

The America Invents Act: Best Practices and Pitfalls for Newly-Effective Provisions

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Janet Gongola

Patent Reform Coordinator

Janet.Gongola@uspto.gov

Direct dial: 517-272-8734



AIA Report Card

(Effective September 16, 2012)

Patent Related

- Inventor's oath / declaration
- Preissuance submission
- Supplemental examination
- Citation of patent owner claim scope statements

Administrative Trials

- Inter partes review
- Post grant review
- Covered business method review



Inventor's Oath/Declaration: Best Practices

- **Submit a signed Application Data Sheet (ADS) for every application**
- **Present domestic benefit claims and foreign priority claims (except for national stage applications) in an ADS**
- **Re-execute a new oath/declaration in a child application filed after September 16, 2012**
- **Submit combination assignment-statement on the same day to avoid a surcharge**



Inventor's Oath/Declaration: Pitfalls to Avoid

- Do not use the new inventor declaration form in an application entering the national stage on or after September 16, 2012, where the PCT application was filed prior to September 16, 2012
- Do not submit papers signed by a juristic entity
- Do not make substantive changes to the application that would constitute new matter after the inventor's oath or declaration has been executed



Inventor's Oath/Declaration: 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: Statistics

(Data as of October 23, 2012)

| Status | Number |
|------------------|------------|
| Proper | 64 |
| Improper | 35 |
| Not Yet Reviewed | 6 |
| TOTAL | 105 |

| Printed Publication | Number |
|-----------------------------------|------------|
| Patent | 146 |
| Published U.S. Patent Application | 48 |
| Foreign Patents | 36 |
| Non-patent literature | 143 |
| TOTAL | 377 |



Preissuance Submissions: Best Practices

- File electronically via the third-party submissions interface in EFS-Web
- Check for timeliness before filing
- List each printed publication for consideration separately
- Provide a complete citation for each printed publication listed
- Concise description of relevancy must explain factually how printed publication is of potential relevance to the examination of the application



Preissuance Submission: Concise Description of Relevance Example

Compliant

Publication X and Publication Y both disclose machines that perform the same function as the machine recited in claim 1.

In the first embodiment depicted in Figure 2 and discussed on page 5, the machine of publication X expressly includes element A of claim 1. See lines 7-14 on page 5 of publication X.

Publication Y teaches a machine having element B of claim 1. See lines 1-3 on page 6 of publication Y.

Non-compliant

Same with the following concluding sentence:

Accordingly, claim 1 is obvious in view of the combination of Publication X and Publication Y.



Preissuance Submissions: Pitfalls to Avoid

- Do not file a preissuance submission in a provisional or reissue application, issued patent, or reexamination proceeding
- Do not submit documents which have not been published
- Do not submit follow-on papers via the preissuance submission interface in EFS-Web
- Do not forget fee to resubmit a submission after receiving a non-compliance notification



Administrative Trial Statistics

(Data as of October 23, 2012)

- Administrative trials = 50 petitions
 - 37 inter partes review
 - 13 covered business method
 - No preliminary patent owner responses
- 75% electrical; 25% chemical/biotech/mechanical
- Majority of challenged patents are currently or previously subject to district court litigation



Administrative Trials: Filing a Petition

- Use PRPS Electronic Filing System
 - <https://ptabtrials.uspto.gov/>
- Users must register before 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



Administrative Trials: Best Practices for Petitions

- **Avoid redundancy**
 - Same claim subject to multiple attacks
 - Attacks lack differentiation
- **Present complete analysis per claim per ground to show how requisite standard is met**



Administrative Trials: Pitfalls to Avoid for Petitions

- Do not mismatch exhibit numbers with exhibit list
- Do not improperly mark exhibits
 - Petitioner: 1000-1999
 - Patent owner: 2000-2999



Motion for Pro Hac Vice Admission: Timing

- *Motorola Mobility LLC v. Arnouse*, Case IPR 2013-00010 (MPT); Patent 7,516,484, Paper 6, October 15, 2012 (expanded PTAB panel)
- File no sooner than 21 days after service of the petition; opposition due no later than one week after opening motion



Motion for Pro Hac Vice Admission: Contents

- **Statement of facts showing there is good cause for admission**
- **Affidavit or declaration of the individual seeking to appear attesting to:**
 - Good standing membership of at least 1 state bar
 - No suspensions or disbarments
 - No application to appear before any court to administrative tribunal ever denied
 - No sanctions or contempt citations
- **Agreement to comply with the Patent Trial Practice Guide and Rules of Practice for Trials**
- **Recognition of being subject to USPTO Code of Professional Conduct**
- **Familiarity with subject matter of proceeding**



AIA Help

- 1-855-HELP-AIA (1-855-435-7242)
- HELPAIA@uspto.gov
- www.uspto.gov/AmericaInventsAct



Ongoing Rulemakings

- **First-inventor-to-file**
 - Comments due November 5, 2012
 - fitf_rules@uspto.gov
 - fitf_guidance@uspto.gov
- **Patent service fees**
 - Comments due November 5, 2012
 - fee.setting@uspto.gov

Thank You



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