

The Timeline of Implementation for the America Invents Act



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Status of Rulemakings

- 20 provisions related to USPTO operations to implement
- 7 provisions implemented
- 9 provisions addressed in Notices of Proposed Rulemaking (NPRMs) to issue on 12 Month Timeline
- 2 provisions in progress on 17 Month Timeline
- 2 provisions to begin work on 18 Month Timeline*
 - First-inventor-to-file
 - Repeal of statutory invention registration



Implemented Provisions

(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 Examination: Implemented (Effective September 26, 2011)

- Original utility or plant patent application for expedited examination if:
 - \$4,800 fee, reduced by 50% for small entity;
 - no more than 4 independent claims, 30 total claims, and no multiple dependent claims; and
 - must file application electronically (utility application)
- Does not apply to international, design, reissue, or provisional applications or in reexamination proceedings; may be requested for a continuing application
- USPTO goal for final disposition (*e.g.*, mailing notice of allowance, mailing final office action) is on average 12 months from date of prioritized status



Prioritized Examination: Implemented (Data as of 1/3/12)

- 1,694 petitions filed
 - 40.8 days on average from filing to petition decision
 - 98.9% grant rate
- 648 prioritized applications received a first Office action
 - 30.7 days on average from grant of petition to first Office action
- 23 Notices of Allowance and 3 Final Rejections issued
 - 39.2 days on average from grant of petition to Notice of Allowance
 - 34.3 days to final rejection
- 1st patent issued in 101 days
 - Filed September 30, 2011
 - Issued January 10, 2012



Implementation Ongoing: 12 Month Timeline

(Effective on September 16, 2012)

	AIA Provision	Notice of Proposed Rulemaking
1	Inventor's oath/declaration	Changes to Implement the Inventor's Oath or Declaration Provisions of the Leahy-Smith America Invents Act, 77 Fed. Reg. 982 (Jan. 6, 2012) ---Comment period closes March 6, 2012
2	Preissuance submissions by third party	Changes to Implement the Preissuance Submissions by Third Parties Provision of the Leahy-Smith America Invents Act, 77 Fed. Reg. 448 (Jan. 5, 2012) ---Comment period closes March 5, 2012
3	Citation of prior art in a patent file	Changes to Implement Miscellaneous Post Patent Provisions of the Leahy-Smith America Invents Act, 77 Fed. Reg. 442, (Jan. 5, 2012) ---Comment period closes March 5, 2012
4	OED Statute of Limitations (effective September 16, 2011)	Implementation of the Statute of Limitations Provisions for Office Disciplinary Proceedings, 77 Fed. Reg. 457 (Jan. 5, 2012) ---Comment period closes March 5, 2012
5	Supplemental Examination	Changes to Implement the Supplemental Examination Provisions of the Leahy-Smith America Invents Act and to Revise Reexamination Fees, 77 Fed. Reg. 3666 (Jan. 25, 2012) ---Comment period closes March 25, 2012

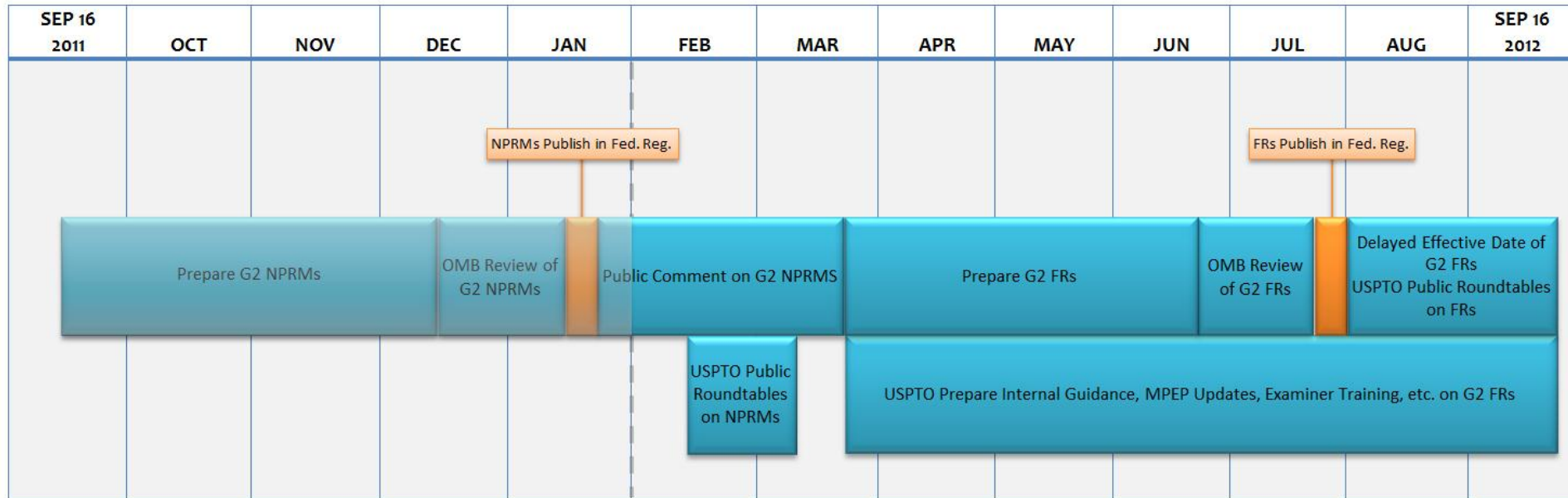


Implementation Ongoing: 12 Month Timeline (cont.) (Effective on September 16, 2012)

	AIA Provision	Notice of Proposed Rulemaking
6	Inter partes review	In progress
7	Post-grant review	In progress
8	Transitional program for covered business method patents	In progress
9	Derivation (effective on March 16, 2013)	In progress



12 Month Timeline





Preissuance Submissions

(Effective September 16, 2012)

- New 35 U.S.C. § 122(e)
- Allows third parties to submit printed publications of potential relevance to examination if certain conditions are met:
 - must provide, in writing, an explanation of the relevance of the submitted documents;
 - must pay the fee set by the Director; and
 - must include a statement by the third party making the submission affirming that the submission is compliant with statutory requirements. § 122(e)(1) & (2)



Preissuance Submissions (cont.)

- Submission must be made before the earlier of:
 - the date a notice of allowance under 35 U.S.C. § 151 is given or mailed in the application; or
 - the later of
 - 6 months after the date on which the application is first published; or
 - the date of the first rejection of any claim in the application. § 122(e)(1)(A) & (B)



Preissuance Submissions (cont.)

- Proposed rule 290(d): recites contents of submission and consists of 5 parts including:
 - List of documents being submitted;
 - Description of the relevance of each document; and
 - Copy of each document, except a U.S. patent or U.S. patent application publication; and



Preissuance Submissions (cont.)

- Proposed rule 290(g): requires fee for submission as set forth in current rule 1.17(p) (*i.e.*, fee for Rule 99 submission)
 - Three or fewer documents are free if first preissuance submission by third party;
 - \$180 for 1 to 10 documents; and
 - \$360 for 11 to 20 documents



Preissuance Submissions (cont.)

- Proposed rule 290(h): applicant has no duty to respond to the submission
 - Third party not required to serve the submission on the applicant, 77 Fed. Reg. at 449; and
 - USPTO will not notify the application of entry of the submission into an application, 77 Fed. Reg. at 450
- Examiners will acknowledge the submission in a manner similar to an IDS submission, 77 Fed. Reg. at 450



Supplemental Exam

(Effective September 16, 2012)

- New 35 U.S.C. § 257
- Patent owner may request supplemental examination of a patent to “consider, reconsider, or correct information” believed to be relevant to the patent. § 257(a)
 - Proposed rule 601(a): Request must be filed by owner of the entire right, title, and interest in the patent
 - Proposed rule 601(c): Third party participation is prohibited



Supplemental Exam (cont.)

- “Information” that forms the basis of the request is not limited to patents and printed publications. § 257(a)
 - Proposed rule 605(a): Number of items of information is limited to 10 per request
 - Proposed rule 605(a): Unlimited number of requests may be filed at any time



Supplemental Exam (cont.)

- Proposed rule 610: Recites contents of a request and consists of 12 parts including:
 - List of each item of information and its publication date;
 - Identification of each issue raised by each item of information;
 - Explanation for each identified issue;
 - Identification of how each item of information is relevant to each aspect of the patent to be examination and how each item of information raises each identified issue;
 - Copy of each item of information
 - Summary of each document over 50 pages in length



Supplemental Exam (cont.)

- USPTO must decide whether the information in the request raises a “substantial new question of patentability” within 3 months from the request. § 257(a)
 - Proposed rule 620 (a): SNQ decision “will generally be limited to” review of the issue identified in the request as applied to the patent claims
 - Proposed rule 620(e): No interviews in supplemental examination, but possible if ex parte reexamination instituted
 - Proposed rule 620(f): No claim amendment in supplemental examination, but possible if ex parte reexamination instituted



Supplemental Exam (cont.)

- Supplemental examination concludes with a supplemental reexamination certificate indicating whether any item of information raised an SNQ. § 257(a)
 - If SNQ, then the Director must order an *ex parte* reexamination. § 257(b)
 - Proposed rule 625(a): certificate will be electronic



Supplemental Exam (cont.)

- *Ex parte* reexamination conducted under 35 U.S.C. chapter 30 and 37 CFR 1.510 et seq. (the *ex parte* reexamination statute and rules), except:
 - Patent owner does not have the right to file a statement; and
 - USPTO will address each SNQ without regard to whether it is raised by a patent or printed publication. § 257(b)



Supplemental Exam (cont.)

- Inequitable conduct immunization, § 257(c)
 - Information considered, reconsidered, or corrected during supplemental examination cannot be the basis for rendering a patent unenforceable so long as the supplemental exam and any ordered ex parte reexamination are finished before the civil action is brought, § 257(c)(1) & (c)(2)(B)
 - But does not apply to information raised in a civil action brought before supplemental exam sought. § 257(c)(2)(A)



Supplemental Exam (cont.)

- Director is authorized to establish fees, and if *ex parte* reexamination is ordered, fees for *ex parte* reexamination to be collected in addition to fee for supplemental examination, § 257(d)(1)
 - Proposed rule 20(k)(1) & (2): \$5,180 for supplemental examination and \$16,120 for *ex parte* reexamination order pursuant to a supplemental examination (total of \$22,100)
 - Proposed rule 610(a): total fee must accompany request
 - Proposed rule 26(c): *ex parte* reexamination fee will be refunded if *ex parte* reexamination not ordered
 - Proposed rule 20(k)(3): non-patent document over 20 sheets has extra cost



Supplemental Exam (cont.)

- If Director learns of “material fraud” committed in connection with the patent subject to supplemental exam, the Director:
 - must confidentially refer the matter to the Attorney General; and
 - may take other action. § 257(e)
- Office regards “material fraud” to be narrower in scope than inequitable conduct as defined in *Therasense*. 77 Fed. Reg. at 3667



Ex Parte Reexamination Fee

- Proposed rule 20(c)(1): *Ex parte* reexamination fee not pursuant to a supplemental examination is increased to \$17,750 from current \$2,520



Fee Methodology

- Supplemental exam and reexamination fees set under 35 U.S.C. § 41(d)(2) for cost recovery and not under Section 10 of the AIA
 - May later be adjusted when USPTO exercises Section 10 fee setting authority
- See Cost Calculations for Supplemental Examination and Reexamination (January 25, 2012), available at http://www.uspto.gov/aia_implementation/cost_calc_supplemental_exam.pdf



Implementation Ongoing: 17 Month Timeline

1. Fee Setting Authority
 - Authority effective on September 16, 2011
2. Micro-entity
 - Status effective on September 16, 2011
 - 75% discount is not available until USPTO exercises fee setting authority



Fee Setting Authority

(Effective September 16, 2011)

- Authorizes the USPTO to set or adjust patent and trademark fees by rule
- Patent/trademark fees may be set to recover only the aggregate estimated cost of patent/trademark operations, including administrative costs
- Small entity and micro-entity discounts apply to fees for “filing, searching, examining, issuing, appealing, and maintaining” patent applications/patents
- Sunsets 7 years after enactment

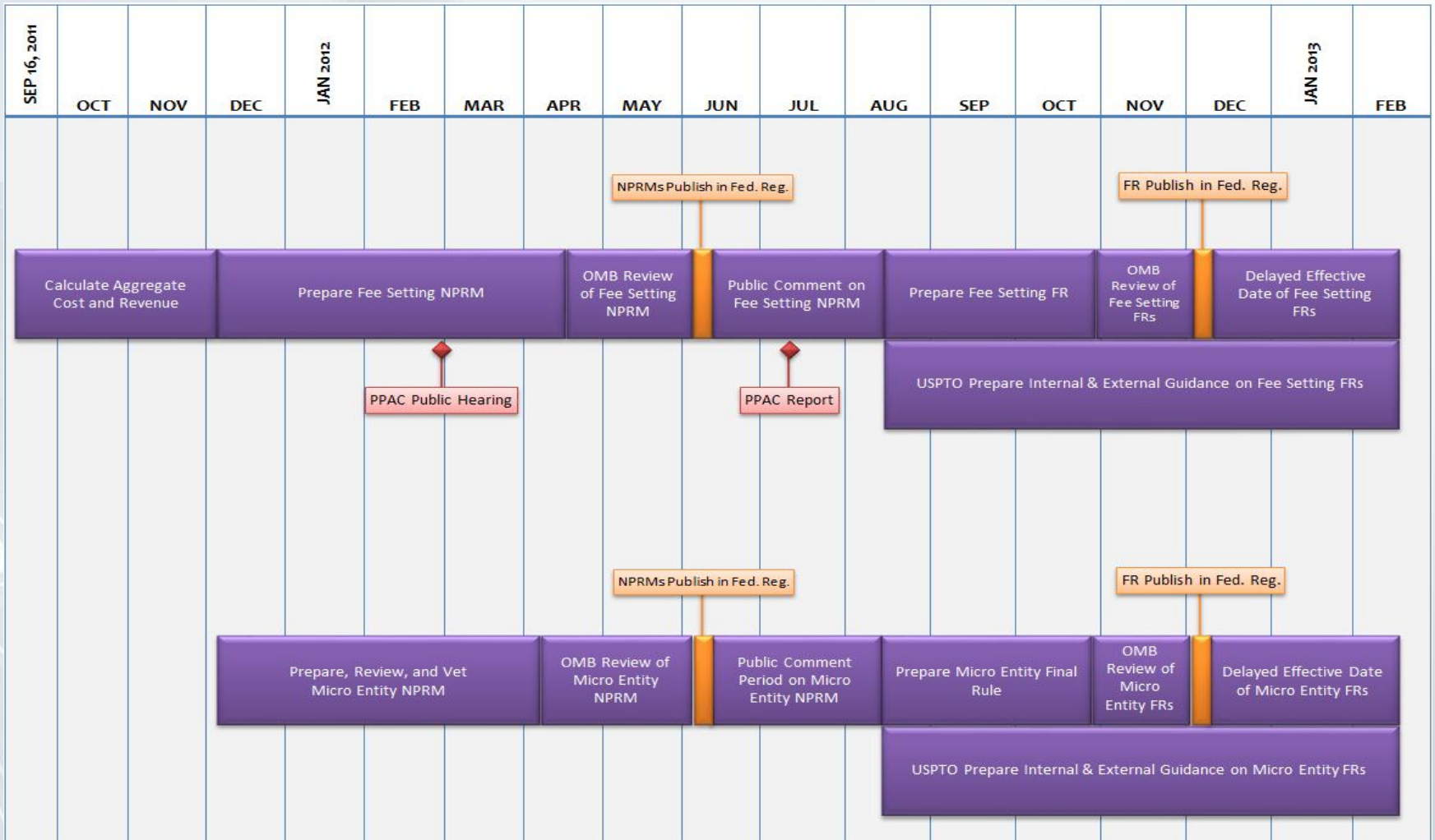


PPAC Fee Setting Hearing

- Required by section 10 of the AIA
- Patent Public Advisory Committee Public Hearings on the Proposed Patent Fee Schedule, 77 Fed. Reg. 4509 (Jan. 20, 2012)
 - Hearings:
 - Wednesday, February 15, 2012 @ USPTO
 - Thursday, February 23, 2012 @ Sunnyvale, CA
 - Written comments due by February 29, 2012
- Fee information will be posted on AIA microsite no later than Tuesday, February 7, 2012
- Questions posed on PPAC's website



17 Month Timeline





Progress Report: Studies

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



Prior User Rights Study

- USPTO studied the operation of prior user rights (PUR) in other industrialized countries
- USPTO consulted with the United States Trade Representative, Secretary of State, and Attorney General
- Report (60-pages) timely submitted to Congress on January 13, 2012



Prior User Rights Report Recommendations

- PUR defense in the AIA is consistent with that offered by major trading partners;
- No substantial evidence that PUR defense in the AIA will have a negative impact on innovation, venture funding, small businesses, universities, or independent inventors;
- U.S. should re-evaluate economic impact of PUR defense in “Implementation of AIA” report due to Congress in 2015;
- PUR defense is appropriate balance between trade secret protection and patent law; and
- U.S. patent law should provide for a PUR defense to address inequity inherent in a first-inventor-to-file system



Congressional PUR Hearing

- House Subcommittee on Intellectual Property, Competition and the Internet is holding a PUR hearing on February 1, 2012 @ 10 am in Rayburn Building
- Director Kappos to testify on PUR Report



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
- Request for Comments and Notice of Public Hearings on Genetic Diagnostic Testing, 77 Fed. Reg. 3748 (Jan. 25, 2012)
 - Hearings:
 - February 16, 2012 @ USPTO
 - March 9, 2012 @ San Diego
 - Written comments due by March 26, 2012
- Report due by June 16, 2012



Progress Report: Programs

	Topic	Due Date from Enactment	Status
1	Pro Bono	Immediately	Complete
2	Diversity of Applicants	6 months	Ongoing
3	Patent Ombudsman for Small Businesses	12 months	Ongoing
4	Satellite Offices	3 years	Ongoing



Satellite Offices

- USPTO required to open 3 satellite offices in three years
- Initial office planned for Detroit; opening 2012
 - 300 River Place Dr. = former home to Parke-Davis Laboratories and the Stroh's Brewery Headquarters
- Comment period closed on January 30, 2012 for suggestions on the locations of the two other satellite offices
 - More than 100 comments received



AIA Roadshows and Hearings

Roadshow and Hearing Schedule 2012

Date	Event	Venue	Location
Wednesday, February 15	PPAC Fee Setting Hearing*	USPTO Campus	Alexandria, VA
Thursday, February 16	Genetic Testing Hearing*	USPTO Campus	Alexandria, VA
Friday, February 17	Roadshow*	USPTO Campus	Alexandria, VA
Thursday, February 23	PPAC Fee Setting Hearing*	Sunnyvale Public Library	Sunnyvale, CA
Friday, February 24	Roadshow*	Sunnyvale Public Library	Sunnyvale, CA
Monday, February 27	Roadshow	Marriott Library, University of Utah	Salt Lake City, UT
Wednesday, February 29	Roadshow	Dallas Public Library	Dallas, TX
Friday, March 2	Roadshow	Broward County Main Library	Ft. Lauderdale, FL
Monday, March 5	Roadshow	Boston Public Library	Boston, MA
Wednesday, March 7	Roadshow	Chicago Public Library	Chicago, IL
Friday, March 9	Genetic Testing Hearing*	University of San Diego	San Diego, CA

Thank You



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