

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

November 2, 2012



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: 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



Inventor's Oath/Declaration: 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



Inventor's Oath/Declaration: Timing of Submission

- Oath/declaration may be postponed until the application is otherwise in condition for allowance provided that a signed Application Data Sheet (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



Inventor's Oath/Declaration: Best Practices

- Submit a signed ADS for every application
 - Identity inventors and assignee (if applicable)
 - 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: 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



Preissuance Submission: Statutory Timing

- 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



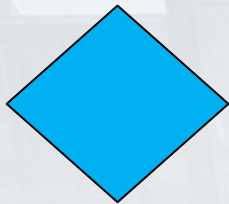
Preissuance Submission: Fee

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



Preissuance Submission: Processing

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



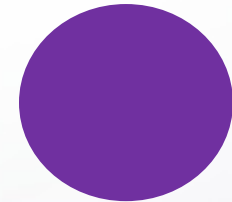
Compliant



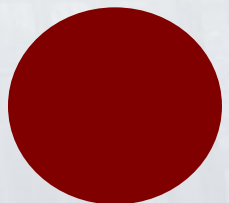
**Submission Made of
Record and
Considered by
Examiner**



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



Non-compliant



**Submission
Discarded**



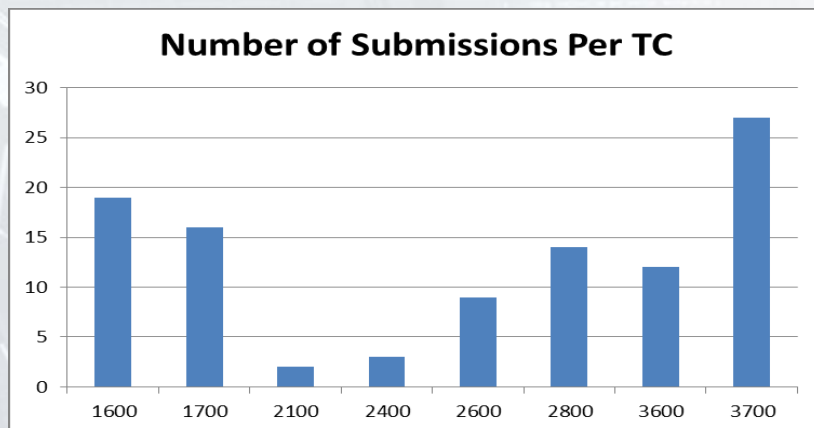
**Third Party
Notified if
Email Address
Available**



Preissuance Submission: Statistics

(Data as of October 31, 2012)

Status	Number
Proper	73
Improper	39
Not Yet Reviewed	13
TOTAL	125



Printed Publication	Number
Patent	160
Published U.S. Patent Application	52
Foreign Reference	41
Non-patent literature	174
TOTAL	427



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



Supplemental Examination: 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
- 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



Supplemental Examination: Fee

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



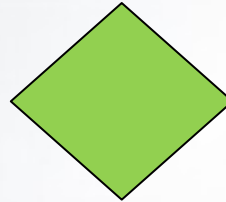
Supplemental Examination: Processing

Patent Owner
Request



3 months

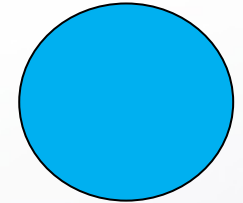
Decision on Patent Owner
Request: Substantial New
Question of Patentability
Standard Triggered?



YES



Supplemental
Examination Concluded
and Ex Parte
Reexamination Initiated



NO



Supplemental
Examination
Concluded



Supplemental Examination: Statistics (Data as of October 31, 2012)

- Requests = 3 submissions



Administrative Trials: 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>



Administrative Trials: Features (cont.)

Proceeding	Available	Applicable	Timing	Fees
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	\$35,000 for 20 or fewer claims; \$800 for each additional claim
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		\$27,200 for 20 or fewer claims; \$600 for each additional claim



Administrative Trials: Process

Petition Phase:

Third Party
Petition
Filed



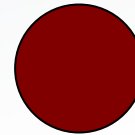
3 months

Patent Owner
Preliminary
Response



3 months

PTAB
Decision
on Petition



Trial Phase:

Patent Owner
Response/
Claim
Amendments



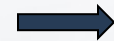
3 months

Third Party
Reply



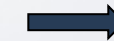
1 months

Patent
Owner
Reply



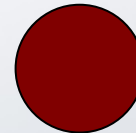
2 months;
Motions to
exclude
evidence

Oral
Hearing



3 months

PTAB Final
Written
Decision



Scheduling conference
at 1 month;
3 months

Sequenced discovery;
No more than 12 months



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 Trial: Statistics

(Data as of October 31, 2012)

- Administrative trials = 52 petitions
 - 39 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: Best Practices for Petitions

- Avoid redundancy
- 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



Janet Gongola

Patent Reform Coordinator

Janet.Gongola@uspto.gov

Direct dial: 517-272-8734