



AMERICA INVENTS ACT

IMPLEMENTATION

Welcome

First Inventor to File (FITF)

FIRST ANNIVERSARY

Public Forum

Monday, April 1, 2014

Public Forum Agenda

Time	Topic
1:00 PM to 1:15 PM	Welcome <i>Janet Gongola, Senior Advisor to the Deputy Director</i>
	Opening Remarks <i>Michelle K. Lee, Deputy Under Secretary and Deputy Director</i>
1:15 PM to 2:15 PM	Will My Application Be Examined Under AIA (FITF) Or Not? <i>Cassandra Spyrou, QAS in TC 2800</i>
2:15 PM to 3:00 PM	FITF -- A Year in Review <i>Tom Hughes, SPE in TC 3700</i>
3:00 PM to 3:15 PM	BREAK
3:15 PM to 4:20 PM	FITF Overview and Tips on Responding to Prior Art Rejections <i>Kathleen Fonda, Senior Legal Advisor Office of Patent Legal Administration</i>
4:20 PM to 4:30 PM	Tour of the AIA (FITF) Website <i>Kathleen Bragdon, QAS in TC 1600</i>
4:30 PM to 5:00 PM	Q&A Panel Discussion (<i>Hughes, Spyrou, Fonda, Bragdon</i>) <i>Christopher Grant, QAS in TC 2400 (Moderator)</i>



Test Your Knowledge!

We will be using Poll Everywhere to challenge the audience with questions during the presentations.

Your participation is voluntary.



Polling Notes

- Select questions will be asked of the audience during some of the presentations
- Answers will be accepted through **Poll Everywhere:**
 - Text message (cell phone) or
 - Web page (cell phone's Internet browser or computer)
- Real-time display of your answers
- Let's Practice!

Polling Introductory Question

Introductory Question – YES OR NO? Have you received an Office action on the merits in an AIA (FITF) application?

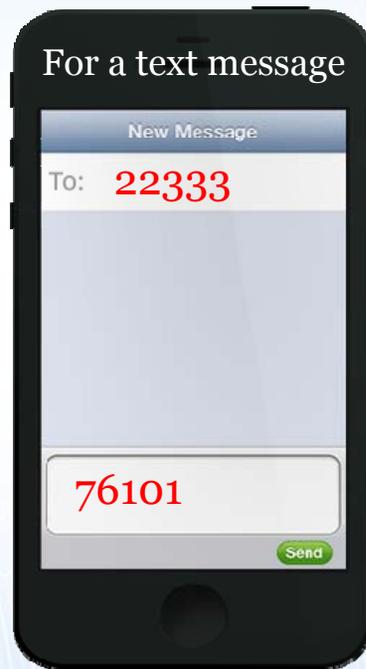
- If texting from your phone, send a text message to **phone number 22333** and use the code that corresponds to your answer as the body of your text message.
 - Codes will differ question-to-question and will be displayed on the current polling slide as, for example:
 - 76101 for **Yes**
 - 76102 for **No**
 - 76103 for **I Don't Know**

- If using the Internet, go to **pollev.com/uspto4** from any browser:
 - Select the appropriate radio button for your answer and submit

Polling Introductory Question

Introductory Question – YES OR NO? Have you received an Office action on the merits in an AIA (FITF) application?

76101 for **Yes**
76102 for **No**
76103 for **I Don't Know**



Select appropriate radio button for your answer

POLLING SLIDE

Please participate in the polling by

- Texting the code for your answer to **phone number 22333**

OR

- Voting at **pollev.com/uspto4**



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AMERICA INVENTS ACT

IMPLEMENTATION

Will My Application Be Examined Under AIA (FITF) or Not?

Cassandra Spyrou
Quality Assurance Specialist
Technology Center 2800

Overview

- How to determine if your application is subject to the AIA First Inventor to File (FITF) provisions
 - Pre-AIA or AIA applications
 - Transition applications
 - Required statement under 37 CFR 1.55 or 1.78 for AIA transition applications
- Scenarios to exemplify AIA determination in practice



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 for 35 U.S.C. 371 national stage entries 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 (First To Invent) application (aka “AIA application” or “pre-AIA application,” respectively).
- 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.

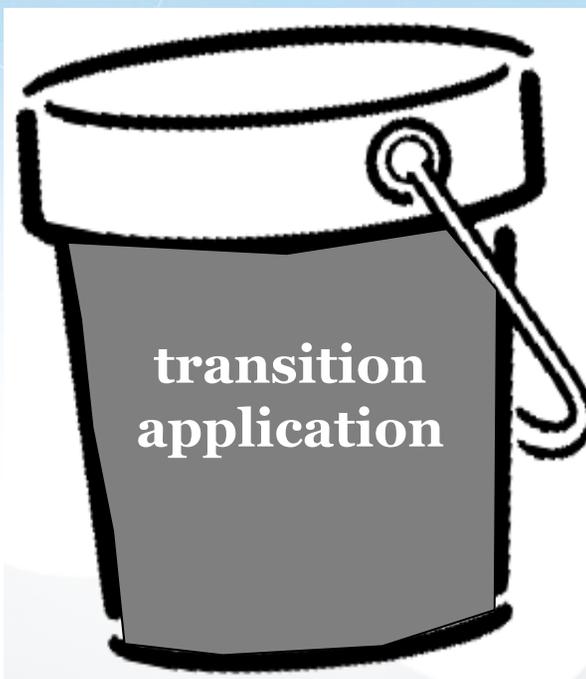
- A claim that comprises new matter, filed on or after March 16, 2013 in a pre-AIA application, will not change the status from pre-AIA to AIA, regardless of the filing date of the application.



Application Types Used to Determine When AIA (FITF) Applies



Filed **before** 3/16/2013



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



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



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 Can Be Either Pre-AIA or AIA (FITF)



Pre-AIA transition application

- Only ever contains claimed inventions that have an EFD **before** March 16, 2013

OR

AIA (FITF) transition application

- Contains or ever contained **any** claim to an invention that has an EFD that is **on or after** March 16, 2013 and/or
- Is ever a CON, DIV, or CIP of an AIA (FITF) application



1.55/1.78 Statements for AIA (FITF) Transition Applications



Pre-AIA transition application

- No statement under 37 CFR 1.55/1.78 is filed.

OR

AIA (FITF) transition application

- Statement under 37 CFR 1.55/1.78 is **required**.



1.55/1.78 Statements for AIA (FITF) Transition Applications

- When filing a transition application that contains or ever contained a claim to an invention having an effective filing date on or after March 16, 2013, a statement under 37 CFR 1.55 or 1.78 (“**the 1.55/1.78 statement**”) is required.
 - 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.



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.



1.55/1.78 Statement Reflected in the Filing Receipt

 **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	GRP ART 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



000000000xxxxxxx

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



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.”

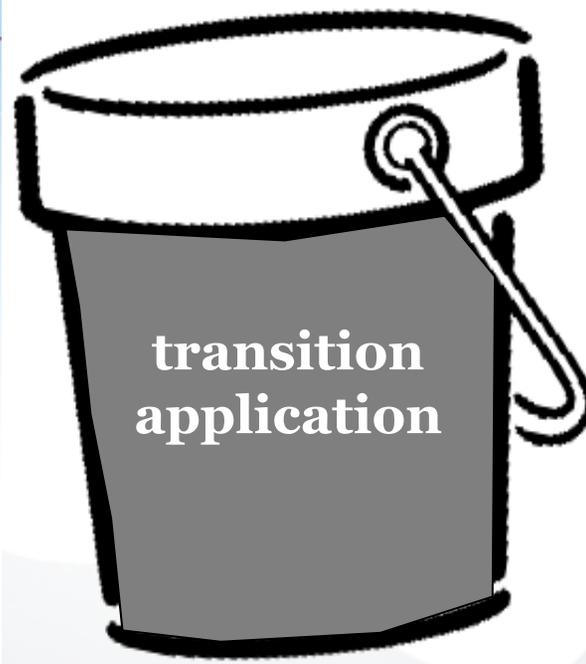
Doc Code	Document Type
R.55.78.STMT	Make/Rescind AIA (First Inventor to File) 1.55/1.78 Stmnt



AIA (FITF) Application Types



1.55/1.78 statement
Not Relevant



**1.55/1.78 statement
NEEDED IF**
the transition application
contains or ever contained a
claim to an invention having an
EFD on or after 3/16/2013*



1.55/1.78 statement
Not Relevant

*A 1.78 statement in a child transition application is not needed if a parent contains a 1.55/1.78 statement.



1.55/1.78 Statement

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

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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.





AMERICA INVENTS ACT

IMPLEMENTATION

AIA First Inventor To File (FITF) Indicator

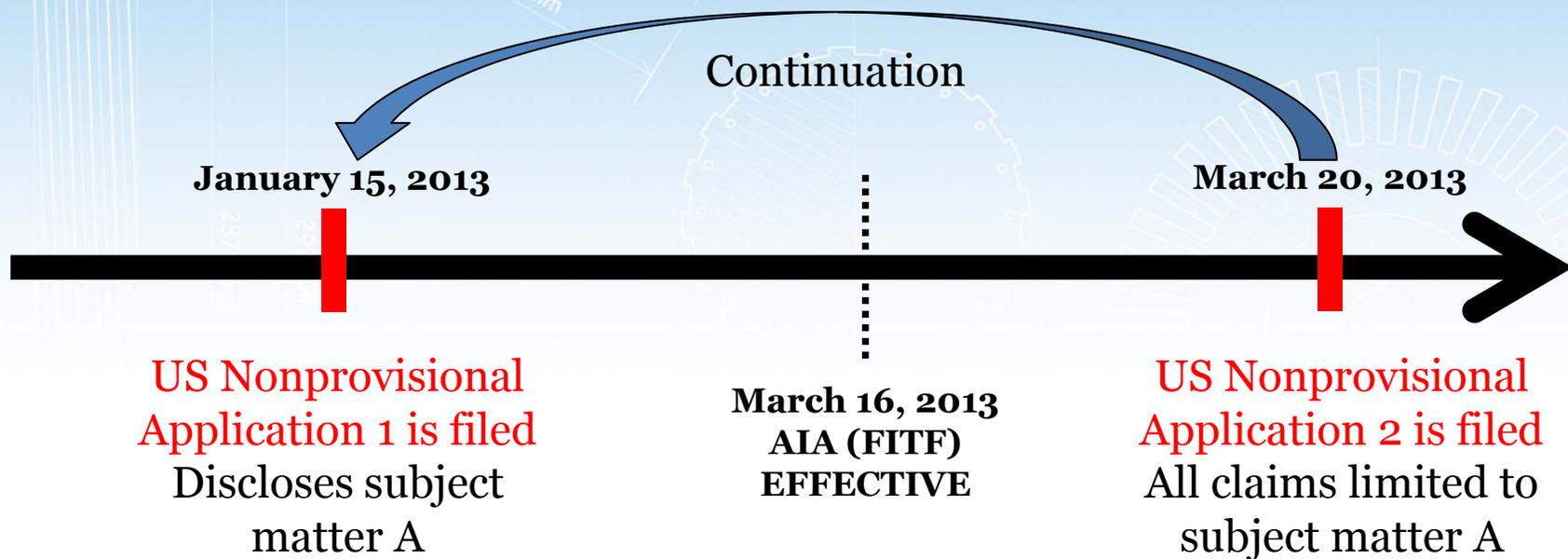
Sample Scenarios

Test Your Knowledge!

Consider the following AIA (FITF) Indicator Scenarios — we will be **polling** for your answers.



Polling Scenario A.1



Question A.1 – YES OR NO? Should the Applicant make a 1.78 statement in Application 2 resulting in the application being designated as AIA (FITF)?



POLLING SLIDE

Please participate in the polling by

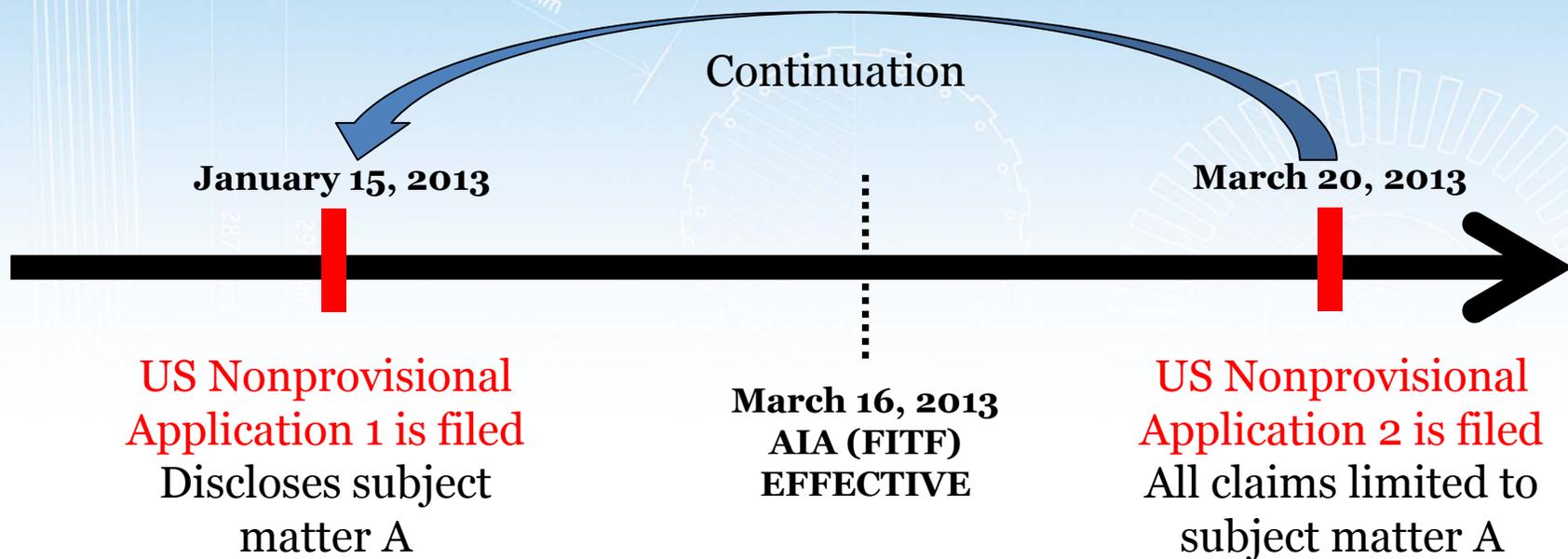
- Texting the code for your answer to **phone number 22333**

OR

- Voting at **pollev.com/uspto4**



Polling Scenario A.1



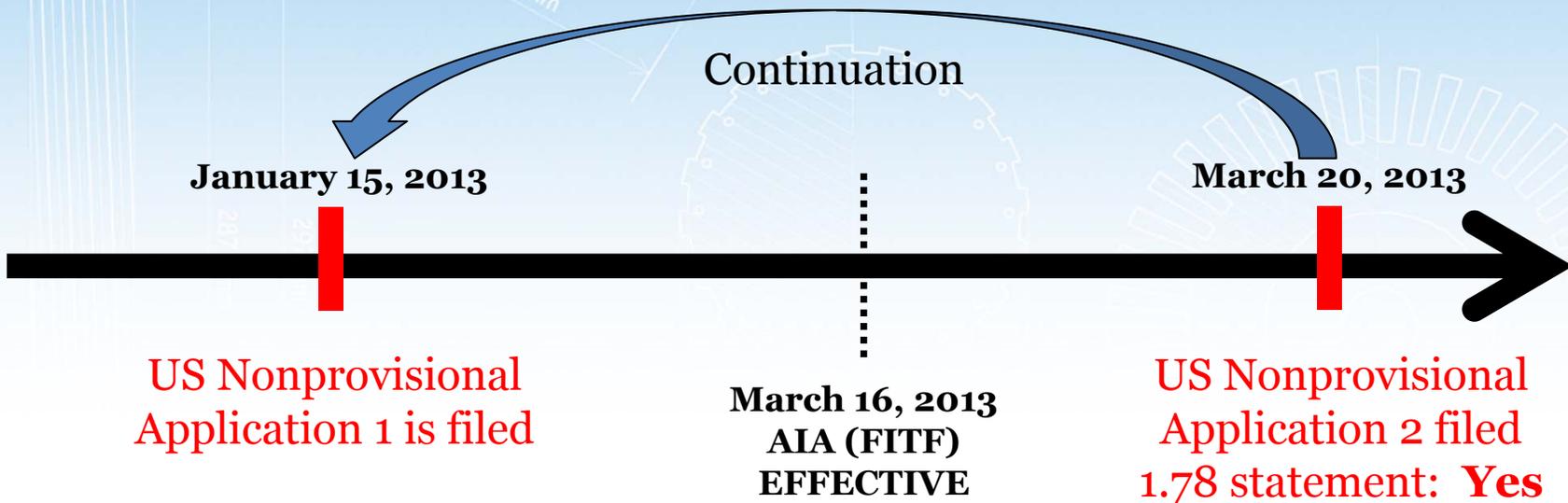
Question A.1 – Should the Applicant make a 1.78 statement in Application 2?

Answer A.1 – NO. Although Application 2 is filed after the AIA (FITF) effective date as transition application, there is no claimed invention with an effective filing date on or after 3/16/13.





Scenario A.2

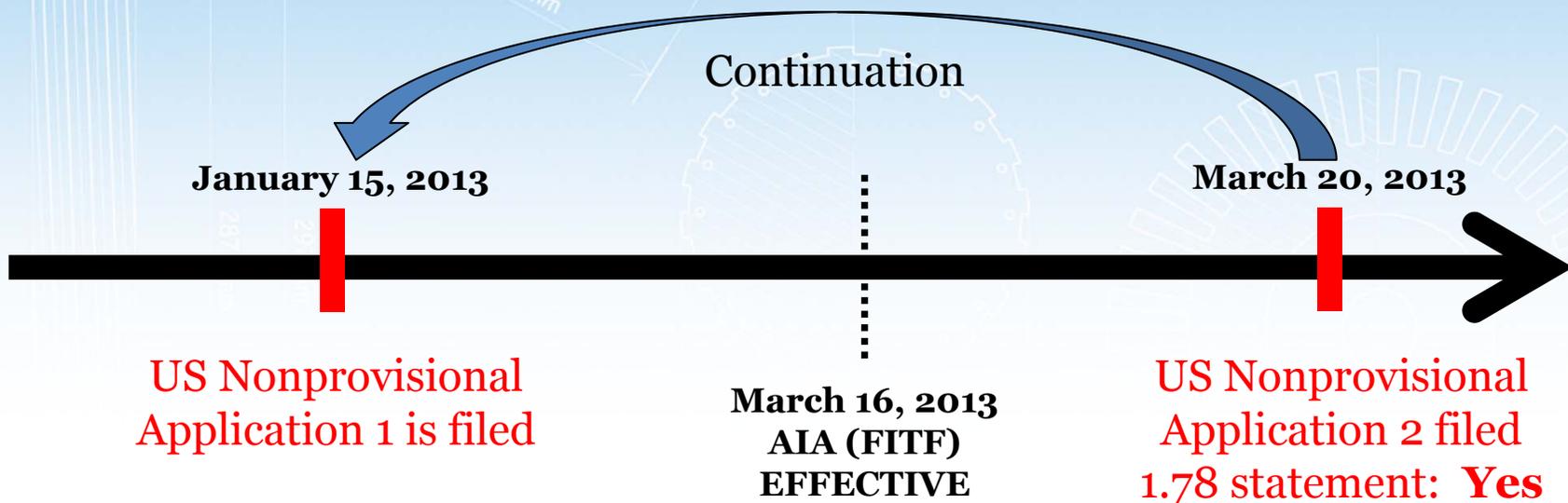


Question A.2 – YES OR NO? If the 1.78 statement was provided by the applicant, will the Office designate Application 2 as Pre-AIA?





Scenario A.2



Question A.2 – Will the Office designate this application as pre-AIA?

Answer A.2 – NO. The Office will designate Application 2 as AIA (FITF). However, a conflict exists between the domestic benefit relationship and the 1.78 statement.





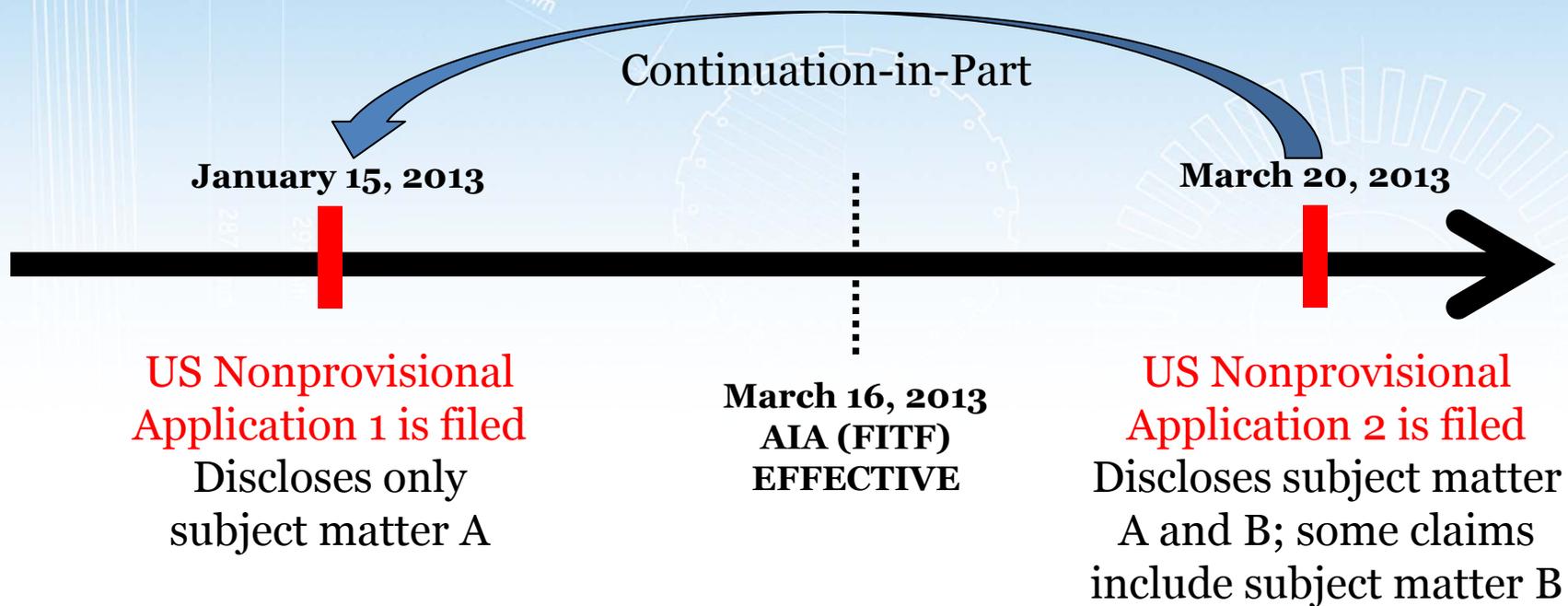
Scenario A.2



CON/DIV Conflict – if identified, the Office will resolve by notifying applicant and designating the application as pre-AIA despite Applicant's 1.78 statement



Polling Scenario B.1



Question B.1 – YES OR NO? Should the Applicant make a 1.78 statement in Application 2 resulting in the application being designated as AIA (FITF)?



POLLING SLIDE

Please participate in the polling by

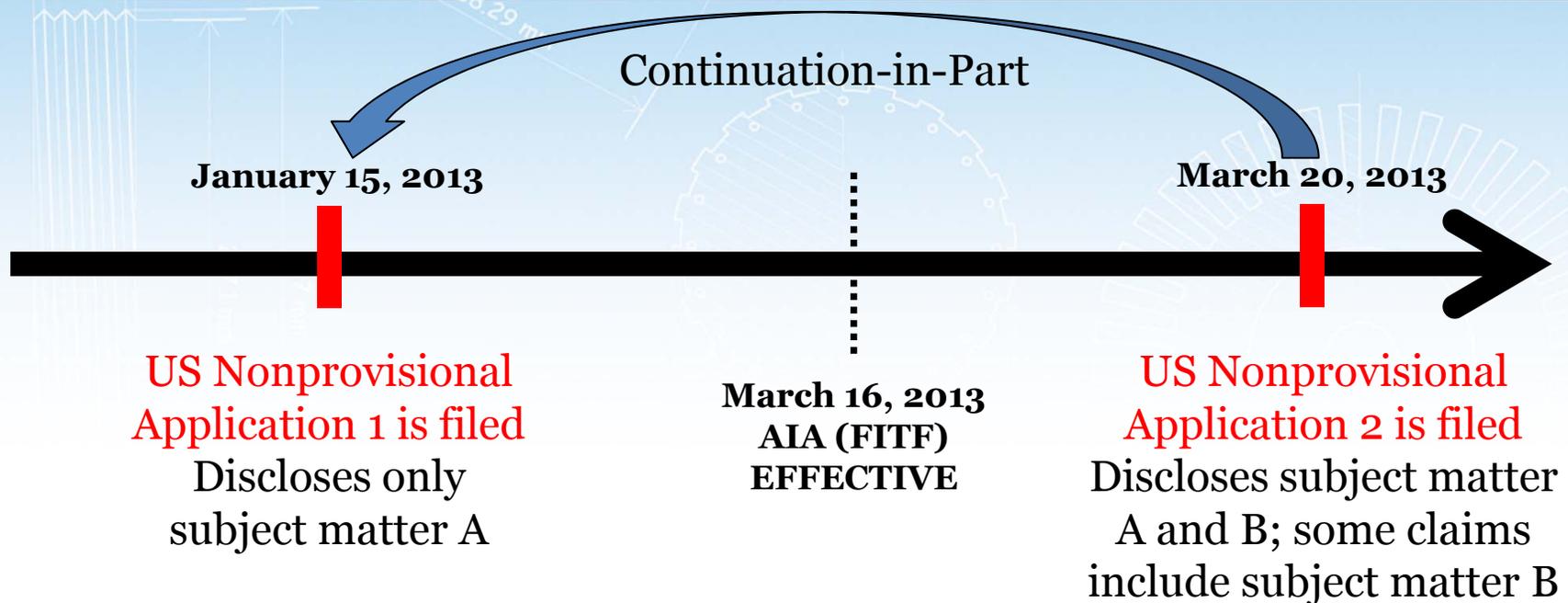
- Texting the code for your answer to **phone number 22333**

OR

- Voting at **pollev.com/uspto4**



Polling Scenario B.1

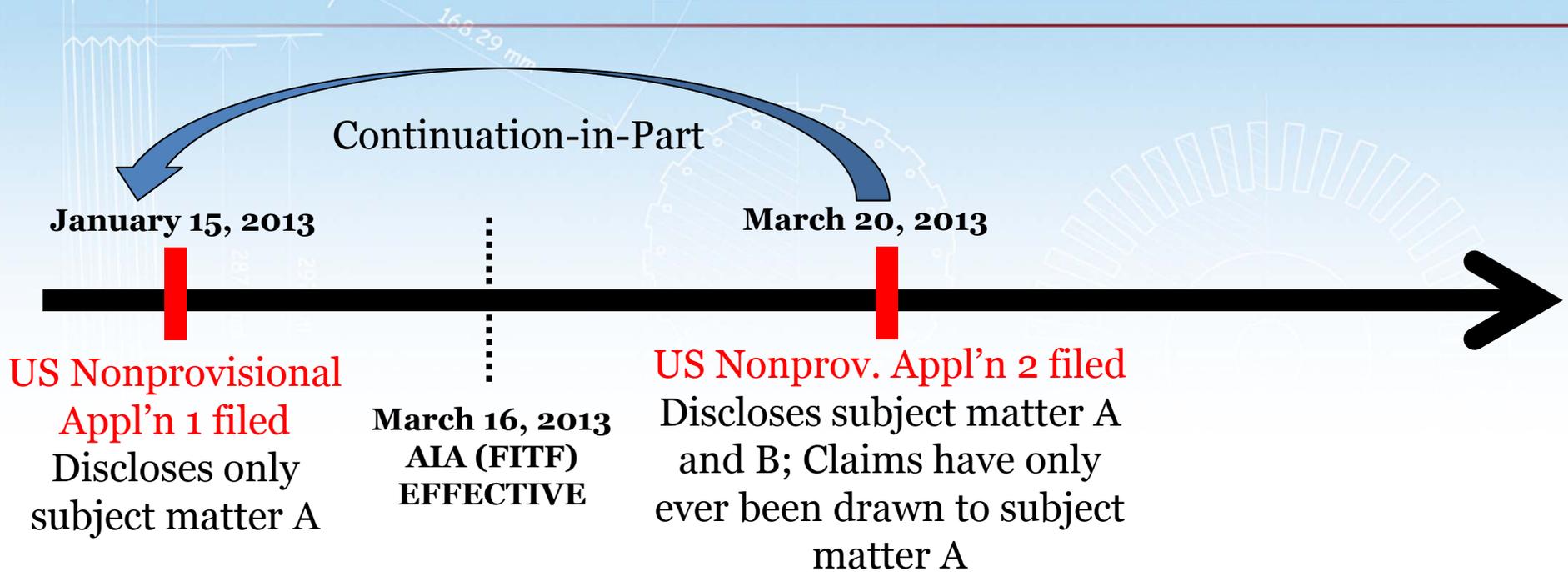


Question B.1 – Should the Applicant make a 1.78 statement in Application 2 resulting in the application being designated as AIA (FITF)?

Answer B.1 – YES. It is a transition application and there is at least one claimed invention having an effective filing date on or after 3/16/13.



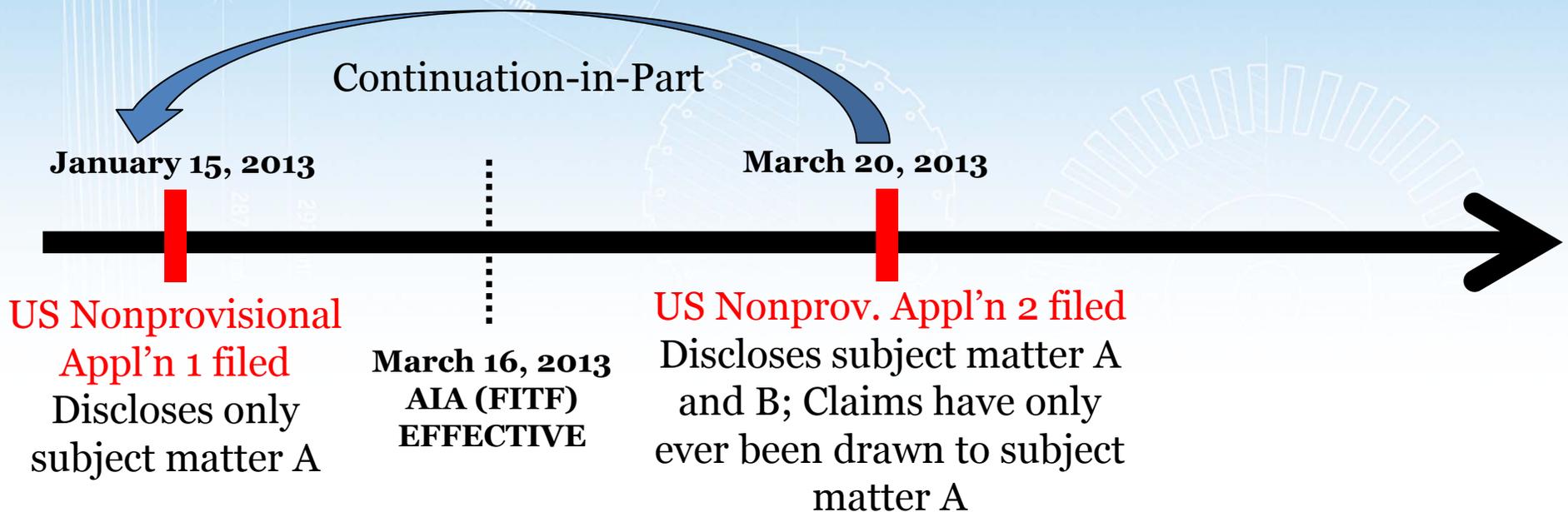
Scenario B.2



Question B.2 – YES OR NO? Should the Applicant make a 1.78 statement in Application 2 resulting in the application being designated as AIA (FITF)?



Scenario B.2

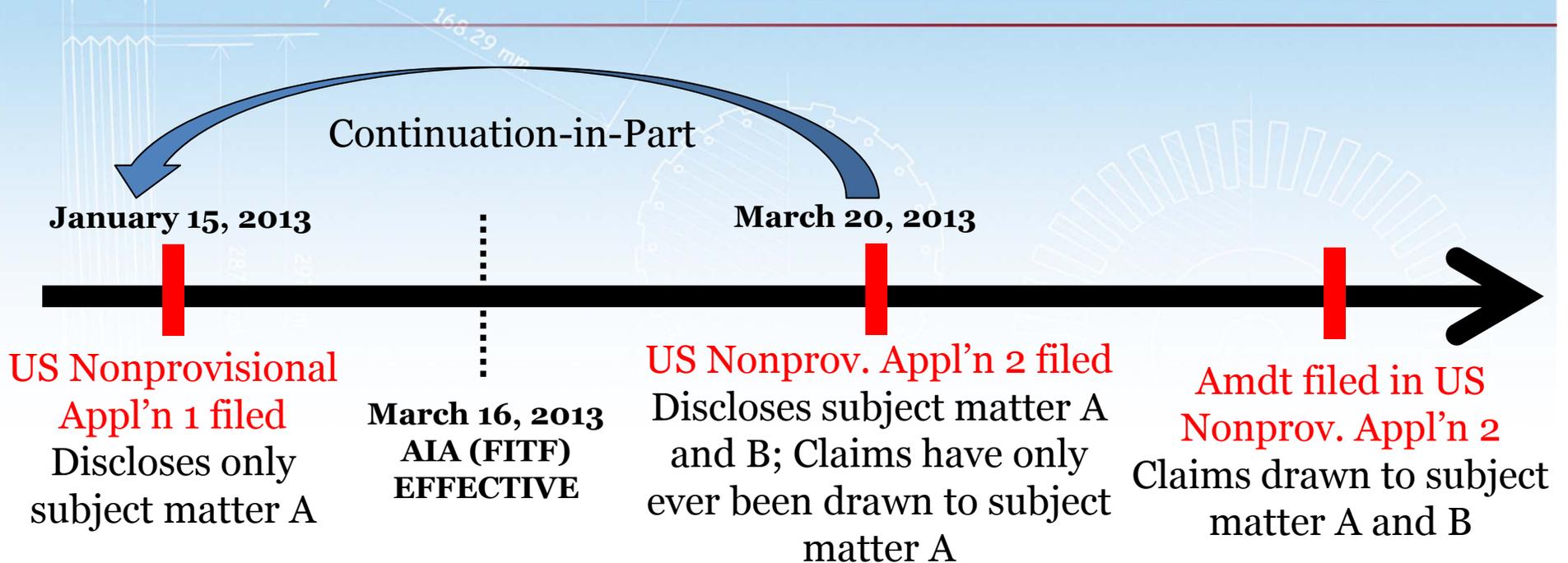


Question B.2 – Should the Applicant make a 1.78 statement in Application 2 resulting in the application being designated as AIA (FITF)?

Answer B.2 – NO. Although it is an Transition Application, there is no claimed invention with an effective filing date on or after 3/16/13.



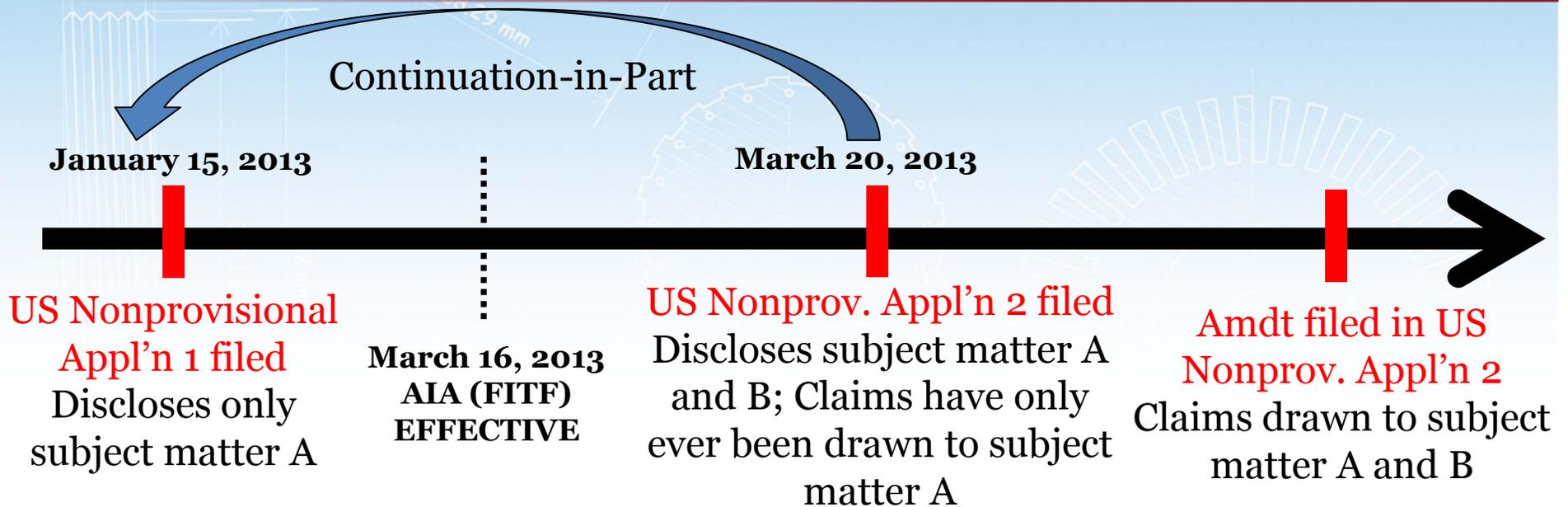
Scenario B.3



Question B.3 – YES OR NO? When the amendment is filed, should the Applicant make a 1.78 statement in Application 2 resulting in Application 2 being designated as AIA (FITF)?



Scenario B.3

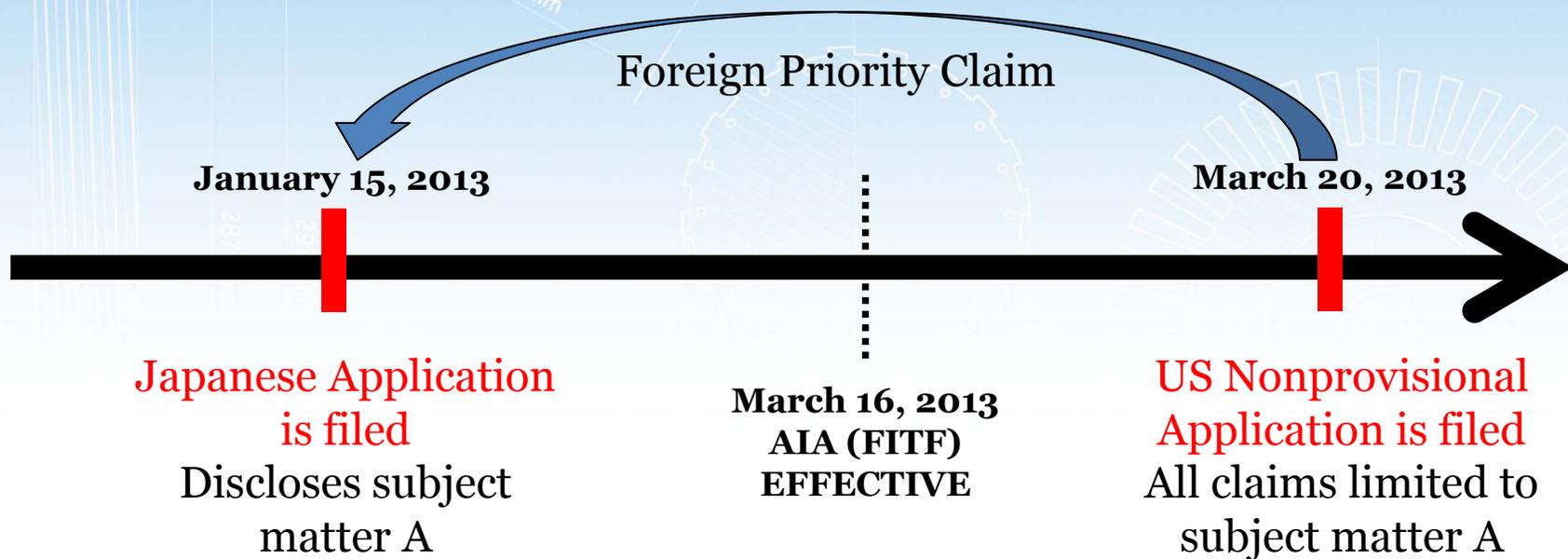


Question B.3 — When the amendment is filed, should the Applicant make a 1.78 statement in Application 2 resulting in the application being designated as AIA (FITF)?

Answer B.3 — YES. The statement should be filed with the amendment either in a separate paper or by corrected ADS.



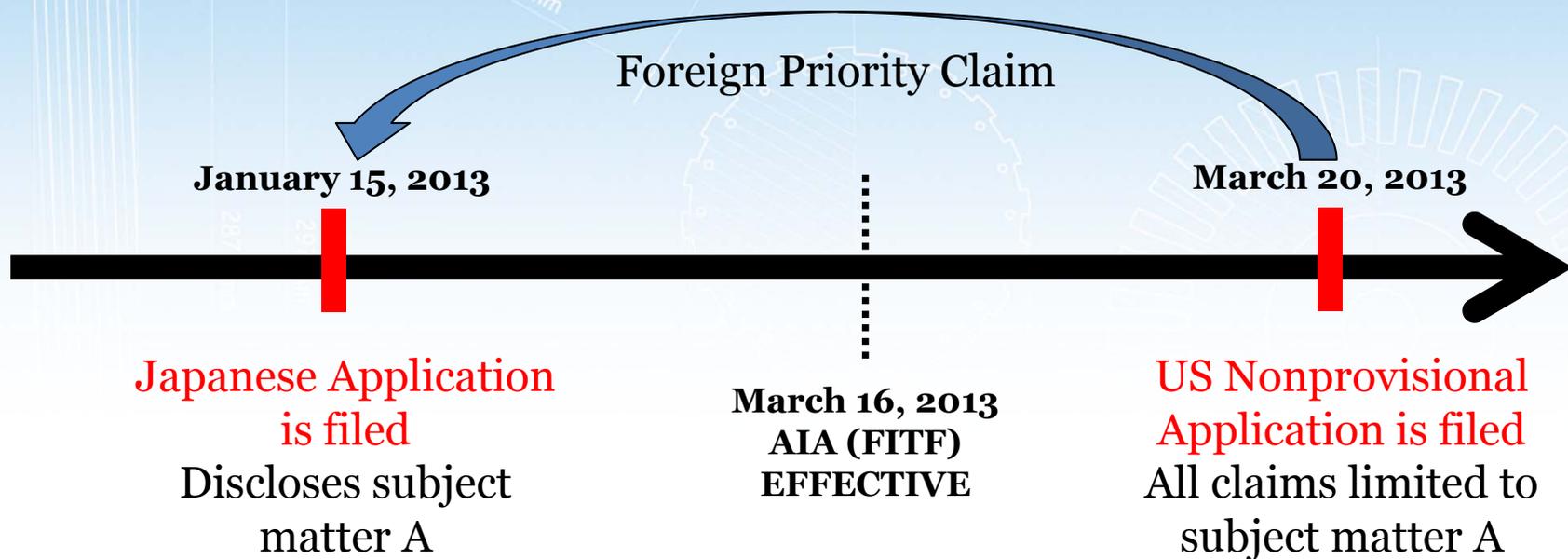
Scenario C.1



Question C.1 — YES OR NO? Should the Applicant make a 1.55 statement in the Nonprovisional Application resulting in the application being designated as AIA (FITF)?



Scenario C.1

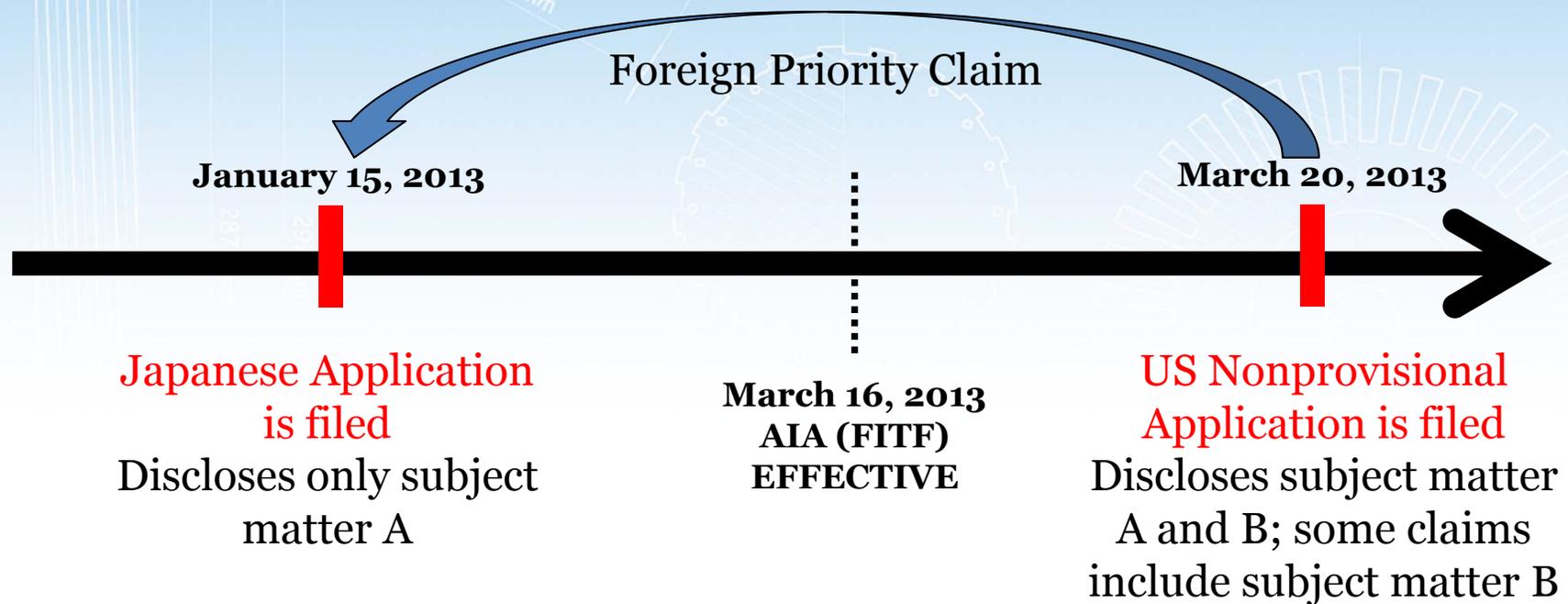


Question C.1 – Should the Applicant make a 1.55 statement in the Nonprovisional Application resulting in the application being designated as AIA (FITF)?

Answer C.1 – NO. Although it is a transition application, there is no claimed invention with an effective filing date on or after 3/16/13.



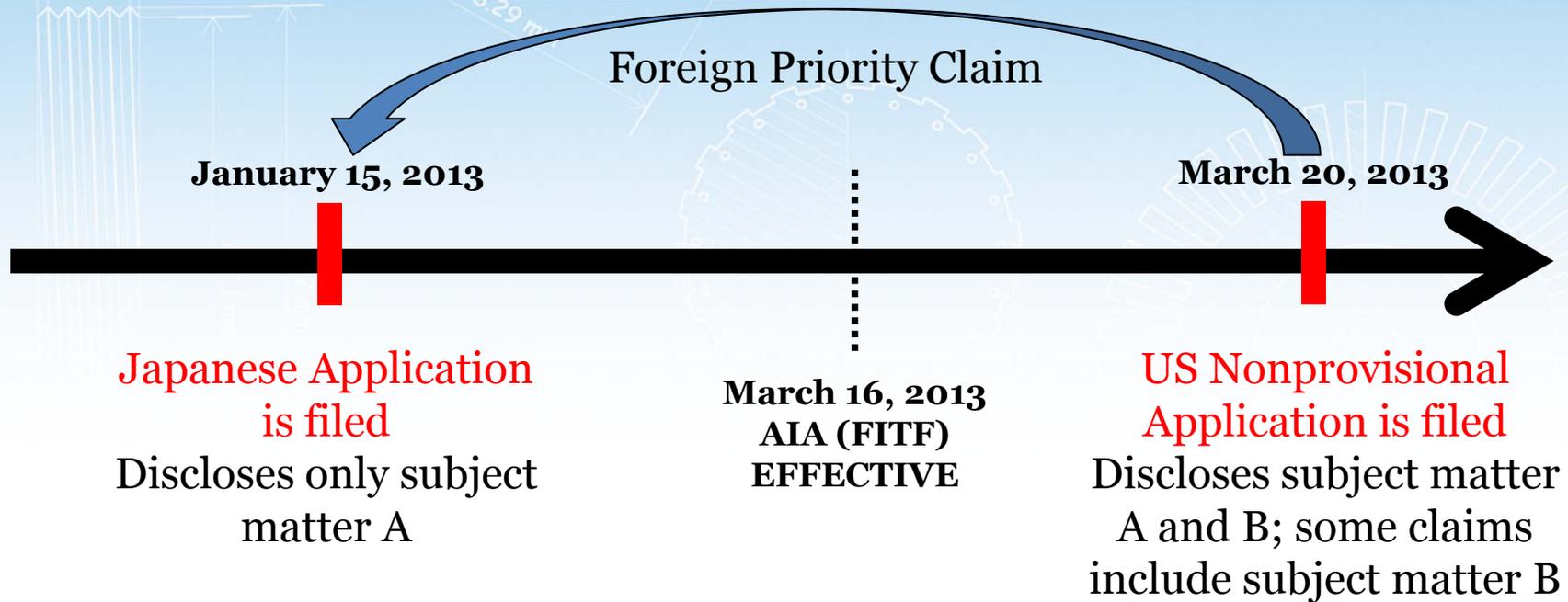
Scenario C.2



Question C.2 – YES OR NO? Should the Applicant make a 1.55 statement in the Nonprovisional Application resulting in the application being designated AIA?



Scenario C.2

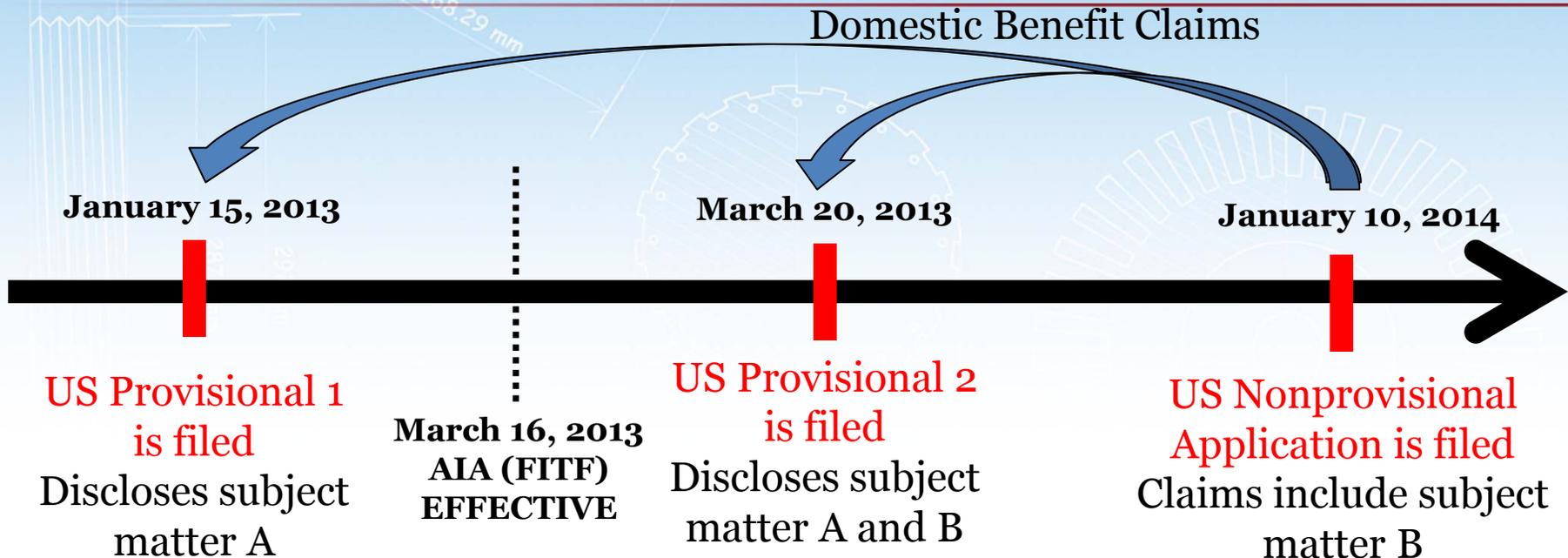


Question C.2 — Should the Applicant make a 1.55 statement in the Nonprovisional Application resulting in the application being designated as AIA (FITF)?

Answer C.2 — YES. It is a transitional application and there is at least one claimed invention having an effective filing date on or after 3/16/13.



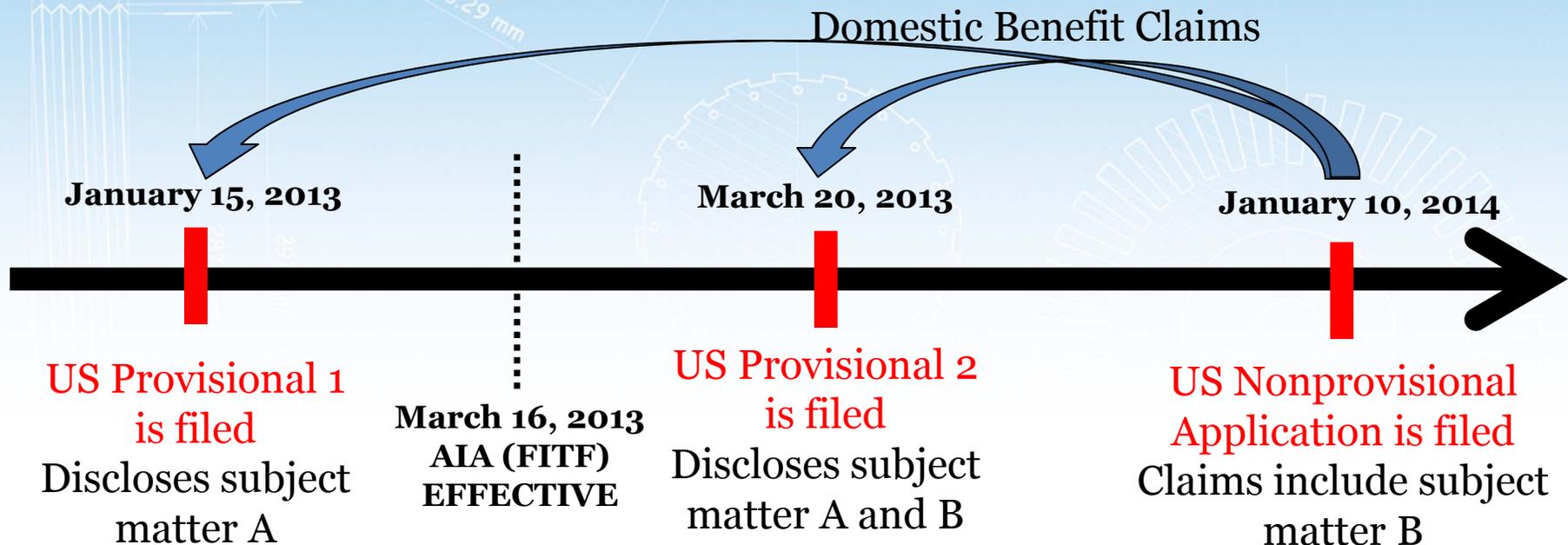
Scenario D.1



Question D.1 – YES OR NO? Should the Applicant make a 1.78 statement in the Nonprovisional Application resulting in the application being designated as AIA (FITF)?



Scenario D.1

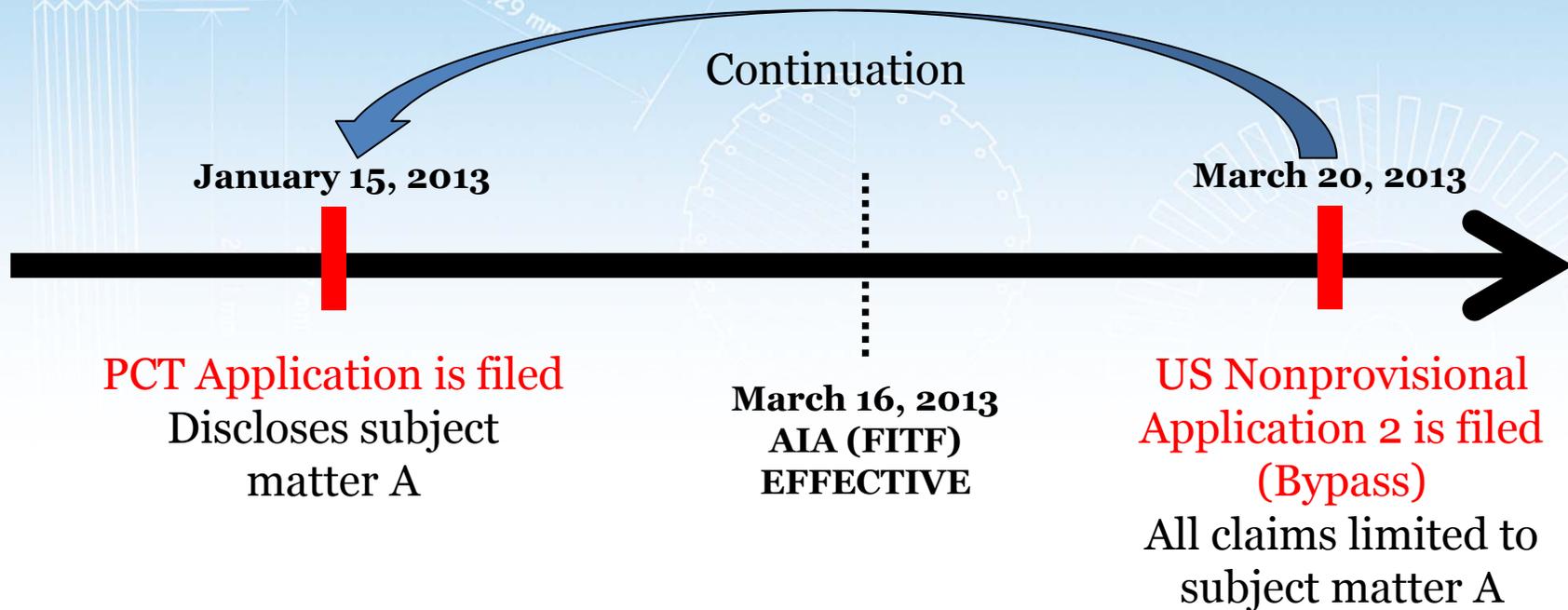


Question D.1 — Should the Applicant make a 1.78 statement in the Nonprovisional Application resulting in the application being designated as AIA (FITF)?

Answer D.1 — YES. It is a transition application with at least one claimed invention having an effective filing date on or after 3/16/13.



Polling Scenario E.1



Question E.1 – YES OR NO? Should the Applicant make a 1.78 statement in Application 2 resulting in the application being designated as AIA (FITF)?



POLLING SLIDE

Please participate in the polling by

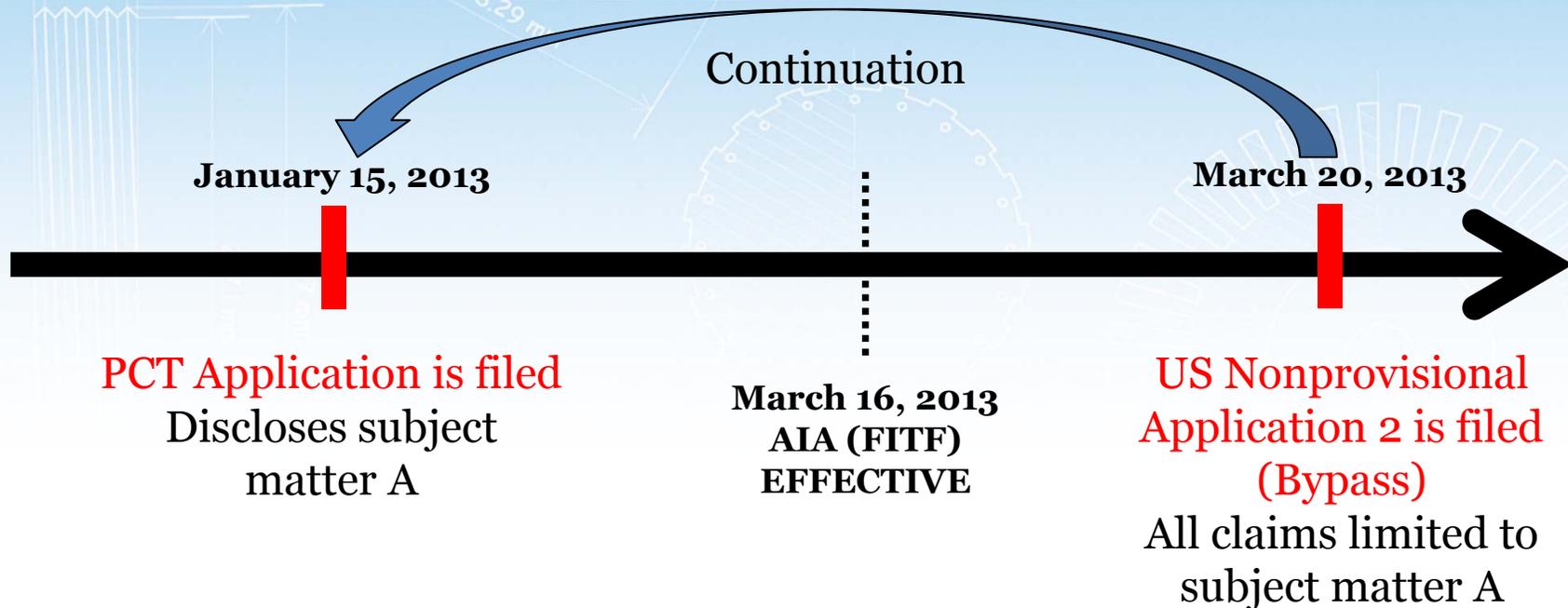
- Texting the code for your answer to **phone number 22333**

OR

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Polling Scenario E.1

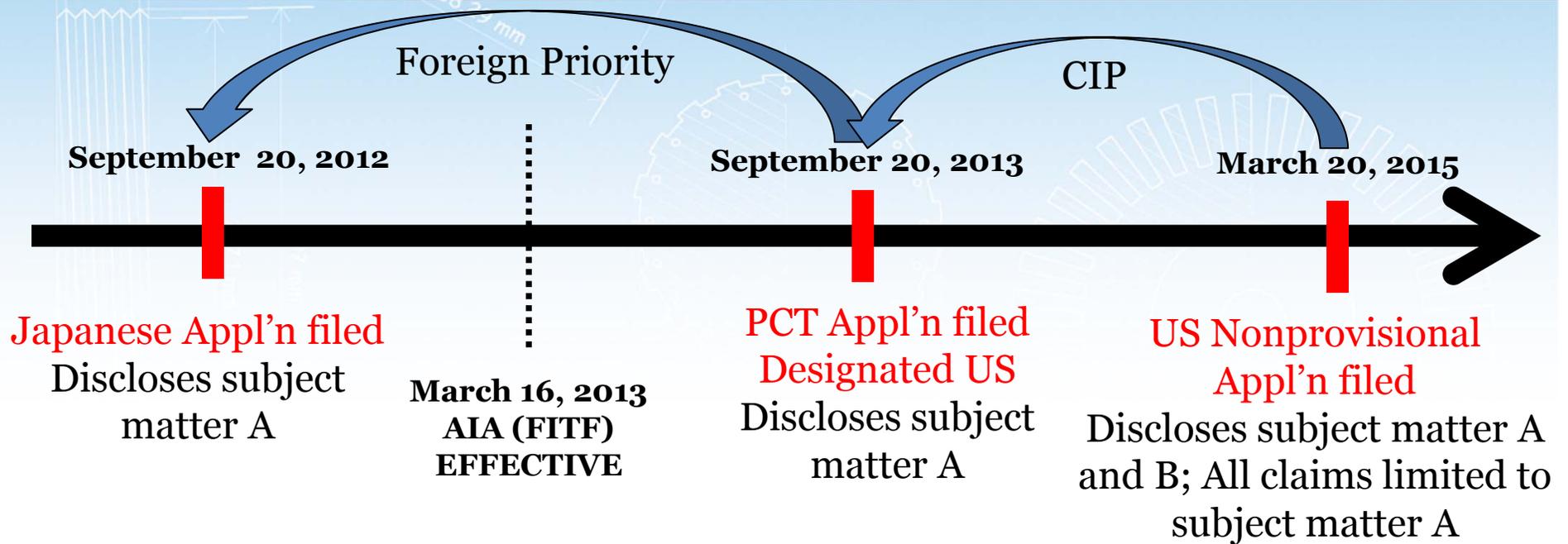


Question E.1 – Should the Applicant make a 1.78 statement in Application 2 resulting in the application being designated as AIA (FITF)?

Answer E.1 – NO. Although Application 2 is a transition application, there is no claimed invention with an effective filing date on or after 3/16/13.



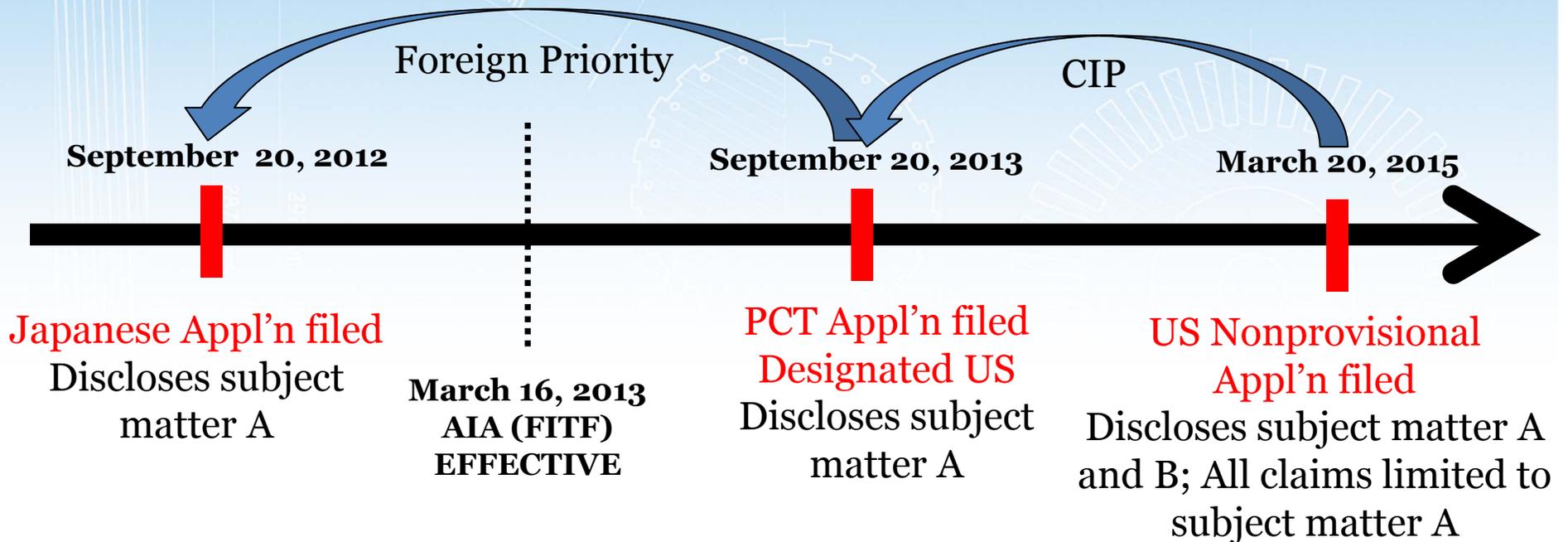
Scenario E.2



Question E.2 – YES OR NO? Should the Applicant make a 1.55 statement in the Nonprovisional Application resulting in the application being designated as AIA (FITF)?



Scenario E.2

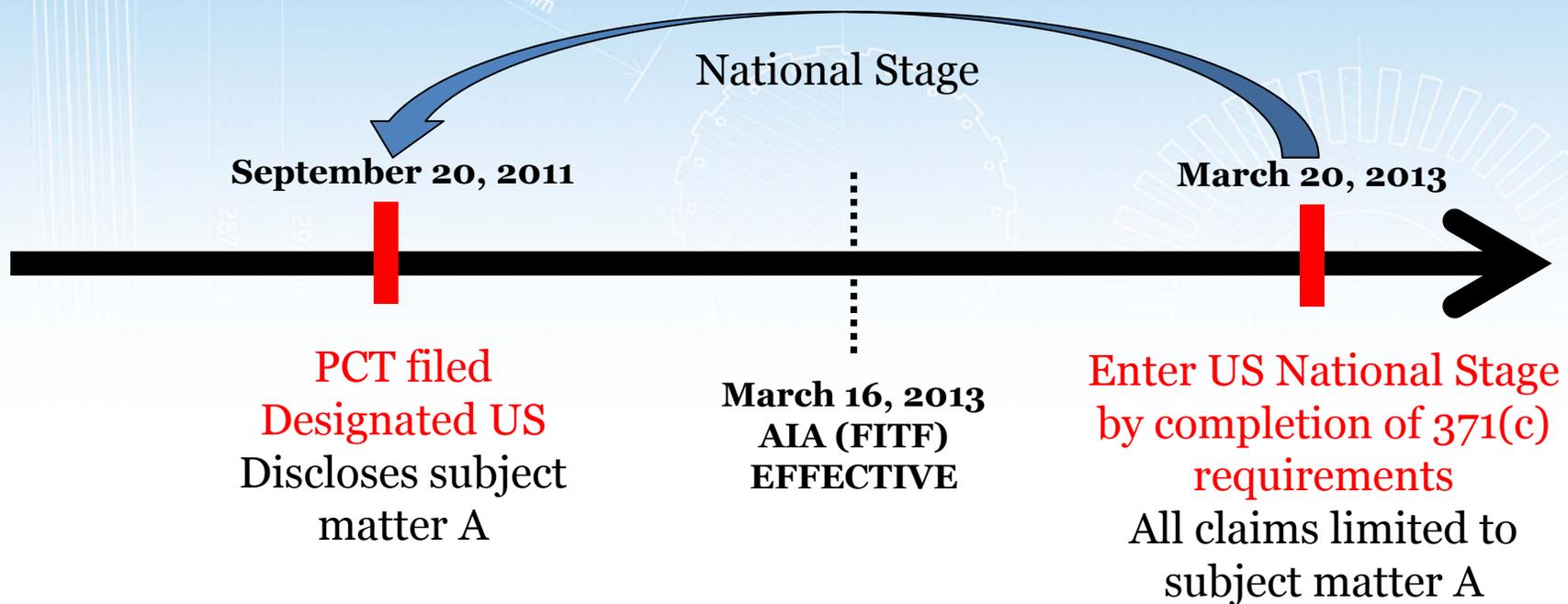


Question E.2 – Should the Applicant make a 1.55 statement in the Nonprovisional Application resulting in the application being designated as AIA (FITF)?

Answer E.2 – NO. Although the Nonprovisional Appl'n is a transition application, there is no claimed invention with an effective filing date on or after 3/16/13.



Polling Bonus Scenario



Bonus Question – YES OR NO? Should the Applicant make a 1.55/1.78 statement resulting in the national stage application being designated as AIA (FITF)?



POLLING SLIDE

Please participate in the polling by

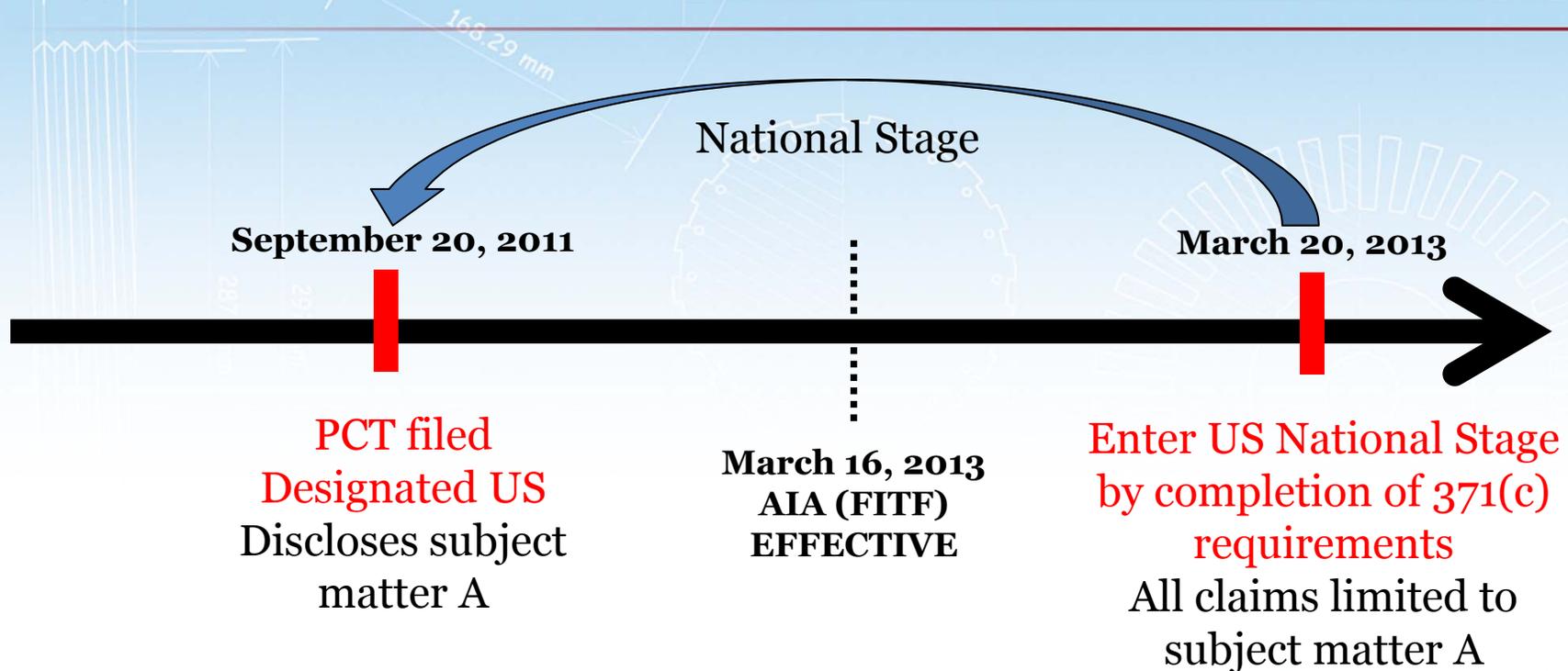
- Texting the code for your answer to **phone number 22333**

OR

- Voting at **pollev.com/uspto4**



Polling Bonus Scenario



Bonus Question — Should the Applicant make a 1.55/1.78 statement resulting in the national stage application being designated as AIA (FITF)?

Bonus Answer: NO. The 371 National Stage Application is not a transition application since its filing date is the filing date of the PCT.



“Take Homes”

- Think carefully about the 1.55/1.78 statement in a transition application
 - Effective filing dates are determined on a claim-by-claim basis
 - It only takes one claim with an effective filing date on or after March 16, 2013 to make the application an AIA (FITF) application
- Continuation-in-part transition applications filed on or after March 16, 2013 are not automatically AIA (FITF).
- Transition applications that claim foreign priority to/benefit of an application filed before March 16, 2013 are not always Pre-AIA (First to Invent).
- Transition CON or DIV applications that include the 1.78 statement appear to be in conflict. A proper transition CON or DIV application would add no new subject matter as compared with the parent, so the effective filing date of all the claims would be prior to March 16, 2013.





AMERICA INVENTS ACT

IMPLEMENTATION

FITF – A Year In Review

Tom Hughes
Supervisory Patent Examiner
Technology Center 3700

Overview

- Review of Examiner Training
- FITF Statistics
- Lessons Learned
 - Application Data Sheets
 - Filing Receipts
 - Statements under 37 CFR 1.55/1.78



Review of Examiner Training

- FITF Overview Training (March 2013)
 - Introductory FITF Video
 - Live Overview Training
 - Follow-up Video



Review of Examiner Training

- FITF Comprehensive Training (Summer 2013)
 - FITF Definitions Video
 - AIA Rules/Regulations (non-FITF)
 - Live Comprehensive Training



Review of Examiner Training

- FITF Hands-On-Workshop (HOW)
 - 1st Session August 2013 (ongoing)
 - Small, Interactive Group Training
 - Live and Webcast sessions offered
 - Brief FITF Overview
 - Mock Application
 - Office Action Preparation



Review of Examiner Training

- AIA (FITF) Indicator Training (January 2014)
 - Determining AIA (FITF) Status
 - Review of AIA (FITF) Indicator
 - Situations Where AIA (FITF) Indicator May Need to be Updated



AIA (FITF) 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	Customer Number:	-
Filing or 371 (c) Date:	03-17-2003	Status:	Patented Case
Application Type:	Utility	Status Date:	01-25-2006
Examiner Name:	Examiner, Pat N.	Location:	ELECTRONIC
Group Art Unit:	2500	Location Date:	-
Confirmation Number:	5711	Earliest Publication No:	US 2004-xxxxxxx A1
Attorney Docket Number:	34977	Earliest Publication Date:	01-15-2004
Class / Subclass:	134/058.00D	Patent Number:	6,xxx,xxx
First Named Inventor:	Doe, John	Issue Date of Patent:	02-14-2005
Entity Status:	Micro	AIA (First Inventor to File):	No

Title of Invention: WIDGET

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



AIA and AIA (FITF)

- AIA (FITF) effective date of March 16, 2013
 - First-Inventor-to-File statutory framework
- Certain other AIA provisions and their corresponding regulations had an effective date of September 16, 2012
 - New rules for oath/declaration
 - Corrected ADS rules



First Inventor To File (FITF) Statistics

Pending Applications (as of January 2014)

- Pre-AIA approximately 86%
- AIA (FITF) approximately 14%



First Inventor To File (FITF) Statistics

Applications filed on or after March 16, 2013

- Pre-AIA approximately 72%
- AIA (FITF) approximately 28%



First Inventor To File (FITF) Statistics

AIA (FITF) Applications*

- 6462 have received at least a first action
 - 3426 Design (53%)
 - 1460 Track One (22.6%)
 - 553 Other Petition to Make Special (8.6%)
 - 1023 Utility (not fast-tracked) (15.8%)
- 3427 have been allowed/patented
 - 2794 Design
 - 633 Utility

*as of February 25, 2014



Lesson Learned

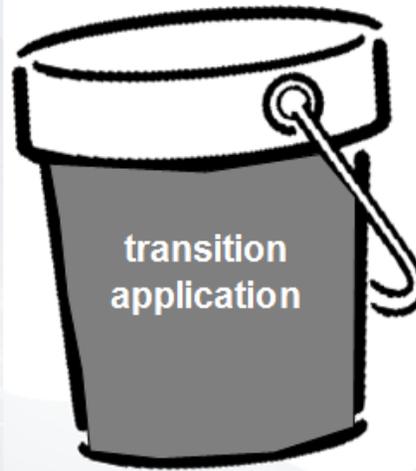
- Application Data Sheets
- Filing Receipts
- 37 CFR 1.55/1.78 Statements



Application Data Sheets, Filing Receipts and 1.55/1.78 Statements



Filed **before** 3/16/2013



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



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

AIA (FITF)-No

**AIA (FITF)-No or
AIA (FITF)-Yes**

AIA (FITF)-Yes



Lessons Learned

Take Home #1

Make sure your Application Data Sheets are accurate and complete



Tips for Application Data Sheets

- Prior to filing an ADS, double check domestic benefit and/or foreign priority claim information (this is required in an ADS for applications filed on or after September 16, 2012)
 - Typos in serial numbers
 - Incorrect filing dates
 - Wrong relationship type (e.g. CON vs. CIP, etc.)



Tips for Application Data Sheets (cont.)

- Be sure to indicate the correct relationship and order of the domestic benefit applications listed on the ADS. If the order is incorrect, then the Office of Patent Application Processing (OPAP) may not accurately capture the entire benefit claim.
 - An example of an incorrect relationship is mis-identifying a 371 national stage entry as a CON of an international application.
 - Another example is non-specific relationship identifiers (e.g. “Continuing” is non-specific; should be Continuation, Divisional or CIP).



Tips for Application Data Sheets (cont.)

- Prior to filing an ADS, review the check box next to the 1.55/1.78 statement
- Below is the 1.55/1.78 statement as it appears in the ADS form PTO/AIA/14.

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.



Tips for Application Data Sheets (cont.)

- Do NOT check the 1.55/1.78 statement in transition applications that are proper CONs or DIVs of a parent application filed prior to March 16, 2013.
 - Since March 16, 2013, we have mailed CON/DIV conflict letters and changed the AIA indicator in over 2,000 applications.



Tips for Application Data Sheets (cont.)

CON/DIV conflict letter

Application Identified as a Pre-AIA Application Despite the 37 CFR 1.55 or 1.78 Statement of Record

The statement under 37 CFR 1.55 or 1.78 (“the 1.55/1.78 statement”) and the domestic benefit/national stage information in this application conflict as to whether this application is to be examined under the AIA (First Inventor to File) or pre-AIA (First to Invent) law.

This application, with a filing date on or after March 16, 2013, contains the 1.55/1.78 statement indicating that this application should be examined under the AIA (First Inventor to File). This statement was either (1) on the Application Data Sheet (ADS) by virtue of the 1.55/1.78 statement for AIA (First Inventor to File) Transition Applications check box being selected or (2) in an otherwise filed paper. The 1.55/1.78 statement provided:

This application * * * contains, or contained at any time, a claim to a claimed invention that has an effective filing date on or after March 16, 2013.

However, this application is separately identified in the Domestic Benefit/National Stage Information section of the ADS as a continuation (CON) or divisional (DIV) of an application filed before March 16, 2013, indicating that this application should be examined under pre-AIA . . .



Tips for Application Data Sheets (cont.)

- A corrected ADS should be accompanied by a properly identified/indexed paper requesting action, such as,
 - a **request for a corrected filing receipt** or
 - a request to correct inventorship (Rule 48 petition)

Information regarding proper indexing of papers can be found at the following three web sites:

http://www.uspto.gov/ebc/portal/efs/rules_doc_codes.htm

<http://www.uspto.gov/patents/process/file/efs/guidance/EFS-WebQuickStartGuide.pdf>

<http://www.uspto.gov/ebc/portal/efs/cbt/efs-web-training.ppt>



Tips for Application Data Sheets (cont.)

- A corrected ADS (for applications filed on or after September 16, 2012) must be marked up as set forth in 37 CFR 1.76(c).
- A corrected ADS showing changes relative to the information of record is required regardless of whether an ADS has been previously filed or not.
- The corrected ADS will not be processed unless markings showing the changes are provided.



Tips for Application Data Sheets (cont.)

- Foreign priority and domestic benefit claims in applications filed on or after September 16, 2012 **MUST** appear in an ADS. See 37 CFR 1.55 for foreign priority claims and 37 CFR 1.78 for domestic benefit claims.
 - Priority/benefit claims made in the first line of the specification or in the oath/declaration are not effective and will NOT be reflected in the filing receipt.
- Make sure the ADS is properly signed.



Lessons Learned

Take Home #2

Check your filing receipts!



Tips for Filing Receipts

- Make sure the information in the filing receipt you receive is correct. In particular, check your filing receipt to make sure that:
 - all domestic benefit and/or foreign priority claims have been accurately captured and
 - the presence or absence of a 1.55/1.78 statement has been accurately captured.



Tips for Filing Receipts (cont.)

Filing receipt

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(c) DATE	GRP ART UNIT	FIL FEE REC'D	ATTY DOCKET NO	TOT CLAIMS	IND CLAIMS
59/956,507	02/03/2014	3773	1260	45456-0102	12	1

CONFIRMATION NO. 7285

12346

FILING RECEIPT



*OC00000057605684

Inventor(s)
Charles Jordan, Sr. Brooklyn, NY
Alexander Robert Thompson, New York, NY
Kwan Jian Pak Seoul, KOREA, REPUBLIC OF

Applicant(s)
VICTOR PEST CONTROL COMPANY

Assignment For Published Patent Application
VICTOR PEST CONTROL COMPANY

Power of Attorney: The patent practitioners associated with Customer Number 12346

Domestic Priority data as claimed by applicant
NONE

Foreign Applications for which priority is claimed (You may be eligible to benefit from the Patent Prosecution Highway program at the USPTO. Please see <http://www.uspto.gov> for more information.)
REPUBLIC OF KOREA 12-2013-004567892 10/2/2013
Foreign application information must be provided in an Application Data Sheet in order to constitute a claim to foreign priority. See 37 CFR 1.55 and 1.76.

Domestic Benefit Data

Foreign Priority Data



Tips for Filing Receipts (cont.)

1.55/1.78 statement
provided?

Filing receipt, page 2

Preliminary is

132

Statement under 37 CFR 1.55 or 1.78 for AIA (First Inventor to File) Transition Applications: No

PROTECTING YOUR INVENTION OUTSIDE THE UNITED STATES

Since the rights granted by a U.S. patent extend only throughout the territory of the United States and have no effect in a foreign country, an inventor who wishes patent protection in another country must apply for a patent in a specific country or in regional patent offices. Applicants may wish to consider the filing of an international application under the Patent Cooperation Treaty (PCT). An international (PCT) application generally has the same effect as a regular national patent application in each PCT-member country. The PCT process **simplifies** the filing of patent applications on the same invention in member countries, but **does not result** in a grant of "an international patent" and does not eliminate the need of applicants to file additional documents and fees in countries where patent protection is desired.

Almost every country has its own patent law, and a person desiring a patent in a particular country must make an application for patent in that country in accordance with its particular laws. Since the laws of many countries differ in various respects from the patent law of the United States, applicants are advised to seek guidance from specific foreign countries to ensure that patent rights are not lost prematurely.

Applicants also are advised that in the case of inventions made in the United States, the Director of the USPTO must issue a license before applicants can apply for a patent in a foreign country. The filing of a U.S. patent application serves as a request for a foreign filing license. The application's filing receipt contains further information and guidance as to the status of applicant's license for foreign filing.

Applicants may wish to consult the USPTO booklet, "General Information Concerning Patents" (specifically, the section entitled "Treaties and Foreign Patents") for more information on timeframes and deadlines for filing foreign patent applications. The guide is available either by contacting the USPTO Contact Center at 800-786-9199, or it can be viewed on the USPTO website at <http://www.uspto.gov/web/offices/pac/doc/general/index.html>.

For information on preventing theft of your intellectual property (patents, trademarks and copyrights), you may wish to consult the U.S. Government website, <http://www.stopfakes.gov>. Part of a Department of Commerce initiative, this website includes self-help "toolkits" giving innovators guidance on how to protect intellectual property in specific countries such as China, Korea and Mexico. For questions regarding patent enforcement issues, applicants may call the U.S. Government hotline at 1-866-999-HALT (1-866-999-4258).



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IMPLEMENTATION

Tips for Filing Receipts (cont.)

- If any information you provided on the ADS was not accurately captured by the USPTO, file a request for a corrected filing receipt.
- If review of the filing receipt and the ADS identifies applicant errors, file both:
 - a request to correct the filing receipt and
 - a corrected ADS



Lessons Learned

Take Home #3

1.55/1.78 statements are not as simple as they appear



Tips for 1.55/1.78 Statements

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.



Tips for 1.55/1.78 Statements (cont.)

- An applicant in a transition application making a 1.55/1.78 statement is asserting that a claim to an invention having an effective filing date on or after March 16, 2013 is present or ever has been present in the application.



Tips for 1.55/1.78 Statements (cont.)

- Applicants can make a 1.55/1.78 statement by checking the box on the ADS or in a separate paper.
 - When 1.55/1.78 statements are made in a separate paper, they should be clear and concise statements



Tips for 1.55/1.78 Statements (cont.)

- If an applicant discovers that a 1.55/1.78 statement was made in error, the statement can be rescinded.
 - When making or rescinding a 1.55/1.78 statement in a separate paper, the paper must be clearly identified as either:
 - “Statement under 37 CFR 1.55 or 1.78;” or
 - “Rescission of a Statement under 37 CFR 1.55 or 1.78”
- When filing the 1.55/1.78 statement online in a separate paper, applicant must select the document description “Make/Rescind AIA (First Inventor to File) 1.55/1.78 Stmnt”



Summary of Lessons Learned

- 1) Make sure your Application Data Sheets are complete and accurate
- 2) Check your filing receipts
- 3) 1.55/1.78 statements are not as simple as they appear





AMERICA INVENTS ACT

IMPLEMENTATION

FITF Overview and Tips on Responding to Prior Art Rejections

Kathleen K. Fonda
Senior Legal Advisor
Office of Patent Legal Administration

Potential Prior Art Is Identified in 35 U.S.C. 102(a)(1) and 102(a)(2)

Only two subsections of the AIA identify potential prior art:

- **102(a)(1)** is for **public disclosures** that have a public availability date *before the effective filing date* of the claimed invention under examination.
- **102(a)(2)** is for issued or published U.S. patent documents that are by another and that have an effectively filed date that is *before the effective filing date* of the claimed invention under examination.



Effective Filing Date under the AIA

- The availability of a disclosure as prior art under 102(a)(1) or 102(a)(2) depends upon the effective filing date (EFD) of the claimed invention.
- Unlike pre-AIA law, the AIA provides that a foreign priority date can be the effective filing date of a claimed invention.
- **During examination, the foreign priority date is treated as the effective filing date of the claimed invention IF**
 - the foreign application supports the claimed invention under 112(a), AND
 - the applicant has perfected the right of priority by providing:
 - a certified copy of the priority application, and
 - a translation of the priority application (if not in English).



AIA Statutory Framework

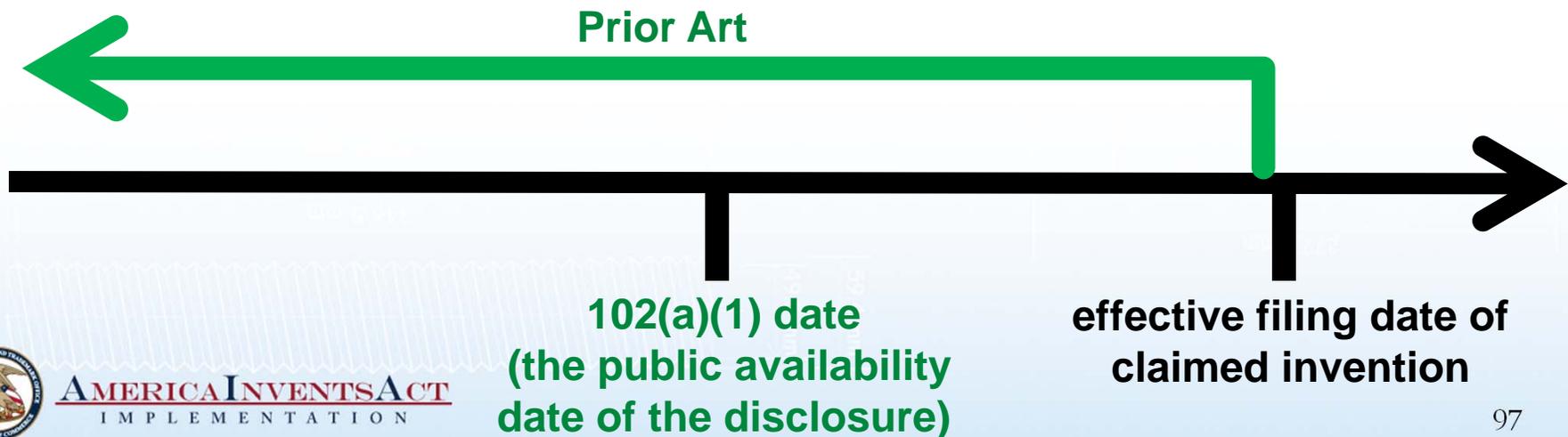
Prior Art 35 U.S.C. 102(a) (Basis for Rejection)	Exceptions 35 U.S.C. 102(b) (Not Basis for Rejection)	
102(a)(1) Disclosure with Prior Public Availability Date	102(b)(1)	(A) Grace Period Disclosure by Inventor or Obtained from Inventor
		(B) Grace Period Intervening Disclosure by Third Party
102(a)(2) 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



35 U.S.C. 102(a)(1): Public Disclosure with Public Availability Date before the Effective Filing Date of the Claimed Invention

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.



102(b)(1)(A) Exception to Potential Prior Art under 35 U.S.C. 102(a)(1)

For the 102(b)(1)(A) exception to apply to a public disclosure under 102(a)(1), the public disclosure must be:

- within the grace period and
- an "inventor-originated disclosure" (i.e., the subject matter in the public disclosure must be attributable to the inventor, one or more co-inventors, or another who obtained the subject matter directly or indirectly from the inventor or a co-inventor).



102(b)(1)(B) Exception to Potential Prior Art under 35 U.S.C. 102(a)(1)

For the 102(b)(1)(B) exception to apply to a third party's disclosure under 102(a)(1):

- the third party's disclosure must have been made during the grace period of the claimed invention,
- an inventor-originated disclosure (i.e., shielding disclosure) must have been made prior to the third party's disclosure, and
- both the third party's disclosure and the inventor-originated disclosure must have disclosed the same subject matter.



Recognizing a 102(b)(1)(A) or 102(b)(1)(B) Exception to a Potential 102(a)(1) Reference

An exception under 102(b)(1)(A) or 102(b)(1)(B) may apply when:

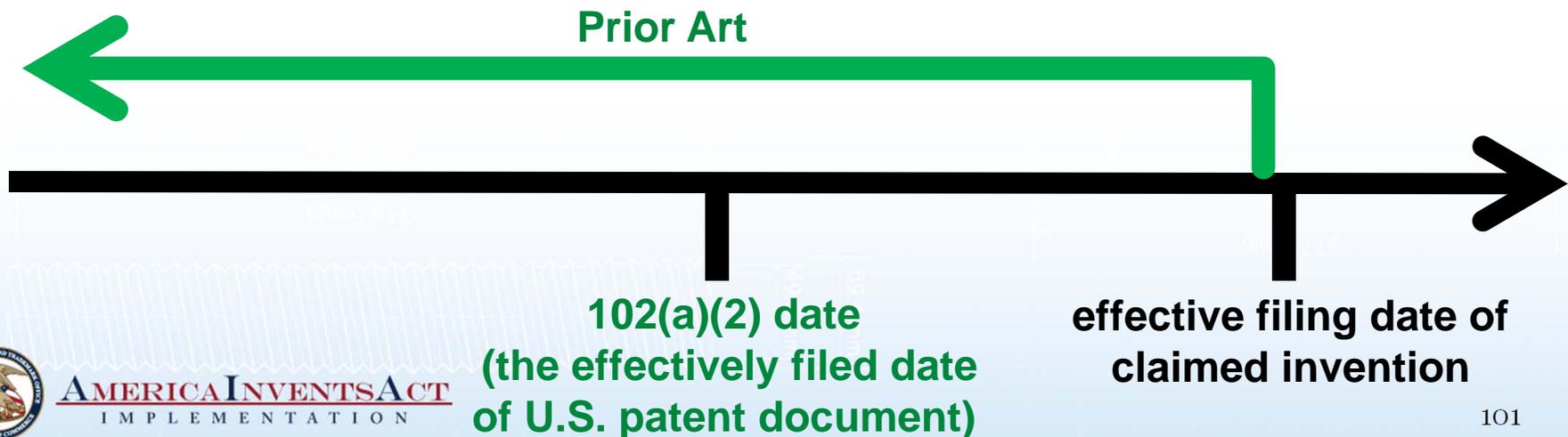
- the authorship/inventorship of the potential reference disclosure only includes one or more joint inventor(s) or the entire inventive entity of the application under examination, or
- there is an appropriate affidavit or declaration under 37 CFR 1.130(a) (attribution) or 1.130(b) (prior public disclosure), or
- the specification of the application under examination identifies the potential prior art disclosure as having been made by or having originated from one or more members of the inventive entity, in accordance with 37 CFR 1.77(b)(6).



35 U.S.C. 102(a)(2): U.S. Patent Documents with Effectively Filed Date before Effective Filing Date of the Claimed Invention

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



102(b)(2)(A) Exception to Potential Prior Art under 35 U.S.C. 102(a)(2)

For the 102(b)(2)(A) exception to apply to a potential prior art U.S. patent document, the U.S. patent document must:

- disclose subject matter that was obtained from one or more members of the inventive entity, either directly or indirectly.



102(b)(2)(B) Exception to Potential Prior Art under 35 U.S.C. 102(a)(2)

For the 102(b)(2)(B) exception to apply to a third party's potential prior art U.S. patent document:

- the third party's U.S. patent document must have been effectively filed before the effective filing date of the claimed invention,
- an inventor-originated disclosure (i.e., shielding disclosure) must have been made prior to the effectively filed date of the third party's U.S. patent document, and
- both the third party's U.S. patent document and the inventor-originated disclosure must have disclosed the same subject matter.



Recognizing a 102(b)(2)(A) or 102(b)(2)(B) Exception to a Potential 102(a)(2) Reference

An exception under 102(b)(2)(A) or 102(b)(2)(B) may apply when:

- the inventive entity of the disclosure only includes one or more joint inventor(s), *but not the entire inventive entity*, of the application under examination, or
- there is an appropriate affidavit or declaration under 37 CFR 1.130(a) (attribution) or 1.130(b) (prior public disclosure), or
- the specification of the application under examination identifies the potential prior art disclosure as having been made by or having originated from one or more members of the inventive entity, in accordance with 37 CFR 1.77(b)(6).



102(b)(2)(C) Exception to Potential Prior Art under 35 U.S.C. 102(a)(2)

For the 102(b)(2)(C) exception to apply, the subject matter of the U.S. patent document and the claimed invention in the application under examination must have been:

- owned by the same person,
- subject to an obligation of assignment to the same person, or
- deemed to have been owned by or subject to an obligation of assignment to the same person, in view of a joint research agreement,

not later than the effective filing date of the claimed invention.



Recognizing a 102(b)(2)(C) Exception to a Potential 102(a)(2) Reference

- A statement on the record that either common ownership in accordance with 102(b)(2)(C) or a joint research agreement (JRA) in accordance with 102(c) were in place may be made.
- A declaration or affidavit is not necessary.
- In the case of a JRA, the application must name or be amended to name the parties to the JRA.





AMERICA INVENTS ACT

IMPLEMENTATION

First Inventor To File (FITF)

Sample Scenarios

Test Your Knowledge!

Consider the following first-inventor-to-file examination scenarios and choose the best answer.

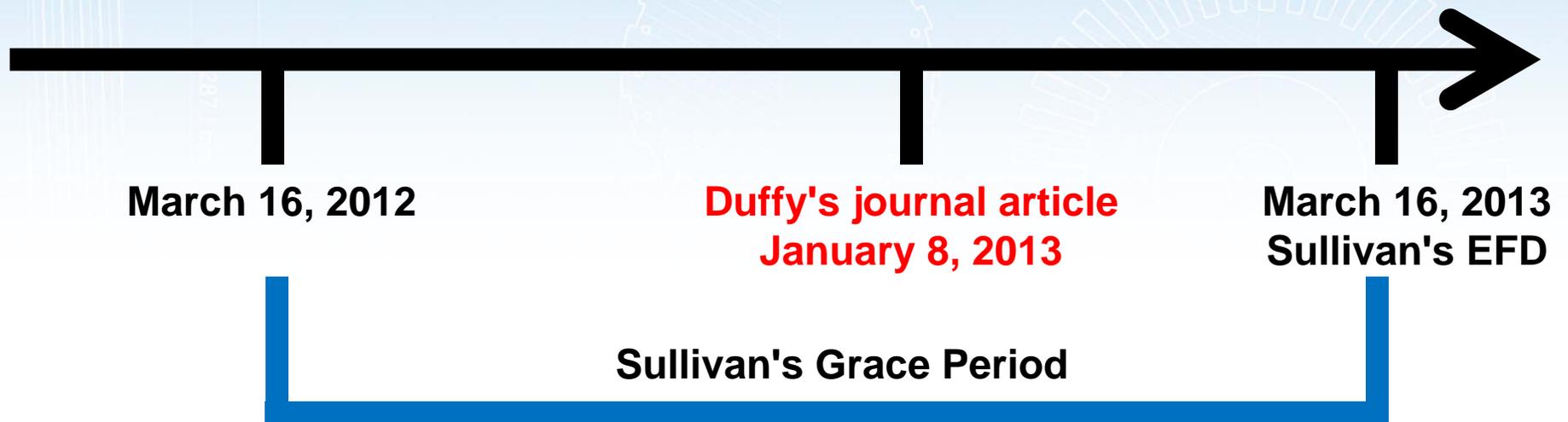


Scenario 1. Traversing a Rejection under 35 U.S.C. 102(a)(1)

- On March 16, 2013, Sullivan files a nonprovisional utility patent application at the USPTO.
- Sullivan does not assert any foreign priority or domestic benefit under 35 U.S.C. 119, 120, 121, or 365.
- The patent examiner rejects all of the claims as anticipated under 35 U.S.C. 102(a)(1) by a journal article to Duffy, which became available to the public on January 8, 2013.



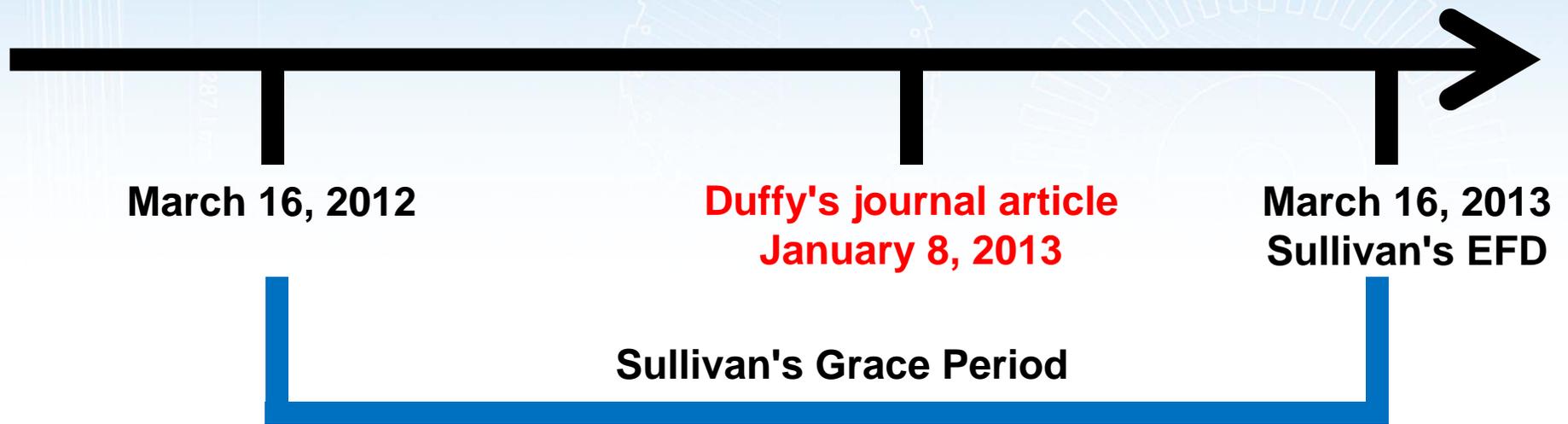
Scenario 1. Traversing a Rejection under 35 U.S.C. 102(a)(1)



How could Sullivan properly traverse the examiner's 102(a)(1) rejection over Duffy?



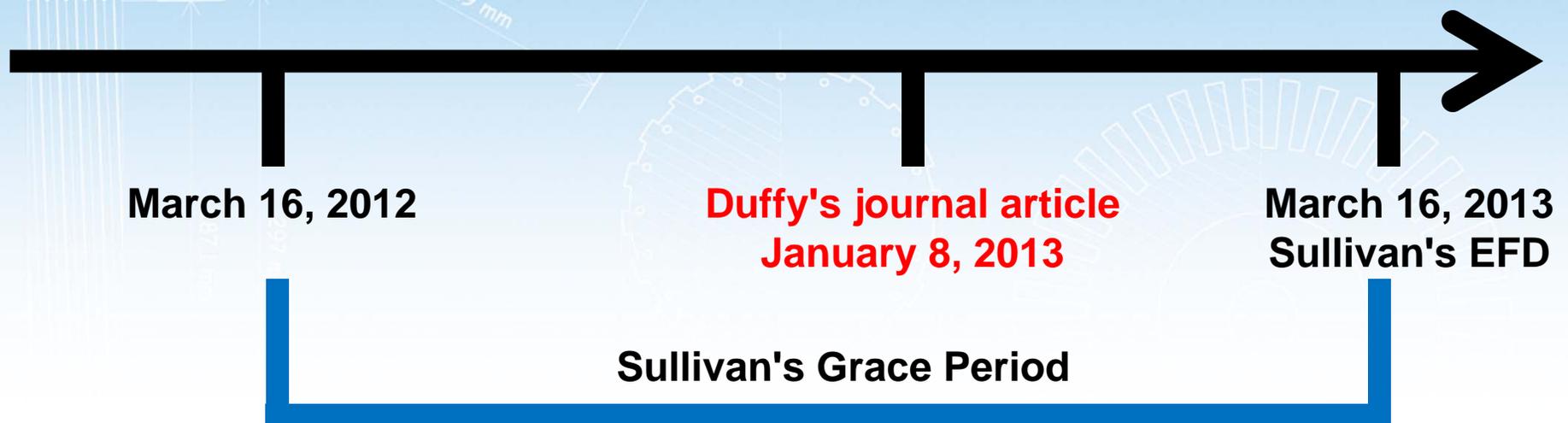
Scenario 1. Traversing a Rejection under 35 U.S.C. 102(a)(1)



Q1.1 – TRUE OR FALSE? Sullivan could properly traverse by arguing that the Duffy article is not prior art under 102(a)(1) because it became available to the public during Sullivan's one-year grace period.



Scenario 1. Traversing a Rejection under 35 U.S.C. 102(a)(1)

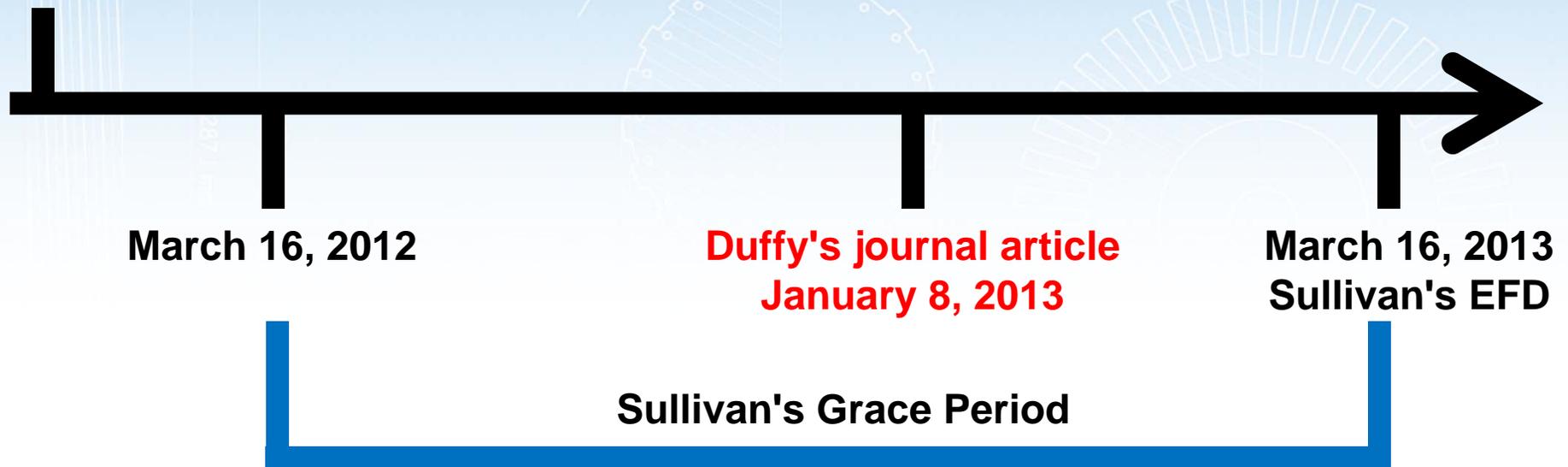


A1.1 – FALSE. The subject matter of the Duffy article did not originate with Sullivan, so 102(b)(1)(A) does not apply. Likewise, Sullivan (or another who got the information from him) did not disclose the subject matter within the year prior to his filing date and before the Duffy article, so 102(b)(1)(B) also does not apply.



Scenario 1. Traversing a Rejection under 35 U.S.C. 102(a)(1)

December 13, 2011
Sullivan's invention date

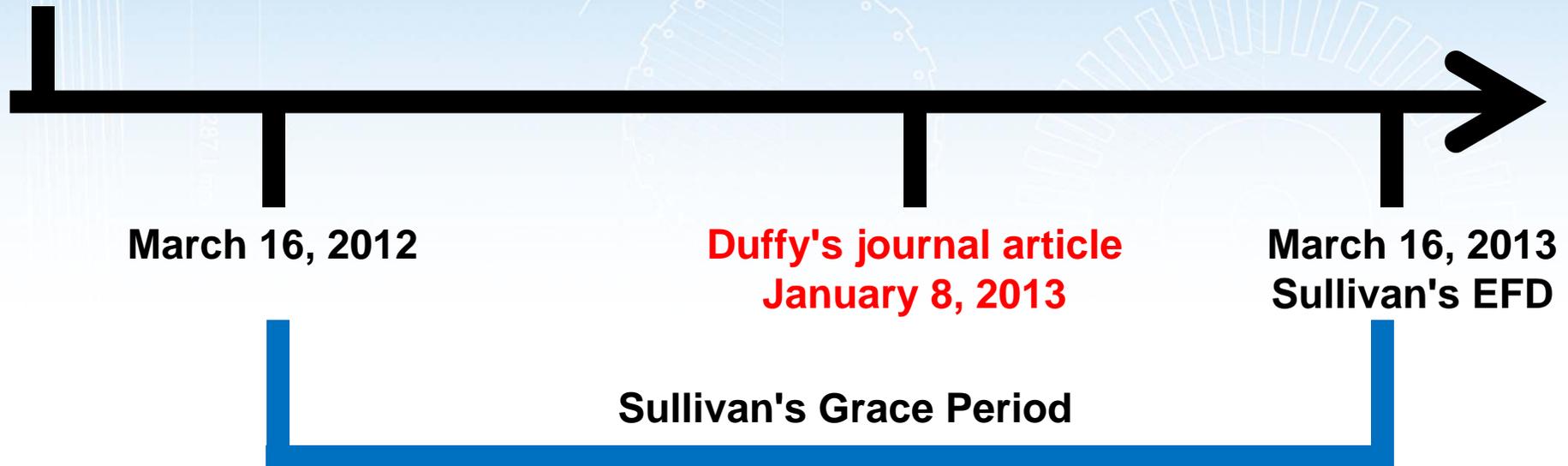


Q1.2 – TRUE OR FALSE? Sullivan could properly traverse the rejection by presenting a declaration under 37 CFR 1.131 establishing that Sullivan's invention date was December 13, 2011.



Scenario 1. Traversing a Rejection under 35 U.S.C. 102(a)(1)

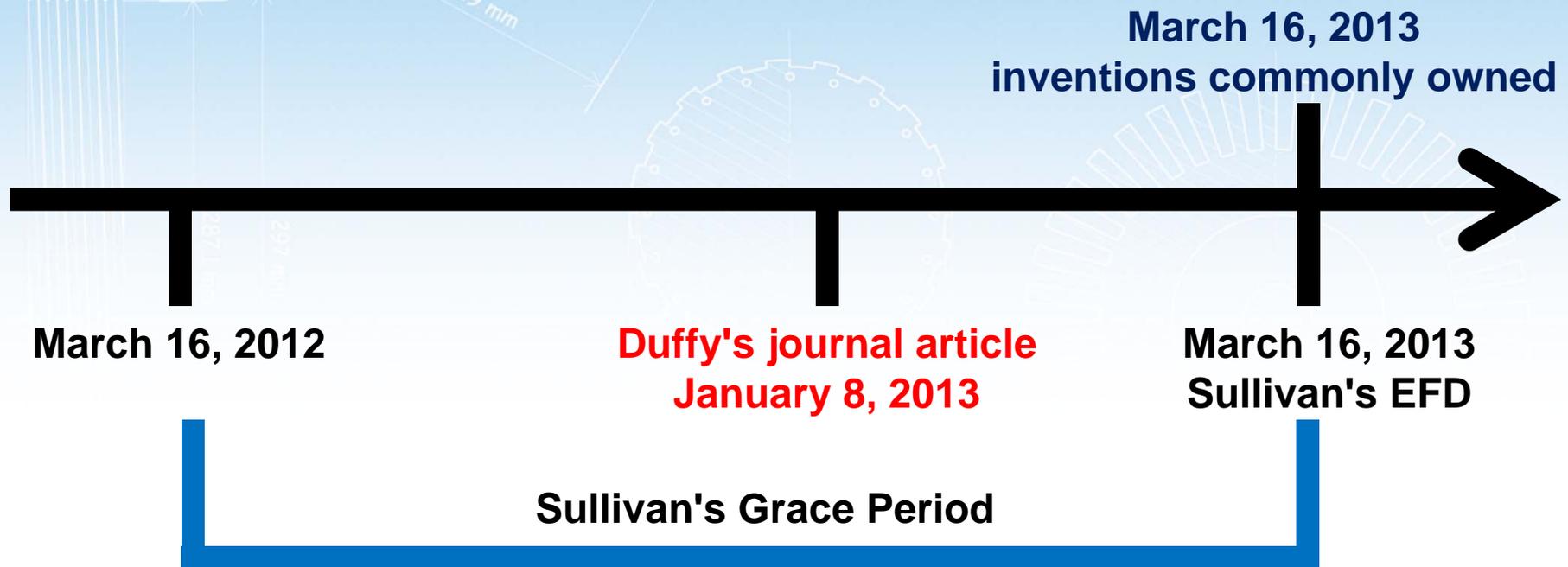
December 13, 2011
Sullivan's invention date



A1.2 – FALSE. Because the AIA is a first-inventor-to-file system rather than a first-to-invent system, an applicant cannot overcome a reference by showing an earlier date of invention.



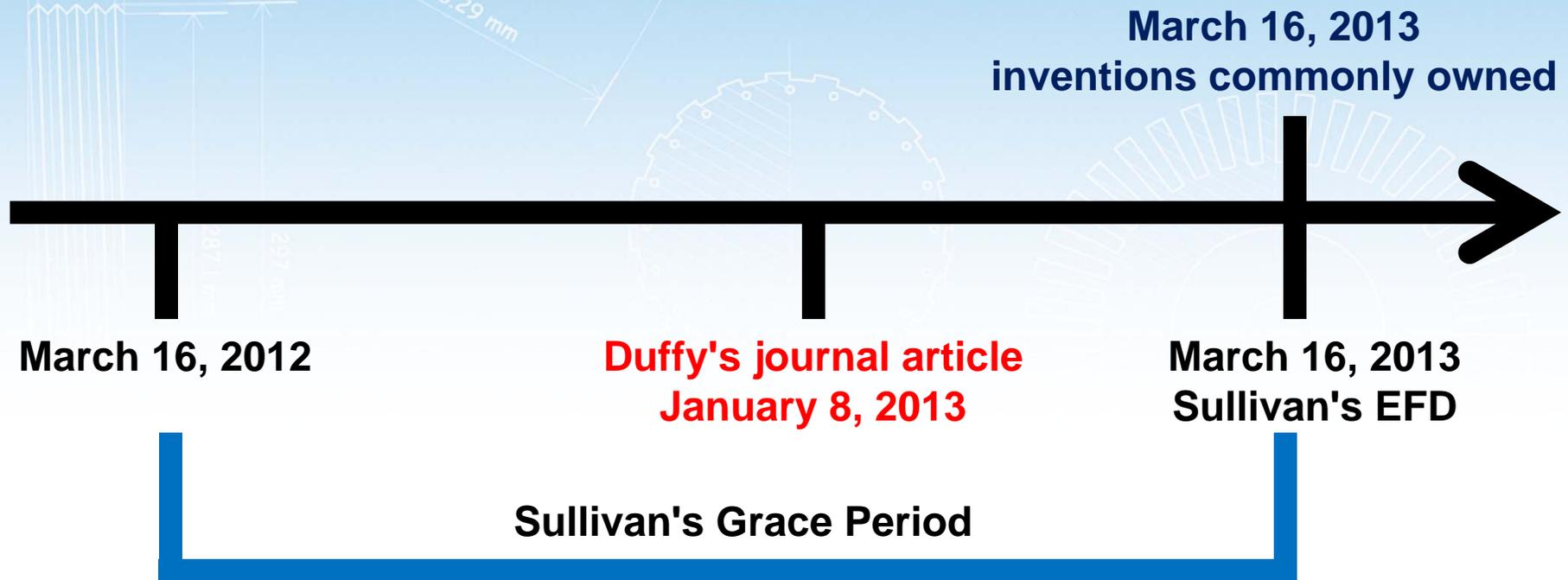
Scenario 1. Traversing a Rejection under 35 U.S.C. 102(a)(1)



Q1.3 – TRUE OR FALSE? Sullivan could properly traverse by presenting a statement under 35 U.S.C. 102(b)(2)(C) that the invention described in the Duffy article and the Sullivan application were commonly owned on March 16, 2013.



Scenario 1. Traversing a Rejection under 35 U.S.C. 102(a)(1)



A1.3 – FALSE. The rejection was made under 102(a)(1), and the common ownership exception of 102(b)(2)(C) only applies to rejections made under 102(a)(2). Therefore, even though Sullivan can establish common ownership as of his effective filing date, the traversal is unavailing.



Scenario 1. Traversing a Rejection under 35 U.S.C. 102(a)(1)

37 CFR 1.132 declaration of commercial success

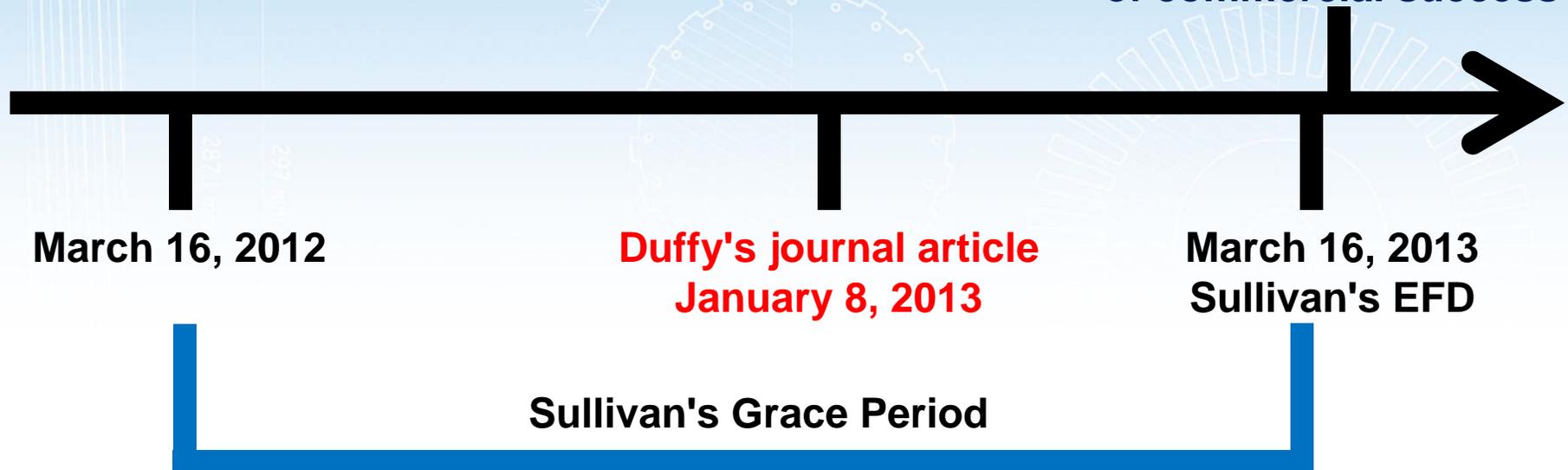


Q1.4 – TRUE OR FALSE? Sullivan could properly traverse by submitting a 37 CFR 1.132 declaration about the commercial success of his invention, including sales figures as well as market share, and establishing a nexus between the claimed invention and the commercial success.



Scenario 1. Traversing a Rejection under 35 U.S.C. 102(a)(1)

37 CFR 1.132 declaration of commercial success



A1.4 – FALSE. A declaration to establish so-called "secondary considerations" such as commercial success may be used to traverse an obviousness rejection, but not an anticipation rejection. This applies to both AIA and pre-AIA applications.



Scenario 2. Traversing a Rejection under 35 U.S.C. 102(a)(2)

- Dolan filed his patent application on December 16, 2013. The application contains one claim directed to widget X.
- Dolan exhibited his invention at a trade show on December 30, 2012.
- The examiner locates a U.S. patent application publication disclosing widget X to Flanagan. The application was filed on October 16, 2013 and published on April 23, 2015.



Scenario 2. Traversing a Rejection under 35 U.S.C. 102(a)(2)



Dolan's attorney receives an Office action rejecting the claim under 35 U.S.C. 102(a)(2) over Flanagan's patent application publication. How could she properly respond to the Office action?



Polling Scenario 2. Traversing a Rejection under 35 U.S.C. 102(a)(2)



Q2.1 – TRUE OR FALSE? Dolan's attorney can submit a declaration under 37 CFR 1.130(a) to establish that the subject matter disclosed in Flanagan's application was invented by Dolan, and that Flanagan obtained it directly or indirectly from him.



POLLING SLIDE

Please participate in the polling by

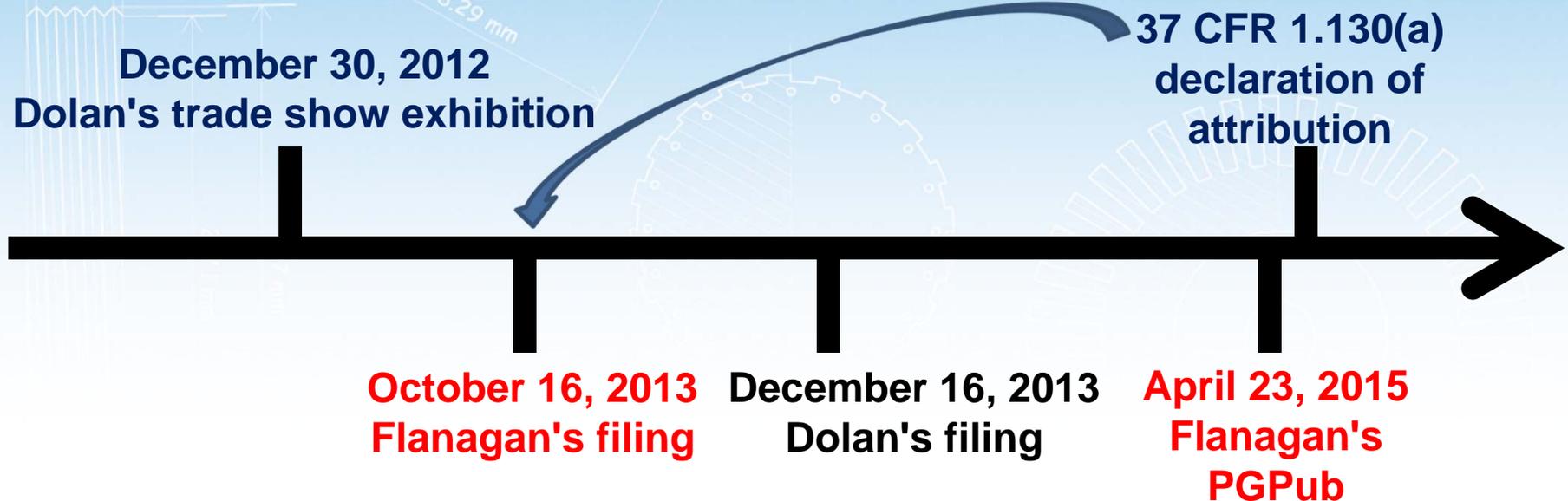
- Texting the code for your answer to **phone number 22333**

OR

- Voting at **pollev.com/uspto4**



Polling Scenario 2. Traversing a Rejection under 35 U.S.C. 102(a)(2)



A2.1 – TRUE. Dolan can invoke the 35 U.S.C. 102(b)(2)(A) exception by submitting a declaration under 37 CFR 1.130(a) showing that Flanagan directly or indirectly obtained the subject matter he disclosed from Dolan, who invented it.



Scenario 2. Traversing a Rejection under 35 U.S.C. 102(a)(2)



Q2.2 – TRUE OR FALSE? Dolan's attorney can properly traverse the rejection by submitting a declaration under 37 CFR 1.130(b) to establish that Dolan had publicly disclosed the widget before the date that Flanagan's application was effectively filed.



Scenario 2. Traversing a Rejection under 35 U.S.C. 102(a)(2)



A2.2 – TRUE. Dolan can invoke the 35 U.S.C. 102(b)(2)(B) exception by submitting a declaration under 37 CFR 1.130(b) to show that he had publicly disclosed the invention before Flanagan's patent application publication was effectively filed.

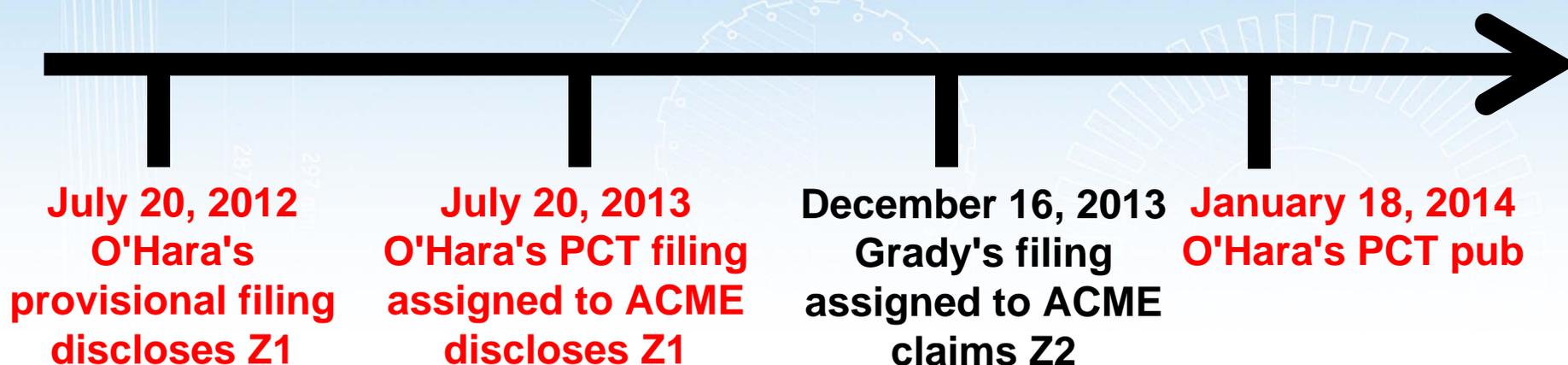


Scenario 3. Relying on the Common Ownership Exception under 35 U.S.C. 102(b)(2)(C)

- Grady filed a patent application, assigned to ACME Corp., on December 16, 2013. His application contains one claim directed to method Z2.
- The examiner found a PCT application publication by O'Hara, published on January 18, 2014, assigned to ACME Corp., which disclosed method Z1. The PCT application designated the United States and was filed on July 20, 2013. It claimed benefit of a provisional application filed on July 20, 2012, which also disclosed method Z1.
- Z2 is obvious over Z1. The examiner issues an Office action rejecting Grady's claim under 35 U.S.C. 103 as obvious over O'Hara's published PCT application.



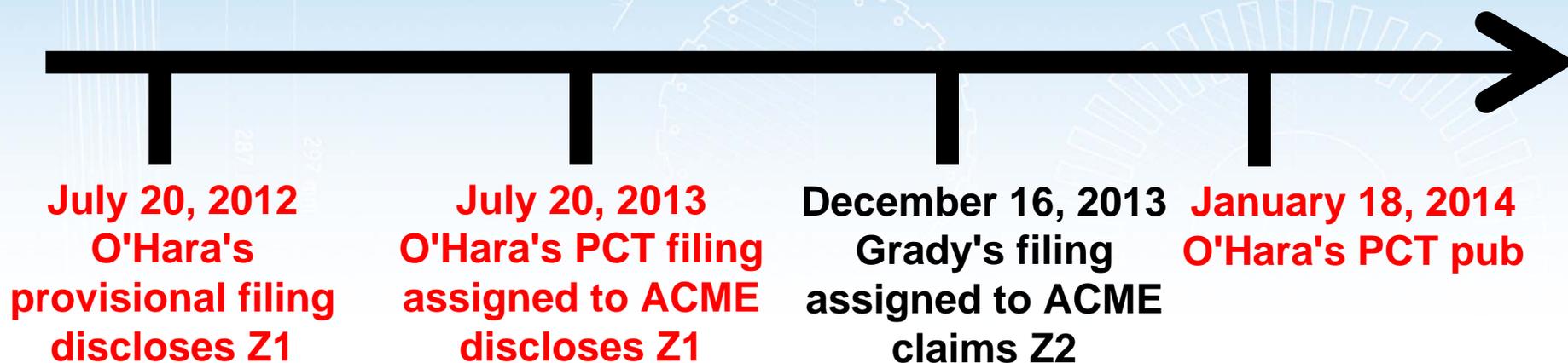
Scenario 3. Relying on the Common Ownership Exception under 35 U.S.C. 102(b)(2)(C)



Consider whether Grady's attorney may invoke the common ownership exception to establish that the O'Hara publication is not prior art to Grady's claimed invention.



Polling Scenario 3. Relying on the Common Ownership Exception under 35 U.S.C. 102(b)(2)(C)



Q3.1 – TRUE OR FALSE? Grady's attorney may not invoke the common ownership exception because O'Hara's PCT publication was effectively filed on July 20, 2012, which is more than one year before Grady's effective filing date.



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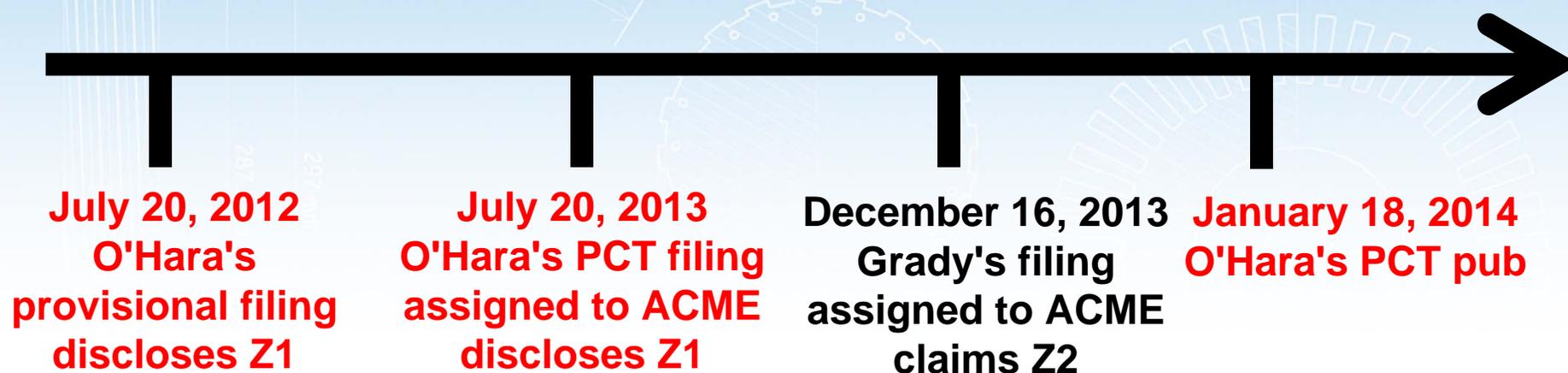
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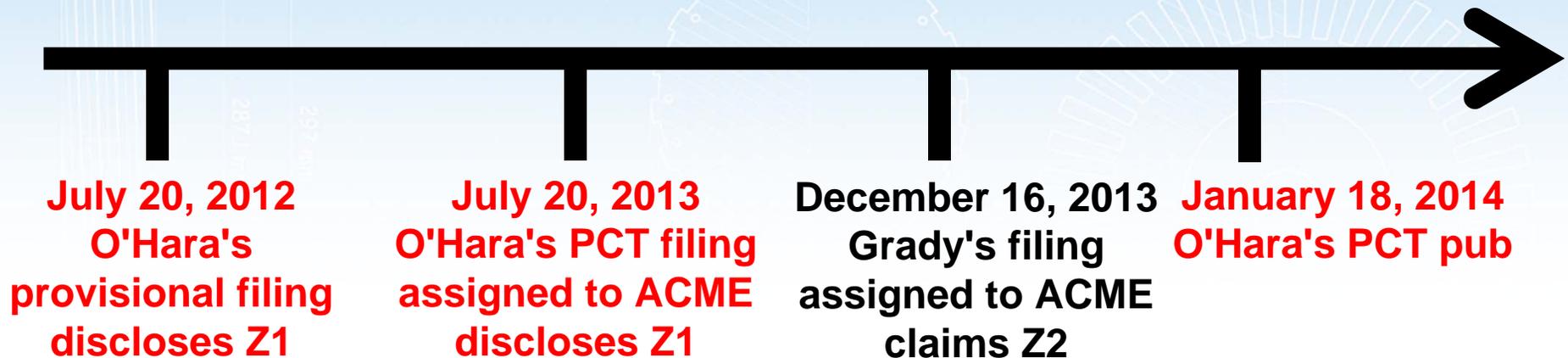
Polling Scenario 3. Relying on the Common Ownership Exception under 35 U.S.C. 102(b)(2)(C)



A3.1 – FALSE. Under 102(a)(2), O'Hara's PCT publication may be prior art as of July 20, 2012, the date it was effectively filed. However, the 102(b)(2)(A), 102(b)(2)(B), and 102(b)(2)(C) exceptions, which apply to 102(a)(2) disclosures, are not limited to disclosures during Grady's one-year grace period. Thus, Grady may invoke the common ownership exception of 102(b)(2)(C).



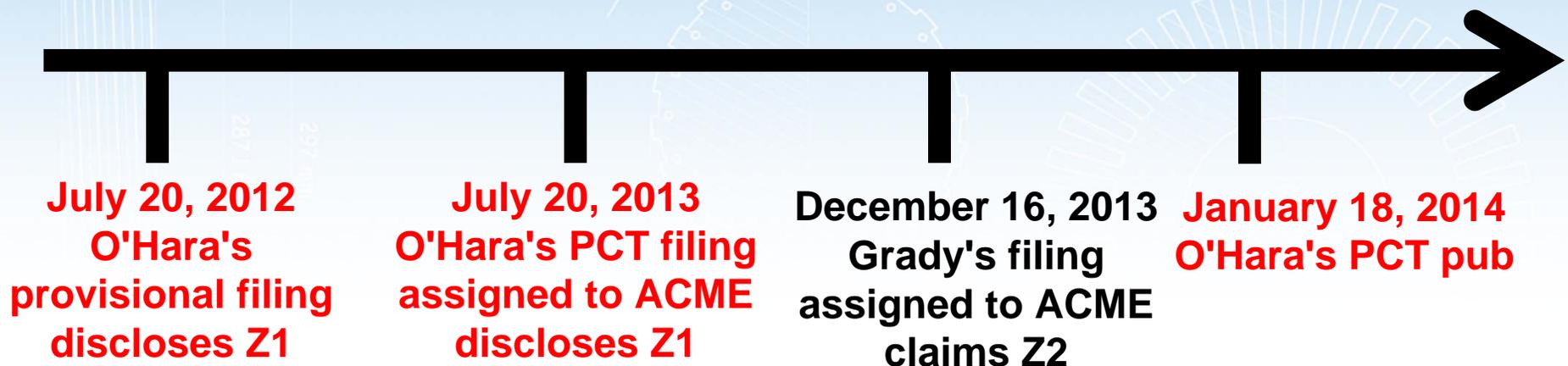
Scenario 3. Relying on the Common Ownership Exception under 35 U.S.C. 102(b)(2)(C)



Q3.2 – TRUE OR FALSE? Although Grady's attorney may invoke the common ownership exception to overcome the examiner's obviousness rejection, he could not have done so if the examiner had made an anticipation rejection.



Scenario 3. Relying on the Common Ownership Exception under 35 U.S.C. 102(b)(2)(C)

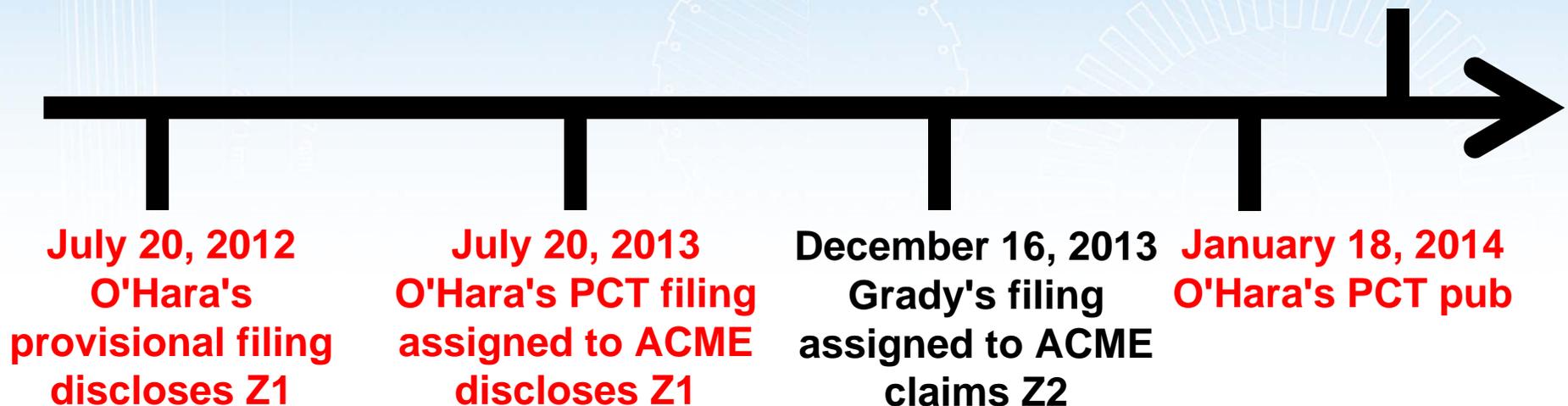


Q3.2 – FALSE. Unlike the pre-AIA 103(c) common ownership exception which applies only to obviousness rejections, the 102(b)(2)(C) exception under the AIA may be invoked to overcome both obviousness and anticipation rejections.



Scenario 3. Relying on the Common Ownership Exception under 35 U.S.C. 102(b)(2)(C)

statement that on December 16, 2013,
Z1 and Z2 were commonly owned

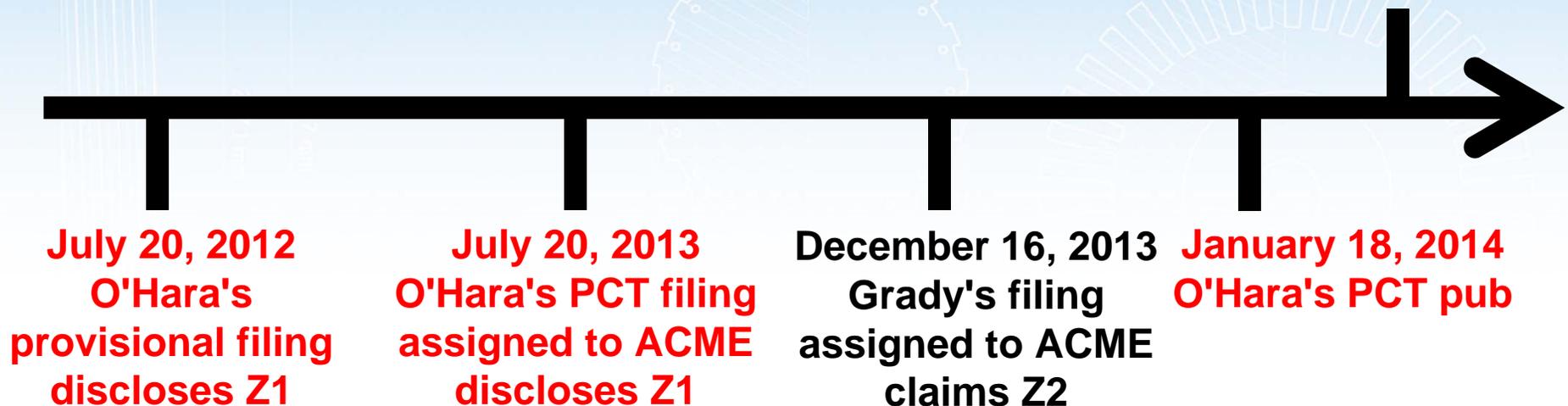


Q3.3 – TRUE OR FALSE? If Grady's attorney provides a statement that Grady's claimed method Z2 and O'Hara's disclosed method Z1 were commonly owned as of December 16, 2013, he can expect the examiner to withdraw the rejection.



Scenario 3. Relying on the Common Ownership Exception under 35 U.S.C. 102(b)(2)(C)

statement that on December 16, 2013,
Z1 and Z2 were commonly owned



A3.3 – TRUE. A statement that Grady's claimed method Z2 and O'Hara's disclosed method Z1 were commonly owned as of Grady's effective filing date is sufficient. A declaration is not needed.



Scenario 3A. Relying on the Common Ownership Exception under 35 U.S.C. 102(b)(2)(C)

- Grady filed a patent application, assigned to ACME Corp., on December 16, 2013. His application contains one claim directed to method Z2.
- The examiner found a PCT application publication by O'Hara, published on January 18, 2014, assigned to ~~ACME~~ **APEX** Corp., which disclosed method Z1. The PCT application designated the United States and was filed on July 20, 2013. It claimed benefit of a provisional application filed on July 20, 2012, which also disclosed method Z1.
- Z2 is obvious over Z1. The examiner issues an Office action rejecting Grady's claim under 35 U.S.C. 103 as obvious over O'Hara's published PCT application.



Scenario 3A. Relying on the Common Ownership Exception under 35 U.S.C. 102(b)(2)(C)

JRA statement and amendment to the specification

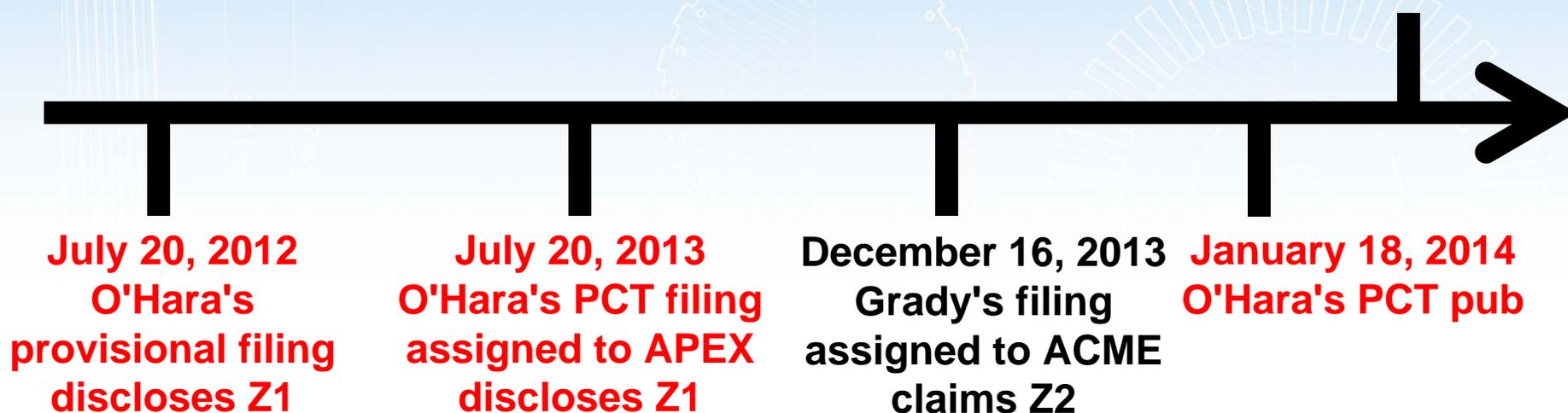


Q3.4 – TRUE OR FALSE? If Grady's attorney provides a statement that ACME and APEX were parties to a joint research agreement (JRA) in effect on or before December 16, 2013, and that Grady's claimed method Z2 resulted from activities within the scope of the JRA, then he can expect the examiner to withdraw the rejection as long as he amends the specification to disclose the names of the parties to the JRA.



Scenario 3A. Relying on the Common Ownership Exception under 35 U.S.C. 102(b)(2)(C)

JRA statement and amendment to the specification



A3.4 – TRUE. An appropriate JRA statement by Grady's attorney is sufficient to overcome an anticipation or obviousness rejection based on a 102(a)(2) disclosure, provided that the specification names or is amended to name the parties to the JRA. A declaration is not needed.

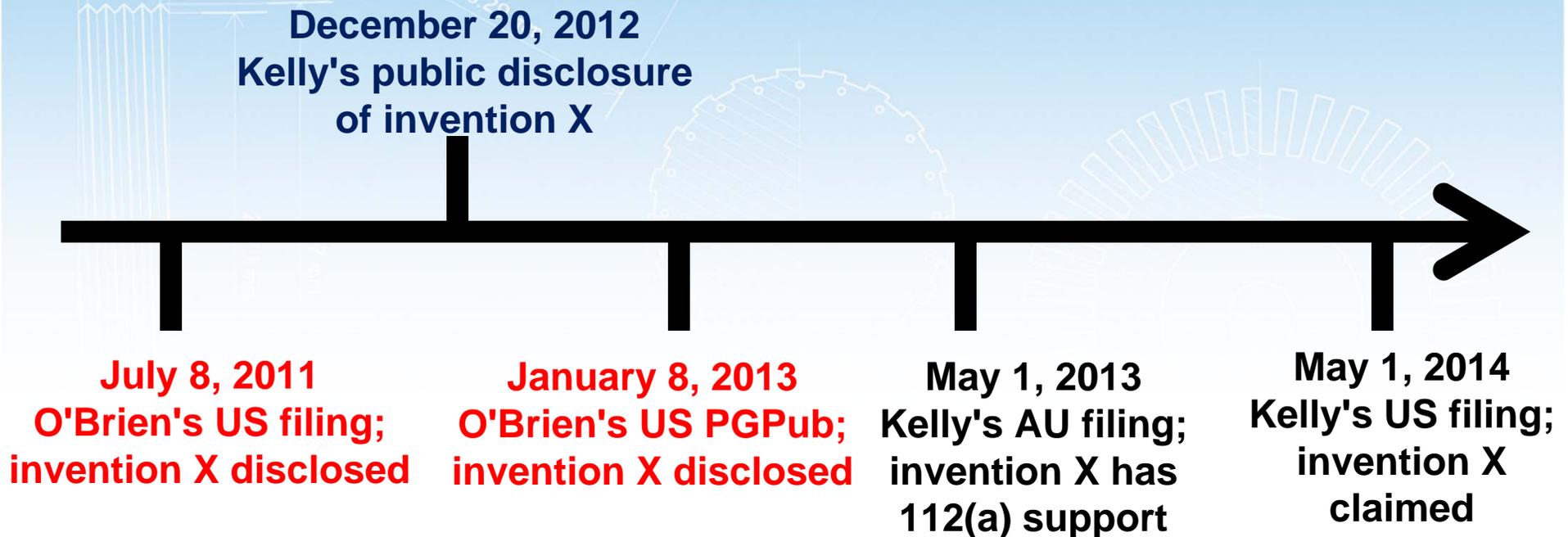


Scenario 4. Traversing a Rejection under 35 U.S.C. 102(a)(1) or 102(a)(2)

- On May 1, 2014, Kelly files a nonprovisional patent application at the USPTO claiming invention X.
- Kelly asserts a foreign priority claim under 35 U.S.C. 119(a)-(d) based on his Australian application filed May 1, 2013. He submits a certified copy of the English-language Australian application to the USPTO. The Australian application provides support under 35 U.S.C. 112(a) for invention X.
- The examiner rejects Kelly's claims as anticipated under 35 U.S.C. 102(a)(1) and 102(a)(2) by a U.S. patent application publication to O'Brien dated January 8, 2013, based on an application filed on July 8, 2011. O'Brien's application discloses invention X. There are no other rejections of record, and the examiner is not aware of any other relevant art.



Polling Scenario 4. Traversing a Rejection under 35 U.S.C. 102(a)(1) or 102(a)(2)



Q4.1 – TRUE OR FALSE? If Kelly submits a declaration under 37 CFR 1.130(b) showing that he had publicly disclosed invention X on December 20, 2012, he should expect allowance of his claims if there are no other issues that impact patentability.



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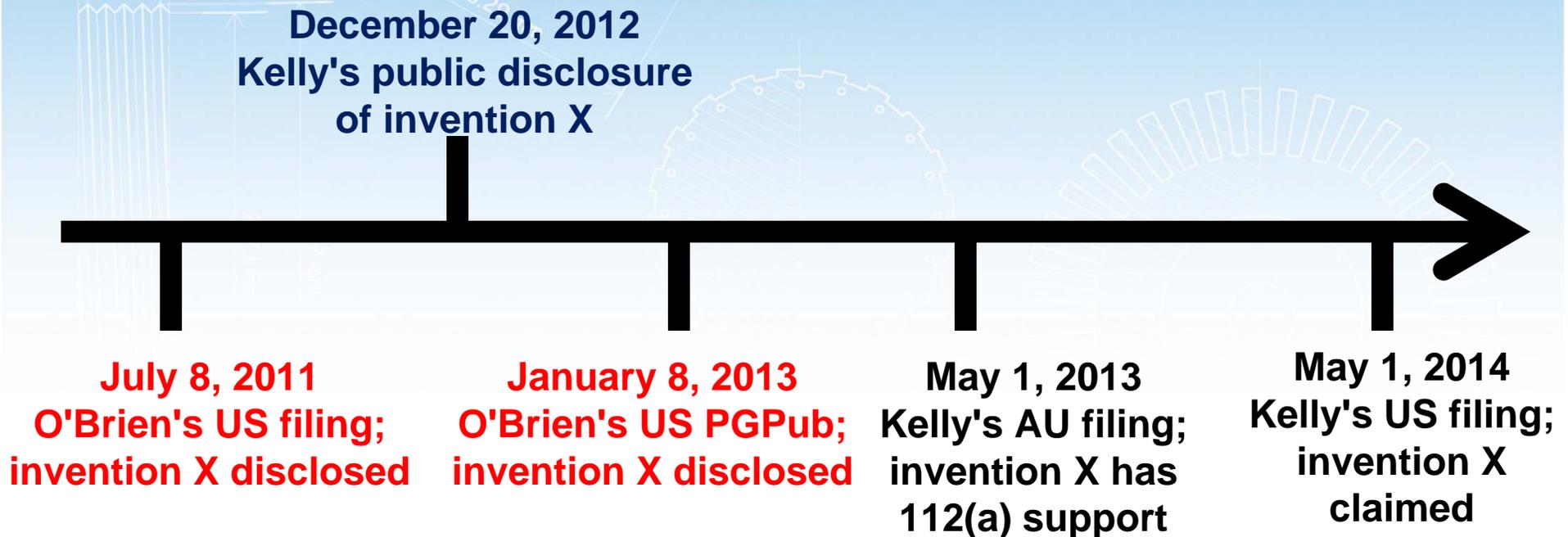
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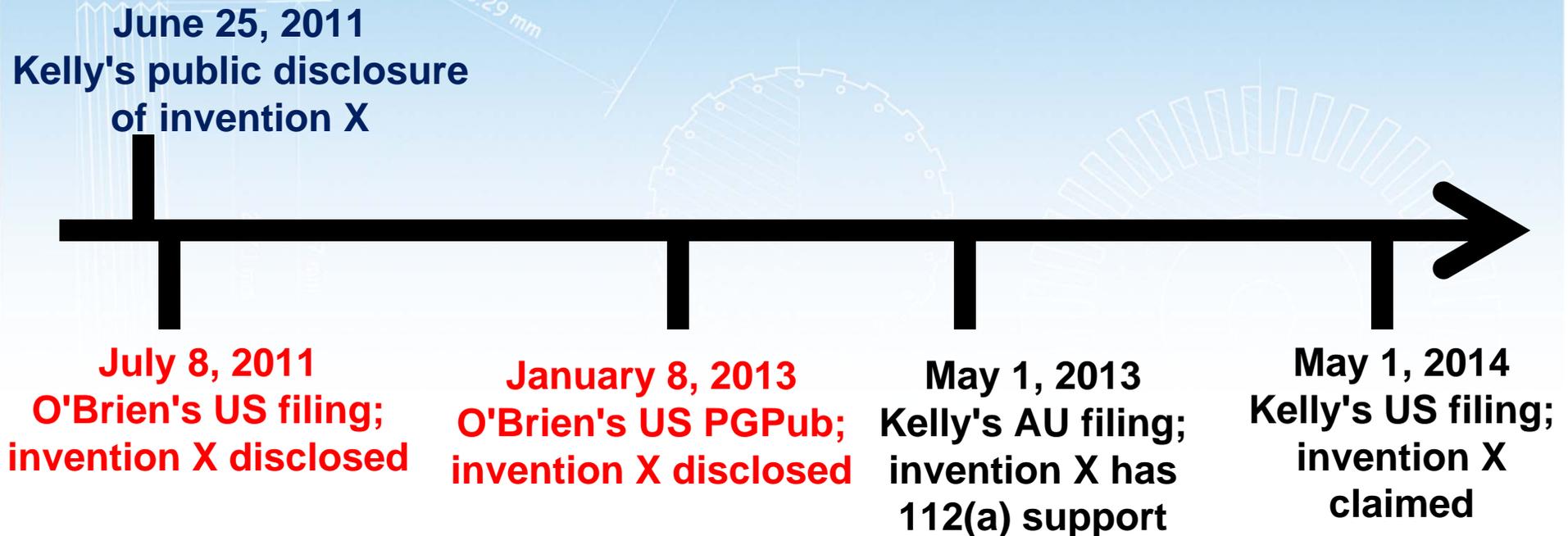
Polling Scenario 4. Traversing a Rejection under 35 U.S.C. 102(a)(1) or 102(a)(2)



A4.1 – FALSE. Kelly's declaration establishes that O'Brien's PGPub is not 102(a)(1) art as of its publication date, but O'Brien's PGPub is still 102(a)(2) art as of the date that it was effectively filed.



Scenario 4. Traversing a Rejection under 35 U.S.C. 102(a)(1) or 102(a)(2)



Q4.2 – TRUE OR FALSE? If Kelly submits a declaration under 37 CFR 1.130(b) showing that he had publicly disclosed invention X on June 25, 2011, he should expect allowance of his claims if there are no other issues that impact patentability.



Scenario 4. Traversing a Rejection under 35 U.S.C. 102(a)(1) or 102(a)(2)



A4.2 – FALSE. Although Kelly's declaration under 37 CFR 1.130(b) is sufficient to establish that O'Brien's PGPub is not prior art under either 102(a)(1) or 102(a)(2), Kelly's prior public disclosure is itself 102(a)(1) prior art to Kelly's claimed invention.

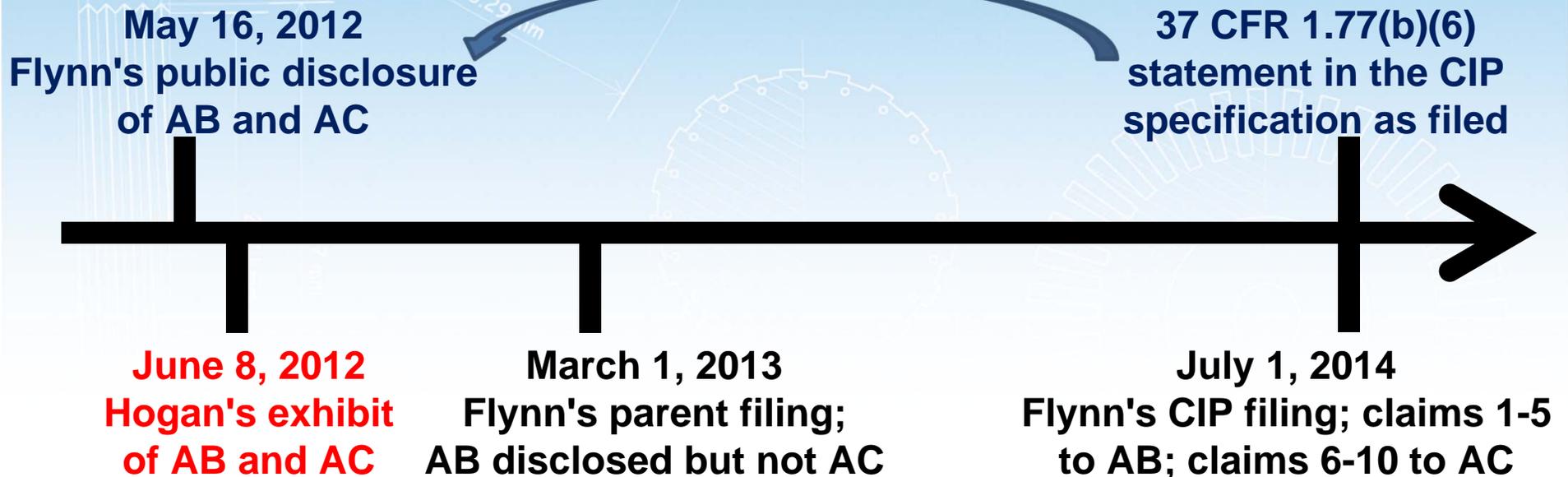


Scenario 5. Traversing a Rejection under 35 U.S.C. 102(a)(1)

- On July 1, 2014, Flynn files a CIP of his earlier nonprovisional patent application filed March 1, 2013.
- Claims 1-5 to invention AB were supported in the March 1, 2013 parent application. Claims 6-10 to invention AC were newly added in the July 1, 2014 CIP, and were not supported in the parent application.
- The examiner rejects all of Flynn's claims as anticipated by a June 8, 2012 trade show exhibit by Hogan which included inventions AB and AC.



Polling Scenario 5. Traversing a Rejection under 35 U.S.C. 102(a)(1)



Q5.1 – TRUE OR FALSE? If Flynn responds by pointing out a statement under 37 CFR 1.77(b)(6) in the specification as filed, which asserts that he had publicly disclosed AB and AC on May 16, 2012, he should expect the examiner to withdraw the rejection of claims 1-5 over the Hogan exhibit.



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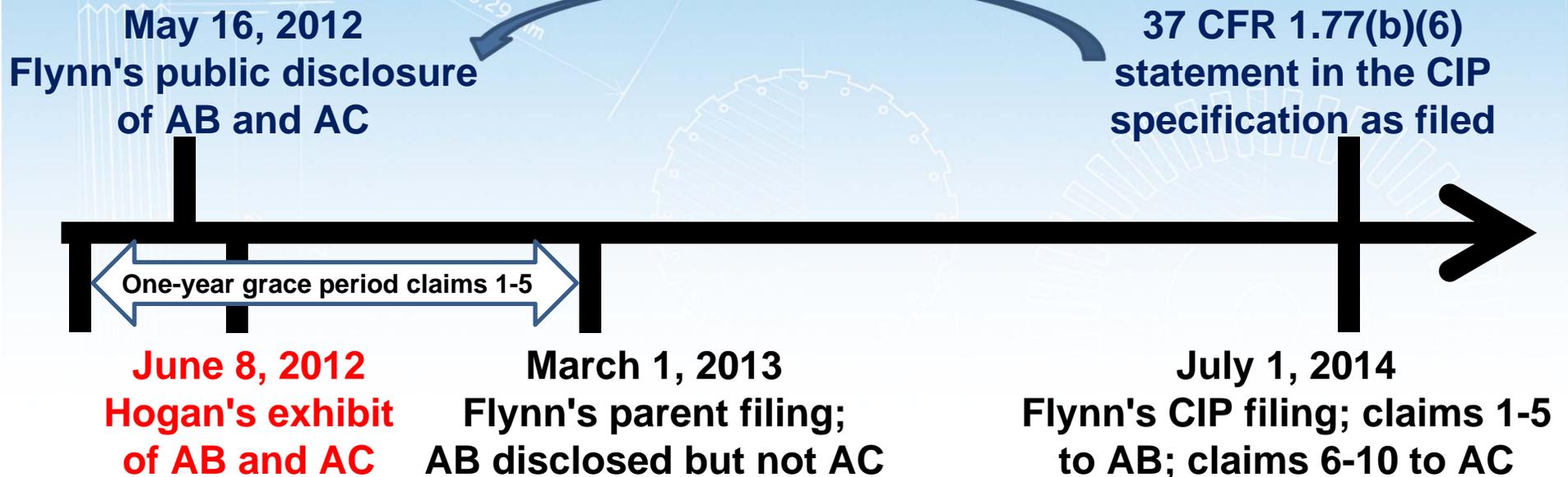
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Polling Scenario 5. Traversing a Rejection under 35 U.S.C. 102(a)(1)



A5.1 – TRUE. All claims in the CIP are examined under FITF, but the effective filing date of claims 1-5 is March 1, 2013. Hogan's exhibit is a 102(a)(1) disclosure within the grace period for claims 1-5. Therefore the rejection can be overcome by relying on a 1.77(b)(6) statement present upon filing to invoke the 102(b)(1)(B) exception.



Scenario 5. Traversing a Rejection under 35 U.S.C. 102(a)(1)

May 16, 2012
Flynn's public disclosure
of AB and AC

37 CFR 1.77(b)(6)
statement in the CIP
specification as filed

June 8, 2012
Hogan's exhibit
of AB and AC

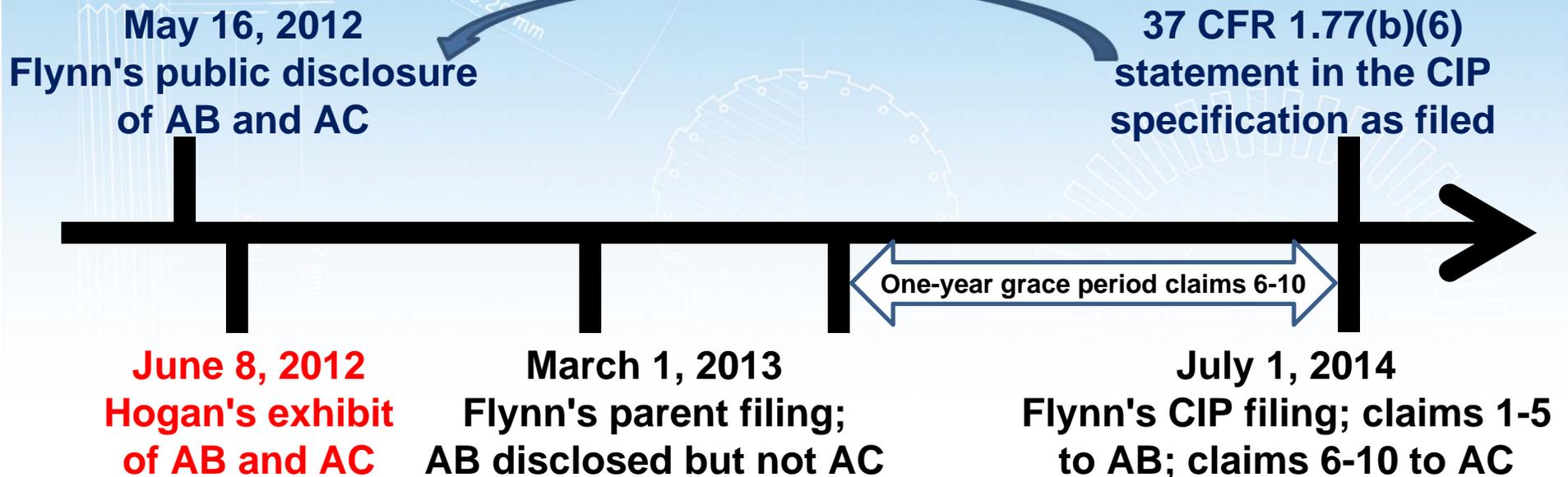
March 1, 2013
Flynn's parent filing;
AB disclosed but not AC

July 1, 2014
Flynn's CIP filing; claims 1-5
to AB; claims 6-10 to AC

Q5.2 – TRUE OR FALSE? If Flynn responds to the rejection by pointing out a statement under 37 CFR 1.77(b)(6) in the specification as filed, which asserts that he had publicly disclosed AB and AC on May 16, 2012, he should expect the rejection of claims 6-10 to be withdrawn.



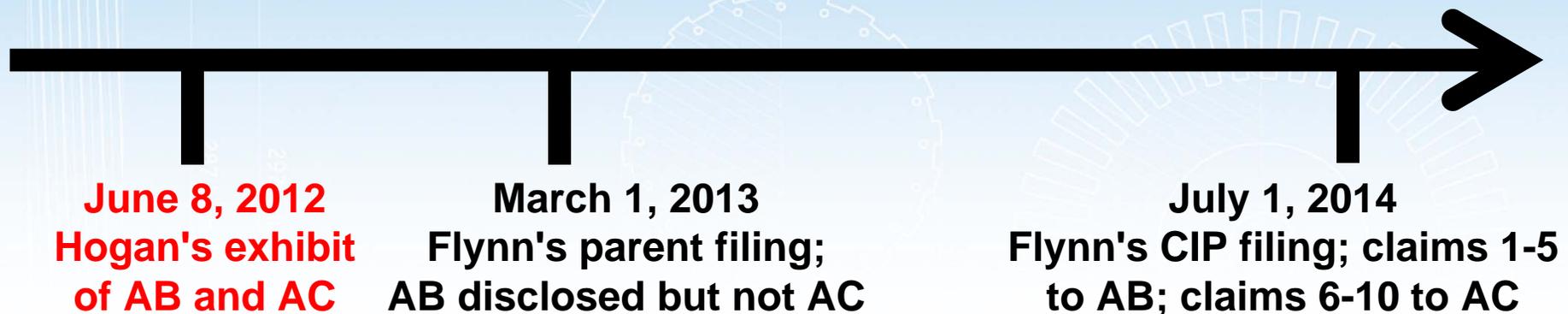
Scenario 5. Traversing a Rejection under 35 U.S.C. 102(a)(1)



A5.2 – FALSE. All claims in the CIP are examined under FITF, but the effective filing date of claims 6-10 is July 1, 2014. Hogan's exhibit is a 102(a)(1) disclosure outside the grace period for claims 6-10. Therefore the rejection cannot be overcome by invoking the 102(b)(1)(B) exception via a 1.77(b)(6) statement. Furthermore, Flynn's disclosure is itself prior art to claims 6-10.



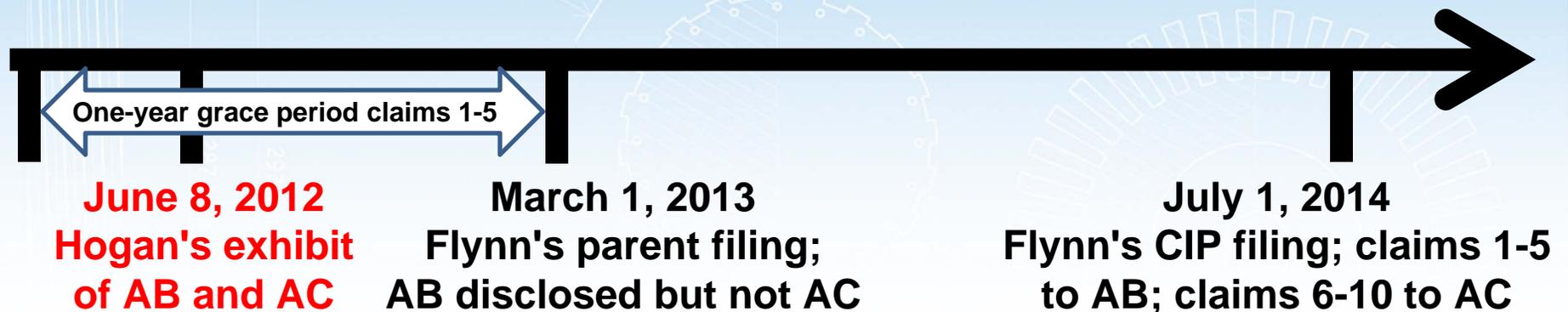
Scenario 5. Traversing a Rejection under 35 U.S.C. 102(a)(1)



Q5.3 – TRUE OR FALSE? If Flynn responds to the rejection by submitting a declaration under 37 CFR 1.130(a) establishing that inventions AB and AC were his own work, and that Hogan obtained them from him, Flynn should expect the rejection of claims 1-5 to AB over Hogan to be withdrawn.



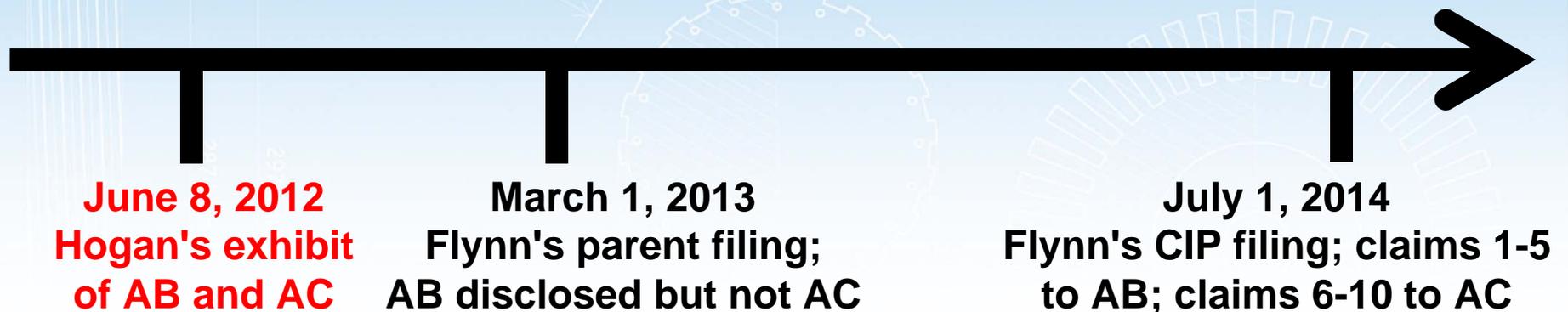
Scenario 5. Traversing a Rejection under 35 U.S.C. 102(a)(1)



A5.3 – TRUE. All claims in the CIP are examined under FITF, but the effective filing date of claims 1-5 is March 1, 2013. Hogan's exhibit is a 102(a)(1) disclosure within the grace period for claims 1-5. Therefore the rejection can be overcome by using a 130(a) declaration (attribution) to invoke the 102(b)(1)(A) exception.



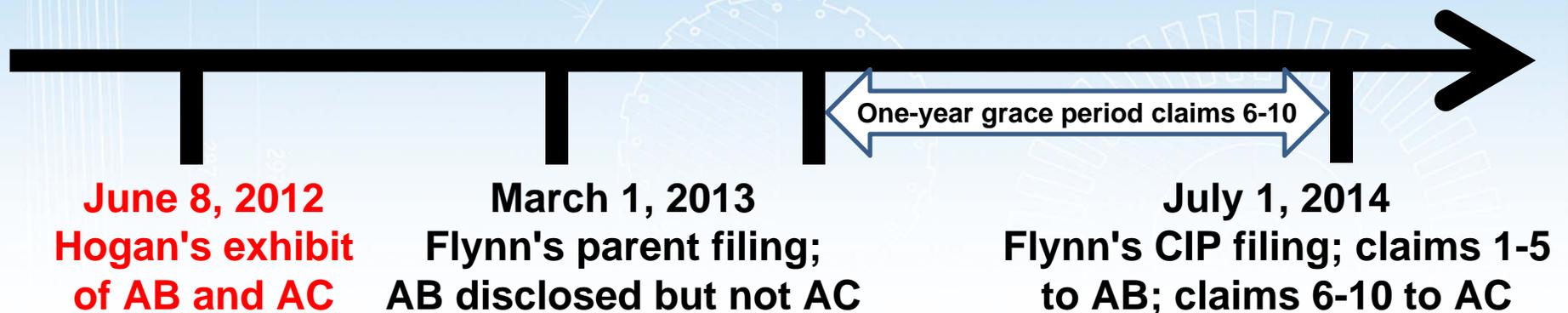
Scenario 5. Traversing a Rejection under 35 U.S.C. 102(a)(1)



Q5.4 – TRUE OR FALSE? If Flynn responds to the rejection by submitting a declaration under 37 CFR 1.130(a) establishing that inventions AB and AC were his own work, and that Hogan obtained inventions AB and AC from him, he should expect the examiner to withdraw the rejection of claims 6-10 to AC over Hogan.



Scenario 5. Traversing a Rejection under 35 U.S.C. 102(a)(1)



A5.4 – FALSE. All claims in the CIP are examined under FITF, but the effective filing date of claims 6-10 is July 1, 2014. Hogan's exhibit is a 102(a)(1) disclosure outside the grace period for claims 6-10. Therefore the rejection cannot be overcome by invoking the 102(b)(1)(A) exception via a 130(a) declaration.





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QUESTIONS?



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Tour of the AIA (FITF) Website

Kathleen Kerr Bragdon
Quality Assurance Specialist
Technology Center 1600



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Q&A

Panel Discussion

Moderator: Chris Grant
Quality Assurance Specialist
Technology Center 2400

Cassandra Spyrou	TC 2800	AIA (FITF) Indicators
Tom Hughes	TC 3700	FITF – Year in Review
Kathleen Fonda	OPLA	FITF Overview and Responding to Rejections
Kathleen Bragdon	TC 1600	Tour of the AIA (FITF) Website

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