

# America Invents Act Patent Rulemaking Patent Roundtable – Greenville, SC



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# Provisions of Law: Implementation Complete

- Change in inter partes reexamination standard
- Tax strategies deemed within the prior art
- Best mode
- Human organism prohibition
- Prioritized examination
- 15% surcharge
- Electronic filing incentive



# Prioritized Examination (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 Exam Statistics: Part I (Data as of 3/15/12)

<b>Total Requests</b>	<b>Pending</b>	<b>Granted</b>	<b>Dismissed</b>	<b>Total</b>
FY 2012	619	2925	129	3673
FY 2011	13	827	15	855

<b>Examination Status</b>	<b>First Action on the Merits Mailed</b>	<b>Final Dispositions Mailed</b>	<b>Number of Allowances of Total Final Dispositions</b>
Number of applications	2717	1235	637



# Best Mode

(Effective September 16, 2011)

- Failure to disclose the best mode shall not be a basis on which any claim of a **patent** may be cancelled or held invalid or otherwise unenforceable, 35 U.S.C. 282:
  - Inventors must continue to meet the best mode requirement as a pending **application** can be rejected under 35 U.S.C. 112(a), which continues to contain the requirement.



# Provisions of Law: 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)



# First-Inventor-to-File v. First-to-Invent

(Effective March 16, 2013)

Aspect of Law	First-to-invent	First-inventor-to-file
1 year grace period	YES, but with differences	
Public use or sale as prior art	Geographic limitation to <b>United States</b> only	<b>No geographic limitation</b> —may occur anywhere in the world
Patents and patent application publications as prior art to another	As of effective filing date: -actual filing date; or -filing date of the earliest <b>U.S. application</b> for which a benefit claim is sought	As of effective filing date: -actual filing date; or -filing date of the <b>earliest application</b> for which a benefit claim or right of priority is sought, <b>regardless if filed in U.S. or a foreign country</b>



# First-Inventor-to-File: Prior Art

- 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: Grace Period

- Reliance on U.S. grace period after public disclosure to file a U.S. application may cause loss of foreign patent rights in absolute novelty countries:
  - notwithstanding the foreign application's reliance on the U.S. application
- Grace period for first-inventor-to-file not the same, *e.g.*:
  - a publication date by another independent inventor even one day prior to the filing date of a first inventor's application can no longer be overcome by a showing of earlier invention



# Inventor's Oath/Declaration: Public Comments

- Public comments sought a more robust approach to implementing the AIA to include greater flexibility in:
  - the required submission time for an oath or declaration;
  - permitting an individual oath or declaration to only identify the inventor executing the document; and
  - decreasing the required information



# Inventor's Oath/Declaration: Requirements

- 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.
- Assignments may include the statements required in an oath or declaration.



# Inventor's Oath/Declaration: Substitute Statement

- Substitute statement permitted in lieu of a inventor's oath/declaration where an inventor is:
  - Deceased;
  - Legally incapacitated;
  - Unable to be found or reached after diligent effort; or
  - Refuses to sign
- Substitute statement can 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



# Preissuance Submissions

(Effective 9/16/12 – 77 FR 42150 (7/17/12) (Final))

- Allows third parties to submit printed publications of potential relevance in the application of another if certain conditions are met, *e.g.*:
  - submitted in writing;
  - contains a concise description of the asserted relevance of each submitted document;
  - the fee is paid (if necessary);
  - includes a statement by the person making the submission affirming that the submission is compliant with statutory and regulatory requirements; and
  - meets the timing requirements.



# Preissuance Submissions

- Third party:
  - Can be anonymous; and
  - Not required to serve submission on applicant.
- Can be filed by EFS-Web with this caveat:
  - Must select the preissuance submission filing option.



# Preissuance Submissions: Fee

- \$180 for every ten items or fraction thereof:
  - 3 and under are free if first submission, but:
    - Need statement that it is a “first and only” submission.



# Preissuance Submissions: Concise Description

- Format that would best explain information:
  - *E.g.*, narrative or claim chart (mapping various portions of a document's information to different claim elements).

Caveat: Not a protest, therefore, do not, *e.g.*,:

- Propose rejections; or
- Provide arguments relating to an Office action or an applicant reply.

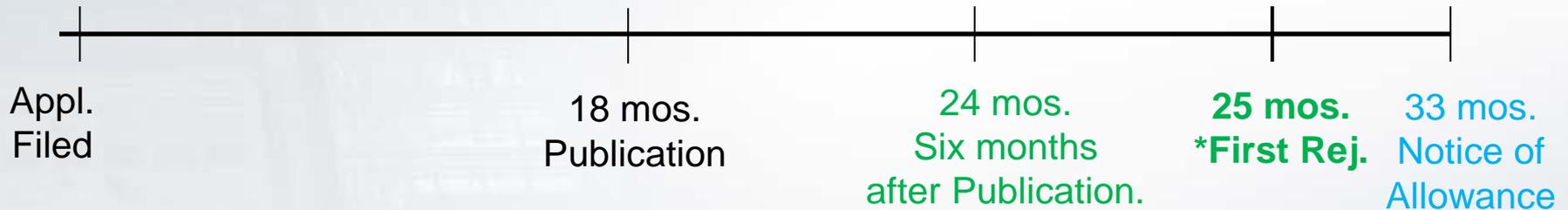


# Preissuance Submissions: Timing

- 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 by the USPTO; or
    - date of the first rejection of any claim in the application



# Preissuance Submissions: Timing Example



\* Preissuance submission must be filed before this date



# Preissuance Submissions: Notifications

- Applicants: Can be notified to entry of a compliant submission:
  - If applicant participates in the Office's e-Office Action program.
- Third party submitters: Can be notified to a noncompliant submission:
  - If an electronic mail message (e-mail) address is provided.



# Supplemental Examination (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.
- Purpose is to immunize the patent against claims of unenforceability based on an allegation of inequitable conduct relating to the information submitted.
- “Information” that forms the basis of the request is not limited to patents and printed publications.



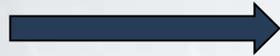
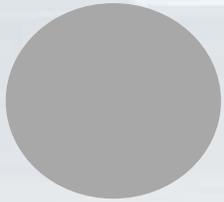
# Supplemental Examination: Inequitable Conduct Immunization

- Immunity does not apply:
  - To allegations pled in a civil action or notice to the patentee before the date of the request for supplemental examination; and
  - Unless the supplemental examination and any resulting *ex parte* reexamination is completed before the civil action is brought.



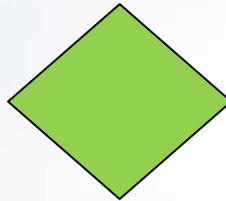
# Supplemental Examination: Flowchart

Patent Owner  
Request



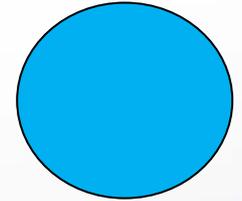
3 months

Decision on Patent  
Owner Request:  
Standard Triggered?



YES

Ex Parte  
Reexamination



NO

Supplemental  
Examination  
Complete



# Supplemental Examination: Process

- USPTO must decide, within 3 months from the request, whether the information in the request raises a “substantial new question of patentability:”
  - Substantial likelihood that a reasonable examiner would consider the item of information important in determining patentability.
- 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 Examination: Material Fraud

- If the Office becomes aware of a material fraud on the Office in connection with the patent under supplemental examination, then USPTO:
  - Must confidentially refer the matter to the U.S. Attorney General; and
  - May take other action as set forth in 35 U.S.C. 257(e), e.g., cancellation of any claims found to be invalid as a result of a reexamination



# Submission of Patent Owner Statements

- Expands scope of information that may be submitted into the file of an issued patent:
  - Statements of the patent owner on scope of any claim of a particular patent.
- Requirements:
  - Statement must have been filed in a proceeding before a Federal court or USPTO proceeding.
  - Must include any other documents, pleadings, and evidence (additional information) that address the statement.



# Submission of Patent Owner Statements

- Must include an explanation of how the statement and any additional information are pertinent to the patented claim(s).
- A patent owner submitting a statement may provide an explanation as to how the claims are patentable over the statement and any additional information.
- The statement and any additional information cannot be used to order reexamination, but can be used once reexamination is ordered.

# Thank You

