FY 2012 Total URR filings through August are currently 6.1% above FY 2011
Patent Examiner Staffing
FY 2001 – FY 2012 (through August)
12-Month Rolling Average UPR Examiner Attrition Rate Less Transfers and Retirees
FY 2001 – FY 2012 (through August)

3.08% as of August 2012.

The oval represents when monthly data begins.
Patent Examiner Staff = 7,867

FY '12 HIRED = 1,506
Forward Looking First Action Pendency
FY 2009 – FY 2012 (through August)
Prioritized Examination (Track One)

- "Fast track" examination
- Brings new inventions to the marketplace faster

Statistics (statistics as of 9/17/12):
- 5,629 petitions for prioritized examination
- 95% of petitions granted
- 5 months to final disposition
- 935 notices of allowance mailed
August 2012 Patents Data, at a Glance

http://www.uspto.gov/dashboards/patents/main.dashxml
Patents Related Provisions

Inventor’s Oath/Declaration
Pre-Issuance Submission
Supplemental Examination
Miscellaneous Provisions

Board Related Provisions

Post Grant Review
*Inter Partes* Review
Covered Business Method Review

AIA Final Rules
(Effective September 16, 2012)
Inventors are no longer the only possible applicants (35 U.S.C. 118, §§ 1.42(a)-(c)):

“Applicant” is no longer synonymous with the person who must execute the oath or declaration.
• Inventor, assignee, or obligated assignee may file an application for patent as the applicant

• Inventor’s oath/declaration need not identify the entire inventive entity, if a signed Application Data Sheet (ADS) is filed that includes identification of each inventor

• Filing of an inventor’s oath/declaration may be postponed until a time period set forth in a Notice of Allowability expires, if a signed ADS is filed that includes identification of each inventor
• 3rd parties to submit potentially relevant printed publications in another’s patent application for consideration by the examiner to build the record before the examiner

• Requirements placed on third parties:
  – Written statement of relevance for each publication;
  – Fee; and
  – Timing requirements
• May be filed in the following pending or abandoned applications: (§ 1.290(a))
  – Non-provisional utility
  – Design
  – Plant
  – Continuations, divisionals, and continuations-in-part

• Submissions may **not** be filed in:
  – Issued patents (file pursuant to § 1.501)
  – Reissue applications (file pursuant to § 1.291)
  – Reexamination proceedings
Filing (continued)

• May be filed by any member of the public (§ 1.290(a))

• No service on applicant required
Statutory Time Periods

• Must be made before the earlier of:
  – Date a notice of allowance is given or mailed;

OR

  – Later of:
    • 6 months after the date on which the application is first published by the Office (§ 1.290(b)(2)(i)); or
    • Date of first rejection of any claim by the examiner (§ 1.290(b)(2)(ii))
Notification to Applicant

• Applicant will **not** be notified of non-compliant submissions
  – Non-compliant submissions will not be made of record in the application

• Applicant **will** be electronically notified upon entry of a compliant submission in its application file provided applicant participates in the Office’s e-Office Action program
Supplemental Examination
(Effective September 16, 2012)

• New 35 U.S.C. 257 - a patent owner may request supplemental examination of a patent to “consider, reconsider, or correct information” believed to be relevant to the patent

• Within 3 months from the filing date of the request - Office must decide whether any of the items filed raises a substantial new question of patentability

• If it is determined that a substantial new question is raised, provide for a prompt resolution of any ex parte reexamination

• A benefit is the avoidance of a post-patent process involving large submissions of unexplained documents (like IDS practice)
Inequitable Conduct Immunization

• Information considered, reconsidered, or corrected during supplemental examination cannot be the basis for rendering a patent unenforceable, except that this immunity does not apply (35 U.S.C. 257(c)(1)-(2)):

  – To allegations pled in a civil action or notice to the patentee before the date of the request for supplemental examination, and
  – Unless the supplemental examination and any resulting *ex parte* reexamination is completed before the civil action is brought
Trial Rules

Inter Partes Review
§§ 42.100 – 42.123

Post-Grant Review
§§ 42.200 – 42.224

Umbrella Trial Rules
§§ 42.1 – 42.80

Covered Business Method Patent Review
§§ 42.300 – 42.304

Derivation Proceeding Proposed
§§ 42.400 – 42.412
Trial Structure

- Same basic structure for all the proceedings

- Reduction of burdens on the parties via:
  - Streamlining and converging issues for decision;
  - Use of page limits and electronic filing;
  - Use of conference calls; and
  - Institution of a trial on a claim-by-claim, ground-by-ground basis
Major Differences between IPR, PGR, and CBM

**IPR**
- All patents are eligible
- Petitioner has not filed an invalidity action and petition is filed no more than one year after service of infringement complaint for the patent
- Only §§ 102 and 103 grounds based on patents or printed publication

**PGR**
- Only FITF patents are eligible
- Petitioner has not filed an invalidity action
- Only §§ 101, 102, 103, and 112, except best mode

**CBM**
- Both FTI & FITF patents are eligible, but must be a covered business method patent
- Petitioner must be sued or charged w/ infringement
- Only §§ 101, 102, 103, and 112, except best mode
Inter Partes Review: Features

- All patents are eligible
- Third party who has not previously filed a civil action challenging the validity of a claim
- Request to cancel as unpatentable based only on patents or printed publications under § 102 or § 103
- Filed after the later of:
  9 months after the grant of a patent or issuance of a reissue of a patent; or date of termination of any post grant review of the patent
• Most aspects of PGR and IPR are effectively the same

• Some differences as compared with IPR:
  • With limited exceptions, only those patents issuing from applications subject to first-inventor-to-file provisions are eligible
  • Challenges may be based on §§ 101, 102, 103, and 112, except best mode
  • Only be requested on or prior to the date that is 9 months after the grant of a patent or issuance of a reissue patent
  • Petition must demonstrate that it is more likely than not (i.e., a higher threshold than IPR) that at least one of the claims challenged in the petition is unpatentable
Covered Business Methods

• Employ the PGR standards and procedures subject to certain exceptions

• Some differences with PGR:
  – Cannot file CBM petition during time a PGR petition could be filed, *i.e.*, 9 months after issuance of a patent
  – Petitioner must be sued or charged with infringement
  – Petitioner has burden of establishing that patent is eligible for CBM review
  – Prior art is limited when challenging a first-to-invent patent
Derivation

• Only a patent applicant may file

• Must be filed within 1 year of the date of the first publication of a claim to an invention that is the same or substantially the same as the earlier application’s claim to the invention

  – “The first publication” means either a patent or an application publication under 35 U.S.C. 122(b), including a publication of an international application designating the U.S. as provided by 35 U.S.C. 374
First-Inventor-to-File
Effective on March 16, 2013

Micro-entity
75% fee discount effective with new fee

Fee Setting
Planned to be effective on March 1, 2013

AIA Proposed Rules
First-inventor-to-file  
(Effective March 16, 2013)

• Builds more transparent, objective, predictable, and simple system for judging novelty and obviousness

• Retains grace period to permit an inventor to disclose his/her invention and then file a patent application within 1 year of disclosure

• Harmonizes the prior art to be applied against a claimed invention in a patent application with other countries
• Authorizes USPTO to set or adjust fees by rule for 7 years

• Fees are set to recover only the aggregate estimated cost of operations

• Goals are to:
  – Collect revenue to reduce backlog and pendency and build a more financially-stable agency
  – Set individual fees to further key policy considerations while taking into account the cost of the particular service
Global Impacts of AIA

- AIA adopts international norms related to:
  - First-to-file
  - Prior user rights
  - Broadening the definition of prior art
  - Eliminating the *Hilmer* doctrine
  - Virtually eliminating the best mode requirement

- US Patent Reform:
  - Facilitates worksharing with international patent offices
  - Provides renewed opportunities to harmonize the international patent system
Cooperative Patent Classification (CPC)

• USPTO and EPO agree to cooperate on a joint classification system derived from IPC-based ECLA

• USPTO to move from USPC to CPC; EPO to move from ECLA to CPC

• CPC planned to be bi-laterally operational at EPO and USPTO
Why the USPTO is Pursuing CPC

• Aligns with USPTO strategic goals
  – Implement IPC-based classification system at USPTO
    • USPTO is currently the only major IP office not using an IPC-based primary classification system
  – Accelerate classification harmonization efforts with other major IP offices
  – Promote resource sharing
• Improves global harmonization for examination and search
  – Classification is the foundation for all global harmonization efforts
• Increases document coverage for classified search
  – A single classification search yields results from the USPTO, EPO and EPO member states
Global Dossier

- USPTO proposal to provide all stakeholders secure, one-stop access to dossier and examination information of all family applications

- Global Dossier is now an initiative under the IP5 framework with WIPO on board as full partner
Global Dossier

- For more information – including a short video:

- For questions, comments and input:
  [globaldossier@uspto.gov](mailto:globaldossier@uspto.gov)
Thank You