

America Invents Act Patent Rulemaking Patent Roundtable – Greenville, SC



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Provisions of Law: Implementation Complete

- Change in inter partes reexamination standard
- Tax strategies deemed within the prior art
- Best mode
- Human organism prohibition
- Prioritized examination
- 15% surcharge
- Electronic filing incentive



Prioritized Examination (Effective September 26, 2011)

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



Prioritized Exam Statistics: Part I (Data as of 3/15/12)

Total Requests	Pending	Granted	Dismissed	Total
FY 2012	619	2925	129	3673
FY 2011	13	827	15	855

Examination Status	First Action on the Merits Mailed	Final Dispositions Mailed	Number of Allowances of Total Final Dispositions
Number of applications	2717	1235	637



Best Mode

(Effective September 16, 2011)

- Failure to disclose the best mode shall not be a basis on which any claim of a **patent** may be cancelled or held invalid or otherwise unenforceable, 35 U.S.C. 282:
 - Inventors must continue to meet the best mode requirement as a pending **application** can be rejected under 35 U.S.C. 112(a), which continues to contain the requirement.



Provisions of Law: Implementation in Progress

(Effective September 16, 2012)

- Inventor's oath / declaration
- Preissuance submission of prior art
- Supplemental examination
- Citation of a patent owner statement in a patent file
- Inter partes review
- Post grant review
- Transitional program for covered business methods
- Derivation (effective March 16, 2013)



First-Inventor-to-File v. First-to-Invent

(Effective March 16, 2013)

Aspect of Law	First-to-invent	First-inventor-to-file
1 year grace period	YES, but with differences	
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 to another	As of effective filing date: -actual filing date; or -filing date of the earliest U.S. application for which a benefit claim is sought	As of effective filing date: -actual filing date; or -filing date of the earliest application for which a benefit claim or right of priority is sought, regardless if filed in U.S. or a foreign country



First-Inventor-to-File: Prior Art

- Broadens prior art:
 - Prior public use or prior sale anywhere qualifies as prior art
 - U.S. patents and patent application publications are effective as prior art as of their “effective filing date,” provided that the subject matter relied upon is disclosed in the priority application
 - Effective filing date = (i) actual filing date; or (ii) filing date of the earliest application for which a right of priority is sought



First-Inventor-to-File: Grace Period

- Reliance on U.S. grace period after public disclosure to file a U.S. application may cause loss of foreign patent rights in absolute novelty countries:
 - notwithstanding the foreign application's reliance on the U.S. application
- Grace period for first-inventor-to-file not the same, *e.g.*:
 - a publication date by another independent inventor even one day prior to the filing date of a first inventor's application can no longer be overcome by a showing of earlier invention



Inventor's Oath/Declaration: Public Comments

- Public comments sought a more robust approach to implementing the AIA to include greater flexibility in:
 - the required submission time for an oath or declaration;
 - permitting an individual oath or declaration to only identify the inventor executing the document; and
 - decreasing the required information



Inventor's Oath/Declaration: Requirements

- Inventor's oath/declaration must include statements that:
 - affiant/declarant believes himself to be the **original** inventor
 - application was made or authorized to be made by the affiant/declarant; and
- Inventor's oath/declaration no longer has to include statements that:
 - affiant/declarant believes himself to be the **first** inventor;
 - citizenship of the inventor.
- Assignments may include the statements required in an oath or declaration.



Inventor's Oath/Declaration: Substitute Statement

- Substitute statement permitted in lieu of a inventor's oath/declaration where an inventor is:
 - Deceased;
 - Legally incapacitated;
 - Unable to be found or reached after diligent effort; or
 - Refuses to sign
- Substitute statement can be made by:
 - Legal representative;
 - Assignee;
 - Party to whom the inventor is under an obligation to assign;
or
 - Party who otherwise shows sufficient proprietary interest



Preissuance Submissions

(Effective 9/16/12 – 77 FR 42150 (7/17/12) (Final))

- Allows third parties to submit printed publications of potential relevance in the application of another if certain conditions are met, *e.g.*:
 - submitted in writing;
 - contains a concise description of the asserted relevance of each submitted document;
 - the fee is paid (if necessary);
 - includes a statement by the person making the submission affirming that the submission is compliant with statutory and regulatory requirements; and
 - meets the timing requirements.



Preissuance Submissions

- Third party:
 - Can be anonymous; and
 - Not required to serve submission on applicant.
- Can be filed by EFS-Web with this caveat:
 - Must select the preissuance submission filing option.



Preissuance Submissions: Fee

- \$180 for every ten items or fraction thereof:
 - 3 and under are free if first submission, but:
 - Need statement that it is a “first and only” submission.



Preissuance Submissions: Concise Description

- Format that would best explain information:
 - *E.g.*, narrative or claim chart (mapping various portions of a document's information to different claim elements).

Caveat: Not a protest, therefore, do not, *e.g.*,:

- Propose rejections; or
- Provide arguments relating to an Office action or an applicant reply.

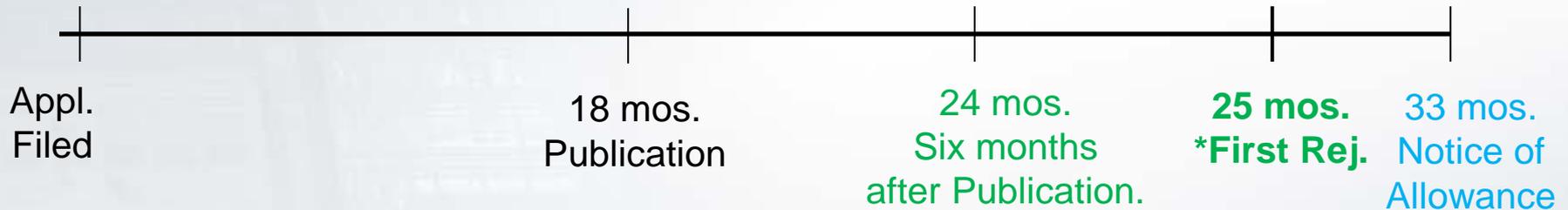


Preissuance Submissions: Timing

- 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 by the USPTO; or
 - date of the first rejection of any claim in the application



Preissuance Submissions: Timing Example



* Preissuance submission must be filed before this date



Preissuance Submissions: Notifications

- Applicants: Can be notified to entry of a compliant submission:
 - If applicant participates in the Office's e-Office Action program.
- Third party submitters: Can be notified to a noncompliant submission:
 - If an electronic mail message (e-mail) address is provided.



Supplemental Examination (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.
- Purpose is to immunize the patent against claims of unenforceability based on an allegation of inequitable conduct relating to the information submitted.
- “Information” that forms the basis of the request is not limited to patents and printed publications.



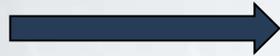
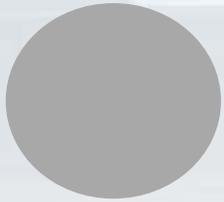
Supplemental Examination: Inequitable Conduct Immunization

- 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.



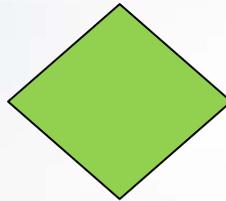
Supplemental Examination: Flowchart

Patent Owner
Request



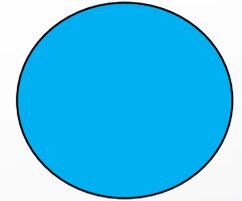
3 months

Decision on Patent
Owner Request:
Standard Triggered?



YES

Ex Parte
Reexamination



NO

Supplemental
Examination
Complete



Supplemental Examination: Process

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



Supplemental Examination: 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



Submission of Patent Owner Statements

- Expands scope of information that may be submitted into the file of an issued patent:
 - Statements of the patent owner on scope of any claim of a particular patent.
- Requirements:
 - Statement must have been filed in a proceeding before a Federal court or USPTO proceeding.
 - Must include any other documents, pleadings, and evidence (additional information) that address the statement.



Submission of Patent Owner Statements

- Must include an explanation of how the statement and any additional information are pertinent to the patented claim(s).
- A patent owner submitting a statement may provide an explanation as to how the claims are patentable over the statement and any additional information.
- The statement and any additional information cannot be used to order reexamination, but can be used once reexamination is ordered.

Thank You

