

At a Glance: USPTO Implementation of the America Invents Act

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Characteristics of the AIA

Give certainty to patent rights sooner

Reduce the cost of patent prosecution

Build a 21st century patent system



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

Aspect of Law	First-to-invent	First-inventor-to-file
1 year grace period		YES
Public use or sale as prior art	Geographic limitation to United States only	No geographic limitation—may occur anywhere in the world
Patents and patent application publications as prior art	As of effective filing date: -actual filing date; or -filing date of the earliest U.S. application for which a right of priority is sought	As of effective filing date: -actual filing date; or -filing date of the earliest application for which a right of priority is sought, regardless if filed in U.S. or a foreign country

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Prioritized Examination (Effective September 26, 2011)

- Original utility, plant, continuation patent application or request for continued examination may be eligible 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
- 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

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Prioritized Exam Statistics: Part I (Data as of 5/31/12)

Total Requests	Pending	Granted	Dismissed	Total
FY 2012	684	2200	87	2971
FY 2011	14	827	14	855
TOTAL	698	3027	101	3826

Pendency to First Action on the Merits	Pendency to Final Dispositions
1.43 mos.	4.2 mos.

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Prioritized Exam Statistics: Part II (Data as of 5/31/12)

Technology Center	Number of Prioritized Applications
1600: Biotechnology and Organic Chemistry	388
1700: Chemical and Materials Engineering	150
2100: Computer Architecture, Software, and Information Security	290
2400: Computer Networks, Multiplex Communication, Video Distribution, and Security	482
2600: Communications	386
2800: Semiconductors, Electrical and Optical Systems and Components	258
3600: Transportation, Construction, Electronic Commerce, Agriculture, National Security, and License and Review	489
3700: Mechanical Engineering, Manufacturing, Products	464
Undesignated	64
TOTAL	2605

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Supplemental Exam: Availability (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

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Supplemental Exam: Inequitable Conduct Immunization

- Purpose is to immunize the patent against an allegation of inequitable conduct for the information considered, reconsidered, or corrected during supplemental examination
- But immunity does not apply
 - To allegations pled in a civil action or notice to the patentee before the date of the request for supplemental examination, and
 - Unless the supplemental examination and any resulting *ex parte* reexamination is completed before the civil action is brought

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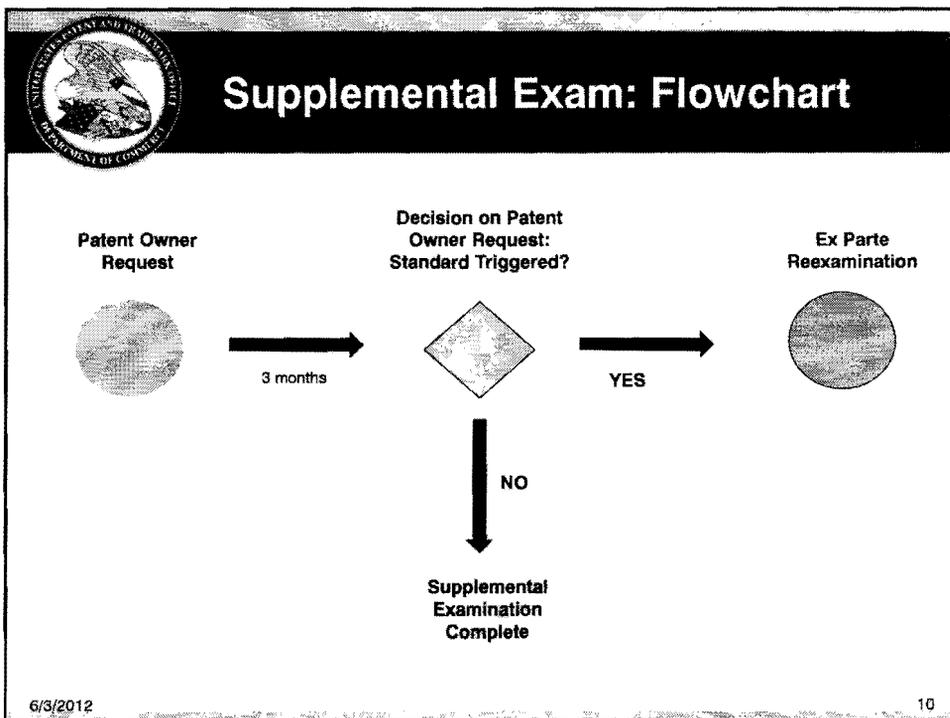
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Supplemental Exam: Process

- USPTO must decide whether the information in the request raises a “substantial new question of patentability” within 3 months from the request
- Supplemental examination concludes with a supplemental reexamination certificate indicating whether any item of information raised an SNQ
- If an SNQ is raised by one or more items of information, then *ex parte* reexamination will be ordered

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Supplemental Exam: Material Fraud

- If the Office becomes aware of a material fraud on the Office in connection with the patent under supplemental examination, then USPTO:
 - must confidentially refer the matter to the U.S. Attorney General; and
 - may take other action as set forth in 35 U.S.C. 257(e), e.g., cancellation of any claims found to be invalid as a result of a reexamination

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Supplemental Examination: Proposed Rules

- Request limited to 10 items of information
- But more than one request for supplemental examination of the same patent may be filed at any time

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Supplemental Examination: Proposed Rules

- Request must include:
 - Identification of the patent and each aspect of the patent for which supplemental examination is sought; and
 - Identification of each item of information that raises an issue with respect to that aspect of the patent

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Supplemental Examination: Proposed Rules

- No amendment to any aspect of the patent may be filed in the supplemental examination
- No interview during supplemental examination
- But if *ex parte* reexamination is ordered, an amendment may be filed and interview occur after the issuance of the initial Office action
- Supplemental examination certificate will be in electronic form

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Supplemental Exam: Proposed Fees

Service	Cost
Filing fee (for processing and treating a request for supplemental examination)	\$ 5180
Reexamination fee (ordered as a result of supplemental examination)	\$16,120
Document size fees for processing and treating a non-patent document over 20 sheets in length	
TOTAL	\$21,300+
Refund if the Office decides not to order an ex parte reexamination proceeding	\$16,120

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Third Party Submissions

- 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;
 - must include a statement by the third party making the submission affirming that the submission is compliant with statutory requirements; and
 - must meet timing requirements

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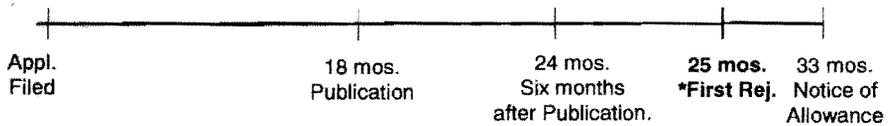
Preissuance Submission

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

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Preissuance Submission



App. Filed 18 mos. Publication 24 mos. Six months after Publication. 25 mos. *First Rej. 33 mos. Notice of Allowance

*** Preissuance submission must be filed before this date**

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- Submission is filed as of its date of receipt by the Office; cannot use certificate of mailing or transmission
- Third party:
 - can be anonymous; and
 - not required to serve submission on applicant
- No duty on applicant to reply to submission, absent a request by Office

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- Examiner will consider submissions in the same manner as information in an IDS
- Third party is not permitted to respond to an examiner's treatment of a submission

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Patent Filing Fees

Service	Cost
First submission of 3 or fewer documents with "first and only" statement	\$0
Submission of 10 documents or fraction thereof	\$180

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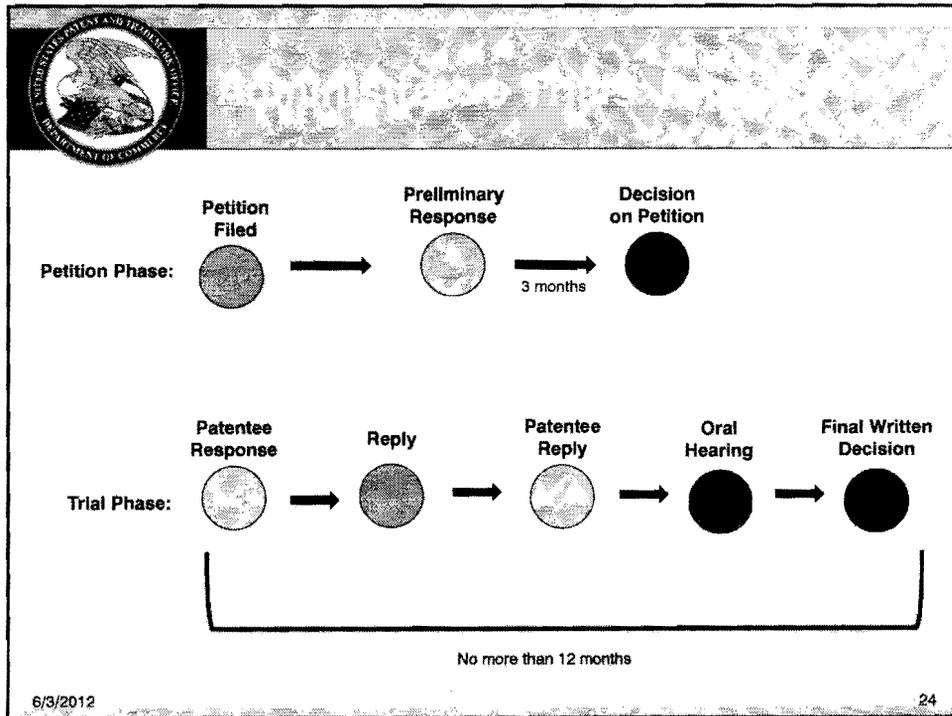
Appeals/Examination Proceedings

Proceeding	Petitioner	Available	Standard	Basis
Post Grant Review (PGR)	Person who is not the patent owner and has not previously had a civil action challenging the validity of a claim of the patent.	From patent grant to 9 months from patent grant or reissue	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
Inter Partes Review (IPR)	Must identify real party in interest	From the later of: (i) 9 months after patent grant or reissue; or (ii) the date of termination of any post grant review of the patent	Reasonable likelihood	102 and 103 based on patents and printed publications

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Proceeding	Applicable	Estoppel	Timing
Post Grant Review (PGR)	Patent issued under first-inventor-to-file	<ul style="list-style-type: none"> • Relief of reasonable cause have taken • Applied to subsequent USPTO/district court/FC action 	Must be completed within 12 months from institution, with 6 months good cause exception possible
Inter Partes Review (IPR)	Patent issued under first-to-invent or first-inventor-to-file		

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- Pro hac vice admission for non-registered practitioners
- Board to issue scheduling order to govern timing during trial phase
- Page limits apply to briefing:
 - 50 pages for IPR petitions
 - 70 pages for PGR petitions
 - Claim charts included in page count



- Patent owner preliminary response (before trial institution) limited to documentary evidence
- Patent owner response (after trial institution) may include both documentary and testimonial evidence



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- 1 motion to amend the claims as of right with subsequent motions permitted in Board's discretion
- Options for claim amendments:
 - Cancel challenged claims; or
 - Propose a reasonable number of substitute claims
- Broadest reasonable interpretation standard applies to claim construction

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- Petitioner may file supplemental evidence within 1 month after institution

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- Discovery divided into (i) routine; and (ii) discretionary
 - Routine discovery for:
 - Cited documents;
 - Cross-examination for submitted testimony; and
 - Information inconsistent with positions advanced during the proceeding
 - Discretionary discovery by request upon a showing of:
 - IPR: Interests of justice
 - PGR: Good cause



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- Patent owner is precluded from taking any action inconsistent with an adverse judgment, including seeking a claim directed to substantially the same invention



Inter Partes Review	Cost
Up to 20 claims	\$ 27,200
21 to 30 claims	\$34,000
31 to 40	\$40,800
41 to 50	\$54,400
51 to 60	\$68,000
Each additional group of 10 claims	\$27,200

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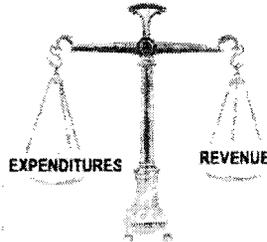


Post Grant Review	Cost
Up to 20 claims	\$ 35,800
21 to 30 claims	\$44,750
31 to 40	\$53,700
41 to 50	\$71,600
51 to 60	\$89,500
Each additional group of 10 claims	\$35,800

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 **Fee Setting Authority**
(Effective September 16, 2012)

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

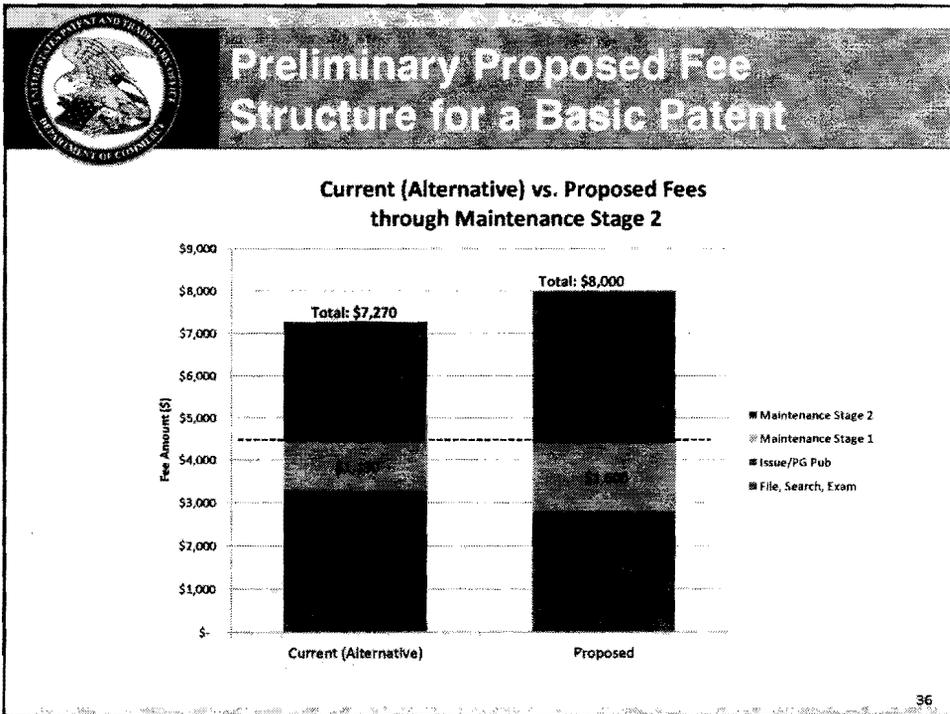
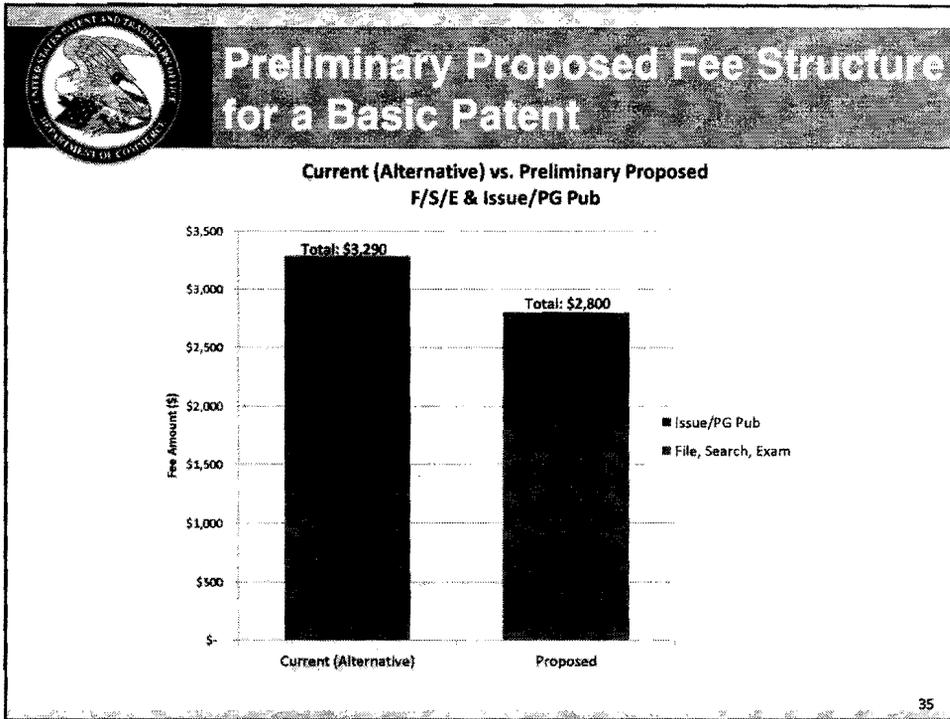


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 **USPTO Fee Setting Principles**

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

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Micro-entity (Effective September 16, 2012)

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

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Micro-entity: General Definition

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

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Micro-entity: Alternate Definition

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

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Micro-entity Notice of Proposed Rulemaking

- Changes to Implement Micro Entity Status for Paying Patent Fees, 77 Fed. Reg. 104 (May 20, 2012)
- Addresses:
 - Procedures to claim micro-entity status;
 - Paying fees as a micro-entity;
 - Notification of loss of micro-entity status; and
 - Correction of payments erroneously paid in the micro-entity amounts
- Public comments due by July 30, 2012

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June 16, 2012
Genetic Testing Study Report
Due

June-July 2012
First-inventor-to-file
NPRM and
Guidance to publish

June-July 2012
Patent Ombudsman Program
Commences

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July 2012
Fee Setting NPRM to publish

By August 16, 2012
Patent
Related and
Board Final
Rules Publish

July 13, 2012
Detroit Satellite Office to Open

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