

The America Invents Act: Patent Related Provisions Effective on the One-Year Anniversary

October 22, 2012



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Patent Reform Coordinator

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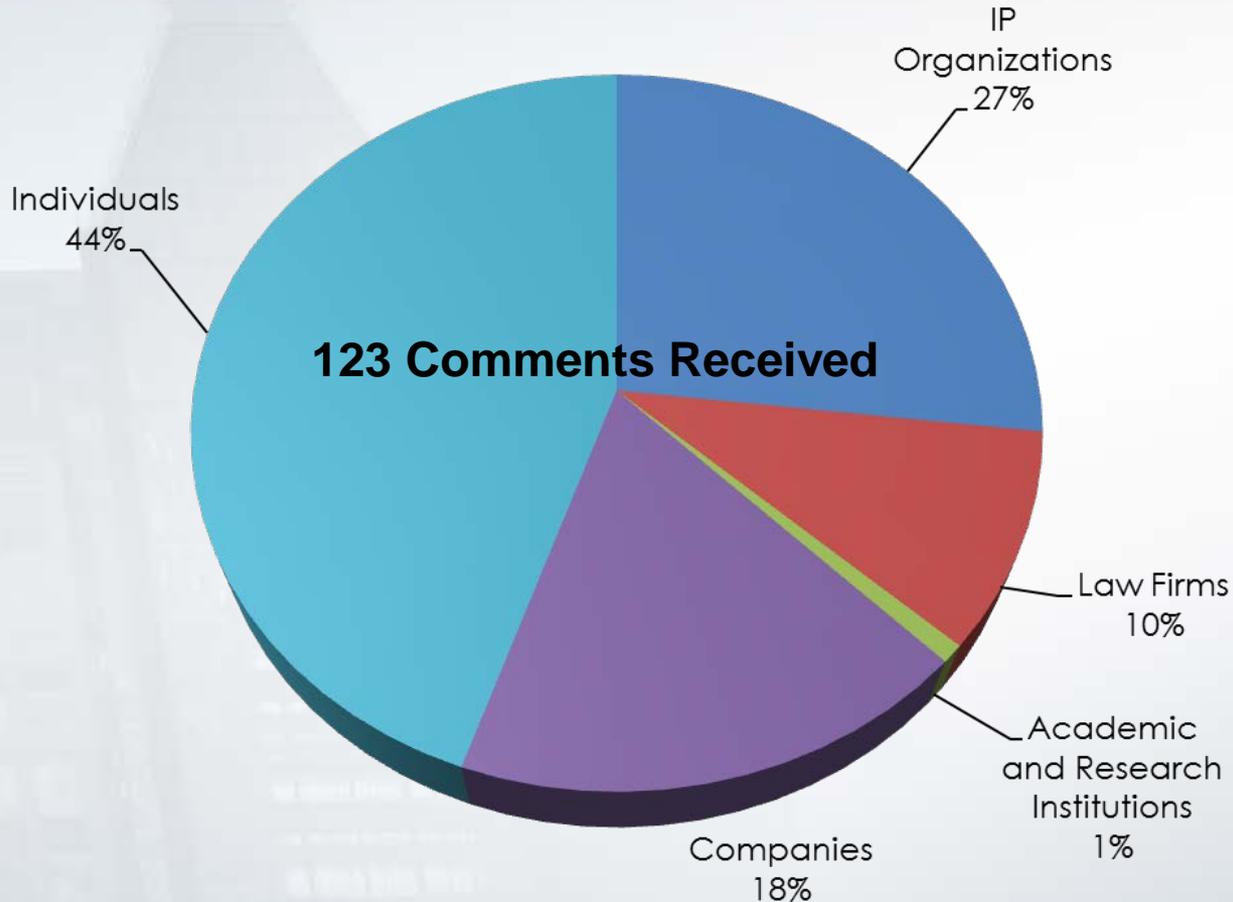


AIA Report Card

Effective September 16, 2012	Effective 2013
Inventor's oath / declaration	Derivation (complete)
Preissuance submission	First-inventor-to-file -Comments due October 5, 2012 fitf_rules@uspto.gov fitf_guidance@uspto.gov
Supplemental examination	Patent service fees -Comments due November 5, 2012 fee.setting@uspto.gov
Citation of patent owner claim scope statements	
Inter partes review	
Post grant review	
Covered business method review	



Public Comments on Patent Related Rulemakings



NOTE: Clarifications and changes from the proposed to the final rules are shown in italicized text

Inventor's Oath or Declaration



35 U.S.C. 115 and 118

Effective Date: September 16, 2012

Applicability: Applications filed on or after September 16, 2012



Applicant Under 35 U.S.C. 118

- Inventors are no longer the only possible applicants
- Applicant may include persons:
 - to whom the inventor has assigned;
 - to whom the inventor is under an obligation to assign (i.e., obligated assignee); and
 - who otherwise show sufficient proprietary interest in the matter



Naming the Inventor Under 35 U.S.C. 115

- Statutory requirement for an inventor's oath or declaration may be satisfied by:
 - Inventor's oath or declaration executed by the inventors;
 - Substitute statement by a non-inventor; or
 - Assignment containing the requirements for an oath or declaration executed by the inventors



Inventor's Oath or Declaration: Contents

- Inventor must state in an oath or declaration that:
 - He/she authorized the application filing; and
 - He/she believes himself/herself to be an original inventor or original joint inventor of the claimed invention in the application
- Several statements required today have been eliminated, for example, the country of citizenship for each inventor, first inventorship, acknowledgment of duty of disclosure
- <http://www.uspto.gov/forms>



Substitute Statements

- Non-inventor applicant may file a substitute statement if an inventor:
 - Is deceased;
 - Is legally incapacitated;
 - Cannot be found or reached after diligent effort; or
 - Refuses to execute an oath or declaration
- <http://www.uspto.gov/forms>



Assignment Containing Statements

- Assignment may serve as an oath or declaration if the assignment as executed:
 - Includes the information and statements required of the inventor for an oath or declaration; and
 - Copy of the assignment is recorded in the Office's assignment database



Inventor's Oath or Declaration: Timing

- Applicants may filing of the inventor's oath or declaration:
 - At the time of filing the patent application; or
 - Upon receive of a Notice of Allowability, if a signed application data sheet (ADS) is filed with the application naming the inventive entity with mailing address and residence for each inventor
- Oath/declaration must still be provided for a reissue application prior to examination

Preissuance Submission



35 U.S.C. 122(e)

Effective Date: September 16, 2012

Applicability: Pending or abandoned non-provisional utility, design, and plant applications filed before, on, or after September 16, 2012



Preissuance Submission: Filing

- Any third party may submit printed publications of potential relevance to the examination of an application for consideration and inclusion in the record of the application
- Submissions are limited to “printed publications”
- May be filed electronically via the Office’s dedicated Web-based interface or in paper but not by facsimile
- No service on applicant required
- May not be made anonymously



Preissuance Submission: Timing

- Must be made before the earlier of:
 - Date a notice of allowance is given or mailed;
- OR
- Later of:
 - 6 months after the date on which the application is first published by the Office; or
 - Date of first rejection of any claim by the examiner



Preissuance Submission: Contents

- Document list
 - <http://www.uspto.gov/forms>
- Concise descriptions of relevance
- Copies of documents, but not for U.S. patents and U.S. patent application publications
- Translations for any non-English language documents
- Statements:
 - compliance with statute and rules;
 - submitting party does not have a duty of disclosure for the application;
 - “first and only” if applicable
- Fee (if necessary)



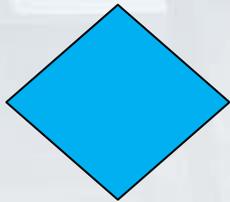
Preissuance Submission: Fee

Service	Fee
Every 10 documents listed or fraction thereof	\$180 fee
First submission of 3 or fewer total documents submitted	No fee



Preissuance Submission: Processing

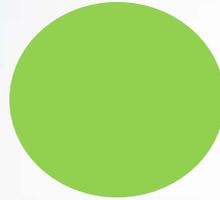
**USPTO Reviews
Submission for
Compliance with 35
U.S.C. § 122(e) and §
1.290**



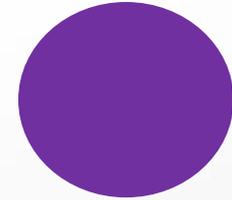
Compliant



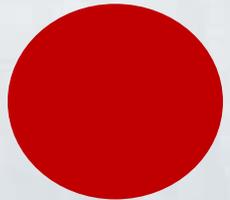
**Submission Made of
Record and
Considered by
Examiner**



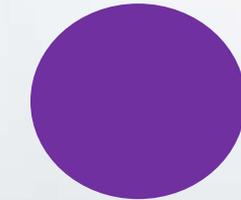
**Patent Owner
Notified if E-Office
Action Participant**



Non-compliant



**Submission
Discarded**



**Third Party
Notified if
Email Address
Available**

Supplemental Examination



35 U.S.C. 257

Effective Date: September 16, 2012

**Applicability: Patent enforceable on/after
September 16, 2012**



Supplemental Examination: Request

- Patent owner may request supplemental examination of a patent to consider, reconsider, or correct information believed to be relevant to the patent
- Request may address 35 U.S.C. 101, 102, 103, and 112, and double-patenting
- Information is not limited to patents and printed publications
- 12 items of information per request, but multiple parallel requests allowed



Supplemental Examination: Filing

- May be filed electronically via the Office's dedicated Web-based interface or in paper but not by facsimile
- Identify the filing as a supplemental examination request
- <http://www.uspto.gov/forms>



Supplemental Examination: Contents

- Identification of the patent and of each claim of the patent for which supplemental examination is requested;
- List of the items of information;
- Separate, detailed explanation of the relevance and manner of applying each item of information; and
- Summary of the relevant portions of any submitted document, other than the request, that is over fifty pages in length
- Fees



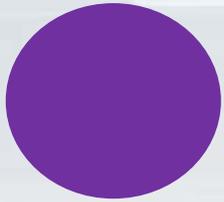
Supplemental Examination: Fee

Service	Fee
Filing fee (for processing and treating a request for supplemental examination) Plus any applicable document size fees for processing and treating, in a supplemental examination proceeding, a non-patent document over 20 sheets in length	\$ 5140
Reexamination fee (for ex parte reexamination ordered as a result of supplemental examination)	\$16,120
TOTAL	\$21,260



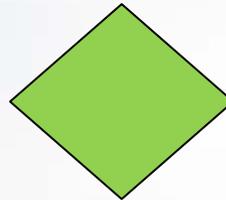
Supplemental Examination: Standard and Processing

Patent Owner
Request



3 months

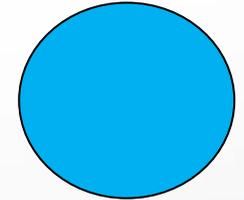
Decision on Patent Owner
Request: Substantial New
Question of Patentability
Standard Triggered?



YES



Supplemental
Examination Concluded
and Ex Parte
Reexamination Initiated



NO



Supplemental
Examination
Concluded

Citation of Patent Owner Claim Scope Statements



35 U.S.C. 301

Effective Date: September 16, 2012

**Applicability: Any patent on or after
September 16, 2012**



35 U.S.C. 301

- Expands the scope of information that may be submitted in a patent beyond prior art to include patent owner claim scope statement
- Governs the use of patent owner claim scope statement by the USPTO
- Identity of submitter kept confidential on written request



Patent Owner Claim Scope Statement

- Written statements about the scope of the patent claims
 - made *inside or outside of a federal court or USPTO proceeding*; and
 - filed *by the patent owner* in the federal court or USPTO proceeding
- May be submitted into patent file by third party or patent owner



Contents for All Submission

- **Prior art and/or patent owner claim scope statement;**
- **Explanation of the pertinence and manner of applying prior art and/or patent owner statement to at least one claim of the patent;**
- **Patent owner explanation may additionally state how any claim is patentable over the prior art and/or patent owner statement; and**
- **Certificate of service on patent owner**



Additional Contents for Submissions with Statements

- Identification of the forum and proceeding in which the patent owner filed the statement;
- Identification of the specific papers or portions of papers submitted containing the statements; and
- Documents, pleadings, or evidence from the proceeding that addresses the statement; and
- Explanation of how the statement is a position taken by the patent owner in a proceeding regarding the scope of a claim



Office Usage

- USPTO will not use a patent owner claim scope statement in deciding whether to order an *ex parte* or *inter partes* reexamination or institute an administrative trial
- USPTO may take a patent owner claim scope statement into account after ordering an *ex parte* or *inter partes* reexamination or instituting and administrative trial to determine the proper meaning of the patent claims



Inventor Assistance & Outreach

Pro Bono Program

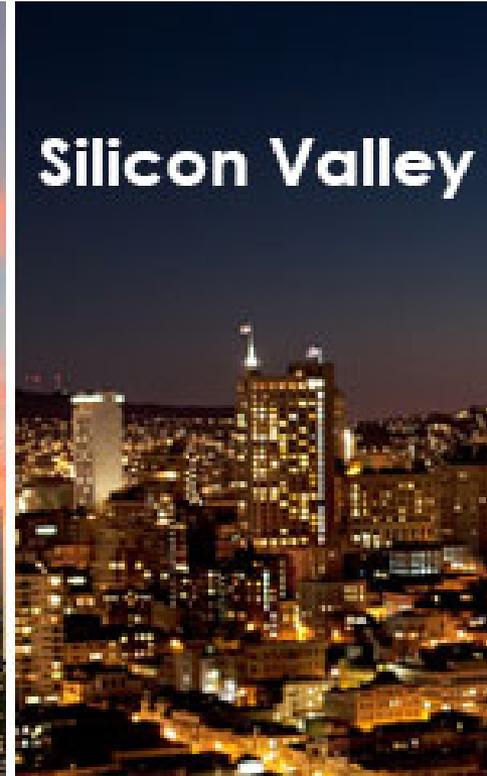
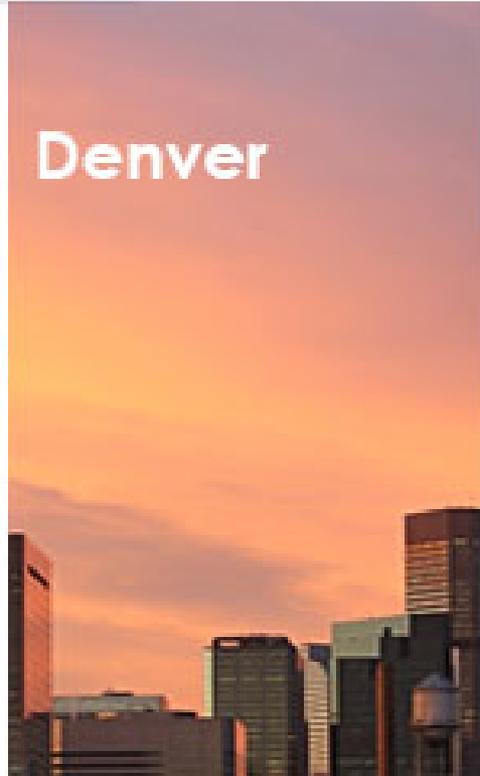
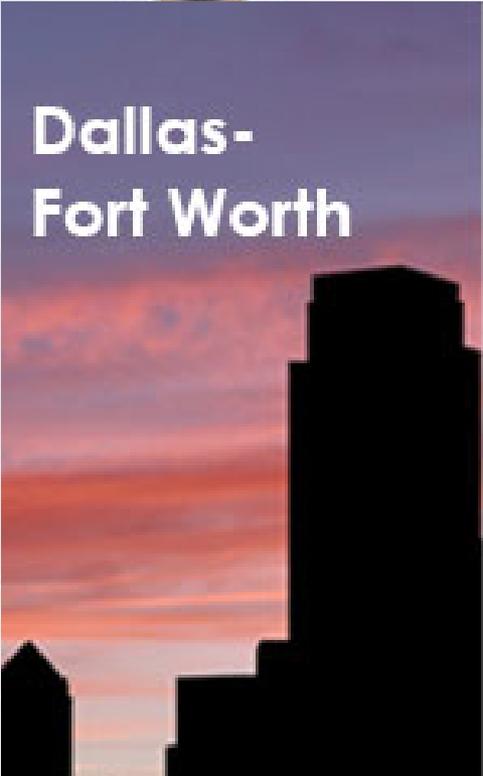
- Assists independent inventors and small businesses in filing and prosecuting professionally-prepared patent applications
- 2 programs operational (Minnesota; Colorado)

Patent Ombudsman Program

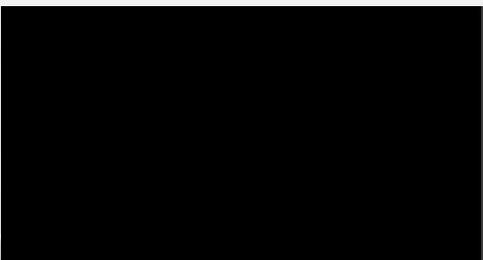
- Assist patent applicants and attorneys with patent application processing issues



Satellite Offices



● historic expansion ● regional job growth ● an innovation ecosystem ● concepts of operation



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AIA Help

- 1-855-HELP-AIA (1-855-435-7242)
- HELPAIA@uspto.gov
- www.uspto.gov/AmericaInventsAct
 - FAQs
 - Videos
 - Reference guide for final rules

Questions?



Thank You



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Appendix

- **Changes to Implement the Inventor's Oath or Declaration Provisions of the Leahy-Smith America Invents Act: Final Rule, 77 Fed. Reg. 48776 (August, 14, 2012)**
- **Changes to Implement Supplemental Examination Provisions of the Leahy-Smith America Invents Act: Final Rule, 77 Fed. Reg. 48828 (August 14, 2012)**
- **Changes to Implement the Preissuance Submissions by Third Party Provisions of the Leahy-Smith America Invents Act: Final Rule, 77 Fed. Reg. 42150 (July 17, 2012)**
- **Changes to Implement Miscellaneous Post Patent Provisions of the Leahy-Smith America Invents Act: Final Rule, 77 Fed. Reg. 46615 (August 6, 2012)**