

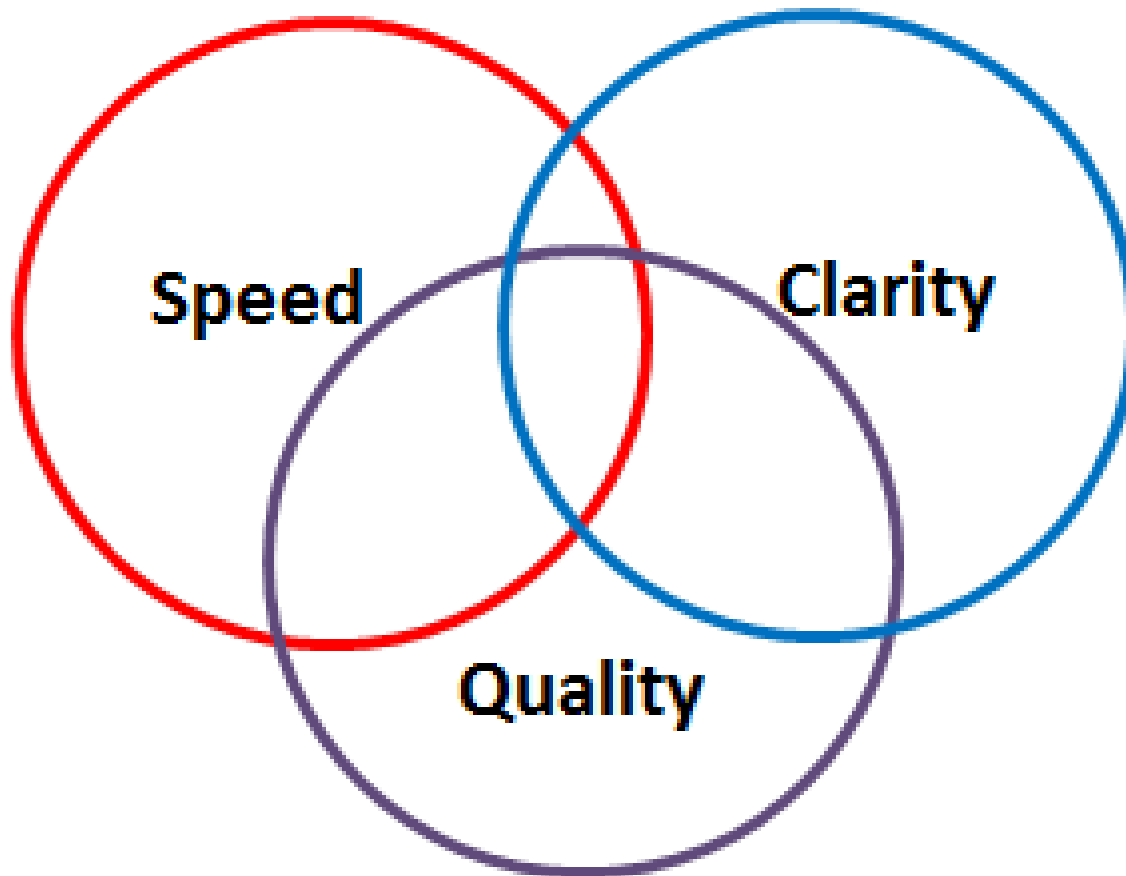
# USPTO Implementation of the America Invents Act



**Janet Gongola**  
**Patent Reform Coordinator**  
**Janet.Gongola@uspto.gov**  
**Direct dial: 571-272-8734**



# Three Pillars of the AIA





# Speed

- Prioritized examination (a.k.a., track 1)
- Priority examination for important technologies
- Fee setting authority
- 15% surcharge



# Prioritized Exam (a.k.a. Track 1) (Effective September 26, 2011)

- Original utility or plant patent application accorded special status 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



# Prioritized Exam (cont.)

- 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 exam is terminated without a refund of prioritized exam fee if patent applicant:
  - petitions for an extension of time to file a reply or to suspend action; or
  - amends the application to exceed the claim restrictions



# Prioritized Exam (cont.)

- USPTO may not accept more than 10,000 requests for prioritized exam per fiscal year, absent regulations to prescribe for conditions for acceptance and limitation on the number of filings

<b>Fiscal Year</b>	<b>Pending</b>	<b>Granted</b>	<b>Dismissed</b>	<b>Total (as of 10/28/11)</b>
FY2011	608	239	0	847
FY2012	317	--	--	317



# Fee Setting Authority

(Effective September 16, 2011)

- Sunsets 7 years after enactment
- 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





# Quality

- Citation of prior art in a patent application
- Supplemental examination
- Inter partes review
- Post grant review
- Transitional program for covered business method patents





# Citation of Prior Art in a Patent Application (Effective September 16, 2012)

- 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 associated fees; and
  - must include a statement by the third party making the submission affirming that the submission is being made in compliance with new 35 U.S.C. 122(e)



# Citation of Prior Art in Patent Application (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



# Supplemental Exam (Effective September 16, 2012)

- Patent owner may request supplemental examination of a patent to “consider, reconsider, or correct information” believed to be relevant to the patent
- “Information” that forms the basis of the request is not limited to patents and printed publications
- USPTO must decide whether the information in the request raises a “substantial new question of patentability” within 3 months from the request
- If yes, then the Director must order an ex parte reexamination



# 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



# Supplemental Exam (cont.)

- Inequitable conduct inoculation
  - 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
  - But does not apply to information raised in a civil action brought before supplemental exam sought



# Contest Case Proceedings

## (Effective September 16, 2012)

Proceeding	Petitioner	Available	Standard	Basis	Applicable	Estoppel	Timing
<b>Post Grant Review (PGR)</b>	Must identify real party in interest	Patent grant to 9 months from patent grant	More likely than not  OR  Novel or unsettled legal question important to other patents/applications	101, 102, 103, 112, double patenting but not best mode	Patent issued under first-inventor-to-file	Raised or reasonably could have raised  Applied to subsequent USPTO/district court/ITC action	Must complete within 12 months from institution, with 6 months good cause exception possible
<b>Inter Partes Review (IPR)</b>	Must identify real party in interest	10 months from patent grant for life of patent or termination of a PGR; Director may limit number during first 4 years	Reasonable likelihood	102 and 103	Any patent pending on September 16, 2012	Raised or reasonable could have raised  Applied to subsequent USPTO/district court/ITC action	Must complete within 12 months from institution, with 6 months good cause exception possible





# Contested Cases: Petition Phase

- Initiated by third party petition
- Patentee file preliminary response to petition
- USPTO must decide petition within 3 months from the patentee's response, if any





# Contested Cases: Review Phase

- Patentee may file response with evidence
- Patentee has 1 motion to amend claims
- Petitioner may file written comments and supplemental information at least 1 time



# Contested Cases: Review Phase (cont.)

- Discovery available to both parties
  - IPR: USPTO to set standards for discovery of relevant evidence limited to:
    - Depositions of witnesses submitting affidavits or declarations; and
    - Otherwise necessary in the interest of justice
  - PGR: evidence directly related to factual assertions advanced by either party



# Contested Cases: Review Phase (cont.)

- Protective orders possible
- Oral hearing as a right
- Director may join petitioners and consolidate
- May be settled



# Contested Cases: Relationship to Parallel Litigation

- If petitioner files a declaratory judgment action:
  - Before PGR/IPR, then no PGR/IPR
  - After PGR/IPR, then automatic stay of litigation
- If patentee sues for patent infringement within 3 months of patent grant, then court may not stay a preliminary injunction motion in view of the PGR
- If petitioner seeks an IPR more than 1 year after being sued for patent infringement, then no IPR



# Transitional Program for Covered Business Methods (Effective September 16, 2012)

- Sunsets in 8 years
- Follows paradigm for PGR
- Applies to any covered business method patent pending on September 16, 2012:
  - Not drawn to technological invention; and
  - Asserted in pending litigation



# Clarity

- Human organism prohibition
- Inventor's oath/declaration
- First-inventor-to-file



# Human Organism Prohibition (Effective September 16, 2011)

- Patent may not issue on a claim directed to or encompassing a human organism itself
- But does not preclude patent drawn to methods of treating a human organism
- USPTO policy already captures a human organism prohibition. See *Animals – Patentability*, 1077 Off. Gaz. Pat. Off., 24 (Apr. 21, 1987)





# Inventor's Oath/Declaration

(Effective September 16, 2012)

- Permits patent application to be filed by assignee
- Patent granted on application filed by assignee must be to the real party in interest
- Individual under an obligation of assignment may include required statements in executed assignment and need not file a separate oath/declaration
- Applicant's citizenship no longer required
- Deceptive intent eliminated from 35 U.S.C. §§ 116, 251, 253, and 256



# First-inventor-to-file (Effective March 16, 2013)

- Transitions the U.S. to a first-inventor-to-file patent system while maintaining a 1-year grace period for inventor disclosures
- Prior public use or prior sale anywhere qualifies as prior art (prior public use and sale is no longer limited to the U.S.)
- U.S. patents and patent application publications are effective as prior art as of their priority date (no longer limited to U.S. priority date), provided that the subject matter relied upon is disclosed in the priority application
- Applies to:
  - Claim with an effective filing date on or after March 16, 2013; and
  - Claim for benefit to an application that ever had a claim with an effective filing date on or after March 16, 2013



# Progress Report: Rulemakings

- 20 total provisions related to USPTO operations to implement
- 8 provisions implemented to date
- 10 Notices of Proposed Rulemaking (NPRMs) to issue in mid- to late January 2012
  - Drafting on track
  - Internal clearance begins on November 15, 2012



# NPRMs for January 2012 Release

	<b>Subject</b>	<b>Section of AIA</b>
1	Inventor's oath / declaration	4
2	Third party submission of prior art for a patent application	8
3	Supplemental examination	12
4	Third party citation of prior art in a patent file	6
5	Umbrella set of rules for contested case procedure	N/A
6	Inter partes review	6
7	Post grant review	6
8	Transitional program for covered business methods	18
9	Definition of technological invention	18
10	Derivation proceeding	3



# Progress Report: Studies

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

<b>Study</b>	<b>Federal Register Notice</b>	<b>Hearings</b>	<b>Witnesses</b>	<b>Written Comments Due</b>	<b>Report</b>
International Patent Protection	October 7, 2011	2	12	November 8, 2011	January 14, 2012
Prior User Rights	October 7, 2011	1	5	November 8, 2011	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 mid-January seeking public comments and announcing hearing dates
- Report due by June 16, 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/1275-01938>  
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 Micro-site (cont.)

[aia\\_implementation@uspto.gov](mailto: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 email (preferred) or postal mail to the following addresses:

Please click on the respective Rulemaking to provide comments:

Group 1 Rulemakings
<a href="#">Inter partes reexamination threshold</a>
<a href="#">Tax strategies are deemed within the prior art</a>
<a href="#">Best mode</a>
<a href="#">Human organism prohibition</a>
<a href="#">OED Statute of Limitations</a>
<a href="#">Fee Setting Authority</a>
<a href="#">Micro-entity</a>
<a href="#">Prioritized examination</a>
<a href="#">15% transition surcharge</a>
<a href="#">Electronic filing incentive</a>
Group 2 Rulemakings
<a href="#">Inventor's oath/declaration</a>
<a href="#">Third party submission of prior art for patent application</a>
<a href="#">Supplemental examination</a>
<a href="#">Citation of prior art in a patent file</a>
<a href="#">Priority examination for important technologies</a>
<a href="#">Inter partes review</a>
<a href="#">Post grant review</a>
<a href="#">Transitional program for covered business method patents</a>
Group 3 Rulemakings
<a href="#">First-Inventor-to-File</a>
<a href="#">Derivation proceedings</a>
<a href="#">Repeal of Statutory Invention Registration</a>

Postal Mail: U.S. Patent and Trademark Office  
Mail Stop Comments—Patents  
Commissioner of Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450



# Public Comment Windows

Timing	Type	Significance	Due Date
Now	Informal	Build proposed rules; will not be addressed with written responses in NPRMS	November 15, 2011
Post-NPRM	Formal	Build final rules; will be addressed with written responses in FRs	60 day window from NPRM publication
Post-final rules	Formal	Modify final rules	Undecided

# Thank You



**Janet Gongola**  
**Patent Reform Coordinator**  
**Janet.Gongola@uspto.gov**  
**Direct dial: 571-272-8734**