Status Report: USPTO Implementation of the America Invents Act

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Progress Report: Rulemakings

• 19 provisions related to USPTO operations to implement

• 7 Group 1 provisions implemented

• 7 Group 2 provisions addressed in Notices of Proposed Rulemaking (NPRMs) to issue in mid- to late January 2012 on 12 Month Timeline

• 2 Group 1 provisions in progress on 17 Month Timeline

• 3 Group 3 provisions to begin work on 18 Month Timeline
<table>
<thead>
<tr>
<th>AIA Provision</th>
<th>Implementation Documents</th>
</tr>
</thead>
<tbody>
<tr>
<td></td>
<td>59055 (Sept. 23, 2011)</td>
</tr>
<tr>
<td>2. Tax strategies are deemed within the prior art</td>
<td>Memo to Examiners, Sept. 20, 2011</td>
</tr>
<tr>
<td>3. Best mode</td>
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</tr>
<tr>
<td>4. Human organism prohibition</td>
<td>Memo to Examiners, Sept. 20, 2011</td>
</tr>
<tr>
<td>5. Prioritized examination</td>
<td>Changes to Implement Prioritized Examination Track (Track I) of the Enhanced Examination</td>
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<tr>
<td>6. 15% transition surcharge</td>
<td>Notice of Availability of Patent Fee Changes Under the Leahy-Smith America Invents Act,</td>
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<tr>
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<td>76 Fed. Reg. 59115 (Sept. 23, 2011)</td>
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## Prioritized Exam

(as of 11/17/11)

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<tr>
<th>Fiscal Year</th>
<th>Pending</th>
<th>Granted</th>
<th>Dismissed</th>
<th>Total</th>
<th>Notice of Allowance</th>
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<tbody>
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<td>222</td>
<td>628</td>
<td>--</td>
<td>850</td>
<td>8</td>
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<tr>
<td>FY2012</td>
<td>419</td>
<td>125</td>
<td>2</td>
<td>546</td>
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</table>
Reserve Fund

- Established by the Department of Treasury

- Favorable language included in minibus to give USPTO access to funds deposited in reserve fund, if any
Implementation Ongoing: 12 Month Timeline (Group 2; Effective on September 16, 2012)

1. Inventor’s oath/declaration
2. Third party submission of prior art in a patent application
3. Supplemental examination
4. Citation of prior art in a patent file
5. Inter partes review
6. Post-grant review
7. Transitional program for covered business method patents
12 Month Timeline

- **SEPT 16 2011**
  - Prepare G2 NPRMs
- **OCT 2011**
  - OMB Review of G2 NPRMs
- **NOV 2011**
  - Public Comment on G2 NPRMS
  - USPTO Public Roundtables on NPRMs
- **DEC 2011**
- **JAN 2012**
  - Prepare G2 FRs
- **FEB 2012**
  - OMB Review of G2 FRs
- **MAR 2012**
  - Delayed Effective Date of G2 FRs
  - USPTO Public Roundtables on FRs
- **APR 2012**
  - USPTO Prepare Internal Guidance, MPEP Updates, Examiner Training, etc. on G2 FRs
- **MAY 2012**
- **JUNE 2012**
- **JULY 2012**
- **AUG 2012**
- **SEPT 16 2012**
Implementation Ongoing: 17 Month Timeline (Group 1)

- **Fee Setting Authority**
  - Authority to set or adjust fees became effective on September 16, 2011
  - Authority to be exercised by rulemaking

- **Micro-entity**
  - Micro-entity status became effective on September 16, 2011
  - 75% discount is not available until USPTO exercises fee setting authority
17 Month Timeline

- **OCT 2011**: Calculate Aggregate Cost and Revenue
- **NOV 2011**: Prepare Fee Setting NPRM
- **DEC 2011**: PPAC Public Hearing
- **JAN 2012**: OMB Review of Fee Setting NPRM
- **FEB 2012**: Public Comment on Fee Setting NPRM
- **APR 2012**: PPAC Report
- **MAY 2012**: Prepare Fee Setting FR
- **JUNE 2012**: OMB Review of Fee Setting
- **JULY 2012**: Delayed Effective Date of Fee Setting FRs
- **AUG 2012**: USPTO Prepare Internal & External Guidance on Fee Setting FRs
- **SEP 2012**: Prepare, Review, and Vet Micro Entity NPRM
- **OCT 2012**: OMB Review of Fee Setting NPRM
- **NOV 2012**: Public Comment Period on Micro Entity NPRM
- **JAN 2013**: Prepare Micro Entity Final Rule
- **FEB 2013**: OMB Review of Micro Entity FRs
- **MAR 2013**: Delayed Effective Date of Micro Entity FRs
- **APR 2013**: USPTO Prepare Internal & External Guidance on Micro Entity FRs
Implementation in Future: 18 Month Timeline* (Group 3; Effective on March 16, 2013)

1. First-Inventor-to-File

2. Derivation proceedings

3. Repeal of Statutory Invention Registration
18 Month Timeline*

- **JAN 2012**
  - Prepare G3 NPRMs

- **FEB**
  - OMB Review of G3 NPRMs

- **MAR**
  - Public Comment on G3 NPRMs
  - USPTO Public Roundtables on NPRMs

- **APR**

- **MAY**
  - Prepare G3 FRs

- **JUNE**
  - OMB Review of G3 FRs

- **JULY**
  - Delayed Effective Date of G3 FRs
  - USPTO Public Roundtables on FRs

- **AUG**
  - USPTO Prepare Internal Guidance, MPEP Updates, Examiner Training, etc. on G3 FRs

- **SEPT**

- **OCT**

- **NOV**

- **DEC**

- **JAN 2013**

- **FEB**

- **MAR**
Progress Report: Studies

- 7 studies for USPTO to conduct as lead
- 2 studies in progress

<table>
<thead>
<tr>
<th>Topic</th>
<th>Due Date from Enactment</th>
</tr>
</thead>
<tbody>
<tr>
<td>International Patent Protection for Small Businesses</td>
<td>4 months</td>
</tr>
<tr>
<td>Prior User Rights</td>
<td>4 months</td>
</tr>
<tr>
<td>Genetic Testing</td>
<td>9 months</td>
</tr>
<tr>
<td>Misconduct Before the Office</td>
<td>Every 2 years</td>
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<tr>
<td>Satellite Offices</td>
<td>3 years</td>
</tr>
<tr>
<td>Virtual Marking</td>
<td>3 years</td>
</tr>
<tr>
<td>Implementation of AIA</td>
<td>4 years</td>
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</table>
Int’l Patent Protection for Small Businesses Study

• USPTO directed to study how the USPTO and other federal agencies can best financially help small businesses with patent protection overseas

• USPTO consulting with the Department of Commerce and the Small Business Administration

• Public input:
  – 19 written comments
  – 2 public hearings; 12 witnesses

• Report due by January 14, 2012
Prior User Rights Study

- USPTO directed to study the operation of prior user rights in other industrialized countries

- USPTO consulting with the United States Trade Representative, the Secretary of State, and the Attorney General
Prior User Rights Study (cont.)


- Public input:
  - 28 written comments
  - 1 public hearing; 5 witnesses

- Report due by January 16, 2012
Genetic Testing Study

• USPTO to report on effective ways to provide independent, confirming genetic diagnostic tests where:
  – gene patents; and
  – exclusive licensing for primary genetic diagnostic tests

• Federal Register to issue in late January seeking public comments and announcing hearing dates
  – Hearings: late February/early March
  – Written comments: late January to late March

• Report due by June 16, 2012
## Progress Report: Programs

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<thead>
<tr>
<th>Topic</th>
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<tbody>
<tr>
<td>Pro Bono</td>
<td>Immediately</td>
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<tr>
<td>Diversity of Applicants</td>
<td>6 months</td>
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<tr>
<td>Patent Ombudsman for Small Businesses</td>
<td>12 months</td>
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<tr>
<td>Satellite Offices</td>
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Pro Bono Program

• Minnesota program running

• Task Force formed to expand the program to other cities; USPTO participating

• First meeting held on October 21, 2011
Satellite Offices

- USPTO is interested in gathering information on potential cities and regions for future satellite offices

- Initial office planned for Detroit; opening 2012

- 2 more offices required

- Request for Comments on Additional USPTO Satellite Offices for the Nationwide Workforce Program, 76 Fed. Reg, 73601 (Nov. 29, 2011)
  - Written comments until January 30, 2012
Executive summaries for provisions
Progress reports (n=2; update monthly)
Federal Register Notices and Memos for Group 1 implemented provisions
Webcast and transcript of hearings and written comments for International Patent Protection and Prior User Rights hearings
Blog (n=7)
FAQ (n>60)
Videos (n=3)
Speeches (n=10)
Press releases (n=8)
Legislative history (complete)
Announcements and Upcoming Events (updated weekly)
Subscription Center
Dear AIA Subscribers:

Thank you for registering to receive regular updates about new features added to the AIA micro-site. We are delighted to have 3,057 subscribers to date and look forward to others joining as our implementation activities continue over the next several months. This is our first subscription center update since we launched our micro-site on September 16, 2011—the date that President Obama signed the America Invents Act into law. Going forward, we plan to send additional email alerts to you on a monthly basis.
AIA Outreach
AIA Outreach (cont.)

- Mid-Atlantic: 41%
- Pacific: 14%
- Northeast: 9%
- Southeast: 2%
- Southwest: 5%
- Caribbean Island: 3%
- Great Lakes: 11%
- International: 4%
- All: 11%
Public Comments (cont.)

Comments by Specific Subject

- Other: 39%
- Post grant review: 14%
- Inter partes review: 11%
- First-Inventor-to-File (FITF): 7%
- Transitional business method: 7%
- Third party art submission: 5%
- FITF - Prior art (102, 103): 6%
- Micro-entity: 5%
- Fee Setting Authority: 6%
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## Group 2 Public Comment Windows

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Thank You