USPTO Implementation of the America Invents Act

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How to submit a question

Submit Question
Type your question and click Send to submit it to the organizer.
Challenges of Implementation

• Numerous provisions to implement simultaneously
  – Ensure that regulations and/or guidance is complementary and not at odds

• Short time periods
  – Date of enactment, 12 months, 18 months

• Coordination required among various USPTO business units as well as other governmental entities
  – Patents, Board of Patent Appeals and Interferences, Finance
  – Small Business Administration, U.S. Trade Representative, Secretary of State, Attorney General, and Secretary of Commerce

• Operational matters, for example, IT updates, training, hiring personnel
### Group 1 Rulemakings and Other Actions
(60-Day and Under Effective Dates) (a.k.a. G1 Rulemakings)

<table>
<thead>
<tr>
<th>Date of Enactment (September 16, 2011)</th>
<th>10 Days After Date of Enactment (September 26, 2011)</th>
<th>October 1, 2011</th>
<th>60 Days After Date of Enactment (November 15, 2011)</th>
</tr>
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<tbody>
<tr>
<td>• Inter partes reexamination threshold and termination</td>
<td>• Prioritized examination</td>
<td>Reserve fund</td>
<td>Electronic filing incentive</td>
</tr>
<tr>
<td>• Tax strategies are deemed within the prior art</td>
<td>• 15% transition surcharge</td>
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<td>• Best mode</td>
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<tr>
<td>• Human organism prohibition</td>
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<tr>
<td>• Venue change from DDC to EDVA for suits brought under 35 U.S.C. §§ 32, 145, 146, 154 (b)(4)(A), and 293</td>
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<tr>
<td>• OED Statute of Limitations</td>
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<tr>
<td>• Fee Setting Authority (effective after rulemaking)</td>
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<tr>
<td>• Establishment of micro-entity (effective after rulemaking)</td>
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</tbody>
</table>
• Elevate standard for triggering an inter partes reexamination
  – from “substantial new question” of patentability (“SNQ”)
  – to “reasonable likelihood that the requester will prevail with respect to at least one of the challenged claims” (“reasonable likelihood”)

• Standard for ex parte reexamination remains as SNQ
IP Reexam Termination
(Effective September 16, 2012)

• Inter partes reexamination termination on September 16, 2012

• Establishes inter partes review to replace inter partes reexamination

• Inter partes review effective on September 16, 2012
IP Reexam Threshold & Termination

• Revision of Standard for Granting an Inter Partes Reexamination Request, 76 Fed. Reg. 59055 (Sept. 23, 2011)

• Impacts 37 C.F.R. §§ 1.913, 1.915, 1.923, 1.927
Fee Setting Authority
(Effective September 16, 2011)

- Sunsets 7 years after enactment
- Authorizes the USPTO to set or adjust patent and trademark fees by rule
- Patent/trademark fees may be set to recover only the aggregate estimated cost of patent/trademark operations, including administrative costs
- Small entity and micro-entity discounts apply to fees for “filing, searching, examining, issuing, appealing, and maintaining” patent applications/patents
Micro-entity  
(Effective September 16, 2011)

- 4 part definition:
  - Qualifies as a small entity
    - See Section 3 of the Small Business Act and 37 C.F.R. 1.27;
  - Has not been named as an inventor on more than 4 previously filed patent applications;
  - Did not have a gross income exceeding 3 times the median household income in the calendar year preceding the calendar year in which the applicable fees is paid; and
  - Has not assigned, granted, conveyed a license or other ownership interest (and is not under an obligation to do so) in the subject application to an entity that exceeds the gross income limit
Micro-entity (cont.)

- Entitled to a 75% discount on fees, once the USPTO exercises its fee setting authority to set fees

- 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

- Includes applicants who are employed by an institute of higher education and has assigned, or is obligated to assign, ownership to that institute of higher education
Prioritized Exam (a.k.a. Track 1)  
(Effective September 26, 2011)

- Original utility or plant patent application accorded special status for expedited examination if:
  - $4,800 fee, reduced by 50% for small entity;
  - no more than 4 independent claims, 30 total claims, and no multiple dependent claims; and
  - must file application electronically (utility application)

- Does not apply to international, design, reissue, or provisional applications or in reexamination proceedings

- May be requested for a continuing application
Prioritized Exam (cont.)

• USPTO goal for final disposition (e.g., mailing notice of allowance, mailing final office action) is on average 12 months from date of prioritized status

• Prioritized exam is terminated without a refund of prioritized exam fee if patent applicant:
  – petitions for an extension of time to file a reply or to suspend action; or
  – amends the application to exceed the claim restrictions
• USPTO may not accept more than 10,000 requests for prioritized exam per fiscal year, absent regulations to prescribe for conditions for acceptance and limitation on the number of filings

• Prioritized examination fee deposited into USPTO appropriations account

• Prioritized examination fee of $4800/$2400 terminates when USPTO exercises fee setting authority
Prioritized Exam (cont.)


- Impacts 37 C.F.R. §§ 1.17 and 1.102
## Prioritized Exam Statistics
(As of October 13, 2011)

<table>
<thead>
<tr>
<th>Fiscal Year</th>
<th>Pending</th>
<th>Granted</th>
<th>Dismissed</th>
</tr>
</thead>
<tbody>
<tr>
<td>FY2011</td>
<td>853</td>
<td>--</td>
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</tr>
<tr>
<td>FY2012</td>
<td>254</td>
<td>--</td>
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</table>
15% Surcharge (Effective September 26, 2011)

• 15% surcharge on all fee charged or authorized under 35 U.S.C. § 41 (a), (b), and (d)(1)

• 15% surcharge does not apply to international stage PCT fees, certain petition fees, and enrollment fees

• 15% surcharge deposited into USPTO appropriations account

• Terminates when USPTO exercises fee setting authority

• Fee table at http://www.uspto.gov/about/offices/cfo/finance/fees.jsp

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

Group 2 Rulemakings
(12-Month Effective Date, i.e., September 16, 2012) (a.k.a. G2 Rulemakings)

• Inventor’s oath/declaration

• Third party submission of prior art for patent application

• Supplemental examination

• Citation of prior art in a patent file

• Priority examination for important technologies

• Inter partes review

• Post grant review

• Transitional program for covered business method patents
Group 3 Rulemakings and Other Actions
(18-Month Effective Date, i.e., March 16, 2013) (a.k.a. G3 Rulemakings)

• First-Inventor-to-File
• Derivation proceedings
• Repeal of Statutory Invention Registration
<table>
<thead>
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<th>Topic</th>
<th>Due Date from Enactment</th>
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</thead>
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<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>
</tr>
<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 international patent protection for small businesses
  - how USPTO and other federal agencies can best help small businesses with patent protection overseas, including whether a loan or grant program should be established to help small businesses cover the costs of application, maintenance, and enforcement fees or related technical assistance

- USPTO will consult with the Department of Commerce and the Small Business Administration
• Public input via:
  – Written comments (30 day window); and/or
  – Public hearings
    • October 27, 2011, 1 to 4 pm @ USPTO
    • November 1, 2011, 9 am to noon @ University of Southern California Gould School of Law

• Report due by January 14, 2012

• USPTO directed to study the operation of prior user rights in other industrialized countries, including:
  – a comparison of patent laws between the United States and members of the European Union, Japan, Canada, and Australia;
  – the effects of prior user rights on innovation, startups, and venture capital;
  – any legal issues that arise with trade secret law; and
  – the impact of switching to a first-to-file patent system

• USPTO will consult with the United States Trade Representative, the Secretary of State, and the Attorney General
• Public input via:
  – Written comments (30 day window); and/or
  – Public hearing
    • October 25, 2011 with 5 witnesses and approximately 60 in attendance
    • http://www.uspto.gov/aia_implementation/aia_studies_reports.jsp#heading-2

• Report due by January 16, 2012

Programs: USPTO to Establish

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<th>Topic</th>
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<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>
<td>3 years</td>
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Pro Bono Program
(Effective September 16, 2011)

- Minnesota piloted a program to connect under-resourced independent inventors and small businesses with patent counsel

- Task Force forming to expand the program to other cities

- First meeting held on October 21, 2011
Timeline: Major Milestones

Month 1
- Implement G1 FRs and other actions

Month 2
- Prepare G2 NPRMs

Month 3
- OMB Review of G2 NPRMs
- Public Comment on G2 NPRMs

Month 4

Month 5
- USPTO Public Roundtables on NPRMs

Month 6
- Prepare G2 FRs

Month 7
- OMB Review of G2 FRs

Month 8
- Delayed Effective Date of G2 FRs
- USPTO Public Roundtables on NPRMs

Month 9
- USPTO Prepare Internal Guidance, MPEP Updates, Examiner Training, etc. on G2 FRs

Month 10
- Effects of H2F on Sm. Bus. Study Due

Month 11
- Patent Litigation Study Due

Month 12
- Patent Ombudsman Program Start
## Rulemakings Planned Under 12 Month Timeline

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<td>2 Third party submission of prior art for a patent application</td>
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<tr>
<td>3 Supplemental examination</td>
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</tr>
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<td>4 Third party citation of prior art in a patent file</td>
<td>6</td>
</tr>
<tr>
<td>5 Umbrella set of rules for contested case procedure</td>
<td>N/A</td>
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<tr>
<td>6 Inter partes review</td>
<td>6</td>
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<tr>
<td>7 Post grant review</td>
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<tr>
<td>8 Transitional program for covered business methods</td>
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<td>9 Definition of technological invention</td>
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<td>10 Derivation proceeding</td>
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AIA Micro-Site
http://www.uspto.gov/americainventsact

• One-stop shopping for info about AIA implementation

• Regularly updated

• Subscription center to receive email alerts when info is added
### Comments

Thank you for visiting the Comments area for AIA implementation. The agency welcomes, encourages, and will consider all comments received about AIA implementation. We also will post all comments received to foster a dialogue among stakeholders about AIA implementation.

### To Submit Comments

Comments may be submitted to the USPTO via email (preferred) or postal mail to the following addresses:

Please click on the respective Rulemaking to provide comments:

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**Postal Mail:**

U.S. Patent and Trademark Office  
Mail Stop Comments—Patents  
Commissioner of Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450
Thank You

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