

Status Report: USPTO Implementation of the America Invents Act



Remy Yucel

Director, Central Reexamination Unit

571-272-0781 (direct)



Scope of America Invents Act

- Creates or amends patent provisions of law
- Requires USPTO to conduct studies into specific areas of patent law
- Requires USPTO to set up new programs



Progress Report: 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
 - 4 NPRMs issued on January 5-6, 2012
 - 5 NPRMs and 1 Guidance Document issued in late January/early February 2012
- 2 provisions in progress on 17 Month Timeline
- 2 provisions to begin work on 18 Month Timeline*



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)



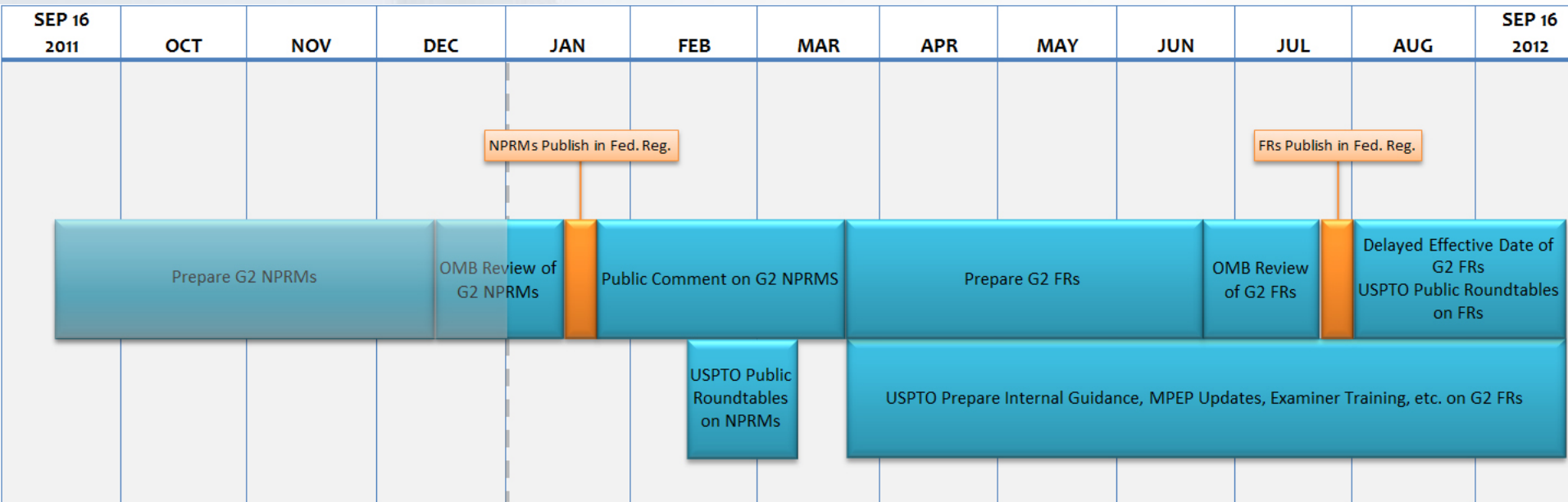
Implementation Ongoing: 12 Month Timeline

(Effective on September 16, 2012)

1. Inventor's oath/declaration
2. Third party submission of prior art in a patent application
3. Citation of prior art in a patent file
4. OED Statute of Limitations (effective September 16, 2011)
5. Supplemental Examination
6. Inter partes review
7. Post-grant review
8. Transitional program for covered business method patents
9. Derivation (effective on March 16, 2013)

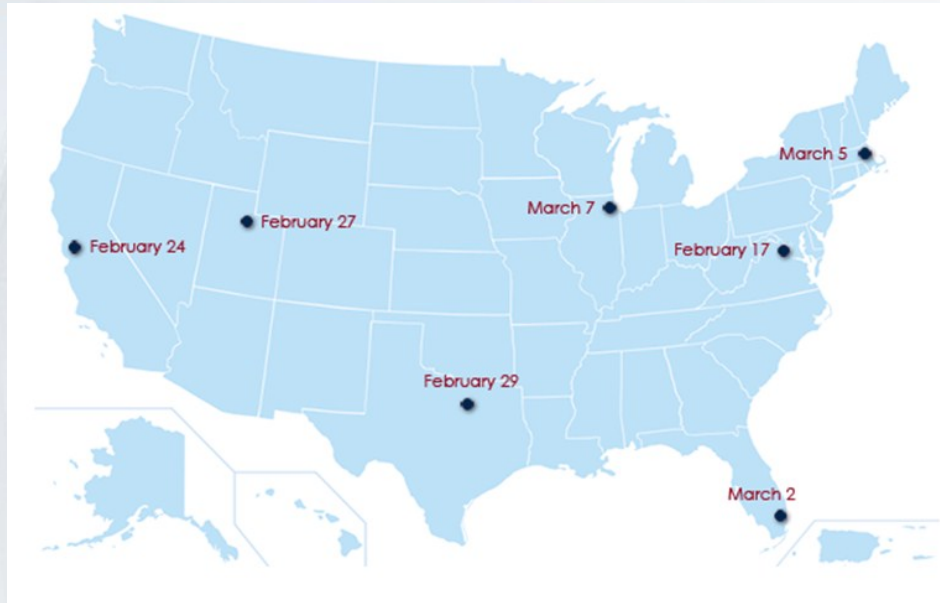


12 Month Timeline





AIA Roadshows



Date	Venue	Location
Friday, February 17	USPTO Campus	Alexandria, VA
Friday, February 24	Sunnyvale Public Library	Sunnyvale, CA
Monday, February 27	Marriott Library, University of Utah	Salt Lake City, UT
Wednesday, February 29	Dallas Public Library	Dallas, TX
Friday, March 2	Broward County Main Library	Ft. Lauderdale, FL
Monday, March 5	Boston Public Library	Boston, MA
Wednesday, March 7	Chicago Public Library	Chicago, IL



Implementation Ongoing: 17 Month Timeline

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



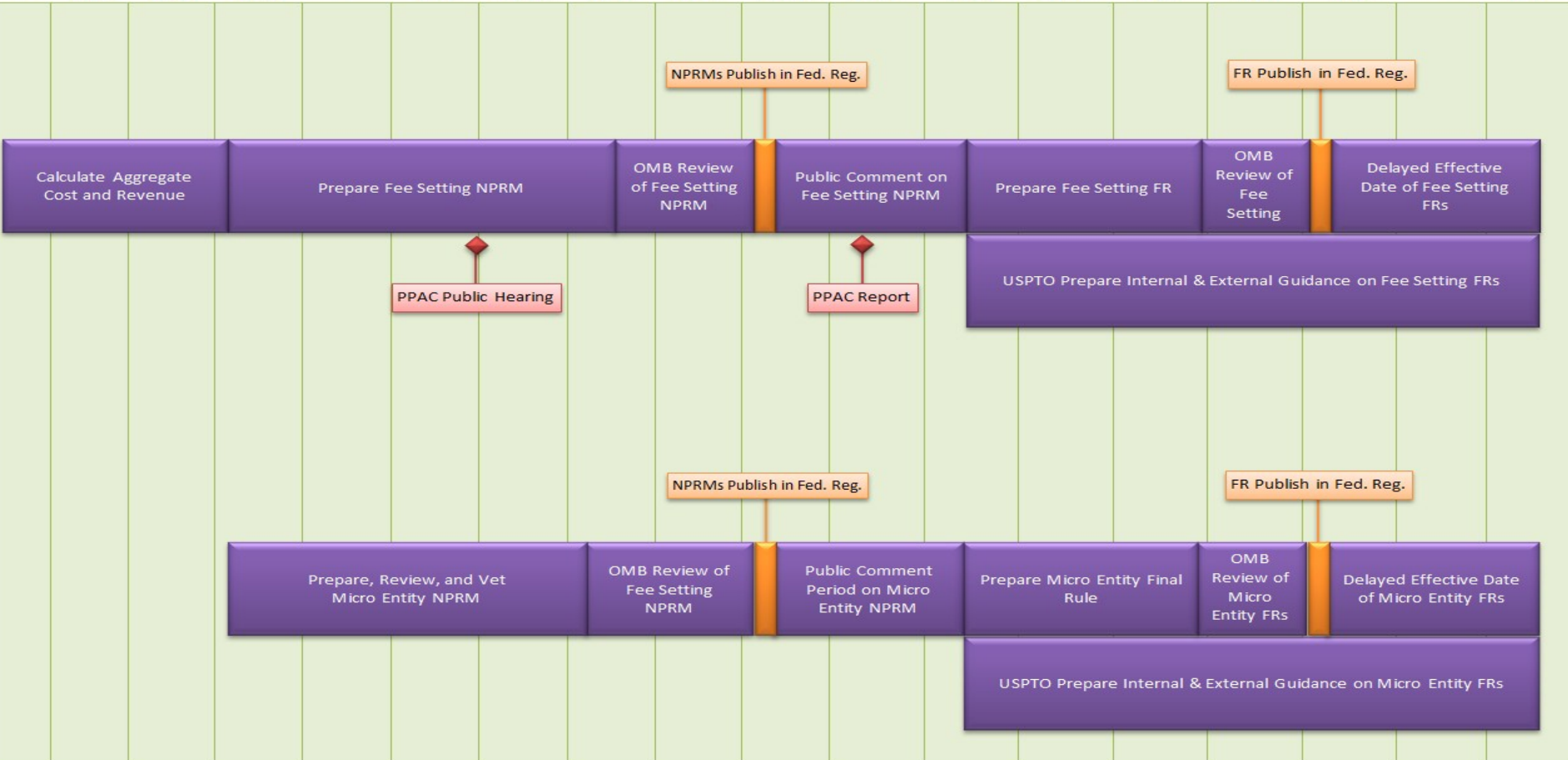
17 Month Timeline

SEPT 16, 2011

JAN 2012

JAN 2013

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



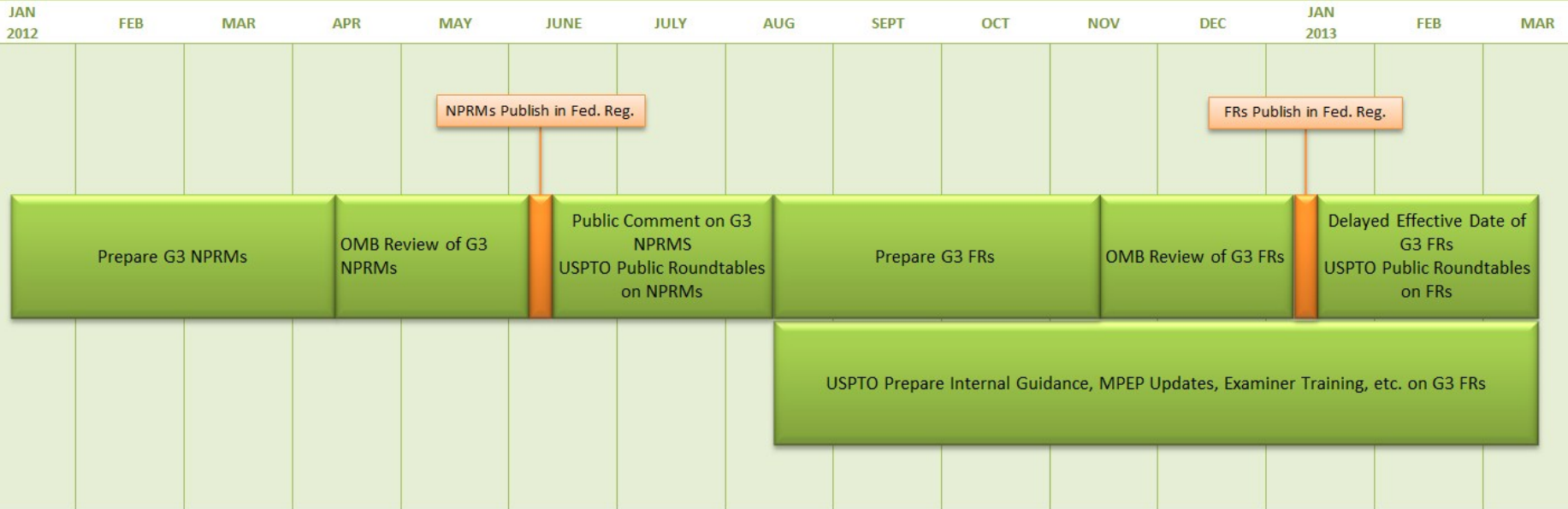


Implementation in Future: 18 Month Timeline* (Group 3; Effective on March 16, 2013)

1. First-Inventor-to-File
2. 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

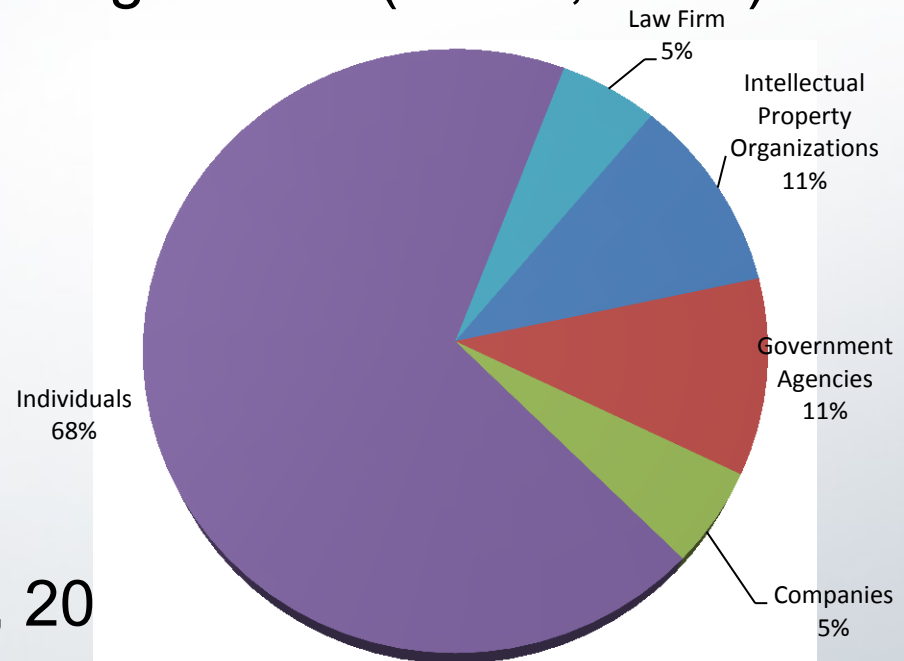
- USPTO directed to study how the USPTO and other federal agencies can best financially help small businesses with patent protection overseas
- USPTO consulting with the Department of Commerce and the Small Business Administration



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, 20





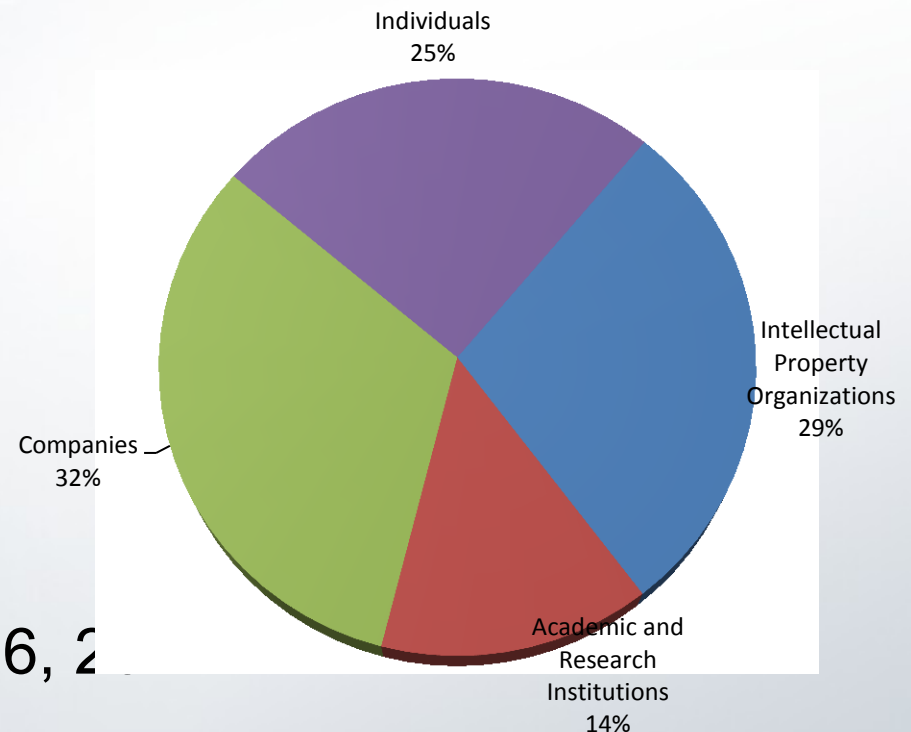
Prior User Rights Study

- 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

- Provides pro bono legal assistance to financially under-resource independent inventors and small businesses to file and prosecute patent applications
- Minnesota program running
- Task Force formed to expand the program to other cities; USPTO participating



Satellite Offices

- USPTO required to open 3 satellite offices in three years
- Initial office planned for Detroit; opening 2012
- 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



AIA Micro-Site

<http://www.uspto.gov/americaninventsact>

Implementation Information

- Patent Examination
- Inter Partes Disputes
- Fees and Budgetary Issues
- AIA Studies and Reports
- Programs
- Miscellaneous

AIA Resources

AIA Informational Videos

AIA Press Releases and Speeches

AIA Frequently Asked Questions

AIA Comments

AIA Blog

Announcements and Upcoming AIA Events

Tuesday, September 20, 2011 @ 2:10pm:
Commissioner Robert L. Stoll
The 21st AI Ohio Annual Institute on
Intellectual Property
Cleveland, OH

Wednesday, September 21, 2011 @ 2:10pm:
Commissioner Robert L. Stoll
The 21st AI Ohio Annual Institute on
Intellectual Property
Cincinnati, OH

Friday, September 23, 2011 @ 1:00pm:
Commissioner Robert L. Stoll
Virginia State Bar IP Law Section
Arlington, VA

Tuesday, September 27, 2011 @ 1:00pm:
Commissioner Robert L. Stoll
American Conference Institute
America Invents Act Webinar
<https://www2.gotomeeting.com/register/127501938>
Registration is complimentary

Leahy-Smith America Invents Act Implementation



President Barack Obama signs the America Invents Act September 16, 2011, at Thomas Jefferson High School for Science and Technology in Alexandria, Va.

Message from Director David Kappos

On September 16, 2011, President Barack Obama signed into law the Leahy-Smith America Invents Act, which will foster innovation and spur job creation in the United States. This Act sets into motion the most comprehensive overhaul to our nation's patent system since 1836.

The new law will afford more certainty for patent applicants and owners, and provide the USPTO the resources needed to operate efficiently and issue high-quality patents. Implementation of the new law will occur over a period of months, and our USPTO team will seek input and provide updates all along the way. I strongly encourage you to use this site to regularly track progress pertaining to the agency's implementation efforts.

All of us at USPTO look forward to working together with the innovation community to tackle the exciting challenges of rolling-out this historic law. Here are a few documents to get started:

- [America Invents Act Signing Ceremony](#)
- [White House chat on the America Invents Act](#)
- [Press Release: President Obama signs America Invents Act](#)
- [Leahy-Smith America Invents Act](#)
- [America Invents Act Effective Dates](#)
- [USPTO Fee Schedule](#)

Timeline: Major Milestones



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 Micro-site (cont.)

aia_implementation@uspto.gov

Comments

Thank you for visiting the Comments area for AIA implementation. The agency welcomes, encourages, and will consider all comments received about AIA implementation. We also will post all comments received to foster a dialogue among stakeholders about AIA implementation.

To Submit Comments

Comments may be submitted to the USPTO via e-mail (preferred) or postal mail to the following addresses:

Please click on the respective Rulemaking to provide comments:

Provision	Before Proposed Rules	Response to Proposed Rules	Response to Final Rules/Guidance
Group 1 Rulemakings			
Inter Partes Reexamination 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 Examination	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



Patent Reform Coordinator

Janet Gongola

janet.gongola@uspto.gov

Direct dial: 571-272-8734



Thank You!