

UNITED STATES
PATENT AND TRADEMARK OFFICE



Patent Quality Chat: First Inventor to File (FITF) Patent Prosecution

Patent Quality Chat
Webinar Series 2016 (2 of 11)
February 9, 2016



To send in questions or comments during the webinar, please email:

PatentQualityEventParticipationBox@uspto.gov



The screenshot shows the USPTO website homepage. At the top, the USPTO logo and navigation links (About Us, Careers, Contact Us) are visible. Below the navigation bar, there are tabs for Patents, Trademarks, IP Policy, and Learning and Resources. A search bar is located in the top right corner. The main content area features a large blue banner with the text "First time here? Let us help you find your bearings." and a "Get Going" button. Below the banner, there are sections for "Learn About the Process" (Patents and Trademarks), "Fees and Payment", and "Patents & Trademarks Initiatives". A yellow arrow points from the "Fees and Payment" section to the "Enhanced Patent Quality Initiative" link in the "Patents & Trademarks Initiatives" section, which is circled in purple. At the bottom, there is a "Patent Quality Chat" logo and the text "Email questions to PatentQualityEventParticipationBox@uspto.gov".

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Patents Trademarks IP Policy Learning and Resources Quick Links

First time here? Let us help you find your bearings.

Learn how patents, trademarks, and copyrights differ and other basic information to get started.

Get Going

Learn About the Process

Patents

- General Information Concerning Patents
- Patent Process Overview

Trademarks

- Trademark Basics
- Trademark Process

Fees and Payment

Fees and Payment

Patents & Trademarks Initiatives

Enhanced Patent Quality Initiative

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More Patents

- Forms
- Fees & payment information
- Initiatives
 - Accelerated Examination
 - Executive Actions
 - Glossary Initiative
 - Patent Application Initiatives
 - Patent Examiner Technical Training Program
 - Patents for Humanity
 - Third-Party Preissuance Submissions
 - Site Experience Education (SEE) Program
 - Software Partnership
 - Track One

Enhanced Patent Quality Initiative

Leading in Quality Excellence – Every Interaction Counts

Intellectual property (IP) intensive industries support at least 40 million jobs in the U.S. and contribute more than \$5 trillion - or nearly 35 percent - to our gross domestic product. Our new quality initiative comes as there is increased recognition and appreciation around the world of the importance of IP.

The dedicated efforts of our employees over the last few years have significantly reduced our patent application backlog and pendency. We want to continue to build on those efforts, and recent America Invents Act (AIA) legislation passed by Congress supports doing just that.

The AIA allows us to set our fees and retain fees collected above our appropriated level. This means our financial health is more stable than in the past, giving us a unique opportunity to further expand our quality efforts throughout the entire process.

Topic Submission for Case Studies Pilot Program
Accepting submissions through Feb. 12, 2016

2016 Patent Quality Chats
Next Chat - Feb. 9, 2016 12 - 1 pm ET

Building an Enhanced Patent Quality System

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Patent Quality Chat:
First Inventor to File (FITF)
Patent Prosecution

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Supervisor, Office of Patent Quality Assurance (OPQA), USPTO

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Agenda

- Overview of the First Inventor to File (FITF) Provision of the America Invents Act (AIA)
- FITF Statistics
- AIA (FITF) Status and Indicator
 - Tips for identifying and correcting errors
- Prior Art Rejections under FITF
 - Tips for prosecuting

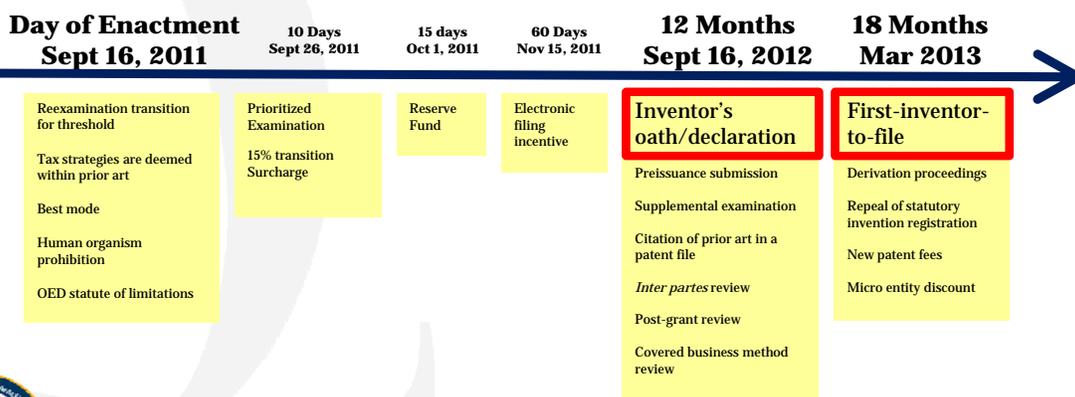


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AIA Provisions and Effective Dates



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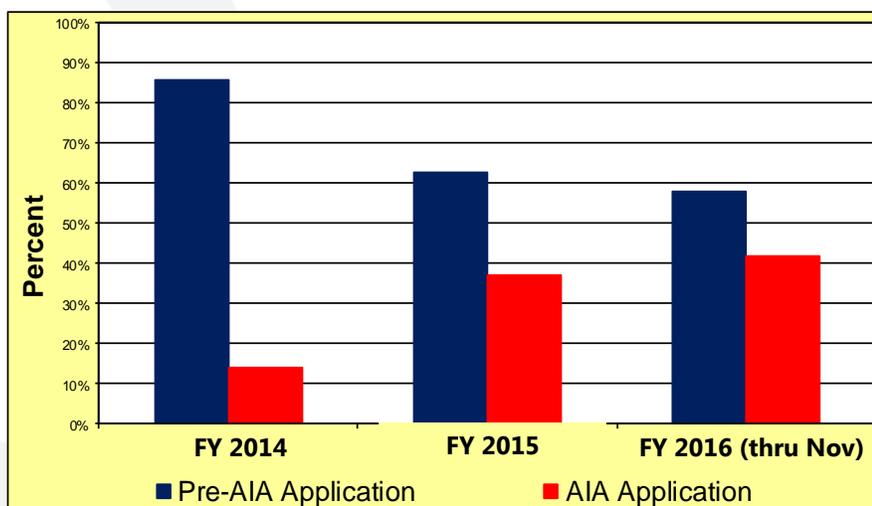
First Inventor to File (FITF) STATISTICS



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Pre-AIA vs. AIA: Percent of Pending Applications*



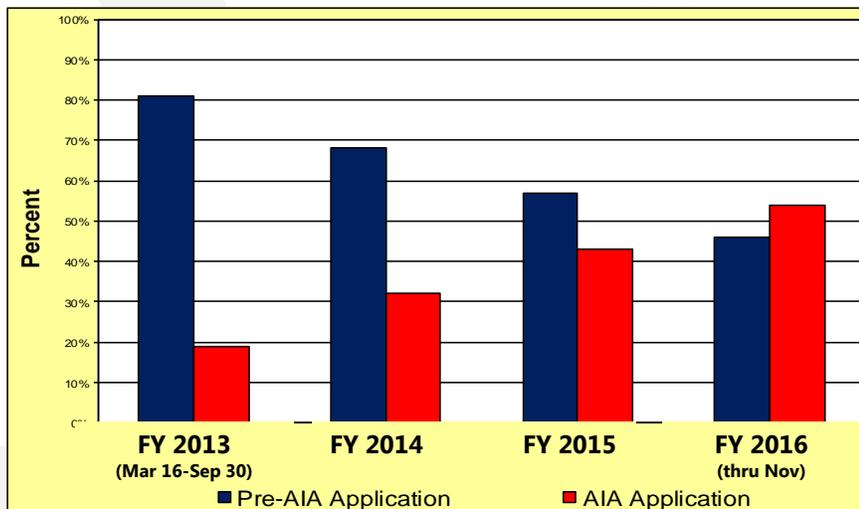
*excluding Design applications



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Pre-AIA vs. AIA: Percent of Applications* Filed



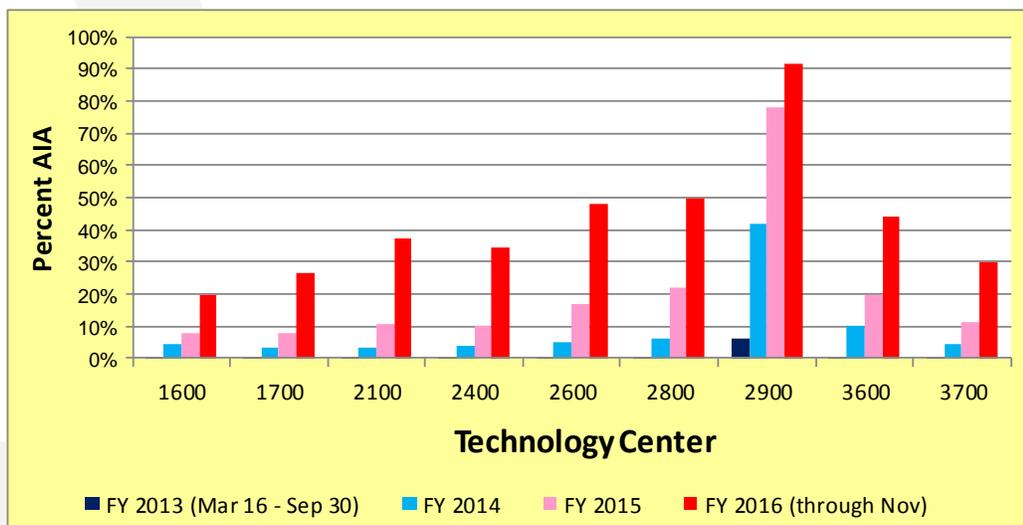
*excluding Design applications



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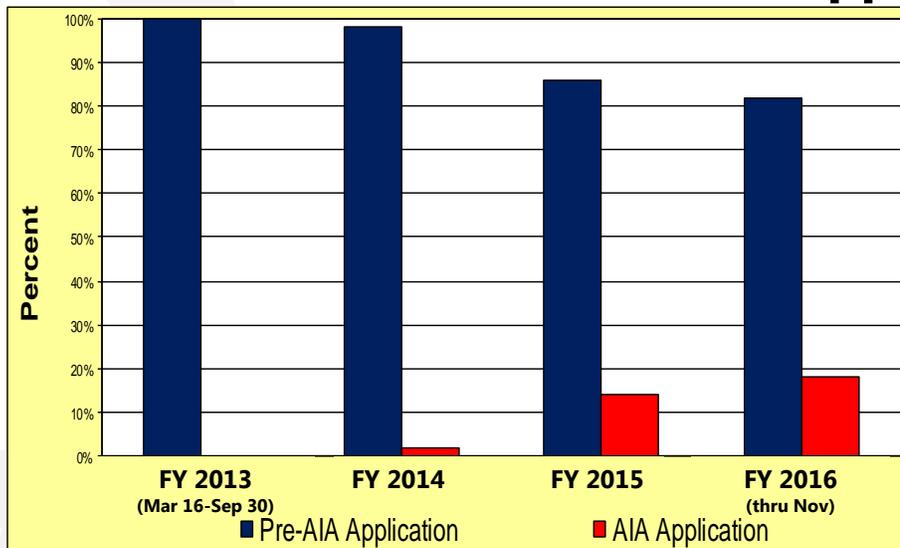
AIA First Actions Completed by Tech Center



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Pre-AIA vs. AIA: Percent of Allowed Applications*



*excluding Design applications



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First Inventor to File (FITF) AIA STATUS and INDICATOR



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AIA First Inventor To File Status

- What is the AIA status of my application as shown in PAIR?
- Do I consider this AIA status to be correct?
- If not, why is it wrong and how can I fix it?



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AIA (FITF) Status Indicator in PAIR

Patent Application Information Retrieval	
Order Certified Application As Filed Order Certified File Wrapper View Order List	
10 / xxx,xxx	WIDGET 34977
Select New Case Application Data Transaction History Image File Wrapper Patent Term Adjustments Continuity Data Foreign Priority Fees Published Documents Address & Attorney/Agent Display References	
Bibliographic Data	
Application Number:	10 / xxx,xxx
Filing or 371 (c) Date:	03-17-2003
Application Type:	Utility
Examiner Name:	Examiner, Pat N.
Group Art Unit:	2500
Confirmation Number:	5711
Attorney Docket Number:	34977
Class / Subclass:	134/058.00D
First Named Inventor:	Doe, John
Entity Status:	Micro
Customer Number:	-
Status:	Patented Case
Status Date:	01-25-2006
Location:	ELECTRONIC
Location Date:	-
Earliest Publication No:	US 2004-xxxxxxx A
Earliest Publication Date:	01-15-2004
Patent Number:	6,xxx,xxx
Issue Date of Patent:	02-1-2006
AIA (First Inventor to File):	No
Title of Invention:	WIDGET

Possible Values

- Yes if FITF
- No if not FITF
- "---" (hyphen) not ready for examination



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AIA (FITF) Application Types



A transition application is an application that contains benefit or priority claims to an application filed before March 16, 2013. A statement under 37 CFR 1.55 or 1.78 may be needed (unless provided in a parent application).



Filed on or after March 16, 2013, without a priority or benefit to an application filed before March 16, 2013.

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Considering a "Wrong" AIA Status Indicator

- Is my domestic benefit/foreign priority information accurately reflected on my filing receipt?
 - No → why not?
 - Yes → next question
- What was the AIA (FITF) status of the parent application?
- Did I make a statement under 1.55 or 1.78?

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.



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Correcting the AIA Status Indicator

- Update my domestic benefit/foreign priority information
 - Submit a properly marked up (i.e., with respect to the latest filing receipt) and signed Corrected Application Data Sheet (ADS)
 - Include an accompanying petition for late claim, if necessary
 - Request a corrected filing receipt
- Confirm that the AIA (FITF) indicator status of the parent application was correct. If not, fix the parent application and monitor the status of the child application
- Make or rescind a statement under 37 CFR 1.55 or 1.78 as necessary



BEST PRACTICE: Monitor PAIR for change in AIA (FITF) status indicator. If no change in AIA (FITF) status indicator, call the examiner.



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First Inventor to File (FITF) PRIOR ART REJECTIONS



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AIA Statutory Framework Chart

Prior Art 35 U.S.C. 102(a) (Basis for Rejection)	Exceptions 35 U.S.C. 102(b) (Not Basis for Rejection)	
102(a)(1) Disclosure with Prior Public Availability Date	102(b)(1)	(A) Grace Period Disclosure by Inventor or Obtained from Inventor
		(B) Grace Period Intervening Disclosure by Third Party
102(a)(2) U.S. Patent, Published U.S. Patent Application, and Published PCT Application with Prior Filing Date	102(b)(2)	(A) Disclosure Obtained from Inventor
		(B) Intervening Disclosure by Third Party
		(C) Commonly Owned Disclosures



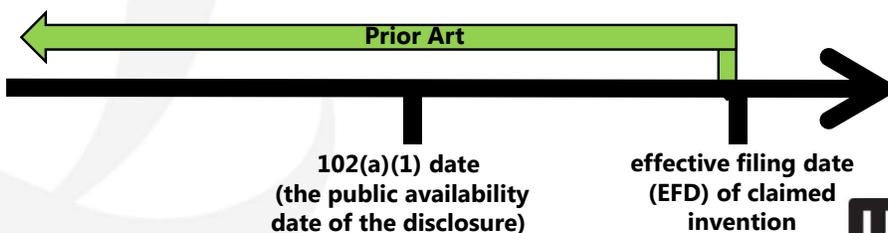
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Prior Art under 35 U.S.C. 102(a)(1)

102(a)(1) potential prior art includes **public disclosures** that have a public availability date before the effective filing date of the claimed invention and are:

- patented;
- described in a printed publication;
- in public use;
- on sale; or
- otherwise available to the public.



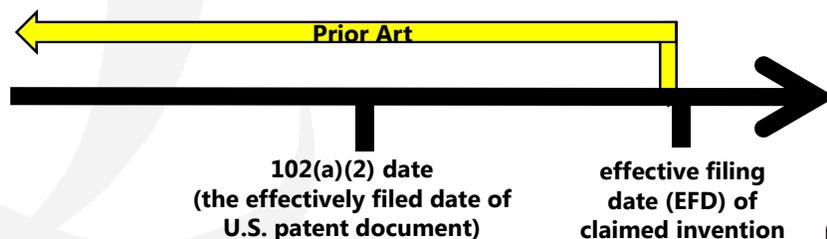
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Prior Art under 35 U.S.C. 102(a)(2)

102(a)(2) potential prior art includes issued or published U.S. patent documents that name another inventor and have an effectively filed date before the effective filing date of the claimed invention:

- U.S. Patent;
- U.S. Patent Application Publication; or
- WIPO published PCT (international) application that designates the United States



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Establishing an Exception

- The potential prior art disclosure can unambiguously be attributed to the application's inventor
- 37 CFR 1.77(b)(6) statement in the specification
- 37 CFR 1.130 declarations of attribution or prior public disclosure
- A statement of common ownership
 - available for 102(a)(2) art only



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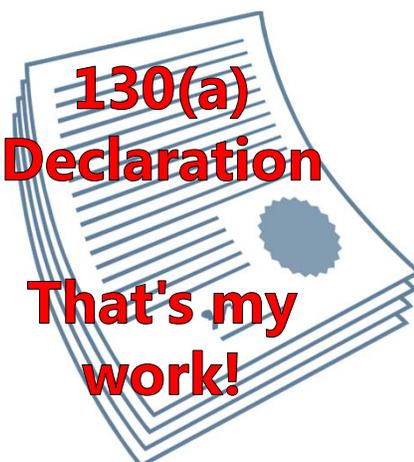
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Declarations under 37 CFR 1.130(a)



**130(a)
Declaration**
**That's my
work!**



for
102(b)(1)(A)
and
102(b)(2)(A)
exceptions



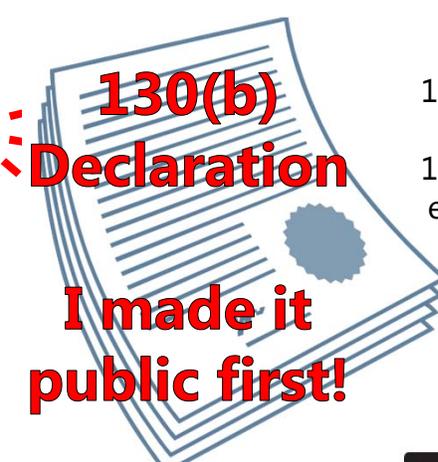
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Declarations under 37 CFR 1.130(b)



**130(b)
Declaration**
**I made it
public first!**



for
102(b)(1)(B)
and
102(b)(2)(B)
exceptions



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Help to Ensure Proper Assessment of Your Evidentiary Declaration

RULE FOR SUBMISSION OF DECLARATION	DOCUMENT DESCRIPTION IN IFW	DOC CODE
130(a)	Affidavit-Rule 130(a)-AIA (FITF) ONLY	AF/D.130A
130(b)	Affidavit-Rule 130(b)-AIA (FITF) ONLY	AF/D.130B
131(a) or 131(c)	Affidavit-Rule 131-pre-AIA (FTI) ONLY	AF/D.131
132	Affidavit-traversing rejectns or objectns rule 132	AF/D.132
Not Covered by a Specific Rule	Affidavit-not covered under specific rule	AF/D.OTHER



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First Inventor to File (FITF) RESOURCES



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How Do I Get Help?

- AIA Contact Center 855-HELP-AIA [855-435-7242]
 - HELPAIA@uspto.gov
- OPLA HelpLine 571-272-7701
 - PatentPractice@uspto.gov
- Your examiner
 - TC AIA Specialists
 - Lead POCs on AIA FITF



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The screenshot shows the USPTO website interface. At the top, there is a navigation bar with 'uspto UNITED STATES PATENT AND TRADEMARK OFFICE' and links for 'About Us', 'Careers', and 'Contact Us'. A search bar is also present. Below the navigation bar, there are tabs for 'Patents', 'Trademarks', 'IP Policy', and 'Learning and Resources', along with a 'Quick Links' dropdown menu. The main content area is titled 'Enhanced Patent Quality Initiative' and includes a sidebar with various links like 'More Patents', 'Forms', and 'Accelerated Examination'. The main text discusses 'Leading in Quality Excellence – Every Interaction Counts' and mentions the America Invents Act (AIA). A red arrow on the right side of the page points downwards, indicating that the user should scroll down to see more content. The 'uspto' logo is visible in the bottom right corner of the screenshot.

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Resources from the Enhanced Patent Quality Initiative

- **Patent Quality Chat** – a monthly webinar discussing various aspects of the patent quality
- **Interview Practice** – including information about free video conferencing with USPTO examiners, AIR a web-based tool for scheduling interviews, Interview Specialists contact information for each Technology Center, and policy and training information.
- **Examination Guidance and Training Materials** – on topics such as 35 U.S.C. 101, America Invents Act claim interpretation, 35 U.S.C. 112, and 35 U.S.C. 103
- **Subject Matter Eligibility Resources**
 - July 2015 Update: Interim Eligibility Guidance Quick Reference Sheet (.pdf)
 - **First Inventor to File (FITF) Resources**
 - Enhancing Clarity of the Record
 - 35 USC 112(f) Resource Page
 - Measuring Patent Quality
 - Patent Quality Composite Video 1 YouTube [@](#) | USPTO hosted video
 - Patent Quality Composite Video 2 YouTube [@](#) | USPTO hosted video
 - Quality Index Reporting (QIR) Variables for Patent Quality Composite.pdf
 - Patent Quality - Quality Index Reporting Variables with FY11-FY13 volumes_v3.pdf
 - **Ombudsman** – Assisting in getting the application back on track

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First Inventor to File (FITF) Resources

The **first inventor to file (FITF)** provision of the America Invents Act transitions the U.S. to a first-inventor-to-file system from a first-to-invent system and became effective on March 16, 2013. The provision introduced changes to 35 U.S.C. § 102 that impact patent prosecution directly. This resource page gathers information about patent prosecution under the FITF system all in one place.

Examiner Training Materials

This section provides training materials developed for examiners.

- First Inventor to File Statutory Framework Chart [PDF]
- FITF Definitions [PDF]
- AIA Rules and Regulations (non-FITF) Slides [PDF]
- AIA FITF Status Indicator Training Slides (Fall 2013) [PDF]
- Overview Training Slides (March 2013) [PDF]
- Overview Follow-On Training Slides (March 2013) that has additional examples [PDF]
- Comprehensive Training Slides (Summer 2013) [PDF]
- FITF Hands on Workshop Introduction and Statute Review Slides (Fall 2013) [PDF]
- FITF Evidentiary Declarations Slides (Jan 2015) [PDF]

Public Events

- 2014 AIA FITF Fall Roadshow (Sep-Oct 2014) Slides [PDF]
- AIA FITF Public Forum on the First Anniversary of FITF (April 2014) Slides [PDF]

Rules and Guidance

- First Inventor to File Rules Correction (78 Fed. Reg. 16182, March 14, 2013) [@](#)
- First Inventor to File Rules (78 Fed. Reg. 11024, February 14, 2013)
- First Inventor to File Final Guidance (78 Fed. Reg. 11059, February 14, 2013)

More information

- For more information on **First Inventor to File** visit here <http://www.uspto.gov/patent/laws-and-regulations/america-invents-act-aia/patents-examination#heading-10>
- For more information on other **AIA provisions**, visit here <http://www.uspto.gov/patent/laws-and-regulations/leahy-smith-america-invents-act-implementation>

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Let's Chat about First Inventor to File (FITF) Patent Prosecution

Tom Hughes

Supervisor, Office of Patent Quality Assurance (OPQA), USPTO

Kathleen Kahler Fonda

Senior Legal Advisor, Office of Patent Legal Administration (OPLA), USPTO

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Thank you for joining us today!

Patent Quality Chat

Webinar Series 2016 (2 of 11)

February 9, 2016



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**Next Patent Quality Chat:
Tuesday, March 8th
*The Latest on the Cooperative Patent
Classification (CPC) System***



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USPTO's Enhanced Patent Quality Initiative,
please email :**

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