

AIA Regulations

October 5, 2012

28th Annual Institute on Intellectual Property Law



Janet Gongola

Patent Reform Coordinator

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571-272-8734



AIA Report Card

Effective September 16, 2012	Effective 2013
Inventor's oath / declaration	Derivation (complete)
Supplemental examination	First-inventor-to-file -Comments due October 5, 2012 fitf_rules@uspto.gov fitf_guidance@uspto.gov
Preissuance submission	Patent service fees -Comments due November 5, 2012 fee.setting@uspto.gov
Citation of patent owner claim scope statements	
Inter partes review	
Post grant review	
Covered business method review	

Supplemental Examination



35 U.S.C. 257

Effective Date: September 16, 2012

**Applicability: Patent enforceable on/after
September 16, 2012**



Request

- Patent owner may request supplemental examination of a patent to consider, reconsider, or correct information believed to be relevant to the patent
- Request may address 35 U.S.C. 101, 102, 103, and 112, and double-patenting
- Item of information must be in writing and is not limited to patents and printed publication
- 12 items of information per request, but multiple parallel requests allowed



Filing the Request

- Request may be filed electronically via the Office's dedicated Web-based interface or in paper but not by facsimile
- Identify the filing as a supplemental examination request
- <http://www.uspto.gov/forms>
 - Features transmittal form



Contents of the Request

- Identification of the patent and each claim for which supplemental examination is requested;
- List of the items of information;
- Separate, detailed explanation of the relevance and manner of applying each item of information; and
- Summary of the relevant portions of any submitted document, other than the request, that is over fifty pages in length
- Fees



Fees

Service	Fee
Filing fee (for processing and treating a request for supplemental examination) Plus any applicable document size fees for processing and treating, in a supplemental examination proceeding, a non-patent document over 20 sheets in length	\$ 5140
Reexamination fee (for ex parte reexamination ordered as a result of supplemental examination)	\$16,120
TOTAL	\$21,260



Filing Date of Request

- Compliant request will be granted a filing date
- Non-compliant request will be not be given a filing date, and patent owner will be notified and given an opportunity to correct the defect within a specified time



Standard

- If one or more items of information raises a substantial new question of patentability (SNQ):
 - ex parte reexamination will be ordered
 - see MPEP 2242 for discussion of SNQ standard
- If an SNQ is not raised by any of the items of information:
 - ex parte reexamination will be not be ordered; and
 - ex parte reexamination fee will be refunded



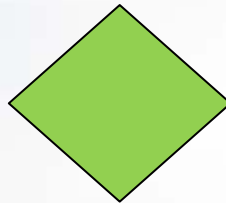
Processing

Patent Owner
Request



3 months

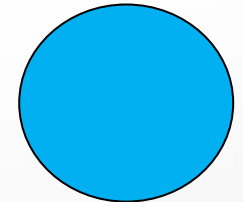
Decision on Patent Owner
Request: Substantial New
Question of Patentability
Standard Triggered?



YES



Supplemental
Examination Concluded
and Ex Parte
Reexamination Initiated



NO



Supplemental
Examination
Concluded



Conclusion

- Supplemental examination will conclude with the electronic issuance of the supplemental examination certificate
- Supplemental examination certificate will indicate the result of the Office's determination as to whether any item of information raises a substantial new question of patentability

Citation of Patent Owner Claim Scope Statements



35 U.S.C. 301

Effective Date: September 16, 2012

**Applicability: Any patent on or after
September 16, 2012**



Patent Owner Claim Scope Statement

- Third party or patent owner may submit patent owner claim scope statements in a patent file
- Patent owner claim scope statement = written statements about the scope of the patent claims
 - made *inside or outside of a federal court or USPTO proceeding*; and
 - filed *by the patent owner* in the federal court or USPTO proceeding



Office Usage

- USPTO will not use a patent owner claim scope statement in deciding whether to:
 - order an *ex parte* or *inter partes* reexamination; or
 - institute an administrative trial
- USPTO may take a patent owner claim scope statement into account after:
 - ordering an *ex parte* or *inter partes* reexamination;
 - or instituting an administrative trialto determine the proper meaning of the patent claims

Questions?



Thank You



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