



AMERICA INVENTS ACT

IMPLEMENTATION

Reference Guide to Statutory Provisions and Final Rules Effective on September 16, 2012

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AMERICA INVENTS ACT

IMPLEMENTATION

Inventor's Oath or Declaration

Effective September 16, 2012

**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)**

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Goals

- **Statutory provision and final rules aim to:**
 - streamline patent application filing;
 - simplify the content requirements for an oath/declaration; and
 - offer flexibility on the timing for an oath or declaration



Dates

- Effective date: September 16, 2012
- Applicability dates:
 - Applications filed under 35 U.S.C. 111(a) and 363 on or after September 16, 2012:
 - Changes to:
 - 37 CFR 1.9, 1.12, 1.14, 1.17(g), 1.27, 1.32, 1.33, 1.36, 1.41-1.43, 1.45, 1.46, 1.53(f) and (h), 1.55, 1.56, 1.63, 1.64, 1.66, 1.67, 1.76, 1.78, 1.81, 1.105, 1.131, 1.153, 1.162, 1.172, 1.175, 1.211, 1.215, 1.321, 1.421, 1.422, 1.424, 1.431, 1.491, 1.495(a), (c) and (h), 1.497, 3.31, 3.71, 3.73, and 41.9; and
 - Removal of:
 - 37 CFR 1.47 and 1.432
 - All other changes do not depend on the application filing date.



Definitions

- An inventor's oath or declaration includes:
 - An oath or declaration by an inventor;
 - A substitute statement for a nonsigning inventor, where appropriate, § 1.63(f) and § 1.64(d); and
 - An assignment that contains the oath or declaration statements by an inventor, § 1.63(e)(2).
- The inventor's oath or declaration refers to all the documents collectively executed by or with respect to all inventors.



Definitions (cont.)

- Juristic entity: Includes corporations or other non-human entities created by law and given certain legal rights.
- Obligated assignee: A person to whom the inventor is under an obligation to assign the invention.
- An application data sheet in accordance with § 1.76: Requires that the ADS be signed in compliance with § 1.33(b).



The Applicant

- 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.
- The regulations pertaining to being applicant have been separated from the regulations pertaining to execution of the inventor’s oath or declaration.



The Applicant (cont.)

- Applicant regulations:
 - § 1.41 inventorship;
 - § 1.42 applicant for patent;
 - § 1.43 legal representative;
 - § 1.45 joint inventors; and
 - § 1.46 applicants other than an inventor.
- Execution of oath or declaration regulations:
 - § 1.63 an inventor's oath or declaration or an assignment serving as such; and
 - § 1.64 substitute statement.



The Applicant (cont.)

- Applicants may be persons (§§ 1.42(b), 1.46):
 - To whom the inventor has assigned;
 - To whom the inventor is under an obligation to assign; and
 - Who otherwise show sufficient proprietary interest in the matter.
- A party who has less than the entire right, title, and interest may not on their own make the application for patent.



The Applicant: Assignee, Obligated Assignee

- For an assignee or obligated assignee (§ 1.46(b)(1)):
 - Documentary evidence of ownership should be recorded no later than the date the issue fee is paid, for example:
 - An assignment for an assignee, or
 - An employment agreement for an obligated assignee.



The Applicant: Sufficient Proprietary Interest

- For a person who otherwise shows sufficient proprietary interest in the matter, the applicant must submit a petition including:
 - The fee set forth in § 1.17(g) (\$200);
 - A showing that such person has sufficient proprietary interest; and
 - A statement that making the application is appropriate to preserve the rights of the parties. (§ 1.46(b)(2)).

Note: Such persons are no longer restricted to situations where all the inventors refused to execute or could not be found or reached after diligent effort.



The Applicant: Applicant Data Sheet

- If an application under 35 U.S.C. 111 is made by an assignee, an obligated assignee, or a person who otherwise shows sufficient proprietary interest in the matter:
 - The application must contain an application data sheet specifying in the applicant information section:
 - The assignee;
 - Person to whom the inventor is under an obligation to assign the invention; or
 - Person who otherwise shows sufficient proprietary interest in the matter.



The Applicant: Inventor's Name

- The Office will continue to use the inventor's name for application and patent identification purposes as inventor names tend to provide a more distinct identification than assignee names. (§ 1.5(a))



The Applicant: National Stage Applications

- The applicant for a national stage application is (§ 1.46(b)):
 - The person identified in the international stage as an applicant for the United States.



The Applicant: International Applications

- As in national applications, inventors are no longer the only possible applicants for purposes of the United States in international applications (35 U.S.C. 118)
- Applicant regulations for international applications:
 - § 1.421 applicant for international application;
 - § 1.422 legal representative; and
 - § 1.424 applicants other than an inventor



The Applicant: International Applications (cont.)

- For international applications filed on/after September 16, 2012, an applicant for the purposes of the United States may be:
 - Sole or joint inventors
 - Legal representative of deceased or legally incapacitated inventor
 - Assignee
 - Obligated assignee
 - Person who otherwise shows sufficient proprietary interest
 - Proof of proprietary interest will be required in the U.S. national phase



The Applicant: Correct, Update, or Change Name

- Use is required of a § 1.76 application data sheet to (§ 1.46(c)):
 - Correct the name of the applicant where the name was originally incorrectly given;
 - Update the name of the applicant where the name of the applicant was either not supplied on filing or the name of the applicant has been updated (e.g., company name change); or
 - Change the name of the applicant where there is a new applicant (e.g., application is sold):
 - Requires compliance with § 3.71(b).



The Applicant: Time of Identification

- The applicant need not be identified on filing of the application.
- It is however, advisable to do so:
 - Granting a power of attorney requires that the applicant be identified so that the power can be from the applicant;
 - The Office will not require identification but may presume the identified inventors are the applicant:
 - A change in applicant would require compliance with § 3.71(b).



Grant of Patent

- Where the applicant is other than the inventor, the Office must grant the patent to the real party in interest (35 U.S.C. 118):
 - Unless notified otherwise by the time of payment of the issue fee, the Office will presume that there has been no change in the real party in interest.
(§ 1.46(e))



Name of the Inventor

- 35 U.S.C. 115(a) provides that an application under 35 U.S.C. 111(a) or that commences the national stage under 35 U.S.C. 371:
 - Must include or be amended to include the name of the inventor for any invention claimed in the application.



Name of the Inventor

- Applicants may name the inventor either by use of:
 - A signed application data sheet (ADS) under § 1.76
 - If filed before or with an inventor's oath or declaration; or
 - An executed inventor's oath or declaration
 - If filed before a signed ADS identifying the inventorship.



Name of the Inventor: National Stage Application

- The inventorship of a national stage application under 35 U.S.C. 371 (§ 1.41(e)):
 - May be changed from that set forth in the International Application by the filing of an ADS with the initial submission under 35 U.S.C. 371.
- Otherwise, the inventorship is the same as set forth in the International Application:
 - Including any change effected under PCT Rule 92bis.



Name of the Inventor: Correction, or Change in Order

- Once the names of the inventors are identified via use of a signed ADS or signed inventor's oath or declaration, a request under § 1.48 must be submitted other than in reissue applications (§ 1.48(f)) to:
 - Correct inventorship (addition or deletion);
 - Correct or update the name of an inventor (*e.g.*, misspelling, name change); or
 - Change the order of the names as they would be printed on the face of the patent taken from the ADS or oath or declaration.



Name of the Inventor: Inventorship Correction

- Where the inventorship is to be corrected in a nonprovisional application, the following must be submitted (§ 1.48(a)):
 - An application data sheet for the entire actual inventive entity that identifies each inventor by his or her legal name;
 - The processing fee under § 1.17(i) (\$130); and
 - A § 1.63 oath or declaration or substitute statement will be required for any actual inventor who has not yet executed such an oath or declaration. (§ 1.48(b))



Name of the Inventor: Requirements

- Inventorship corrections no longer require:
 - a statement regarding lack of deceptive intent; or
 - written consent of any assignee.



Name of the Inventor: Examples

- Setting inventorship:
 - Executed declaration filed with the application naming A as an inventor ((preamble, § 1.41(b)):
 - Signed ADS filed a week later naming A and B as the actual inventors
 - Inventorship is set by the executed declaration which named A
 - A § 1.48 request is required to correct inventorship to A and B



Name of the Inventor: Examples

- Executed declaration on filing naming A as an inventor without an ADS:
 - Executed declaration filed a week later naming B as an inventor
 - Inventorship is set by the executed declaration that named A
 - A § 1.48 request is required to correct inventorship if the actual inventorship is other than A, *e.g.*, A and B or B alone.



Name of the Inventor: Recap

- Where the inventor's oath or declaration is supplied on filing of the application, applicant must either:
 - Set forth the entire inventive entity in each oath or declaration; or
 - Supply an application data sheet (ADS) naming the entire inventive entity where the oath or declaration only identifies the executing inventor. § 1.63.
- Where applicant delays submission of an inventor's oath or declaration:
 - Applicant will need to identify the inventive entity (name, residence and mailing address) in an ADS under § 1.76.
 - The ADS may be submitted on filing or in response to a notice to file missing parts.



Inventor's Oath or Declaration

- An inventor's oath or declaration continues to be required (35 U.S.C. 111(a)(2) and 35 U.S.C. 371(c)) and can be supplied as follows:
 - Inventor executes an oath or declaration under § 1.63(a) (35 U.S.C. 115(a)):
 - Filed in the application;
 - Inventor executes an assignment that contains the statements required by § 1.63 (35 U.S.C. 115(e) and § 1.63(e)):
 - Recorded in the Office's assignment database;



Inventor's Oath or Declaration

- A substitute statement can be submitted where an inventor is deceased, legally incapacitated, cannot be found or reached after diligent effort, or refuses to execute, (35 U.S.C. 115(d), § 1.64).
 - An applicant other than an inventor, *e.g.*, an assignee-applicant, cannot file a substitute statement unless one of the above enumerated conditions is met.



Inventor's Oath or Declaration

- Where an exception exists to an inventor executing the oath or declaration, the following parties may execute a substitute statement:
 - For an inventor who refused to execute or cannot be found after diligent effort:
 - An assignee;
 - A party to whom the inventor is under an obligation to assign;
 - A party who otherwise shows sufficient proprietary interest in the matter; or
 - The other joint inventor or inventors.
 - For a deceased or legally incapacitated inventor:
 - The same parties as above, except other inventors; or
 - The legal representative.



Inventor's Oath or Declaration: Time of Submission

- The submission of an inventor's oath or declaration, including a substitute statement, or assignment containing the required statements, may be postponed until the application is otherwise in condition for allowance (§ 1.53(f)(3)) provided:
 - The application is an original non-reissue application
 - An application data sheet under § 1.76 is earlier submitted:
 - Identifying each inventor by his or her legal name; and
 - Providing a mailing address (where mail is customarily received), and residence for each inventor.
- A surcharge will still be required (35 U.S.C. 111(a)(3) and 371(d)).



Inventor's Oath or Declaration: Time of Submission

- The Office will not send a Notice to File Missing Parts of Application where the required fees have been paid, but the inventor's oath or declaration has not been submitted (§ 1.53(f)(3)(ii)):
 - A Notice to File Missing Parts of Application will be sent requiring an ADS or inventor's oath or declaration where neither has been filed with the application.



Inventor's Oath or Declaration: Time of Submission

- Applicants should continue to exercise reasonable diligence in ascertaining the actual inventorship.
- The Office recommends that applicants continue to provide the inventor's oath or declaration on filing or shortly thereafter.
- The longer the delay, the more difficult it may be to obtain an inventor's signature.



Inventor's Oath or Declaration: Time of Submission

- Under 35 U.S.C. 371:
 - Entry into the national stage no longer requires submission of the inventor's oath or declaration. (§1.491(b))
 - Delaying submission of the inventor's oath or declaration may impact patent term adjustment:
 - The 14 month time frame in 35 U.S.C. 154(b)(1)(A)(i)(II) for issuing an Office action under 35 U.S.C. 132 or notice of allowance under 35 U.S.C. 151 is measured from “the date on which an international application fulfilled the requirements of section 371,” which includes the filing of the inventor's oath or declaration. See 35 U.S.C. 371(c)(4).



Inventor's Oath or Declaration: Time of Submission

- The Office cannot issue a Notice of Allowance and Fee(s) Due (PTOL-85) without the proper inventor's oath or declaration. In such case (§ 1.53(f)(3)(ii)):
 - A Notice of Allowability (PTOL-37), without a Notice of Allowance and Fee(s) Due, will be issued (preamble, § 1.53(f)(3)):
 - The time period set in a Notice of Allowability is not extendable.



Inventor's Oath or Declaration: Requirements

- Must contain statements (35 U.S.C. 115(b), § 1.63(a)):
 - Application was made or was authorized to be made by the person executing the oath or declaration.
 - The person executing the oath or declaration believes himself or herself to be the original inventor or an original joint inventor of a claimed invention in the application.



Inventor's Oath or Declaration: Requirements

- **Must Identify:**
 - The application to which it is directed.
 - At least the inventor who is executing the oath or declaration by his or her legal name.
- A claim for foreign priority under § 1.55(a)(1)(i) must be set forth in an application data sheet:
 - Presence of the priority claim in the oath or declaration will not be recognized.



Inventor's Oath or Declaration: Requirements

- The entire inventive entity and the mailing address for each inventor need not be identified (§ 1.63(b)):
 - If a signed ADS, § 1.76, is used to identify each inventor with his or her legal name and a mailing address for each inventor is given.



Inventor's Oath or Declaration: Requirements

- Residence and mailing address:
 - Mailing address is clarified to mean where an inventor customarily receives mail:
 - Includes where the inventor works, or a post office box, preamble § 1.63(b).
- No longer required:
 - Identification of an inventor's citizenship
 - That the inventor believes himself or herself to be the "first" inventor.



Inventor's Oath or Declaration: Requirements

- The oath or declaration is no longer required to state that the person making the oath or declaration:
 - acknowledges the duty of disclosure under § 1.56, and
 - has reviewed and understands the contents of the application.
- However, § 1.63(c) requires that a person may not execute an oath or declaration unless the person: (1) is aware of the duty to disclose all information known to be material to patentability, and (2) has reviewed and understands the contents of the application.



Inventor's Oath or Declaration: Requirements for Declaration

- Penalty clause has changed:
 - Requires an acknowledgement (35 U.S.C. 115(i), § 1.63(g)):
 - Any willful false statement is punishable under section 1001 of title 18 by fine or imprisonment of not more than 5 years, or both.
- Eliminates the statement that all statements are true and that all statements made on information and belief are believed to be true.



Inventor's Oath or Declaration: Requirements: Alterations

- Interlineation, erasure, cancellation, or other alteration to application papers may be made before or after signing of the oath or declaration (§ 1.52(c)):
 - Provided the statements made in the oath or declaration remain applicable to the altered application papers, *e.g.*,:
 - Correction of obvious typographical errors.

Note: A substitute specification may be required.



Inventor's Oath or Declaration: Requirements

- National Stage applications:
 - Requirements for the inventor's oath or declaration are set forth in § 1.497
 - § 1.497(b) sets forth minimum requirements to satisfy 35 U.S.C. 371(c)(4)
 - Important for PTA 14-month trigger (35 U.S.C. 154(b)(1)(A)(i)(II))
 - Must still comply with requirements of § 1.63 (§1.497(a) and (c))



Substitute Statement: Requirements

- Comply with the requirements of § 1.63(a);
- Identify the inventor with respect to whom the statement applies;
- Identify the person executing the substitute statement and the relationship to the nonsigning inventor;
- Identify the permitted basis:
 - Whether the inventor is deceased, legally incapacitated, cannot be found after diligent effort or refuses to execute.
- Contain the acknowledgement of penalties clause. (§ 1.64(e))



Substitute Statement: Requirements

- Unless supplied in an application data sheet, § 1.76:
 - The legal name of each inventor; and
 - Last known mailing address and residence of:
 - The person executing the substitute statement, and
 - Of the nonsigning inventor, unless deceased or legally incapacitated.



Substitute Statement: Requirements

- A person may not execute a substitute statement unless that person:
 - Has reviewed and understands the contents of the application, including the claims; and
 - Is aware of the duty to disclose to the Office all information known to the person to be material to patentability as defined in § 1.56.



Substitute Statement: Requirements

- A petition is not required for an assignee or an obligated assignee to be considered the applicant or to execute the substitute statement:
 - A petition is required for a person who otherwise shows sufficient proprietary interest in the matter.
 - Proof of a refusal to execute or that the inventor cannot be found or reached after diligent effort is no longer required.



Substitute Statement: Publication of Application

- The Office will no longer publish notice in the *Official Gazette* of the filing of an application by parties other than the inventor, except where:
 - An application is filed by a person who otherwise shows sufficient proprietary interest in the matter.
(§ 1.14(f))



Substitute Statement: Joining of Nonsigning inventor

- A nonsigning inventor may subsequently join in the application by submitting an oath or declaration (§ 1.64(f)):
 - Such submission will not permit the nonsigning inventor or legal representative to revoke or grant a power of attorney.



Assignment-Statements

- An assignment may also serve as an oath or declaration under § 1.63 if the assignment as executed:
 - Includes the information and statements required in § 1.63(a) and (b); and
 - A copy of the assignment is recorded in the Office's assignment database. (§ 1.63(e)(1)(ii))



Assignment-Statements: Paper Submissions

- For a paper submission of a dual purpose assignment along with an application:
 - Utilize a conspicuous indication on the assignment cover sheet (§ 3.31):
 - So the Office will know to scan the assignment into the application file before forwarding the assignment for recording to the Assignment Recordation Branch.



Assignment-Statements: EFS-Web Submissions

- EFS-Web does not accept assignments for recording purposes. (See the EFS-Web Legal Framework, section B2.)
- For an EFS-Web submission of a dual purpose assignment, either with or after an application has been filed, the Office:
 - Will place the assignment in the application file; but
 - Will not forward the assignment to Assignment Recordation Branch for recordation.



Assignment-Statements: EPAS

- Recording of assignments may only be done electronically in EPAS (Electronic Patent Assignment System).
- For EPAS submissions of a dual purpose assignment:
 - If there is a conspicuous indication on the cover sheet (e.g., check-box is used), the Office will place a copy of the assignment in the related application file.



Supplemental Oath or Declaration

- The Office will not require a supplemental oath or declaration, or equivalent statement. (35 U.S.C. 115(h)(2), § 1.67(c))
- The Office may require a new oath or declaration to correct a deficiency in an original oath or declaration:
 - Such as failure to comply with a statutory requirement.



Supplemental Oath or Declaration

- An applicant may withdraw, replace, or otherwise correct an inventor's oath or declaration at any time (35 U.S.C. 115(h)(1), § 1.63(h), § 1.67):
 - Correction of deficiencies or inaccuracies due to the failure to meet the requirements of § 1.63(b):
 - May be made by an application data sheet, § 1.76.
 - Where correction is being made by a supplemental oath or declaration:
 - It must be executed by the person whose oath or declaration is being corrected. (§1.67(b))



Supplemental Oath or Declaration (cont.)

- Does not permit:
 - New matter to be introduced in the application; or
 - Inventorship to be corrected other than by § 1.48.
- If filed after the mailing of a notice of allowance, the oath or declaration will generally not be reviewed.



Continuing Applications: Copy of Oath or Declaration

- A copy of an inventor's oath or declaration, including a substitute statement or assignment-statement, from a prior application in a benefit chain under 35 U.S.C. 120, 121, or 365(c) in compliance with § 1.78:
 - may be used in continuing applications, including continuation-in-part applications.
(35 U.S.C. 115(g)(1), § 1.63(d))
 - the prior oath or declaration must, however, be compliant with amended 35 U.S.C. 115(a).
(35 U.S.C. 115(g)(1)(A))
- Any new joint inventor must provide an oath or declaration. (§ 1.63(d)(3))



Continuing Applications: Inventorship

- The inventorship in a continuing application filed under 35 U.S.C. 111(a) is (§ 1.63(d)(2)):
 - That specified in an ADS filed before or concurrently with the copy of the inventor's oath or declaration from the earlier-filed application; or
 - What is set forth in the copy of the oath or declaration if there is no ADS, unless
 - The copy is accompanied by a statement signed pursuant to § 1.33(b) stating the name of each inventor in the continuing application.



Application Data Sheets

- Clarified that an ADS may be submitted in a national stage application under 35 U.S.C. 371 (as well as in provisional and nonprovisional applications under 35 U.S.C. 111).
- An ADS must be submitted when required by § 1.55 or § 1.78 to claim priority to or the benefit of a prior-filed application under 35 U.S.C. 119, 120, 121 or 365.
- If an application under 35 U.S.C. 111 is made by a person other than the inventor under § 1.46(a), an ADS must be submitted specifying the applicant.



Application Data Sheets

- Correcting or updating information is done by a new ADS (§ 1.76(c)(1)):
 - Such an ADS is no longer considered a “Supplemental ADS.”
- A corrected or updated ADS may include:
 - All sections listed in § 1.76(b), or
 - Only those section containing changed or updated information (§ 1.76(c)(2)):
 - All information in the section must be provided, with identification of what has changed in the section, except for an initial 35 U.S.C. 371 submission:
 - Underling for insertions, strike-through or brackets for deletions.



Application Data Sheets

- An ADS must be signed by applicant or a patent practitioner (§ 1.76(e)):
 - If unsigned, treated only as a transmittal letter.
- The most recent ADS will govern with respect to foreign priority (§ 1.55) or domestic benefit (§ 1.78) claims.
- The naming of inventorship is governed by § 1.41:
 - With changes thereto governed by § 1.48.
- A properly executed ADS may now include an Authorization to Permit Access to Application by Participating Offices.



Priority and Benefit Claims

- A claim for foreign priority under § 1.55(a)(1)(i) must be set forth in an application data sheet:
 - Presence of the priority claim in the oath or declaration will not be recognized.
- A claim for domestic benefit under § 1.78 must be set forth in an application data sheet:
 - Presence of the benefit claim in the first sentence(s) of the specification will not be recognized.



Powers of Attorney

- **Must be signed by the applicant for patent (§ 1.42) or the patent owner.**
 - An assignee, obligated assignee, or person who otherwise shows sufficient proprietary interest in the matter applying for the patent may sign the power of attorney (no § 3.73(c) statement must be filed).
- **Inventors who are not the applicant may not sign the power of attorney.**
- **A combined inventor declaration and power of attorney should not be used.**



Powers of Attorney: From Inventors

- The grant of a request to correct the inventorship by addition of an inventor results in loss of any power of attorney given by the prior inventors unless (§ 1.32(e)):
 - The added inventor provides a power consistent with the power granted by the originally named inventors.
- Where an added inventor does not provide a power of attorney:
 - A practitioner may act in a representative capacity under § 1.34, if applicable.



Powers of Attorney: Copies from Prior Applications

- The power of attorney from a prior national application may have effect in a continuing application claiming benefit to the prior application if a copy of the power is provided in the continuing application, unless:
 - The power in the prior application was granted by the inventor, and
 - The continuing application names an inventor who was not named as an inventor in the prior application.



Powers of Attorney: Prosecution by Assignee

- The assignee of the entire right, title and interest, or partial assignees and inventors who have not assigned who together own the entire right title and interest, may conduct prosecution of a (§ 3.71(a)):
 - National patent application as the applicant under § 1.46;
 - Supplemental examination; or
 - Reexamination proceeding.



Powers of Attorney: Prosecution by Assignee

- An assignee who is the original applicant need not resort to §§ 3.71 and 3.73 to conduct prosecution, such as by appointing a power of attorney.
- An assignee who is not the original applicant must comply with § 1.46(c) to become the applicant and establish its ownership pursuant to § 3.73(c):
 - If more than one assignee exists, each assignee either:
 - Establishes its extent of ownership (by percentage), or
 - Submits a statement identifying the parties who together own the entire right, title and interest.



Powers of Attorney: Prosecution by Assignee

- If two purported assignees file conflicting statements under § 3.73(c), the Director will determine which, if any, will be permitted to control prosecution of the application.
- The submission establishing ownership must be signed by a person authorized to act on behalf of the assignee:
 - For patent matters only, a submission signed by a practitioner of record is now identified as also acceptable. (§ 3.73(d)(3))



Correspondence Address

- Where multiple correspondence addresses are supplied either in a single document or in multiple documents (e.g., on filing of an application) (§ 1.33(a)):
 - The Office may select the address associated with a Customer Number over a typed correspondence address.



Correspondence Address

- The ability to change a correspondence address by various parties is no longer dependent upon whether an oath or declaration has been filed.
- A correspondence address may now be changed at any time by (§ 1.33(a)):
 - A patent practitioner of record, or
 - The applicant (§ 1.42).



Correspondence Address

- After a patent issues (§ 1.33(g)):
 - A patent practitioner acting in a representative capacity whose correspondence address is the correspondence address of record in the application:
 - May change the correspondence address, provided the change is accompanied by a statement that notice has been given to the patentee or owner.



Correspondence Address

- Where the correspondence address was changed during the prosecution of a prior application (§ 1.33(f)):
 - The correspondence address for a continuing application must be supplied in an ADS or separate paper.
 - This is important where application papers from a prior application are used in the continuing application (e.g., an oath or declaration that sets forth the previous correspondence address).



Juristic Entities

- Juristic entities who seek to prosecute an application, including taking over prosecution (§§ 1.31 and 1.33(b)(3)):
 - Must be represented by a patent practitioner.
- Juristic entities can continue to take actions, such as:
 - Executing terminal disclaimers; and
 - Executing statements under § 3.73(c).



Reissue Applicants

- The reissue applicant is the original patentee, or the current patent owner if there has been an assignment.
- The assignee of the entire interest may now be the applicant of a reissue:
 - Including a broadening reissue where (35 U.S.C. 251, § 1.172):
 - The application for the patent being reissued was filed by the assignee of the entire interest.



Execution of the Reissue Oath or Declaration

- The assignee of the entire interest may sign the inventor's oath or declaration for a reissue application where:
 - The reissue is not a broadening reissue (§ 1.175(c)(1));
or
 - The reissue is a broadening reissue, if the application for the original patent was filed under § 1.46 by the assignee of the entire interest. (§ 1.175(c)(2))



Reissue Oaths or Declarations: Requirements

- Reissue oaths or declarations:
 - A statement that all errors arose without any deceptive intent is no longer required;
 - A supplemental reissue oath or declaration stating that all errors arose without any deceptive intent is no longer required where an amendment is made:
 - A new oath or declaration would still be required where there is a failure to:
 - identify any error, or
 - at least one error of the type that would support a reissue.



Reissue Oaths or Declarations: Requirements

- Where the previously identified errors are no longer being relied upon as the basis for reissue (§ 1.175(d)):
 - A supplemental oath or declaration is no longer required:
 - But applicant must still identify an error being relied upon as the basis for reissue, such as in the remarks of an amendment.



Reissue Oaths or Declarations: Submission

- The ability to delay submission of an inventor's oath or declaration until a Notice of Allowability issues:
 - Does not apply to reissue oaths or declarations, § 1.175(e).
- The oath or declaration must be present before a reissue application will be examined.
- An oath or declaration filed at any time will be placed in the file record (§ 1.175(g)):
 - But may not be reviewed.



Broadened Reissues

- It is clarified that a claim broadened in any respect must be treated as a broadened claim:
 - Even though the claim may be narrowed in another respect.
- The inventor's oath or declaration must identify a claim (not all claims) that the application seeks to broaden.



Continuing Reissue

- A continuing reissue may utilize a copy of an inventor's oath or declaration from an earlier-filed reissue application provided (§ 1.175(f)):
 - Each inventor executed an inventor's oath or declaration for the earlier-filed reissue application (except as provided for in § 1.64);
 - The continuing reissue application does not seek to enlarge the scope of the claims of the original patent; or
 - The application for the original patent was filed under § 1.46(b) by the assignee of the entire interest.



Continuing Reissue

- A copy of an oath or declaration from a prior reissue application may not be used where all of the following conditions exist:
 - The oath or declaration for the earlier-filed reissue application was executed by the patent owner;
 - The continuing reissue application seeks to enlarge the scope of the claims of the original patent; and
 - The application for the original patent was not filed under § 1.46 by the assignee of the entire interest.



Miscellaneous

- An executed oath or declaration is no longer required for publication of the application (§ 1.211):
 - The Office may delay publication until the application includes an oath or declaration or ADS containing the information required in § 1.63(b).
- The “without deceptive intention” requirements have been eliminated from requests to correct inventorship in:
 - Applications (§ 1.48);
 - Patents (§ 1.324); and
 - *Ex parte* and *inter partes* reexaminations (§ 1.530).



Miscellaneous: Small Entity Status

- A written assertion of entitlement to small entity status can be signed by (§ 1.27(c)(2)):
 - The applicant;
 - A patent practitioner of record or acting in a representative capacity;
 - An inventor or joint inventor only if the inventor is the applicant; or
 - The assignee of the entire right, title and interest.
- Written assertions can no longer be signed by:
 - An inventor who is not an applicant, or
 - A partial assignee.



Miscellaneous: Credit Card Payments

- Credit card payments, not being made via the Office's electronic filing systems (e.g., EFS-Web), may only be submitted with:
 - An original handwritten signature;
 - That is personally signed; and
 - In permanent dark ink or its equivalent.(§ 1.4(e)(2))
- An S-signature (§ 1.4(d)(2)) may no longer be used for such payments.
- Facsimile transmission to the Central Facsimile Number is a paper submission.



Miscellaneous: National Stage

- An application submission containing conflicting indications as between an application under 35 U.S.C. 111 and a submission to enter the national stage under 35 U.S.C. 371 will be treated as a submission to enter the national stage under 35 U.S.C. 371. (§ 1.495(g))



Miscellaneous: New Forms

- Declaration forms for use with an ADS:
 - Utility or Design Application: PTO/SB/AIA01
 - Plant Application: PTO/SB/AIA03
- Substitute Statement:
 - Utility or Design Application: PTO/SB/AIA02
 - Plant Application: PTO/SB/AIA04
 - Supplemental Sheet: PTO/SB/AIA11



Miscellaneous: New Forms (cont.)

- Reissue Application Forms:
 - Declaration by the Inventor: PTO/SB/AIA05
 - Declaration by the Assignee: PTO/SB/AIA06
 - Substitute Statement: PTO/SB/AIA07
- Declaration forms for use without an ADS:
 - Utility or Design Application: PTO/SB/AIA08
 - Plant Application: PTO/SB/AIA09
 - Supplemental Sheet for Declaration: PTO/SB/AIA10
- Use of an ADS, and forms that utilize an ADS, is strongly recommended.



Key Changes from Proposed Rules

- The Final Rule includes significant changes over what was proposed to provide increased flexibility in regard to:
 - Who may be the applicant; and
 - The requirements of an inventor's oath or declaration and when it must be submitted.





AMERICA INVENTS ACT

IMPLEMENTATION

Supplemental Examination

Effective September 16, 2012

Changes to Implement Supplemental Examination
Provisions of the Leahy-Smith America Invents Act: Final
Rule, 77 Fed. Reg. 48828 (August 14, 2012)

Contents

- Goals
- 35 U.S.C. 257
- Inequitable Conduct Immunization
- Filing of Papers
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- Request Requirements
- Optional Request Requirements
- Filing Date of Request
- Format of Papers
- Conduct of Proceeding
- Conclusion of Proceeding
- Publication of Certificate
- Procedure After Conclusion
- Material Fraud
- Key Changes from Proposed Rules



Supplemental Examination Goals

- Provide patentees with an alternative to litigating inequitable conduct allegations
- Create a process that allows completion within the 3-month statutory time frame, and prompt resolution of any *ex parte* reexamination
- Avoid a post-patent process involving large submissions of unexplained documents (like IDS practice)



Supplemental Examination

35 U.S.C. 257

- New 35 U.S.C. 257 provides that 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, the Office must decide whether any of the items of information filed with the request raises a substantial new question of patentability. (35 U.S.C. 257(a); § 1.620(a))



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.



Filing of Papers

- Request for supplemental examination must be filed by owner(s) of the entire right, title, and interest in the patent. (§ 1.601(a)).
 - The scope of the patent claims may be changed (e.g., by cancellation or amendment) during any reexamination resulting from a supplemental examination proceeding.
 - The change in scope will be binding on all parties having an ownership interest in the patent.



Filing of Papers

- A request may be filed:
 - on or after Sept. 16, 2012; and
 - at any time during the period of enforceability of the patent. (§ 1.601(c))
- Third party may not request supplemental examination or participate in a supplemental examination. (§ 1.601(b)).



Item of Information Limit

- The request may not include more than twelve items of information. § 1.605(a).
- More than one request for supplemental examination of the same patent may be filed at any time during the period of enforceability of the patent.
 - USPTO must be able to make a timely decision whether to order *ex parte* reexamination



Items of Information

- “An item of information” includes a document containing information that the patent owner requests the Office to consider, reconsider, or correct. (§ 1.605(b)).
- Information that forms the basis of the request is not limited to patents and printed publications.
- Any information believed to be relevant to the patent may be submitted, such as transcripts of audio or video recordings, etc.



Counting Items of Information

- An item of information must be in writing. Any audio or video recording must be filed in the form of a written transcript. (§ 1.605(c)).
- If an item of information is combined in the request with one or more additional items of information, each item of information of the combination may be separately counted. (§ 1.605(d)).
 - For example:

If a patent owner requests the Office to consider the patentability of the claims in view of a combination of reference A and reference B, reference A and reference B may be separately counted, resulting in two items of information.



Counting Items of Information

- Any one item of information may raise multiple issues of patentability. For example:
 - A document, which raises issues under 35 U.S.C. 101 and also under 35 U.S.C. 112 with respect to the original disclosure, will be counted as one item of information.
- The Office will count the number of items of information, but will not count the number of issues raised by any one item.



Counting Items of Information

- If the information is not, at least in part, contained within or based on any document filed with the request, the discussion within the body of the request relative to the information will be considered to be an “item of information”. (§ 1.605(b)).
 - For example:

If a discussion of a potential application of 35 U.S.C. 101 to patent claim 1 is wholly contained within the body of the request and is not based, at least in part, on any supporting document, then the discussion in the request will be considered as an item of information.



Counting Items of Information

- The counting of an item of information may not be avoided by inserting the content of the supporting document within the body of the request.

– For example:

If an image of a supporting document, such as an e-mail, is provided in the body of the request, a separate copy of the supporting document must be filed as an item of information.



Counting Items of Information

- If the discussion within the body of the request is based, at least in part, on a supporting document, then the supporting document, and not the discussion within the request, will be considered as an item of information.

– For example:

If the patent owner discusses in the request a potential public use or sale of the claimed invention, and also submits a supporting document with the request as possible evidence of the public use or sale, or the lack thereof, then the supporting document, and not the discussion within the body of the request, will be considered as the item of information.



Counting Items of Information

- A declaration or affidavit may be counted as an item of information.
 - If the declaration presents one item of information, such as information regarding erroneous data presented during the prior examination with respect to an issue under 35 U.S.C. 103 affecting claim 10 of the patent, and relies on, or refers to, a single exhibit such as a new table of data to support facts presented in the declaration, then the declaration and the single supporting exhibit may be counted together as one item of information.



Counting Items of Information

- If the declaration presents two separate and distinct items of information, then each item of information may be counted separately. For example:
 - If a declaration presents information relating to a potential ground under 35 U.S.C. 101 affecting patent claim 1, and also presents information relating to erroneous facts or data presented during the prior examination of the patent with respect to an issue under 35 U.S.C. 103 affecting patent claim 1, then each item of information within the declaration may be counted separately, resulting in two items of information.



Counting Items of Information

- If the declaration relies on, or refers to, two separate and distinct exhibits, then each exhibit may be counted separately, resulting in two items of information. For example:
 - A declaration that refers to two separate and distinct sales receipts as evidence of a potential sale of the invention, such as a sales receipt dated March 2011 and a second, separate sales receipt dated October 2011, which provides evidence of a second, separate sale of the invention, may be counted as two items of information -- one item consisting of the declaration and one sales receipt, and the second item consisting of the second sales receipt.



Counting Items of Information

- Cumulative items of information may be separately counted.
- When considering the submission, as items of information, of multiple documents that are believed to be cumulative, the Office recommends the selection of one or two of the documents as the items of information that will be submitted with the request.



Fees

- A request for supplemental examination must include payment of the following fees:

Service	Cost
Filing fee (for processing and treating a request for supplemental examination)	\$ 5140
Reexamination fee (for ex parte reexamination ordered as a result of supplemental examination)	\$16,120
TOTAL	\$21,260
REFUND (if the Office decides not to order an ex parte reexamination proceeding)	\$16,120

- Plus any applicable document size fees for processing and treating, in a supplemental examination proceeding, a non-patent document over 20 sheets in length



Request Requirements

The request must also include:

- An identification of the number of the patent for which supplemental examination is requested.
(§ 1.610(b)(1))
- An identification of each claim of the patent for which supplemental examination is requested.
(§ 1.610(b)(4))



Request Requirements

- An identification of the owner(s) of the entire right title, and interest in the patent requested to be examined. (§ 1.610(b)(9))
- A submission by the patent owner in compliance with § 3.73(c) establishing the entirety of the ownership in the patent requested to be examined. (§ 1.610(b)(9))



Request Requirements

- A list of the items of information that are requested to be considered, reconsidered, or corrected. Where appropriate, the list must meet the requirements of § 1.98(b). (§ 1.610(b)(2))
 - If the item of information is a discussion within the body of the request as set forth in § 1.605(b), the pages of the request on which the discussion appears, and a brief description of the item of information, such as “discussion in request of why claims are patentable under 35 U.S.C. 101, pages 7-11” must be listed.



Request Requirements

- A list identifying any other prior or concurrent post-patent Office proceedings involving the patent for which supplemental examination is requested (§ 1.610(b)(3)), including :
 - The type of proceeding (*e.g.*, a reissue application, or an *ex parte* or *inter partes* reexamination, supplemental examination, post-grant review, or *inter partes* review proceeding);
 - The identifying number (*e.g.*, control number or reissue application number); and
 - The filing date of the proceeding.



Request Requirements

- A separate, detailed explanation of the relevance and manner of applying each item of information to each claim of the patent for which supplemental examination is requested. (§ 1.610(b)(5))
 - Comparable to request requirement for *ex parte* reexamination
 - To meet this requirement, the patent owner should consider the guidance set forth in MPEP § 2214, which governs *ex parte* reexamination.



Request Requirements

- A legible copy of the patent for which supplemental examination is requested, and a copy of any disclaimer or certificate issued for the patent. (§ 1.610(b)(6))
 - A “certificate issued for the patent” includes, *e.g.*, a certificate of correction, a certificate of extension, a supplemental examination certificate, a post-grant review certificate, an *inter partes* review certificate, an *ex parte* reexamination certificate, and/or an *inter partes* reexamination certificate issued for the patent.



Request Requirements

- A legible copy of each item of information including:
 - A written English language translation of all of the necessary and pertinent parts of any non-English language document. (§ 1.610(b)(7))
- Copies of U.S. patents and patent application publications are not required, but are encouraged to be submitted.
- Items of information that form part of the discussion within the body of the request as specified in § 1.605(b) are not required to be submitted.



Request Requirements

- A summary of the relevant portions of any submitted document (including patent documents), other than the request, that is over 50 pages in length. § 1.610(b)(8).
 - The summary must include citations to the particular pages containing the relevant portions.
 - Redaction of lengthy documents is encouraged, unless the redaction would remove the context of the relevant portions.



Optional Request Components

- The request may optionally include the following: (§ 1.610(c)(1)-(4)):
 - A cover sheet itemizing each component submitted as part of the request (§ 1.610(c)(1));
 - A “component” may be a certificate of mailing, a transmittal sheet, the request itself, a copy of the patent to be examined or of an item of information, a § 3.73(c) submission, and any other separate document that is deposited with or as part of the request.



Optional Request Components

- A table of contents for the request (§ 1.610(c)(2));
- An explanation of how the claims are patentable over an item of information (§ 1.610(c)(3)); and
- An explanation of why each item of information submitted as part of the request does or does not raise a substantial new question of patentability (§ 1.610(c)(4)).



Filing Date of Request

- A request will not be granted a filing date if it is not in compliance with all of the requirements for the request, including the requirements for the number of items of information, and for the content and formatting of the request. (§ 1.610(d))
 - The granting of a filing date is subject to the discretion of the Office. For example, a filing date may be granted to a request if the only defect in the request is the presence of improper margins, but the text is legible and reproducible.



Filing Date of Request

- If the Office determines that the request, as originally submitted, is not entitled to a filing date, the patent owner will be notified and will be given an opportunity to complete the request within a specified time. (§ 1.610(d))
 - A procedure is being established in which the request, and any other papers or information submitted as part of or accompanying the request, will not be available in Public PAIR until the request is granted a filing date.



Filing Date of Request

- If, in response to the notice informing the patent owner that the request is not entitled to a filing date, the patent owner does not timely file a corrected request that complies with all of the requirements of the request as set forth in §§ 1.605, 1.610, and 1.615 , then:
 - the request will not be granted a filing date,
 - the processing of the request will be terminated, and
 - the fee for reexamination will be refunded. § 1.610(d).



Filing Date of Request

- If, in response to the notice, the patent owner timely files a corrected request that properly addresses all of the defects set forth in the notice, and that otherwise complies with all of the requirements of the request as set forth in §§ 1.605, 1.610, and 1.615, then **the filing date of the request will be the receipt date of the corrected request.** (§ 1.610(d))



Format of Papers

- All papers filed in a supplemental examination proceeding must be formatted in accordance with § 1.52. (§ 1.615(a))
- Court documents and non-patent literature may be redacted, but must otherwise be identical both in content and in format to the original documents. If a court document, it must otherwise be identical to the document submitted to the court. (§ 1.615(b))



Format of Papers

- Court documents and non-patent literature must not be reduced in size or modified (other than by redaction), particularly in terms of font type, font size, line spacing, and margins.
- Patents, patent application publications, and third-party-generated declarations must not be reduced in size or modified in the manner described above.



Conduct of Proceeding

- Within 3 months from the filing date of the request, the Office will determine whether any of the item(s) of information filed with the request raises a substantial new question of patentability affecting a claim of the patent.
- The determination will be:
 - Based on the claims in effect at the time of the determination, and
 - Generally limited to a review of the item(s) of information identified in the request as applied to the identified claim(s) of the patent.



Conduct of Proceeding

- The standard will be the similar to the standard for *ex parte* reexamination (see, e.g., MPEP 2242):
 - Whether there is a substantial likelihood that a reasonable examiner would consider the item of information important in determining patentability.



Conduct of Proceeding

- The Office may hold in abeyance an action on any filing date petition or other paper filed in a supplemental examination proceeding until after the proceeding is concluded by the electronic issuance of the supplemental examination certificate. (§ 1.620(b))
 - The Office will determine whether:
 - the request is entitled to a filing date; and
 - any of the items of information submitted with the request raise a substantial new question of patentability.



Conduct of Proceeding

- If an unauthorized or otherwise improper paper is filed in a supplemental examination proceeding, it will not be entered into the official file or considered, or if inadvertently entered, it will be expunged. (§ 1.620(c))



Conduct of Proceeding

- Upon the discovery of any prior or concurrent post-patent Office proceeding involving the patent for which supplemental examination is requested, the patent owner must file a paper limited to notice of the post-patent Office proceeding, if not previously provided with the request. § 1.620(d).
 - The notice must not include a discussion of the issues of the current supplemental examination proceeding or of the identified post-patent Office proceeding(s).



Conduct of Proceeding

- The notice of any other prior or concurrent post-patent Office proceeding will be limited to the identification of the post-patent proceeding, including:
 - the type of proceeding (*e.g.*, a reissue application, or an *ex parte* or *inter partes* reexamination, supplemental examination, post-grant review, or *inter partes* review proceeding);
 - the identifying number, (*e.g.*, a control number or application number); and
 - the filing date of any such proceeding(s). (§ 1.620(d))



Conduct of Proceeding

- Interviews are prohibited in a supplemental examination proceeding. § 1.620(e).
- Telephone calls to confirm receipt of the request, or to discuss general procedural questions, are not considered to be interviews for the purpose of this provision.
- The prohibition only applies to supplemental examination proceedings. Interview practice for any *ex parte* reexamination ordered as a result of the supplemental examination proceeding will be governed by the regulations governing *ex parte* reexamination proceedings. See, e.g., § 1.560.



Conduct of Proceeding

- No amendment may be filed in a supplemental examination proceeding. (§ 1.620(f))
- If *ex parte* reexamination is ordered, an amendment may be filed after the issuance of the initial Office action in the *ex parte* reexamination proceeding. An amendment may not be filed prior to the initial Office action.



Conclusion of Proceeding

- The supplemental examination proceeding will conclude with the electronic issuance of the supplemental examination certificate. § 1.625(a).
- The certificate will indicate the result of the Office's determination whether any item of information filed with the request raises a substantial new question of patentability.



Conclusion of Proceeding

- The certificate will be electronically issued in the Office image file wrapper (IFW) and the Patent Application Retrieval (PAIR) systems within three months of the filing date of the request, and will be viewable by the public in Public PAIR.



Publication of Certificate

- If the supplemental examination certificate states that no substantial new question of patentability is raised by any of the items of information in the request:
 - *ex parte* reexamination will not be ordered;
 - the electronically-issued supplemental examination certificate will be published as part of the patent by the Office's patent publication process; and
 - The reexamination fee for supplemental examination will be refunded. (§ 1.625(c))



Publication of Certificate

- If the supplemental examination certificate states that a substantial new question of patentability is raised by one or more items of information in the request:
 - *ex parte* reexamination will be ordered;
 - upon the conclusion of the resulting *ex parte* reexamination proceeding, an *ex parte* reexamination certificate, which will include a statement specifying that *ex parte* reexamination was ordered under 35 U.S.C. 257, will be published as part of the patent by the Office's patent publication process; and
 - the electronically issued supplemental examination certificate will remain as part of the public record of the patent. § 1.625(b).



Procedure After Conclusion

- Any *ex parte* reexamination ordered as a result of a supplemental examination proceeding will be conducted in accordance with the regulations governing *ex parte* reexamination proceedings (§§ 1.530 – 1.570), except that:
 - the patent owner will not have the right to file a patent owner statement under § 1.530, and the order will not set a time period to file such a statement (§ 1.625(d)(1));
 - reexamination of any patent claim may be conducted on the basis of any item of information, and is not limited to patents and printed publications or to subject matter added or deleted during reexamination (§ 1.625(d)(2));



Procedure After Conclusion

- issues in addition to those raised by patents and printed publications, and by subject matter added or deleted during a reexamination proceeding, may be considered and resolved (§ 1.625(d)(3)); and
- information material to patentability will be defined by § 1.56(b) for the purposes of a supplemental examination proceeding, and for any resulting *ex parte* reexamination proceeding. (§ 1.625(d)(4))



Procedure After Conclusion

- Any reference to “applicant” in § 1.56(b) will be read as “patent owner.”
- The material to patentability standard under § 1.56(b) is used because the standard applicable to *ex parte* reexamination (§ 1.555(b)) is limited to patents and printed publications.



Material Fraud

- If the Office becomes aware of a material fraud on the Office in connection with the patent under supplemental examination, then the matter will confidentially be referred to the U.S. Attorney General. § 1.620(g).
- The Office may take other action as set forth in 35 U.S.C. 257(e).
- The Office regards “material fraud” to be narrower in scope than inequitable conduct.



Key Changes from Proposed Rules

Final Rule

Items of information considered increased to 12

Content requirements have been significantly streamlined, and are comparable to requirements for a request for *ex parte* reexamination

Request may be filed at any time during the enforceability of the patent

Proposed Rule

Items of information considered limited to 10

Content requirements were considered burdensome

Request may be filed at any time





AMERICA INVENTS ACT

IMPLEMENTATION

Preissuance Submissions

Effective September 16, 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)

Contents

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- Examiner Consideration
- Electronic Filing
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- Key Changes from Proposed Rules



Preissuance Submissions Goals

- Statutory provision aims to improve the quality of examination and issued patents
- Final rule is designed to:
 - Promote efficient processing of submissions; and
 - Promote focused submissions of the most relevant documents



Preissuance Submissions

35 U.S.C. 122(e)

- Allows any third party to submit for consideration and inclusion in the record of a patent application
 - Any patent, published patent application, or other printed publication of potential relevance to the examination of the application
- Must be timely made in writing and include:
 - Concise description of the asserted relevance of each document submitted;
 - Fee prescribed by the Director; and
 - Statement of compliance with 35 U.S.C. 122(e)



Preissuance Submissions

35 U.S.C. 122(e)

- Implemented in new 37 C.F.R. 1.290
- Takes effect on September 16, 2012
 - Applies to any patent application filed before, on, or after September 16, 2012



Filing

- 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

- May be filed by any member of the public (§ 1.290(a))
 - For example, private persons and corporate entities
 - Need not be filed by a registered patent practitioner
 - Must not be filed by applicant or other § 1.56(c) party (§ 1.290(d)(5)(i))
- No service on applicant required



Filing

- May be filed electronically
 - Use the Office's dedicated Web-based interface
 - Will receive immediate, electronic acknowledgment of the Office's receipt of the submission
- May be filed in paper
 - Processing delays (for scanning and indexing)
 - May include a self-addressed postcard for acknowledgment of the Office's receipt of the submission
- May not be filed by facsimile (§ 1.6(d)(3))



Printed Publications

- Submissions are limited to “printed publications” (§ 1.290(a))
 - U.S. patents and patent application publications
 - Foreign patents and published patent applications
 - Other printed publications
 - Non-patent documents, such as articles, Office actions, communications from foreign patent offices, etc. that qualify as publications
- Need not be prior art
- Best practice not to submit documents that are cumulative of each other or information already of record



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))

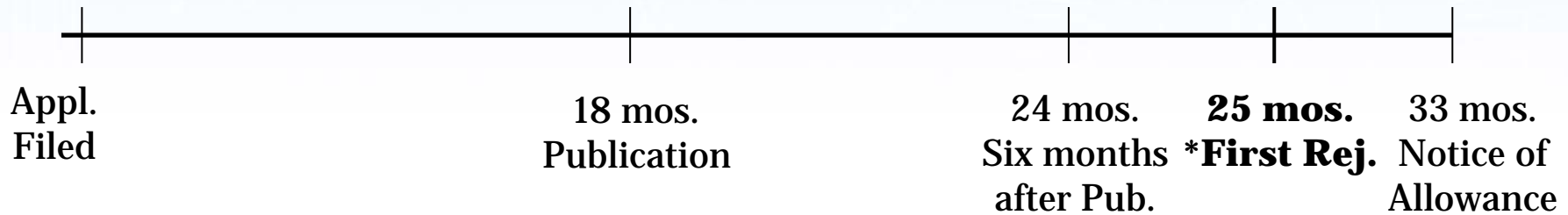


Statutory Time Periods

- Time periods cannot be waived
 - Extensions of time will not be granted
 - Abandonment will not toll time period for filing
 - Untimely submissions will not be entered or considered, and will be discarded
- Must be filed before, not on, the critical date
 - Submission is filed as of its date of receipt by the Office
 - Certificate of mailing/transmission does not apply (§ 1.8(a)(2)(i)(I), § 1.290(i))
 - USPS Express Mail service does apply (§ 1.10)



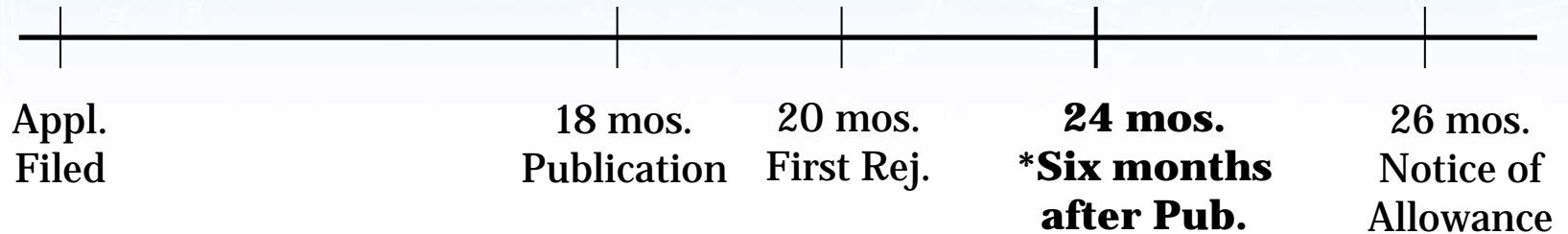
Timing Example #1



*** Third-party submission must be filed before this date**



Timing Example #2



*** Third-party submission must be filed before this date**



Requirements

- Document list
- Concise descriptions of relevance
- Copies (as required)
- Translations (as required)
- Statements
- Fee (if necessary)



Document List

- Must identify the documents or portions of documents being submitted (§ 1.290(d)(1))
- Must include a heading that identifies the list as a third-party submission under § 1.290 (§ 1.290(e))
- Must identify the application number on each page of the list (§ 1.290(e))
- Form PTO/SB/429
 - Automatically generated for electronic submissions
 - Available at <http://www.uspto.gov/forms> for paper submissions



Document List

- List U.S. patents and U.S. patent application publications in a separate section from other items (§ 1.290(e))
- Identify U.S. patents by: (§ 1.290(e)(1))
 - Patent number, first named inventor, and issue date
- Identify U.S. patent application publications by: (§ 1.290(e)(2))
 - Patent application publication number, first named inventor, and publication date



Document List

- Identify foreign patents or published foreign patent applications by: (§ 1.290(e)(3))
 - The country or patent office that issued the patent or published the application
 - The applicant, patentee, or first named inventor
 - An appropriate document number
 - The publication date indicated on the patent or published application



Document List

- Identify non-patent publications by: (§ 1.290(e)(4))
 - Author (if any)
 - Title
 - Pages being submitted
 - Publication date
 - Where available, publisher and place of publication
- If no publication date is known, the third party must provide evidence of publication (§ 1.290(e)(4))



Concise Description

- Provide a concise description of the asserted relevance for each document identified (§ 1.290(d)(2))
- A statement of facts explaining how the document is of potential relevance to the examination of the application
 - Not an invitation for the third party to participate in the prosecution of the application



Concise Description

- Use a format that would best explain to the examiner the relevance of the document
 - Point out relevant pages, paragraph, lines, figures, etc.
 - A focused description is more effective in drawing the examiner's attention to the relevant issues
- Must not include:
 - Proposed rejections of the claims
 - Arguments relating to an Office action or an applicant's reply in the application



Concise Description

- Examples of improper concise descriptions:
 - A bare statement of relevance:
 - Document 1 is relevant
 - See Document 1
 - Document 1 discloses/may disclose the invention
 - Document 1 teaches the invention in Claim 1
 - An annotated copy of the submitted document



Copies

- **Must submit a legible copy of each item identified (§ 1.290(d)(3))**
 - Except for U.S. patents and U.S. patent application publications
- **Where only a portion of a document is listed:**
 - Only submit a copy of that portion and not a copy of the entire document
 - Submit copies of pages of the document that provide identifying information (e.g., a copy of the cover, the title page, the copyright information page, etc.)



Translations

- Must submit an English language translation of any non-English language item identified (§ 1.290(d)(4))
 - May submit a reliable machine translation
 - Need not be certified
- Where only a portion of a non-English language document is listed:
 - Only submit a translation of that portion and not a translation of the entire document



Statements

- **Statement by the party making the submission that the party is not an individual who has a duty to disclose information with respect to the application (§ 1.290(d)(5)(i))**
 - Must not be an individual associated with the filing and prosecution of the patent application pursuant to § 1.56(c)
 - Avoids potential misuse by applicants attempting to circumvent the information disclosure statement (IDS) rules
- **Statement by the party making the submission that the submission complies with the requirements of 35 U.S.C. 122(e) and § 1.290 (§ 1.290(d)(5)(ii))**



Statements

- “First and only” statement for fee exemption (§ 1.290(g))
 - Statement that, to the knowledge of the person signing the statement after making reasonable inquiry, the submission is the first and only third-party submission in the application by the third party or a party in privity with the third party
- Form PTO/SB/429 and dedicated Web-based interface include the required statements to facilitate compliance
- Statements must be signed
 - Submitter will be identified
 - Real party in interest need not be identified



Fee

- \$180 fee for every 10 documents listed or fraction thereof (§ 1.290(f))
- No fee for first submission of 3 or fewer total documents submitted (§ 1.290(g))
 - Must be accompanied by “first and only” statement
 - More than one third party can take advantage of the fee exemption in a given application



“First and Only” Statement

- Precludes a third party from making multiple submissions in an application on the same day and asserting that each is the first submission in the application by the third party
- If a third party takes advantage of the fee exemption in an application, the third party may make additional submissions in the application
 - Where the need for the subsequent submissions was not known at the time of the first submission



Fee Examples

- First submission by a third party in an application:
 - \$0 for 1-3 documents (with “first and only” statement)
 - \$180 for 4-10 documents
 - \$360 for 11-20 documents
- Second or subsequent submission by the same third party in the same application:
 - \$180 for 1-10 documents
 - \$360 for 11-20 documents



Processing

- Third-party submissions will be reviewed by the Office to determine compliance with 35 U.S.C. 122(e) and § 1.290 before being made of record in an application
- Compliance determination, for both paper and electronic submissions, will be completed promptly following receipt
- A third-party submission may not be entered or considered by the Office if any part of the submission is not in compliance with 35 U.S.C. 122(e) and § 1.290 (§ 1.290(a))



Non-Compliant Submissions

- Submissions deemed non-compliant will not be made of record or considered, and will be discarded
- Fees will not be refunded
- The statutory time period for filing will not be tolled
 - No time period will be set to file a corrected submission
 - Amendments to a non-compliant submission that was previously filed will not be accepted
 - The third party may file another complete submission, provided the statutory time period for filing has not closed



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.



Notification to Third Party

- Third party will be notified if the submission is found non-compliant where an email address is provided with the submission (whether filed electronically or in paper)
 - Notification will include reason(s) for non-compliance
 - Notification will not be made of record in the application
- Third party will not be notified of compliant submission
 - May access the Office's public Patent Application Information Retrieval System (PAIR) to confirm that a submission was entered (in a published application)



Examiner Consideration

- Examiner will consider third-party submissions in the same manner as information in an IDS
 - By initialing and/or signing the listing, the examiner is indicating consideration of both the listed document and its concise description, not that the examiner agrees with the third party's position regarding the document
- A copy of the document list, indicating which documents were considered by the examiner, will be provided to the applicant generally with the next Office action following entry of a compliant submission



Examiner Consideration

- Considered documents will be printed on the patent
 - Documents submitted by third parties will be distinguished from documents cited by the applicant and the examiner
- Third party is not permitted to respond to an examiner's treatment of a submission
- In the absence of a request by the Office, an applicant need not reply to a submission (§ 1.290(h))



Electronic Filing

- Select the “Third-Party Preissuance Submission under 37 CFR 1.290” option in the Office’s electronic filing system—Web (EFS-Web)
 - Electronically filing a submission other than via the dedicated option for third-party submissions is prohibited
- Benefits of electronic filing
 - Automatic acknowledgement of receipt
 - Automatically generates the document list (Form PTO/SB/429)
 - Compliant submissions efficiently routed to examiner



EFS-Web Registered eFiler

<https://efs.uspto.gov/authenticate/AuthenticateUserLocalEPF.html>

EFS Registered

Registered eFilers Please Read Announcements

Certification

A submission has not been filed officially at the USPTO until the e-filer executes the Submit function and the documents are received at the USPTO Eastern Time. The Acknowledgement Receipt is evidence of this submission.
All items denoted by * are required.

EFSWeb demo test.

IMPORTANT: Please read the [Legal Framework for using EFS-Web](#). For information on the Paperwork Reduction Act as it pertains to: ePetitions, [please see the OMB Clearance and PRA Burden Statement ePetitions page](#); third party submissions under 37 CFR 1.290, please see the [OMB Clearance and PRA Burden Statement Third Party Submissions page](#).

Your Digital Certificate has been authenticated - please certify your identity:

I certify that I am the certificate holder **Rich FQT Fernandez**

I certify that I am working under the authority of the certificate holder: **Rich FQT Fernandez**

*Main Functions

New application/proceeding
(This includes new filings of continuation, divisional, continuation-in-part and re-issue applications, as well as reexamination and supplemental examination proceedings. A request for continued examination (RCE) and continued prosecution application (CPA) are considered existing documents and must be filed as a registered eFiler.)

Existing application/patent/proceeding

Select Type of Submission for Existing Application/Proceeding

Documents/Fees for an existing application/proceeding (applicant/representative only)
(A request for continued examination (RCE) and continued prosecution application (CPA) are considered existing documents)

ePetition (for automatic processing and immediate grant, if all petition requirements are met)

eProcessing (Electronic Terminal Disclaimer and other requests for automatic processing)

Pre-Grant Publication under 37 CFR 1.211 to 1.221

Third-Party Preissuance Submission under 37 CFR 1.290
(for utility, design, or plant application only, and not a reissue application or reexam proceeding)

* Application Number (EXAMPLE: 99999999 , 99/999999 or 99/999,999)

* Confirmation Number (EXAMPLE: 1234)

* Pursuant to 37 CFR 11.18(b), a party presenting any paper to the Office is certifying that all statements made therein of the party's own knowledge are true, and that all statements made therein on information and belief are believed to be true, and all statements are made with the knowledge that whoever willfully makes any false statements or representations shall be subject to the penalties set forth under 18 U.S.C. 1001.

Any required fee must be paid at the time of filing. REGISTERED eFILERS who authenticate can save "in-progress" submissions and return to edit them prior to completing the submission, but payment will be due upon filing of the completed submission. UNREGISTERED eFILERS do not have the option of saving "in-progress" submissions. After selecting the "Continue" button below, UNREGISTERED eFILERS must complete the submission and make any required payment.



EFS-Web Unregistered eFiler

<https://efs.uspto.gov/efile/portal/efs-unregistered>

EFS Unregistered

Unregistered eFilers Registered eFilers Please Read Announcements

Welcome to Electronic Patent Filing for UNREGISTERED eFILERS

A submission has not been filed officially at the USPTO until the e-filer executes the Submit function and the documents are received at the USPTO Eastern Time. The Acknowledgement Receipt is evidence of this submission.

* All items denoted by * are required.

EFSWeb demo test.

IMPORTANT: Please read [Legal Framework for using EFS-Web](#). For information on the Paperwork Reduction Act as it pertains to third party submissions under 37 CFR 1.290, please see the [OMB Clearance and PRA Burden Statement - Third Party Submissions page](#)

Sign-on as an UNREGISTERED eFILER

* e-Filer Last Name:

* e-Filer First Name:

* e-Filer E-Mail Address:

* Main Functions

New application/proceeding
(This includes new filings of continuation, divisional, continuation-in-part and reissue applications, as well as reexamination and supplemental examination proceedings. A request for continued examination (RCE) and continued prosecution application (CPA) are considered existing documents and must be filed as a registered eFiler.)

Existing application/patent **i**

Select Type of Submission for Existing Application/Proceeding

Petition

Third-Party Preissuance Submission under 37 CFR 1.290 **i**
(for utility, design, or plant application only, and not a reissue application or reexam proceeding)

* Application Number (EXAMPLE: 99999999 , 99/999999 or 99/999,999) **i**

* Confirmation Number (EXAMPLE: 1234) **i**

* Pursuant to 37 CFR 11.18(b), a party presenting any paper to the Office is certifying that all statements made therein of the party's own knowledge are true, and that all statements made therein on information and belief are believed to be true, and all statements are made with the knowledge that whoever willfully makes any false statements or representations shall be subject to the penalties set forth under 18 U.S.C. 1001.

Any required fee must be paid at the time of filing. REGISTERED eFILERS who authenticate can save "in-progress" submissions and return to edit them prior to completing the submission, but payment will be due upon filing of the completed submission. UNREGISTERED eFILERS do not have the option of saving "in-progress" submissions. After selecting the "Continue" button below, UNREGISTERED eFILERS must complete the submission and make any required payment.

[Privacy Policy](#)



Electronic Filing

- Enter no more than 10 items per electronic submission
 - File another electronic submission to list additional items
 - Must pay any required fees at the time of filing
 - Registered users may save a submission as a work-in-progress
- Fill in the concise description of relevance field for an item or upload a separate paper
 - For paper filing, provide a separate paper for each concise description (do not combine the descriptions in a single paper)
 - Prominently identify the submitted document to which the concise description pertains



Other Rules

37 CFR 1.99, 1.291, 1.292

- Third-party submissions under § 1.99 eliminated in favor of new § 1.290
 - Do not file under former § 1.99 on or after September 16, 2012
- Some protest provisions of § 1.291 amended for clarity and consistency with new § 1.290, where appropriate
 - For example, §§ 1.291(c)(1)(i) through (c)(1)(v) added to provide requirements for identifying the information submitted
- Public use proceedings under § 1.292 eliminated
 - Petitions filed under former § 1.292 on or after September 16, 2012 will not be entered or otherwise treated and will be discarded



Key Changes from Proposed Rules

- The final rule provides for notification to applicant upon entry of a compliant third-party submission in an application file
- The final rule provides for notification to a third party if the third-party's submission is deemed non-compliant
- In the final rule, third-party submissions are not permitted in reissue applications
 - Where a submission is filed under § 1.290 in a reissue application, the Office will process the submission as a protest under § 1.291





AMERICA INVENTS ACT

IMPLEMENTATION

Miscellaneous Post Patent Provisions

Effective September 16, 2012

Changes to Implement Miscellaneous Post Patent Provisions of the Leahy-Smith America Invents Act: Final Rule, 77 Fed. Reg. 46615 (August 6, 2012)

Contents

- Goals
- Statutory Provisions Implemented
 - 35 U.S.C. §§ 301, 315(e)(1), and 315(e)(2)
- Patent Owner Claim Scope Statements
 - Defined – What qualifies
 - Submission Requirements
 - Permitted/Prohibited Uses
- *Ex parte* Reexamination Request Estoppel
 - Which events trigger estoppel
 - Who is estopped
 - Certification requirement for request
- Key Changes from Proposed Rules



Miscellaneous Post Patent Provisions

Goals

- Implementation of the statutory provisions in a manner that reflects the legislative history and the public comments
- The final rule is designed to:
 - Facilitate the filing and review of these statements
 - Prevent improper consideration of submissions
 - Conserve Office resources
 - Preserve the integrity of patent files
 - Make technical changes to conform to AIA language



Miscellaneous Post Patent Provisions - AIA Statutory Provisions Implemented

- Final Rule implementation:
 - 35 U.S.C. 301 expands the scope of information that may be submitted in a patent, and governs the use of such information.
 - Estoppel provisions of §§ 315(e)(1) and 325(e)(1) bar a third party requester from filing an *ex parte* reexamination on the same patent after a final decision in a post grant review or *inter partes* review that was requested by the same third party.
 - Miscellaneous technical corrections.



Patent Owner Claim Scope Statements - 35 U.S.C. 301 (a) & (c) Information Submitted

(a) In General. – Any person at any time may cite to the Office in writing –

(1) prior art consisting of patents or printed publications which that person believes to have a bearing on the patentability of any claim of a particular patent; or

(2) statements of the patent owner filed in a proceeding before a Federal court or the Office in which the patent owner took a position on the scope of any claim of a particular patent.

(c) Additional Information. – A party that submits a written statement pursuant to subsection (a)(2) shall include any other documents, pleadings, or evidence from the proceeding in which the statement was filed that addresses the written statement.

Patent Owner Claim Scope Statements - 35 U.S.C. 301 (b) & (e) Explanation & Anonymity

(b) Official File. – If the person citing prior art or written statements pursuant to subsection (a) explains in writing the pertinence and manner of applying the prior art or written statements to at least 1 claim of the patent, the citation of the prior art or written statements and the explanation thereof shall become a part of the official file of the patent.

(e) Confidentiality. – Upon the written request of the person citing prior art or written statements pursuant to subsection (a), that person's identity shall be excluded from the patent file and kept confidential.



Patent Owner Claim Scope Statements - 35 U.S.C. 301 (d) Limitations

Limitations. – A written statement submitted pursuant to subsection (a)(2), and additional information submitted pursuant to subsection (c), shall not be considered by the Office for any purpose other than to determine the proper meaning of a claim in a proceeding ordered pursuant to section 304, 314, or 324.

If any such written statement or additional information is subject to an applicable protective order, such statement or information shall be redacted to exclude information that is subject to that order.

Patent Owner Claim Scope Statements Defined – What qualifies

- A Patent Owner Claim scope statement (§ 1.501(a)(2)) is :
 - a statement in which patent owner took a position on the scope of any claim of the patent; and
 - the statement was filed by the patent owner in a proceeding before a Federal court or the Office.



Patent Owner Claim Scope Statements Defined – What qualifies

- Patent owner written statements made outside of a Federal court or Office proceeding and later filed by the patent owner in a Federal court or Office proceeding – are eligible for submission.
- Patent owner statements filed by a third party (a party other than the patent owner) in a Federal court or Office proceeding are not eligible for submission.



Patent Owner Claim Scope Statements - Submission Requirements for Prior Art and Written Statements

- A third party submission of a statement will not be entered into the file history of a patent unless it also identifies:
 - The forum and proceeding in which each statement was filed;
 - The specific papers or portions of papers that contain the statements; and
 - How each statement submitted constitutes a position taken by patent owner on the scope of any claim of the patent.

(§ 1.501(a)(3))



Patent Owner Claim Scope Statements - Submission Requirements for Prior Art and Written Statements

- Any patent owner claim scope statement must be accompanied by information that addresses the statement. (§ 1.501(a)(2))
 - the documents
 - pleadings, and
 - evidence (from the proceeding in which the statement was filed)
- The statement and information must be redacted to exclude information that is subject to any protective order.



Patent Owner Claim Scope Statements - Submission Requirements for Prior Art and Written Statements

- A third party submission into the file history of a patent may be made anonymously. (§ 1.501(d))
- However, proof of service upon the patent owner is required, in the form of a certificate of service. (§ 1.501(e))



Patent Owner Claim Scope Statements - Submission Requirements for Prior Art and Written Statements

- Any submission must include an explanation of the pertinence and manner of applying any included prior art, patent owner statement(s) and accompanying information, with respect to at least one claim of the patent. (§ 1.501(b)(1))
- A patent owner explanation may additionally state how any claim is patentable over any submitted prior art, patent owner statement(s) and accompanying information. (§ 1.501(b)(2))



Patent Owner Claim Scope Statements – Permitted/Prohibited Uses - *Ex Parte* Reexamination

- When determining whether to grant a request for *ex parte* reexamination, the examiner will not consider any patent owner statement or accompanying information submitted under § 1.501(a)(2). (§ 1.515(a))
- The examiner will use the Broadest Reasonable Interpretation claim construction standard during the determination (order) stage of the proceeding, for unexpired patents.



Patent Owner Claim Scope Statements - Permitted/Prohibited Uses - *Ex Parte* Reexamination

- The examiner will consider any submitted patent owner statement, accompanying information, and explanation after *ex parte* reexamination has been ordered. (§ 1.552(d))
- Claim construction standards for reexamination are unaffected.
- The examiner will consider any submitted patent owner statement, accompanying information, and explanation, only in making an independent determination of the proper meaning of a claim.



***Ex parte* Reexamination Request Estoppel -
35 U.S.C. 315(e)(1) & 325(e)(1)
Inter Partes & Post Grant Review Estoppel Provisions**

315(e)(1) [325(e)(1)]

The petitioner in an inter partes [a post grant] review of a claim in a patent under this chapter that results in a final written decision under section 318(a) [328(a)], or the real party in interest or privy of the petitioner, may not request or maintain a proceeding before the Office with respect to that claim on any ground that the petitioner raised or reasonably could have raised during that inter partes [post grant] review.

***Ex Parte* Reexamination Estoppel – Which events trigger estoppel**

- The estoppel with respect to reexamination applies only to making a request after receiving a final decision under 35 U.S.C §§ 318 or 328.
- The requester of a reexamination does not “maintain” such a proceeding, as it has no ability to terminate it.
 - The Office maintains the reexamination proceeding, and the statute does not prohibit the Office from maintaining the reexamination proceeding.



***Ex Parte* Reexamination Estoppel**

- A request for *ex parte* reexamination must include a certification by the third party that the requester is not estopped from requesting an *ex parte* reexamination. (§ 1.51o(b)(6))
- The real party in interest need not be identified in a request for *ex parte* reexamination.



Key Changes from Proposed Rules

Final

- Patent owner statement must have been filed in the Court or Office proceeding by patent owner.
- The statement may have originated outside the court or Office proceeding in which it was filed.
- Estoppel applies only to reexamination requests.
- Real Party in Interest need not be identified in a reexamination request.

Proposed

- Patent owner statement may have been filed in the Court or Office proceeding by any person.
- The filed statement must have originated in the Court or Office proceeding.
- Estoppel applies to reexamination requests and ongoing proceedings.
- Real Party in Interest must be identified in a reexamination request.





AMERICA INVENTS ACT

IMPLEMENTATION

Administrative Patent Trials

Effective September 16, 2012

Final Rules

- **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)**



Contents

- Overview of AIA Trial Proceeding Structure
- Discussion of Proceeding-Specific Rules
 - *Inter Partes* Review (IPR)
 - Post-Grant Review (PGR)
 - Transitional Program for Covered Business Method Patents (CBM)
- Discussion of Umbrella Rules and Practice Guide



Public Comments

- The AIA Patent Trial Final Rules and Practice Guide for the Final Rules are effective as of **September 16, 2012**.
- 251 written comments from the IP community related to Trial Proposed Rules and Practice Guide.
- Significant modifications to certain proposed provisions.
- **E.g., fee, discovery, estoppel, and page limit provisions were modified.**

(Clarifications and changes are shown in bolded blue text in this presentation.)



Considerations in Formulating Final Rules

- AIA provides that the Office consider the effect of the regulations on the economy, the integrity of the patent system, the efficient operation of the Office, and the ability to timely complete the proceedings. 35 U.S.C. 316(b) & 326(b).
- Legislative history provides that proceedings reflect a quick, effective, and efficient alternative to often costly and protracted district court litigation.



AIA Trial Proceeding Structure

- AIA provides for same basic structure for all the proceedings.
- Reduction of burdens on the parties
 - The final rules lay out a framework for conducting the proceedings aimed at streamlining and converging the issues for decision.
 - Rules streamlining the procedure include the use of page limits and electronic filing as the default manner in which documents are filed.
- Board will conduct the proceeding so as to reduce the burdens
 - Conference calls with a judge handling the case to decide issues quickly and efficiently and to avoid the burdens associated with filing requests for relief.
 - Instituting a trial on a claim-by-claim, ground-by-ground basis.



AIA Trial Proceedings

Inter Partes Review
§§ 42.100 – 42.123

Post-Grant Review
§§ 42.200 – 42.224

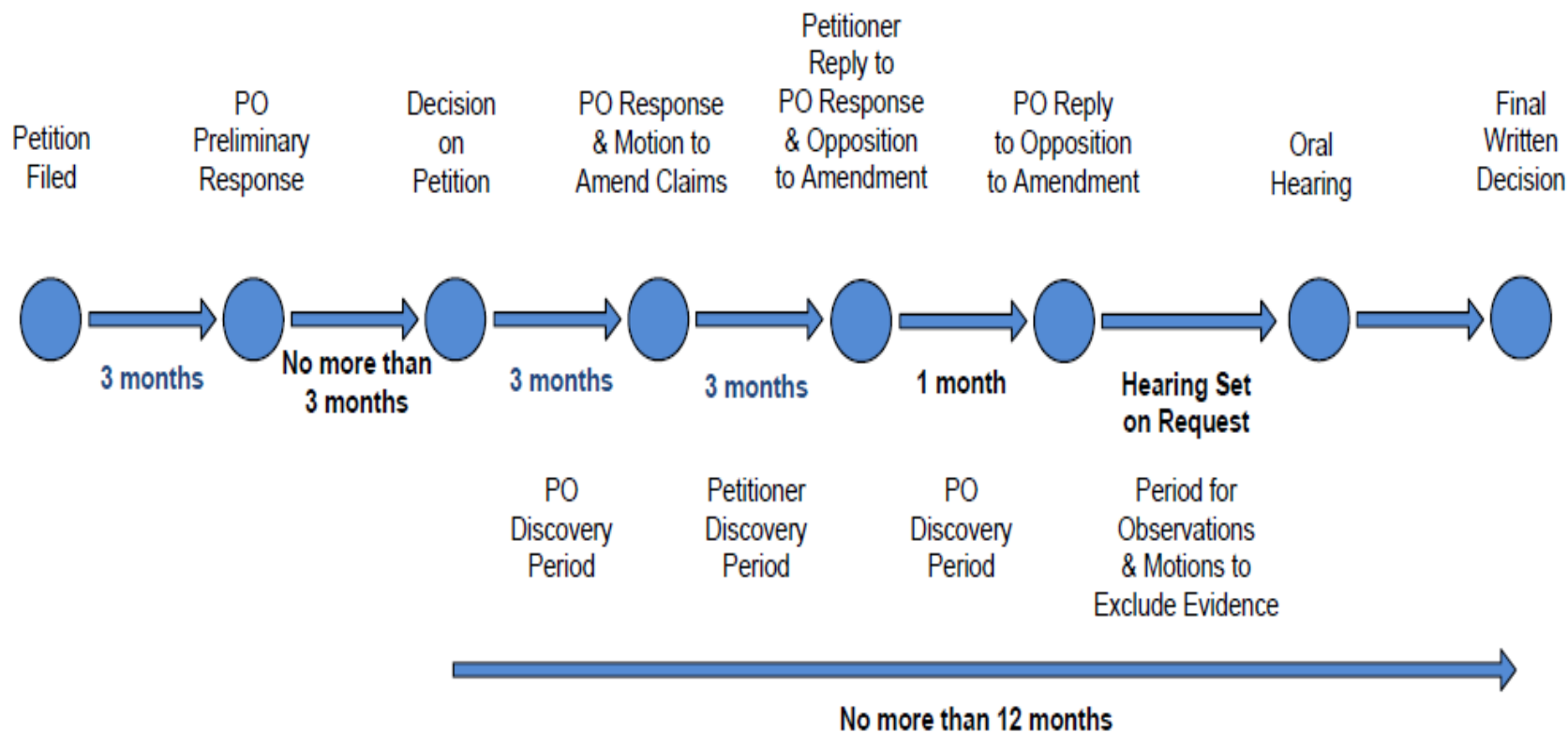
Umbrella Trial Rules
§§ 42.1 – 42.80

Covered Business
Method Patent Review
§§ 42.300 – 42.304

Derivation Proceeding
Proposed §§ 42.400 –
42.412



AIA Trial Proceedings



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 are permitted.

PGR

Only FITF patents are eligible.

Petitioner has not filed an invalidity action.

Only §§ 101, 102, 103, and 112, except best mode, grounds are permitted.

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, grounds are permitted.



Threshold Standards for Institution

IPR

Petition must demonstrate a **reasonable likelihood** that petitioner would prevail as to at least one of the claims challenged.

PGR/CBM

Petition must demonstrate that it is **more likely than not** that at least one of the claims challenged is unpatentable.

PGR/CBM: Greater than 50% chance

IPR: May encompass a 50/50 chance



Administrative Patent Trials

- In general, a person who is not the patent owner may file an IPR/PGR/CBM petition in the following time periods:

First-to-Invent
Patents

CBM
After issuance

IPR
> 9 months
from issue date

First-Inventor-
to-File
Patents

PGR
 \leq 9 months
from issue date

IPR or CBM
> 9 months
from issue date



Inter Partes Review

- All patents are eligible for an IPR. § 6(c)(2)(A) of AIA.
- A person who is not the patent owner and has not previously filed a civil action challenging the validity of a claim of the patent may file an IPR. 35 U.S.C. 315(a)(1); § 42.101.
- An IPR petitioner may request to cancel, as unpatentable, one or more claims of a patent only on a ground that could be raised under § 102 or 103 and only on the basis of prior art consisting of patents or printed publications. 35 U.S.C. 311(b); § 42.104(b)(2).
- An IPR petition cannot be filed until after the later of: 1) 9 months after the grant of a patent or issuance of a reissue of a patent; or 2) the date of termination of any post grant review of the patent. 35 U.S.C. 311(c); § 42.102(a).



Inter Partes Review

- Petition must:
 - Be accompanied by a **fee**. 35 U.S.C. 312(a)(1); § 42.15 & 42.103.
 - Identify all **real parties in interest**. 35 U.S.C. 312(a)(2); § 42.8.
 - Identify all **claims challenged** and **grounds** on which the challenge to each claim is based. 35 U.S.C. 312(a)(3); § 42.104(b).
 - Provide a **claim construction** and show how the construed claim is unpatentable based on the grounds alleged. § 42.104(b).
 - Provide copies of **evidence** relied upon. 35 U.S.C. 312(a)(5); § 42.6(c).
 - Certify that the petitioner is **not estopped** from proceeding. § 42.104(a).



Inter Partes Review

Patent owner preliminary response

- A patent owner may file a preliminary response to the petition to provide reasons why no IPR should be instituted. 35 U.S.C. 313; § 42.107(a).
- Preliminary response is due **3 months** from petition docketing date. § 42.107(b).
- **In addition to documentary evidence, patent owners may provide testimonial evidence in a preliminary response where interests of justice so require, e.g., to demonstrate that petitioner's real party in interest is estopped from challenging patent claims. See Practice Guide, Section II.C.**



Inter Partes Review

Threshold and Institution

- An IPR petition must demonstrate a reasonable likelihood that petitioner would prevail as to at least one of the claims challenged. 35 U.S.C. 314(a); § 42.108(c).
- Where IPR standards are met, the Board will institute the trial on: 1) claim-by-claim basis; and 2) ground-by-ground basis. § 42.108(a) & (b).
 - **A party may request that panel rehears decision on petition. § 42.71(c) & (d).**
- An IPR trial will be completed within one year from institution, except the time may be extended up to six months for good cause. 35 U.S.C. 316(a)(11); § 42.100(c).



Inter Partes Review

Patent owner response (35 U.S.C. 316(a)(8); § 42.120)

- A patent owner may file a response to petition addressing any ground for unpatentability not already denied by the Board.
- In submitting a response, the patent owner must file, through affidavits or declarations, any additional factual evidence and expert opinions on which the patent owner relies in support of the response.
- **The default date for filing a patent owner response is 3 months from institution.**



Inter Partes Review

Motion to Amend (35 U.S.C. 316(a)(9), (b) & (d); § 42.121)

- **Authorization is not required to file the initial motion to amend, but conferring with the Board is required.**
- The motion to amend may cancel any challenged claim and/or propose a reasonable number of substitute claims.
- **Additional motion to amend may be authorized for good cause, e.g., where supplemental information is belatedly submitted.**
- Motions to amend may be limited to prevent abuse and to aid in efficient administration and timely completion of the proceeding.



Post-Grant Review

- Most aspects of PGR and IPR are effectively the same.
- There are some differences between a PGR and an IPR, such as:
 - With limited exceptions, only those patents issuing from applications subject to first-inventor-to-file provisions are eligible. § 6(f) of AIA.
 - PGR allows challenges based on §§ 101, 102, 103, and 112, except best mode. 35 U.S.C. 321(b); § 42.204(b)(2).
 - PGR may 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. 35 U.S.C. 321(c); § 42.202(a).
 - 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. 35 U.S.C. 324(a); § 42.208(c).



Covered Business Methods

- CBM proceedings employ the PGR standards and procedures subject to certain exceptions. § 18(a)(1) of AIA; § 42.303(a).
- Differences between a CBM and a PGR include:
 - Cannot file CBM petition during time a PGR petition could be filed, *i.e.*, 9 months after issuance of a patent. § 18(a)(2) of AIA.
 - Petitioner must be sued or charged with infringement. § 18(a)(1)(B) of AIA; § 42.302(a).
 - Petitioner has burden of establishing that patent is eligible for CBM review. § 42.304(a).
 - Prior Art is limited when challenging a first-to-invent patent. § 18(a)(1)(C) of AIA.



Covered Business Methods

Eligible patents:

- Both first-to-invent and first-inventor-to-file patents are eligible. §§ 6(f)(2)(A) & 18(a)(1) of AIA.
- Must be a covered business method patent. § 18(d)(1) of AIA; § 42.301.
 - Covered business method patent generally defined in the AIA as a method or corresponding apparatus for performing data processing or other operations for financial product or service.
 - The definition excludes patents for technological inventions.



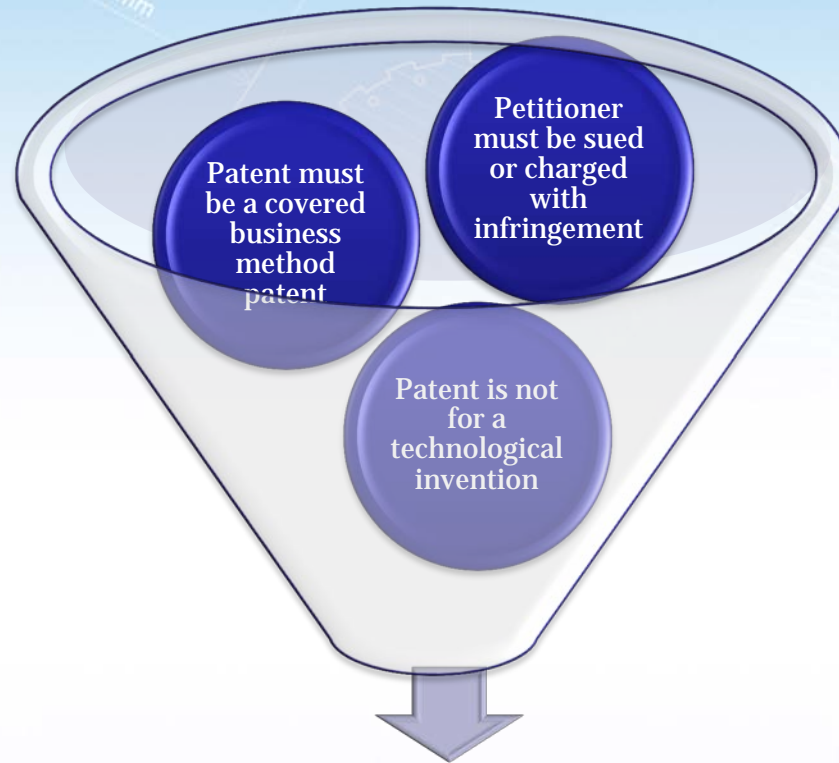
Covered Business Methods

Technological Invention – § 42.301(b) provides that:

- **Solely** for purposes of a CBM review the following will be considered on a case-by-case basis to determine if a patent is for a “technological invention”:
 - whether the claimed subject matter as a whole:
 - (1) recites a technological feature that is novel and unobvious over the prior art; and
 - (2) solves a technical problem using a technical solution.
- **The definition is based on what the patent claims, i.e., a patent having one or more claims directed to a covered business method is eligible for review.**



Covered Business Methods



CBM Review



Derivation

- Only a patent applicant may file a derivation petition. § 42.402.
- The petition 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. 35 U.S.C. 135(a), as amended; § 42.403.
 - **“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. § 42.401.**



Derivation

- The petitioner must have a claim that is the same or substantially the same as a respondent's claim, and the same or substantially the same as the invention disclosed to the respondent. § 42.405(a).
 - **“Same or substantially the same” means patentably indistinct. § 42.401.**
- The petition must set forth with particularity the basis for finding that an inventor named in an earlier application or patent derived the claimed invention. § 42.405(b)



Derivation

- **The petitioner must certify that the inventor from whom the invention was derived did not authorize the filing of the earliest application claiming such invention. § 42.405(b).**
- The petition must provide substantial evidence, including one affidavit, in support of the petition to show how the invention was communicated to the respondent. § 42.405(c).
- A derivation is not likely to be instituted, even where the Director thinks the standard for instituting a derivation proceeding is met, until a patent with the claimed invention issues.



Umbrella Rules

- Per statutory requirements, real parties in interest will have to be identified. *See, e.g.*, 35 U.S.C. 312(a)(2), 322(a)(2); § 42.8(b)(1).
- Practice Guide (Section I. *D*) provides factors that may be considered in determining whether a party constitutes a real party in interest or privy.
- Additionally, both petitioner and patent owner will be required to provide a certain level of information necessary to conduct the proceeding including related proceedings, lead and backup counsel, and contact information (email addresses and phone numbers). § 42.8(b).



Umbrella Rules

Practice Before the Board in the Trial Proceedings

- **The lead counsel must be a registered practitioner.**
- The Board may recognize counsel pro hac vice during a proceeding upon a showing of good cause, subject to the Office's Code of Professional Responsibility and any other conditions as the Board may impose. § 42.10(c).
 - ***E.g., counsel is an experienced litigation attorney and has a familiarity with subject matter at issue.***
- Similarly, the Board may take action to revoke pro hac vice status, taking into account various factors, including incompetence, unwillingness to abide by the Office's Code of Professional Responsibility, and incivility. § 42.10.



Umbrella Rules

Petition Fees (§ 42.15)

- **Proposed fee escalation in block increments of 10 claims has not been adopted in the final rule.**
- **Rather, the final rule establishes a flat fee for each additional challenged claim after 20.**

IPR

\$ 27,200

\$ 600
for each additional
claim > 20.

PGR/CBM

\$ 35,800

\$ 800
for each additional
claim > 20.

Derivation

\$ 400



Umbrella Rules

- For IPR, PGR, and CBM, the Director is required to set the fees to be paid by the third party requesting review “in such amounts as the Director determines to be reasonable, considering the aggregate costs of the review.” 35 U.S.C. 311 & 321; § 42.15.
 - Consistent with statute, the fees are set at a cost recovery level and are promulgated under the Office’s 35 U.S.C. 41(d)(2) cost recovery fee setting authority.
 - **Pursuant to new fee setting authority under section 10 of the AIA, the Office is proposing a staged fee structure which would permit a refund of a portion of the petition fees in cases where a trial is not instituted.**



Umbrella Rules

- **Proposed page limits have been increased by 10 pages. The final rule provides the following (§ 42.24):**

IPR

60 pages

**For a petition,
preliminary
response, and
PO response**

PGR/CBM

80 pages

**For a petition,
preliminary
response, and
PO response**

Derivation

60 pages

**For a petition
and opposition
to petition**

- **For claim charts, single spacing is permitted. § 42.6(a)(2)(iii).**
- **Statement of material facts in a petition or motion is optional. § 42.22(c).**



Umbrella Rules

Protection of Confidential Information

- AIA provides that the file of a proceeding is open to the public, except that a party may seek to have a document sealed by filing a motion to seal. *See, e.g.*, 35 U.S.C. 316(a)(1); §§ 42.14 & 42.55.
- AIA also provides for protective orders to govern the exchange and submission of confidential information. *See, e.g.*, 35 U.S.C. 316(a)(7); § 42.55.
- **Parties seeking a protective order may file a motion to seal accompanied by the default protective order set forth in the Practice Guide or a proposed protective order. §§ 42.54 & 42.55.**



Umbrella Rules

Testimony and document production is permitted

- AIA authorizes the Office to set standards and procedures for the taking of discovery. 35 U.S.C. 316(a)(5) & 326(a)(5).
- **Discovery rules allow parties to agree to discovery between themselves.** § 42.51(a)(1) & (b)(2).
- The final rules provide for **mandatory initial disclosures**, routine discovery, and additional discovery. § 42.51.



Umbrella Rules

Mandatory initial disclosures

- **Parties may agree to mandatory discovery requiring initial disclosures as set forth in the Practice Guide. Otherwise, a party may seek such discovery by motion. § 42.51(a).**
- **For example, parties may agree to the following mandatory initial disclosures: the name and contact information of each individual likely to have discoverable information along with the subjects of that information or information regarding secondary indicia of non-obviousness.**



Umbrella Rules

- Routine discovery – reduces costs to parties by making basic information readily available at the outset of the proceeding. Routine discovery may assist the parties to assess the merits of their respective positions, to avoid harassment in the proceeding, or to reach settlement. § 42.51(b)(1).
 - Routine discovery includes documents cited, cross-examination for submitted testimony, and information inconsistent with positions advanced during the proceeding.
 - **Proposed rule on inconsistent statements has been modified to limit both scope and number of individuals subject to the rule. § 42.51(b)(1)(iii).**



Umbrella Rules

Additional discovery

- **The parties may agree to additional discovery between themselves.** Otherwise, a party must request any discovery beyond routine discovery.
- A party seeking additional discovery in IPR and derivation must demonstrate that the additional discovery is in the interests of justice. 35 U.S.C. 316(a)(5) for IPR; § 42.51(c).
- A party seeking additional discovery in PGR and CBM will be subject to the lower good cause standard. 35 U.S.C. 326(a)(5) for PGR; § 42.224.



Umbrella Rules

Supplemental information (35 U.S.C. 316(a)(3); § 42.123)

- **A request for the authorization to file a motion to submit supplemental information must be made within one month after institution.**
- **The supplemental information must be relevant to a claim for which the trial has been instituted.**
- **An motion to file 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.**



Umbrella Rules

- Sanctions are available for abuse of the proceeding
 - AIA requires the Office to prescribe sanctions for abuse of discovery, abuse of process, or any other improper use of the proceeding, such as to harass or cause unnecessary delay or an unnecessary increase in the cost of the proceeding. 35 U.S.C. 316(a)(6) & 326(a)(6); 37 CFR 10 & 11.
- Proposed sanctions (§ 42.12) include:
 - order holding facts to have been established
 - order expunging a paper
 - order excluding evidence
 - order precluding a party from obtaining, opposing discovery
 - order providing for compensatory expenses, including attorney fees
 - judgment or dismissal of the petition



Umbrella Rules

Settlement

- AIA encourages settlement in a trial by allowing the parties to settle.
- A settlement in IPR/PGR/CMB terminates the proceeding with respect to the petitioner and the Board may terminate the proceeding or issue a final written decision. 35 U.S.C. 317, 327; § 42.73, 42.74.
- A settlement in derivation will be accepted by the Board unless it is inconsistent with the evidence of record. 35 U.S.C. 135(e); § 42.73, 42.74.



Umbrella Rules

Final decision where a trial is instituted and not dismissed:

- For IPR/PGR/CBM, the Board will issue a final written decision that addresses the patentability of any claim challenged and any new claim added. 35 U.S.C. 318(a), 328(a); § 42.73.
- For derivation, the Board will issue a written decision that states whether an inventor named in an earlier application derived the claimed invention from an inventor named in the petitioner's application without authorization. 35 U.S.C. 135(b); § 42.73.



Umbrella Rules

Petitioner Estoppels After Final Written Decision

- A petitioner in an IPR/PGR/CBM may not request or maintain a proceeding before the **USPTO** with respect to any claim on any ground raised or reasonably could have been raised before the USPTO. 35 U.S.C. 315(e)(1), 325(e)(1); § 42.73(d)(1).
- A petitioner in an IPR/PGR/CBM may not assert in **district court or the ITC** that a claim is invalid on any ground petitioner raised, and in IPR/PGR, any ground that reasonably could have been raised in the trial before the USPTO. 35 U.S.C. 315(e)(2), 325(e)(2); § 18(a)(1)(D) of AIA.



Umbrella Rules

Patent Owner Estoppel (§ 42.73(d)(3))

- **A patent owner is precluded from taking action inconsistent with the adverse judgment including obtaining in any patent:**
 - **A claim that is patentably indistinct from a finally refused or canceled claim.**
 - **An amendment of a specification or drawing that was denied during the trial, but this provision does not apply to an application or patent that has a different written description.**
- **The proposed estoppel provision as to claims that could have been presented was not adopted in the final rule.**



Umbrella Rules

- **A party dissatisfied with a decision may file a request for rehearing with the Board. § 42.71(c) & (d).**
 - **A request must be filed within 14 days of the entry of a non-final decision or a decision to institute a trial or within 30 days of the entry of a final decision or a decision not to institute a trial.**
- A party dissatisfied with the final written decision in an IPR/PGR/CBM may appeal to the Federal Circuit.
35 U.S.C. 319, 329.
- A party dissatisfied with a final decision in a derivation may appeal to the Federal Circuit, 35 U.S.C. 141(d), or have remedy by a civil action, 35 U.S.C. 146. § 90.2.





AMERICA INVENTS ACT

IMPLEMENTATION

**Additional Information Available
at:**

www.uspto.gov/AmericaInventsAct