Status Report: USPTO Implementation of the America Invents Act

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Director, Central Reexamination Unit
571-272-0781 (direct)
Scope of America Invents Act

• Creates or amends patent provisions of law

• Requires USPTO to conduct studies into specific areas of patent law

• Requires USPTO to set up new programs
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 issued in late January/early February 2012
- 2 provisions in progress on 17 Month Timeline
- 2 provisions to begin work on 18 Month Timeline*

4/3/2012
## 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>
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)
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>
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</table>
Implementation Ongoing: 17 Month Timeline

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
17 Month Timeline

- Calculate Aggregate Cost and Revenue
- Prepare Fee Setting NPRM
  - PPAC Public Hearing
- OMB Review of Fee Setting NPRM
- Public Comment on Fee Setting NPRM
- Prepare Fee Setting FR
  - PPAC Report
  - USPTO Prepare Internal & External Guidance on Fee Setting FRs
- Prepare Micro Entity Final Rule
  - OMB Review of Micro Entity NPRMs
- Prepare Micro Entity NPRM
  - OMB Review of Fee Setting NPRM
  - Public Comment Period on Micro Entity NPRM
- Delayed Effective Date of Micro Entity FRs
- USPTO Prepare Internal & External Guidance on Micro Entity FRs
1. First-Inventor-to-File

2. Repeal of Statutory Invention Registration
18 Month Timeline*

Prepare G3 NPRMs

OMB Review of G3 NPRMs

Public Comment on G3 NPRMs
USPTO Public Roundtables on NPRMs

Prepare G3 FRs

OMB Review of G3 FRs

Delayed Effective Date of G3 FRs
USPTO Public Roundtables on FRs

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

NPRMs Publish in Fed. Reg.

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>
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

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

<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 Parties Disputes
- 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 AI Ohio Annual Institute on Intellectual Property
Cleveland, OH

Wednesday, September 21, 2011 @ 2:10pm:
Commissioner Robert L. Stoll
The 21st AI 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.gotometing.com/register/127501338
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
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.
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 e-mail (preferred) or postal mail to the following addresses:

Please click on the respective Rulemaking to provide comments:

<table>
<thead>
<tr>
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<tbody>
<tr>
<td><strong>Group 1 Rulemakings</strong></td>
<td></td>
<td></td>
<td></td>
</tr>
<tr>
<td>Inter Partes Reexamination Threshold</td>
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<td>Tax Strategies deemed within Prior Art</td>
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<td>Best Mode</td>
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</tr>
<tr>
<td>Human Organism Prohibition</td>
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<td>N/A</td>
<td>Open</td>
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<tr>
<td>Prioritized Examination</td>
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<td>N/A</td>
<td>Open</td>
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<td>15% Surcharge</td>
<td>N/A</td>
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<td>Open</td>
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<td>Electronic Filing Incentive</td>
<td>N/A</td>
<td>N/A</td>
<td>Open</td>
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<tr>
<td>Fee Setting</td>
<td>Open until late February 2012</td>
<td>Mid-June 2012 to mid-August 2012</td>
<td>TBD</td>
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</table>
Janet Gongola
janet.gongola@uspto.gov
Direct dial: 571-272-8734
Thank You!