

The America Invents Act: Modernization of U.S. Patent Law

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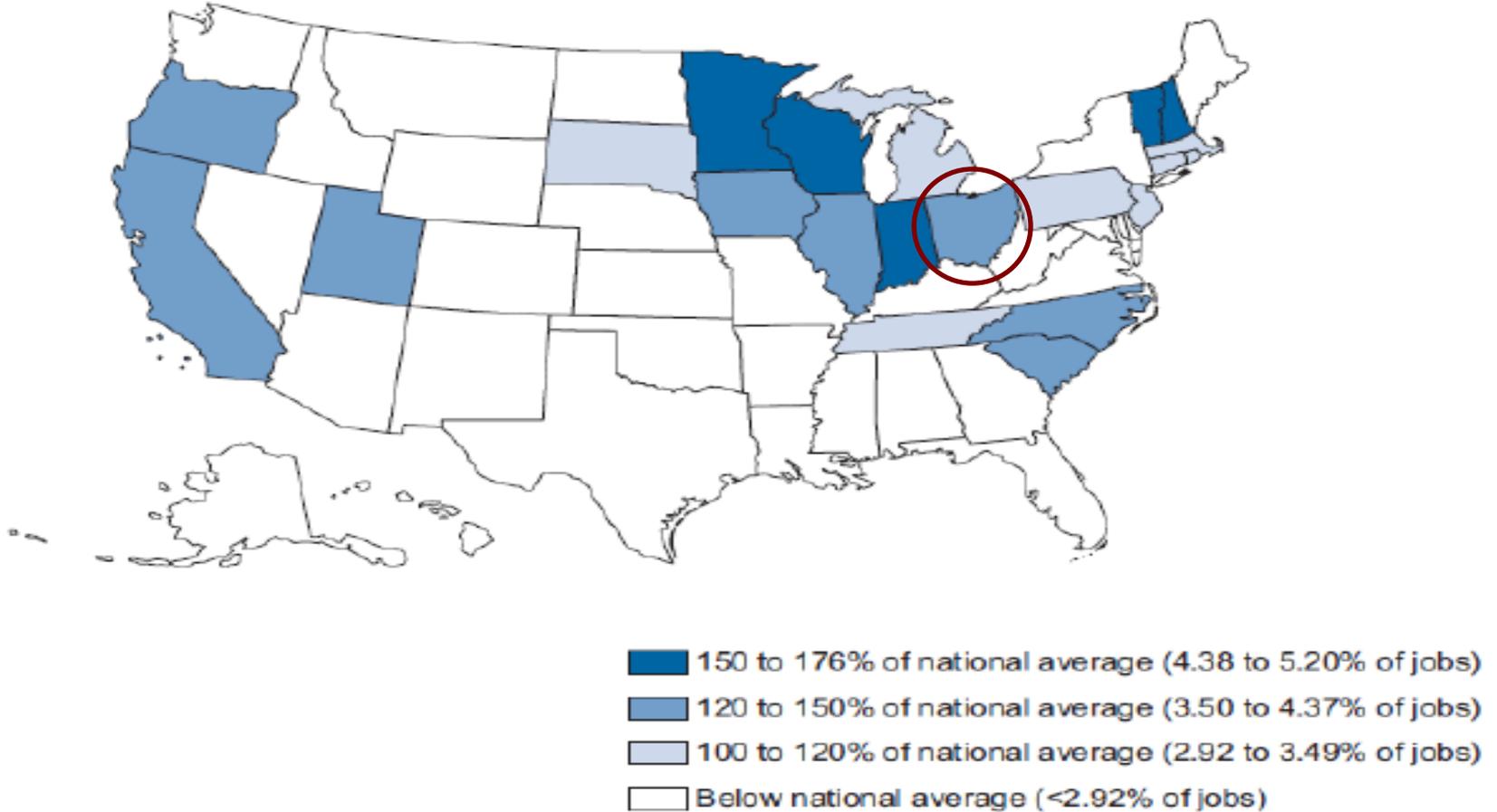
Intellectual Property and the Economy: Industries in Focus

(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.



Overview

- First-inventor-to-file
- Preissuance submissions
- Prior User Rights Defense
- Inventor Assistance

First-Inventor-to-File



Effective March 16, 2013



First-to-invent v. First-inventor-to-file

- Under first-inventor-to-file, priority of invention is awarded to the first inventor to file a patent application in the USPTO
- Under current first-to-invent, priority of invention is awarded to the first entity to invent, regardless of patent application filing date



Example 1

April 2013	May 2013	June 2013	July 2013
A invents	B invents	B files	A files

- Pre-AIA: A gets the patent
- AIA: B gets the patent



First-inventor-to-file Framework

- Establishes framework for determining novelty (35 U.S.C. 102) and obviousness (35 U.S.C. 103) of a claimed invention:
 - Sets forth what constitutes prior art
 - Creates exceptions to prior art (e.g., grace period)



First-inventor-to-file Characteristics

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



35 U.S.C. 102 (a)(1) & (b)(1): Prior Art and Exceptions Under Grace Period

Provision	Function	Language
102(a)(1)	<ul style="list-style-type: none"> Creates prior art 	Invention publicly disclosed before the effective filing date of the claimed invention via: <ul style="list-style-type: none"> Patent Printed Publication Sale—anywhere in the world Public Use—anywhere in the world Otherwise available to the public
102(b)(1)	<ul style="list-style-type: none"> Gives 2 exceptions prior art 	Not prior art if the invention was publicly disclosed one year or less before the effective filing date of the claimed invention by (i) inventor; (ii) joint inventor; or (iii) by another who obtained the subject matter directly or indirectly from either the inventor or joint inventor (collectively INVENTOR); or Not prior art if INVENTOR disclosed the subject matter before third party's public disclosure and INVENTOR'S disclosure was one year or less before the effective filing date of the claimed invention



35 U.S.C. 102 (a)(1) & (b)(1): Prior Art and Exceptions Under Grace Period

Provision	Function	Language
102(a)(1)	<ul style="list-style-type: none"> Creates prior art 	Invention publicly disclosed before the effective filing date of the claimed invention <ul style="list-style-type: none"> Patent Public Otherwise available
102(b)(1)	<ul style="list-style-type: none"> Gives 2 exceptions prior art 	Not published in a printed publication <ul style="list-style-type: none"> (i) invention was disclosed by the inventor or joint inventor, or another person who obtained the invention from the inventor or joint inventor, or from both of them, before the effective filing date of the claimed invention, and (ii) the invention was disclosed by the inventor or joint inventor, or another person who obtained the invention from the inventor or joint inventor, or from both of them, before the effective filing date of the claimed invention, and the disclosure occurred in the United States or abroad no more than one year before the effective filing date of the claimed invention.

Public Disclosure of Invention

Disclosure by Inventor in Grace Period

Disclosure by Inventor in Grace Period Before Third Party Disclosure



Example 2

		A's Grace Period		
April 2013	June 2013	July 2013 to June 2014		July 2014
A invents		A publishes		A files

- A gets the patent



Example 3

		A's Grace Period		
April 2013	June 15, 2013	July 2013 to June 2014		July 2014
A invents X	B invents X	A publishes on X	B publishes on X	A files on X

- A gets the patent



Example 4

		A's Grace Period		
April 2013	June 15, 2013	July 2013 to June 2014		July 2014
A invents X	B invents X	A publishes on X	B publishes on X + Y	A files on X

- A might get the patent; B's publication of Y is prior art, which might render A's claim to X obvious



35 U.S.C. 102 (a)(2) & (b)(2): Prior Art and Other Exceptions

Provision	Function	Language
102(a)(2)	<ul style="list-style-type: none">Creates prior art	Invention was effectively filed by third party before the effective filing date of the claimed invention by inventor: <ul style="list-style-type: none">U.S. PatentsU.S. Patent Application PublicationsWIPO Publications
102(b)(2)	<ul style="list-style-type: none">Gives 3 exceptions prior art	Not prior art if earlier disclosure made by third party who obtained the subject matter directly or indirectly from either the inventor or joint inventor Not prior art if INVENTOR disclosed the subject matter before another effective filing date Not prior art if subject matter disclosed by a third party and the claimed invention were commonly owned or subject to an obligation of assignment to the same person not later than the effective filing date of the claimed invention



35 U.S.C. 102 (a)(2) & (b)(2): Prior Art and Other Exceptions

Provision	Function	Language
102(a)(2)	<ul style="list-style-type: none"> Creates prior art 	<p>Invention was effectively first disclosed to a third party before the effective filing date of the claimed invention:</p> <ul style="list-style-type: none"> Non-public Disclosure (Application Filing) That Becomes Public WIPO
102(b)(2)	<ul style="list-style-type: none"> Gives 3 exceptions prior art 	<p>made by third party who directly or indirectly from either the</p> <p>Not prior art if another effective filing date of the claimed invention</p> <p>Not prior art if subject matter disclosed by a third party and the claimed invention were commonly owned by the inventor or joint inventor as of the effective filing date of the claimed invention</p> <ul style="list-style-type: none"> Non-Public Disclosure = Inventor's Work Inventor's Disclosure Before Non-Public Disclosure Non-Public Disclosure Commonly Owned



Example 5

April 2013	May 2013	June 2013	July 2013
A invents	B invents	B files	A files

- A gets the patent if A shows that the subject matter disclosed by B was obtained from A



Example 6

April 2013	May 2013	June 2013	July 2013	August 2013
A invents	B invents	A publishes on X	B files on X	A files on X

- A gets the patent



Example 7

April 2013	May 2013	June 2013	July 2013	August 2013
A invents	B invents	A publishes on X	B files on X + Y	A files on X

- A might get the patent; B's publication of Y is prior art, which might render A's claim to X obvious



Example 8

April 2013	May 2013	June 2013	August 2013
A invents and assigns to Smith Company	B invents and assigns to Smith Company	B files	A files

- A gets the patent since A and B assigned to the same company before A filed



Applicability of New 102

- AIA 35 U.S.C. 102 and 103 will apply to an application or patent that contains or contained at any time:
 - a claim having an effective filing date that is on or after March 16, 2013; or
 - a benefit claim under 35 U.S.C. 120 (continuation), 121 (divisional), or 365(c) (U.S. national or international) to an application that contains or contained at any time a claim having an effective filing date on or after March 16, 2013



Applicability of Old and New 102 and 103

- Pre-AIA 35 U.S.C. 102(g) and AIA 35 U.S.C. 102 and 103 will apply to an application that contains, or contained at any time:
 - a claim having an effective filing date before March 16, 2013, and
 - a claim having an effective filing date that is on or after March 16, 2013



Example 9

	Parent application filed before 3/16/2013	Child application filed after 3/16/2013 claiming benefit to parent
Specification includes	A, B, and C	A, B, C, and D
Claims require	Not relevant	Claim 1: A-C

- Child application is subject to pre-AIA prior art provisions because Claim 1 is supported in the parent application which was filed before 3/16/2013



Example 10

	Parent application filed before 3/16/2013	Child application filed after 3/16/2013 claiming benefit to parent
Specification includes	A, B, and C	A, B, C, and D
Claims require	Not relevant	Claim 1: A - C Claim 2: A - D

- Child application is subject to pre-AIA and AIA prior art provisions because:
 - Claim 1 has an effective filing date before 3/16/2013
 - Claim 2 requires D which is only supported in an application filed after 3/16/2013

Preissuance Submission



Effective September 16, 2012

Applies to any pending or abandoned utility, plant, or design application pending on or after September 16, 2012



Requirements

- 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”

Printed Publication Examples	NOT Printed Publications
U.S. or foreign patent	Confidential internal memo
U.S. or foreign patent application publication	Court document subject to protective order
Non-patent literature --journal article --Office action	



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



Timing Example



* Third-party submission must be filed before this date



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



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.



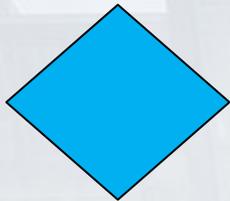
Fee

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



Office Processing

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



Compliant



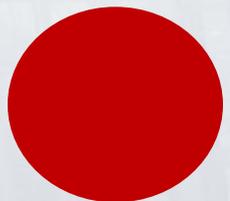
**Submission Made of
Record and
Considered by
Examiner**



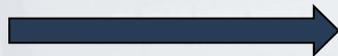
**Patent Owner
Notified if E-Office
Action Participant**



Non-compliant



**Submission
Discarded**



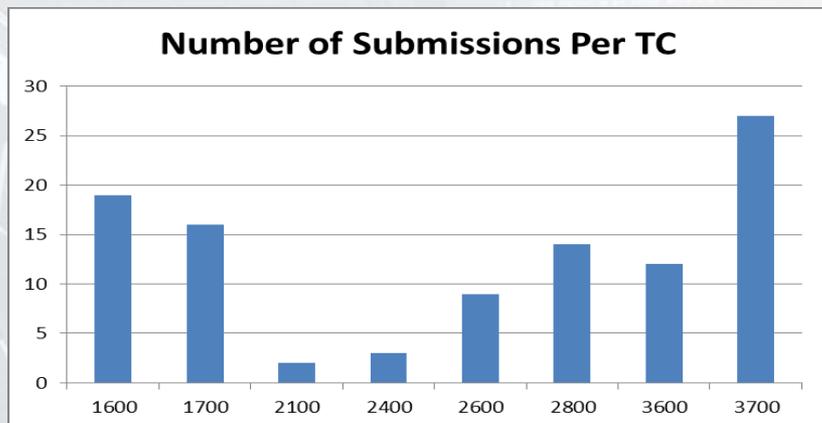
**Third Party
Notified if
Email Address
Available**



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

Prior User Rights



Effective September 16, 2011



Prior User Rights Defense

- Provides a defense to infringement for an accused infringer who engages in internal commercial use or sale of claimed invention at least 1 year before the earlier of:
 - (i) the effective filing date; or
 - (ii) inventor's disclosure
- Timing designed to preclude “Johnny-come-lately’s” from hurrying into commercial use or of invention
- Personal to commercial user or seller and cannot be transferred, except with sale of entire business

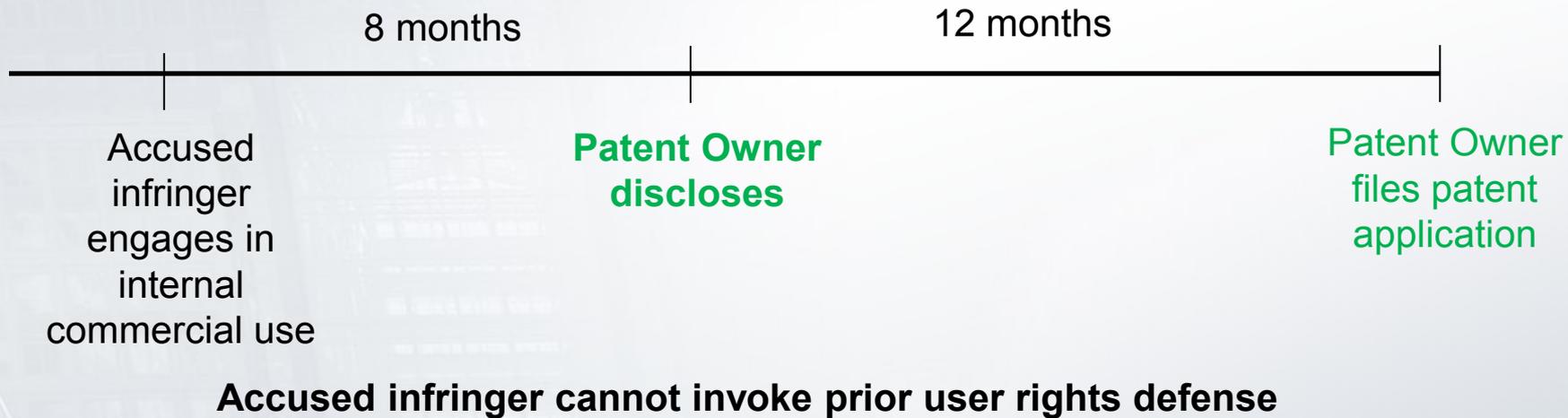


Prior User Rights Defense

- Covers all technologies
 - Expansion from pre-AIA law that only covered business methods
- Accused infringer asserting must prove prior use or sale with clear and convincing evidence
- Cannot be asserted against patents owned by a university
- Sanctions against accused infringer who asserts the defense without a “reasonable” basis for doing so



Timing Example





Pro Bono Program

- Assists financially under-resourced independent inventors and small businesses in filing and prosecuting patent applications before USPTO
- 2 programs operational (Minnesota; Colorado)
- Contact Office of Innovation Development:
 - <http://www.uspto.gov/inventors/index.jsp>
 - Telephone: 571-272-8877
 - Email: independentinventor@uspto.gov

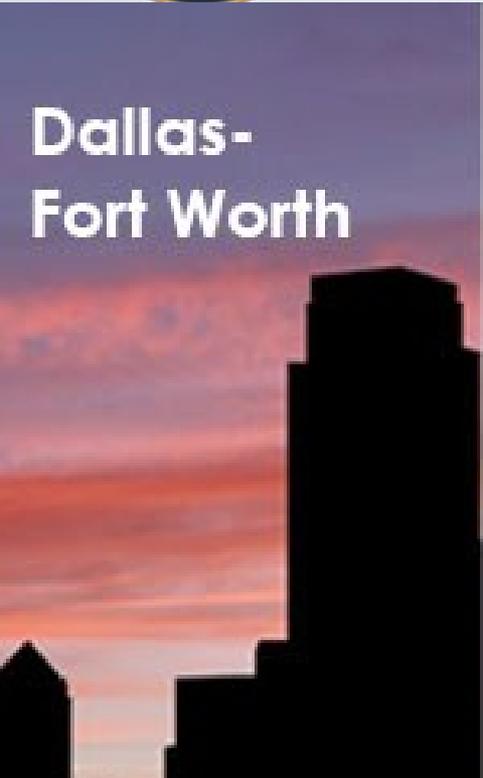


Patent Ombudsman Program

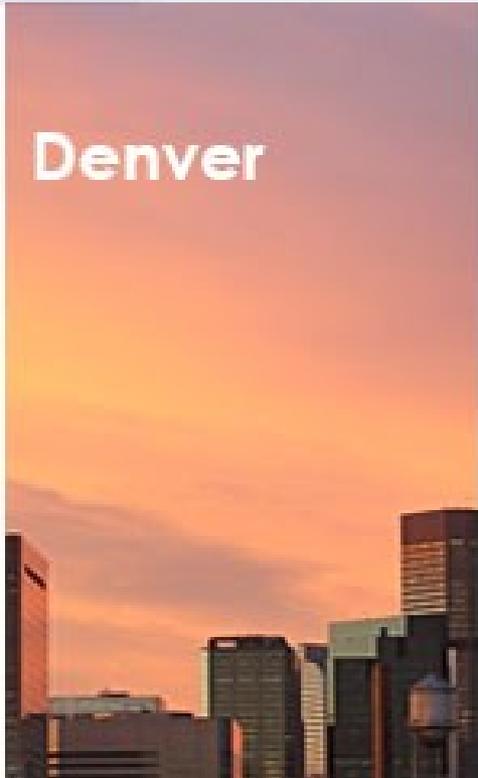
- Assist all patent applicants and attorneys when application stalled in prosecution
- Not intended to supersede the authority of the examiners or Supervisory Patent Examiners
- Contact Patent Ombudsman:
 - <http://www.uspto.gov/patents/ombudsman.jsp>
 - Telephone: 571-272-5555 or 855-559-8589
 - Email: ombudsmanprogram@uspto.gov



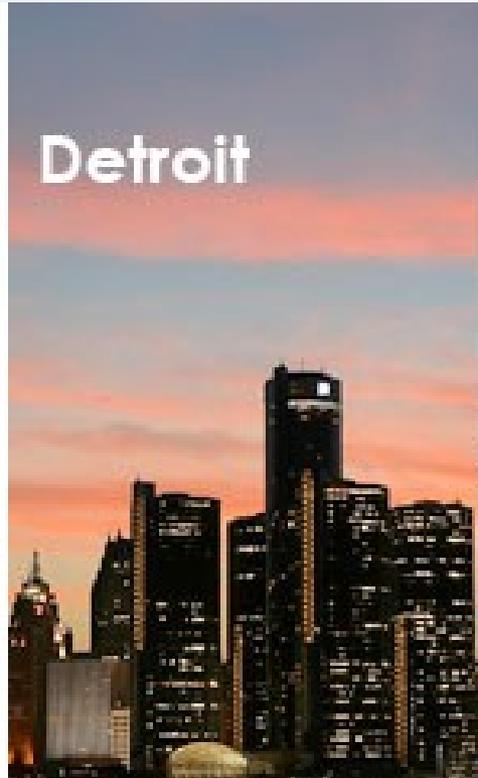
Satellite Offices



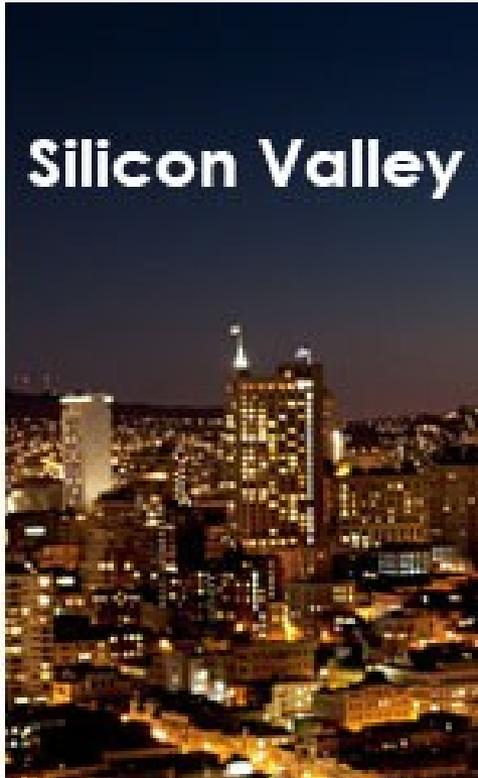
Dallas-Fort Worth



Denver

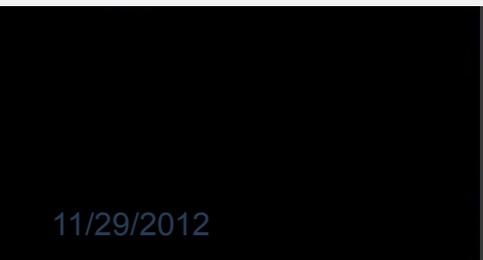


Detroit



Silicon Valley

● historic expansion ● regional job growth ● an innovation ecosystem ● concepts of operation





AIA Help

- 1-855-HELP-AIA (1-855-435-7242)
- HELPAIA@uspto.gov
- www.uspto.gov/AmericaInventsAct
 - Explanation of provisions
 - Frequently Asked Questions
 - Videos

Thank You



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