THREE PILLARS OF THE AIA

20 PROVISIONS RELATED TO USPTO OPERATIONS TO IMPLEMENT OVER NEXT 12 TO 18 MONTHS

—7 PROVISIONS IMPLEMENTED TO DATE
—9 PROVISIONS UNDER IMPLEMENTATION NOW
—4 PROVISIONS FOR FUTURE IMPLEMENTATION
SPEED

Prioritized examination

— Implemented

Fee setting authority / micro-entity

— Under development now
Fee Setting Authority
(Effective September 16, 2011)

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
Reduce the backlog of patent applications

— From 669,625 applications at the end of FY 2011
— To 329,500 at the end of FY 2015
QUALITY

• **Electronic filing incentive**
  — **Implemented**

• **Preissuance submissions**
  — **Proposed rules issued**

• **Citation of a patent owner statement**
  — **Proposed rules issued**

• **Supplemental examination**
  — **Proposed rules issued**
Micro-entity
(Effective September 16, 2011)

General 4-part definition for an —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;

• Applicants are not considered to be named on a previously filed application if he/she has assigned, or is obligated to assign, ownership as a result of previous employment
Micro-entity automatically includes an 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.
Institution of higher education under the Higher Education Act of 1965 means an educational institution, among other things, that:

— is located in any State (i.e., no foreign universities);
— admits persons having a certificate of graduation from a secondary education school;
— awards a bachelor’s degree; and
— is public or non-profit
DIRECTOR MAY IMPOSE ADDITIONAL LIMITS AS ARE
—REASONABLY NECESSARY TO AVOID AN UNDUE IMPACT ON OTHER PATENT APPLICANTS OR OWNERS OR ARE OTHERWISE REASONABLY NECESSARY AND APPROPRIATE

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

USPTO ENGAGED IN RULEMAKING UNDER 18 MONTH TIMELINE
Electronic Filing Incentive
(Effective November 15, 2011)

Establish a $400 fee, reduced by 50% for small entities, for all original (non-reissue) applications filed by non-electronic means.

Fee does not apply to design, plant, or provisional applications.

Fee must be deposited in a general account at Treasury and is not available for the PTO to spend in appropriations account.
Preissuance Submissions
(Effective September 16, 2012)

New 35 U.S.C. § 122(e)

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; and
—must include a statement by the third party making the submission affirming that the submission is compliant with statutory requirements. § 122(e)(1) & (2)
Submission must be made before the earlier of:

—Date a notice of allowance under 35 U.S.C. § 151 is given or mailed in the application; or

—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. § 122(e)(1)(A) & (B)
Proposed rule 290(d): recites contents of submission and consists of 5 parts including:

—list of documents being submitted;
—description of the relevance of each document; and
—copy of each document, except a U.S. patent or U.S. patent application publication
Proposed rule 290(g): requires fee for submission as set forth in current rule 1.17(p) (i.e., fee for Rule 99 submission)

- Three or fewer documents are free if first preissuance submission by third party;
- $180 for 1 to 10 documents; and
- $360 for 11 to 20 documents
Proposed rule 290(h): applicant has no duty to respond to the submission

—Third party not required to serve the submission on the applicant, 77 Fed. Reg. at 449; and

—USPTO will not notify the applicant of entry of the submission into an application, 77 Fed. Reg. at 450

» Examiners will acknowledge the submission in a manner similar to an IDS submission, 77 Fed. Reg. at 450
Citation of Patent Owner Statement
(Effective September 16, 2012)

• Amends 35 U.S.C. § 301
• Expands the information that can be submitted in the file of an issued patent to include written statements made by a patent owner before a Federal court or the Office regarding the scope of any claim of the patent. § 301(a)(2)
• Requires documentation of statement. § 301(c)
• Limits the Office’s use of such written statements to determining the meaning of a patent claim in ex parte reexamination proceedings that have already been ordered and in inter partes review and post grant review proceedings that have been instituted. § 301(d)
Supplemental Exam
(Effective September 16, 2012)

- **New 35 U.S.C. § 257**

- **Patent owner may request supplemental examination of a patent to—consider, reconsider, or correct information‖ believed to be relevant to the patent. § 257(a)**
  - **Proposed rule 601(a): Request must be filed by owner of the entire right, title, and interest in the patent**
  - **Proposed rule 601(c): Third party participation is prohibited**
Contested Cases

4 Kinds:

—Inter partes review: new 35 U.S.C. 311 to 319
—Post grant review: new 35 U.S.C. 321 to 329
—Covered business method review
Clarity

Inventor’s oath/declaration
—Proposed rules issued

First-inventor-to-file and derivation
—Under development now
Inventor’s Oath/Declaration

Replaces language in 35 U.S.C. 115 with new language

An application for patent * * * shall include * * * the name of the inventor for any invention claimed in the application

Each individual who is the inventor or a joint inventor * * * shall execute an oath or declaration
Inventor’s Oath/Declaration (cont.)

Inventor’s oath/declaration must include statements that:

—Application was made or authorized to be made by the affiant/declarant; and
—Affiant/declarant believes himself to be the original inventor

Inventor’s oath/declaration no longer has to include statements that:

—Affiant/declarant believes himself to be the first inventor;
—Citizenship of the inventor;
—Statement that the application is made without deceptive intent
TRANSITIONS the U.S. to a first-inventor-to-file patent system

—Hybrid between first-to-invent (current U.S. law) and first-to-file (used in all other industrialized countries)

MAINTAINS 1-year grace period for inventor disclosures

—If an inventor makes a disclosure during the 1-year period before its U.S. filing date, then that disclosure is excepted from being patent defeating prior art
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QUESTIONS?