

Status Report: USPTO Implementation of the America Invents Act



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Progress Report: Rulemakings

- 19 provisions related to USPTO operations to implement
- 7 Group 1 provisions implemented
- 7 Group 2 provisions addressed in Notices of Proposed Rulemaking (NPRMs) to issue in mid- to late January 2012 on 12 Month Timeline
- 2 Group 1 provisions in progress on 17 Month Timeline
- 3 Group 3 provisions to begin work on 18 Month Timeline



Implemented Provisions

(Group 1; Effective on September 16, 2011 or within 60 days)

	AIA Provision	Implementation Documents
1	Change in inter partes reexamination standard	Revision of Standard for Granting an Inter Partes Reexamination Request, 76 Fed. Reg. 59055 (Sept. 23, 2011)
2	Tax strategies are deemed within the prior art	Memo to Examiners, Sept. 20, 2011
3	Best mode	Memo to Examiners, Sept. 20, 2011
4	Human organism prohibition	Memo to Examiners, Sept. 20, 2011
5	Prioritized examination	Changes to Implement Prioritized Examination Track (Track I) of the Enhanced Examination Timing Control Procedures Under the Leahy-Smith America Invents Act, 76 Fed. Reg. 59050 (Sept. 23, 2011)
6	15% transition surcharge	Notice of Availability of Patent Fee Changes Under the Leahy-Smith America Invents Act, 76 Fed. Reg. 59115 (Sept. 23, 2011)
7	Electronic filing incentive	Notice of Availability of Patent Fee Changes Under the Leahy-Smith America Invents Act, 76 Fed. Reg. 59115 (Sept. 23, 2011); and Fee for Filing a Patent Application Other than by the Electronic System, 79 Fed. Reg. 70651 (Nov. 15, 2011)



Prioritized Exam

(as of 11/17/11)

Fiscal Year	Pending	Granted	Dismissed	Total	Notice of Allowance
FY2011	222	628	--	850	8
FY2012	419	125	2	546	0



Reserve Fund

- Established by the Department of Treasury
- Favorable language included in minibus to give USPTO access to funds deposited in reserve fund, if any



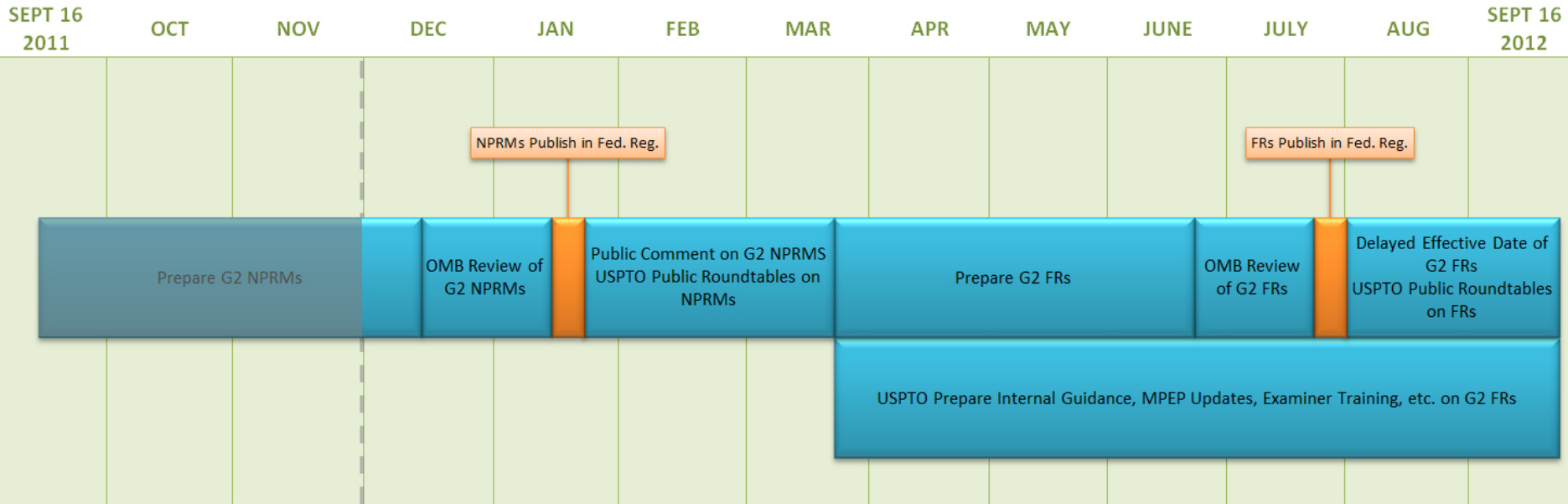
Implementation Ongoing: 12 Month Timeline

(Group 2; Effective on September 16, 2012)

1. Inventor's oath/declaration
2. Third party submission of prior art in a patent application
3. Supplemental examination
4. Citation of prior art in a patent file
5. Inter partes review
6. Post-grant review
7. Transitional program for covered business method patents



12 Month Timeline





Implementation Ongoing: 17 Month Timeline (Group 1)

- Fee Setting Authority
 - Authority to set or adjust fees became effective on September 16, 2011
 - Authority to be exercised by rulemaking
- Micro-entity
 - Micro-entity status became effective on September 16, 2011
 - 75% discount is not available until USPTO exercises fee setting authority



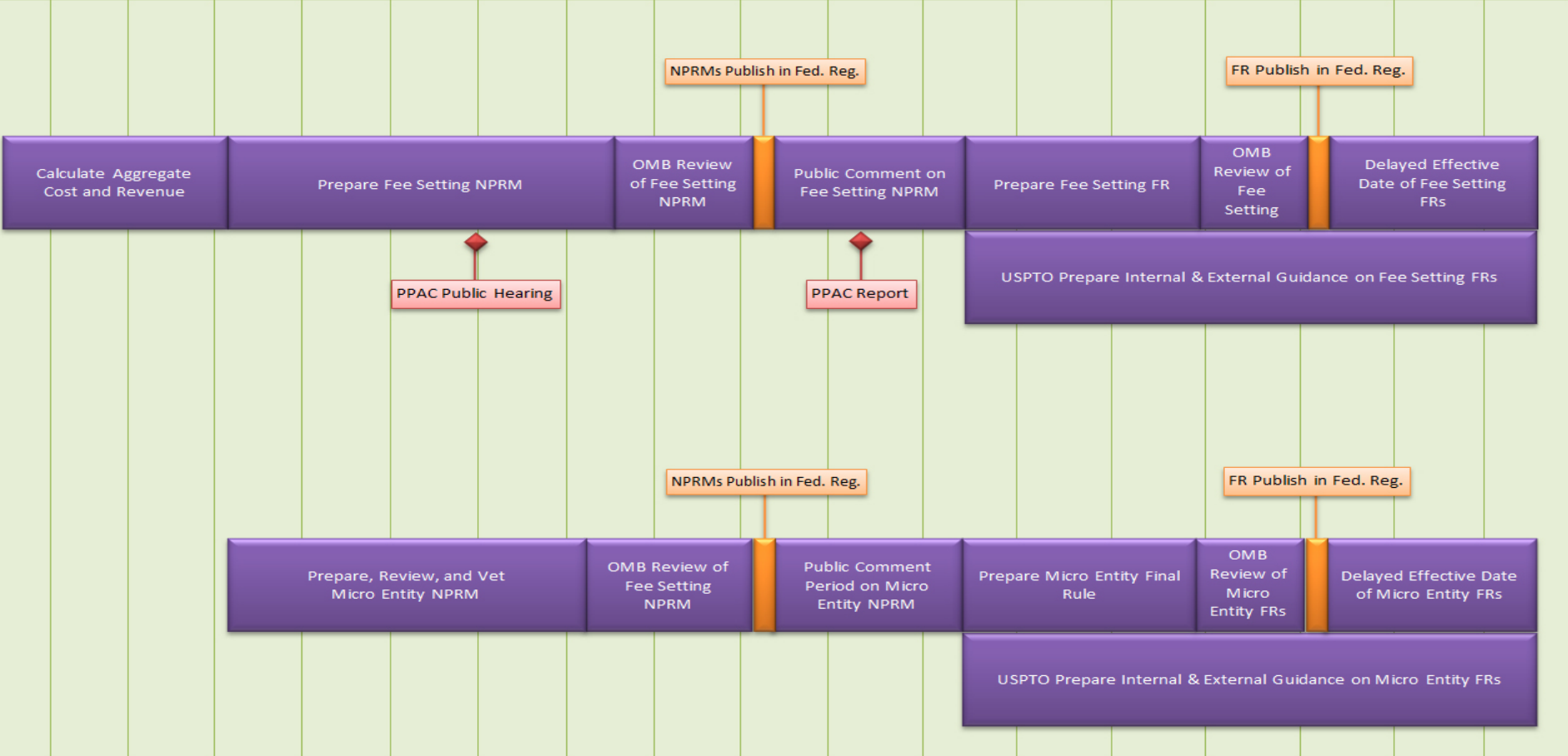
17 Month Timeline

SEPT 16, 2011

JAN 2012

JAN 2013

OCT NOV DEC FEB MAR APR MAY JUNE JULY AUG SEPT OCT NOV DEC FEB



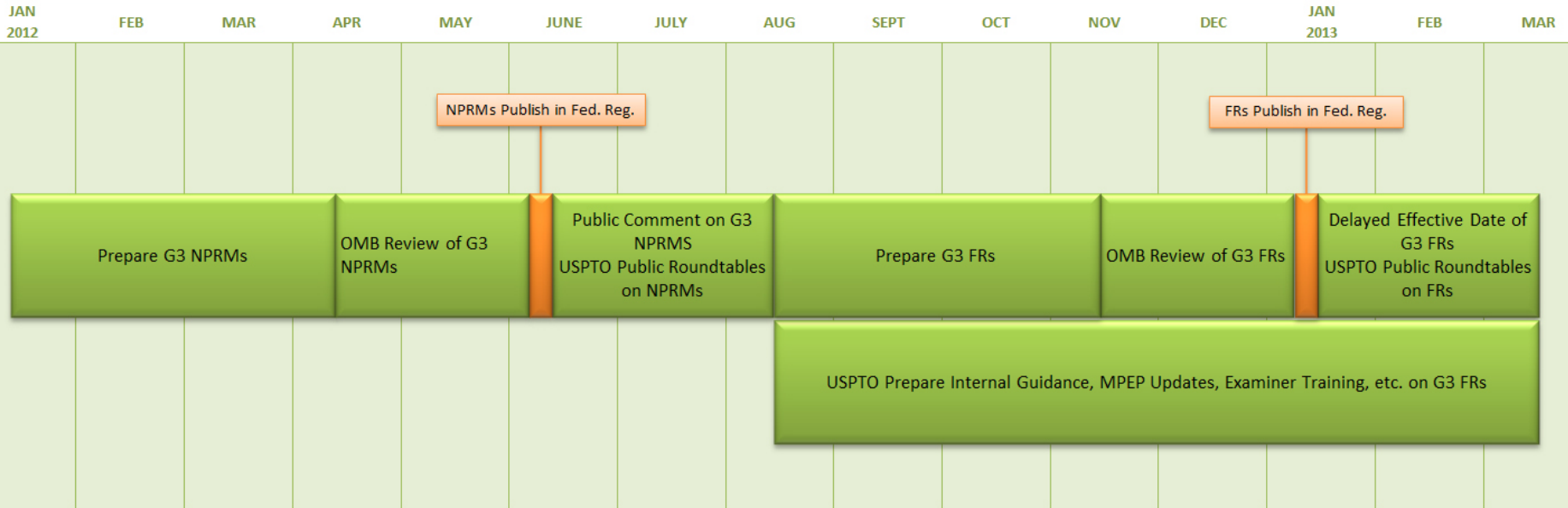


Implementation in Future: 18 Month Timeline* (Group 3; Effective on March 16, 2013)

1. First-Inventor-to-File
2. Derivation proceedings
3. Repeal of Statutory Invention Registration



18 Month Timeline*





Progress Report: Studies

- 7 studies for USPTO to conduct as lead
- 2 studies in progress

Topic	Due Date from Enactment
International Patent Protection for Small Businesses	4 months
Prior User Rights	4 months
Genetic Testing	9 months
Misconduct Before the Office	Every 2 years
Satellite Offices	3 years
Virtual Marking	3 years
Implementation of AIA	4 years



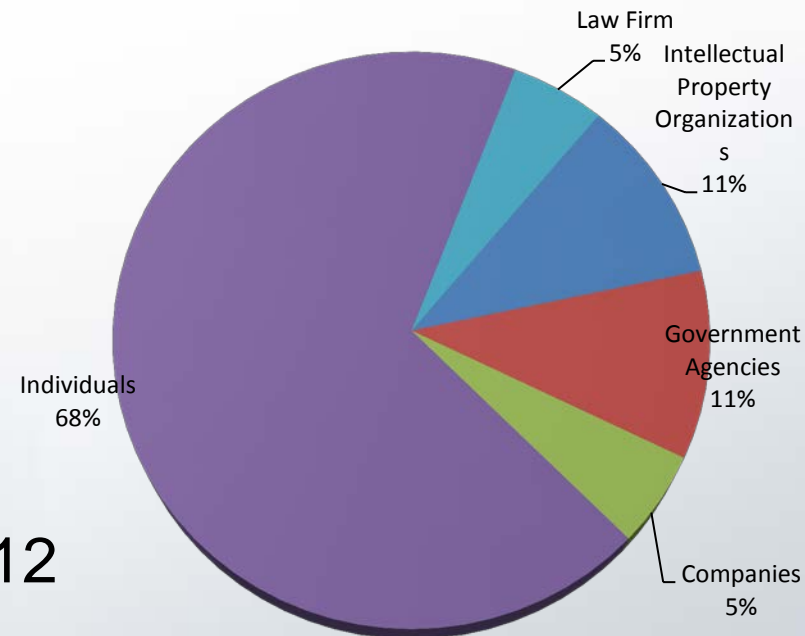
Int'l Patent Protection for Small Businesses Study

- USPTO directed to study how the USPTO and other federal agencies can best financially help small businesses with patent protection overseas
- USPTO consulting with the Department of Commerce and the Small Business Administration



Int'l Protection Study (cont.)

- Request for Comments and Notice of Public Hearings on the Study of International Patent Protection for Small Businesses, 76 Fed. Reg. 62389 (Oct. 7, 2011)
- Public input:
 - 19 written comments
 - 2 public hearings;
 - 12 witnesses
- Report due by January 14, 2012





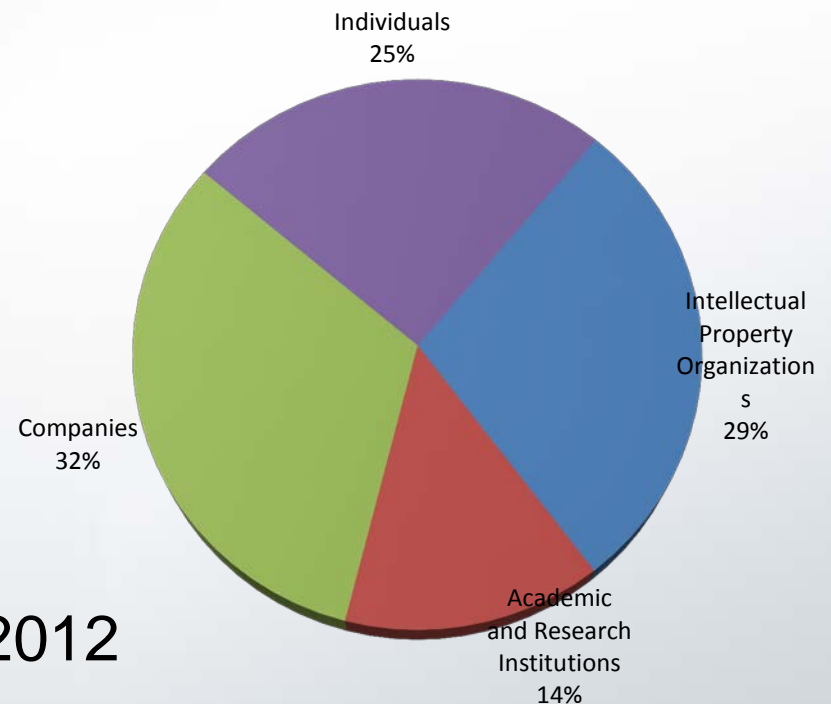
Prior User Rights Study

- USPTO directed to study the operation of prior user rights in other industrialized countries
- USPTO consulting with the United States Trade Representative, the Secretary of State, and the Attorney General



Prior User Rights Study (cont.)

- Request for Comments and Notice of Public Hearings on the Study of Prior User Rights, 76 Fed. Reg. 62388 (Oct. 7, 2011)
- Public input:
 - 28 written comments
 - 1 public hearing;
5 witnesses
- Report due by January 16, 2012





Genetic Testing Study

- USPTO to report on effective ways to provide independent, confirming genetic diagnostic tests where:
 - gene patents; and
 - exclusive licensing for primary genetic diagnostic tests
- Federal Register to issue in late January seeking public comments and announcing hearing dates
 - Hearings: late February/early March
 - Written comments: late January to late March
- Report due by June 16, 2012



Progress Report: Programs

Topic	Due Date from Enactment
Pro Bono	Immediately
Diversity of Applicants	6 months
Patent Ombudsman for Small Businesses	12 months
Satellite Offices	3 years



Pro Bono Program

- Minnesota program running
- Task Force formed to expand the program to other cities; USPTO participating
- First meeting held on October 21, 2011

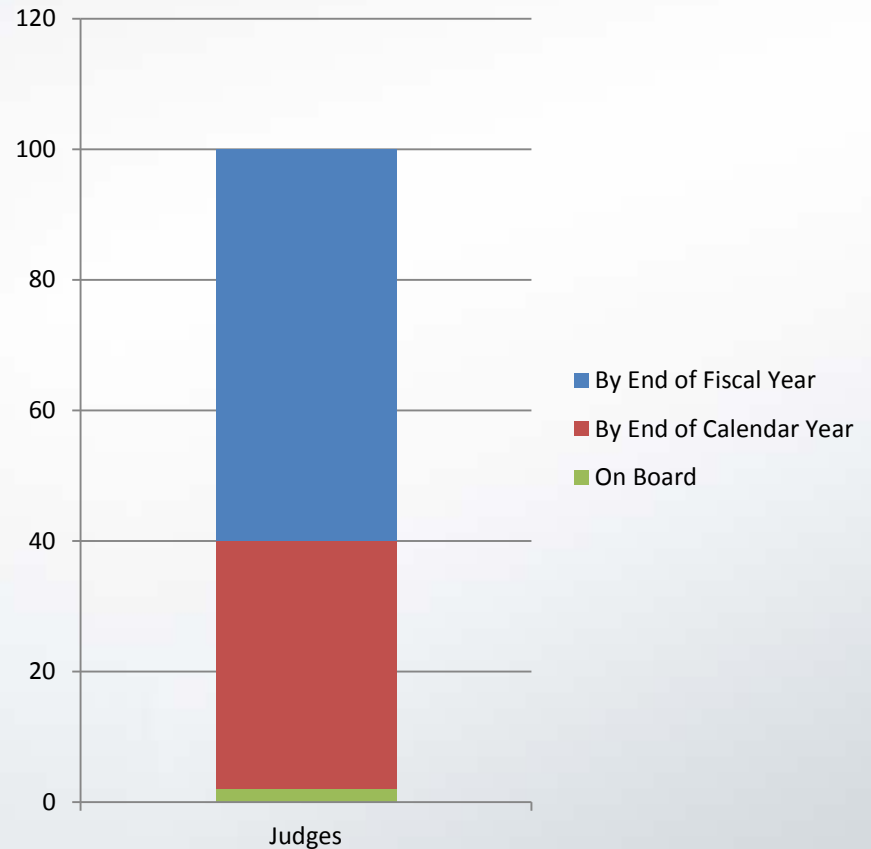
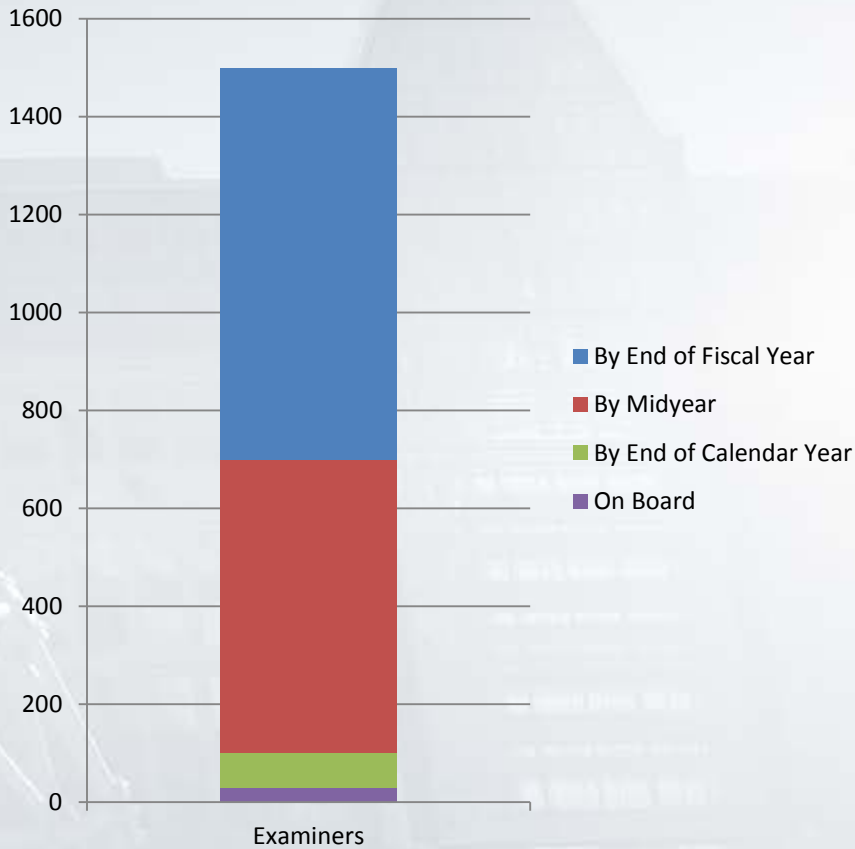


Satellite Offices

- USPTO is interested in gathering information on potential cities and regions for future satellite offices
- Initial office planned for Detroit; opening 2012
- 2 more offices required
- Request for Comments on Additional USPTO Satellite Offices for the Nationwide Workforce Program, 76 Fed. Reg, 73601 (Nov. 29, 2011)
 - Written comments until January 30, 2012



Progress Report: Hiring





AIA Micro-Site: New Features

www.uspto.gov/americaninventsact

- Executive summaries for provisions
- Progress reports (n=2; update monthly)
- Federal Register Notices and Memos for Group 1 implemented provisions
- Webcast and transcript of hearings and written comments for International Patent Protection and Prior User Rights hearings
- Blog (n=7)
- FAQ (n>60)
- Videos (n=3)
- Speeches (n=10)
- Press releases (n=8)
- Legislative history (complete)
- Announcements and Upcoming Events (updated weekly)
- Subscription Center



AIA Subscription Center

<http://enews.usptoenews.gov/lists/?p=subscribe&id=1>



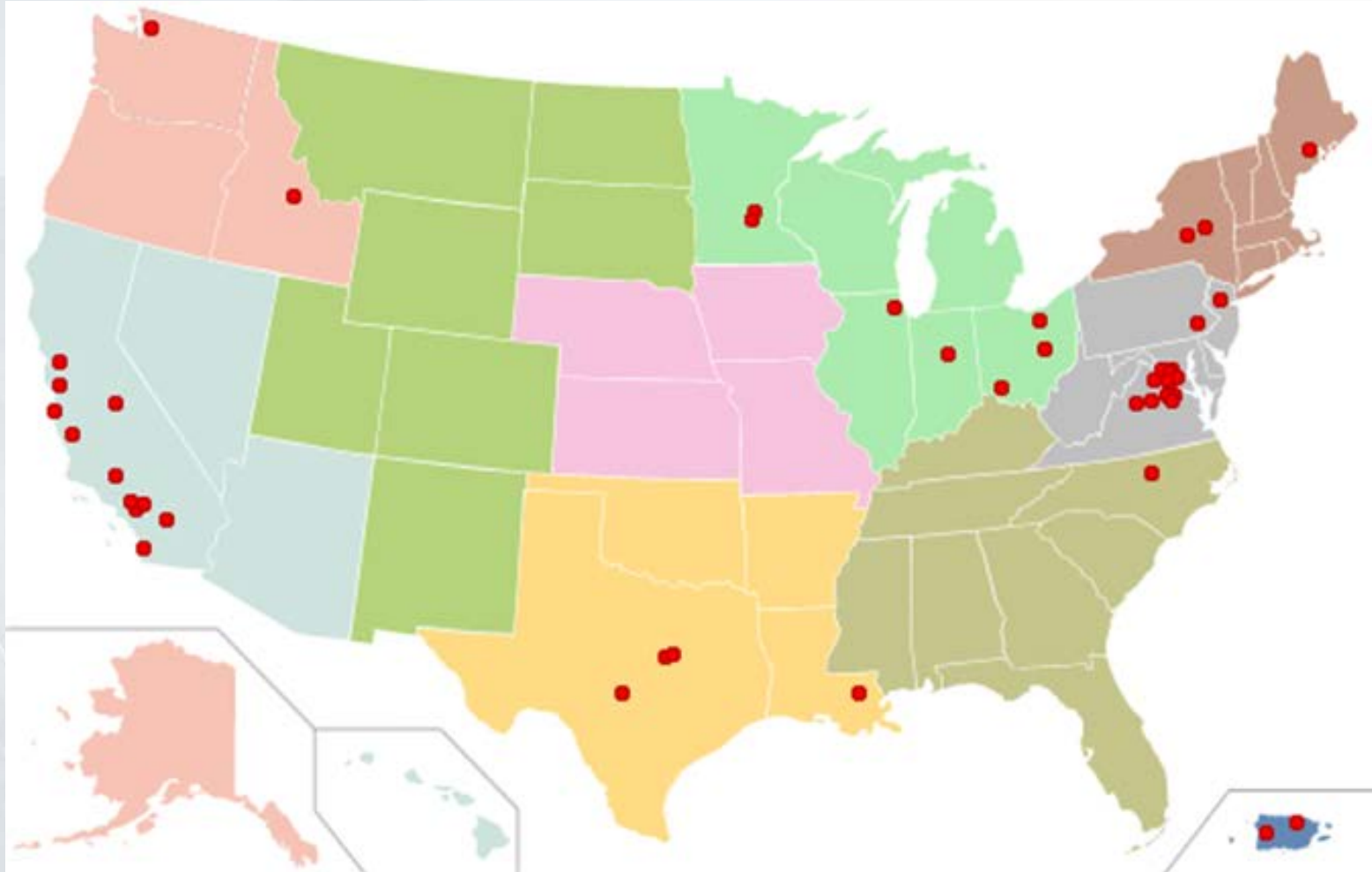
AMERICA INVENTS ACT IMPLEMENTATION

Dear AIA Subscribers:

Thank you for registering to receive regular updates about new features added to the AIA micro-site. We are delighted to have 3,057 subscribers to date and look forward to others joining as our implementation activities continue over the next several months. This is our first subscription center update since we launched our micro-site on September 16, 2011 – the date that President Obama signed the America Invents Act into law. Going forward, we plan to send additional email alerts to you on a monthly basis.

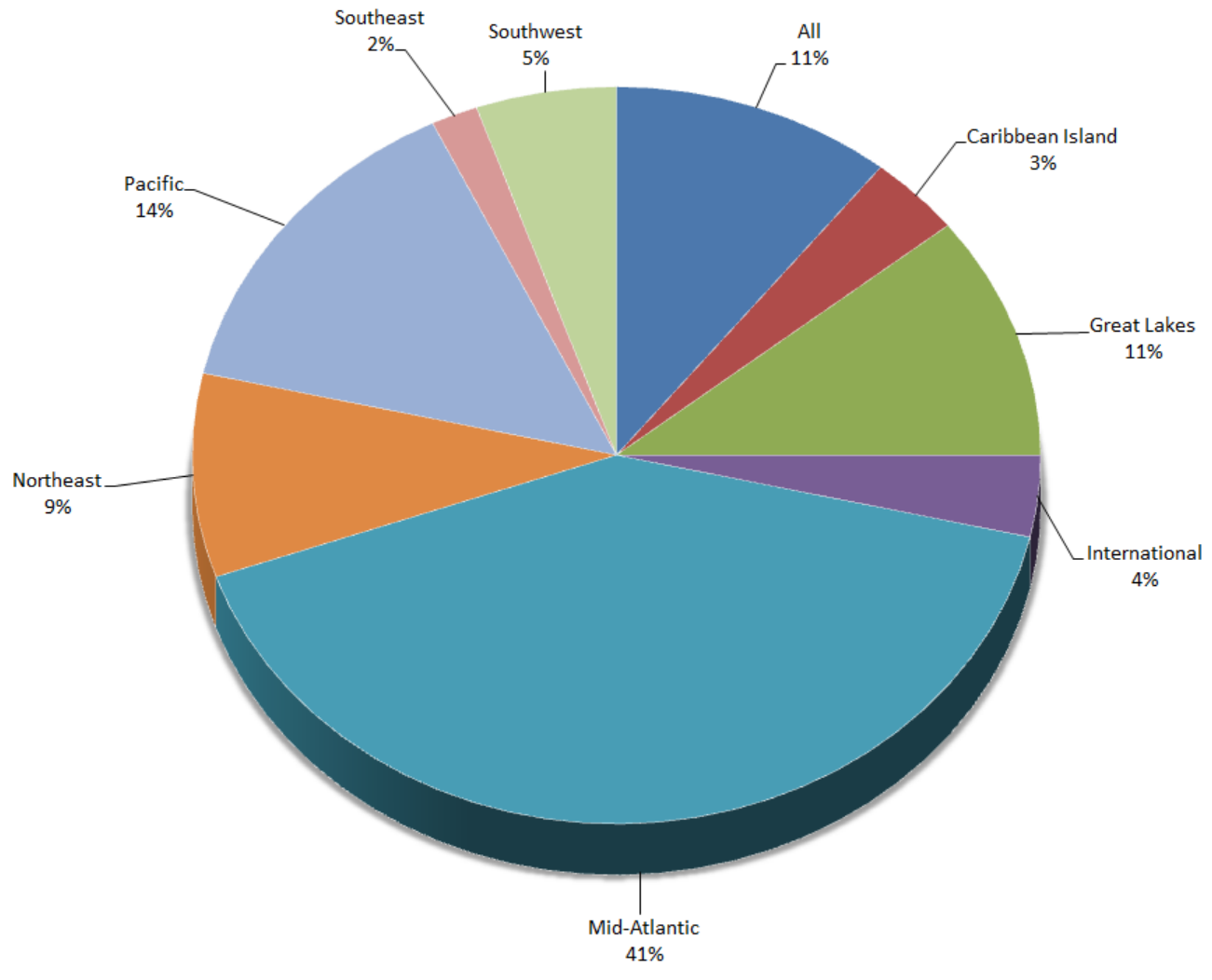


AIA Outreach





AIA Outreach (cont.)

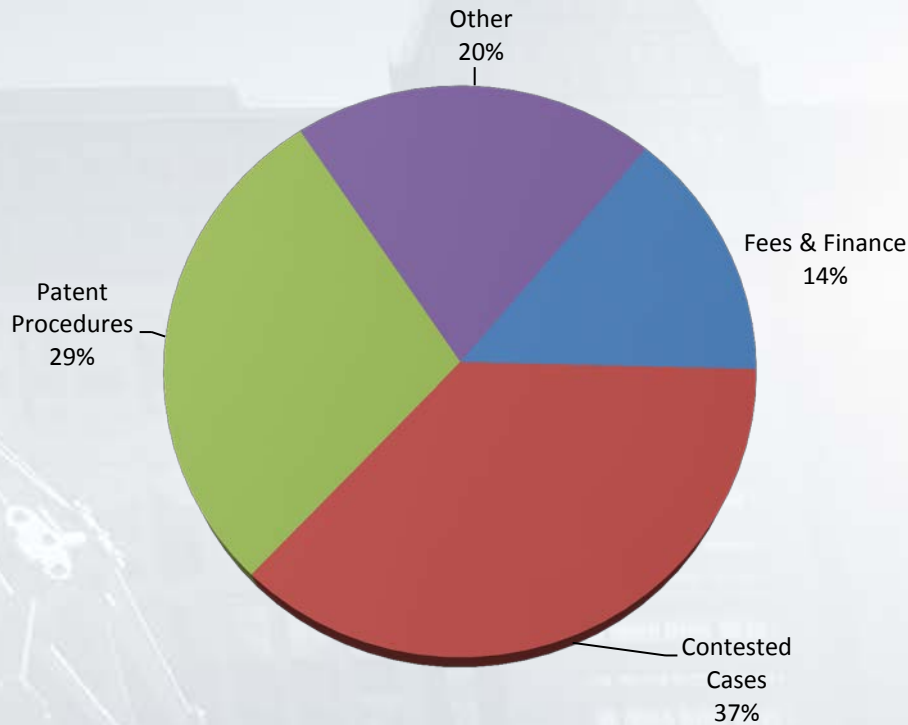




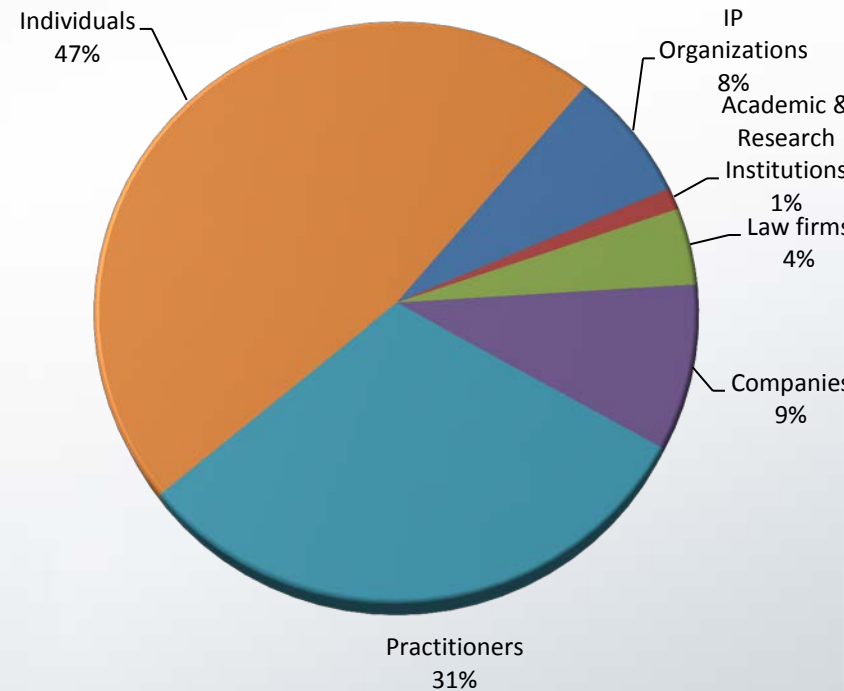
Public Comments

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Comments by Subject Area



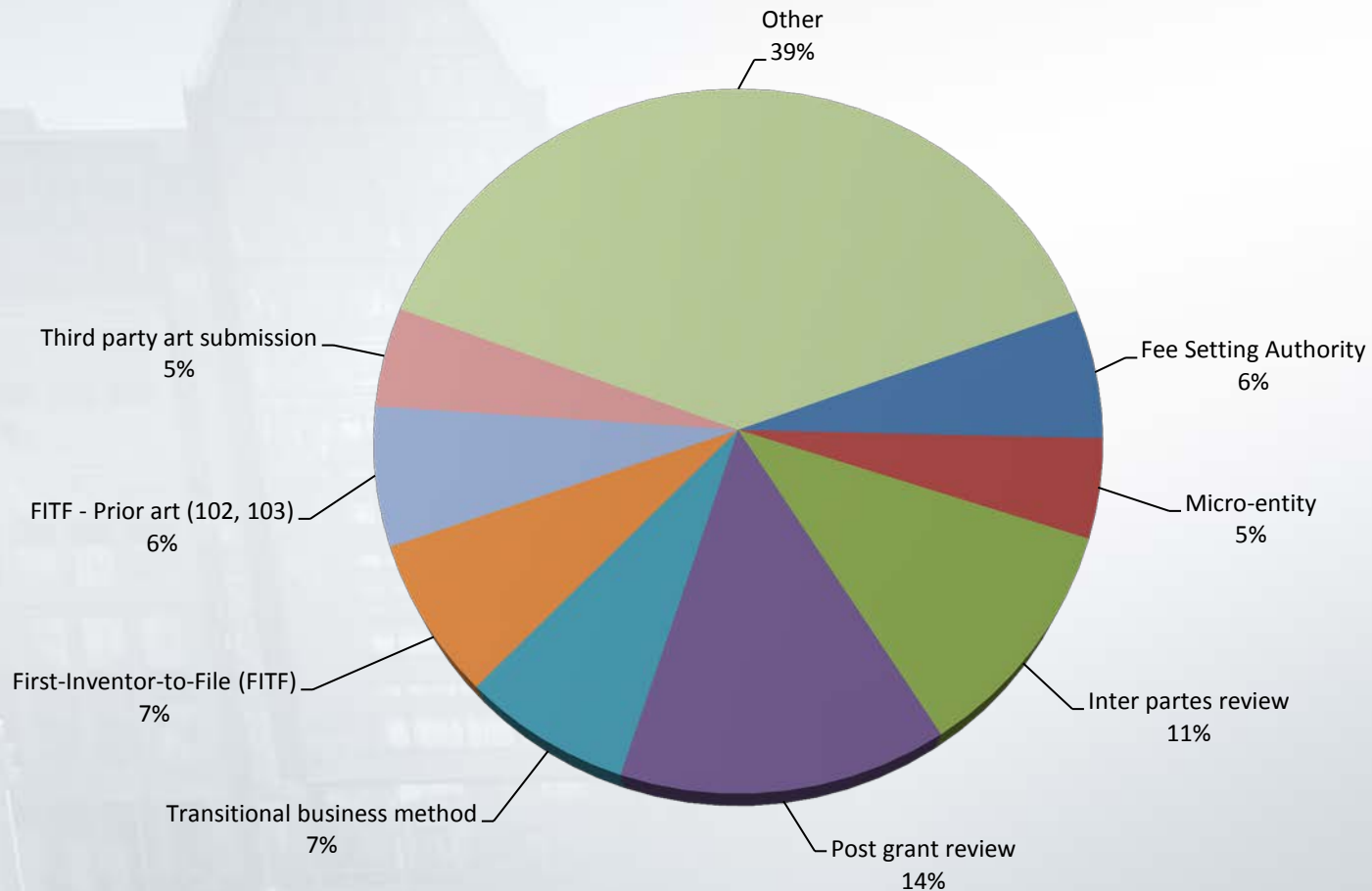
Comments by Organization





Public Comments (cont.)

Comments by Specific Subject





Group 1 Public Comment Windows

Provision	Before Proposed Rules	Response to Proposed Rules	Response to Final Rules/Guidance
Inter parte reexam threshold	N/A	N/A	Open
Tax strategies deemed within prior art	N/A	N/A	Open
Best mode	N/A	N/A	Open
Human organism prohibition	N/A	N/A	Open
Prioritized exam	N/A	N/A	Open
15% Surcharge	N/A	N/A	Open
Electronic filing incentive	N/A	N/A	Open
Fee Setting	Open until late February 2012	Mid-June 2012 to mid-August 2012	TBD
Micro-entity	Open until late February 2012	Mid-June 2012 to mid-August 2012	TBD



Group 2 Public Comment Windows

Provision	Before Proposed Rules	Response to Proposed Rules	Response to Final Rules/Guidance
Inventor's Oath/declaration	Closed	Mid/late January 2012 to mid/late March 2012	TBD
Third party submission of prior art in a patent application	Closed	Mid/late January 2012 to mid/late March 2012	TBD
Supplemental exam	Closed	Mid/late January 2012 to mid/late March 2012	TBD
Citation of prior art in a patent file	Closed	Mid/late January 2012 to mid/late March 2012	TBD
Post grant review	Closed	Mid/late January 2012 to mid/late March 2012	TBD
Inter partes review	Closed	Mid/late January 2012 to mid/late March 2012	TBD
Transitional program for covered business methods	Closed	Mid/late January 2012 to mid/late March 2012	TBD



Group 3 Public Comment Windows

Provision	Before Proposed Rules	Response to Proposed Rules	Response to Final Rules/Guidance
First-inventor-to-file	Open until mid-March 2012	Mid-June 2012 to mid-August 2012	TBD
Derivation	Open until mid-March 2012	Mid-June 2012 to mid-August 2012	TBD
Repeal of Statutory Invention Registration	Open until mid-March 2012	Mid-June 2012 to mid-August 2012	TBD

Thank You

