

Patent Public Advisory Committee Meeting

USPTO Implementation of the America Invents Act



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September 1, 2011



Status

- House of Representatives passed America Invents Act (AIA) on June 23, 2011
- Senate has cloture vote scheduled for September 6, 2011
- USPTO is proactively preparing for implementation should AIA be enacted

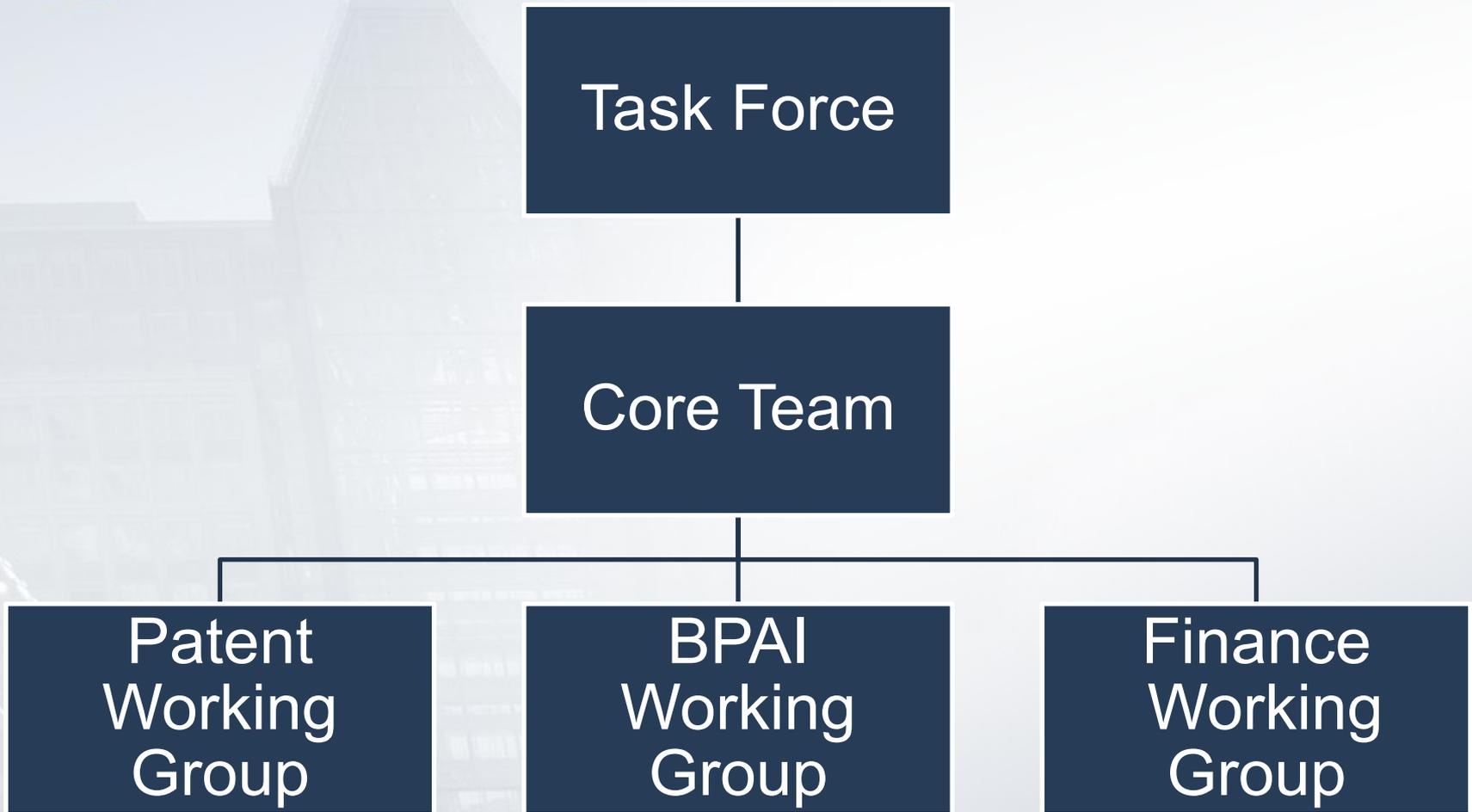


Challenges of Implementation

- Numerous provisions to implement simultaneously
 - Ensure that regulations and/or guidance is complimentary and not at odds
- Short time periods
 - Date of enactment, 12 months, 18 months
- Coordination required among various USPTO business units as well as other governmental agencies
 - Patents, BPAI, Finance
 - SBA, U.S. Trade Representative, Secretary of State, and Attorney General, and Secretary of Commerce
- Operational matters, for example, IT updates, training, hiring personnel



Organization





Group 1 Rulemakings and Other Actions

(60-Day and Under Effective Dates) (a.k.a. G1 Rulemakings)

Date of Enactment	10 Days After Date of Enactment	60 Days After Date of Enactment	October 1, 2011
<ul style="list-style-type: none"> • Reexamination transition for threshold • Tax strategies are deemed within the prior art • Best mode • Human organism prohibition • Patent term extension for drugs • Virtual and false marking • Venue change from DDC to EDVA for suits brought under 35 U.S.C. §§ 32, 145, 146, 154 (b)(4)(A), and 293 • OED Statute of Limitations • Fee Setting Authority • Establishment of micro-entity 	<ul style="list-style-type: none"> • Prioritized examination • 15% transition surcharge 	<p>Electronic filing incentive</p>	<p>Reserve fund</p>



Group 2 Rulemakings

(12-Month Effective Date) (a.k.a. G2 Rulemakings)

- Inventor's oath/declaration
- Third party submission of prior art for patent application
- Supplemental examination
- Citation of prior art in a patent file
- Priority examination for important technologies
- *Inter partes* review
- Post-grant review
- Transitional post-grant review program for covered business method patents



Group 3 Rulemakings and Other Actions

(18-Month Effective Date) (a.k.a. G3 Rulemakings)

- First-Inventor-to-File
- Derivation proceedings
- Repeal of Statutory Invention Registration



Studies: USPTO as Lead Agency

Topic	Objective	Due Date from Enactment
International Protection for Small Businesses	Report on how to help small business with international patent protection, including a revolving fund loan or grant program to defray costs	4 months
Prior User Rights	Report on the operation of prior user rights in other industrialized countries	4 months
Genetic Testing	Report on providing second opinion genetic diagnostic testing	9 months
Misconduct Before the Office	Report on impact of new statute of limitations provisions barring disciplinary action in response to substantial evidence of misconduct before the Office	Every 2 years
Satellite Offices	Report on the rationale for selecting the location of satellite offices, progress in establishment, and achieving identified purposes	3 years
Virtual Marking	Report on the effectiveness of the virtual marking as an alternative to physical marking articles	3 years
Implementation of AIA	Report on how AIA is being implemented by the USPTO and its effect on innovation, competitiveness, and small business access to capital	4 years



Studies: USPTO as Consultant

Topic	Lead Agency	Objective	Due Date from Enactment
Effects of First-Inventor-to-File on Small Business	Small Business Administration	Report on effects of small businesses switching to a first-inventor-to-file system	1 year
Patent Litigation	General Accountability Office	Report on impact of patent infringement litigation by non-practicing entities	1 year

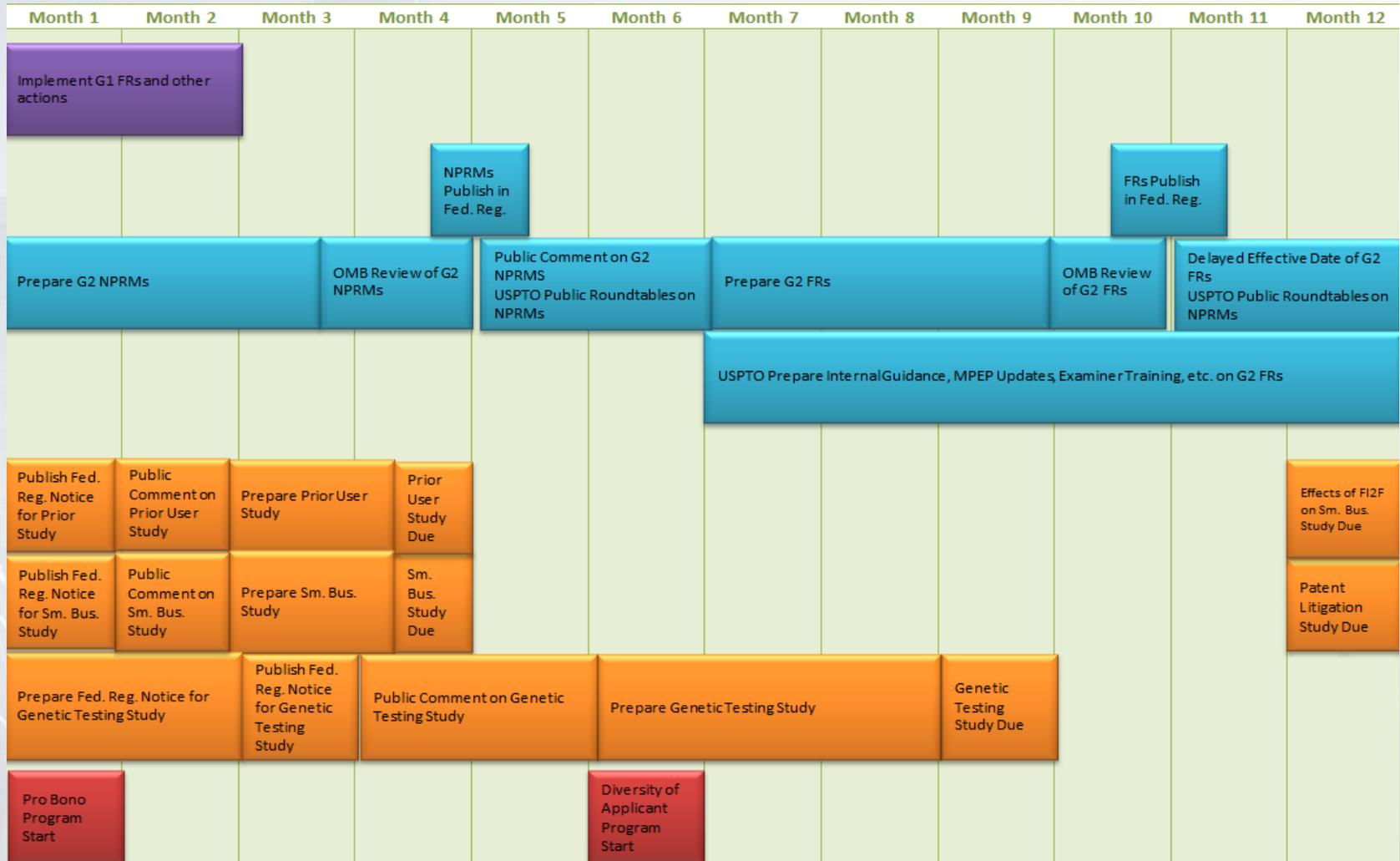


Programs: USPTO to Establish

Topic	Objective	Due Date from Enactment
Pro Bono	Directs USPTO to work with IP law associations to establish pro bono programs to assist financially under-resourced independent inventors and small businesses	Immediately
Diversity of Applicants	Requires USPTO to establish methods for studying diversity of patent applicants	6 months
Patent Ombudsman for Small Businesses	Requires USPTO to establish and maintain a Patent Ombudsman Program to provide support and services to small business concerns and independent inventors	12 months
Satellite Offices	Requires USPTO to establish 3 or more satellite offices in the U.S.	3 years



Timeline: Major Milestones





Opportunities for Public Input

- Pre-enactment stakeholder meetings
 - Two sessions held in August 2011
- Notice-and-comment rulemaking
 - Formal comments
- Public roundtables
- Email: aia_implementation@uspto.gov
 - Informal comments
- AIA Microsite



AIA Micro-Site

http://www.uspto.gov/patents/init_events/aia_implementation.jsp

- One-stop shopping for public regarding AIA implementation
- Regularly updated
- Preparing for phase II to release upon AIA enactment

The screenshot shows the USPTO website's navigation and content for the AIA implementation. At the top, there is a search bar and a navigation menu with links for Home, Help, Site Index, and Contact Us. Below the search bar is a secondary navigation menu with links for About USPTO, Patents, Trademarks, IP Law & Policy, Products & Services, Careers, Inventors, News & Notices, eBusiness/Alerts, FAQs, and For Kids. The main content area features a sidebar with a list of links including Patent Process, Patent Classification, Patent Forms, Statistics, Electronic Business Center, Patent Laws, Regulations, Policies & Procedures, Resources and Guidance, Office of Data Management, Announcements, Initiatives & Events (with sub-links for Biotechnology / Chemical / Pharmaceutical Conferences, Patent Cooperation Treaty, and Patent Prosecution Highway), International Protection, Employee Locator, and Contact Patents. The main content area has a heading for "Leahy-Smith America Invents Act Implementation" and a photograph of David Kappos and Lamar Smith. Below the photo is a caption and a paragraph of text explaining the AIA and the USPTO's role in its implementation. At the bottom, there is a list of implementation documents organized by topic area.

United States Patent and Trademark Office
An Agency of the Department of Commerce

Home | Help | Site Index | Contact Us

SEARCH: GO

HOW DO I: - Select an Option - GO

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Patent Laws, Regulations, Policies & Procedures

Resources and Guidance

Office of Data Management

Announcements

Initiatives & Events

- Biotechnology / Chemical / Pharmaceutical Conferences
- Patent Cooperation Treaty
- Patent Prosecution Highway

International Protection

Employee Locator

Contact Patents

Leahy-Smith America Invents Act Implementation

Under Secretary of Commerce for Intellectual Property and Director of the USPTO David Kappos (right) talks with House Judiciary Committee Chairman Lamar Smith after Kappos' House testimony March 30.

The Leahy-Smith America Invents Act (AIA), H.R. 1249, passed by the U.S. House of Representatives on June 23, 2011, and currently pending before the U.S. Senate, proposes significant and far-reaching changes to U.S. patent law. Although patent reform legislation is still pending before Congress and neither its passage nor enactment can be presumed, the USPTO would like to proactively engage with the public to best prepare for the timely and effective implementation of the legislation should it be enacted.

If this legislation is enacted, the USPTO will need to undertake a series of rulemakings to implement the Act. Because several provisions of the AIA require implementation within a period of one year from enactment, expeditious rulemaking proceedings will be required. Given this tight time frame, preliminary input from our stakeholders and the public on implementation of the key provisions would facilitate this process even before the legislation has been enacted.

Therefore, we are establishing this website to provide information to our stakeholders and the public on the legislation and USPTO's actions to implement the provisions of the AIA, and to seek your preliminary input and comments. We will provide updates on this site throughout the implementation process. While any comments you provide on the site are informal and not treated as part of a formal request for comments or a rulemaking, we intend to review and consider comments provided on the site. As appropriate, and assuming the legislation is enacted, the USPTO plans to issue formal notices of proposed rulemaking and will, of course, respond to comments received through that formal process.

Documents posted below under "Implementation documents" are organized by topic area:

- Patents
- Board of Patent Appeals and Interferences (BPAI)
- Fees and Budgetary Issues
- Congressionally-Directed Studies and Reports
- Miscellaneous

If you wish to submit comments, we ask that you submit your comment to the attention of the contact person for that area (see below) and reference in the subject line one of the five topic areas and the specific issue addressed in the comment. Comments submitted by email are preferred and may be addressed to aia_implementation@uspto.gov. Comments may also be mailed to Mail Stop Comments-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, marked to the attention of Hiram Bernstein. Comments will be posted on the USPTO website. We recommend that you do not include information, such as an address or phone number, that you do not want to be made public.

Thank You



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