



AIA (FITF) Indicator Training For Examiners



AIA (FITF) Indicator Status is Critical for Examination

- AIA (FITF) indicator status identifies which prior art framework will be applied to the application during examination (i.e., pre-AIA or AIA law)
- Correct AIA (FITF) indicator status is necessary for OACS to display the proper form paragraphs

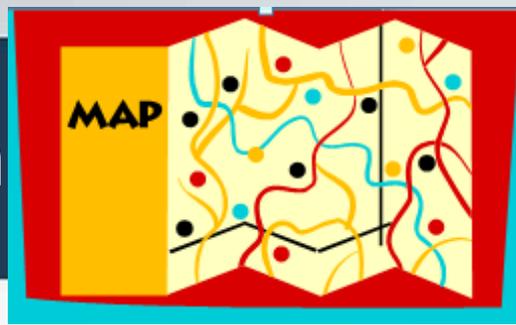


AIA (FITF) Indicator Status: TC AIA Specialist & Examiner Roles

- TC AIA Specialist is responsible for updating the AIA (FITF) indicator status when necessary
 - TC Specialists are trained to determine the correct status and how to change the status if needed (e.g. to correct errors in status).
- Examiners should be aware:
 - The AIA indicator status of an application can change over time. This should be a rare occurrence.
 - If an examiner has a question about the indicator status of a particular application, or observes an inconsistency in the indicator status, the examiner should consult a TC AIA Specialist.



Topics for Discussion



- Review of the AIA (FITF) Indicator (“AIA Indicator”) in eDAN and PALM
- Determining AIA (First Inventor to File) Status
- Situations Where the AIA Indicator May Need to be Updated



Identification of an AIA (FITF) Application in eDAN and PALM

- Look in PALM (Application Number Information page) or eDAN (application or docket view) for one of these AIA indicators:
 - "AIA (FITF)" or
"AIA (First Inventor to File)"
 - "YES" = AIA application
 - "NO" = pre-AIA application
- Software will set the status of the AIA indicators in the eDAN and PALM records before an application is placed on an examiner's docket.



AIA Indicator in eDAN Docket View

Docket Management: Joe Examiner 01/31/2013 10:28:27 - Regular New - 28 days

Refresh Last Refreshed: 01/30/2013 16:26:28

Regular New (19) Amendments (1) Continuing New (4) Spl Prgms New (1) Spl Law New (0) Expedited (0) Special Am

Oldest New = 12/PPPPP Multiplier Days = 28 Ceiling Days = 56

	Categor...	App #	AIA (FITF)	Filing D...	FAOM	INTER	ALW ...	ABN ...	Oldes...	St...	Class	Subcl...	Class/Su...	Title
1	Regular	12/xxxx,xxx	No	02/03/2009	1.25	1.5	2.0	0.75		30	715	255.000	715/255.000	Widget
2	Regular	12/zzz,zzz	No	01/31/2009	1.25	1.5	2.0	0.75		30	715	234.000	715/234.000	Widget
3	Regular	12/yyy,yyy	No	01/31/2009	1.25	1.5	2.0	0.75		30	715	229.000	715/229.000	Widget
4	Regular	13/bbb,bbb	Yes	04/23/2013	1.25	1.5	2.0	0.75		30	715	205.000	715/205.000	Widget



AIA Indicator in eDAN Application View

TOC - 12/xxx,xxx - AI Lowance - Fiber Optic Mouse Trap

App. # 12/xxx,xxx Close App Refresh Refreshed: 02/11/2013 13:04:51

Hide Details... **AIA (First Inventor To File): No** Show: Active

Inventor: Bill Johnson Examiner: AI Lowance
Filing Date: 12/01/2009 Class/ subclass: 370/390.000

PROSECUTION (21) Incoming (10) Outgoing (6) IDS (1) Fees Petitions Bib Annotate (4) All (21) Messages (0)

	Img	Status	Doc Code	Document Type	Date	P...	Annotations
1			7 SPEC	Specification	12/01/2009	39	
2			7 CLM	Claims	12/01/2009	6	
3			7 ABST	Abstract	12/01/2009	1	
4			7 NTC.PUB	Notice of Publication	09/30/2010	1	
5			7 PD.FILED.E	Priority Documents electronically retrieved by USPTO from a participati...	02/09/2010	41	
6			7 APP.FILE.REC	Filing Receipt	01/25/2010	3	
7			7 PEFR	Applicant Response to Pre-Exam Formalities Notice	01/14/2010	1	
8			7 OATH	Oath or Declaration filed	01/14/2010	3	
9			7 WFEE	Fee Worksheet (PTO-06)	01/14/2010	2	
10			7 N417	Status Letter Mailed to Applicant	01/14/2010	2	
11			7 NTC.MISS.PRT	Notice to File Missing Parts	12/17/2009	2	



AIA Indicator in PALM Application Number Information Page

Application Number Information

Application Number: 13/xxxx,xxx [Assignments](#)

Filing or 371(c) Date: 06/26/2013 [eDan](#)

Effective Date: 05/02/2013

Application Received: 05/02/2013

Pat. Num./Pub. Num.: / xxxxx/xxxxxxxxxx

Issue Date: 00/00/0000

Date of Abandonment: 00/00/0000

Attorney Docket Number: ABCDEF

Status: 30 /DOCKETED NEW CASE - READY FOR EXAMINATION

Confirmation Number:

Title of Invention: **Widget with Gears**

AIA (First Inventor to File): **Yes**

Examiner Number: 100,000 - Sam Smith

Group Art Unit: 3700

Class/Subclass: 555/333

Lost Case: NO

Interference Number:

Unmatched Petition: NO

[L&R Code](#): Secrecy Code:1

Third Level Review: NO

Oral Hearing: NO

IFW Madras

Waiting for Response Desc.

[Prior Art Filed](#)

[Prior Art Filed](#)

Secrecy Order: NO

Status Date: 12/26/2013

Bar Code	PALM Location	Location Date	Charge to Loc	Charge to Name	Employee Name
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Appln Info

Contents

Petition Info

Atty/Agent Info

Continuity Data

Foreign Data

Inventors

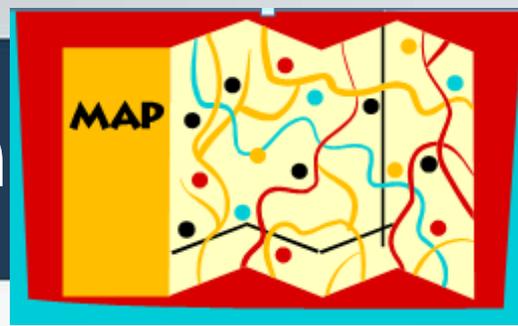
Address

Fees

Post Info



Topics for Discussion



- Review of the AIA (FITF) Indicator (“AIA Indicator”) in eDAN and PALM
- **Determining AIA (First Inventor to File) Status**
- Situations Where the AIA Indicator May Need to be Updated



Determining AIA (First Inventor to File) Status

- The First Inventor to File (FITF) provisions of the AIA, which became effective on March 16, 2013:
 - DO NOT apply to applications **filed before** March 16, 2013 (these applications are always pre-AIA (First to Invent or FTI) applications); and
 - Apply to certain applications **filed on or after** March 16, 2013.

Note: The U.S. filing date of 371 national stage applications is the international filing date, not the 371(c) date.



Determining AIA (First Inventor to File) Status (cont.)

- An application, **filed on or after** March 16, 2013, is an AIA (FITF) application if:
 - the application contains or ever contained a claim to an invention that has an effective filing date that is on or after March 16, 2013 (even if all such claims have now been cancelled);
- OR**
- the application is ever a CON, CIP, or DIV of an earlier application that contained at any time a claim having an effective filing date that is on or after March 16, 2013 (even if the domestic benefit claim is later deleted).



Determining AIA (First Inventor to File) Status (Cont.)

- The AIA definition of “effective filing date” (EFD) in 35 U.S.C. 100(i), which takes foreign priority into account, is used to determine whether any application, filed on or after March 16, 2013, is an AIA (FITF) or a pre-AIA (FTI) application.
- If an application filed on or after March 16, 2013 is determined to be a pre-AIA application, the pre-AIA definition of EFD, which does not take foreign priority into account, is used for examination.



Determining AIA (First Inventor to File) Status (Cont.)

- What does “contains or ever contained a claim” with an effective filing date on or after March 16, 2013 mean?
 - An application is considered to contain or to have ever contained such a claim if there is at least one claim having an effective filing date on or after March 16, 2013, that is:
 - ◇ pending and under consideration, **or**
 - ◇ withdrawn, **or**
 - ◇ now cancelled.
 - Claims presented but not entered do not affect the AIA indicator status of an application.



Determining AIA (First Inventor to File) Status (Cont.)

- What does “contains or ever contained a claim” with an effective filing date on or after March 16, 2013 mean? (cont.)
 - An application is considered NOT to contain or to have ever contained such a claim if all claims entered have an effective filing date before March 16, 2013.
 - Note: A claim with an effective filing date on or after March 16, 2013 that is cancelled on the same day that it is filed is considered to have not ever been presented. This is consistent with previous practice.
- A claim that comprises new matter, filed on or after March 16, 2013 in a pre-AIA application, will not change the status from pre-AIA to AIA, regardless of the filing date of the application.



AIA and pre-AIA 35 U.S.C. 102(g): It Will Be RARE

- An application filed on or after March 16, 2013 will be either an AIA application or a pre-AIA application, but not both.
 - However, in rare circumstances, all claims in an AIA application may also be subject to pre-AIA 35 U.S.C. 102(g) (for an interference proceeding or an *ex parte* rejection) if the AIA application:
 - contains or ever contained a claim with an effective filing date before March 16, 2013;
- or**
- claims or ever claimed domestic benefit to an application containing at any time such a claim



Application Types Used to Determine When AIA (FITF) Applies



**“pure” pre-AIA
(First to Invent)
application**

Filed **before** 3/16/2013



**transition
application**

Filed **on or after** 3/16/2013
and
AT LEAST ONE foreign
priority or domestic benefit
claim to an appln filed
before 3/16/2013



**“pure” AIA
(First Inventor
to File)
application**

Filed **on or after** 3/16/2013
and
ALL foreign priority or
domestic benefit claims, if any,
are to an appln filed
on or after 3/16/2013



Alternative Illustration of the Application Types Used to Determine When AIA (FITF) Applies

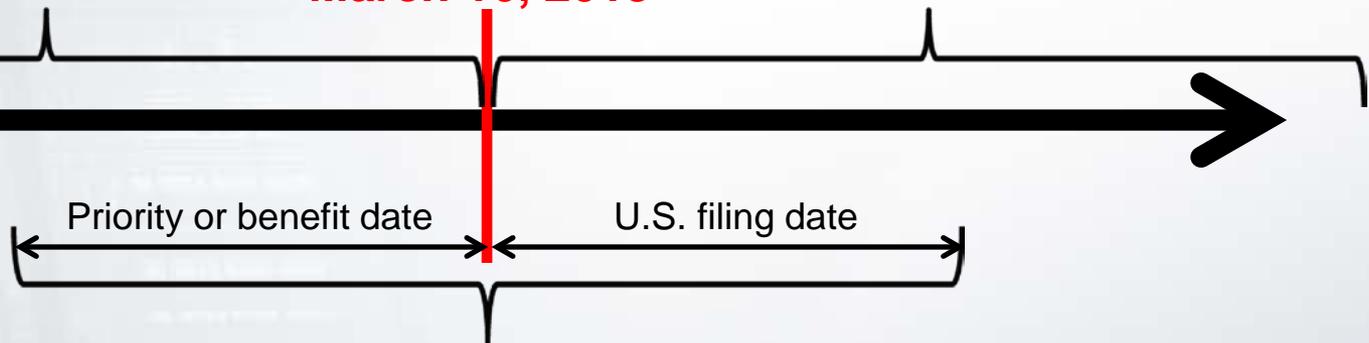
“PURE”
PRE-AIA (FIRST TO INVENT)
APPLICATION

U.S. filing date
before March 16, 2013

“PURE”
AIA (FIRST INVENTOR TO FILE) APPLICATION

U.S. filing date
on or after March 16, 2013
and **ALL**
foreign priority or domestic benefit claims
(if present) to an application filed
on or after March 16, 2013

March 16, 2013



TRANSITION APPLICATION

U.S. filing date on or after March 16, 2013
AND
AT LEAST ONE
foreign priority or domestic benefit claim
to an application filed
before March 16, 2013



Transition Applications

- “**Transition Applications**” = Nonprovisional applications that are:
 - i. filed on or after March 16, 2013; ***and***
 - ii. claim foreign priority to, or domestic benefit of, an application filed before March 16, 2013.
- Transition applications may be either pre-AIA applications or AIA applications depending on the effective filing date of the claims in the application.



Transition Applications May Contain a 1.55/1.78 Statement

- If applicant files a statement under 37 CFR 1.55 or 1.78 (“**the 1.55/1.78 statement**”) in a transition application indicating that the application contains or ever contained a claim to an invention having an effective filing date on or after March 16, 2013, the software will set the AIA indicator to YES before examination.
 - Rule 55 relates to foreign priority claims
 - Rule 78 relates to domestic benefit claims
- A 1.78 statement in a child transition application is not needed if a parent contains a 1.55/1.78 statement. The software will set the AIA indicator of the child transition application to YES before examination.



Forms for Making a 1.55/1.78 Statement

- Updated versions of the application data sheet (ADS -- Form PTO/AIA/14) and the transmittal letter for 371 national stage filing (Form PTO-1390) are available for an applicant to make the 1.55/1.78 statement by marking a check box on the forms.



Application Data Sheet with 1.55/1.78 Statement Check Box

PTO/AIA/14 (03-13)

Approved for use through 01/31/2014. OMB 0651-0032

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

Application Data Sheet 37 CFR 1.76	Attorney Docket Number	
	Application Number	
Title of Invention		

Statement under 37 CFR 1.55 or 1.78 for AIA (First Inventor to File) Transition Applications

This application (1) claims priority to or the benefit of an application filed before March 16, 2013 and (2) also contains, or contained at any time, a claim to a claimed invention that has an effective filing date on or after March 16, 2013.

NOTE: By providing this statement under 37 CFR 1.55 or 1.78, this application, with a filing date on or after March 16, 2013, will be examined under the first inventor to file provisions of the AIA.



Making or Rescinding a 1.55/1.78 Statement Using a Separate Paper

- If applicant does not select the 1.55/1.78 statement check box on the ADS, applicant may provide the statement in a separate document.
- Applicant may also rescind an erroneous 1.55/1.78 statement in a separate document.
- To index the above separate documents correctly when filing online, applicant must select the document description “Make/Rescind AIA (First Inventor to File) 1.55/1.78 Stmnt.”

Doc Code	Document Type
R.55.78.STMT	Make/Rescind AIA (First Inventor to File) 1.55/1.78 Stmnt



1.55/1.78 Statement Recorded in PALM

Date	Status	Code	Description
04/24/2013		R155X	1.55/1.78 STATEMENT FILED



1.55/1.78 Statement Shown on Filing Receipt

**Doc Code
in IFW**



** APP.FILE.REC (03/29/2013) ▼



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NUMBER	FILING or 371(e) DATE	OR PART UNIT	FIL. FEE REC'D	ATTY. DOCKET NO.	TOT CLAIMS	IND CLAIMS
13/xxx,xxx	03/29/2013	56xx	57xx	xx40-x212US	24	4

CONFIRMATION NO. xx62

5x122
ACME INC.
21333 South Shore Drive
Innovation, OH 99999

FILING RECEIPT



00000000xxxxxxx

Title

Television Stand

Preliminary Class

D14

Statement under 37 CFR 1.55 or 1.78 for AIA (First Inventor to File) Transition Applications: **Yes**

PROTECTING YOUR INVENTION OUTSIDE THE UNITED STATES





Topics for Discussion



- Review of the AIA (FITF) Indicator (“AIA Indicator”) in eDAN and PALM
- Determining AIA (First Inventor to File) Status
- Situations Where the AIA Indicator May Need to be Updated



AIA Indicator May Need to be Updated During Examination

- TC AIA Specialist will be responsible for any needed AIA indicator updates for all applications after status 20 (i.e., after the application is released from Pre-Exam) based upon notification from OPAP, PALM report, PTAB, examiner, etc.
 - If a TC AIA Specialist receives notice from OPAP, PALM report, or PTAB to review the AIA indicator and subsequently changes the AIA indicator status, the TC AIA Specialist will notify examiners of the status change via:
 - ◇ email;
 - and**
 - ◇ annotation made in IFW (e.g., “AIA indicator status changed to YES”) next to any paper effecting the change.



Examples of Where AIA Indicator Status May Be Updated During Examination

- 1.55/1.78 statement or rescission made after the case has been docketed for examination
- Examiner determines that a transition application without a 1.55/1.78 statement contains a claim having an effective filing date (EFD) on or after March 16, 2013
- Examiner is persuaded by applicant's arguments that the AIA indicator is incorrect
- Board decision impacts AIA indicator status
- Parent AIA indicator changes



Consulting With TC AIA Specialist

- If an examiner has one of these situations previously discussed, the examiner should consult with the TC AIA Specialist.
- A TC AIA Specialist will determine and/or verify the correct AIA indicator status using an AIA Indicator Decision Table created by the Office and make any necessary AIA indicator update.
- If you are interested in the AIA Indicator Decision Table, please see the Appendix to these slides.



Resources and Questions

- Internal AIA microsite link:
<http://ptoweb.uspto.gov/patents/fitf>
- Lead FITF Points of Contact



Lead FITF Points of Contact

Contact	Business Unit
Cassandra Spyrou	TC 2600 & 2800
Chris Grant	TC 2100, 2400 & OPT
Tom Hughes	TC 3600, 3700 & CRU
Kathleen Bragdon	TC 1600, 1700 & 2900
Gerald Leffers	OPQA/ TC 1600, 1700 & 2900
Steve Saras	OPQA/ TC 2600 & 2800
MaryBeth Jones	OPQA/ TC 3600, 3700 & CRU
Don Sparks	OPQA/ TC 2100, 2400 & OPT

Thank You!





APPENDIX



AIA Indicator Decision Table

(A) Fact Pattern #	(B) Filing date (FD) before 3/16/13 (for 371 national stage applications, the FD is the international FD)?	(C) 1.55/1.78 statement present?	(D) Any domestic benefit claim to a case with filing date before 3/16/13?	(E) Any foreign priority claim to a case with filing date before 3/16/13?	(F) Any domestic benefit claim to a parent AIA application?	(G) Any <u>deleted</u> domestic benefit claim to an AIA application?	(H) Determination made that a claim has an EFD on or after 3/16/2013 (issue raised during examination)?	(I) AIA (FITF) Indicator should be set to:	(J) Application Type
1	Y	Y or N	Y or N	Y or N	N	N	N	NO	pure pre-AIA
2	N	Y or N	N	N	Y or N	Y or N	Y or N	YES	pure AIA
3	N	N	Y	N	N	N	N	NO	transition
4	N	N	N	Y	N	N	N	NO	transition
5	N	N	Y	Y	N	N	N	NO	transition
6	N	Y	Columns (D) and (E) can be either Y or N but both cannot be N		Y or N	Y or N	Y or N	YES	transition
7	N	Y or N	Columns (D) and (E) can be either Y or N but both cannot be N		Y	Y or N	Y or N	YES	transition
8	N	Y or N	Columns (D) and (E) can be either Y or N but both cannot be N		Y or N	Y	Y or N	YES	transition
9	N	Y or N	Columns (D) and (E) can be either Y or N but both cannot be N		Y or N	Y or N	Y	YES	transition



AIA Indicator Decision Table Example

- Fact pattern for an application in status 20 (information regarding application obtained from filing receipts and AIA indicator status for parent obtained from PALM):
 - Filing date of application: April 1, 2013
 - No 1.55/1.78 statement
 - Domestic benefit claim to a nonprovisional filed on January 17, 2013
 - No foreign priority claim
 - No domestic benefit claim to a parent AIA application
 - No deleted benefit claim to an AIA application
 - No determination made that a claim has an EFD on or after March 16, 2013

(A)	(B)	(C)	(D)	(E)	(F)	(G)	(H)	(I)	(J)
Fact Pattern #	Filing date (FD) before 3/16/13 (for 371 national stage applications, the FD is the international FD)?	1.55/1.78 statement present?	Any domestic benefit claim to a case with filing date before 3/16/13?	Any foreign priority claim to a case with filing date before 3/16/13?	Any domestic benefit claim to a parent AIA application?	Any <u>deleted</u> domestic benefit claim to an AIA application?	Determination made that a claim has an EFD on or after 3/16/2013 (issue raised during examination)?	AIA (FITF) Indicator should be set to:	Application Type
	NO	NO	YES	NO	NO	NO	NO	?	?



AIA Indicator Decision Table Example (Cont.)

(A) Fact Pattern #	(B) Filing date (FD) before 3/16/13 (for 371 national stage applications, the FD is the international FD)?	(C) 1.55/1.78 statement present?	(D) Any domestic benefit claim to a case with filing date before 3/16/13?	(E) Any foreign priority claim to a case with filing date before 3/16/13?	(F) Any domestic benefit claim to a parent AIA application?	(G) Any <u>deleted</u> domestic benefit claim to an AIA application?	(H) Determination made that a claim has an EFD on or after 3/16/2013 (issue raised during examination)?	(I) AIA (FITF) Indicator should be set to:	(J) Application Type
	NO	NO	YES	NO	NO	NO	NO	?	?
1	Y	Y or N	Y or N	Y or N	N	N	N	NO	pure pre-AIA
2	N	Y or N	N	N	Y or N	Y or N	Y or N	YES	pure AIA
3	N	N	Y	N	N	N	N	NO	transition
4	N	N	N	Y	N	N	N	NO	transition
5	N	N	Y	Y	N	N	N	NO	transition
6	N	Y	Columns (D) and (E) can be either Y or N but both cannot be N		Y or N	Y or N	Y or N	YES	transition
7	N	Y or N	Columns (D) and (E) can be either Y or N but both cannot be N		Y	Y or N	Y or N	YES	transition
8	N	Y or N	Columns (D) and (E) can be either Y or N but both cannot be N		Y or N	Y	Y or N	YES	transition
9	N	Y or N	Columns (D) and (E) can be either Y or N but both cannot be N		Y or N	Y or N	Y	YES	transition

Match →

