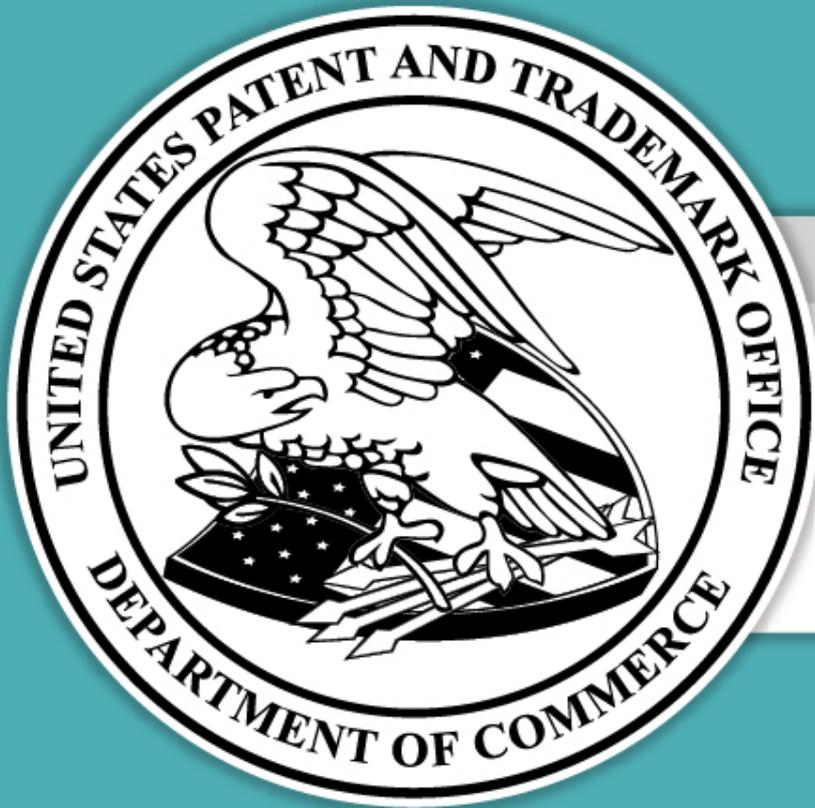


Aerospace Industries Association

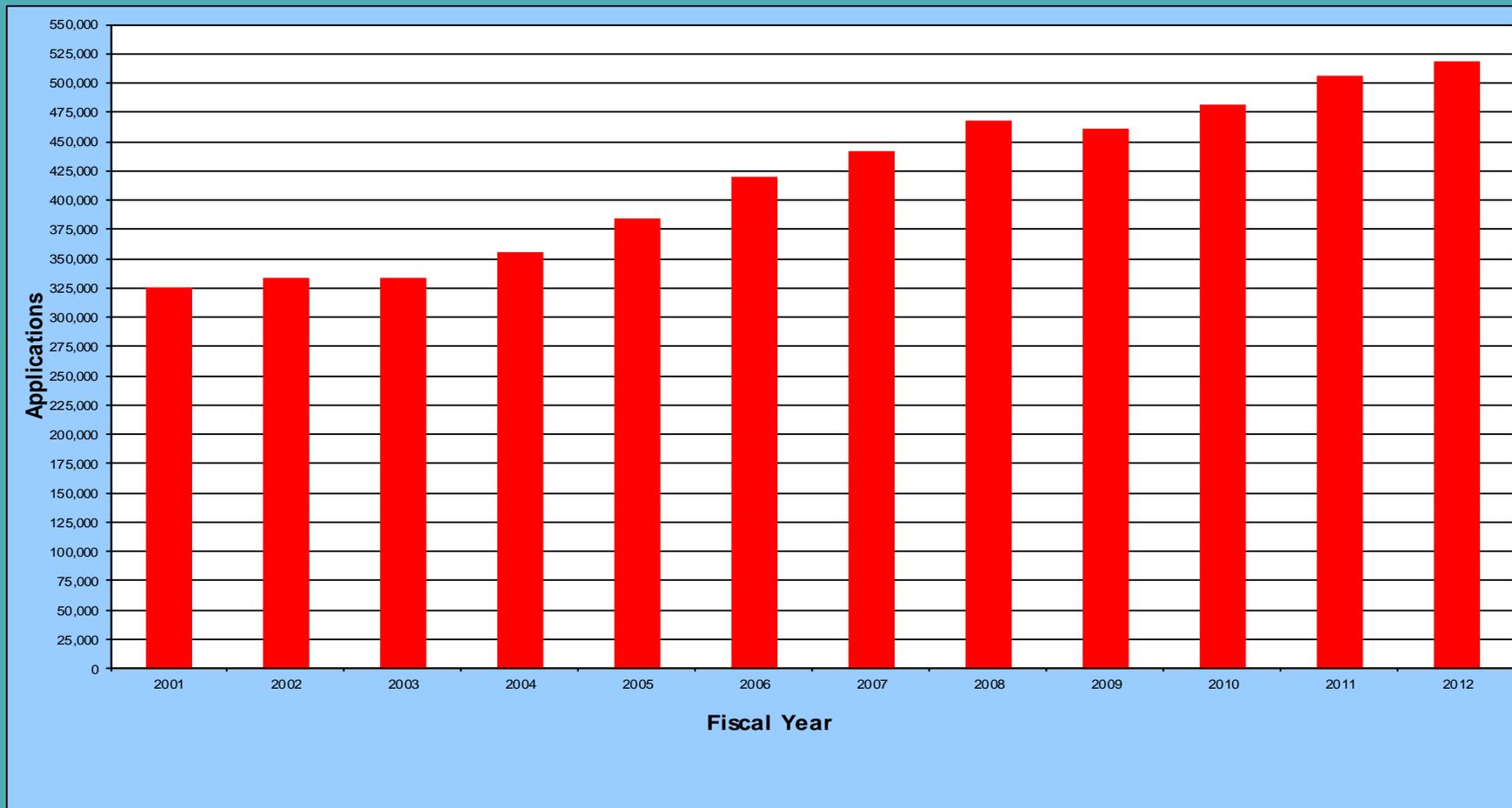


Robert Bahr
Senior Patent Attorney
Office of the Commissioner for Patents
October 16th, 2012



Total UPR Filings

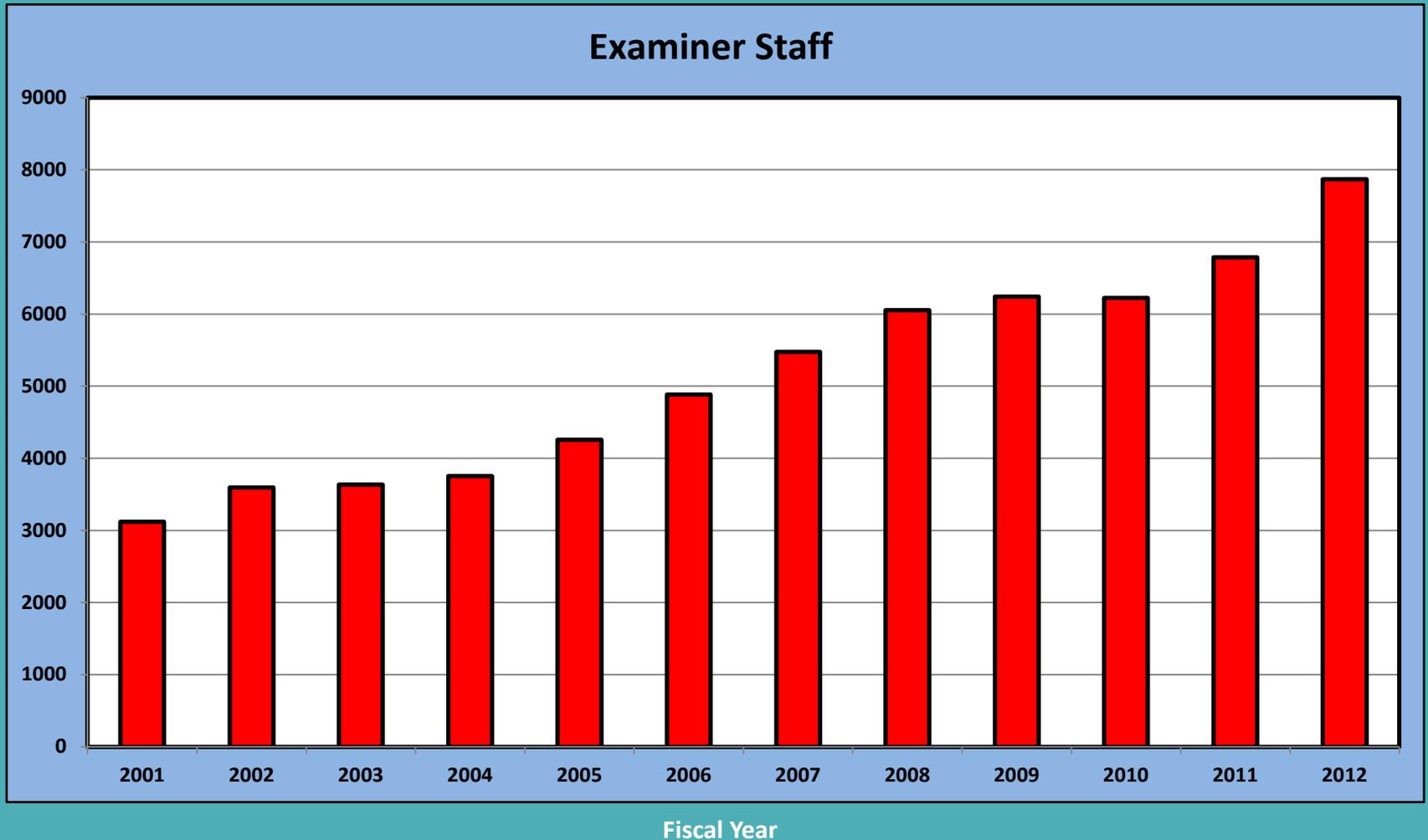
FY 2001 – FY 2012 (through September 24, 2012)



FY 2012 Total URR filings through August are currently 6.1% above FY 2011

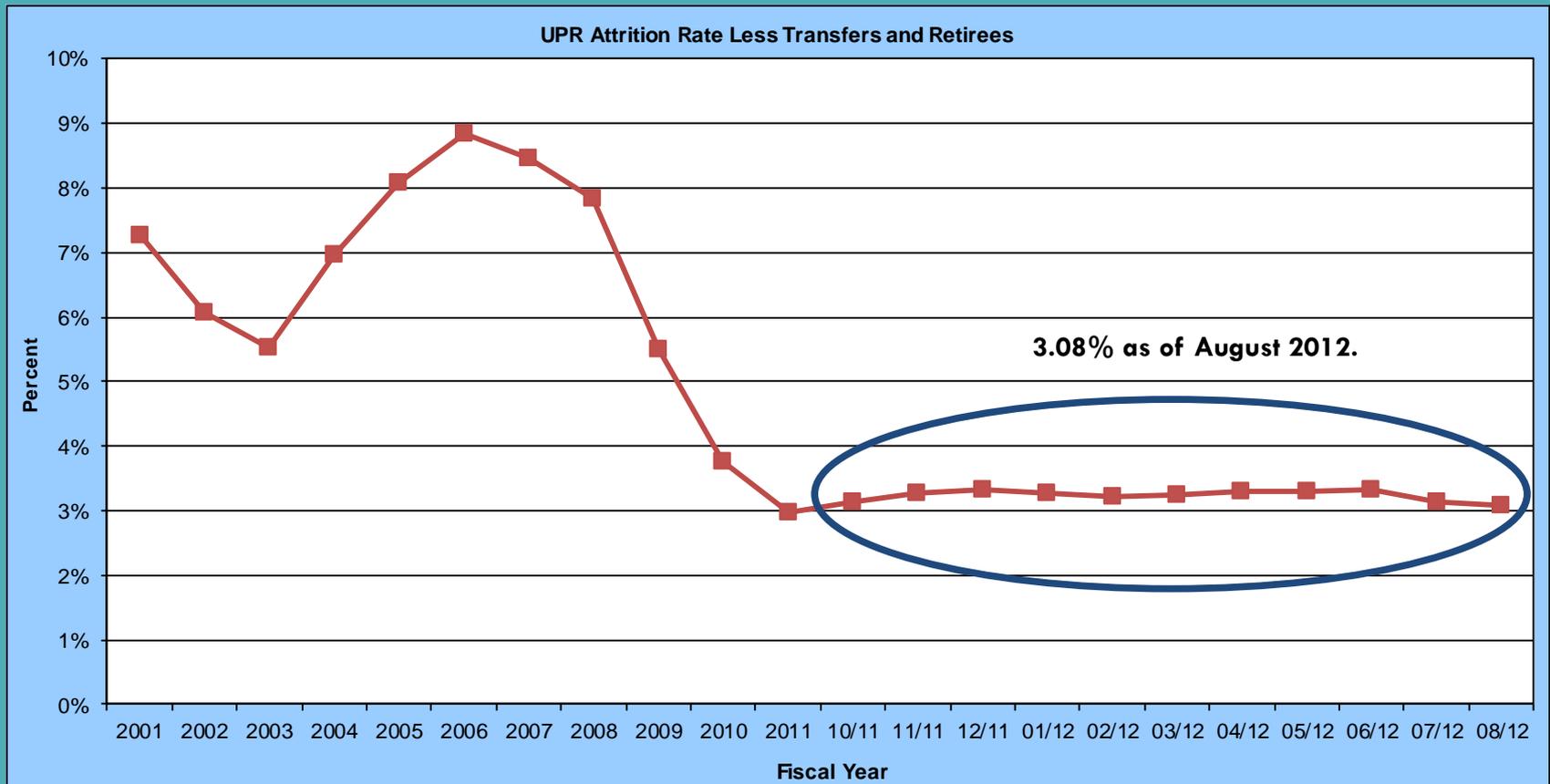


Patent Examiner Staffing FY 2001 – FY 2012 (through August)





12-Month Rolling Average UPR Examiner Attrition Rate Less Transfers and Retirees FY 2001 – FY 2012 (through August)



 The oval represents when monthly data begins.

Patent Examiner Staffing

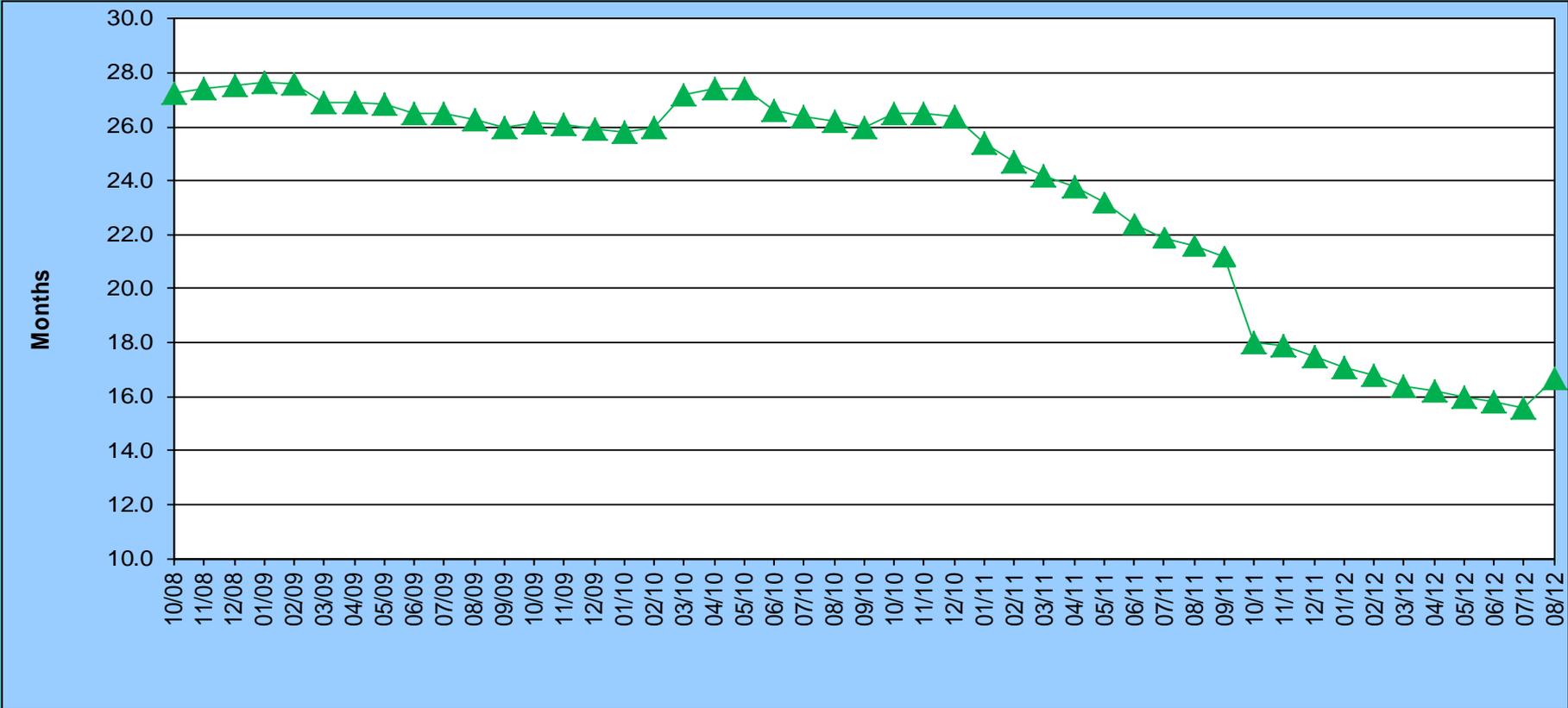
Patent Examiner Staff = 7,867

FY '12 HIRED = 1,506



Forward Looking First Action Pendency

FY 2009 – FY 2012 (through August)



Prioritized Examination (Track One)

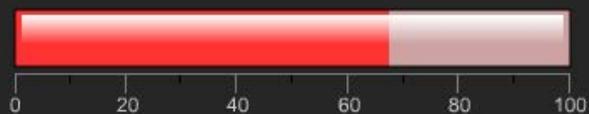


- “Fast track” examination
- Brings new inventions to the marketplace faster
- Statistics (statistics as of 9/17/12):
 - 5,629 petitions for prioritized examination
 - 95% of petitions granted
 - 5 months to final disposition
 - 935 notices of allowance mailed

Patents Dashboard



August 2012 Patents Data, at a Glance



Patents Related Provisions

Inventor's Oath/Declaration

Pre-Issuance Submission

Supplemental Examination

Miscellaneous Provisions

Board Related Provisions

Post Grant Review

Inter Partes Review

Covered Business Method Review



AIA Final Rules

(Effective September 16, 2012)



Inventor's Oath/Declaration

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



Inventor's Oath/Declaration

(Effective September 16, 2012)

- Inventor, assignee, or obligated assignee may file an application for patent as the applicant
- Inventor's oath/declaration need not identify the entire inventive entity, if a signed Application Data Sheet (ADS) is filed that includes identification of each inventor
- Filing of an inventor's oath/declaration may be postponed until a time period set forth in a Notice of Allowability expires, if a signed ADS is filed that includes identification of each inventor



Preissuance Submissions

(Effective September 16, 2012)

- 3rd parties to submit potentially relevant printed publications in another's patent application for consideration by the examiner to build the record before the examiner
- Requirements placed on third parties :
 - Written statement of relevance for each publication;
 - Fee; and
 - Timing requirements



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 (continued)

- May be filed by any member of the public (§ 1.290(a))
- No service on applicant required



Statutory Time Periods

- Must be made before the earlier of:
 - Date a notice of allowance is given or mailed;
- OR
- Later of:
 - 6 months after the date on which the application is first published by the Office (§ 1.290(b)(2)(i)); or
 - Date of first rejection of any claim by the examiner (§ 1.290(b)(2)(ii))



Notification to Applicant

- Applicant will not be notified of non-compliant submissions
 - Non-compliant submissions will not be made of record in the application
- Applicant will be electronically notified upon entry of a compliant submission in its application file provided applicant participates in the Office's e-Office Action program



Supplemental Examination

(Effective September 16, 2012)

- **New 35 U.S.C. 257** - a patent owner may request supplemental examination of a patent to “consider, reconsider, or correct information” believed to be relevant to the patent
- **Within 3 months from the filing date of the request** - Office must decide whether any of the items filed raises a substantial new question of patentability
- **If it is determined that a substantial new question is raised**, provide for a prompt resolution of any ex parte reexamination
- **A benefit is the avoidance of a post-patent process involving large submissions of unexplained documents (like IDS practice)**



Inequitable Conduct Immunization

- Information considered, reconsidered, or corrected during supplemental examination cannot be the basis for rendering a patent unenforceable, except that this immunity does not apply (35 U.S.C. 257(c)(1)-(2)):
 - To allegations pled in a civil action or notice to the patentee before the date of the request for supplemental examination, and
 - Unless the supplemental examination and any resulting *ex parte* reexamination is completed before the civil action is brought



Trial Rules

***Inter Partes* Review**
§§ 42.100 – 42.123

Post-Grant Review
§§ 42.200 – 42.224

Umbrella Trial Rules
§§ 42.1 – 42.80

**Covered Business
Method Patent Review**
§§ 42.300 – 42.304

**Derivation Proceeding
Proposed §§ 42.400 –
42.412**



Trial Structure

- Same basic structure for all the proceedings
- Reduction of burdens on the parties via:
 - Streamlining and converging issues for decision;
 - Use of page limits and electronic filing;
 - Use of conference calls; and
 - Institution of a trial on a claim-by-claim, ground-by-ground basis



Major Differences between IPR, PGR, and CBM

IPR

All patents are eligible

Petitioner has not filed an invalidity action and petition is filed no more than one year after service of infringement complaint for the patent

Only §§ 102 and 103 grounds based on patents or printed publication

PGR

Only FITF patents are eligible

Petitioner has not filed an invalidity action

Only §§ 101, 102, 103, and 112, except best mode

CBM

Both FTI & FITF patents are eligible, but must be a covered business method patent

Petitioner must be sued or charged w/ infringement

Only §§ 101, 102, 103, and 112, except best mode



Inter Partes Review: Features

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



Post-Grant Review

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



Covered Business Methods

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



Derivation

- Only a patent applicant may file
- Must be filed within 1 year of the date of the first publication of a claim to an invention that is the same or substantially the same as the earlier application's claim to the invention
 - “The first publication” means either a patent or an application publication under 35 U.S.C. 122(b), including a publication of an international application designating the U.S. as provided by 35 U.S.C. 374

First-Inventor-to-File

Effective on March 16, 2013

Micro-entity

75% fee discount effective
with new fee

Fee Setting

Planned to be effective on March 1, 2013

AIA Proposed Rules



First-inventor-to-file

(Effective March 16, 2013)

- Builds more transparent, objective, predictable, and simple system for judging novelty and obviousness
- Retains grace period to permit an inventor to disclose his/her invention and then file a patent application within 1 year of disclosure
- Harmonizes the prior art to be applied against a claimed invention in a patent application with other countries





Fee Setting Authority

- Authorizes USPTO to set or adjust fees by rule for 7 years
- Fees are set to recover only the aggregate estimated cost of operations
- Goals are to:
 - Collect revenue to reduce backlog and pendency and build a more financially-stable agency
 - Set individual fees to further key policy considerations while taking into account the cost of the particular service



Global Impacts of AIA

Cooperative Patent Classification

Global Dossier

International



Global Impacts of AIA

- AIA adopts international norms related to:
 - First-to-file
 - Prior user rights
 - Broadening the definition of prior art
 - Eliminating the *Hilmer* doctrine
 - Virtually eliminating the best mode requirement
- US Patent Reform:
 - Facilitates worksharing with international patent offices
 - Provides renewed opportunities to harmonize the international patent system



Cooperative Patent Classification (CPC)

- USPTO and EPO agree to cooperate on a joint classification system derived from IPC-based ECLA
- USPTO to move from USPC to CPC; EPO to move from ECLA to CPC
- CPC planned to be bi-laterally operational at EPO and USPTO



Why the USPTO is Pursuing CPC

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



Global Dossier

- USPTO proposal to provide all stakeholders secure, one-stop access to dossier and examination information of all family applications
- Global Dossier is now an initiative under the IP5 framework with WIPO on board as full partner



Global Dossier

- For more information – including a short video:

http://www.uspto.gov/patents/int_protect/gbldssr/index.jsp

- For questions, comments and input:

globaldossier@uspto.gov



Thank You