The 411 on Patenting It Yourself
NCET2 Webinar

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Director of Inventor Education,
Outreach, and Recognition
July 31, 2013
Total Serialized and RCE Filings
FY 2002 – FY 2013 (through June 4)

FY 2013 Target based on FY 14 President’s Budget model (5% Projected Growth over FY 2012). Serialized filings in FY 2013 are projected to grow 7.2% over FY 2012. RCE filings are projected to have negative growth of -0.8%, compared to FY 2012.

FY 2012 Results: 5.2% total UPR growth rate over FY 2011. Serialized filings grew 6% over FY 2011. RCE filings grew 3.3% over FY 2011.
Unexamined Patent Application Backlog
FY 2009 – FY 2013 (through June 18th)

Applications Awaiting First Action

586,025 Unexamined Applications as of June 18, 2013.

End of Fiscal Year 2012 backlog was 608,283.
Average Total Pendency FY 2012 Target: 34.7 months. Actual result: 32.4 months.
Average First Action Pendency FY 2012 Target: 22.5 months. Actual result: 21.9 months.
FY 2013 Targets:
- Average First Action Pendency: 17.3 months.
- Average Total Pendency: 29.6 Months.
12-Month Rolling Average Allowance Rate as of June 1, 2013: 52.4%
12-Month Rolling Average UPR Examiner Attrition Rate Less Transfers and Retirees and Overall Attrition Rate FY 2001 – FY2013 (through May)

Attrition Rate Less Transfers and Retirees: 3.60% as of May FY 13.
Overall Attrition Rate: 4.41% as of May FY 13.
Patent Staffing

- 9,582 total Patents Employees (as of 6/1/13)
- 7,861 UPRD Patent Examiners on Board (as of 6/18/13)
- 3,762 Patent Employees Hoteling full time (as of 6/7/13)
Best Places to Work in the Federal Government®

The Best Places to Work IN THE FEDERAL GOVERNMENT®
Patent Examination Overview
Technology Centers

- 1600 Biotechnology and Organic Chemistry
- 1700 Chemical Engineering/Inorganic Chemistry
- 2100 Electrical, Data Processing, Computers
- 2600 Electrical, Communications
- 2800 Semiconductors, Circuits, Optics
- 2900 Designs
- 3600 Mechanical: Construction, Transportation
- 3700 Mechanical: Games, Guns, and Tools
Role of the Patent Examiner

• To safeguard the public interest with respect to intellectual property
• To provide direct service and assistance to customers of the office (e.g., applicants and their attorneys or agents, public searchers)
• To assist inventors in obtaining patents on new and useful inventions in a timely manner, thereby serving the public through the disclosure of new technologies.
Duties of the Patent Examiner

- Locate the most relevant prior art
- Determine the patentability of the claimed invention under the conditions for patentability defined by Title 35 of the United States Code
- Determine if the application meets other formal requirements established by the Office
- Clearly communicate the results of the examination to the applicant
Patentability Determinations Made by Examiners

- Utility (35 USC 101): The claimed invention must be useful.
- Novelty (35 USC 102): The claimed invention must not have been done before.
- Non-obviousness (35 USC 103): The claimed invention must not only be different from the prior art, the differences between the claimed invention and the prior art can’t be obvious.
- Enablement/written description (35 USC 112(a)): The specification must adequately describe the invention.
- Definiteness (35 USC 112(b)): The claims must be clear.
- Double patenting (judicially created doctrine): Only one patent per different invention, unless a TD is filed.
The Goal – U.S. Patent Grant
Patent Initiatives for Applicants
Micro Entity Discount

- Entitled to a 75% discount on fees for “filing, searching, examining, issuing, appealing, and maintaining” patent applications/patents
- 2 ways to be eligible:
  - Limited income and limited number of patent filings; or
  - Employment or assignment to institution of higher education
- Must certify micro entity eligibility before paying a fee in the micro entity amount
- 1,485 UPR applications have claimed micro entity status as of May 24, 2013
Interview Time
FY 2008 – FY 2013 (through May)

115,498 hours in FY 2013, compared with 104,818 hours in FY 2012, over the same period.
First Action Interview Pilot

FAIP First Action allowance rate = 30.2%

First Action allowance rate in new, non-continuing applications = 11.0%

March 2013
Application Requirements:

- Must be a non-reissue, non-provisional utility application under 35 USC 111(a) or national stage application under 35 USC 371

- Must contain three or fewer independent claims and twenty or fewer total claims

- Must not contain any multiple dependent claims

- Must claim only a single invention

- Must not have a first Office action on the merits as of the date Applicant requests participation in program
Prioritized Examination (Track One)

• Available for utility, plant, and continuing patent applications and requests for continued examination
  – Not available for international, design, reissue, or provisional applications or in reexamination proceedings
• Requirements:
  – no more than 4 independent claims, 30 total claims, and no multiple dependent claims; and
  – electronically file (utility application); and
  – pay fee

<table>
<thead>
<tr>
<th>Fee Prior to March 19, 2013</th>
<th>Current Fees</th>
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<tr>
<td>$ 4,800/$2,400</td>
<td>$ 4,000/$2,000/$1,000</td>
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</table>
Prioritized Examination (Track One) Total Pendency vs. Traditional Total Pendency

- Prosecution Time with Office
- Time Awaiting First Action
- Prosecution Time with Applicant

Track One Terminal Disposals FY 2012:
- 1.3
- 2.9
- 2.9

Terminal Disposals FY 2012:
- 2.6
- 23.8
- 6.7
### Prioritized Examination (Track One) Statistics (through May 16, 2013)

<table>
<thead>
<tr>
<th>Petitions Filed</th>
<th>% of Decided Petitions Granted</th>
<th>Average Days from Petition Grant to first Office action</th>
<th>Average Days from Petition Grant to Final Disposition</th>
</tr>
</thead>
<tbody>
<tr>
<td>10,085</td>
<td>94%</td>
<td>59</td>
<td>176</td>
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</table>

<table>
<thead>
<tr>
<th>First Action Completed</th>
<th>Final Dispositions</th>
<th>Allowances</th>
<th>Percent of Petitions From Small Entities</th>
<th>Number of Micro Entity Applications</th>
</tr>
</thead>
<tbody>
<tr>
<td>7,004</td>
<td>4,749</td>
<td>2,354</td>
<td>45%</td>
<td>18</td>
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# Track One Statistics

(through June 5, 2013)

**Petitions Received**

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<tr>
<th></th>
<th>October</th>
<th>November</th>
<th>December</th>
<th>January</th>
<th>February</th>
<th>March</th>
<th>April</th>
<th>May</th>
<th>June</th>
<th>July</th>
<th>August</th>
<th>September</th>
<th>Total</th>
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<tr>
<td>FY 11</td>
<td>390</td>
<td>302</td>
<td>285</td>
<td>292</td>
<td>371</td>
<td>442</td>
<td>457</td>
<td>516</td>
<td>436</td>
<td>470</td>
<td>517</td>
<td>559</td>
<td>855</td>
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<td>FY 12</td>
<td>505</td>
<td>512</td>
<td>576</td>
<td>504</td>
<td>469</td>
<td>1,031</td>
<td>400</td>
<td>503</td>
<td>47</td>
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<td>FY 13</td>
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<td></td>
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<td>5,037</td>
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**Percent of Petitions From Small Entities**

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<tr>
<td>46%</td>
<td>36</td>
<td>48.7</td>
<td>94%</td>
<td>594</td>
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**First Actions Completed**

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<tr>
<th>First Actions Completed</th>
<th>Average Days from Petition Grant to Final Rejection</th>
<th>Final Rejections</th>
<th>Number of Issues</th>
<th>Number of Abandonments</th>
<th>Number of Allowances</th>
<th>Average Days from Petition Grant to Allowance</th>
<th>Average Days from Petition Grant to Final Disposition</th>
</tr>
</thead>
<tbody>
<tr>
<td>7,344</td>
<td>60.3</td>
<td>2,518</td>
<td>2,129</td>
<td>99</td>
<td>2,472</td>
<td>145</td>
<td>178</td>
</tr>
</tbody>
</table>

**Oldest Track One Application Still in Prosecution (days from petition grant)**

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<thead>
<tr>
<th>Oldest Track One Application Still in Prosecution (days from petition grant)</th>
<th>Oldest Track One Application Without a First Action (days)</th>
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<tbody>
<tr>
<td>580</td>
<td>226</td>
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Prioritized Examination (Track One) Filings by Workgroup

Track One Filings by Workgroup

- **1620: Organic Chemistry**
- **2170: Graphical User Interface**
- **2440: Computer Networks**
- **2650: Videophones & Telephonic Communications**
- **2830: Circuits/Measuring**
- **3620: Data Processing: Financial Business Practice**
- **3730: Medical Instruments, Diagnostic Equipment**

**Applications**

- 1770: Separation, Purification, Petroleum & Processing
• What is PPH?
  • When claims are determined to be allowable in the Office of First Filing or earlier examination, a corresponding application with corresponding claims filed in another PPH office is fast-tracked for examination.

• What is the purpose of PPH?
  • Second office can leverage the search and examination results of the first thereby avoiding duplication of work and expediting the examination process.
Patent Prosecution Highway (PPH)

- Benefits of PPH
  - Provides a useful tool to expedite prosecutions of claims toward patentability
  - Decreases costs of prosecution
  - Provides quicker patentability determinations
  - May be particularly attractive to rapidly evolving industries
Patent Prosecution Highway (PPH)

- Current U.S. PPH Programs
  - Australia  Japan
  - Austria   Korea
  - Canada    Mexico
  - China     Columbia
  - Norway    Czech Republic
  - Denmark   Nordic Patent Inst.
  - Russia    EPO
  - Finland   Singapore
  - Germany   Spain
  - Hungary   Sweden
  - Iceland   Taiwan
  - Israel    United Kingdom
Ombudsman

- Enhances the USPTO's ability to assist applicants or their representatives with issues that arise during patent application prosecution.

Contact an Ombudsman by:
http://www.uspto.gov/patents/ombudsman.jsp
AIA requires a Patent Ombudsman Program to provide patent filing support and services to small business and independent inventors.

- Resource for applicants that facilitates complaint-handling when applications have stalled in the examination process.

- Tracks complaints to ensure each is handled expeditiously.
Patent Ombudsman Program

- 1579 inquiries received in FY 2012

- Inquiries related to:
  - After Final
  - Customer Service
  - Petitions
  - Certificates of Correction
  - Application Prosecution Concerns
Ombudsman

Inquiries by Type

2013 to Date

- Pro se: 908
- Attorney/Agent: 735
- Others: 532

Program Total

- Pro se: 1458
- Attorney/Agent: 1873
- Others: 1071
Useful Tools
Welcome to the Intellectual Property Awareness Assessment Tool. The IP Assessment includes the following five general categories, that are included in all assessments:

- IP Strategies & Best Practices
- International IP Rights
- IP Asset Tracking
- Licensing Technology to Others
- Using Technology of Others

There are five additional categories that can be taken or which may be customized through a pre-assessment. These five categories include:

- Copyrights
- Design Patents
- Trademarks
- Trade Secrets
- Utility Patents

Not all businesses have all categories of IP Assets, so they have an opportunity to opt out of certain categories by using the customer or pre-assessment or may opt to take the full assessment of ten categories containing 62 questions.

The full assessment requires about 20-30 minutes to complete. The customer or pre-assessment can reduce the required time by 15-15 minutes.

enter the IP Awareness Assessment

Before starting the assessment, please note:

- Save this link for this page as a favorite/bookmark on your browser.
- In the Internet history or your browser, delete cache history or exit. This will allow you to return and resume your assessment session in case you cannot finish it in one sitting. This will also allow you to access your training materials and assessment results at your convenience.
- As you are answering the assessment questions, choose the answer that best applies to your business or circumstances as an independent inventor or individual. Where applicable, choose all the responses that apply to your situations.
- Responses or data collected in the assessment are not stored or used by the USPTO or NIST.
Useful Tools
Pro Bono Program

- Minnesota, Colorado, California, Washington DC, and Texas programs are currently up and running.
- Upcoming programs (dates listed are subject to change):
  - Massachusetts/VT/New Hampshire/Maine/Northeast NY – last quarter 2013
  - New York City metropolitan area – 4th quarter 2013
  - Eastern PA/Southern New Jersey/Delaware – summer 2013
  - Eastern Ohio/Western PA/West Virginia/Northern Kentucky – early fall 2013
  - Michigan/Western Ohio/Eastern Indiana – 4th quarter 2013
  - Northern Illinois/Western Indiana/Wisconsin – 4th quarter 2013
  - North Carolina/Eastern Tennessee/Southern Virginia – 1st quarter 2014
  - Georgia/South Carolina/Central Tennessee – 1st quarter 2014
  - Washington state/Northern Idaho/Western Montana – 1st quarter 2014
  - Utah/Western Colorado/Western Wyoming/Southern Idaho – late 2014
  - Florida – late 2014
  - Additional areas of country 2nd/3rd quarter 2014
Satellite Office Program

Dallas-Fort Worth
- Temporary Space Open
- 4 PTAB Judges

Denver
- Byron G. Rogers Building
- Temporary space Open
- 5 PTAB Judges

Detroit
- 72 patent examiners
- 10 PTAB Judges

Silicon Valley
- Temporary Space Open
- Michelle Lee, Director
- 4 PTAB Judges
Contact Us

- Office of Innovation Development
  www.uspto.gov/inventors
  571.272.8877
  independentinventor@uspto.gov
THANK YOU!