

The America Invents Act At a Glance



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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: 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



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



Preissuance Submissions

(Effective September 16, 2012)

- Allows third parties to submit printed publications of potential relevance to examination if certain conditions are met, *e.g.*:
 - must be made in writing;
 - must provide a concise description of the asserted relevance of the submitted document;
 - must include a statement by the person making the submission affirming that the submission is compliant with statutory and regulatory requirements; and
 - third party:
 - can be anonymous; and
 - not required to serve submission on applicant



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



Preissuance Submissions: Timing Example



* Preissuance submission must be filed before this date



Inventor's Oath/Declaration

(Effective September 16, 2012)

- A new declaration form will be required due to changes in the required statutory language, *e.g.*:
 - the application was made or authorized to be made; and
 - the penalty clause for a willful false statement must refer to imprisonment of not more than 5 years



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



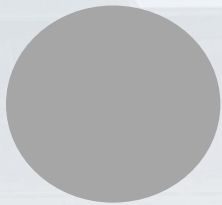
Supplemental Exam (Effective September 16, 2012)

- Patent owner may request supplemental examination of a patent to “consider, reconsider, or correct information” believed to be relevant to the patent
- 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



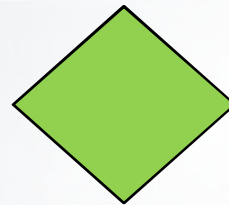
Supplemental Exam: Flowchart

Patent Owner
Request Entitled to
Filing Date



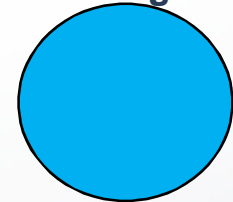
3 months

Decision on Patent
Owner Request:
Standard Triggered?



YES

Ex Parte
Reexamination
Proceeding Initiated



NO



Supplemental
Examination
Proceeding
Concluded



Supplemental Examination: Proposed Rules

- Request limited to 10 items of information
- USPTO must decide whether the information raised a “substantial new question of patentability” within three months from the request
- But more than one request for supplemental examination of the same patent may be filed at any time

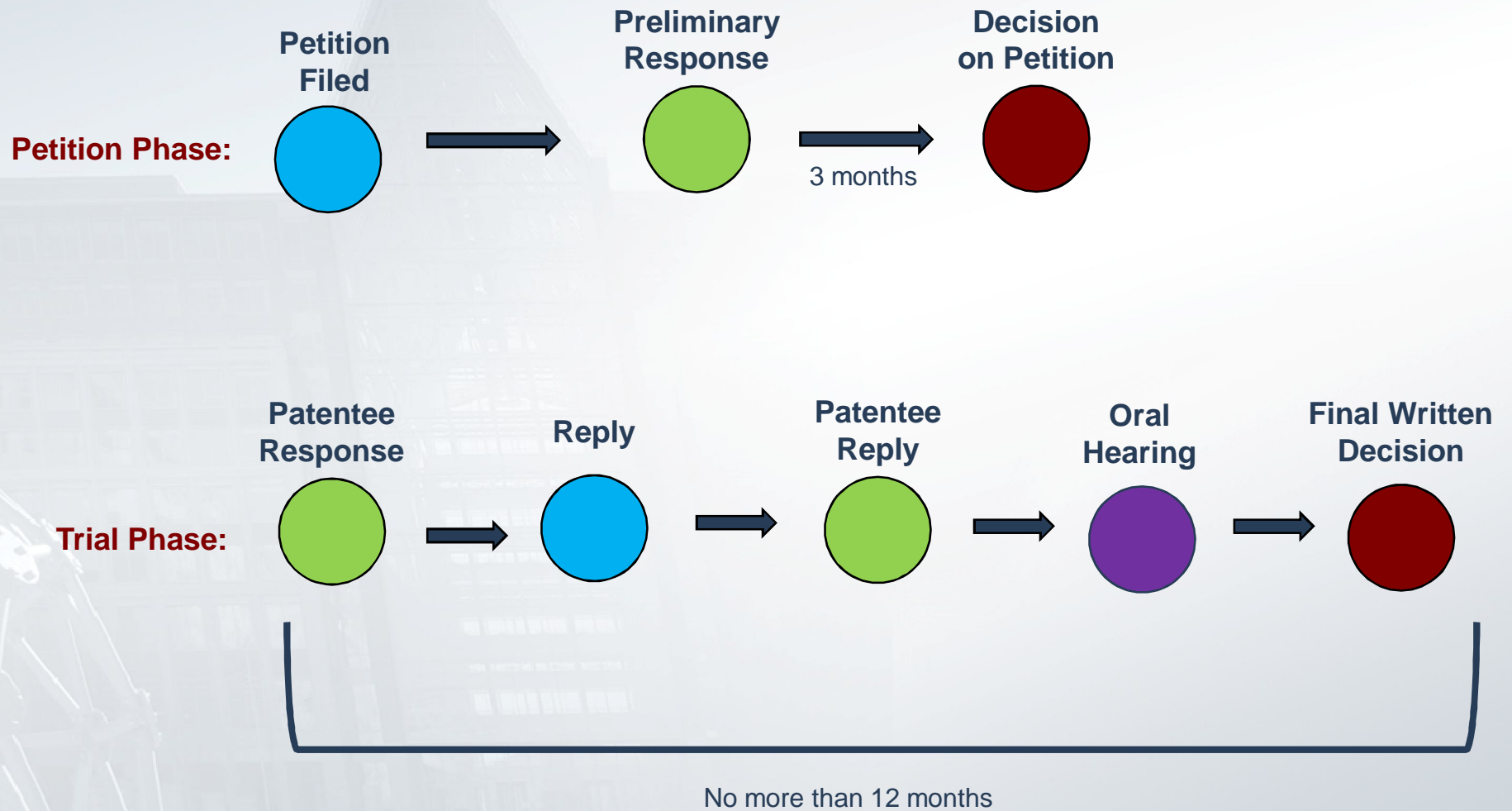


Administrative Trials: Features (Effective September 16, 2012)

Proceeding	Petitioner	Available	Standard	Basis	Timing
Post Grant Review (PGR)	<ul style="list-style-type: none"> Person who is not the patent owner and has not previously filed 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	Must be completed within 12 months from institution, with 6 months good cause exception possible
Inter Partes Review (IPR)	<ul style="list-style-type: none"> 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	



Administrative Trials: Process





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





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



Fall Roadshows on Final Rules



Date	Location
Monday, Sept 10	Minneapolis, MN
Wednesday, Sept 12	Alexandria, VA
Friday, Sept 14	Los Angeles, CA
Monday, Sept 17	Denver, CO
Thursday, Sept 20	Detroit, MI
Monday, Sept 24	Atlanta, GA
Wednesday, Sept 26	Houston, TX
Friday, Sept 28	New York, NY

Thank You



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