Status Report: USPTO Implementation of the America Invents Act

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Progress Report: Rulemakings

• 20 provisions related to USPTO operations to implement

• 7 provisions implemented

• 9 provisions addressed in Notices of Proposed Rulemaking (NPRMs) to issue on 12 Month Timeline
  – 4 NPRMs issued on January 5-6, 2012
  – 5 NPRMs and 1 Guidance Document to issue in late January 2012

• 2 provisions in progress on 17 Month Timeline

• 2 provisions to begin work on 18 Month Timeline*
### Implemented Provisions
(Effective on September 16, 2011 or within 60 days)

<table>
<thead>
<tr>
<th>AIA Provision</th>
<th>Implementation Documents</th>
</tr>
</thead>
<tbody>
<tr>
<td>1 Change in inter partes reexamination standard</td>
<td>Revision of Standard for Granting an Inter Partes Reexamination Request, 76 Fed. Reg. 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>
<td>Memo to Examiners, Sept. 20, 2011</td>
</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 Timing Control Procedures Under the Leahy-Smith America Invents Act, 76 Fed. Reg. 59050 (Sept. 23, 2011)</td>
</tr>
</tbody>
</table>
Implementation Ongoing: 12 Month Timeline  (Effective on September 16, 2012)

1. Inventor’s oath/declaration

2. Third party submission of prior art in a patent application

3. Citation of prior art in a patent file

4. OED Statute of Limitations (effective September 16, 2011)

5. Supplemental Examination

6. Inter partes review

7. Post-grant review

8. Transitional program for covered business method patents

9. Derivation (effective on March 16, 2013)
NPRMs Published to Date

• Changes to Implement the Preissuance Submissions by Third Parties Provision of the Leahy-Smith America Invents Act, 77 Fed. Reg. 448 (Jan. 5, 2012)


• Changes to Implement the Inventor’s Oath or Declaration Provisions of the Leahy-Smith America Invents Act, 77 Fed. Reg. 982 (Jan. 6, 2012)

# 12 Month Timeline

<table>
<thead>
<tr>
<th>Date</th>
<th>Event</th>
</tr>
</thead>
<tbody>
<tr>
<td>SEP 16 2011</td>
<td>Prepare G2 NPRMs</td>
</tr>
<tr>
<td>OCT 2011</td>
<td>OMB Review of G2 NPRMs</td>
</tr>
<tr>
<td>NOV 2011</td>
<td>Public Comment on G2 NPRMs</td>
</tr>
<tr>
<td>JAN 2012</td>
<td>Prepare G2 FRs</td>
</tr>
<tr>
<td>FEB 2012</td>
<td>OMB Review of G2 FRs</td>
</tr>
<tr>
<td>MAR 2012</td>
<td>USPTO Public Roundtables on NPRMs</td>
</tr>
<tr>
<td>APR 2012</td>
<td>USPTO Prepare Internal Guidance, MPEP Updates, Examiner Training, etc.</td>
</tr>
<tr>
<td>MAY 2012</td>
<td>Delayed Effective Date of G2 FRs</td>
</tr>
<tr>
<td>JUN 2012</td>
<td>USPTO Public Roundtables on FRs</td>
</tr>
<tr>
<td>AUG 2012</td>
<td></td>
</tr>
<tr>
<td>SEP 16 2012</td>
<td></td>
</tr>
</tbody>
</table>
# AIA Roadshows

<table>
<thead>
<tr>
<th>Date</th>
<th>Venue</th>
<th>Location</th>
</tr>
</thead>
<tbody>
<tr>
<td>Friday, February 17</td>
<td>USPTO Campus</td>
<td>Alexandria, VA</td>
</tr>
<tr>
<td>Friday, February 24</td>
<td>Sunnyvale Public Library</td>
<td>Sunnyvale, CA</td>
</tr>
<tr>
<td>Monday, February 27</td>
<td>Marriott Library, University of Utah</td>
<td>Salt Lake City, UT</td>
</tr>
<tr>
<td>Wednesday, February 29</td>
<td>Dallas Public Library</td>
<td>Dallas, TX</td>
</tr>
<tr>
<td>Friday, March 2</td>
<td>Broward County Main Library</td>
<td>Ft. Lauderdale, FL</td>
</tr>
<tr>
<td>Monday, March 5</td>
<td>Boston Public Library</td>
<td>Boston, MA</td>
</tr>
<tr>
<td>Wednesday, March 7</td>
<td>Chicago Public Library</td>
<td>Chicago, IL</td>
</tr>
</tbody>
</table>
1. Fee Setting Authority
   – Authority effective on September 16, 2011
   – Authority to be exercised by rulemaking

2. Micro-entity
   – Status effective on September 16, 2011
   – 75% discount is not available until USPTO exercises fee setting authority
1. First-Inventor-to-File

2. Repeal of Statutory Invention Registration
18 Month Timeline*

- **JAN 2012**
  - Prepare G3 NPRMs
  - OMB Review of G3 NPRMs

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

- **JULY**
  - Prepare G3 FRs

- **AUG**
  - OMB Review of G3 FRs

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

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

3/20/2012
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>
</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>
</tr>
</tbody>
</table>
## Progress Report: Programs

<table>
<thead>
<tr>
<th>Topic</th>
<th>Due Date from Enactment</th>
</tr>
</thead>
<tbody>
<tr>
<td>Pro Bono</td>
<td>Immediately</td>
</tr>
<tr>
<td>Diversity of Applicants</td>
<td>6 months</td>
</tr>
<tr>
<td>Patent Ombudsman for Small Businesses</td>
<td>12 months</td>
</tr>
<tr>
<td>Satellite Offices</td>
<td>3 years</td>
</tr>
</tbody>
</table>
Pro Bono Program

- Provides pro bono legal assistance to financially under-resource independent inventors and small businesses to file and prosecute patent applications

- Minnesota program running

- Task Force formed to expand the program to other cities; USPTO participating
Satellite Offices

- USPTO required to open 3 satellite offices in three years
- Initial office planned for Detroit; opening 2012
- 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
AIA Micro-Site
http://www.uspto.gov/americainventsact

Implementation Information
- Patent Examination
- Inter Partes Deputies
- Fees and Budgetary Issues
- AIA Studies and Reports
- Programs
- Miscellaneous

AIA Resources
AIA Informational Videos
AIA Press Releases and Speeches
AIA Frequently Asked Questions
AIA Comments
AIA Blog

Announcements and Upcoming AIA Events
Tuesday, September 20, 2011 @ 2:10pm:
Commissioner Robert L. Stoll
The 21st Al Ohio Annual Institute on Intellectual Property
Cleveland, OH

Wednesday, September 21, 2011 @ 2:10pm:
Commissioner Robert L. Stoll
The 21st Al Ohio Annual Institute on Intellectual Property
Cincinnati, OH

Friday, September 23, 2011 @ 1:00pm:
Commissioner Robert L. Stoll
Virginia State Bar IP Law Section
Arlington, VA

Tuesday, September 27, 2011 @ 1:00pm:
Commissioner Robert L. Stoll
American Conference Institute
America Invents Act Webinar
https://www2.gotomeeting.com/register/127501938
Registration is complimentary

Leahy-Smith America Invents Act Implementation


Message from Director David Kappos
On September 16, 2011, President Barack Obama signed into law the Leahy-Smith America Invents Act, which will foster innovation and spur job creation in the United States. This Act sets into motion the most comprehensive overhaul to our nation's patent system since 1836.

The new law will afford more certainty for patent applicants and owners, and provide the USPTO the resources needed to operate efficiently and issue high-quality patents. Implementation of the new law will occur over a period of months, and our USPTO team will seek input and provide updates all along the way. I strongly encourage you to use this site to regularly track progress pertaining to the agency's implementation efforts.

All of us at USPTO look forward to working together with the innovation community to tackle the exciting challenges of rolling-out this historic law. Here are a few documents to get started:

- America Invents Act Signing Ceremony
- White House chat on the America Invents Act
- Press Release: President Obama signs America Invents Act
- Leahy-Smith America Invents Act
- America Invents Act Effective Dates
- USPTO Fee Schedule

Timeline: Major Milestones

3/20/2012
Thank You

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