

Multiple Aspects of AIA Implementation



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Provisions of Law

September 16, 2011 – Present

	Completed	Ongoing
Rulemakings for Provisions of Law	7	9
Studies	2	1
Programs	2	2

Future – March 16, 2013

	Forthcoming
Rulemakings for Provisions of Law	4
Studies	0
Programs	1

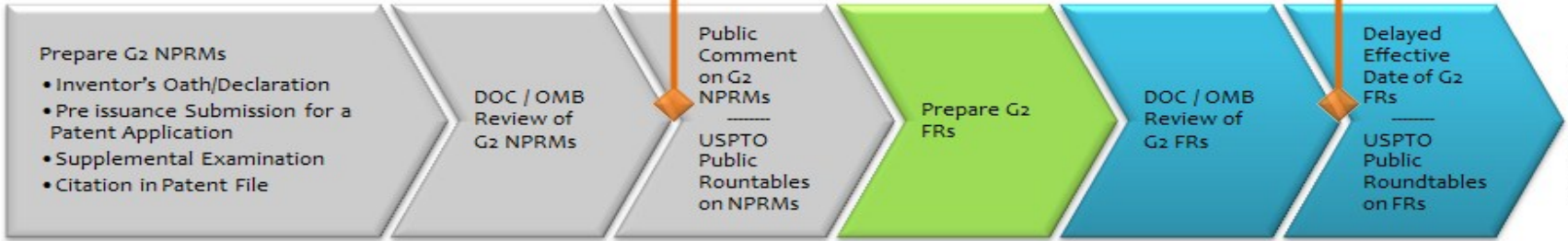




Ongoing Rulemakings

PATENT RULES

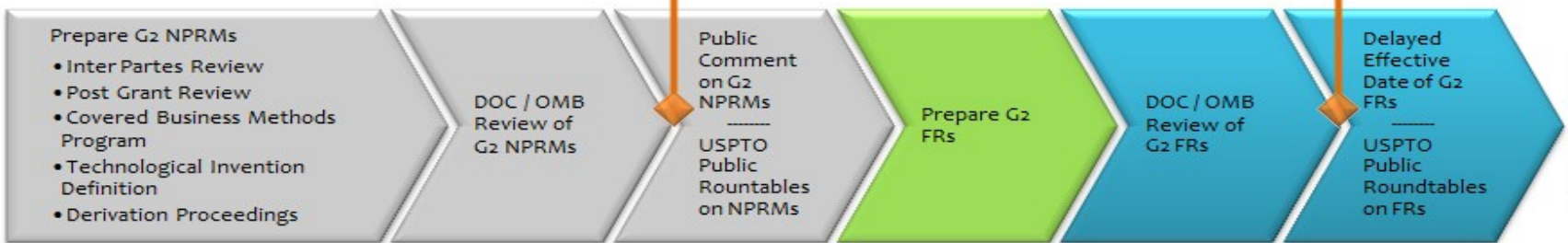
SEP 16, 2011



SEP 16, 2012

BOARD RULES

SEP 16, 2011



SEP 16, 2012

Completed
 In Progress
 Not Started

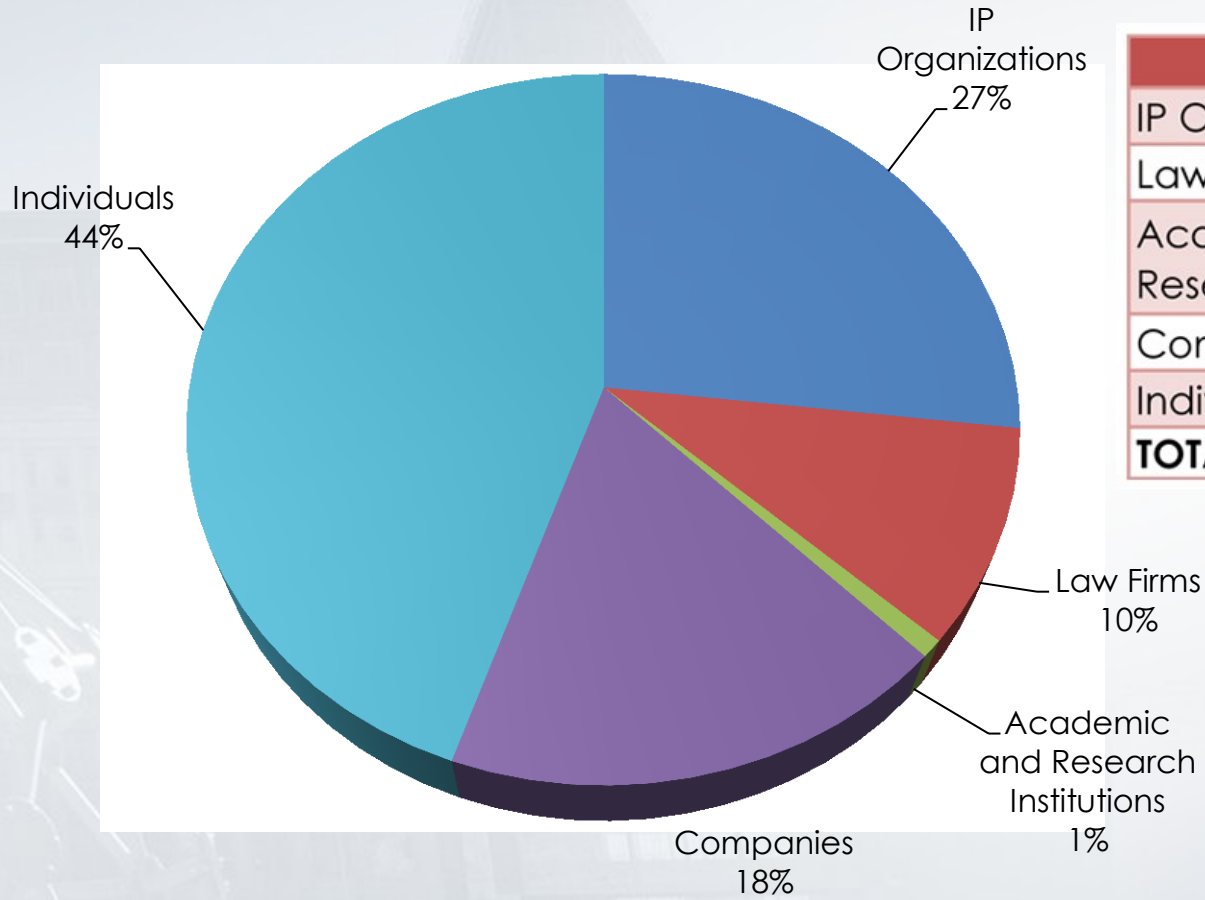


Patent Related Notices of Proposed Rulemaking

	AIA Provision	Comment Period End	Comments Received
1	Preissuance Submissions	March 5, 2012	36
2	Citation of Patent Owner Statement in a Patent File		17
3	OED Statute of Limitations		5
4	Inventor's Oath/Declaration Supplemental Examination	March 6, 2012	30
5	Supplemental Examination	March 25, 2012	35
	TOTAL	--	123



Comments on Patent Rulemaking



Entity	Comments
IP Organizations	33
Law Firms	12
Academic and Research Institutions	1
Companies	22
Individuals	55
TOTAL	123

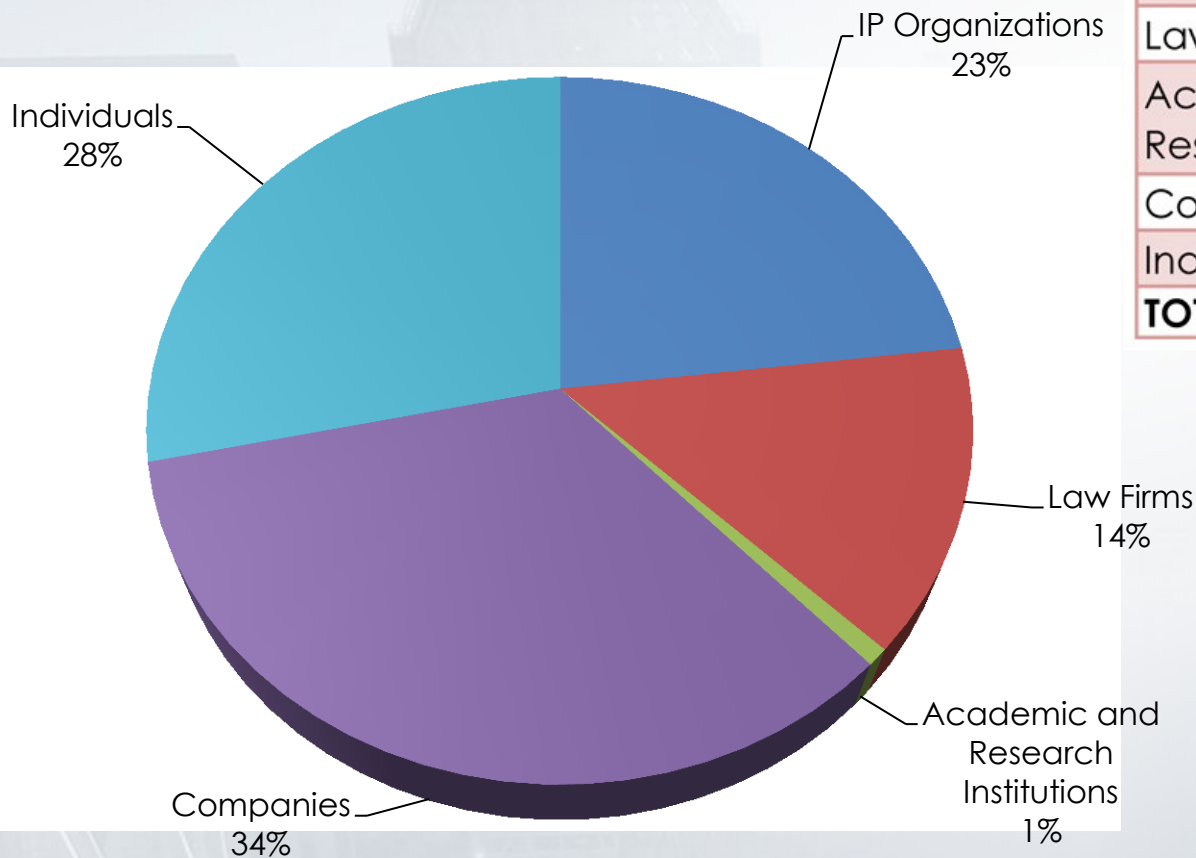


Board Related Notices of Proposed Rulemaking for Trials

	AIA Provision	Comment Period End	Comments Received
6	Inter partes review	April 10, 2012	49
7	Post-grant review		48
8	Derivation		19
9	Covered business method review		41
10	Technological invention Definition		28
11	Umbrella Rules		April 9, 2012
12	Trial Practice Guide		
	TOTAL	--	251



Comments on Board Rulemaking



Entity	Comments
IP Organizations	58
Law Firms	35
Academic and Research Institutions	2
Companies	85
Individuals	71
TOTAL	251



First-inventor-to-file: Grace Period

- Transitions the U.S. to a first-inventor-to-file patent system from first-to-invent system
- Maintains 1-year grace period for inventor disclosures
- Broadens prior art:
 - Prior public use or prior sale anywhere qualifies as prior art
 - U.S. patents and patent application publications are effective as prior art as of their “effective filing date”
 - Effective filing date = (i) actual filing date; or (ii) filing date of the earliest application for which a right of priority is sought



Forthcoming Rulemaking: First-inventor-to-file

First-Inventor-to-File

SEP 16, 2011



MAR 16, 2013



Fee Setting Authority

- Authorizes the USPTO to set or adjust patent and trademark fees by rule for 7 years
- Patent/trademark fees may be set to recover only the aggregate estimated cost of patent/trademark operations, including administrative costs

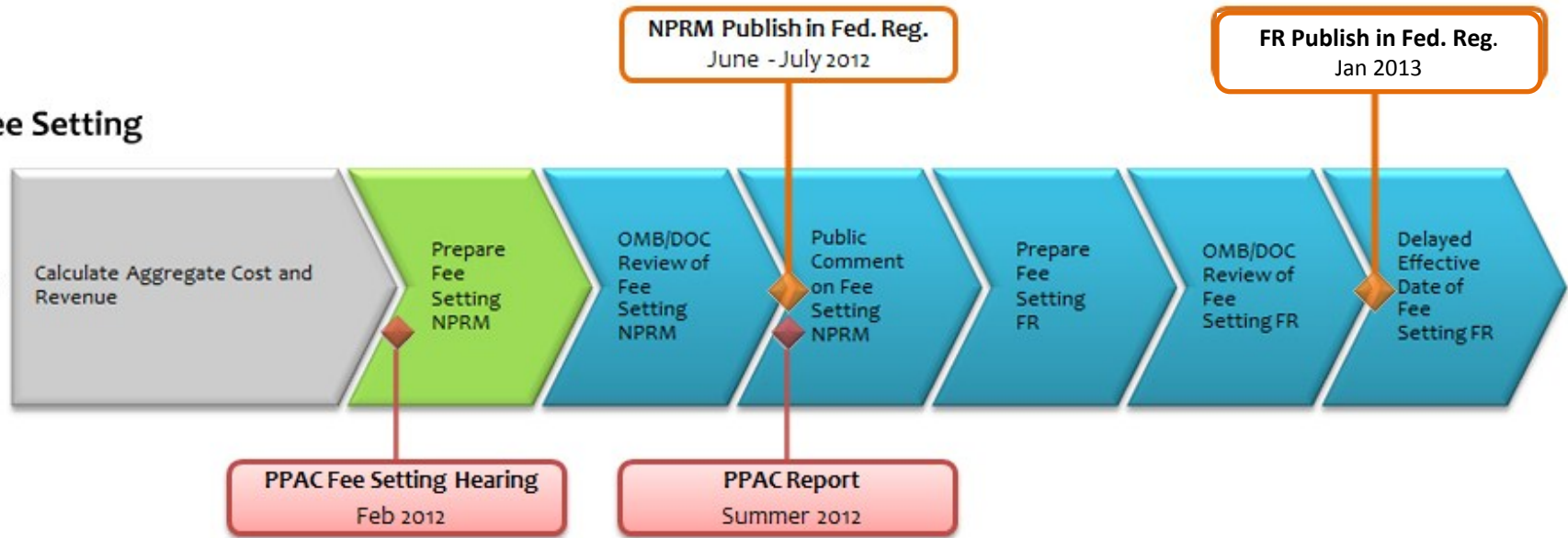




Forthcoming Rulemaking: Fee Setting

Fee Setting

SEP 16, 2011



MAR 2013

Completed

In Progress

Not Started



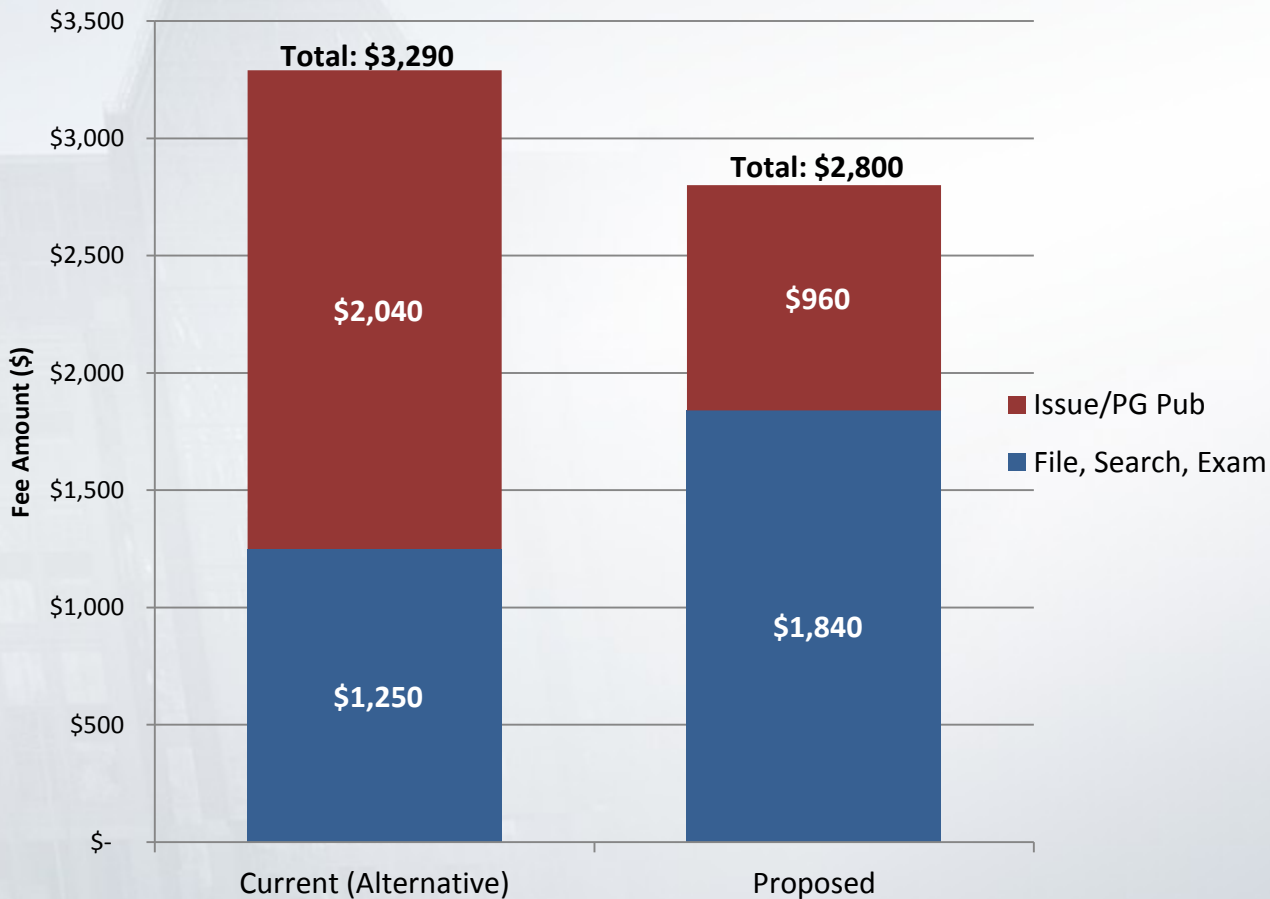
USPTO Fee Setting Principles

- Accelerate USPTO's progress in reducing the backlog of unexamined patent applications and reducing patent application pendency;
- Realign the fee structure to add processing options during patent application prosecution; and
- Put USPTO on a path to financial sustainability



Preliminary Proposed Fee Structure for a Basic Patent

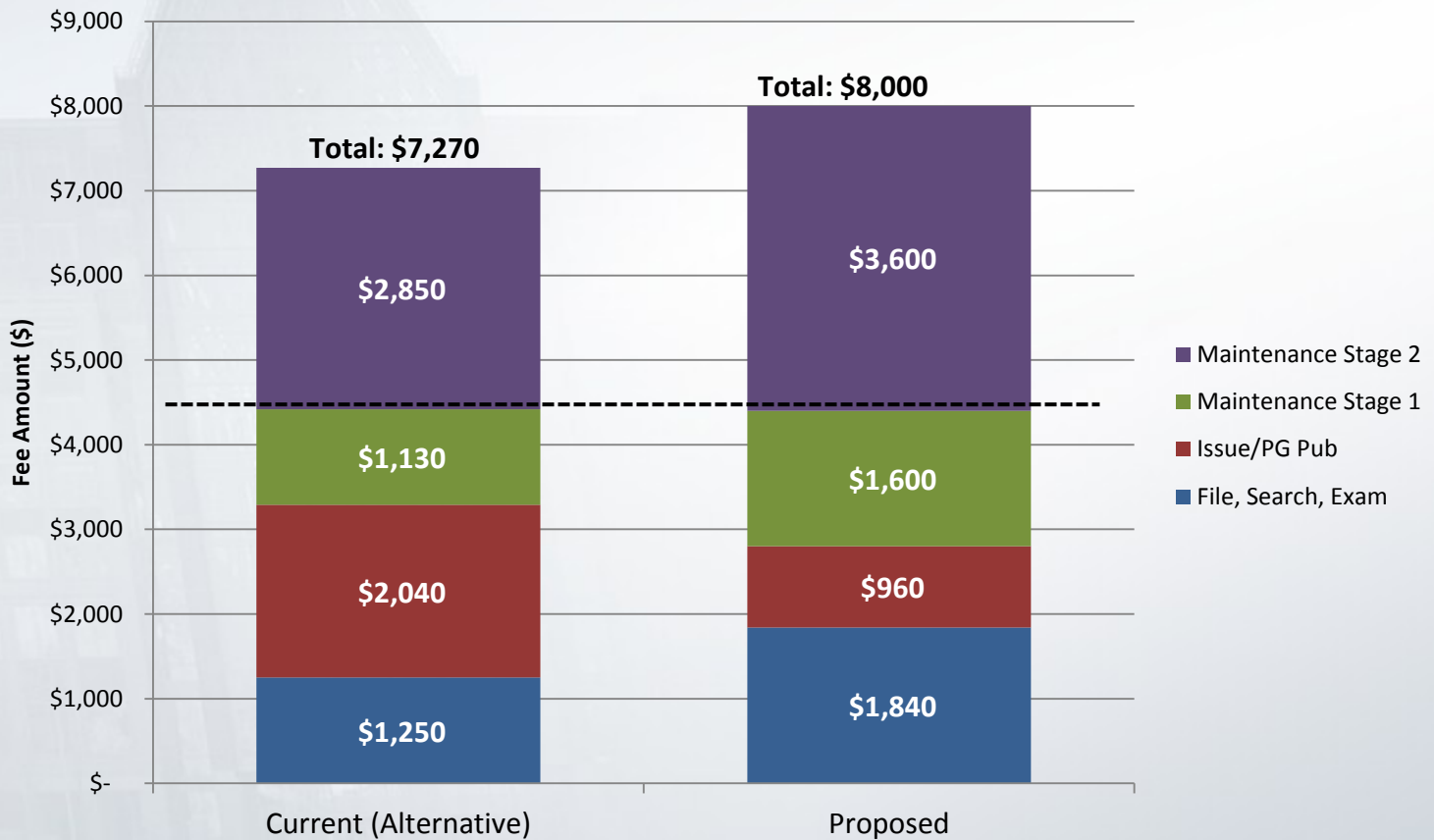
Current (Alternative) vs. Preliminary Proposed
F/S/E & Issue/PG Pub





Preliminary Proposed Fee Structure for a Basic Patent

Current (Alternative) vs. Proposed Fees through Maintenance Stage 2





Preliminary Proposed RCE Fees

Description	Historical Cost (2010)	Current Large Entity Fee	Proposed Large Entity Fee	Dollar Change	Percent Change
Request for Continued Examination Fee	\$1,696	\$930	\$1,700	+ \$770	+83%

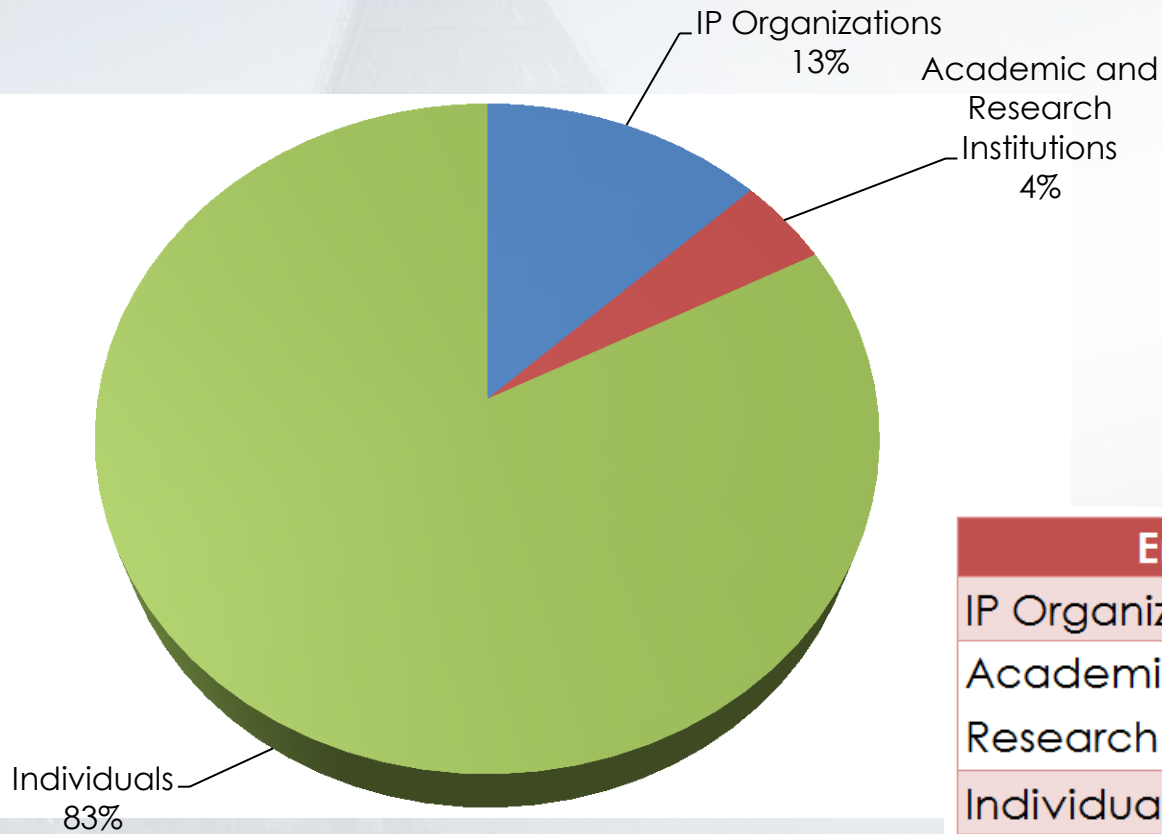


Preliminary Proposed Appeals Fees

Description	Historical Cost (2010)	Current Large Entity Fee	Proposed Large Entity Fee	Dollar Change	Percent Change
Notice of Appeal (NOA)	\$4,960	\$620	\$1,500	\$880	142%
Filing a Brief in Support of an Appeal		\$620	\$0	-\$620	-100%
Appeal Fee		\$0	\$2,500	\$2,500	
Appeal Fee Changes - Subtotal	\$4,960	\$1,240	\$4,000	\$2,760	223%
Request for Oral Hearing	\$361	\$1,240	\$1,300	\$60	5%



Comments from PPAC Hearing



Entity	Comments
IP Organizations	3
Academic and Research Institutions	1
Individuals	19
TOTAL	23



Micro-entity Status

- New size-based entity status
- Entitled to a 75% discount on fees for “filing, searching, examining, issuing, appealing, and maintaining” patent applications/patents, once the USPTO exercises its fee setting authority
- Discount not available until USPTO exercises fee setting authority
- 2 alternative definitions



Micro-entity: General Definition

- “Applicant” certifies that he/she/it:
 1. qualifies as a small entity;
 2. has not been named as an inventor on more than 4 previously filed patent applications;
 3. did not have a gross income exceeding 3 times the median household income in the calendar before the applicable fees is paid; and
 4. has not assigned, granted, conveyed a license or other ownership interest (and is not obligated to do so) in the subject application to an entity that exceeds the gross income limit

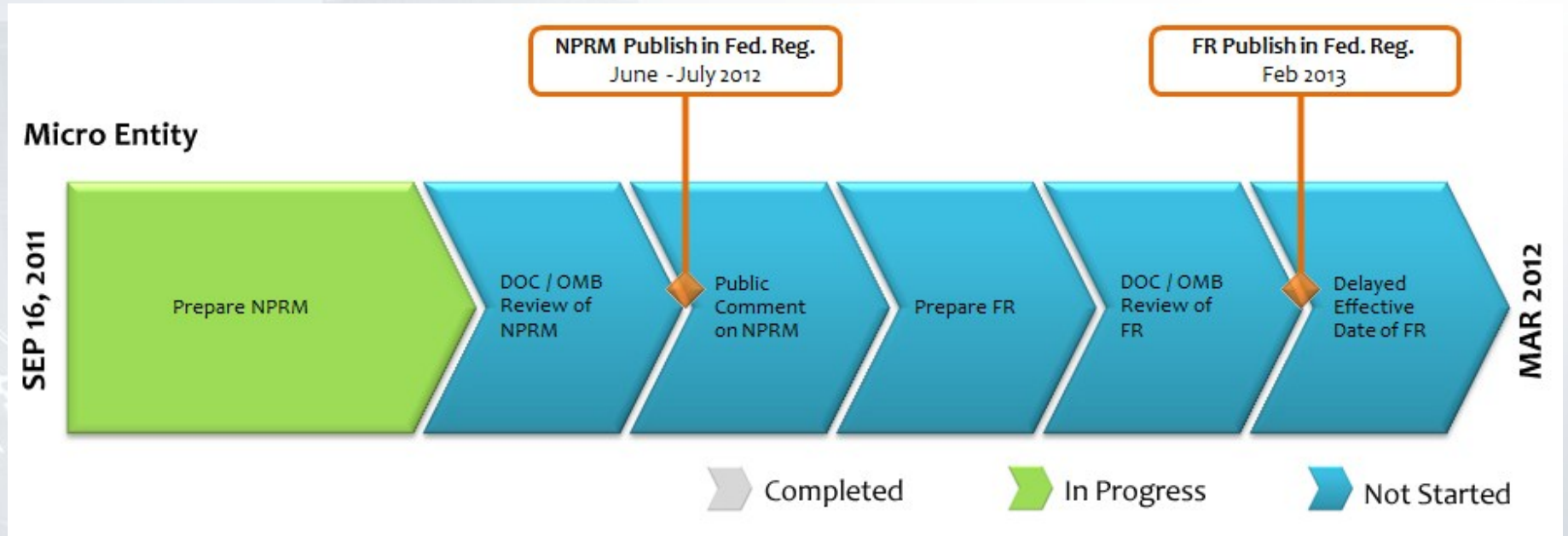


Micro-entity: Alternate Definition

- “Applicant”:
 - certifies that his/her employer is an institution of higher education as defined in section 101(a) of the Higher Education Act of 1965;
- or**
- has assigned, or is obligated to assign, ownership to that institute of higher education



Forthcoming Rulemaking: Micro-entity



Thank You



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