposed rule 42.107(a)
  - Proposed rule 42.107(b): Preliminary response is due  
2 months from petition docketing date
  - Proposed rule 42.107(c): Preliminary response may  
present non-testimonial evidence



# Contested Cases: Petition Phase (cont.)

- USPTO must decide petition within 3 months from the patentee's preliminary response, if any
  - Proposed rule 42.108(a) and (b): Board will institute trial where standard is met on:
    - claim-by-claim basis; and
    - ground-by-ground basis



# Administrative Trials: Trial Phase

- Patentee may file response and must include any additional factual evidence and/or expert opinions, [Proposed rule 42.120](#)
- [Proposed rules 42.107\(e\) and 42.207\(e\)](#): Patentee may disclaim claims



# Administrative Trials: Trial Phase (cont.)

- Patentee may file 1 motion to amend claims that may be limited in scope after consultation with the Board, [Proposed rule 42.121\(a\)](#)
  - Amendments may
    - cancel any challenged claim; and/or
    - propose a reasonable number of substitute claims, [Proposed rule 42.121\(a\)](#)
  - Additional motions may be filed if authorized by Board, [Proposed rule 42.121\(a\)](#)

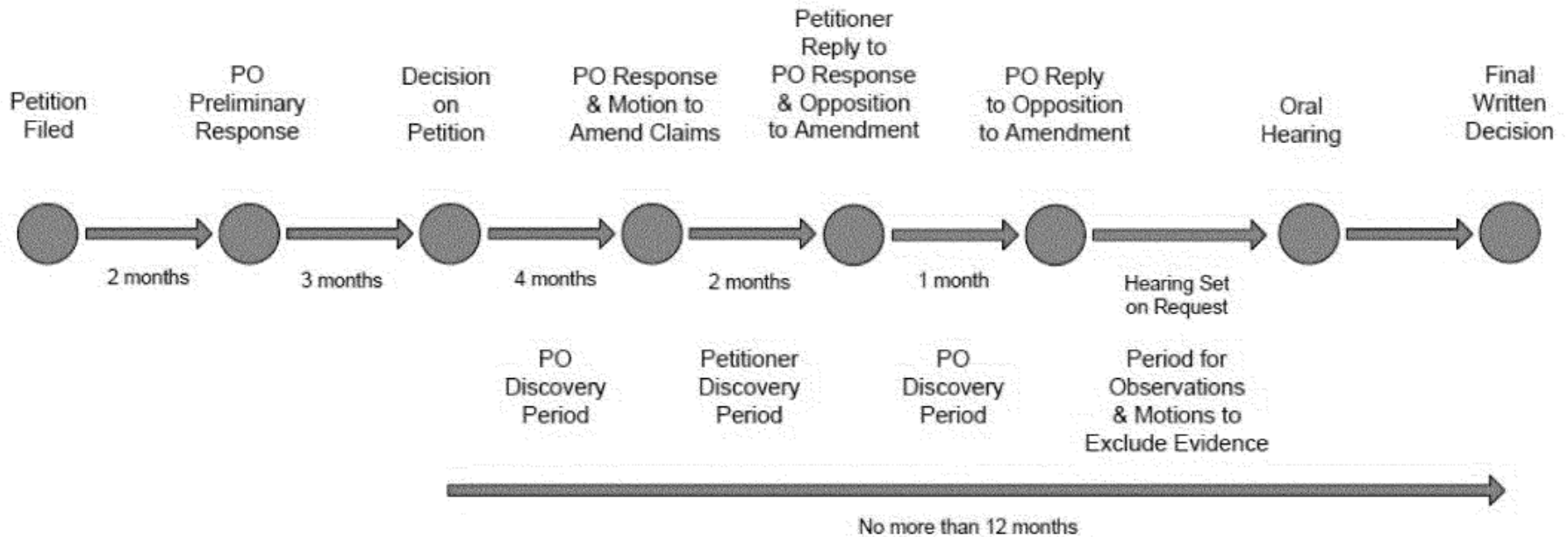


# Contested Cases: Trial Phase (cont.)

- Petitioner may file supplemental information after a trial is instituted with Board authorization, [Proposed rules 42.123 and 42.223](#)



# Administrative Trials





# Contested Cases: Trial Phase (cont.)

- Discovery available according to standards and procedures set by the Board
- Proposed rule 42.51(b), (c): Provides for two types of discovery:
  - routine; and
  - permissive



# Contested Cases: Trial Phase (cont.)

- Proposed rule 42.51(b): Routine discovery for documents cited, cross-examination for submitted testimony, and information inconsistent with positions advanced during the proceeding
- Permissive discovery
  - PGR: good cause standard, Proposed rule 42.224
  - IPR: interests of justice, Proposed rule 42.51(c)
- Proposed rule 42.53(a): Live testimony may be authorized where critical





# Contested Cases: Trial Phase (cont.)

- Any party may seek additional relief by motion, **Proposed rule 42.20**
- **Proposed rule 42.23: A party may rebut an opponent's motion by filing an opposition**
- **Proposed rule 42.25: A party seeking to respond to an opposition may file a reply**
- **Administrative patent judge assigned to the case may decide the motions during a conference call**



# Contested Cases: Trial Phase (cont.)

- Protective orders possible, [Proposed rule 42.54](#)
- Oral hearing as a right, [Proposed rule 42.70](#)
  - Length and scope of the hearing will be set on a case-by-case basis taking into account the complexity of the case
- Director may join petitioners and consolidate
- May be settled, [Proposed rule 42.74](#)



# Contested Cases: Trial Phase (cont.)

- Trial concludes with a written decision addressing patentability of any claim challenged and any new claim added, [Proposed rule 42.73](#)
- [Proposed rule 42.71\(c\)](#): Either party may seek reconsideration



# Contested Cases: Trial Phase (cont.)

- Proposed rule 42.10 (c): Pro hac vice admission possible upon a showing of good cause
  - Board may impose conditions, e.g.,
    - Bound to Office's Code of Professional Responsibility
  - Board may revoke pro hac vice status for cause, e.g.,
    - Unwillingness to abide by the Office's Code of Professional Responsibility;
    - Incompetence; and
    - Incivility



# Contested Cases (cont.)

<b>Proceeding</b>	<b>Cost</b>	<b>Basis</b>
<b>PGR</b>	\$35,800 for 20 claims or less, Proposed rule 42.15	cost of ~ 130 hours of Judge time plus IT costs
<b>IPR</b>	\$27,200 for 20 claims or less, Proposed rule 42.15	cost of ~ 100 hours of Judge time plus IT costs



# Contested Cases (cont.)

(Effective on September 16, 2012)

<b>AIA Provision</b>	<b>Notice of Proposed Rulemaking</b>	<b>Comment Period Ends</b>
<b>IPR</b>	Changes to Implement Inter Partes Review Proceedings, 77 Fed. Reg. 7041 (Feb. 12, 2012)  --inter_partes_review@uspto.gov	April 10, 2012
<b>PGR</b>	Changes to Implement Post Grant Review Proceedings, 77 Fed. Reg. 7060 (Feb. 12, 2012)  --post_grant_review@uspto.gov	April 10, 2012
<b>Transitional program for covered business method patents</b>	Changes to Implement Transitional Program for Covered Business Method Patents, 77 Fed. Reg. 7080 (Feb. 12, 2012)  --TPCBMP@uspto.gov	April 10, 2012
	Transitional Program for Covered Business Method Patents— Definition of Technological Invention, 77 Fed. Reg. 7095 (Feb. 12, 2012)  --TPCBMP_Definition@uspto.gov	April 10, 2012



# Contested Cases (cont.)

(Effective on September 16, 2012)

<b>AIA Provision</b>	<b>Notice of Proposed Rulemaking</b>	<b>Comment Period Ends</b>
<b>Derivation</b> (effective on March 16, 2013)	Changes to Implement Derivation Proceedings, 77 Fed. Reg. 7028 (Feb. 12, 2012)  --derivation@uspto.gov	April 10, 2012
<b>General</b>	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)  --patent_trial_rules@uspto.gov	April 9, 2012
<b>General</b>	Practice Guide for Proposed Trial Rules, 77 Fed. Reg. 6868 (Feb. 11, 2012)	April 9, 2012



# Clarity

- Inventor's oath/declaration
  - Proposed rules issued
- First-inventor-to-file and derivation
  - Under development now





# Inventor's Oath/Declaration

- Replaces language in 35 U.S.C. 115 with new language
- An application for patent \* \* \* shall include \* \* \* the name of the inventor for any invention claimed in the application
- [E]ach individual who is the inventor or a joint inventor \* \* \* shall execute an oath or declaration



# Inventor's Oath/Declaration (cont.)

- Inventor's oath/declaration must include statements that:
  - application was made or authorized to be made by the affiant/declarant; and
  - affiant/declarant believes himself to be the original inventor
  
- 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 (cont.)

- Substitute statement permitted where an inventor is:
  - deceased;
  - legally incapacitated;
  - unable to be found or reached after diligent effort; or
  - refuses to sign despite obligation to assign



# Inventor's Oath/Declaration (cont.)

- Oath/declaration for a deceased or incapacitated inventor may now be made by:
  - legal representative;
  - assignee;
  - party to whom the inventor is under an obligation to assign; or
  - party who otherwise shows sufficient proprietary interest



# Inventor's Oath/Declaration (cont.)

- Assignment may include the statements required in an oath/declaration
- Proposed rule 63(c)(1): Assignment must:
  - include the statements regarding authorization for filing and original inventor;
  - be filed in the application; and
  - be recorded against the application



# Inventor's Oath/Declaration (cont.)

- 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
- Proposed rule 63(a)(2): inventor's oath/declaration must be submitted on filing or shortly thereafter and must identify each inventor



# Inventor's Oath/Declaration (cont.)

- Changes to Implement the Inventor's Oath or Declaration Provisions of the Leahy-Smith America Invents Act, 77 Fed. Reg. 982 (Jan. 6, 2012)
- [Oath\\_declaration@uspto.gov](mailto:Oath_declaration@uspto.gov)
- Comment period originally closed March 6, 2012, but extended by 1 week to March 13, 2012



# First-inventor-to-file

(Effective March 16, 2013)

- Transitions the U.S. to a first-inventor-to-file patent system
  - Hybrid between first-to-invent (current U.S. law) and first-to-file (used in all other industrialized countries)
- 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
- Few proposed rules; mainly implemented by agency guidance and revisions to the Manual of Patent Examining Procedure; under 18 month timeline



# First-inventor-to-file Hypo 1

March	April	May	June
A invents	B invents	A files patent application	B files patent application

- Old law: A gets the patent
- New law: A gets the patent



# First-inventor-to-file Hypo 2

March	April	May	June
A invents	B invents	B files patent application	A files patent application

- Old law: A gets the patent
- New law: B gets the patent



# First-inventor-to-file Hypo 3

		<b>A's Grace Period</b>		
April 2013	June 2013	July 2013 to June 2014		July 2014
A invents		A publishes		A files

- Old law: A gets the patent
- New law: A gets the patent



# First-inventor-to-file Hypo 4

		<b>A's Grace Period</b>		
April 2013	June 2013	July 2013 to June 2014		July 2014
A invents	A publishes			A files

- Old law: A does **NOT** get the patent
- New law: A does **NOT** get the patent



# First-inventor-to-file Hypo 5

		<b>A's Grace Period</b>		
April 2013	June 15, 2013	July 2013 to June 2014		July 2014
A invents	B invents	B publishes		A files

- Old law: A gets the patent
- New law: A does **NOT** get the patent

# AIA Information





# AIA Microsite

## [www.uspto.gov/AmericanInventsAct](http://www.uspto.gov/AmericanInventsAct)

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## Leahy-Smith America Invents Act Implementation





# Thank You



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