



AMERICA INVENTS ACT

IMPLEMENTATION

Welcome

America Invents Act Roadshow

September 2012



AMERICA INVENTS ACT

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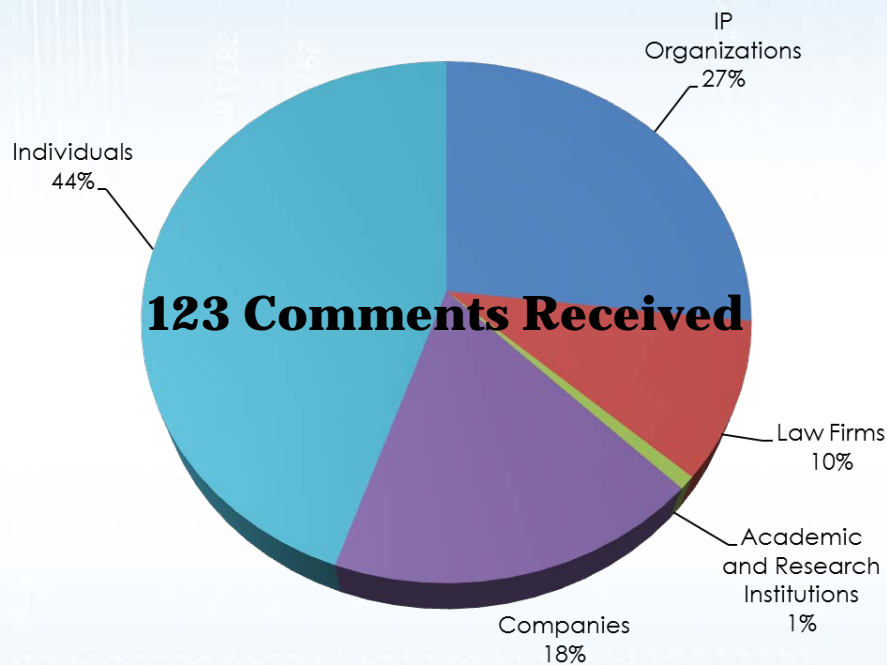
AIA Roadshows

**Alexandria, Atlanta, Detroit, Denver, Houston,
Los Angeles, Minneapolis, New York City**

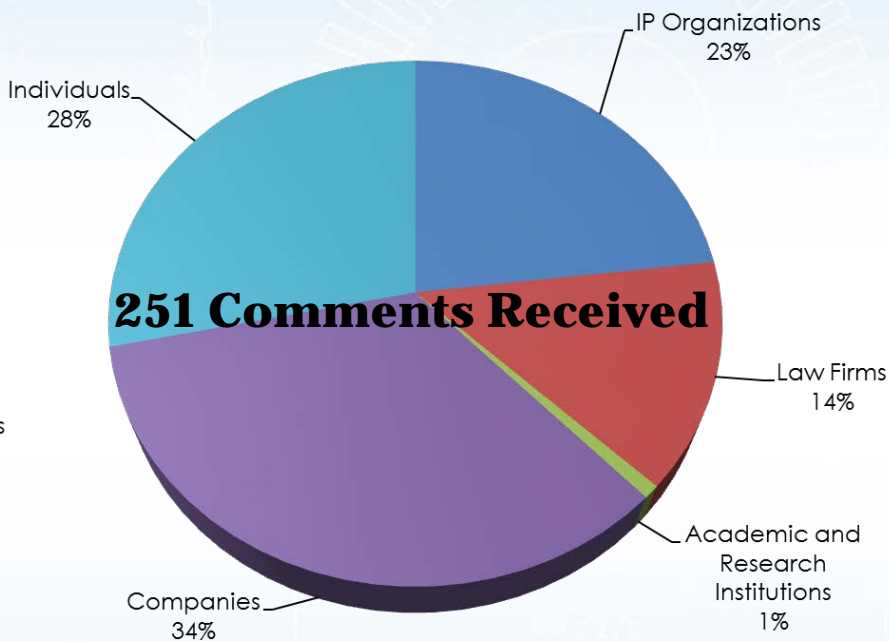


Final Rule Promulgation: Public Comments

Patent Rulemakings



Board Rulemakings



Roadshow Agenda

Time	Topic
10:30 AM to 11:00 AM	Introductory Remarks
11:00 AM to 12:30 PM	Patents Related Final Rules <ul style="list-style-type: none">• Inventor's Oath or Declaration• Supplemental Examination• Preissuance Submission• Citation of Patent Owner Claim Scope Statement
12:30 PM to 1:30 PM	LUNCH (on your own)
1:30 PM to 3:15 PM	Administrative Patent Trial Final Rules <ul style="list-style-type: none">• Post Grant Review• Inter Partes Review• Transitional Program for Covered Business Methods
3:15 PM to 3:30 PM	BREAK
3:30 PM to 4:10 PM	Proposed Patent Fee Rules
4:10 PM to 4:50 PM	First-Inventor-to-File Proposed Rules and Examination Guidelines
4:50 PM to 5:00 PM	Closing Remarks



AIA Help

- 1-855-HELP-AIA
- HELPAIA@uspto.gov
- Operational on Monday, September 17, 2012
- http://www.uspto.gov/aia_implementation/faq.jsp





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Introductory Remarks



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Patent Related Final Rules



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Inventor's Oath or Declaration: Final Rules

Inventor's Oath/Declaration: Goals

- Statutory provision and final rules aim to:
 - streamline patent application filing;
 - simplify the content requirements for an oath/declaration; and
 - offer flexibility on the timing for filing an oath/declaration



Inventor's Oath/Declaration: Dates

- Effective Date: September 16, 2012
- Applicability: Applications filed on or after September 16, 2012



Applicant Under 35 U.S.C. 118

- Permits an assignee, person to whom there is an obligation to assign, or person with a sufficient proprietary interest in the claimed invention to be the applicant
- Term “applicant” is no longer synonymous with the inventor
- Each inventor must still execute an oath or declaration



The Applicant

- Applicant may be the person:
 - To whom the inventor has assigned;
 - To whom the inventor is under an obligation to assign (obligated assignee);
and
 - Who otherwise shows sufficient proprietary interest in the matter



The Applicant (cont.)

- Applicant may also be:
 - Legal representative of a deceased or incapacitated inventor; or
 - Remaining joint inventor(s) if a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort



Name of the Inventor

- Application must include or be amended to include the name of the inventor for any invention claimed in the application
- Inventor may be named by:
 - signed application data sheet (ADS) filed before or with an executed inventor's oath/declaration; or
 - executed inventor's oath/declaration



Application Data Sheet: Requirement

- ADS is required for:
 - assignee, obligated assignee, or a person who otherwise shows sufficient proprietary interest to be considered the applicant in an application (except national stage applications);
 - claim for foreign priority (except national stage applications); and
 - claim for domestic benefit



Application Data Sheet: Benefits

- Use of an ADS permits:
 - each oath/declaration to identify only the inventor executing the oath/declaration and not the entire inventive entity; and
 - filing of the inventor's oath/declaration to be postponed until the application is otherwise in condition for allowance



35 U.S.C. 115

- 35 U.S.C. 115 requires for each inventor:
 - Oath/declaration executed by the inventor;
 - Substitute statement with respect to the inventor; or
 - Assignment that contains the statements required for an oath/declaration by the inventor
- Phrase “inventor’s oath or declaration” in the rules means an oath, declaration, an assignment-statement, or substitute statement



Inventor's Oath or Declaration: Statutory Requirements

- **Inventor must state in oath/declaration that:**
 - application was made or was authorized to be made by the person executing the oath/declaration; and
 - person executing the oath/declaration believes himself or herself to be the original inventor or an original joint inventor of a claimed invention in the application



Inventor's Oath or Declaration: Rule Requirements

- Inventor must identify in oath/declaration:
 - application to which it is directed; and
 - person executing the oath/declaration by his or her legal name



Substitute Statements

- Non-inventor applicant may file a substitute statement if an inventor:
 - is deceased;
 - is legally incapacitated;
 - cannot be found or reached after diligent effort; or
 - refuses to execute an oath or declaration



Substitute Statements Requirements

- Must contain the statements and information required for an oath/declaration;
- Identify the inventor with respect to whom the statement applies;
- Identify the person executing the substitute statement and the relationship to the non-signing inventor;
- Identify the permitted basis, i.e., whether the inventor is deceased, legally incapacitated, cannot be found after diligent effort, or refuses to execute



Assignment Containing Statements

- Assignment may serve as an oath/declaration if the assignment as executed:
 - includes the information and statements required for an oath/declaration; and
 - copy of the assignment is recorded in the Office's assignment database



Eliminated Requirements

- Oath/declaration is no longer required to state:
 - Names of all inventors (if provided in an ADS);
 - Identification of an inventor’s citizenship;
 - That the inventor believes himself or herself to be the “first” inventor; and
 - Foreign priority claims (must be provided in an ADS)



Eliminated Requirements (cont.)

- Oath/declaration is no longer required to state that the person making the oath/declaration:
 - acknowledges the duty of disclosure; and
 - has reviewed and understands the contents of the application
- However, a person may not execute an oath or declaration unless the person:
 - is aware of the duty of disclosure; and
 - has reviewed and understands the contents of the application



Inventor's Oath/Declaration: Forms

- <http://www.uspto.gov/forms/>
- Dual language forms in progress
- No form for combination assignment-statements
 - Assignment governed by state law



Timing of Submission

- Oath/declaration may be postponed until the application is otherwise in condition for allowance provided that a signed ADS has been submitted:
 - identifying each inventor by his or her legal name; and
 - with a mailing address and residence for each inventor
- Oath/declaration must still be provided for a reissue application prior to examination
- Current surcharge is still required when the oath/declaration is not present on filing



Priority and Benefit Claims

- Claim for foreign priority must be set forth in an ADS (except national stage applications)
 - Presence of the priority claim in the oath/declaration will not be recognized
- Claim for domestic benefit must be set forth in an ADS
 - Presence of the benefit claim in the first sentence(s) of the specification will not be recognized



Inventor's Oath/Declaration: Proposed v. Final Rules

Aspect	Proposed	Final
Who may file a patent application as the applicant?	Only the inventor	Inventor, assignee, obligated assignee, or person with a sufficient proprietary interest in a claimed invention
Is the oath/declaration required to identify the entire inventive entity?	Yes	No, if a signed ADS is filed that includes identification of each inventor
When is the oath/declaration required to be filed?	With a patent application or shortly thereafter	By the end of the time period set forth in a Notice of Allowability, if a signed ADS is filed with a patent application that includes an identification of each inventor



Inventor's Oath/Declaration: Proposed v. Final Rules (cont.)

Aspect	Proposed	Final
Is an assignee or obligated assignee who executes a substitute statement required to provide proof of the steps taken to obtain an executed oath/declaration for inventors who refuse to sign or cannot be found or reached?	Yes	No
If an applicant wants a combination assignment-oath/declaration to be recorded in a patent application, what is the applicant permitted to do?	File a copy of the combination document in the application	Request the Office to place a copy of the combination document in the application file





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Supplemental Examination: Final Rules

Supplemental Examination: Goals

- Statutory provision aims to provide patentees with a mechanism to immunize a patent from allegations of inequitable conduct
- Final rules designed to:
 - create a process that allows for completion of the supplemental examination within the 3-month statutory time frame and for prompt resolution of any *ex parte* reexamination; and
 - avoid a post-patent process involving large submissions of unexplained documents (like IDS practice)



Supplemental Examination: Dates

- Effective Date: September 16, 2012
- Applicability: Patent enforceable on or after September 16, 2012



Request

- Request for supplemental examination may be filed only by the patent owner
- Request may be filed at any time during the period of enforceability of the patent, e.g., generally 6 years after expiration of the patent
- Third party may not request supplemental examination or participate in a supplemental examination



Filing Requirements

- Request may be filed electronically via the Office's dedicated Web-based interface or in paper but not by facsimile
- Identify the filing as a supplemental examination request
- <http://www.uspto.gov/forms>

REQUEST FOR SUPPLEMENTAL EXAMINATION TRANSMITTAL FORM

Address to:
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Attorney Docket No.:

Date:

- This is a request for supplemental examination pursuant to 37 CFR 1.610 of patent number _____ issued _____, 37 CFR 1.610(b)(1).
- Supplemental examination of claim(s) _____ is requested. 37 CFR 1.610(b)(4).
- a. The name(s) of the patent owner(s) (**not** the patent practitioner(s)) is (are):

 b. A submission by the patent owner(s) in compliance with 37 CFR 3.73(c), which establishes that the patent owner(s) has (have) the entirety of the ownership in the patent for which supplemental examination is requested, is included. 37 CFR 1.610(b)(9).
- a. A check in the amount of \$ _____ is enclosed to cover the fee for processing and treating a request for supplemental examination, the fee for reexamination ordered under 35 USC 257, and the fee for processing and treating each non-patent document over 20 sheets in length (37 CFR 1.20(k)(1 - 3));
 b. The Director is hereby authorized to charge all applicable fees as set forth in 37 CFR 1.20(k)(1 - 3) to Deposit Account No. _____; or
 c. Payment by credit card. Form PTO-2038 is attached. 37 CFR 1.610(a).
- Any refund should be made by check or credit to Deposit Account No. _____, 37 CFR 1.26(c). If payment is made by credit card, refund must be to the credit card account.
- A copy of the patent for which supplemental examination is requested, and a copy of any disclaimer or certificate issued for the patent are included. 37 CFR 1.610(b)(6).
- CD-ROM or CD-R in duplicate, Computer Program (Appendix) or large table
 Landscape Table on CD
- Nucleotide and/or Amino Acid Sequence Submission
If applicable, items a. - c. are required.
 - Computer Readable Form (CRF)
 - Specification Sequence Listing on:
 - CD-ROM (2 copies) or CD-R (2 copies), or
 - paper
 - Statements verifying the identity of above copies
- A list of no more than 12 items of information submitted as part of this request is provided in Part B of this form. Where appropriate, the list must meet the requirements of 37 CFR 1.98(b). 37 CFR 1.605(a), 1.610(b)(2).



Contents of Request

- Identification of the patent and of each claim for which supplemental examination is requested;
- List of the items of information requested to be considered, reconsidered, or corrected;
- Separate, detailed explanation of the relevance and manner of applying each item of information to each identified patent claim;
- Summary of the relevant portions of any submitted document, other than the request, that is over fifty pages in length; and
- Fees



Items of Information

- Information must be in writing and is not limited to patents and printed publications
- Request may not include more than twelve items of information
- More than one request for supplemental examination of the same patent may be filed at any time



Fees

Service	Cost
Filing fee (for processing and treating a request for supplemental examination) <ul style="list-style-type: none">• Plus any applicable document size fees	\$ 5140
Reexamination fee (for <i>ex parte</i> reexamination ordered as a result of supplemental examination)	\$16,120
TOTAL	\$21,260
REFUND (if the Office decides not to order an <i>ex parte</i> reexamination proceeding)	\$16,120



Standard for Supplemental Examination

- If one or more items of information raises a substantial new question of patentability (SNQ):
 - *ex parte* reexamination will be ordered
- If an SNQ is not raised by any of the items of information:
 - *ex parte* reexamination will be not be ordered; and
 - *ex parte* reexamination fee will be refunded



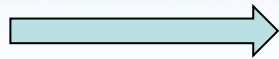
Conclusion of Proceeding

- Supplemental examination proceeding will conclude with the electronic issuance of the supplemental examination certificate
- Certificate will indicate the result of the Office's determination whether any item of information raises a substantial new question of patentability



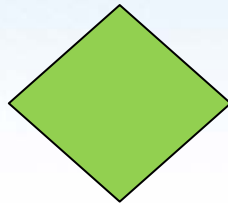
Processing

**Patent Owner
Request**



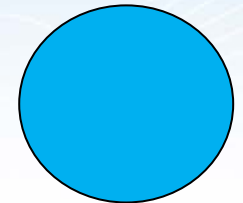
3 months

**Decision on Patent
Owner Request:
SNQ Standard
Triggered?**



YES

**Supplemental
Examination Concluded
and *Ex Parte*
Reexamination Initiated**



NO

**Supplemental
Examination
Concluded**



***Ex Parte* Reexamination Following Supplemental Examination**

- *Ex parte* reexamination regulations govern, except that:
 - patent owner will not have the right to file a patent owner statement; and
 - reexamination is not limited to patents and printed publications or to subject matter added or deleted during reexamination



Material Fraud

- If the Office becomes aware of a material fraud on the Office in connection with the patent under supplemental examination, then the matter will confidentially be referred to the U.S. Attorney General
- Office may take other action as set forth in 35 U.S.C. 257(e)
- Office regards “material fraud” to be narrower in scope than inequitable conduct



Proposed v. Final Rules for Supplemental Examination

Aspect	Proposed	Final
How many items of information may be filed in a supplement examination request?	10	12
What is the nature of the content required for the request?	More detailed	Comparable to requirements for an <i>ex parte</i> reexamination request
When can a supplemental examination request be filed?	At any time	Any time during the enforceability of the patent





AMERICA INVENTS ACT

IMPLEMENTATION

Questions?



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Preissuance Submissions: Final Rules

Preissuance Submissions: Goals

- Statutory provision aims to improve the quality of examination and issued patents
- Final rule is designed to promote:
 - efficient processing of submissions; and
 - focused submissions of the most relevant documents



Preissuance Submission: Dates

- Effective Date: September 16, 2012
- Applicability: Pending or abandoned application filed before, on, or after September 16, 2012



35 U.S.C. 122(e)

- Any third party may submit printed publications of potential relevance to the examination of an application for consideration and inclusion in the record of the application
- Must be timely made in writing and include:
 - Concise description of asserted relevance of each document;
 - Fee; and
 - Statement of compliance with statute



Filing of Submission

- May be filed in pending or abandoned non-provisional utility, design, and plant applications
- May not be filed in issued patents, reissue applications, or reexamination proceedings
- May be submitted electronically via the Office's dedicated Web-based interface or in paper but not by facsimile
- No service on applicant required
- Must be signed by submitter, but real party in interest need not be identified



EFS-Web

EFS Registered

Registered eFilers Please Read Announcements

Certification

A submission has not been filed officially at the USPTO until the e-filer executes the Submit function and the documents are received at the USPTO Eastern Time. The Acknowledgement Receipt is evidence of this submission.

All items denoted by * are required.

EFSWeb demo test.

IMPORTANT: Please read the [Legal Framework for using EFS-Web](#). For information on the Paperwork Reduction Act as it pertains to ePetitions, please see the [OMB Clearance and PRA Burden Statement ePetitions page](#); third party submissions under 37 CFR 1.290, please see the [OMB Clearance and PRA Burden Statement Third Party Submissions page](#).

Your Digital Certificate has been authenticated - please certify your identity:

- I certify that I am the certificate holder **Rich FQT Fernandez**
- I certify that I am working under the authority of the certificate holder: **Rich FQT Fernandez**



*Main Functions


- New application/proceeding

(This includes new filings of continuation, divisional, continuation-in-part and re-issue applications, as well as reexamination and supplemental examination proceedings. A request for continued examination (RCE) and continued prosecution application (CPA) are considered existing documents and must be filed as a registered eFiler.)

- Existing application/patent/proceeding 

Select Type of Submission for Existing Application/Proceeding

- Documents/Fees for an existing application/proceeding (applicant/representative only)
(A request for continued examination (RCE) and continued prosecution application (CPA) are considered existing documents)
- ePetition (for automatic processing and immediate grant, if all petition requirements are met)
- eProcessing (Electronic Terminal Disclaimer and other requests for automatic processing)
- Pre-Grant Publication under 37 CFR 1.211 to 1.221 
- Third-Party Preissuance Submission under 37 CFR 1.290 
(for utility, design, or plant application only, and not a reissue application or reexam proceeding)

- Third-Party Preissuance Submission under 37 CFR 1.290 
(for utility, design, or plant application only, and not a reissue application or reexam proceeding)

* Application Number (EXAMPLE: 99999999 , 99/999999 or 99/999.999) 

* Confirmation Number (EXAMPLE: 1234) 

* Pursuant to 37 CFR 11.18(b), a party presenting any paper to the Office is certifying that all statements made therein of the party's own knowledge are true, and that all statements made therein on information and belief are believed to be true, and all statements are made with the knowledge that whoever willfully makes any false statements or representations shall be subject to the penalties set forth under 18 U.S.C. 1001.



Printed Publications

- Submissions are limited to “printed publications,” for example:
 - U.S. patents and patent application publications
 - Foreign patents and published patent applications
 - Non-patent documents, such as articles, Office actions, communications from foreign patent offices, etc. that qualify as publications
- Need not be prior art
- Best practice is to not submit documents that are cumulative of each other or information already of record



Statutory Time Periods

- Must be made before the later of:
 - 6 months after the date on which the application is first published by the Office; or
 - date of first rejection of any claim by the examiner

AND

- Must be made before the date a notice of allowance is given or mailed



Time Period: Example



*** Third-party submission must be filed before this date**



Filing Date

- Submission is filed as of its date of receipt by the Office
- Certificate of mailing or transmission provisions do not apply



Contents of Submissions

- Document list
- Concise descriptions of relevance
- Copies of documents, but not for U.S. patents and U.S. patent application publications
- Translations for any non-English language documents
- Statements: (i) of compliance with statute and rule; (ii) that the submitting party does not have a duty of disclosure for the application; and (iii) “first and only” submission (if fee exemption applies)
- Fee (if necessary)



Form PTO/SB/429

- <http://www.uspto.gov/forms>

Doc Code: IDS
 Document Description: Information Disclosure Statement Filed
 PTO/SB/429 (08-12)
 Approved for use through 07/31/2015. OMB 0651-0062
 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 displays a valid OMB control number

THIRD-PARTY SUBMISSION UNDER 37 CFR 1.290 (Do <u>not</u> submit this form electronically via EFS-Web)	Application Number (required):
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U.S. PATENTS AND U.S. PATENT APPLICATION PUBLICATIONS			
Cite No.	Document Number	Issue Date or Publication Date	First Named Inventor
	Number-Kind Code ¹	MM/DD/YYYY	
	US-		
	US-		
	US-		
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FOREIGN PATENTS AND PUBLISHED FOREIGN PATENT APPLICATIONS				
Cite No.	Country or Patent Office and Document Number	Publication Date	Applicant, Patentee or First Named Inventor	Translation Attached
	Country Code ² -Number ³ -Kind Code ⁴	MM/DD/YYYY		<input type="checkbox"/>
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Concise Description of Relevance

- Statement of facts explaining how the document is of potential relevance to the examination of the application
- Third party should not use the concise description to:
 - propose rejections; or
 - raise arguments related to an Office action or an applicant's response



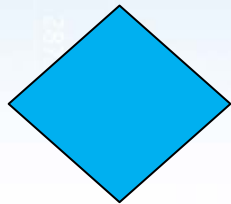
Fee

Service	Fee
Every 10 documents listed or fraction thereof	\$180 fee
First submission of 3 or fewer total documents submitted <ul style="list-style-type: none"><li data-bbox="208 858 1136 958">• Must be accompanied by “first and only” statement	No fee

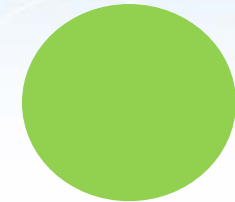
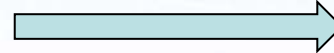
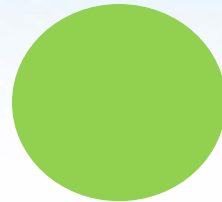


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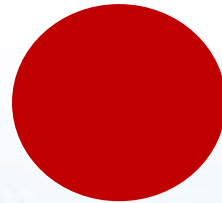
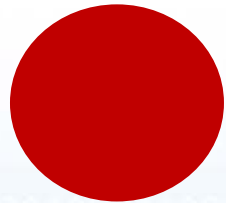
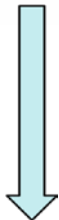
**USPTO Reviews
Submission for
Compliance with
35 U.S.C. § 122(e) and
37 C.F.R. § 1.290**



Compliant



Non-compliant



**Submission Made
of Record and
Applicant Notified
if E-Office Action
Participant**

**Submission
Considered by
Examiner**

**Third Party Notified if
Email Address Provided
with Request for
Notification**

**Submission
Discarded**



Examiner Consideration

- Submissions (documents and concise descriptions) will be considered in the same manner as documents cited on an IDS
 - Copy of the document list, indicating which documents the examiner considered, will be provided to the applicant
 - Considered documents will be printed on the patent
 - Examiner's consideration does not equate to agreement with third party
- Third party is not permitted to respond to an examiner's treatment of a submission
- Applicant need not reply to a submission in the absence of a request by the Office to do so



Proposed v. Final Rules for Preissuance Submissions

Aspect	Proposed	Final
Will an applicant be notified upon entry of a compliant submission in an application file?	No	Yes
Will a third party be notified if a submission is deemed non-compliant?	No	Yes
Is a submission permitted in a reissue application?	Yes	No, it will be treated as a protest





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Citation of Patent Owner Claim Scope Statements: Final Rules

Citation of Patent Owner Claim Scope Statements: Goals

- Statutory provision aims to prevent the patent owner from presenting different positions on claim scope for the same claims in the same patent in different proceedings
- Final rule designed to:
 - facilitate the filing and review of these statements;
 - prevent improper consideration of submissions; and
 - preserve the integrity of patent files



Dates

- **Effective Date: September 16, 2012**
- **Applicability: Any patent on or after September 16, 2012**



35 U.S.C. 301

- Expands the scope of information that may be submitted in a patent beyond prior art to include written statements about the scope of the patent claims filed by the patent owner in a federal court or USPTO proceeding
- Governs the use of such information by the USPTO
- Identity of submitter kept confidential on written request



Contents for All Submissions

- Prior art and/or patent owner claim scope statement;
- Explanation of the pertinence and manner of applying prior art and/or patent owner statement to at least one claim of the patent;
- Patent owner explanation may state how any claim is patentable over the prior art and/or patent owner statement; and
- Certificate of service on patent owner



Additional Contents for Submissions with Patent Owner Claim Scope Statements

- Documents, pleadings, or evidence from the proceeding that addresses the statement;
- Identification of the forum and proceeding in which the patent owner filed the statement;
- Identification of the submitted papers or portions of papers containing the statements; and
- Explanation of how the statement is a position taken by the patent owner in a proceeding regarding the scope of a claim



Office Usage

- USPTO will not use a patent owner claim scope statement in deciding whether to:
 - order an *ex parte* or *inter partes* reexamination; or
 - institute an administrative trial
- USPTO may take a patent owner claim scope statement into account after:
 - ordering an *ex parte* or *inter partes* reexamination;
 - or instituting an administrative trialto determine the proper meaning of the patent claims



Proposed v. Final Rules for Citation of Patent Owner Claim Scope Statements

Aspect	Proposed	Final
Who may have filed the patent owner claim scope statement in the court or USPTO proceeding?	Any person	Only the patent owner
Where may the patent owner claim scope statement have originated?	In the court or USPTO proceeding	Outside the court or USPTO proceeding in which it was filed





AMERICA INVENTS ACT

IMPLEMENTATION

Ex Parte Reexamination Estoppel: Final Rules

35 U.S.C. §§ 315(e)(1) and 325(e)(1)

- Bar a third party requester from filing an *ex parte* reexamination on the same patent after a final decision in a post grant review or *inter partes* review that was requested by the same third party (or their privies)



***Ex Parte* Reexamination Estoppel**

- Request for *ex parte* reexamination must include a certification by the third party that the requester is not estopped from requesting an *ex parte* reexamination
- Real party in interest need not be identified in a request for *ex parte* reexamination



Proposed v. Final Rules for *Ex Parte* Reexamination Estoppel

Aspect	Proposed	Final
To what proceedings does estoppel apply?	Reexamination requests and ongoing proceedings	Only reexamination requests
Does the real party in interest have to be identified in the reexamination request?	Yes	No



Appendix

- **Changes to Implement the Inventor's Oath or Declaration Provisions of the Leahy-Smith America Invents Act: Final Rule, 77 Fed. Reg. 48776 (August, 14, 2012)**
- **Changes to Implement Supplemental Examination Provisions of the Leahy-Smith America Invents Act: Final Rule, 77 Fed. Reg. 48828 (August 14, 2012)**
- **Changes to Implement the Preissuance Submissions by Third Party Provisions of the Leahy-Smith America Invents Act: Final Rule, 77 Fed. Reg. 42150 (July 17, 2012)**
- **Changes to Implement Miscellaneous Post Patent Provisions of the Leahy-Smith America Invents Act: Final Rule, 77 Fed. Reg. 46615 (August 6, 2012)**





AMERICA INVENTS ACT

IMPLEMENTATION

Questions?



AMERICA INVENTS ACT

IMPLEMENTATION

Lunch



AMERICA INVENTS ACT

IMPLEMENTATION

Administrative Patent Trials: Final Rules

NOTE: Clarifications and changes from the proposed to the final rules are shown in italicized text in this section of the presentation

Public Comments

- Patent Trial Final Rules and Practice Guide for the Final Rules are effective as of September 16, 2012
- 251 written comments
- Significant modifications
 - *E.g., fee, discovery, estoppel, and page limit provisions*



Considerations in Formulating Final Rules

- AIA provides that the Office consider:
 - effect of the regulations on the economy;
 - integrity of the patent system;
 - efficient operation of the Office; and
 - ability to timely complete the proceedings
- Legislative history provides that proceedings reflect a quick, effective, and efficient alternative to often costly and protracted district court litigation



Trial Structure

- Same basic structure for all the proceedings
- Reduction of burdens on the parties via:
 - Streamlining and converging issues for decision;
 - Use of page limits and electronic filing;
 - Use of conference calls; and
 - Institution of a trial on a claim-by-claim, ground-by-ground basis



Trial Rules

Inter Partes Review
§§ 42.100 – 42.123

Post-Grant Review
§§ 42.200 – 42.224

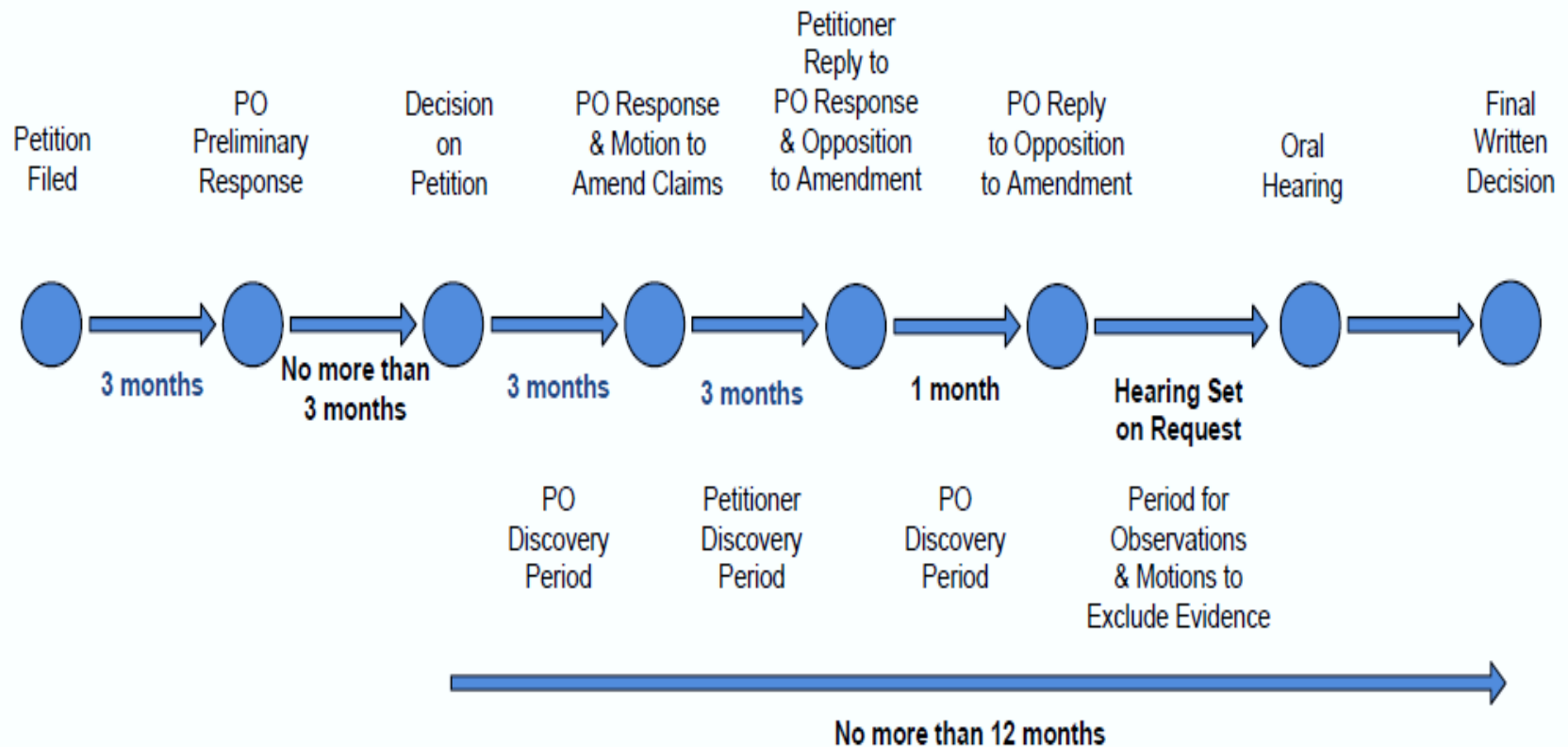
Umbrella Trial Rules
§§ 42.1 – 42.80

Covered Business
Method Patent Review
§§ 42.300 – 42.304

Derivation Proceeding
§§ 42.400 – 42.412



Trial Proceedings



PO = Patent Owner



Major Differences between IPR, PGR, and CBM

IPR

All patents are eligible

Petitioner has not filed an invalidity action and petition is filed no more than one year after service of infringement complaint for the patent

Only §§ 102 and 103 grounds based on patents or printed publication

PGR

Only FITF patents are eligible

Petitioner has not filed an invalidity action

Only §§ 101, 102, 103, and 112, except best mode

CBM

Both FTI & FITF patents are eligible, but must be a covered business method patent

Petitioner must be sued or charged w/ infringement

Only §§ 101, 102, 103, and 112, except best mode



Threshold Standards for Institution

IPR

Petition must demonstrate a **reasonable likelihood** that petitioner would prevail as to at least one of the claims challenged

PGR/CBM

Petition must demonstrate that it is **more likely than not** that at least one of the claims challenged is unpatentable

PGR/CBM: Greater than 50% chance

IPR: May encompass a 50/50 chance



Time Windows to File IPR/PGR/CMB Petition

First-to-Invent
Patents

CBM
After issuance

IPR
> 9 months
from issue date

First-Inventor-
to-File
Patents

PGR
 ≤ 9 months
from issue date

IPR or CBM
> 9 months
from issue date



***Inter Partes* Review: Features**

- All patents are eligible
- Third party who has not previously filed a civil action challenging the validity of a claim
- Request to cancel as unpatentable based only on patents or printed publications under § 102 or § 103
- Filed after the later of:
 - 9 months after the grant of a patent or issuance of a reissue of a patent; or
 - date of termination of any post grant review of the patent



Inter Partes Review: **Petition Requirements**

- Fee
- Real parties in interest
- Claims challenged and grounds
- Claim construction and show how claim is unpatentable
- Evidence
- Certify not estopped



Inter Partes Review: Patent Owner Preliminary Response

- Provide reasons why no IPR should be instituted
- Due *3 months* from petition docketing date
- Documentary evidence permitted
- *Testimonial evidence permitted where interests of justice so require, e.g., to demonstrate estoppel*



Inter Partes Review: **Threshold and Institution**

- Reasonable likelihood that petitioner would prevail as to at least one of the claims challenged
- Board will institute the trial on:
 - claim-by-claim basis; and
 - ground-by-ground basis
- *Party may request rehearing*
- Completed within one year from institution, except the time may be extended up to six months for good cause



Inter Partes Review: **Patent Owner Response**

- Address any ground for unpatentability not already denied by the Board
- File, through affidavits or declarations, any additional factual evidence and expert opinions
- *Due 3 months from institution*



Inter Partes Review: **Motion to Amend**

- *Authorization is not required to file the initial motion to amend, but conferring with the Board is required*
- May cancel any challenged claim and/or propose a reasonable number of substitute claims
- *Additional motion may be authorized for good cause, e.g., where supplemental information is belatedly submitted*
- May be limited to prevent abuse and to aid in efficient administration and timely completion of the proceeding



Post-Grant Review

- Most aspects of PGR and IPR are effectively the same
- Some differences as compared with IPR:
 - With limited exceptions, only those patents issuing from applications subject to first-inventor-to-file provisions are eligible
 - Challenges may be based on §§ 101, 102, 103, and 112, except best mode
 - Only be requested on or prior to the date that is 9 months after the grant of a patent or issuance of a reissue patent
 - Petition must demonstrate that it is more likely than not (*i.e.*, a higher threshold than IPR) that at least one of the claims challenged in the petition is unpatentable



Covered Business Methods

- Employ the PGR standards and procedures subject to certain exceptions
- Some differences with PGR:
 - Cannot file CBM petition during time a PGR petition could be filed, *i.e.*, 9 months after issuance of a patent
 - Petitioner must be sued or charged with infringement
 - Petitioner has burden of establishing that patent is eligible for CBM review
 - Prior art is limited when challenging a first-to-invent patent



Covered Business Methods: Eligible Patents

- Both first-to-invent and first-inventor-to-file patents are eligible
- Must be a covered business method patent
 - Generally defined in the AIA as a method or corresponding apparatus for performing data processing or other operations for financial product or service
 - Definition excludes patents for technological inventions

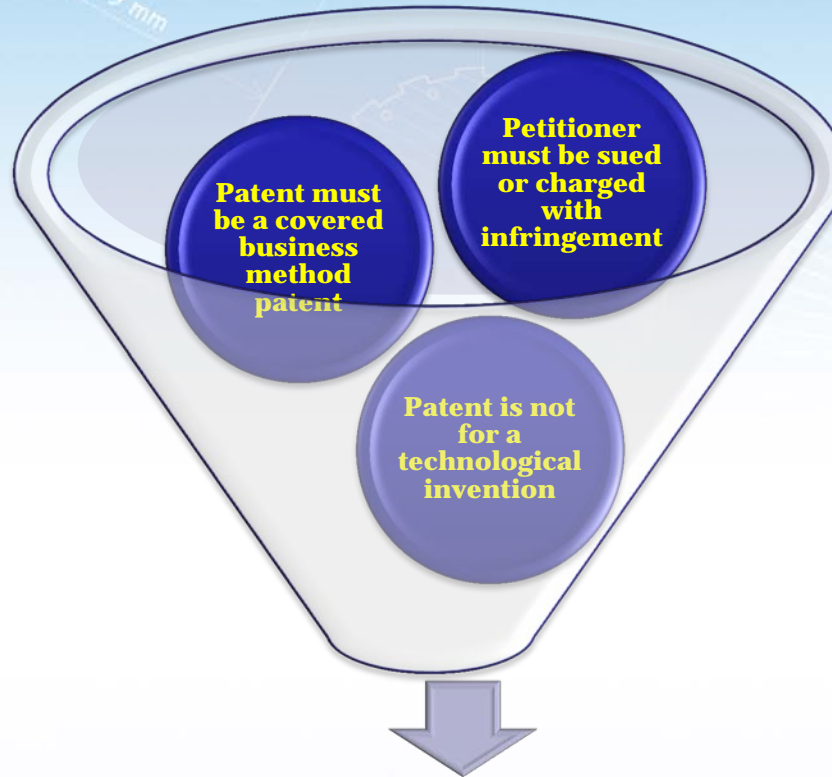


Covered Business Methods: Technological Invention

- **Solely** for purposes of a CBM review the following will be considered on a case-by-case basis:
- whether the claimed subject matter as a whole:
 - (1) recites a technological feature that is novel and unobvious over the prior art; and
 - (2) solves a technical problem using a technical solution
- *Based on what the patent claims, i.e., a patent having one or more claims directed to a covered business method is eligible for review*



Covered Business Methods



CBM Review



Derivation

- Only a patent applicant may file
- Must be filed within 1 year of the date of the first publication of a claim to an invention that is the same or substantially the same as the earlier application's claim to the invention
 - *“The first publication” means either a patent or an application publication under 35 U.S.C. 122(b), including a publication of an international application designating the U.S. as provided by 35 U.S.C. 374*



Derivation

- Must have a claim that is the same or substantially the same as a respondent's claim, and the same or substantially the same as the invention disclosed to the respondent
 - *“Same or substantially the same” means patentably indistinct*
- Must set forth basis for finding that an inventor named in an earlier application or patent derived the claimed invention



Derivation

- *Must certify that the inventor from whom the invention was derived did not authorize the filing of the earliest application claiming such invention*
- Must provide substantial evidence, including one affidavit, in support of the petition to show how the invention was communicated to the respondent
- Not likely to be instituted, even if standard is met, until a patent with the claimed invention issues



Umbrella Rules

- Real parties in interest have to be identified
 - Practice Guide provides factors that may be considered in determining whether a party constitutes a real party in interest or privy
- Petitioner and patent owner must provide a certain information necessary to conduct the proceeding including:
 - related proceedings;
 - lead and backup counsel; and
 - contact information (email addresses and phone numbers)



Umbrella Rules

- *Lead counsel must be a registered practitioner*
- Board may recognize counsel pro hac vice upon a showing of good cause, subject to the Office's Code of Professional Responsibility and any other conditions as the Board may impose
 - *E.g., counsel is an experienced litigation attorney and has a familiarity with subject matter at issue*
- Board may revoke pro hac vice status, taking into account various factors, including:
 - incompetence,
 - unwillingness to abide by the Office's Code of Professional Responsibility, and
 - incivility



Umbrella Rules: Petition Fees

- *Final rule establishes a flat fee for each additional challenged claim after 20*
- *Proposed fee escalation in block increments of 10 claims not adopted*

IPR

\$ 27,200

\$ 600

*for each additional
claim > 20*

PGR/CBM

\$ 35,800

\$ 800

*for each additional
claim > 20*

Derivation

\$ 400



Umbrella Rules: Fee Setting

- Director is required to set fees for IPR, PGR, and CBM “in such amounts as the Director determines to be reasonable, considering the aggregate costs of the review”
- Consistent with statute, fees promulgated at a cost recovery level
- *Pursuant to new fee setting authority under section 10 of the AIA, Office is proposing a staged fee structure which would permit a refund of a portion of the petition fees in cases where a trial is not instituted*



Umbrella Rules: Page Limits

- *Proposed page limits have been increased:*

IPR

60 pages

*For a petition,
PO preliminary
response, and
PO response*

PGR/CBM

80 pages

*For a petition,
PO preliminary
response, and
PO response*

Derivation

60 pages

*For a petition and
opposition*

- *Single spacing is permitted for claim charts*
- *Statement of material facts in a petition or motion is optional*



Umbrella Rules: Confidential Information

- File of a proceeding is open to the public, except that a party may seek to have a document sealed by filing a motion to seal
- Protective orders may be entered to govern the exchange and submission of confidential information
- *Parties seeking a protective order may file a motion to seal accompanied by the default protective order*



Umbrella Rules: Discovery

- AIA authorizes the Office to set standards and procedures for the taking of discovery
- *Discovery rules allow parties to agree to discovery between themselves*
- Final rules provide for:
 - *mandatory initial disclosures;*
 - routine discovery; and
 - additional discovery



Umbrella Rules: Mandatory Initial Disclosures

- *Parties may agree to mandatory discovery requiring initial disclosures*
- *Otherwise, a party may seek such discovery by motion*
- *For example, parties may agree to disclose the name and contact information of each individual likely to have discoverable information along with the subjects of that information or information regarding secondary indicia of non-obviousness*



Umbrella Rules: Routine Discovery

- Routine discovery includes documents cited, cross-examination for submitted testimony, and information inconsistent with positions advanced during the proceeding
- *Proposed rule on inconsistent statements has been modified to limit both scope and number of individuals subject to the rule*



Umbrella Rules: Additional Discovery

- *Parties may agree to additional discovery between themselves or a party must request any discovery beyond routine discovery*
- Party seeking additional discovery:
 - in IPR: additional discovery is in the interests of justice
 - in PGR and CBM: subject to the lower good cause standard



Umbrella Rules: Supplemental Information

- *Request for the authorization to file a motion to submit supplemental information must be made within one month after institution*
- *Supplemental information must be relevant to a claim for which the trial has been instituted*
- *Motion to file supplemental information filed later than one month after institution must show why the supplemental information reasonably could not have been obtained earlier and that consideration of the information would be in the interests-of-justice*



Umbrella Rules: Sanctions for Abuse

- Order holding facts to have been established
- Order expunging a paper
- Order excluding evidence
- Order precluding a party from obtaining, opposing discovery
- Order providing for compensatory expenses, including attorney fees
- Judgment or dismissal of the petition



Umbrella Rules: Settlement

- Terminates the proceeding with respect to the petitioner
- Board may terminate the proceeding or issue a final written decision



Umbrella Rules: Final Decision and Request for Rehearing

- Board will issue a final written decision that addresses the patentability of any claim challenged and any new claim added
- *Request for rehearing must be filed within 14 days of the entry of a non-final decision or a decision to institute a trial or within 30 days of the entry of a final decision or a decision not to institute a trial*
- Party dissatisfied with the final written decision in an IPR/PGR/CBM may appeal to the Federal Circuit



Umbrella Rules: Petitioner Estoppel

- Petitioner may not request or maintain a proceeding before the **USPTO** with respect to any claim on any ground raised or reasonably could have been raised before the USPTO
- Petitioner may not assert in **district court or the ITC** that a claim is invalid on any ground petitioner raised, and in IPR/PGR, any ground that reasonably could have been raised in the trial before the USPTO



Umbrella Rules: Patent Owner Estoppel

- *Patent owner is precluded from taking action inconsistent with the adverse judgment including obtaining:*
 - *a claim that is patentably indistinct from a finally refused or canceled claim; or*
 - *an amendment of a specification or drawing that was denied during the trial, but this provision does not apply to an application or patent that has a different written description*
- *Proposed estoppel provision as to claims that could have been presented was not adopted in the final rule*





AMERICA INVENTS ACT

IMPLEMENTATION

Patent Review Processing System (PRPS) Filing System

Available at
www.uspto.gov/AmericaInventsAct

Appendix

- **General Administrative Trial Final Rules, 77 Fed. Reg. 48612 (August 14, 2012)**
- **Trial Practice Guide, 77 Fed. Reg. 48756 (August 14, 2012)**
- **Inter Partes, Post Grant, and Covered Business Method Review Final Rules, 77 Fed. Reg. 48680 (August 14, 2012)**
- **Covered Business Method and Technological Invention Definitions Final Rules, 77 Fed. Reg. 48734 (August 14, 2012)**





AMERICA INVENTS ACT

IMPLEMENTATION

Questions?



AMERICA INVENTS ACT

IMPLEMENTATION

Break



AMERICA INVENTS ACT

IMPLEMENTATION

Fee Setting: Proposed Rules

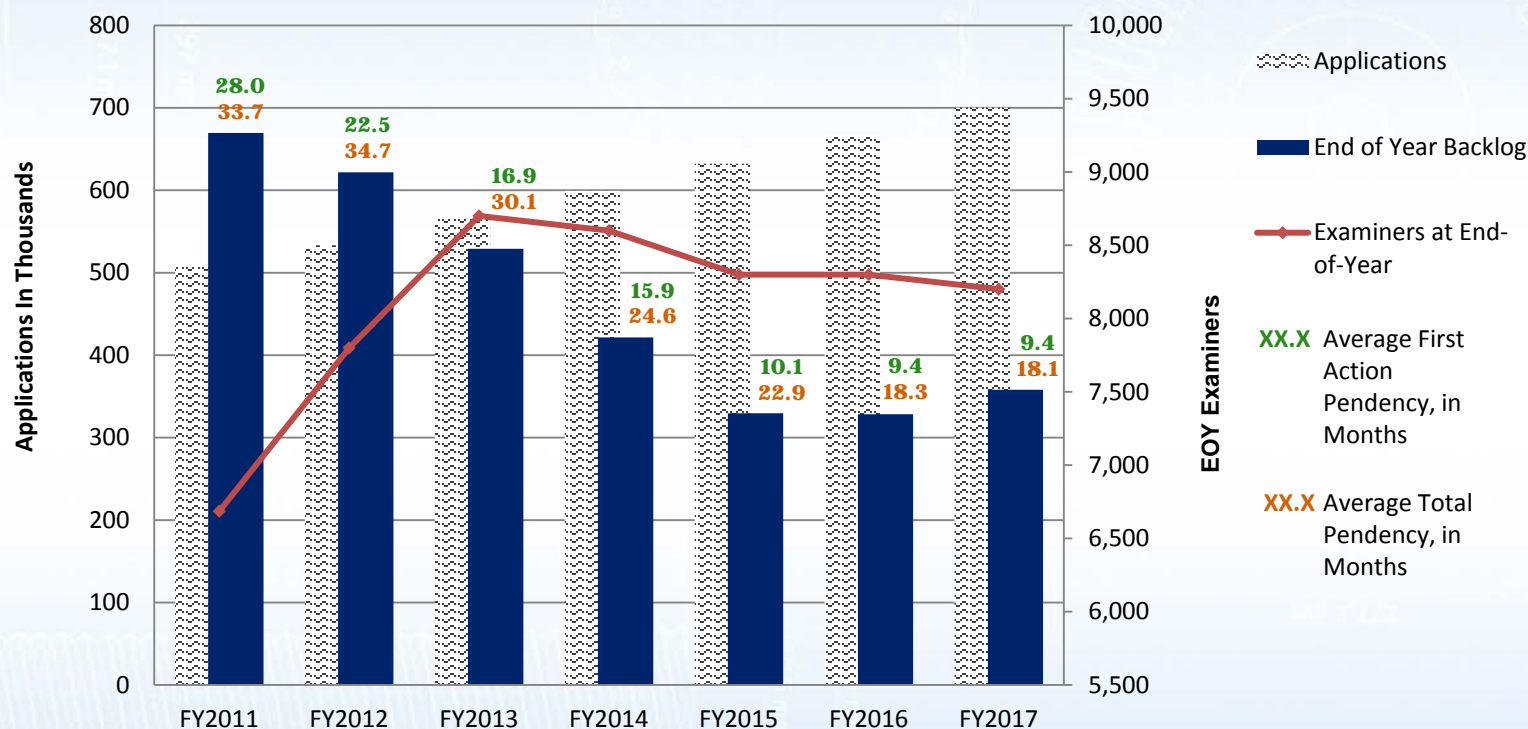
Fee Setting Goals and Strategies

- Ensure the patent fee schedule generates sufficient aggregate revenue to recover the aggregate cost to achieve two significant USPTO Goals:
 - Optimize patent timeliness and quality; and
 - Implement a sustainable funding model for operations
- Set individual fees to further key policy considerations:
 - Fostering innovation;
 - Facilitating the effective administration of the patent system; and
 - Offering patent prosecution options to applicants



Optimize Patent Timeliness and Quality

- Reduce total patent application pendency by more than 12 months
- Provide for an incremental increase in the average value of a patent of \$6.9 billion over a 5-year period (FY 2013 to FY 2017)



Optimize Patent Timeliness and Quality

- Improve patent quality through:
 - Comprehensive training for examiners;
 - Expanded and enhanced Ombudsman program;
 - Reengineering the examination process;
 - Guidelines for examiners to address clarity in patent applications; and
 - Encouraging and facilitating interviews



Implement a Sustainable Funding Model

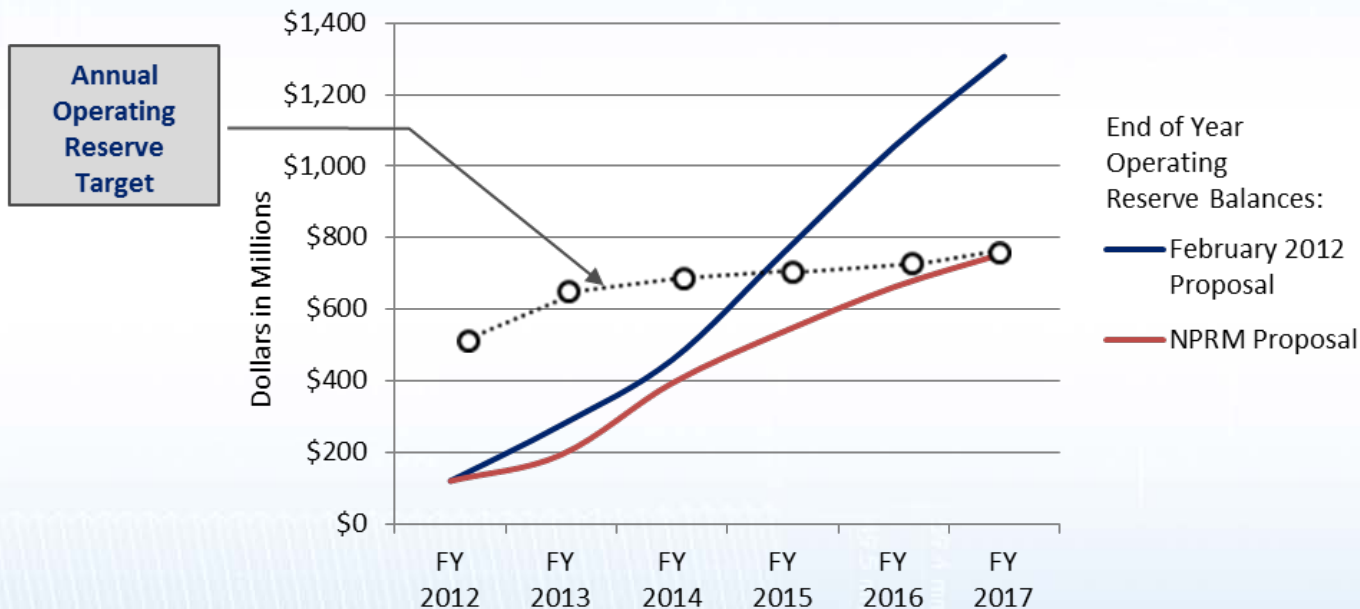
- Continue building an operating reserve of 3 months of operating expenses by 2017
- Facilitates the Office's long-term operational and financial planning
- Increases the USPTO's ability to absorb and respond to unanticipated shocks and temporary changes in its operating environment or circumstances



Operating Reserve Estimates

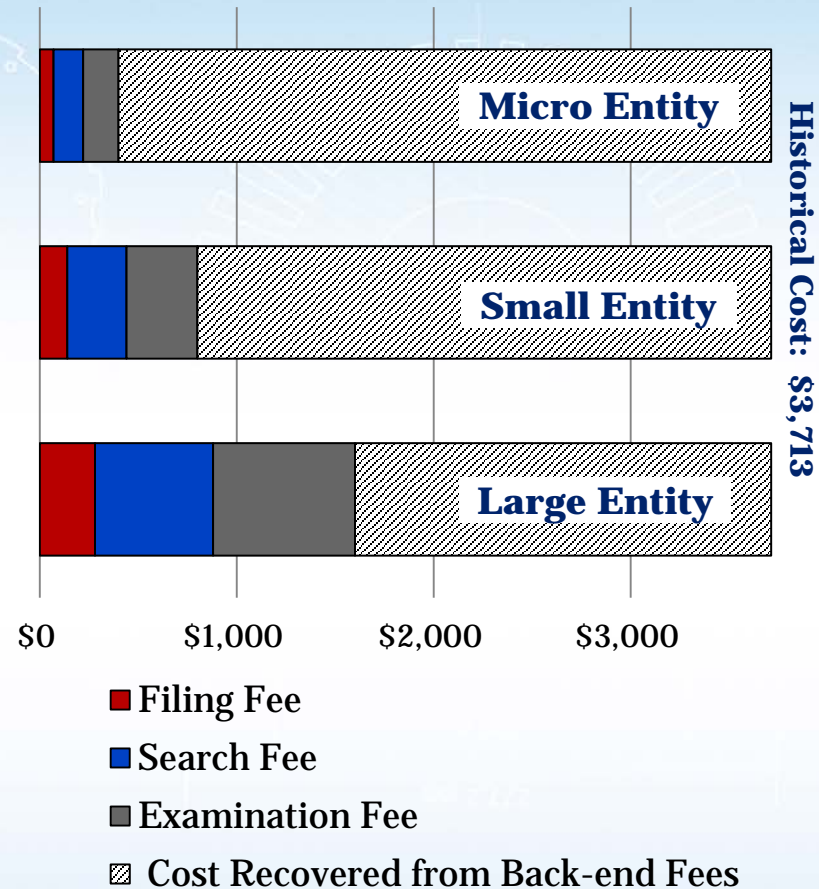
Description	FY 2013	FY 2014	FY 2015	FY 2016	FY 2017
3 Months Operating Expense	\$637 M	\$676 M	\$702 M	\$712 M	\$736 M
Estimated End of Year Balance	\$194 M	\$394 M	\$537 M	\$662 M	\$757 M
Annual Cost (Increase to Reserve)	\$73 M	\$200 M	\$143 M	\$125 M	\$95 M

Target Achieved



Policy Consideration: *Fostering Innovation*

- Basic “front-end” fees (e.g., filing, search, and examination) set below the actual cost of carrying out these activities
- Fee reductions for small (50%) and micro (75%) entity innovators
- Basic “back-end” fees (e.g., issue and maintenance) set above cost to recoup the revenue not collected by “front-end” and small and micro entity fees



Policy Consideration:

Facilitating the Effective Administration of the Patent System

- Encourage submission of applications or other actions that enable examiners to provide prompt and quality interim and final decisions;
- Encourage prompt conclusion of prosecution, which results in pendency reduction, faster dissemination of information, and certainty in patented inventions; and
- Help recover the additional costs imposed by the more intensive use of certain services by some applicants



Policy Consideration:

Offering Patent Prosecution Options to Applicants

- Prioritized examination offers applicants a choice for greater control over the timing of examination by choosing a “fast track” examination for an additional fee
- Multi-part and staged fees for requests for continued examination (RCE)
- Staged fees for *ex parte* appeals
- Multi-part fees for administrative trial proceedings



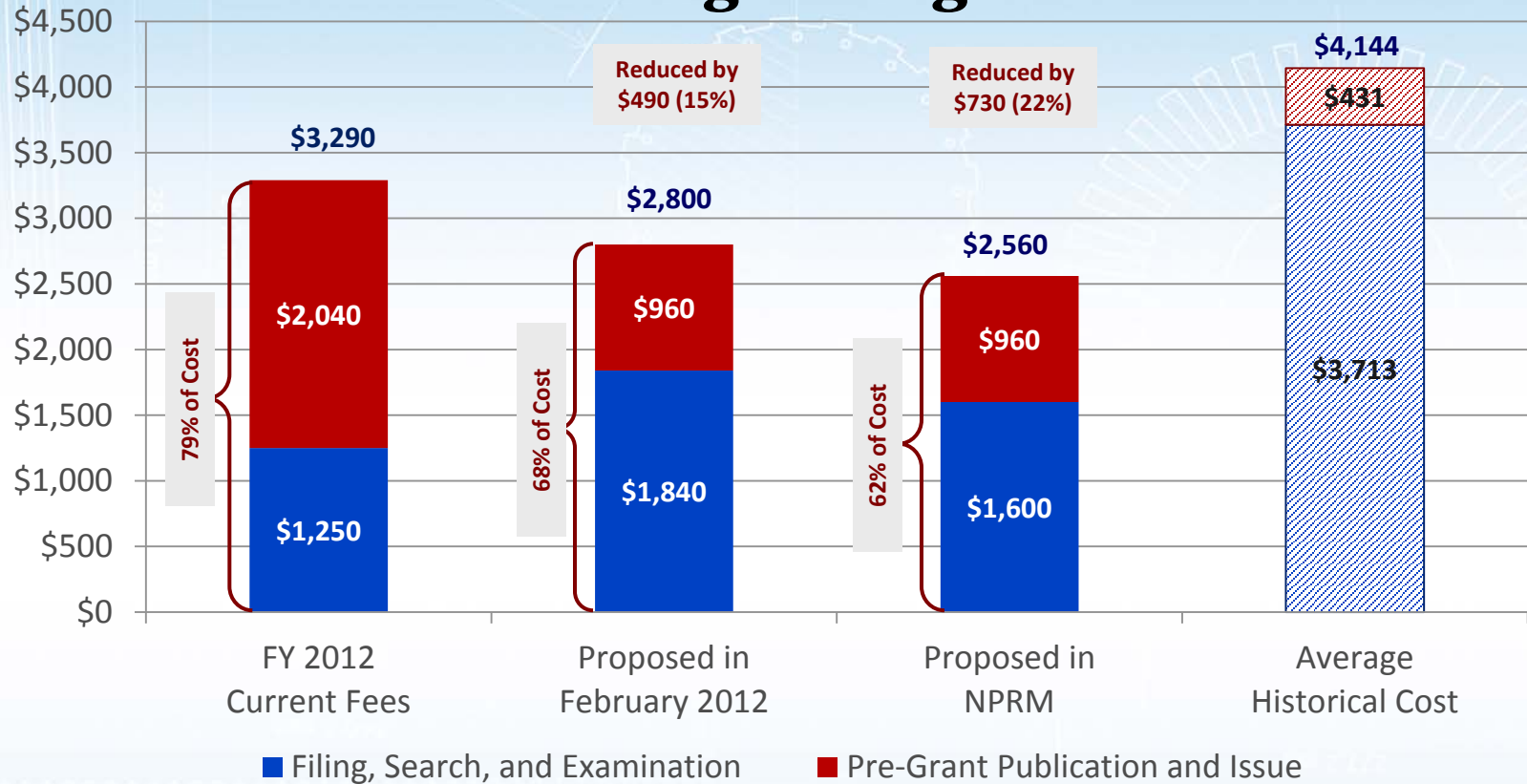
Benefits and Costs

- Office prepared a Regulatory Impact Analysis (RIA) to analyze benefits and costs of proposed fees as compared to current fees and 3 other alternatives over a 5-year period
- Proposed fee schedule has the largest **incremental net benefit of \$6.9 billion over the 5-year period**
 - **Incremental benefit** of an increase in private patent value of nearly **\$7.7 billion**
 - **Qualitative benefits** from fee schedule design and greater certainty of patent rights from patents acted upon sooner
 - **Incremental cost** of patent operations of about **\$0.7 billion**
 - **Incremental cost** of lost patent value of over **\$0.1 billion**



Proposed Fees v. Current Fees

From Filing through Issue

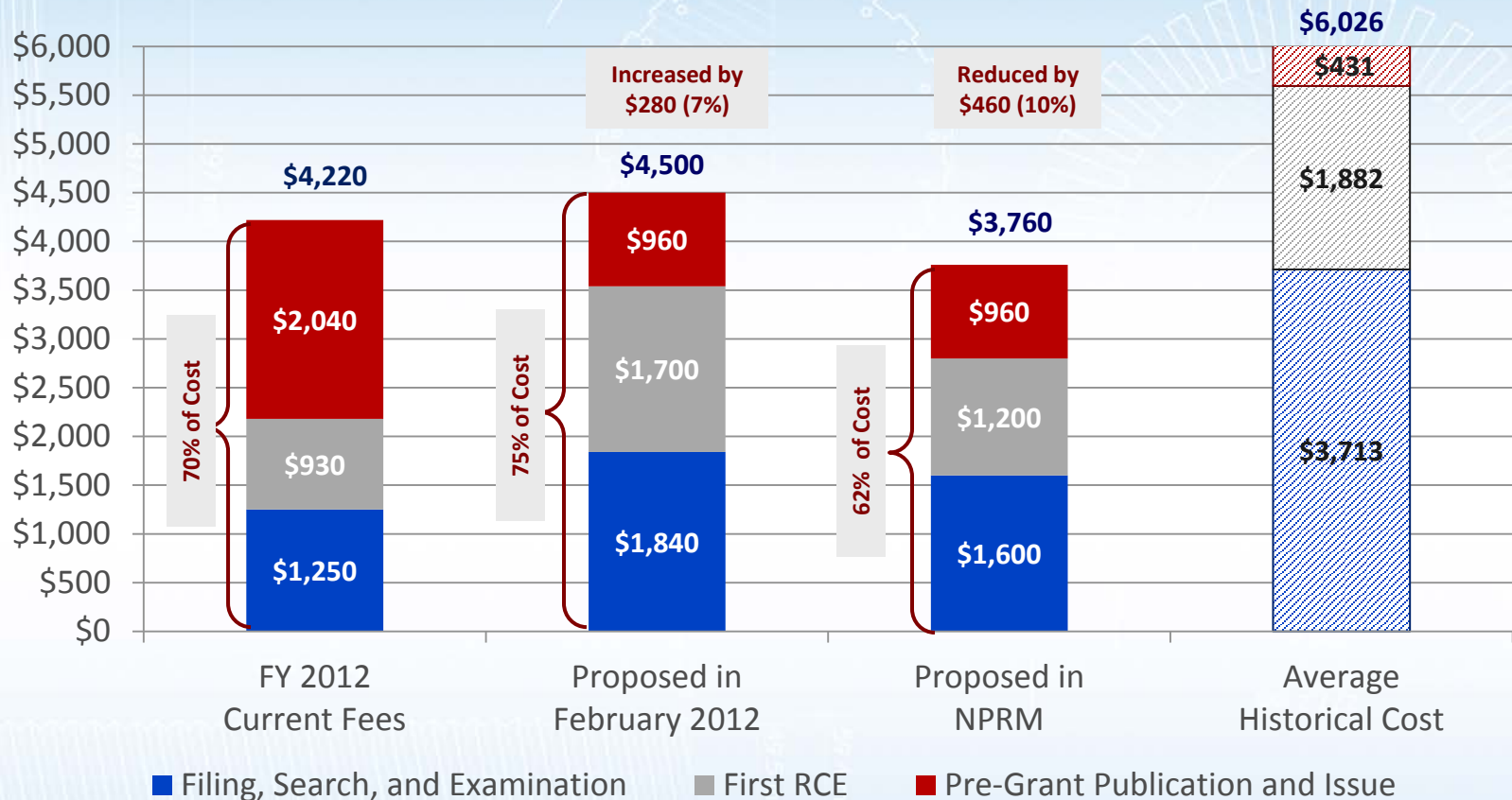


Note: In each scenario, from the Current to the NPRM fee structures, the fees paid could also increase by (a) \$170 for each independent claim in excess of 3; (b) \$20 for total claims in excess of 20; and (c) \$330 for each multiple dependent claim.



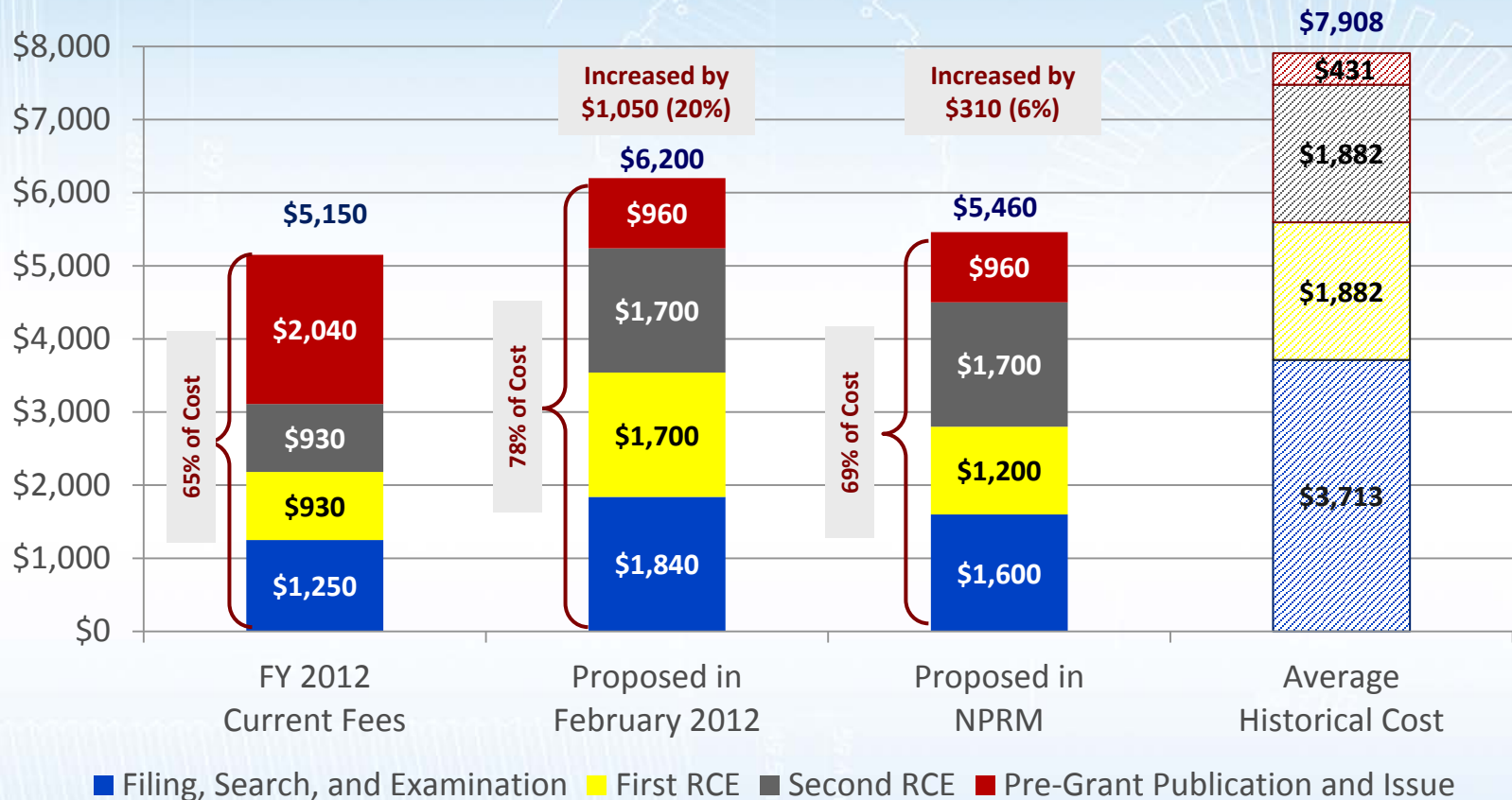
Proposed Fees v. Current Fees

From Filing through Issue with One RCE



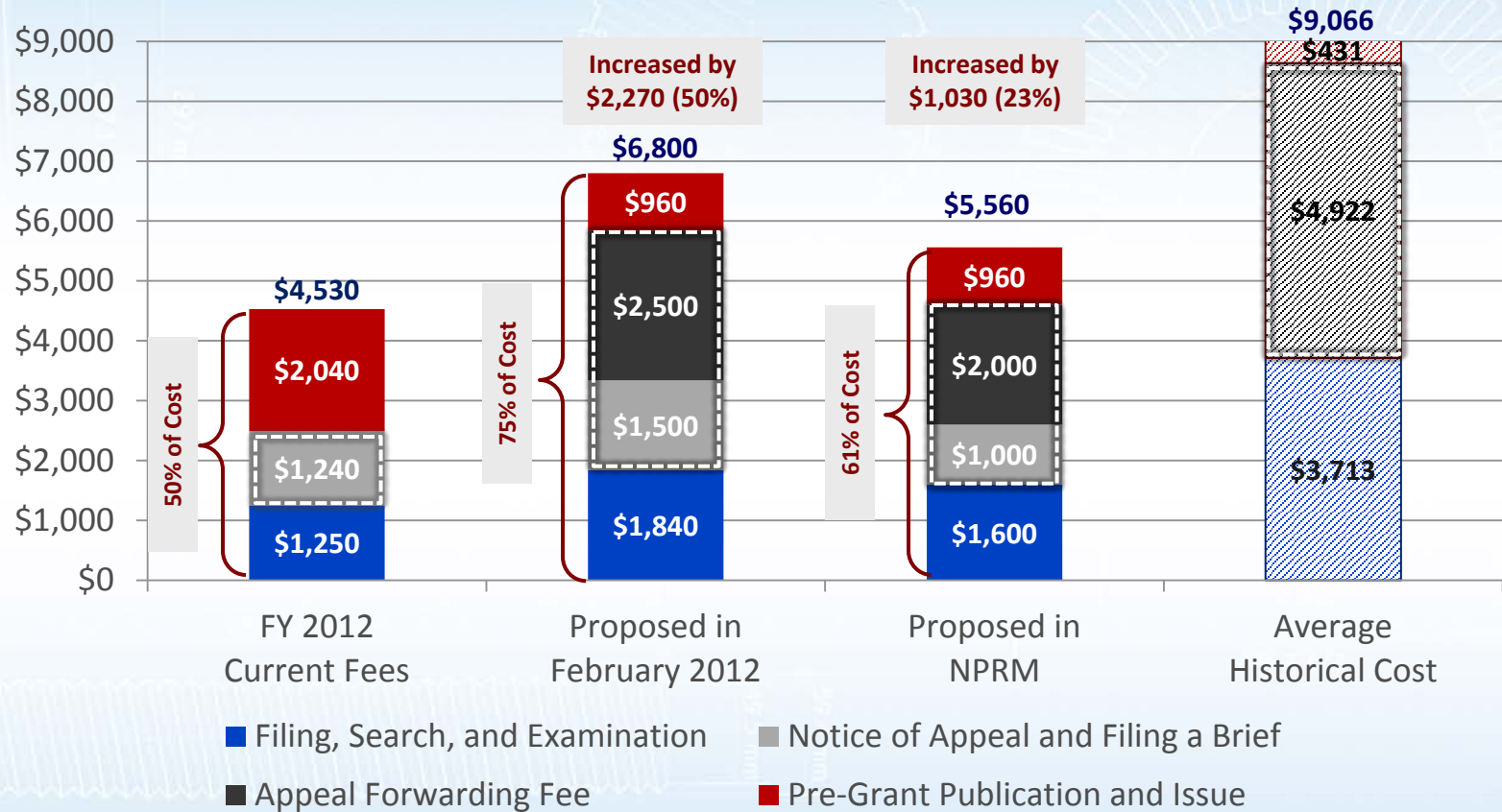
Proposed Fees v. Current Fees

From Filing through Issue with Two RCEs



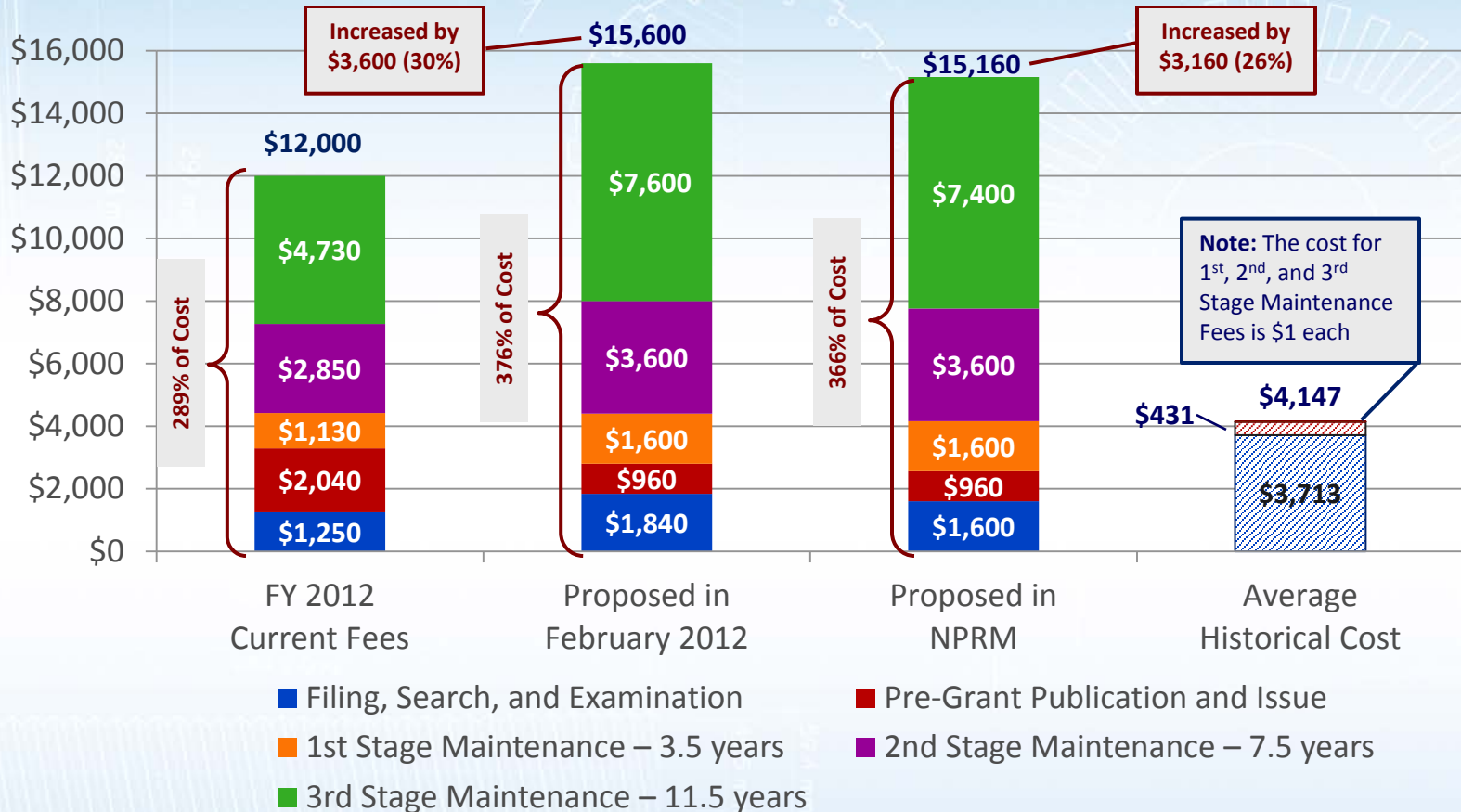
Proposed Fees v. Current Fees

From Filing through Issue with a Notice of Appeal and Appeal Forwarding Fee



Proposed Fees v. Current Fees

From Filing through 3rd Stage Maintenance



Appendix

- Patent Fees Proposed Rule (77 Fed. Reg. 55028, September 6, 2012)
- Comments due: November 5, 2012





AMERICA INVENTS ACT

IMPLEMENTATION

Questions?



AMERICA INVENTS ACT

IMPLEMENTATION

First Inventor to File: Proposed Rules and Proposed Examination Guidelines

First Inventor to File: Goals

- Provide guidance to examiners and the public on changes to examination practice in light of the AIA
- Address examination issues raised by the AIA
- Provide the Office with information to readily determine whether the application is subject to the AIA's changes to 35 U.S.C. 102 and 103



Date

- Effective Date: March 16, 2013
- Comments Due: October 5, 2012



Framework

Prior Art	Exceptions	Label
102(a)(1)	102(b)(1)(A)	Grace Period Inventor Disclosures & Grace Period Non-inventor Disclosures
	102(b)(1)(B)	Grace Period Intervening Disclosures
102(a)(2)	102(b)(2)(A)	Non-inventor Disclosures
	102(b)(2)(B)	Intervening Disclosures
	102(b)(2)(C)	Commonly Owned Disclosures



35 U.S.C. 102(a)(1): Prior Art

- Precludes a patent if a claimed invention was, before the effective filing date of the claimed invention:
 - Patented;
 - Described in a Printed Publication;
 - In Public Use;
 - On Sale; or
 - Otherwise Available to the Public
- Generally corresponds to the categories of prior art in pre-AIA 35 U.S.C. 102(a) and 35 U.S.C. 102(b)



Sales

- AIA does not state whether on sale activity must be public to constitute prior art
- USPTO seeking public comment on the extent to which public availability plays a role in “on sale” prior art



35 U.S.C. 102(b): Exceptions

- Provides that certain “disclosures” shall not be prior art
- Disclosure is understood to be a generic term intended to encompass the documents and activities enumerated in AIA 35 U.S.C. 102(a)



Grace Period Inventor and Non-inventor Disclosure Exception

- Grace period exceptions under 35 U.S.C. 102(b)(1) for prior art under 35 U.S.C. 102(a)(1)
- 35 U.S.C. 102(b)(1)(A):
 - A disclosure made one year or less before the effective filing date of the claimed invention shall not be prior art under 35 U.S.C. 102(a)(1) if:
 - The disclosure was made by:
 - the inventor or joint inventor; or
 - another who obtained the subject matter directly or indirectly from the inventor or joint inventor



Example 1: 102(b)(1)(A) Exception

Smith's Grace Period	
July 2013 to June 2014	July 2014
Smith publishes	Smith files

- Smith gets the patent because Smith's publication was by Smith within a year of filing
- Inventor Smith: "That is my disclosure"



Example 2: 102(b)(1)(A) Exception

Smith's Grace Period	
July 2013 to June 2014	July 2014
Taylor publishes Smith's subject matter	Smith files

- Smith gets the patent, if Smith shows the subject matter disclosed by Taylor was obtained from Smith
- Inventor Smith: “That disclosure originated from me”



Grace Period Intervening Disclosure Exception

- Grace period exceptions under 35 U.S.C. 102(b)(1) for prior art under 35 U.S.C. 102(a)(1)
- 35 U.S.C. 102(b)(1)(B):
 - A disclosure made one year or less before the effective filing date of the claimed invention shall not be prior art under 35 U.S.C. 102(a)(1) if:
 - The subject matter disclosed was, before such disclosure, publicly disclosed by:
 - the inventor or joint inventor; or
 - another who obtained the subject matter directly or indirectly from the inventor or joint inventor



Example 3: 102(b)(1)(B) Exception

Smith's Grace Period		
July 2013 to June 2014		July 2014
Smith publishes	Taylor publishes	Smith files

- Smith gets the patent if the subject matter of Taylor's publication is the same subject matter of Smith's publication.
- Inventor Smith: "I publicly disclosed the subject matter first"



35 U.S.C. 102(a)(2): Prior Art

- Precludes a patent to a different inventive entity if a claimed invention was described in a:
 - U.S. Patent;
 - U.S. Patent Application Publication; or
 - WIPO PCT Application Publicationthat was effectively filed before the effective filing date of the claimed invention
- Generally corresponds to the categories of prior art in pre-AIA 35 U.S.C. 102(e)



Effective Prior Art Date: Definition

- Effective prior art date of subject matter in patents and published applications under AIA 35 U.S.C. 102(a)(2) is:
 - actual filing date of the patent or published application, or
 - date to which the patent or published application is entitled to claim a right of priority or benefit under 35 U.S.C. 119, 120, 121, or 365 which describes the subject matter



Non-inventor Disclosure Exception

- Exceptions under 35 U.S.C. 102(b)(2) for prior art under 35 U.S.C. 102(a)(2)
- 35 U.S.C. 102(b)(2)(A):
 - A disclosure in an application or patent shall not be prior art under 35 U.S.C. 102(a)(2) if:
 - the disclosure was made by another who obtained the subject matter directly or indirectly from the inventor or joint inventor



Intervening Disclosures Exception

- Exceptions under 35 U.S.C. 102(b)(2) for prior art under 35 U.S.C. 102(a)(2)
- Exception 2 (35 U.S.C. 102(b)(2)(B)):
 - A disclosure in an application or patent shall not be prior art under 35 U.S.C. 102(a)(2) if:
 - the subject matter disclosed was, before such subject matter was effectively filed, publicly disclosed by:
 - the inventor or joint inventor; or
 - another who obtained the subject matter directly or indirectly from the inventor or joint inventor



Commonly Owned Disclosure Exception

- Exceptions under 35 U.S.C. 102(b)(2) for prior art under 35 U.S.C. 102(a)(2)
- 35 U.S.C. 102(b)(2)(C):
 - A disclosure made in an application or patent shall not be prior art under 35 U.S.C. 102(a)(2) if:
 - the subject matter and the claimed invention were commonly owned or subject to an obligation of assignment to the same person not later than the effective filing date of the claimed invention



Joint Research Agreements

- Treatment of joint research agreements under Exception 3
- “Common ownership” exception under 35 U.S.C. 102(b)(2)(C) for 35 U.S.C. 102(a)(2) prior art is applicable if:
 - claimed invention was made by/on behalf of at least one party to a joint research agreement in effect on/before the effective filing date of the claimed invention;
 - claimed invention was made as a result of activities within the scope of the joint research agreement; and
 - application discloses the parties to the joint research agreement



Applicability of AIA's Prior Art Provisions

- AIA's FITF provisions apply to any application or patent that contains, or contained at any time, a claimed invention having an effective filing date that is on or after March 16, 2013; or
- AIA's FITF provisions apply to any application or patent that contains, or contained at any time, a specific reference under 35 U.S.C. 120, 121, or 365(c) to an application which contains, or contained at any time, a claimed invention having an effective filing date on or after March 16, 2013



Applicability of Pre-AIA's Prior Art Provisions

- Pre-AIA 35 U.S.C. 102(g), 135, and 291 apply to any AIA application or patent that contains, or contained at any time, any claimed invention having an effective filing date that occurs before March 16, 2013



Example 4: AIA's Prior Art Provisions Apply

	Parent application filed before 3/16/2013	Child application filed after 3/16/2013 claiming benefit to Parent
Specification includes	A, B, and C	A, B, C, and D
Claims require	Not relevant	Claim 1: A-C Claim 2: A- D

- Child application is subject to AIA prior art provisions because Claim 2 requires D, which is only supported in an application filed after 3/16/2013
- Child application is also subject to pre-AIA prior art provisions (i.e., former 35 U.S.C. 102(g), 135 and, if patented, 291) because Claim 1 has an effective filing date before 3/16/2013



Proposed Rule: Affidavits or Declarations

- Proposed 37 C.F.R. 1.130: Applicants may submit affidavits or declarations showing that:
 - disclosure upon which a rejection is based was by the inventor or joint inventor, or by another who obtained the subject matter disclosed directly or indirectly from the inventor or joint inventor; or
 - there was a prior public disclosure of the subject matter by the inventor or joint inventor, or by another who obtained the subject matter disclosed directly or indirectly from the inventor or joint inventor



Proposed Rule: Certified Copy Requirement

- Proposed rule 1.55(a)(2): Certified copy of any foreign priority application must be filed within the later of:
 - 4 months from the actual filing date; or
 - 16 months from the filing date of the prior foreign application
- Certified copy is needed prior to publication since U.S. patents and U.S. patent application publications have a prior art effect under the AIA's 35 U.S.C. 102(a)(2) as of their earliest effective filing date including foreign priority



Proposed Rule: Required Statements

- Proposed rules 1.55(a)(4), 1.78(a)(3), and 1.78(c)(2): For nonprovisional applications that are:
 - Filed on or after March 16, 2013; and
 - Claim priority/benefit of a foreign, provisional, or nonprovisional application filed prior to March 16, 2013:
 - Applicant must indicate if the application:
 - contains, or contained at any time, a claim having an effective filing date on or after March 16, 2013; or
 - discloses subject matter not also disclosed in the prior foreign, provisional, or nonprovisional application



Proposed Rule: Required Statements (cont.)

- Applicant is not required to:
 - identify how many or which claims have an effective filing date on or after March 16, 2013;
 - identify the subject matter not disclosed in the prior application; or
 - make the second statement if the application does not disclose subject matter not also disclosed in a relied upon application filed prior to March 16, 2013



Proposed Rule: Required Statements Timing

- Proposed rules 1.55(a)(4), 1.78(a)(3), and 1.78(c)(2): Statements must be filed within the later of:
 - 4 months from the actual filing date of the later-filed application;
 - 4 months from the date of entry into the national stage;
 - 16 months from the filing date of the prior-filed application from which benefit or priority is sought; or
 - the date that a first claim having an effective filing date on or after March 16, 2013, is presented in the later-filed application



Appendix

- **Changes to Implement the First Inventor to File Provisions of the Leahy-Smith America Invents Act, 77 Fed. Reg. 43742 (July 26, 2012)**
- **Examination Guidelines for Implementing the First-Inventor-to-File Provisions of the Leahy-Smith America Invents Act , 77 Fed. Reg. 43759 (July 26, 2012)**





AMERICA INVENTS ACT

IMPLEMENTATION

Questions?



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Closing Remarks



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Thank You