

The America Invents Act: Implementation Progress One Year After Enactment

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Purpose of the AIA

- “This long-overdue reform is vital to our ongoing efforts to modernize America’s patent laws and reduce the backlog of 700,000 patent applications – which won’t just **increase transparency and certainty for inventors, entrepreneurs and businesses**, but help **grow our economy and create good jobs.**”

-President Barack Obama



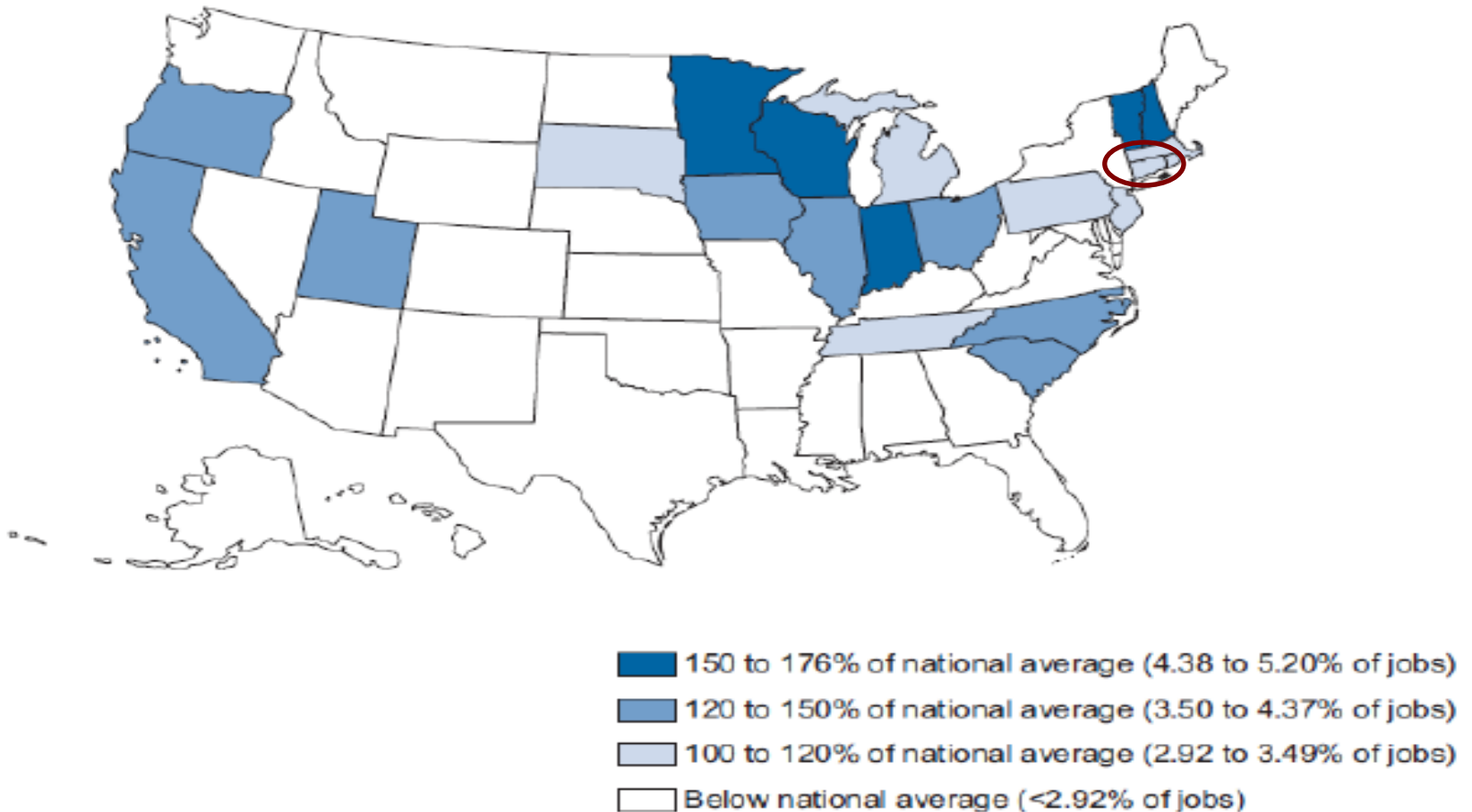
Intellectual Property and the Economy: Industries in Focus

(Data for 2010)

- Entire U.S. economy relies on some form of IP
- 40 million jobs tied to IP-intensive industries
- \$5.06 trillion, or 34.8% of U.S. gross domestic product, attributable to IP-intensive industries
- 42% higher wages in IP-intensive industries
- 60.7% of all exports, or \$775 billion, from IP-intensive industries



IP-Intensive Industries by State



Source: ESA calculations using data from the Bureau of Labor Statistics' Quarterly Census of Employment and Wages.



AIA Report Card

Effective September 16, 2012	Effective 2013
Inventor's oath / declaration	Derivation (complete)
Preissuance submission	First-inventor-to-file -Comments due October 5, 2012 fitf_rules@uspto.gov fitf_guidance@uspto.gov
Supplemental examination	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	

Inventor's Oath or Declaration



35 U.S.C. 115 and 118

Applicability: Utility, design, patent, and reissue applications filed on or after September 16, 2012



35 U.S.C. 118

- *Permits an assignee, person to whom there is an obligation to assign, or person with a sufficient proprietary interest in the claimed invention to be the applicant*
- Term “applicant” is no longer synonymous with the inventor
- Each inventor must still be named



35 U.S.C. 115

- 35 U.S.C. 115 requires for each inventor:
 - Oath/declaration executed by the inventor;
 - Substitute statement with respect to the inventor; or
 - Assignment that contains the statements required for an oath/declaration by the inventor
- Phrase “inventor’s oath/declaration” in the rules means an oath/declaration, assignment-statement, or substitute statement



Timing of Submission

- *Oath/declaration may be postponed until the application is otherwise in condition for allowance provided that a signed ADS has been submitted:*
 - *identifying each inventor by his or her legal name; and*
 - *with a mailing address and residence for each inventor*
- Oath/declaration must still be provided for a reissue application prior to examination
- Current surcharge is still required when the oath/declaration is not present on filing



Application Data Sheet

- **Required if inventor's oath/declaration not submitted with application**
- **Must identify all inventors with mailing addresses and residences**
- **Must contain foreign priority (except national stage application) or domestic benefit claims**
- **Can be signed by applicant or applicant's representative**



Forms

- <http://www.uspto.gov/forms/>
 - Oath/declaration
 - Substitute statement
 - Power of Attorney
 - Application data sheet
- No form for combination assignment-statements
- Quick reference guide for how to file an inventor's oath/declaration available on AIA micro-site
 - http://www.uspto.gov/aia_implementation/inventors-oath-or-declaration-quick-reference-guide.pdf

Preissuance Submission



35 U.S.C. 122(e)

Applicability: Pending or abandoned utility, design, and plant applications filed before, on, or after September 16, 2012; may not be filed in issued patents, *reissue applications*, or reexaminations



35 U.S.C. 122(e)

- Any third party may submit printed publications of potential relevance to the examination of an application for consideration and inclusion in the record of the application
- Must be timely made in writing and include:
 - Concise description of asserted relevance of each document;
 - Fee; and
 - Statement of compliance with statute



Printed Publications

- Submissions are limited to “printed publications”
 - See MPEP 2128 for discussion of printed publications
- Third party has burden to establish publication
- Cumulative references may be submitted



Concise Description of Relevance

- Statement of facts explaining how the document is of potential relevance to the examination of the application
- Third party should not use the concise description to:
 - propose rejections; or
 - raise arguments related to an Office action or an applicant's response



Filing of Submission

- May be submitted electronically via the Office's dedicated Web-based interface or in paper but not by facsimile
 - Guide for electronic filing available on AIA micro-site
 - <http://www.uspto.gov/patents/process/file/efs/index.jsp>
- No service on applicant required
 - *Applicant notified if subscribe to e-Office Action*
- Must be signed by submitter, but real party in interest need not be identified



Statutory Time Periods

- Must be made before the later of:
 - 6 months after the date on which the application is first published by the Office; or
 - date of first rejection of any claim by the examiner

AND

- Must be made before the date a notice of allowance is given or mailed



Filing Date

- Submission is filed as of its date of receipt by the Office
- Certificate of mailing or transmission provisions do not apply
- *Third party notified if submission is not compliant if third party provides email address with submission*



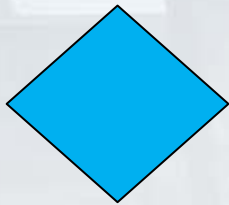
Fee

Service	Fee
Every 10 documents listed or fraction thereof	\$180 fee
First submission of 3 or fewer total documents submitted	No fee

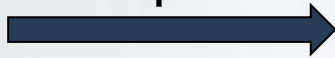


Processing

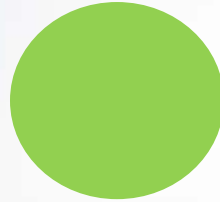
**USPTO Reviews
Submission for
Compliance with 35
U.S.C. § 122(e) and §
1.290**



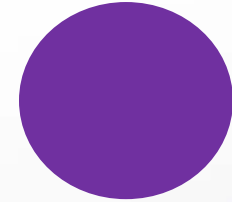
Compliant



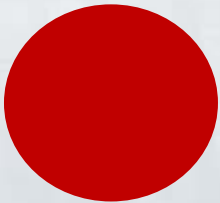
**Submission Made of
Record and
Considered by
Examiner**



**Patent Owner
Notified if E-Office
Action Participant**



Non-compliant



**Submission
Discarded**



**Third Party
Notified if
Email Address
Available**

Administrative Trials



35 U.S.C. 311-318 (Inter Partes Review)

35 U.S.C. 321-329 (Post Grant Review)

Effective Date: September 16, 2012



Features

Proceeding	Petitioner	Petitioner Estoppel	Standard	Basis
Post Grant Review (PGR)	<ul style="list-style-type: none"> Person who is not the patent owner and has not previously filed a civil action challenging the validity of a claim of the patent 	<ul style="list-style-type: none"> Raised or reasonably could have raised Applied to subsequent USPTO/district court/ITC action 	<p>More likely than not</p> <p>OR</p> <p>Novel or unsettled legal question important to other patents/applications</p>	<p>101, 102, 103, 112, double patenting but not best mode</p>
Inter Partes Review (IPR)	<ul style="list-style-type: none"> Must identify real party in interest 		<p>Reasonable likelihood</p>	<p>102 and 103 based on patents and printed publications</p>



Features (cont.)

Proceeding	Available	Applicable	Timing
Post Grant Review (PGR)	From patent grant to 9 months from patent grant or reissue	Patent issued under first-inventor-to-file	Must be completed within 12 months from institution, with 6 months good cause exception possible
Inter Partes Review (IPR)	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	Patent issued under first-to-invent or first-inventor-to-file	



Process

Petition Phase:

Third Party
Petition
Filed



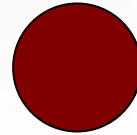
3 months

Patent Owner
Preliminary
Response



3 months

PTAB
Decision
on Petition



Trial Phase:

Patent
Owner
Response



3 months



3 months

Third Party
Reply



1 months

Patent
Owner
Reply



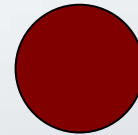
2 months

Oral
Hearing



3 months

PTAB Final
Written
Decision



No more than 12 months



Filing a Petition

- Use PRPS Electronic Filing System
 - <https://ptabtrials.uspto.gov/>
- Users must register filing any papers
 - Registration is only available for practitioners with a USPTO registration number
- Quick Start Guide available to walk through filing process
 - http://www.uspto.gov/ip/boards/bpai/prps_quick_start_guide.pdf



Page Limits: Petition, Patent Owner Preliminary Response, and Patent Owner Response

- *80 pages for PGR*
- *60 pages for IPR*
- *Claim charts included in page count, but single spacing is permitted*
- *Statement of material facts is optional*



Motion to Amend

- *Authorization is not required to file the initial motion to amend, but conferring with the Board is required*
- **May cancel any challenged claim and/or propose a reasonable number of substitute claims**
- *Additional motion may be authorized for good cause, e.g., where supplemental information is belatedly submitted*



Types of Discovery

- *Parties may agree to discovery between themselves*
- Discovery divided into 3 types:
 - *mandatory initial disclosures;*
 - routine; and
 - discretionary



Scope of Discovery

- Routine discovery:
 - Cited documents;
 - Cross-examination for submitted testimony; and
 - *Information inconsistent with positions advanced during the proceeding*
- Discretionary discovery by request upon a showing of:
 - PGR: Good cause
 - IPR: Interests of justice



Supplemental Information

- *Request for the authorization to file a motion to submit supplemental information must be made within one month after institution*
- *Must be relevant to a claim for which the trial has been instituted*
- *Any supplemental information filed later than one month after institution must show why the supplemental information reasonably could not have been obtained earlier and that consideration of the information would be in the interests-of-justice*



Settlement

- Terminates the proceeding with respect to the petitioner
- Board may terminate the proceeding or issue a final written decision



Final Decision and Request for Rehearing

- Board will issue a final written decision that addresses the patentability of any claim for which a trial is instituted and any new claim added
- *Request for rehearing possible:*
 - *14 days of the entry of a non-final decision or a decision to institute a trial; or*
 - *within 30 days of the entry of a final decision or a decision not to institute a trial*
- Party dissatisfied with the final written decision may appeal to the Federal Circuit



Patent Owner Estoppel

- *Patent owner is precluded from taking any action inconsistent with an adverse judgment, including:*
 - *Obtaining a claim in any patent that is patentably indistinct from a finally refused or canceled claim; or*
 - *Making an amendment to the specification or a drawing that was denied during the trial, but this provision does not apply to an application or patent that has a different written description*



Post Grant Review Fees

Service	Fee
Petition challenging 20 or fewer claims	\$ 35,000
Additional claims challenged in excess of 20	\$800 per claim



Inter Partes Review Fees

Service	Fee
Petition challenging 20 or fewer claims	\$ 27,200
Additional claims challenged in excess of 20	\$600 per claim



AIA Help

- 1-855-HELP-AIA (1-855-435-7242)
- HELPAIA@uspto.gov
- www.uspto.gov/AmericaInventsAct
 - FAQs
 - Videos
 - Reference guide for final rules

Questions?



Thank You



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Appendix

- **Changes to Implement the Inventor's Oath or Declaration Provisions of the Leahy-Smith America Invents Act: Final Rule, 77 Fed. Reg. 48776 (August, 14, 2012)**
- **Changes to Implement Supplemental Examination Provisions of the Leahy-Smith America Invents Act: Final Rule, 77 Fed. Reg. 48828 (August 14, 2012)**
- **Changes to Implement the Preissuance Submissions by Third Party Provisions of the Leahy-Smith America Invents Act: Final Rule, 77 Fed. Reg. 42150 (July 17, 2012)**
- **Changes to Implement Miscellaneous Post Patent Provisions of the Leahy-Smith America Invents Act: Final Rule, 77 Fed. Reg. 46615 (August 6, 2012)**



Appendix (cont.)

- **General Administrative Trial Final Rules, 77 Fed. Reg. 48612 (August 14, 2012)**
- **Trial Practice Guide, 77 Fed. Reg. 48756 (August 14, 2012)**
- **Inter Partes, Post Grant, and Covered Business Method Review Final Rules, 77 Fed. Reg. 48680 (August 14, 2012)**
- **Covered Business Method and Technological Invention Definitions Final Rules, 77 Fed. Reg. 48734 (August 14, 2012)**