

# America Invents Act (AIA) Update

Welcoming remarks will begin at  
11:55 a.m. Eastern Time.

The formal presentation will begin at noon.

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# America Invents Act (AIA) Update

*Presented by:*

**Janet Gongola, United States Patent and Trademark Office**

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# Questions?

We will be taking questions during a designated question and answer periods during the presentation. Please hold all questions until this designated period.

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Audio difficulties: Dial 0 0

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- AUTM Licensing Activity Survey (currently for United States and Canada)
- AUTM Update

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**Janet Gongola**  
Patent Reform Coordinator  
U.S. Patent and Trademark  
Office

# Implementing the America Invents Act: Final Rules

September 5, 2012



Janet Gongola  
Patent Reform Coordinator  
Janet.Gongola@uspto.gov



## Overview

- Inventor's Oath Declaration
- Preissuance Submission
- Supplemental Examination
- Citation of Patent Owner Claim Scope Statements
- Administrative Trials (Post Grant Review and Inter Partes Review)



# Inventor's Oath or Declaration



**35 U.S.C. 115 and 118**

**Effective Date: September 16, 2012**

**Applicability: Applications filed on or after September 16, 2012**

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## Applicant Under 35 U.S.C. 118

- Inventors are no longer the only possible applicants
- Applicant may include persons:
  - to whom the inventor has assigned;
  - to whom the inventor is under an obligation to assign (i.e., obligated assignee); and
  - who otherwise show sufficient proprietary interest in the matter

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## Naming the Inventor Under 35 U.S.C. 115

- Statutory requirement for an inventor's oath or declaration may be satisfied by:
  - Inventor's oath or declaration executed by the inventors;
  - Substitute statement by a non-inventor; or
  - Assignment containing the requirements for an oath or declaration executed by the inventors

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## Inventor's Oath or Declaration: Contents

- Inventor must state in an oath or declaration that:
  - He/she authorized the application filing; and
  - He/she believes himself/herself to be an original inventor or original joint inventor of the claimed invention in the application
- Several statements required today have been eliminated, for example, the country of citizenship for each inventor, first inventorship, acknowledgment of duty of disclosure
- <http://www.uspto.gov/forms>

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## Substitute Statements

- Non-inventor applicant may file a substitute statement if an inventor:
  - Is deceased;
  - Is legally incapacitated;
  - Cannot be found or reached after diligent effort; or
  - Refuses to execute an oath or declaration
- <http://www.uspto.gov/forms>

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## Assignment Containing Statements

- Assignment may serve as an oath or declaration if the assignment as executed:
  - Includes the information and statements required of the inventor for an oath or declaration; and
  - Copy of the assignment is recorded in the Office's assignment database

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## Inventor's Oath or Declaration: Timing

- Applicants may filing of the inventor's oath or declaration:
  - At the time of filing the patent application; or
  - Upon receive of a Notice of Allowability, if a signed application data sheet (ADS) is filed with the application naming the inventive entity with mailing address and residence for each inventor
- Oath/declaration must still be provided for a reissue application prior to examination

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## Polling Question #1

Please identify yourself as one of the following:

- (a) Scientist or researcher
- (b) Technology transfer officer
- (c) Patent agent or practitioner
- (d) None of the above

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# Preissuance Submission



**35 U.S.C. 122(e)**

**Effective Date: September 16, 2012**

**Applicability: Pending or abandoned non-provisional utility, design, and plant applications filed before, on, or after September 16, 2012**

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## Preissuance Submission: Filing

- Any third party may submit printed publications of potential relevance to the examination of an application for consideration and inclusion in the record of the application
- Submissions are limited to “printed publications”
- May be filed electronically via the Office’s dedicated Web-based interface or in paper but not by facsimile
- No service on applicant required
- May not be made anonymously

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## Preissuance Submission: Timing

- 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; or
  - Date of first rejection of any claim by the examiner

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## Preissuance Submission: Contents

- Document list
  - <http://www.uspto.gov/forms>
- Concise descriptions of relevance
- Copies of documents, but not for U.S. patents and U.S. patent application publications
- Translations for any non-English language documents
- Statements:
  - compliance with statute and rules;
  - submitting party does not have a duty of disclosure for the application;
  - “first and only” if applicable
- Fee (if necessary)

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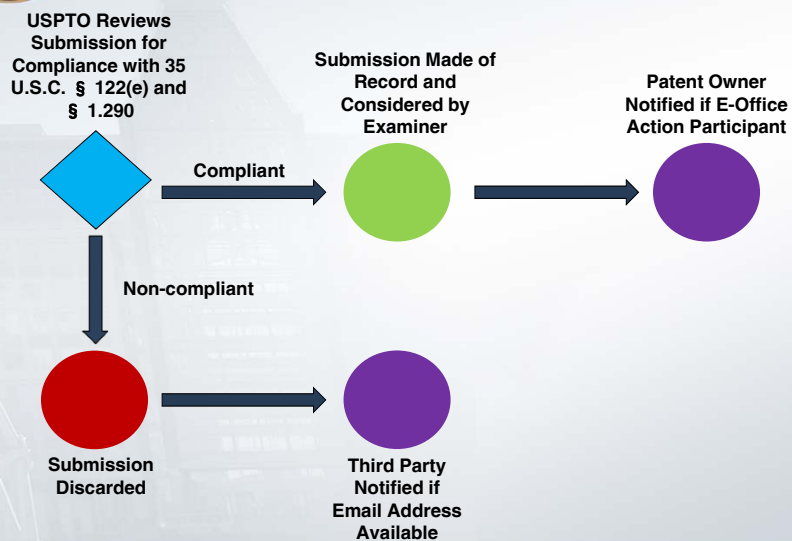


## Preissuance Submission: Fee

Service	Fee
Every 10 documents listed or fraction thereof	\$180 fee
First submission of 3 or fewer total documents submitted	No fee



## Preissuance Submission: Processing





# Questions?

**Click the raise hand button.**

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# Supplemental Examination



**35 U.S.C. 257**

**Effective Date: September 16, 2012**

**Applicability: Patent enforceable on/after  
September 16, 2012**

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## Supplemental Examination: Request

- Patent owner may request supplemental examination of a patent to consider, reconsider, or correct information believed to be relevant to the patent
- Request may address 35 U.S.C. 101, 102, 103, and 112, and double-patenting
- Information is not limited to patents and printed publications
- 12 items of information per request, but multiple parallel requests allowed

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## Supplemental Examination: Filing

- May be filed electronically via the Office's dedicated Web-based interface or in paper but not by facsimile
- Identify the filing as a supplemental examination request
- <http://www.uspto.gov/forms>

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## Supplemental Examination: Contents

- Identification of the patent and of each claim of the patent for which supplemental examination is requested;
- List of the items of information;
- Separate, detailed explanation of the relevance and manner of applying each item of information; and
- Summary of the relevant portions of any submitted document, other than the request, that is over fifty pages in length
- Fees

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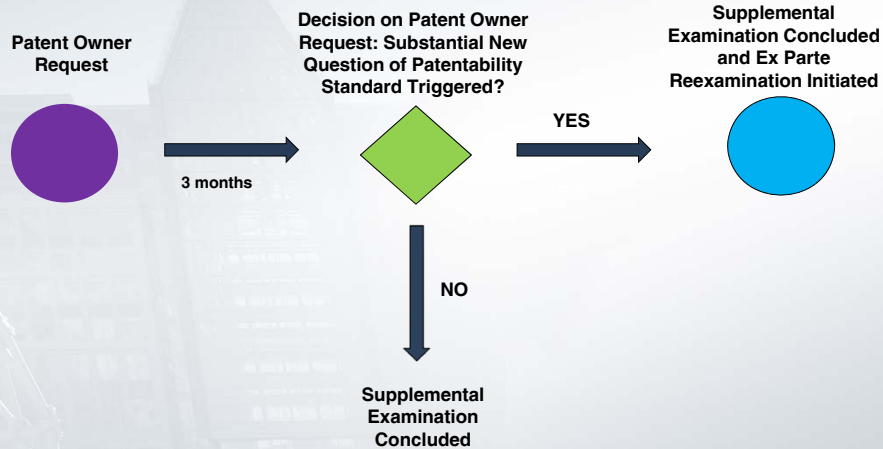
## Supplemental Examination: Fee

<b>Service</b>	<b>Fee</b>
Filing fee (for processing and treating a request for supplemental examination) Plus any applicable document size fees for processing and treating, in a supplemental examination proceeding, a non-patent document over 20 sheets in length	\$ 5140
Reexamination fee (for ex parte reexamination ordered as a result of supplemental examination)	\$16,120
<b>TOTAL</b>	<b>\$21,260</b>

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## Supplemental Examination: Standard and Processing



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## Polling Question #2

Which statutory provision of the AIA that becomes effective on September 16, 2012, are you most concerned about impacting your patent application filing practices and/or patent portfolio?

- (a) Inventor's oath/declaration
- (b) Preissuance submissions
- (c) Supplemental examination or administrative trial
- (d) Don't know

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# Citation of Patent Owner Claim Scope Statements



**35 U.S.C. 301**

**Effective Date: September 16, 2012**

**Applicability: Any patent on or after September 16, 2012**

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## **35 U.S.C. 301**

- Expands the scope of information that may be submitted in a patent file beyond prior art to include written statements about the scope of the patent claims filed by the patent owner in a federal court or USPTO proceeding
- Governs the use of such information by the USPTO
- Identity of submitter kept confidential on written request

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## Contents for All Submission

- Prior art and/or patent owner claim scope statement;
- Explanation of the pertinence and manner of applying prior art and/or patent owner statement to at least one claim of the patent;
- Patent owner explanation may additionally state how any claim is patentable over the prior art and/or patent owner statement; and
- Certificate of service on patent owner

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## Additional Contents for Submissions with Statements

- Documents, pleadings, or evidence from the proceeding that addresses the statement;
- Identification of the forum and proceeding in which the patent owner filed the statement;
- Identification of the specific papers or portions of papers submitted containing the statements; and
- Explanation of how the statement is a position taken by the patent owner in a proceeding regarding the scope of a claim

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## Office Usage

- USPTO will not use a patent owner claim scope statement in deciding whether to order an *ex parte* or *inter partes* reexamination or institute an administrative trial
- USPTO may take a patent owner claim scope statement into account after ordering an *ex parte* or *inter partes* reexamination or instituting an administrative trial to determine the proper meaning of the patent claims

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## Questions?

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# Administrative Trials



35 U.S.C. 311-318 (Inter Partes Review)  
 35 U.S.C. 321-329 (Post Grant Review)  
 Effective Date: September 16, 2012



## Features

Proceeding	Petitioner	Petitioner Estoppel	Standard	Basis
<b>Post Grant Review (PGR)</b>	<ul style="list-style-type: none"> <li>Person who is not the patent owner and has not previously filed a civil action challenging the validity of a claim of the patent</li> </ul>	<ul style="list-style-type: none"> <li>Raised or reasonably could have raised</li> <li>Applied to subsequent USPTO/district court/ITC action</li> </ul>	More likely than not OR Novel or unsettled legal question important to other patents/applications	101, 102, 103, 112, double patenting but not best mode
<b>Inter Partes Review (IPR)</b>	<ul style="list-style-type: none"> <li>Must identify real party in interest</li> </ul>		Reasonable likelihood	102 and 103 based on patents and printed publications





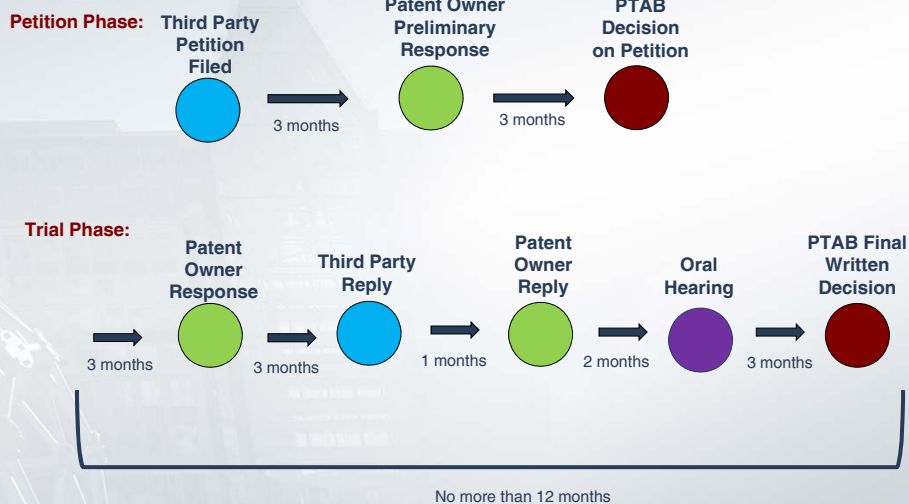
## Features (cont.)

Proceeding	Available	Applicable	Timing
<b>Post Grant Review (PGR)</b>	From patent grant to 9 months from patent grant or reissue	Patent issued under first-inventor-to-file	Must be completed within 12 months from institution, with 6 months good cause exception possible
<b>Inter Partes Review (IPR)</b>	From the later of: (i) 9 months after patent grant or reissue; or (ii) the date of termination of any post grant review of the patent	Patent issued under first-to-invent or first-inventor-to-file	

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## Process



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## Petition: Contents

- Identify all real parties in interest;
- Identify all claims challenged and grounds on which the challenge to each claim is based;
- Provide a claim construction and show how the construed claim is unpatentable based on the grounds alleged;
- Provide copies of evidence relied upon;
- Certify that the petitioner is not estopped from proceeding;
- Identify lead and backup counsel with contact information; and
- Include required fees

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## Page Limits: Petition, Patent Owner Preliminary Response, and Patent Owner Response

- 80 pages for PGR
- 60 pages for IPR
- Claim charts included in page count, but single spacing is permitted
- Statement of material facts is optional

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## Types of Discovery

- Parties may agree to discovery between themselves
- Discovery divided into 3 types:
  - mandatory initial disclosures;
  - routine; and
  - discretionary

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## Scope of Discovery

- Routine discovery:
  - Cited documents;
  - Cross-examination for submitted testimony; and
  - Information inconsistent with positions advanced during the proceeding
- Discretionary discovery by request upon a showing of:
  - PGR: Good cause
  - IPR: Interests of justice

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## Supplemental Information

- Request for the authorization to file a motion to submit supplemental information must be made within one month after institution
- Must be relevant to a claim for which the trial has been instituted
- Any supplemental information filed later than one month after institution must show why the supplemental information reasonably could not have been obtained earlier and that consideration of the information would be in the interests-of-justice

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## Patent Owner Estoppel

- Patent owner is precluded from taking any action inconsistent with an adverse judgment, including:
  - Obtaining a claim in any patent that is patentably indistinct from a finally refused or canceled claim; or
  - Making an amendment to the specification or a drawing that was denied during the trial, but this provision does not apply to an application or patent that has a different written description

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## Post Grant Review Fees

<b>Service</b>	<b>Fee</b>
Petition challenging 20 or fewer claims	\$ 35,000
Additional claims challenged in excess of 20	\$800 per claim

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## Inter Partes Review Fees

<b>Service</b>	<b>Fee</b>
Petition challenging 20 or fewer claims	\$ 27,200
Additional claims challenged in excess of 20	\$600 per claim

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## Polling Question #3

Do you anticipate filing a petition for a post grant review or an inter partes review against another's patent?

- (a) Yes, likely within the next 6 months
- (b) Yes, likely within the next year
- (c) No, never
- (d) Don't know



## September 2012 Roadshows



Date	Location
Monday, Sept 10	Minneapolis, MN
Wednesday, Sept 12	Alexandria, VA
Friday, Sept 14	Los Angeles, CA
Monday, Sept 17	Denver, CO
Thursday, Sept 20	Detroit, MI
Monday, Sept 24	Atlanta, GA
Wednesday, Sept 26	Houston, TX
Friday, Sept 28	New York, NY



## Appendix

- **Changes to Implement the Inventor's Oath or Declaration Provisions of the Leahy-Smith America Invents Act: Final Rule, 77 Fed. Reg. 48776 (August, 14, 2012)**
- **Changes to Implement Supplemental Examination Provisions of the Leahy-Smith America Invents Act: Final Rule, 77 Fed. Reg. 48828 (August 14, 2012)**
- **Changes to Implement the Preissuance Submissions by Third Party Provisions of the Leahy-Smith America Invents Act: Final Rule, 77 Fed. Reg. 42150 (July 17, 2012)**
- **Changes to Implement Miscellaneous Post Patent Provisions of the Leahy-Smith America Invents Act: Final Rule, 77 Fed. Reg. 46615 (August 6, 2012)**

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## Appendix (cont.)

- **General Administrative Trial Final Rules, 77 Fed. Reg. 48612 (August 14, 2012)**
- **Trial Practice Guide, 77 Fed. Reg. 48756 (August 14, 2012)**
- **Inter Partes, Post Grant, and Covered Business Method Review Final Rules, 77 Fed. Reg. 48680 (August 14, 2012)**
- **Covered Business Method and Technological Invention Definitions Final Rules, 77 Fed. Reg. 48734 (August 14, 2012)**

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# Questions?

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# Thank You



Janet Gongola  
Patent Reform Coordinator  
Janet.Gongola@uspto.gov



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Equity Based License Agreements  
Financial Conflicts of Interest  
Marketing: Whether By Traditional or Social Media, the Value  
Need to Know Basics of Technology Transfer for Support Staff  
Negotiation of License Agreements  
Nuts and Bolts for Compliance Under Federal Funding Awards  
The Basics of Open Source Licensing  
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