
Patent Office Procedures Under AIA

by

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Overview Patent Office Procedures Under AIA



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Based on USPTO FAQs: http://www.uspto.gov/aia_implementation/faq.jsp#heading-14

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Best Mode



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Best Mode

Best Mode provision 35 U.S.C. 282(a)(3) effective date in the AIA is September 16, 2011

The failure to disclose the best mode shall no longer be a basis, in patent validity or infringement proceedings, on which any claim of a patent may be canceled or held invalid or otherwise unenforceable. As stated above, this new practice does not affect the patent examination practice.

Derivation Proceedings



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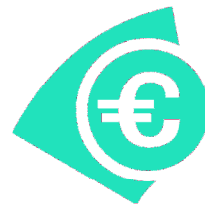


Derivation Proceedings

Derivation provision effective date in the AIA is March 16, 2013.

A derivation proceeding requires that an applicant for patent file a petition to institute the proceeding. The petition must set forth with particularity the basis for finding that an inventor named in an earlier application derived the claimed invention from the petitioner. The petition must be made under oath and supported by substantial evidence. 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.

User Fees



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User Fees

15% increase in fee rates became effective at 12:00 a.m. on Monday, September 26, 2011.

Prioritized Examination fees became effective at 12:00 a.m. on Monday, September 26, 2011 and are \$4,800.00 large/ \$2,400.00 small.

Electronic Filing Incentive become effective at 12:00 a.m. on Tuesday, November 15, 2011 with additional \$400 (and \$200 for small entity) for an original patent application (except for a design, plant, or provisional application) that is not filed electronically.

Micro Entity fees: the AIA do not permit the USPTO to apply the 75% micro entity fee discount until the micro entity fee for a specific item is set or adjusted using the fee setting authority provided in section 10 of the Act.

Comments on fees due by 11/5/12

“pay to play” = big \$\$\$

First Inventor to File



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First Inventor to File

First Inventor to File effective date in the AIA is March 16, 2013.

Only inventors are entitled to a patent. Someone who copies another's idea cannot be the inventor.

Regardless of whether the application was filed before or after the first-inventor-to-file provisions take effect on March 16, 2013, disclosure one month prior to a filing date is not prior art to the claimed invention by virtue of a one year grace period.

One word: Absolute Novelty!

Double condom: provisional plus NDA before third party disclosures

Best Practices: e-file , use PTO forms, record assignments asap, used layered provisionals (heart of the onion, plus layers all within one year), "The World is Flat" = if not adding value get out of the equation, teach inventors "learn to fish," always consider trade secrets, simple but valuable = patent, complex and valuable = trade secret, Mötley Crüe trade secret case, use "clean room" techniques for proof of trade secret, keep lab notebooks.

Inter Partes Reexamination



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Inter Partes Reexamination

Inter Partes Reexamination effective date in the AIA is September 16, 2011.

The AIA elevates the standard for granting a request for inter partes reexamination, wherein under the new standard, the information presented in an inter partes reexamination request must provide a showing that there is a reasonable likelihood that the requester will prevail with respect to at least one of the patent claims challenged in the request. The standard for ex parte reexamination remains unchanged (except “pay to play” = big \$).

Inter Partes Review



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Inter Partes Review

Inter Partes Review effective date in the AIA is September 16, 2012.

All patents issuing from applications subject to first-inventor-to-file provisions of the AIA as well as those patents issuing from applications subject to the first-to-inventor provisions in current Title 35 are eligible for an inter partes review.

A petitioner for inter partes review may request to cancel as unpatentable one or more claims of a patent 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.

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Post Grant Review



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Post Grant Review

Post Grant Review effective date in the AIA is September 16, 2012.

With limited exceptions, only those patents issuing from applications subject to first-inventor-to-file provisions of the AIA are eligible for post grant review.

A petitioner for post grant review may request to cancel as unpatentable one or more claims of a patent on any ground that could be raised under paragraph (2) or (3) of 35 U.S.C. 282(b) relating to invalidity (i.e., novelty, obviousness, written description, enablement, indefiniteness, but not best mode).

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Prioritized Examination



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Prioritized Examination (Track 1)

Prioritized Examination (Track 1) became effective at 12:00 a.m. on Monday, September 26, 2011.

Prioritized examination is a procedure for expedited review of a patent application for an additional fee. The Office's goal for prioritized examination is to provide a final disposition within twelve months of prioritized status being granted.

"pay to play" = big \$

Different than accelerated exam: no search, no supporting documents, limited to first 10,000 filings but limit may be increased.

Must use EFS-web.

Need signed declaration with new application filing.

Pay for excess claims at time of filing and limited to 4 independent and 30 claims total, no multiple dependent claims.

Request must be made at time of filing

Best Practice: include authorization to charge deposit account

Inventor's Oath or Declaration



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Inventor's Oath or Declaration

Inventor's Oath or Declaration effective date in the AIA is September 16, 2012.

An inventor must state in his/her oath/declaration that (i) he/she is an original inventor of the claimed invention; and (ii) he/she authorized the filing of the patent application for the claimed invention. An inventor is no longer required to (i) state that he/she is the first inventor of the claimed invention; (ii) state that the application filing is made without deceptive intent; or (iii) provide his/her country of citizenship.

Before 9/16/12 = old forms, 9/16/12 or after = new forms.

PCT designating US filing date determines which forms to use.

Simplifies “hostile inventor” and other situations for companies.

“duty to assign” very important in employment and joint venture and “work for hire” contracts.

Tax Strategies



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Tax Strategies

Tax Strategies effective date in section 14 of the AIA is September 16, 2011.

Applicants will no longer be able to rely solely on the novelty or non-obviousness of a tax strategy embodied in their claims in order to distinguish the claims from the prior art.

Tax patent portfolio values lowered.

Tax patents dead?

Transitional Program for Covered Business Method Patents



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Transitional Program for Covered Business Method Patents

Covered Business Method Patents effective date in the AIA is September 16, 2012.

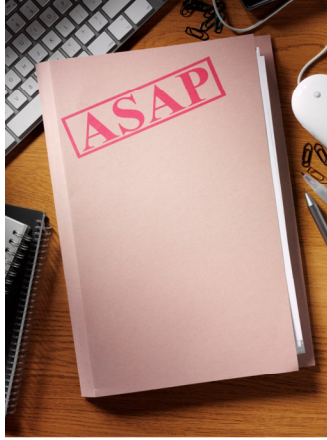
The AIA provides that the covered business review provision sunsets after 8 years from the effective date of the provision. Accordingly, the Office will not accept new petitions for covered business method review filed on or after September 16, 2020.

A covered business method review is available for all patents issuing from applications subject to first-inventor-to-file provisions of the AIA as well as those patents issuing from applications subject to the first-to-inventor provisions in current Title 35, provided that the patent is drawn to a covered business method. The AIA specifies that a covered business method patent is a patent that claims a method or corresponding apparatus for performing data processing or other operations used in the practice, administration, or management of a financial product or service, except that the term does not include patents for technological inventions. The AIA does not specify what a patent for a technological invention covers, and therefore, the Office has promulgated a rule for technological invention.

Business method portfolio values lowered.

Business method patents dying?

Preissuance Submissions



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Preissuance Submissions

Preissuance Submissions effective date in the AIA is September 16, 2012.

A third party may file a preissuance submission in any non-provisional utility, design, or plant application, as well as in any continuing application, even if the application to which the submission is directed has been abandoned or has not been published. Third-party preissuance submissions may not be filed in any reissue application or reexamination proceeding.

A third-party preissuance submission statutorily must be made in a patent application before the earlier of: (a) the date a notice of allowance under 35 U.S.C. 151 is given or mailed in the application; or (b) the later of (i) six months after the date on which the application is first published under 35 U.S.C. 122 by the Office, or (ii) the date of the first rejection under 35 U.S.C. 132 of any claim by the examiner during the examination of the application.

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Citation of Patent Owner Statements in a Patent File



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Citation of Patent Owner Statements in a Patent File

Citation of Patent Owner Statements in a Patent File effective date in the AIA is September 16, 2012.

Either a third party or the patent owner may cite patent owner statements in a patent file.

A statement of the patent owner filed by the patent owner 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 the patent may be filed.

Basically estoppels or tooting your own horn?.

Supplemental Examination



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Supplemental Examination

Supplemental Examination effective date in the AIA is September 16, 2012.

The patent owner may request a supplemental examination for a patent so that the Office can consider, reconsider, or correct information believed to be relevant to the patent.

The patent owner may present any information believed to be relevant to the patent. The information is not limited to patents or printed publications, but instead may include information concerning any ground of patentability, i.e., patent eligible subject matter, anticipation, obviousness, written description, enablement, best mode, and indefiniteness.

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Oath & Declaration in More Detail



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Inventor's Oath or Declaration

Substitute statement can be filed when the inventor is: (i) deceased; (ii) legally incapacitated; (iii) unable to be found or reached after diligent effort; or (iv) refuses to sign an oath/declaration; By:

(i) the inventor's legal representative; (ii) the assignee; (iii) a party to whom the inventor is under an obligation to assign; or (iv) a party who otherwise shows sufficient proprietary interest in the claimed invention.

An assignment may include the statements required in an oath/declaration, wherein the applicant may file a combined inventor's oath/declaration and assignment document in the Office.

Forms related to the inventor's oath/declaration provision are available on the Office's AIA microsite as well as on the Office's form site, including an inventor declaration for an original (non-reissue) application, inventor declaration for a reissue application, substitute statement, and Application Data Sheet (ADS).

There is new statutorily-mandated language that must be included in the inventor oath/declaration after September 16, 2012, that is not included on the inventor oath/declaration form available before that date. The new statutorily mandated language includes: (1) a statement that "the application was made or authorized to be made by the affiant or declarant," and (2) the acknowledgement of penalties clause must refer to "imprisonment of not more than 5 years."

Not needed until Notice of Allowance (but will cost \$3K).

Change of inventor with no oath/declaration = \$1.7K.

Best Practice: Use PTO forms.

User Fees in More Detail



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User Fees Details

Like all fees, the USPTO is not authorized to apply a micro entity discount to the prioritized exam fee without setting the fee using the section 10 fee setting process.

Fees such as international stage PCT fees, certain petition fees, enrollment fees, and service fees will not be increasing by 15%.

Applicants are encouraged to provide authorization in the application file to charge fees to a specified Deposit Account to avoid insufficient payment of fees.

The USPTO published a notice of proposed rulemaking (NPRM) to set and adjust patent fees using the section 10 fee setting authority. The NPRM and supporting materials are available at http://www.uspto.gov/aia_implementation/fees.jsp#heading-1. The public comment period ends on November 5, 2012. The Office will issue a final rulemaking after considering the comments from the public. The Office expects most of the new fees could be effective during the Spring of 2013.

“pay to play” = big \$: post issuance submissions, inter partes review (IPR), supplemental examination (SE), post grant review (PGR).

SE = \$7K for request, plus \$20K for examination, PGR = <20 claims \$35.8K, 61-70 \$125.3K, groups of ten \$35.8K, IPR = <20 claims \$27.2K, 61-70 \$95.2K, groups of ten \$27.2K.

What small inventor or start up can afford this?

Proposed User Fees

Description	Current Fees		Proposed Fees and % Change		
	Current Large Entity Fee	Current Small Entity Fee	Proposed Large Entity Fee	Proposed Small Entity Fee	Proposed Micro Entity Fee
Basic Filing, Search, and Exam - Utility (total)	\$1,250	\$625	\$1,600 28%	\$800 28%	\$400 -36%
Request for Prioritized Examination	\$4,800	\$2,400	\$4,000 -17%	\$2,000 -17%	\$1,000 -58%
Independent Claims in Excess of Three	\$250	\$125	\$420 68%	\$210 68%	\$105 -16%
Claims in Excess of Twenty	\$60	\$30	\$80 33%	\$40 33%	\$20 -33%
Multiple Dependent Claims	\$450	\$225	\$780 73%	\$390 73%	\$195 -13%
Utility Application Size Fee – For each Additional 50 Sheets that Exceed 100 Sheets	\$310	\$155	\$400 29%	\$200 29%	\$100 -35%

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“pay to play” = big \$:

Ex Parte Re-exam = \$17.6K with \$13.43K refund if not granted.

Increased claims fees for more than 3 and 20 = like Japan?

RCE’s \$930 to \$1.7K.

Notice of Appeal: filing notice \$1.5K, filing appeal brief \$2.5K

What small inventor or start up can afford this?

Proposed User Fees (Cont'd)

Description	Current Fees		Proposed Fees and % Change		
	Current Large Entity Fee	Current Small Entity Fee	Proposed Large Entity Fee	Proposed Small Entity Fee	Proposed Micro Entity Fee
First Request for Continued Examination (RCE)	\$930	\$465	\$1,200 29%	\$600 29%	\$300 -35%
Second and Subsequent Request for Continued Examination (NEW)	\$930	\$465	\$1,700 83%	\$850 83%	\$425 -9%
Notice of Appeal	\$620	\$310	\$1,000 61%	\$500 61%	\$250 -19%
Filing a Brief in Support of an Appeal in Application or <i>Ex Parte</i> Reexamination Proceeding	\$620	\$310	\$0 -100%	\$0 -100%	\$0 -100%
Appeal Forwarding Fee (NEW)	NEW	NEW	\$2,000 N/A	\$1,000 N/A	\$500 N/A

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Proposed User Fees (Cont'd)

Description	Current Fees		Proposed Fees and % Change		
	Current Large Entity Fee	Current Small Entity Fee	Proposed Large Entity Fee	Proposed Small Entity Fee	Proposed Micro Entity Fee
Publication Fee for Early, Voluntary, or Normal Publication	\$300	N/A	\$0 -100%	\$0 -100%	\$0 -100%
Utility Issue Fee	\$1,740	\$870	\$960 -45%	\$480 -45%	\$240 -72%
<i>Combined Total – Pre-grant Publication and Issue Fee - Utility</i>	<i>\$2,040</i>	<i>\$1,170</i>	<i>\$960 -53%</i>	<i>\$480 -59%</i>	<i>\$240 -79%</i>
Maintenance Fee Due at 3.5 Years (1st Stage)	\$1,130	\$565	\$1,600 42%	\$800 42%	\$400 -29%
Maintenance Fee Due at 7.5 Years (2nd Stage)	\$2,850	\$1,425	\$3,600 26%	\$1,800 26%	\$900 -37%
Maintenance Fee Due at 11.5 Years (3rd Stage)	\$4,730	\$2,365	\$7,400 56%	\$3,700 56%	\$1,850 -22%

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Proposed User Fees (Cont'd)

- ❑ Other proposed fees are listed in the tables attached to your conference package.
- ❑ These are the USPTO proposed fees.
Comment on them by November 5, 2012



Prioritized Examination in More Detail



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Prioritized Examination (Track 1)

The fees required to be paid upon filing for prioritized examination are:

- i. Basic filing fee
- ii. Search fee
- iii. Examination fee
- iv. Publication fee
- v. Track I processing fee
- vi. Track I prioritized examination fee
- vii. Application size fee (specification and drawings exceed 100 sheets of paper)
- viii. Excess independent claim fee (number of independent claims exceeds three).
- ix. Excess claim fee (number of claims exceeds twenty).

If any fee is unpaid, request for Prioritized Examination dismissed except with explicit authorization to charge any additional required fees.

The prioritized examination program grants special status until one of the following occurs:

- i. Applicant files a petition for extension of time to extend the time period for filing a reply.
- ii. Applicant files an amendment to amend the application to contain more than four independent claims, more than thirty total claims, or a multiple dependent claim.
- iii. Applicant subsequently files a request for continued examination (RCE).
- iv. Applicant files a notice of appeal.
- v. Applicant files a request for suspension of action.
- vi. A notice of allowance is mailed.
- vii. A final Office action is mailed.
- viii. The application is abandoned.
- ix. Examination is completed as defined in 37 CFR 41.102.

“pay to play” = big \$

NFOA by month 4 for earlier of first 10,000 filings, 6 months average to Notice of Allowance with 1 year max, after NFOA applicant must take charge, no publication, can be used to avoid 3rd party submissions and post grant review, may create “false patents.”

International Filing Considerations



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International Filing Considerations (from Gene Quinn “Important New Changes to US Patent Law for PCT Applicants”

<http://www.ipwatchdog.com/2012/08/05/important-new-changes-to-us-patent-law-for-pct-applicants/id=27145/>)

Effective September 16, 2012, the requirement that the inventors be named as applicants solely for the purposes of U.S. designation is no longer required.

An assignee or other person to whom the inventor is under an obligation to assign the invention, or who otherwise has sufficient proprietary interest in innovation, may be the applicant even when the U.S. is designated.

There is continued requirement that a U.S. inventor’s oath or declaration be submitted.

A declaration of inventorship can currently be submitted as part of the PCT application pursuant to PCT Rules 4.17(iv) and 51bis.1(a)(iv). After September 16, 2012, the current language of the PCT Rule 4.17(iv) declaration will not comply with the requirements of the AIA for international applications filed on or after September 16, 2012.

Simultaneous foreign and US filings to take advantage of 102(e) will no longer be needed as foreign filing date will apply after 3/16/13.

Best Practice: file before 3/16/13 in most cases to avoid AIA or after in limited cases to take advantage of AIA.

International Filing Considerations (cont.)



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International Filing Considerations (cont.)

PCT Applicants that will seek to designate the U.S. on or after September 16, 2012, should be aware that it will be unnecessary to identify the inventor as the applicant for international patent applications filed on or after September 16, 2012 even though amendments to the PCT Regulations addressing this U.S. law change will likely not enter into effect before January 1, 2013.

Updates to the PCT-SAFE software, as well as other PCT e-filing software, will likely take some time. WIPO expects that the e-filing software will be updated by January 2013. Applicants using PCT-SAFE may, however, simply indicate that the applicant is applicant “for all designated States” and ignore any warning messages. (PCT Safe software may be up to date now!)

Despite the fact that PCT software was not up to date on September 16, 2012, the PCT/RO/101 has been modified accordingly.

PCT transmittal form also up to date.

Real world example: USPA filed 10/11, PCT filed 10/12, filed assignment before PCT filing, used new PCT forms with company listed as applicant, need to correct checking inventor as “inventor and applicant” instead of just “inventor” before month 30.

Adapting Prosecution Strategies to the AIA



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Adapting Prosecution Strategies to the AIA (from Lisa M. Caldwell “America Invents Act Patent Prosecution Strategy” http://www.klarquist.com/Articles/39_AIA%20Patent%20Prosecution%20Strategy.pdf)

File as soon as have an enabling disclosure;

Keep pre-AIA patent filings isolated in their own patent families to limit prior art;

Discourage pre-patent filing publication/disclosure in most instances (Absolute Novelty!);

Pay closer attention to competitor published applications, with new option for submitting prior art;

Pay extra to get urgent patent applications examined;

Use supplemental examination to have additional references considered in issued patents.

ALWAYS keep USPA pending due to lack of clarity in the patent laws and to capture future infringers.

Act like IBM, patent or publish or keep as trade secret.

“Top 10 Things You Need to Know About the Leahy-Smith America Invents Act” by Patrick Doody

<http://www.pillsburylaw.com/top%2010%20things%20you%20need%20to%20know%20about%20the%20americ%20invents%20act%20revised%2010%204%2011.pdf>

File provisional applications based on beefed up invention disclosures

Private sales and offers to sell most likely not “disclosures”

Cannot swear behind third party disclosure based on conception and RTP (C&RTP)

Foreign entities may wish to file in foreign country first for earlier 102(e) date (C&RTP by B -> JP filing by A -> USPA by B within one year of C&RTP -> PCT by A designating US -> PCT by A published and prior art against B based on JP by A filing date)

Disclosure by A -> Disclosure by C independently of A -> USPA by A within one year -> neither disclosure is prior art

For derivation what is “first publication” if claims publish and are later amended to include derived subject matter?

USPA by B derived from A -> Disclosure by C independently of A or B -> USPA by B publishes -> USPA by A -> derivation action by A prevails -> does disclosure by C less than one year from USPA by A invalidate A’s claim?

USPA A claiming x before AIA -> AIA 3/16/13 -> USPA B claiming x + y filed as CIP of A -> USPA B cancels claim to x and claim to priority to USPA A -> FIF applies to USPA B but claims to Y may still benefit from interference practice

For supplemental examination, avoid disclosing prior art that may invalidate a patent claim or disclose if patentee agrees not to file supplemental examination based on that prior art

No Tax Strategy Patents

Civil litigation stayed for covered business methods patents

Use expedited prosecution to try to avoid 3rd party submissions

Re-examine patent marking program, as now easier

Conclusion



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AIA is death nail for small inventors and start ups?

Other sources:

"WHEN TRADE SECRETS CANNOT BE PROTECTED BY AN NDA"
(<http://www.ndasforfree.com/TradeSecretsCannotProtect.html>).

"New rules implementing the AIA - Assignee as Applicant"
(http://www.gtlaw.com/portalresource/PR_assignees).

"Practical patent portfolio strategies for the America Invents Act"
(<http://www.beyerlaw.com/pdf/IAMv51p31EVanGieson%20JanFeb%202012.pdf>).

"How Will Patent Reform Affect the Software and Internet Industries?"
(<http://www.finnegan.com/resources/articles/articlesdetail.aspx?news=345b9502-13f7-4dbe-b40d-dcb671ff3c44>).

"Developing a Patent Strategy" (<http://www.lowenstein.com/files/Publication/505ffae1-d16c-4f8e-a9be-2b14921567dc/Presentation/PublicationAttachment/5198f8ce-9fcd-4227-af9a-2cd564104c4c/Important%20Considerations%20for%20Patent%20Strategies.pdf>).

"Strategic Planning in the Wake of the New Prior Art Provisions in the America Invents Act"
(<http://www.finnegan.com/resources/articles/articlesdetail.aspx?news=2a5d1c67-7407-433a-8cdb-8094ec620379>).

"Patent Reform 2011"
(http://www.fr.com/files/Uploads/Documents/Fasse,%20Harvey,%20DeYoung_revised%20Patent%20Reform%20slides%20for%20UMASS.pdf).

"Inventor's Oath or Declaration" (<http://www.aiarulemaking.com/rulemaking-topics/group-2/inventors-oath-declaration.php>).

"Proposed Patent Fees Under the Leahy-Smith America Invents Act: Be Prepared for Sticker Shock" (<http://www.wardandsmith.com/articles/proposed-patent-fees-under-the-leahy-smith-america-invents-act-be-prepared-for-sticker-shock>)

"AIA Practice Tips: Using New Inventor Declaration Forms"
(<http://www.patentlyo.com/patent/2012/08/aia-practice-tips-using-new-inventor-declaration-forms.html>).



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The Villamar Firm is a Professional Limited Liability Company (PLLC) law firm based in Virginia with easy access to the [United States Patent and Trademark Office](#). The Villamar Firm specializes in the practice of Intellectual Property Law, including [patents](#), [trademarks](#), [copyrights](#), [trade secrets](#) and [computer and internet law](#).

At The Villamar Firm we strive to provide the best possible work product, at a competitive price, and with superior client service.

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Carlos R. Villamar, J.D., M.S.E.E., B.S.E.E.

attorneys



Carlos R. Villamar is a founding partner of **The Villamar Firm**.*

Areas of Practice: Patents, Trademarks, Copyrights, Licensing.

Mr. Villamar is a patent attorney with broad experience assisting clients with foreign and domestic patent application preparation and prosecution, opinion work, litigation, and IP counseling.

*Mr. Villamar is licensed to practice US state law in Virginia and the District of Columbia.

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Mr. Villamar's expertise covers a wide variety of technologies, including wired, wireless, optical, terrestrial broadcast and satellite communications, neural networks, fuzzy logic and artificial intelligence, encryption, digital signal processing, speech recognition and language understanding, sound and image processing, video processing, medical imaging, video games, on-line gaming, gaming engines, physics engines, 3D graphics, virtual worlds, Digital Rights Management, e-commerce, military technologies, radar, sonar, fighter aircraft, missiles, ground guidance, heads-up displays, computers and architectures, computer networks and security, semiconductors, device manufacturing, nanotechnology, oil and gas exploration, renewable energy, electrical, solar, thermal and wind power, automotive technologies, and electromechanical technologies.

Prior to founding **The Villamar Firm**, Carlos gained extensive experience in numerous aspects of intellectual property law as an attorney in large, national general practice and IP boutique law firms and as a patent examiner in the Speech Signal Processing Group of the [U.S. Patent Trademark Office](#).

As an electrical engineer, Mr. Villamar has over nine years of commercial experience, including production design and testing for the [Standard Missile](#) Program at the [General Dynamics Corporation](#) Missile Systems Group (purchased by [Raytheon](#)), high-speed digital logic and computer design for the [Advanced Tactical Fighter](#) Program at the [Hughes Aircraft Company](#) Radar Systems Group (purchased by Raytheon), and IR&D and design of high-speed digital signal processing and communications systems at the Hughes Aircraft Company Advanced Circuits Technology Center (purchased by Raytheon, spun off as TelASIC and then purchased by [MTI](#)).

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Education: J.D., The George Washington University Law School (1998); M.S.E.E., California State University, Long Beach, emphasis in Digital Signal Processing & Neural Networks, (1992); and B.S.E.E., California State Polytechnic University, Pomona, emphasis in Digital Signal Processing, (1987).

Admitted: Virginia, the District of Columbia, the United States Supreme Court, the Court of Appeals for the Fourth Circuit, the Court of Appeals for the Federal Circuit, the Virginia Supreme Court, and the District Court for the Eastern District of Virginia. Served on the Board of Directors of the Federal Circuit Bar Association.

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The Villamar Firm
Attorneys at Law

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Barbara Villamar, S.J.D., LL.M.

attorneys



Dr. Barbara Villamar is Of Counsel to **The Villamar Firm**.*

Areas of Practice: International Business Transactions, Corporate, International Trademark Law.**

*Dr. Villamar is only licensed to practice US state law in the District of Columbia.

**Dr. Villamar's practice will be limited to Trademark Law while licensed in the District of Columbia.

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Dr. Villamar is licensed to practice law in [Germany](#) and the United States and specializes in international and domestic corporate and business issues and trademark law. She is also available to serve in a liaison capacity between German and U.S. counterparts. Before joining the firm, Dr. Villamar worked on both sides of the Atlantic advising and representing clients in corporate, regulatory and transactional matters. She has broad experience guiding clients through the evaluation, negotiation and closing process of commercial arrangements, specifically pertaining to Internet service providers. She has assisted in the formation and restructuring of corporations and joint ventures, execution of domestic and cross-border transactional agreements, and formulation of internal and external corporate policies.

Dr. Barbara Villamar ist für **The Villamar Firm** als freie Mitarbeiterin tätig.*

Schwerpunkte: Internationales Handels- und Gesellschaftsrecht, Internationales Markenrecht.
Dr. Villamar ist in Deutschland und in den Vereinigten Staaten als Rechtsanwältin zugelassen und konzentriert sich in ihrer Tätigkeit auf nationales und internationales Handels- und Gesellschaftsrecht und Markenrecht. Darüberhinaus steht sie als Verbindungsperson zwischen deutschen und US-amerikanischen Partnern zur Verfügung. Dr. Villamar hat sowohl in Deutschland als auch in den USA Mandanten im Unternehmensrecht beraten und vertreten. Sie hat, u.a. im Bereich der Telekommunikation tätige, Klienten während des Evaluierungs- und Verhandlungsprozesses unterstützt, z.B. bei der Gründung und Umstrukturierung von Unternehmen und Joint Ventures, im Zusammenhang mit nationalen und internationalen Handelsverträgen und bei der Formulierung von internen und externen Unternehmenspraktiken.

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Education/Ausbildung:

[Johannes-Gutenberg-Universität, Mainz](#) (1. State Bar Exam 1989).

[Landgericht Frankfurt am Main](#) (2. State Bar Exam 1992).

[The George Washington University Law School](#) (LL.M. 1994).

[The George Washington University Law School](#) (S.J.D. 2005).

Bar Admissions/Zulassungen:

[Landgericht Frankfurt am Main, Germany](#) (1992) (presently dormant)

*[District of Columbia Court of Appeals, Washington, D.C.](#) (2002).

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USPTO Patent Fees												
USPTO Large/Small Fee Codes	Description	Current Fees		Proposed Fees			Change in Large Entity Fees		FY 2009 Unit Cost	FY 2010 Unit Cost	FY 2011 Unit Cost	(a) Change in Large Entity Fees is >5% AND >\$10
		Large	Small	Large	Small	Micro	Dollar Change	Percent Change				
Patent Application Filing Fees												
1011/2011/3011	Basic filing fee - Utility	380.00	190.00	280.00	140.00	70.00	-100.00	-26%	241.00	243.00	234.00	Yes
4011	Basic filing fee - Utility (electronic filing for small entities)	n/a	95.00	n/a	70.00	n/a	-25.00	-26%	241.00	243.00	234.00	
1051/2051/3051	Surcharge - Late filing fee, search fee, examination fee or oath or declaration	130.00	65.00	140.00	70.00	35.00	10.00	8%	(d)			
1012/2012/3012	Basic filing fee - Design	250.00	125.00	180.00	90.00	45.00	-70.00	-28%	241.00	243.00	234.00	Yes
1017/2017/3017	Basic filing fee - Design (CPA)	250.00	125.00	180.00	90.00	45.00	-70.00	-28%	728.00	632.00	715.00	Yes
1013/2013/3013	Basic filing fee - Plant	250.00	125.00	180.00	90.00	45.00	-70.00	-28%	241.00	243.00	234.00	Yes
1014/2014/3014	Basic filing fee - Reissue	380.00	190.00	280.00	140.00	70.00	-100.00	-26%	239.00	242.00	233.00	Yes
1019/2019/3019	Basic filing fee - Design Reissue (CPA)	380.00	190.00	280.00	140.00	70.00	-100.00	-26%	728.00	632.00	715.00	Yes
1005/2005/3005	Provisional application filing fee	250.00	125.00	260.00	130.00	65.00	10.00	4%	126.00	122.00	124.00	
1052/2052/3052	Surcharge - Late provisional filing fee or cover sheet	50.00	25.00	60.00	30.00	15.00	10.00	20%	(d)			
1631/2631/3631	Basic National Stage Fee	380.00	190.00	280.00	140.00	70.00	-100.00	-26%	322.00	355.00	331.00	Yes
1053/2053/3053	Non-English specification	130.00	n/a	140.00	70.00	35.00	10.00	8%	(d)			
Patent Search Fees												
1111/2111/3111	Utility Search Fee	620.00	310.00	600.00	300.00	150.00	-20.00	-3%	1,520.00	1,694.00	1,521.00	
1112/2112/3112	Design Search Fee	120.00	60.00	120.00	60.00	30.00	0.00	0%	307.00	448.00	430.00	
1113/2113/3113	Plant Search Fee	380.00	190.00	380.00	190.00	95.00	0.00	0%	1,520.00	1,694.00	1,521.00	
1114/2114/3114	Reissue Search Fee	620.00	310.00	600.00	300.00	150.00	-20.00	-3%	1,523.00	1,694.00	1,521.00	
1640/2640/3640	National Stage Search Fee - U.S. was the ISA or IPEA and all claims satisfy PCT Article 33(1)-(4)	0.00	0.00	0.00	0.00	0.00	0.00	0%	300.00	277.00	305.00	
1641/2641/3641	National Stage Search Fee - U.S. was the ISA	120.00	60.00	120.00	60.00	30.00	0.00	0%	300.00	277.00	305.00	
1642/2642/3642	National Stage Search Fee - search report prepared and provided to USPTO	490.00	245.00	480.00	240.00	120.00	-10.00	-2%	1,523.00	1,694.00	1,521.00	
1632/2632/3632	National Stage Search Fee - all other situations	620.00	310.00	600.00	300.00	150.00	-20.00	-3%	1,523.00	1,694.00	1,521.00	
Patent Examination Fees												
1311/2311/3311	Utility Examination Fee	250.00	125.00	720.00	360.00	180.00	470.00	188%	1,904.00	1,969.00	1,814.00	Yes
1312/2312/3312	Design Examination Fee	160.00	80.00	460.00	230.00	115.00	300.00	188%	586.00	517.00	587.00	Yes
1313/2313/3313	Plant Examination Fee	200.00	100.00	580.00	290.00	145.00	380.00	190%	1,904.00	1,969.00	1,814.00	Yes
1314/2314/3314	Reissue Examination Fee	750.00	375.00	2,160.00	1080.00	540.00	1,410.00	188%	1,906.00	1,969.00	1,814.00	Yes
1643/2643/3643	National Stage Examination Fee - U.S. was the ISA or IPEA and all claims satisfy PCT Article 33(1)-(4)	0.00	0.00	0.00	0.00	0.00	0.00	0%	1,906.00	1,969.00	1,814.00	
1633/2633/3633	National Stage Examination Fee - all other situations	250.00	125.00	720.00	360.00	180.00	470.00	188%	1,906.00	1,969.00	1,814.00	Yes
XXXX	Correct Inventorship After First Action on the Merits	n/a	n/a	1000.00	500.00	250.00	n/a	n/a	(d)			Yes
Request for Continuing Examination Fees												
1801/2801/3801	Request for continued examination (RCE) (1st Request) (see 37 CFR 1.114)	930.00	465.00	1,200.00	600.00	300.00	270.00	29%	1,881.00	1,696.00	2,070.00	Yes
XXXX	Request for continued examination (RCE) (2nd and subsequent)	n/a	n/a	1,700.00	850.00	425.00	n/a	n/a	1,881.00	1,696.00	2,070.00	Yes
Track I Fees												
1817/2817/3817	Request for prioritized examination	4,800.00	2,400.00	4,000.00	2,000.00	1,000.00	-800.00	-17%	(c)			Yes

USPTO Patent Fees												
USPTO Large/Small Fee Codes	Description	Current Fees		Proposed Fees			Change in Large Entity Fees		FY 2009 Unit Cost	FY 2010 Unit Cost	FY 2011 Unit Cost	(a) Change in Large Entity Fees is >5% AND >\$10
		Large	Small	Large	Small	Micro	Dollar Change	Percent Change				
Pre-Grant Publication Fees												
1504	Publication fee for early, voluntary, or normal publication - Through 12/31/12	300.00	n/a	300.00	n/a	n/a	0.00	0%	243.00	158.00	181.00	
1504	Publication fee for early, voluntary, or normal publication - Effective 1/1/2014	300.00	n/a	0.00	n/a	n/a	-300.00	-100%	243.00	158.00	181.00	Yes
1505	Publication fee for republication	300.00	n/a	300.00	n/a	n/a	0.00	0%	80.00	122.00	146.00	Yes
Issue Fees												
1501/2501/3501	Utility issue fee - Through 12/31/2013	1,740.00	870.00	1,780.00	890.00	445.00	40.00	2%	224.00	231.00	257.00	Yes
1501/2501/3501	Utility issue fee - Effective 1/1/2014	1,740.00	870.00	960.00	480.00	240.00	-780.00	-45%	224.00	231.00	257.00	Yes
1502/2502/3502	Design issue fee - Through 12/31/2013	990.00	495.00	1,020.00	510.00	255.00	30.00	3%	224.00	231.00	257.00	Yes
1502/2502/3502	Design issue fee - Effective 1/1/2014	990.00	495.00	560.00	280.00	140.00	-430.00	-43%	224.00	231.00	257.00	Yes
1503/2503/3503	Plant issue fee - Through 12/31/2013	1,370.00	685.00	1,400.00	700.00	350.00	30.00	2%	224.00	231.00	257.00	Yes
1503/2503/3503	Plant issue fee - Effective 1/1/2014	1,370.00	685.00	760.00	380.00	190.00	-610.00	-45%	224.00	231.00	257.00	Yes
1511/2511/3511	Reissue issue fee - Through 12/31/2013	1,740.00	870.00	1,780.00	890.00	445.00	40.00	2%	224.00	231.00	257.00	Yes
1511/2511/3511	Reissue issue fee - Effective 1/1/2014	1,740.00	870.00	960.00	480.00	240.00	-780.00	-45%	224.00	231.00	257.00	Yes
Patent Maintenance Fees												
1551/2551/3551	Due at 3.5 years	1,130.00	565.00	1,600.00	800.00	400.00	470.00	42%	2.00	1.00	(d)	Yes
1552/2552/3552	Due at 7.5 years	2,850.00	1,425.00	3,600.00	1,800.00	900.00	750.00	26%	2.00	1.00	(d)	Yes
1553/2553/3553	Due at 11.5 years	4,730.00	2,365.00	7,400.00	3,700.00	1,850.00	2,670.00	56%	2.00	1.00	(d)	Yes
1554/2554/3554	Surcharge - 3.5 year - Late payment within 6 months	150.00	75.00	160.00	80.00	40.00	10.00	7%	(d)			
1555/2555/3555	Surcharge - 7.5 year - Late payment within 6 months	150.00	75.00	160.00	80.00	40.00	10.00	7%	(d)			
1556/2556/3556	Surcharge - 11.5 year - Late payment within 6 months	150.00	75.00	160.00	80.00	40.00	10.00	7%	(d)			
1557/2557/3557	Surcharge after expiration - Late payment is unavoidable	700.00	n/a	700.00	350.00	175.00	0.00	0%	110.00	68.00	95.00	
1558/2558/3558	Surcharge after expiration - Late payment is unintentional	1,640.00	n/a	1,640.00	820.00	410.00	0.00	0%	110.00	68.00	95.00	
Patent Appeals/Interference Fees												
1405	Petitions to the Chief Administrative Patent Judge under 37 CFR 41.3	400.00	n/a	400.00	n/a	n/a	0.00	0%	110.00	68.00	312.00	
1401/2401/3401	Notice of appeal	620.00	310.00	1,000.00	500.00	250.00	380.00	61%	5,008.00	4,960.00	4,799.00	Yes
1402/2402/3402	Filing a brief in support of an appeal	620.00	310.00	0.00	0.00	0.00	-620.00	-100%				Yes
XXXX	Forwarding an appeal in an application or ex parte reexamination proceeding to the Board	n/a	n/a	2,000.00	1,000.00	500.00	2,000.00	100%				Yes
XXXX	Filing a brief in support of an appeal in an inter partes reexamination proceeding	n/a	n/a	2,000.00	1,000.00	500.00	2,000.00	100%	(c)			Yes
1403/2403/3403	Request for oral hearing	1,240.00	620.00	1,300.00	650.00	325.00	60.00	5%	203.00	361.00	358.00	
XXXX	Petition for Inter Partes Review up to 20 claims	27,200.00	n/a	n/a	n/a	n/a	n/a	n/a	(c)			
XXXX	Petition for Inter Partes Review, for each claim in excess of 20	600.00	n/a	n/a	n/a	n/a	n/a	n/a	(c)			
XXXX	Inter Partes Review Request Fee	n/a	n/a	9,000.00	n/a	n/a	9,000.00	100%	(c)			Yes
XXXX	Inter Partes Review Post-Institution Fee	n/a	n/a	14,000.00	n/a	n/a	14,000.00	100%	(c)			Yes
XXXX	Inter Partes Review Request of Each Claim in excess of 20	n/a	n/a	200.00	n/a	n/a	200.00	100%	(c)			Yes
XXXX	Inter Partes Post-Institution Request of Each Claim in excess of 15	n/a	n/a	400.00	n/a	n/a	400.00	100%	(c)			Yes
XXXX	Post Grant of Covered Business Method Patent Review up to 20 claims	35,800.00	n/a	n/a	n/a	n/a	n/a	n/a	(c)			
XXXX	Post Grant of Covered Business Method Patent Review, for each claim in excess of 20	800.00	n/a	n/a	n/a	n/a	n/a	n/a	(c)			
XXXX	Post Grant of Covered Business Method Patent Review Request	n/a	n/a	12,000.00	n/a	n/a	12,000.00	100%	(c)			Yes

USPTO Patent Fees												
USPTO Large/Small Fee Codes	Description	Current Fees		Proposed Fees			Change in Large Entity Fees		FY 2009 Unit Cost	FY 2010 Unit Cost	FY 2011 Unit Cost	(a) Change in Large Entity Fees is >5% AND >\$10
		Large	Small	Large	Small	Micro	Dollar Change	Percent Change				
XXXX	Post Grant of Covered Business Method Patent Review Post Institution	n/a	n/a	18,000.00	n/a	n/a	18,000.00	100%		(c)		Yes
XXXX	Post Grant of Covered Business Method Patent Review Request of Each Claim in excess of 20	n/a	n/a	250.00	n/a	n/a	250.00	100%		(c)		Yes
XXXX	Post Grant of Covered Business Method Patent Review Post-Institution Request of Each Claim in excess of 15	n/a	n/a	550.00	n/a	n/a	550.00	100%		(c)		Yes
XXXX	Derivation Petition	400.00	n/a	400.00	n/a	n/a	0.00	0%		(c)		Yes
XXXX	Derivation Institution and Trial Fee	n/a	n/a	0.00	n/a	n/a	n/a	n/a		(c)		
XXXX	Request to make settlement agreement available	n/a	n/a	400.00	n/a	n/a	400.00	100%		(c)		Yes
Re-exam Ex Partes Fees												
1812	Request for ex parte reexamination	2,520.00	n/a	15,000.00	7,500.00	3,750.00	12,480.00	495%	17,162.00	16,648.00	19,626.00	Yes
Excess Claims Fees												
1201/2201/3201	Independent claims in excess of three	250.00	125.00	420.00	210.00	105.00	170.00	68%		(b)		Yes
1202/2202/3202	Claims in excess of 20	60.00	30.00	80.00	40.00	20.00	20.00	33%		(b)		Yes
1203/2203/3203	Multiple dependent claim	450.00	225.00	780.00	390.00	195.00	330.00	73%		(b)		Yes
1204/2204/3204	Reissue independent claims in excess of three	250.00	125.00	420.00	210.00	105.00	170.00	68%		(b)		Yes
1205/2205/3205	Reissue claims in excess of 20	60.00	30.00	80.00	40.00	20.00	20.00	33%		(b)		Yes
1614/2614/3614	[PCT National Stage] Claims - extra independent (over three)	250.00	125.00	420.00	210.00	105.00	170.00	68%		(b)		Yes
1615/2615/3615	[PCT National Stage] Claims - extra total (over 20)	60.00	30.00	80.00	40.00	20.00	20.00	33%		(b)		Yes
1616/2616/3616	[PCT National Stage] Claims - multiple dependent	450.00	225.00	780.00	390.00	195.00	330.00	73%		(b)		Yes
Patent Extension of Time Fees												
1251/2251/3251	Extension for response within first month	150.00	75.00	200.00	100.00	50.00	50.00	33%		(d)		Yes
1252/2252/3252	Extension for response within second month	560.00	280.00	600.00	300.00	150.00	40.00	7%		(d)		Yes
1253/2253/3253	Extension for response within third month	1,270.00	635.00	1,400.00	700.00	350.00	130.00	10%		(d)		Yes
1254/2254/3254	Extension for response within fourth month	1,980.00	990.00	2,200.00	1,100.00	550.00	220.00	11%		(d)		Yes
1255/2255/3255	Extension for response within fifth month	2,690.00	1,345.00	3,000.00	1,500.00	750.00	310.00	12%		(d)		Yes
Application Size Fees												
1081/2081/3081	Utility Application Size Fee - for each additional 50 sheets that exceeds 100 sheets	310.00	155.00	400.00	200.00	100.00	90.00	29%		(b)		Yes
1082/2082/3082	Design Application Size Fee - for each additional 50 sheets that exceeds 100 sheets	310.00	155.00	400.00	200.00	100.00	90.00	29%		(b)		Yes
1083/2083/3083	Plant Application Size Fee - for each additional 50 sheets that exceeds 100 sheets	310.00	155.00	400.00	200.00	100.00	90.00	29%		(b)		Yes
1084/2084/3084	Reissue Application Size Fee - for each additional 50 sheets that exceeds 100 sheets	310.00	155.00	400.00	200.00	100.00	90.00	29%		(b)		Yes
1085/2085/3085	Provisional Application Size Fee - for each additional 50 sheets that exceeds 100 sheets	310.00	155.00	400.00	200.00	100.00	90.00	29%		(b)		Yes
1681/2681/3681	National Stage Application Size Fee - for each additional 50 sheets that exceeds 100 sheets	310.00	155.00	400.00	200.00	100.00	90.00	29%		(b)		Yes
Revival Fees												
1452/2452/3452	Petition to revive unavoidably abandoned application	620.00	310.00	640.00	320.00	160.00	20.00	3%	110.00	68.00	312.00	
1453/2453/3453	Petition to revive unintentionally abandoned application	1,860.00	930.00	1,900.00	950.00	475.00	40.00	2%	110.00	68.00	312.00	

USPTO Patent Fees												
USPTO Large/Small Fee Codes	Description	Current Fees		Proposed Fees			Change in Large Entity Fees		FY 2009 Unit Cost	FY 2010 Unit Cost	FY 2011 Unit Cost	(a) Change in Large Entity Fees is >5% AND >\$10
		Large	Small	Large	Small	Micro	Dollar Change	Percent Change				
Miscellaneous Patent Fees												
1808	Processing fee, except in provisional applications	130.00	n/a	130.00	n/a	n/a	0.00	0%	39.00	37.00	33.00	Yes
1803	Request for voluntary publication or republication	130.00	n/a	130.00	n/a	n/a	0.00	0%	110.00	68.00	95.00	
1802	Request for expedited examination of a design application	900.00	n/a	900.00	450.00	225.00	0.00	0%	110.00	68.00	95.00	
1806/2806/3806	Submission of an Information Disclosure Statement	180.00	n/a	180.00	90.00	45.00	0.00	0%	(e)			
1807	Processing fee for provisional applications	50.00	n/a	50.00	n/a	n/a	0.00	0%	39.00	37.00	33.00	
1809/2809/3809	Filing a submission after final rejection (see 37 CFR 1.129(a))	810.00	405.00	840.00	420.00	210.00	30.00	4%	1,553.00	1,329.00	1,533.00	
1810/2810/3810	For each additional invention to be examined (see 37 CFR 1.129(b))	810.00	405.00	840.00	420.00	210.00	30.00	4%	1,553.00	1,329.00	1,533.00	
1814/2814	Statutory disclaimer, including terminal disclaimer	160.00	80.00	160.00	n/a	n/a	0.00	0%	(d)			
XXXX	Reexamination Petition	1,930.00	n/a	1,940.00	970.00	485.00	10.00	1%	(c)			
XXXX	Supplemental Examination Request	5,140.00	n/a	4,400.00	2,200.00	1,100.00	-740.00	-14%	(c)			
XXXX	Supplemental Examination Reexamination	16,120.00	n/a	13,600.00	6,800.00	3,400.00	-2,520.00	-16%	(c)			
XXXX	Supplemental Examination document size fees; 21-50	170.00	n/a	180.00	90.00	45.00	10.00	6%	(c)			
XXXX	Supplemental examination document size fees; each additional 50	280.00	n/a	280.00	140.00	70.00	0.00	0%	(c)			
Post Issuance Fees												
1811	Certificate of correction	100.00	n/a	100.00	n/a	n/a	0.00	0%	61.00	68.00	74.00	Yes
1816	Processing fee for correcting inventorship in a patent	130.00	n/a	130.00	n/a	n/a	0.00	0%	(e)			
1813	Request for inter partes reexamination	8,800.00	n/a	n/a	n/a	n/a	n/a	n/a	31,399.00	31,688.00	35,975.00	
1821/2821/3821	Reexamination independent claims in excess of three and also in excess of the number of such claims in the patent under reexamination	250.00	125.00	420.00	210.00	105.00	170.00	68%	(b)			
1822/2822/3822	Reexamination claims in excess of 20 and also in excess of the number of claims in the patent under reexamination	60.00	30.00	100.00	50.00	25.00	40.00	67%	(b)			
1814/2814	Statutory disclaimer, including terminal disclaimer	160.00	80.00	160.00	n/a	n/a	0.00	0%	(d)			
Patent Petition Fees												
1462/2462/3462	Petitions requiring the petition fee set forth in 37 CFR 1.17(f) (Group I)	400.00	n/a	400.00	200.00	100.00	0.00	0%	110.00	68.00	312.00	Yes
1463/2463/3463	Petitions requiring the petition fee set forth in 37 CFR 1.17(g) (Group II)	200.00	n/a	200.00	100.00	50.00	0.00	0%	110.00	68.00	312.00	
1464/2464/3464	Petitions requiring the petition fee set forth in 37 CFR 1.17(h) (Group III)	130.00	n/a	140.00	70.00	35.00	10.00	8%	110.00	68.00	95.00	
1454/2454/3454	Acceptance of an unintentionally delayed claim for priority, or for filling a request for the restoration of the right of priority	1,410.00	n/a	1,420.00	710.00	355.00	10.00	1%	110.00	68.00	312.00	
1455	Filing an application for patent term adjustment	200.00	n/a	200.00	n/a	n/a	0.00	0%	110.00	68.00	95.00	
1456	Request for reinstatement of term reduced	400.00	n/a	400.00	n/a	n/a	0.00	0%	110.00	68.00	95.00	
1457	Extension of term of patent	1,120.00	n/a	1,120.00	n/a	n/a	0.00	0%	110.00	68.00	95.00	
1458	Initial application for interim extension (see 37 CFR 1.790)	420.00	n/a	420.00	n/a	n/a	0.00	0%	110.00	68.00	95.00	
1459	Subsequent application for interim extension (see 37 CFR 1.790)	220.00	n/a	220.00	n/a	n/a	0.00	0%	110.00	68.00	95.00	

USPTO Patent Fees												
USPTO Large/Small Fee Codes	Description	Current Fees		Proposed Fees			Change in Large Entity Fees		FY 2009 Unit Cost	FY 2010 Unit Cost	FY 2011 Unit Cost	(a) Change in Large Entity Fees is >5% AND >\$10
		Large	Small	Large	Small	Micro	Dollar Change	Percent Change				
PCT Fees - National Stage												
1617/2617/3617	Search fee, examination fee or oath or declaration after thirty months from priority date	130.00	65.00	140.00	70.00	35.00	10.00	8%	(d)			
1618/2618/3618	English translation after thirty months from priority date	130.00	n/a	140.00	70.00	35.00	10.00	8%	(d)			
PCT Fees - International Stage												
1601/2601/3601	Transmittal fee	240.00	n/a	240.00	120.00	60.00	0.00	0%	913.00	424.00	354.00	
1602/2602/3602	Search fee - regardless of whether there is a corresponding application (see 35 U.S.C. 361(d) and PCT Rule 16)	2,080.00	n/a	2,080.00	1,040.00	520.00	0.00	0%	1,885.00	1,889.00	2,012.00	
1604/2604/3604	Supplemental search fee when required, per additional invention	2,080.00	n/a	2,080.00	1,040.00	520.00	0.00	0%	1,885.00	1,889.00	2,012.00	
1605/2605/3605	Preliminary examination fee - U.S. was the ISA	600.00	n/a	600.00	300.00	150.00	0.00	0%	875.00	710.00	853.00	
1606/2606/3606	Preliminary examination fee - U.S. was not the ISA	750.00	n/a	760.00	380.00	190.00	10.00	1%	875.00	710.00	853.00	
1607/2607/3607	Supplemental examination fee per additional invention	600.00	n/a	600.00	300.00	150.00	0.00	0%	875.00	710.00	853.00	
1619	Late payment fee	variable	n/a	variable	variable	variable	n/a	n/a	(d)			
1621	Transmitting application to Intl. Bureau to act as receiving office	240.00	n/a	240.00	120.00	60.00	0.00	0%	7.00	9.00	9.00	
Patent Service Fees												
8001	Printed copy of patent w/o color, delivery by USPS, USPTO Box, or electronic means	3.00	n/a	3.00	n/a	n/a	0.00	0%	(e)			
8003	Printed copy of plant patent in color	15.00	n/a	15.00	n/a	n/a	0.00	0%	(e)			
8004	Color copy of patent (other than plant patent) or SIR containing a color drawing	25.00	n/a	25.00	n/a	n/a	0.00	0%	(e)			
8005	Patent Application Publication (PAP)	3.00	n/a	3.00	n/a	n/a	0.00	0%	(e)			
8007	Copy of patent application as filed	20.00	n/a	20.00	n/a	n/a	0.00	0%	(e)			
8008	Copy of patent-related file wrapper and contents of 400 or fewer pages, if provided on paper	200.00	n/a	200.00	n/a	n/a	0.00	0%	(e)			
8009	Additional fee for each additional 100 pages of patent-related file wrapper and (paper) contents, or portion thereof	40.00	n/a	40.00	n/a	n/a	0.00	0%	(e)			
8010	Individual application documents, other than application as filed, per document	25.00	n/a	25.00	n/a	n/a	0.00	0%	(e)			
8011	Copy of patent-related file wrapper and contents if provided electronically or on a physical electronic medium as specified in 1.19(b)(1)(ii)	55.00	n/a	55.00	n/a	n/a	0.00	0%	(e)			
8012	Additional fee for each continuing physical electronic medium in single order of 1.19(b)(1)(ii)(B)	15.00	n/a	15.00	n/a	n/a	0.00	0%	(e)			
8041	Copy of patent-related file wrapper contents that were submitted and are stored on compact disk or other electronic form (e.g., compact disks stored in Artifact folder), other than as available in 1.19(b)(1); first physical electronic medium in a single order	55.00	n/a	55.00	n/a	n/a	0.00	0%	(e)			
8042	Additional fee for each continuing copy of patent-related file wrapper contents as specified in 1.19(b)(2)(i)(A)	15.00	n/a	15.00	n/a	n/a	0.00	0%	(e)			
8043	Copy of patent-related file wrapper contents that were submitted and are stored on compact disk, or other electronic form, other than as available in 1.19(b)(1); if provided electronically other than on a physical electronic medium, per order	55.00	n/a	55.00	n/a	n/a	0.00	0%	(e)			

USPTO Patent Fees													
USPTO Large/Small Fee Codes	Description	Current Fees		Proposed Fees			Change in Large Entity Fees		FY 2009 Unit Cost	FY 2010 Unit Cost	FY 2011 Unit Cost	(a) Change in Large Entity Fees is >5% AND >\$10	
		Large	Small	Large	Small	Micro	Dollar Change	Percent Change					
8013	Copy of office records, except copies of applications as filed	25.00	n/a	25.00	n/a	n/a	0.00	0%		(e)			
8014	For assignment records, abstract of title and certification, per patent	25.00	n/a	25.00	n/a	n/a	0.00	0%		(e)			
8904	Library service	50.00	n/a	50.00	n/a	n/a	0.00	0%		(e)			Yes
8015	List of U.S. patents and SIRs in subclass	3.00	n/a	3.00	n/a	n/a	0.00	0%		(e)			
8016	Uncertified statement re status of maintenance fee payments	10.00	n/a	10.00	n/a	n/a	0.00	0%		(e)			
8017	Copy of non-U.S. document	25.00	n/a	25.00	n/a	n/a	0.00	0%		(e)			
8050	Petitions for documents in form other than that provided by this part, or in form other than that generally provided by Director, to be decided in accordance with merits	AT COST	n/a	AT COST	n/a	n/a	n/a	n/a		(e)			
8020	International type search report	40.00	n/a	40.00	n/a	n/a	0.00	0%		(e)			
8902	Self-service copy charge, per page	0.25	n/a	0.25	n/a	n/a	0.00	0%		(e)			
8021	Recording each patent assignment, agreement or other paper, per property - when submitted other than electronically	40.00	n/a	40.00	n/a	n/a	0.00	0%		(e)			
XXXX	Recording each patent assignment, agreement or other paper, per property - when submitted electronically	40.00	n/a	0.00	n/a	n/a	-40.00	-100%		(e)			
8022	Publication in Official Gazette	25.00	n/a	25.00	n/a	n/a	0.00	0%		(e)			
8023	Labor charges for services, per hour or fraction thereof	40.00	n/a	40.00	n/a	n/a	0.00	0%		(e)			
8024	Unspecified other services, excluding labor	AT COST	n/a	AT COST	n/a	n/a	n/a	n/a		(e)			
8026	Handling fee for incomplete or improper application	130.00	n/a	130.00	n/a	n/a	0.00	0%		(e)			
8027	Handling fee for withdrawal of SIR	130.00	n/a	130.00	n/a	n/a	0.00	0%		(e)			
Patent Enrollment Fees													
9001	Application fee (non-refundable)	40.00	n/a	40.00	n/a	n/a	0.00	0%		(e)			
9003	Registration to practice or grant of limited recognition under §11.9(b) or (c)	100.00	n/a	100.00	n/a	n/a	0.00	0%		(e)			
9004	Reinstatement to practice	100.00	n/a	100.00	n/a	n/a	0.00	0%		(e)			
9005	Certificate of good standing as an attorney or agent	10.00	n/a	10.00	n/a	n/a	0.00	0%		(e)			
9006	Certificate of good standing as an attorney or agent, suitable for framing	20.00	n/a	20.00	n/a	n/a	0.00	0%		(e)			
9010	For test administration by commercial entity	200.00	n/a	200.00	n/a	n/a	0.00	0%		(e)			
9011	For test administration by the USPTO	450.00	n/a	450.00	n/a	n/a	0.00	0%		(e)			
9012	Review of decision by the Director of Enrollment and Discipline under §11.2(c)	130.00	n/a	130.00	n/a	n/a	0.00	0%		(e)			
9013	Review of decision of the Director of Enrollment and Discipline under §11.2(d)	130.00	n/a	130.00	n/a	n/a	0.00	0%		(e)			
9014	Application fee for person disciplined, convicted of a felony or certain misdemeanors under §11.7(h)	1,600.00	n/a	1,600.00	n/a	n/a	0.00	0%		(e)			
9015	Annual fee for registered attorney or agent in active status	118.00	n/a	120.00	n/a	n/a	2.00	2%		(e)			
9016	Annual fee for registered attorney or agent in voluntary inactive status	25.00	n/a	25.00	n/a	n/a	0.00	0%		(e)			
9017	Requesting restoration to active status from voluntary inactive status	50.00	n/a	50.00	n/a	n/a	0.00	0%		(e)			

USPTO Patent Fees												
USPTO Large/Small Fee Codes	Description	Current Fees		Proposed Fees			Change in Large Entity Fees		FY 2009 Unit Cost	FY 2010 Unit Cost	FY 2011 Unit Cost	(a) Change in Large Entity Fees is >5% AND >\$10
		Large	Small	Large	Small	Micro	Dollar Change	Percent Change				
9018	Balance of annual fee due upon restoration to active status from voluntary inactive status	93.00	n/a	100.00	n/a	n/a	7.00	8%	(e)			
9019	Annual fee for individual granted limited recognition	118.00	n/a	120.00	n/a	n/a	2.00	2%	(e)			
9020	Delinquency fee for annual fee	50.00	n/a	50.00	n/a	n/a	0.00	0%	(e)			
9024	Unspecified other services,excluding labor	AT COST	n/a	AT COST	n/a	n/a	n/a	n/a	(e)			
9025	Registration to practice for change of practitioner type	100.00	n/a	100.00	n/a	n/a	0.00	0%	(e)			
(a) - Discussed in detail in the "Individual Fee Rationale" section of the Supplementary Information in the notice of proposed rulemaking (NPRM).												
(b) - Included within the average unit cost of search and exam. See "Individual Fee Rationale" section of the Supplementary Information of the NPRM for additional information.												
(c) - Cost was not derived purely from historical ABI cost, but from like historical data used as a foundation to calculate the prospective cost of a new program or activity.												
(d) - Unit cost was not calculated for these fees because there are no significant, specific activities supporting them, other than collecting and depositing the fee.												
(e) - Recent unit costs were not calculated for these fees and the Office is therefore, not proposing changes to these fees until we are able to evaluate them against their current respective cost (with two exceptions: three enrollment fees are adjusted to correct rounding errors; and the Office is proposing a \$0 fee for assignments submitted electronically).												
(f) - See the Costing Methodology Appendix for calculation descriptions.												

- I. Patent Office Procedures Under AIA (from http://www.uspto.gov/aia_implementation/faq.jsp)
 - a. Best Mode
 - i. Best Mode provision 35 U.S.C. 282(a)(3) effective date in the AIA is September 16, 2011
 - ii. The failure to disclose the best mode shall no longer be a basis, in patent validity or infringement proceedings, on which any claim of a patent may be canceled or held invalid or otherwise unenforceable. As stated above, this new practice does not affect the patent examination practice.
 - b. Derivation Proceedings
 - i. Derivation provision effective date in the AIA is March 16, 2013
 - ii. A derivation proceeding requires that an applicant for patent file a petition to institute the proceeding. The petition must set forth with particularity the basis for finding that an inventor named in an earlier application derived the claimed invention from the petitioner. The petition must be made under oath and supported by substantial evidence. 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.
 - c. Fees
 - i. 15% increase in fee rates became effective at 12:00 a.m. on Monday, September 26, 2011
 - ii. Prioritized Examination fees became effective at 12:00 a.m. on Monday, September 26, 2011 and are \$4,800.00 large/ \$2,400.00 small
 - iii. Electronic Filing Incentive become effective at 12:00 a.m. on Tuesday, November 15, 2011 with additional \$400 (and \$200 for small entity) for an original patent application (except for a design, plant, or provisional application) that is not filed electronically
 - iv. Micro Entity fees: the AIA do not permit the USPTO to apply the 75% micro entity fee discount until the micro entity fee for a specific item is set or adjusted using the fee setting authority provided in section 10 of the Act
 - d. First Inventor to File
 - i. First Inventor to File effective date in the AIA is March 16, 2013
 - ii. Only inventors are entitled to a patent. Someone who copies another's idea cannot be the inventor.
 - iii. Regardless of whether the application was filed before or after the first-inventor-to-file provisions take effect on March 16, 2013, disclosure one month prior to a filing date is not prior art to the claimed invention by virtue of a one year grace period
 - e. Inter Partes Reexamination
 - i. Inter Partes Reexamination effective date in the AIA is September 16, 2011
 - ii. The AIA elevates the standard for granting a request for inter partes reexamination, wherein under the new standard, the information presented in an inter partes reexamination request must provide a showing that there is a reasonable likelihood that the requester will prevail with respect to at least one of the patent claims challenged in

the request. The standard for ex parte reexamination remains unchanged.

- f. Inter Partes Review
 - i. Inter Partes Review effective date in the AIA is September 16, 2012
 - ii. All patents issuing from applications subject to first-inventor-to-file provisions of the AIA as well as those patents issuing from applications subject to the first-to-inventor provisions in current Title 35 are eligible for an inter partes review
 - iii. A petitioner for inter partes review may request to cancel as unpatentable one or more claims of a patent 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.
- g. Post Grant Review
 - i. Post Grant Review effective date in the AIA is September 16, 2012
 - ii. With limited exceptions, only those patents issuing from applications subject to first-inventor-to-file provisions of the AIA are eligible for post grant review.
 - iii. A petitioner for post grant review may request to cancel as unpatentable one or more claims of a patent on any ground that could be raised under paragraph (2) or (3) of 35 U.S.C. 282(b) relating to invalidity (i.e., novelty, obviousness, written description, enablement, indefiniteness, but not best mode).
- h. Prioritized Examination (Track 1)
 - i. Prioritized Examination (Track 1) became effective at 12:00 a.m. on Monday, September 26, 2011
 - ii. Prioritized examination is a procedure for expedited review of a patent application for an additional fee. The Office's goal for prioritized examination is to provide a final disposition within twelve months of prioritized status being granted
- i. Inventor's Oath or Declaration
 - i. Inventor's Oath or Declaration effective date in the AIA is September 16, 2012
 - ii. An inventor must state in his/her oath/declaration that (i) he/she is an original inventor of the claimed invention; and (ii) he/she authorized the filing of the patent application for the claimed invention. An inventor is no longer required to (i) state that he/she is the first inventor of the claimed invention; (ii) state that the application filing is made without deceptive intent; or (iii) provide his/her country of citizenship.
- j. Tax Strategies
 - i. Tax Strategies effective date in section 14 of the AIA is September 16, 2011
 - ii. Applicants will no longer be able to rely solely on the novelty or non-obviousness of a tax strategy embodied in their claims in order to distinguish the claims from the prior art
- k. Transitional Program for Covered Business Method Patents
 - i. Covered Business Method Patents effective date in the AIA is September 16, 2012
 - ii. The AIA provides that the covered business review provision sunsets after 8 years from the effective date of the provision. Accordingly, the

Office will not accept new petitions for covered business method review filed on or after September 16, 2020

- iii. A covered business method review is available for all patents issuing from applications subject to first-inventor-to-file provisions of the AIA as well as those patents issuing from applications subject to the first-to-inventor provisions in current Title 35, provided that the patent is drawn to a covered business method. The AIA specifies that a covered business method patent is a patent that claims a method or corresponding apparatus for performing data processing or other operations used in the practice, administration, or management of a financial product or service, except that the term does not include patents for technological inventions. The AIA does not specify what a patent for a technological invention covers, and therefore, the Office has promulgated a rule for technological invention.

I. Preissuance Submissions

- i. Preissuance Submissions effective date in the AIA is September 16, 2012
- ii. A third party may file a preissuance submission in any non-provisional utility, design, or plant application, as well as in any continuing application, even if the application to which the submission is directed has been abandoned or has not been published. Third-party preissuance submissions may not be filed in any reissue application or reexamination proceeding.
- iii. A third-party preissuance submission statutorily must be made in a patent application before the earlier of: (a) the date a notice of allowance under 35 U.S.C. 151 is given or mailed in the application; or (b) the later of (i) six months after the date on which the application is first published under 35 U.S.C. 122 by the Office, or (ii) the date of the first rejection under 35 U.S.C. 132 of any claim by the examiner during the examination of the application.

m. Citation of Patent Owner Statements in a Patent File

- i. Citation of Patent Owner Statements in a Patent File effective date in the AIA is September 16, 2012
- ii. Either a third party or the patent owner may cite patent owner statements in a patent file.
- iii. A statement of the patent owner filed by the patent owner 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 the patent may be filed.

n. Supplemental Examination

- i. Supplemental Examination effective date in the AIA is September 16, 2012
- ii. The patent owner may request a supplemental examination for a patent so that the Office can consider, reconsider, or correct information believed to be relevant to the patent.
- iii. The patent owner may present any information believed to be relevant to the patent. The information is not limited to patents or printed publications, but instead may include information concerning any ground of patentability, i.e., patent eligible subject matter, anticipation, obviousness, written description, enablement, best mode, and indefiniteness.

- II. Oath & Declaration
 - a. Substitute statement can be filed when the inventor is: (i) deceased; (ii) legally incapacitated; (iii) unable to be found or reached after diligent effort; or (iv) refuses to sign an oath/declaration; By:
 - b. (i) the inventor's legal representative; (ii) the assignee; (iii) a party to whom the inventor is under an obligation to assign; or (iv) a party who otherwise shows sufficient proprietary interest in the claimed invention.
 - c. An assignment may include the statements required in an oath/declaration, wherein the applicant may file a combined inventor's oath/declaration and assignment document in the Office.
 - d. Forms related to the inventor's oath/declaration provision are available on the Office's AIA microsite as well as on the Office's form site, including an inventor declaration for an original (non-reissue) application, inventor declaration for a reissue application, substitute statement, and Application Data Sheet (ADS).
 - e. There is new statutorily-mandated language that must be included in the inventor oath/declaration after September 16, 2012, that is not included on the inventor oath/declaration form available before that date. The new statutorily mandated language includes: (1) a statement that "the application was made or authorized to be made by the affiant or declarant," and (2) the acknowledgement of penalties clause must refer to "imprisonment of not more than 5 years."
 - f. Not needed until Notice of Allowance.
- III. User Fees
 - a. Like all fees, the USPTO is not authorized to apply a micro entity discount to the prioritized exam fee without setting the fee using the section 10 fee setting process.
 - b. Fees such as international stage PCT fees, certain petition fees, enrollment fees, and service fees will not be increasing by 15%.
 - c. Applicants are encouraged to provide authorization in the application file to charge fees to a specified Deposit Account to avoid insufficient payment of fees.
 - d. The USPTO published a notice of proposed rulemaking (NPRM) to set and adjust patent fees using the section 10 fee setting authority. The NPRM and supporting materials are available at http://www.uspto.gov/aia_implementation/fees.jsp#heading-1. The public comment period ends on November 5, 2012. The Office will issue a final rulemaking after considering the comments from the public. The Office expects most of the new fees could be effective during the Spring of 2013.
- IV. Prioritized Examination
 - a. The fees required to be paid upon filing for prioritized examination are:
 - b. i. Basic filing fee
 - c. ii. Search fee
 - d. iii. Examination fee
 - e. iv. Publication fee
 - f. v. Track I processing fee
 - g. vi. Track I prioritized examination fee
 - h. vii. Application size fee (specification and drawings exceed 100 sheets of paper
 - i. viii. Excess independent claim fee (number of independent claims exceeds three).
 - j. ix. Excess claim fee (number of claims exceeds twenty).

- k. If any fee is unpaid, request for Prioritized Examination dismissed except with explicit authorization to charge any additional required fees.
 - l. The prioritized examination program grants special status until one of the following occurs:
 - m.
 - i. Applicant files a petition for extension of time to extend the time period for filing a reply.
 - ii. Applicant files an amendment to amend the application to contain more than four independent claims, more than thirty total claims, or a multiple dependent claim.
 - iii. Applicant subsequently files a request for continued examination (RCE).
 - iv. Applicant files a notice of appeal.
 - v. Applicant files a request for suspension of action.
 - vi. A notice of allowance is mailed.
 - vii. A final Office action is mailed.
 - viii. The application is abandoned.
 - ix. Examination is completed as defined in 37 CFR 41.102.
- V. International Filing Considerations (from Gene Quinn “Important New Changes to US Patent Law for PCT Applicants”
<http://www.ipwatchdog.com/2012/08/05/important-new-changes-to-us-patent-law-for-pct-applicants/id=27145/>)
- a. Effective September 16, 2012, the requirement that the inventors be named as applicants solely for the purposes of U.S. designation is no longer required.
 - b. An assignee or other person to whom the inventor is under an obligation to assign the invention, or who otherwise has sufficient proprietary interest in innovation, may be the applicant even when the U.S. is designated.
 - c. There is continued requirement that a U.S. inventor’s oath or declaration be submitted.
 - d. A declaration of inventorship can currently be submitted as part of the PCT application pursuant to PCT Rules 4.17(iv) and 51bis.1(a)(iv). After September 16, 2012, the current language of the PCT Rule 4.17(iv) declaration will not comply with the requirements of the AIA for international applications filed on or after September 16, 2012.
 - e. PCT Applicants that will seek to designate the U.S. on or after September 16, 2012, should be aware that it will be unnecessary to identify the inventor as the applicant for international patent applications filed on or after September 16, 2012 even though amendments to the PCT Regulations addressing this U.S. law change will likely not enter into effect before January 1, 2013.
 - f. Updates to the PCT-SAFE software, as well as other PCT e-filing software, will likely take some time. WIPO expects that the e-filing software will be updated by January 2013. Applicants using PCT-SAFE may, however, simply indicate that the applicant is applicant “for all designated States” and ignore any warning messages.
 - g. Despite the fact that PCT software was not up to date on September 16, 2012, the PCT/RO/101 has been modified accordingly.
- VI. Adapting Prosecution Strategies to the AIA (from Lisa M. Caldwell “America Invents Act Patent Prosecution Strategy”
http://www.klarquist.com/Articles/39_AIA%20Patent%20Prosecution%20Strategy.pdf)
- a. File as soon as have an enabling disclosure;
 - b. Keep pre-AIA patent filings isolated in their own patent families to limit prior art;

- c. Discourage pre-patent filing publication/disclosure in most instances;
- d. Pay closer attention to competitor published applications, with new option for submitting prior art;
- e. Pay extra to get urgent patent applications examined;
- f. Use supplemental examination to have additional references considered in issued patents.

A. Submitting Comments on the AIA
(http://www.uspto.gov/aia_implementation/faq.jsp)

Question C1: If I would like to submit comments on the Notices of Proposed Rule Making that the Office will be issuing, but cannot finish my comments by the due date, may I have an extension to submit them?

Due to the tight enactment time frames of the AIA and the rule making process, the Office does not anticipate being able to accommodate extension requests to submit comments.

Question C2: Do I have to wait for a Notice of Proposed Rule Making to comment on a specific provision of the AIA?

No. The Office encourages you to submit your comments to aia_implementation@uspto.gov and requests that your subject line reference the topic or AIA provision(s) that your comments address. Given the tight implementation time frames resulting from the AIA, preliminary input from our stakeholders and the public on implementation of the key provisions would facilitate our review process.

Question C3: I already submitted comments through the aia_implementation@uspto.gov email address. May I also submit comments in response to a Notice of Proposed Rule Making on the same topic(s)?

Yes. Comments submitted through the aia_implementation@uspto.gov email address are being considered before the Office issues a Notice of Proposed Rule Making (NPRM). Timely filed comments responding to a NPRM should address what is promulgated in the proposed rules. These comments should be submitted to the email address designated in the NPRM.

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B. Best Mode

Question BM1: What is the effective date for the Best Mode provision in the AIA?

The effective date for the Best Mode provision in the AIA is September 16, 2011.

Question BM2: Does AIA's amendment to 35 U.S.C. 282(a)(3) impact current patent examination practice regarding evaluation of an application for compliance with the best mode requirement of 35 U.S.C. 112?

No. As this change is applicable only in patent validity or infringement proceedings, it does not change current patent examination practices set forth in MPEP § 2165.

Question BM3: What is the impact of AIA's amendment to 35 U.S.C. 282(a)(3) concerning Best Mode?

The failure to disclose the best mode shall no longer be a basis, in patent validity or infringement proceedings, on which any claim of a patent may be canceled or held invalid or otherwise unenforceable. As stated above, this new practice does not affect the patent examination practice.

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C. Derivation Proceedings

Question DER1: What is the effective date for the derivation provision in the AIA?

The effective date for the derivation provision in the AIA is March 16, 2013.

Question DER2: What are the requirements for seeking a derivation proceeding?

A derivation proceeding requires that an applicant for patent file a petition to institute the proceeding. The petition must set forth with particularity the basis for finding that an inventor named in an earlier application derived the claimed invention from the petitioner. The petition must be made under oath and supported by substantial evidence. 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.

Question DER3: What statutory requirements must a petitioner meet in a petition for a derivation proceeding?

In a petition for a derivation proceeding, the petitioner must (i) identify which application or patent is disputed; and (ii) provide at least one affidavit addressing communication of the derived invention and the lack of authorization for filing the earlier application.

Question DER4: What is the standard for instituting a derivation proceeding and who will decide whether the standard is met?

A derivation may be instituted where the petition sets forth a basis for finding that the inventor named in an earlier application derived the claimed invention and there is substantial evidence to support the allegations raised in the petition. The Board of Patent Appeals and Interferences (soon to be renamed the Patent Trial and Appeal Board) will decide petitions for derivation and conduct any ensuing derivation proceeding.

Question DER5: How will the Board conclude a derivation proceeding?

The AIA provides that where a derivation proceeding is instituted and not dismissed, the Board shall 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.

Question DER6: Can a party to a derivation proceeding appeal the Board's final decision?

Yes, a party dissatisfied with a final decision in a derivation proceeding may appeal to district court or the Federal Circuit.

Question DER7: In lieu of a derivation, can the parties to a derivation proceeding resolve inventorship in any other way?

Yes, the parties to a derivation proceeding may resort to binding arbitration to determine inventorship.

Question DER8: Can the parties to a derivation proceeding engage in settlement?

Yes, the AIA permits the parties to a derivation proceeding to settle. A settlement in a derivation proceeding will be accepted by the Board unless inconsistent with the evidence of record.

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D. Fees

Prioritized Examination

Question FEE1: How much is the fee for prioritized examination and when will it be effective?

The new fee for prioritized examination will be effective at 12:00 a.m. on Monday, September 26, 2011. The fee rates for large and small entities are listed below. Like all fees, the USPTO is not authorized to apply a micro entity discount to the prioritized exam fee without setting the fee using the section 10 fee setting process.

CFR Section	Fee Code	Description	9/26/2011 Fee (i.e., post-AIA enactment)
1.17(c)	1817	Request for Prioritized Examination	\$4,800.00
1.17(c)	2817	Request for Prioritized Examination	\$2,400.00

Question FEE2: Are there any other fees required upon filing a Request for Prioritized Examination (Track I)? What happens if one of the required fees is not present upon filing?

Consult the current fee schedule available at <http://www.uspto.gov/about/offices/cfo/finance/fees.jsp> for the correct fee amounts. The fees required to be paid upon filing for prioritized examination are:

- i. Basic filing fee, as set forth in 37 CFR 1.16(a), or for a plant application, 37 CFR 1.16(c).

- ii. Search fee, as set forth in 37 CFR 1.16(k), or for a plant application, 37 CFR 1.16(m).
- iii. Examination fee, as set forth in 37 CFR 1.16(o), or for a plant application, 37 CFR 1.16(q).
- iv. Publication fee, as set forth in 37 CFR 1.18(d).
- v. Track I processing fee, as set forth in 37 CFR 1.17(i).
- vi. Track I prioritized examination fee of \$4800.00 (\$2400.00 for small entities).
- vii. If applicable, any application size fee, due because the specification and drawings exceed 100 sheets of paper, as set forth in 37 CFR 1.16(s).
- viii. If applicable, any excess independent claim fee, due because the number of independent claims exceeds three, as set forth in 37 CFR 1.16(h).
- ix. If applicable, any excess claim fee, due because the number of claims exceeds twenty, as set forth in 37 CFR 1.16(i).

If any fee is unpaid at the time of filing of the application, the request for Prioritized Examination will be dismissed. However, if an explicit authorization to charge any additional required fees has been provided in the papers accompanying the application and the request, the fees will be charged in accordance with the authorization, and the request will not be dismissed for nonpayment of fees.

15% Surcharge

Question FEE3: On what date will I have to begin paying the 15% increase on patent fees?

The 15% increase in fee rates will become effective at 12:00 a.m. on Monday, September 26, 2011.

Question FEE4: I would like to ensure that I am paying the proper amount. How do I determine the new fee rates after applying the 15% increase?

The specific fees that will be increased by 15% are listed in the table [here](#). The entire updated fee schedule can be found at <http://www.uspto.gov/about/offices/cfo/finance/fees.jsp>.

Question FEE5: Are there any patent fees that will not be increasing by 15%?

Yes. Fees such as international stage PCT fees, certain petition fees, enrollment fees, and service fees will not be increasing by 15%.

Question FEE6: What will happen if I forget to pay the increased fee amount on or after September 26, 2011?

The applicable fee amount is the amount in effect on the day the fee is paid. If the applicable fee amount is not paid, the USPTO will treat the submission as having an insufficient payment of fees. Applicants are encouraged to provide authorization in the application file to charge fees to a specified Deposit Account to avoid insufficient payment of fees.

Question FEE7: On June 27, 2011, the USPTO issued a notice of proposed rulemaking to adjust certain patent fee amounts for fiscal year 2012 to reflect fluctuations in the Consumer Price Index (CPI). Does the office plan to implement this increase in addition to the 15% patent fee increase in the AIA?

No. Given the timing of the enactment of the AIA so close to the beginning of fiscal year 2012, the USPTO does not plan on implementing the CPI for fiscal year 2012.

Question FEE8: Did the 15% increase to certain patent fees impact the FY 2011 fee collections?

Yes, the USPTO collected and was able to spend almost \$5 million more in patent fees during FY 2011 related to the 15% fee increase and the prioritized examination fee. However, the timing of enactment of the AIA led to an unfortunate rush on fee payments during the 10 days from AIA enactment (September 16, 2011) to the fee increase effective date (September 26, 2011). Prior to enactment of the AIA, the USPTO estimated that it would collect approximately \$70 to \$80 million more than the \$2.090 billion it was authorized to spend. The rush on fee payments triggered an additional \$139 million in FY 2011 fee collections above the \$2.090 billion authorized level. The total \$209 million in fees above the USPTO's FY 2011 appropriation are not available for the USPTO to spend on operations. The USPTO estimates that about half of these unavailable fees are collections that otherwise would have been received in FY 2012.

Electronic Filing Incentive

Question FEE9: When will the USPTO begin collecting the additional \$400 (and \$200 for small entity) for an original patent application (except for a design, plant, or provisional application) that is not filed electronically?

This new fee will be effective at 12:00 a.m. on Tuesday, November 15, 2011. This fee applies to a patent application filed by mail, rather than via the Office's electronic filing system (EFS-Web). This includes PCT international applications filed with the USPTO as the Receiving Office. All applications filed by mail or hand delivery on or after November 15, 2011, must include the additional \$400 (\$200 for small entity) fee. Requests for Continued Examination (RCE) are not subject to the additional \$400 (\$200 for small entity) fee.

Fee Setting Authority

Question FEE10: When will the USPTO set or adjust fees using the fee setting authority outlined in section 10 of the Act?

The USPTO published a notice of proposed rulemaking (NPRM) to set and adjust patent fees using the section 10 fee setting authority. The NPRM and supporting materials are available at http://www.uspto.gov/aia_implementation/fees.jsp#heading-1. The public comment period ends on November 5, 2012. The Office will issue a final rulemaking after considering the comments from the public. The Office expects most of the new fees could be effective during the Spring of 2013.

Question FEE11: Will I have an opportunity to provide input into the fee amounts that might be revised using the USPTO's new fee setting authority under section 10 of the AIA?

When the USPTO sets fees using the authority outlined in section 10 of the AIA, the public will have at least three (3) opportunities to provide suggestions and comments. The first opportunity is now. While the USPTO is deliberating internally about fees, you can provide suggestions or ideas for the USPTO to consider by emailing the USPTO at aia_implementation@uspto.gov. The second opportunity will be during the public hearing held by the Patent Public Advisory Committee (watch for the date(s) on our AIA calendar of events). The third opportunity will be during the 60-day public comment period after the USPTO publishes the notice of proposed rulemaking.

Micro Entity

Question FEE12: If I meet the micro entity of the AIA, will I be able to pay a micro entity fee beginning on the date of enactment – September 16, 2011?

No. The AIA does not permit the USPTO to apply the 75% micro entity fee discount until the micro entity fee for a specific item is set or adjusted using the fee setting authority provided in section 10 of the Act.

Miscellaneous

Question FEE13: Will fees collected in FY 2011 in excess of USPTO's appropriations be deposited into the Reserve Fund created by Section 22 of the Act?

No, the reserve fund is only effective upon the first day of fiscal year 2012 (October 1). So any fees collected in excess of USPTO's appropriations in FY 2011 (see Question FEE12) would not be deposited in this new fund. Any fees collected in excess of FY 2012 amounts this coming year will be deposited in the new fund and, assuming the USPTO receives appropriations language giving the agency the authority to access these fees, would be available to the USPTO subject to submission of a reprogramming request.

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E. First Inventor to File

Question FITF1: What is the effective date of the First Inventor to File provision of AIA?

The effective date for the First Inventor to File provision of AIA is March 16, 2013.

Question FITF2: I'm an independent inventor planning on filing a new nonprovisional patent application on October 1, 2011. Will my patent application be subject to the first-inventor-to-file provisions?

No. The first-inventor-to-file provisions become effective on March 16, 2013. Thus, an application filed before that date would not be subject to the first-inventor-to-file provisions. The application will be treated under the first-to-invent provisions of the law in effect on September 15, 2011.

Question FITF3: Once the first-inventor-to-file provisions take effect on March 16, 2013, would someone who copies my idea and files a patent application on the subject matter before I do be entitled to a patent?

No. Only inventors are entitled to a patent. Someone who copies another's idea cannot be the inventor.

Question FITF4: My co-inventor disclosed our invention at a trade show one month before the filing date of our application. Will that disclosure prevent us from obtaining a patent?

No. Regardless of whether the application was filed before or after the first-inventor-to-file provisions take effect on March 16, 2013, disclosure one month prior to a filing date is not prior art to the claimed invention by virtue of a one year grace period.

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F. Inter Partes Reexamination

Question R1: What is the effective date of the provisions effecting inter partes reexamination?

The effective date of the inter partes reexamination provisions is September 16, 2011.

Question R2: Did the AIA change the standard for inter partes reexamination?

Yes. Section 6 of the AIA elevates the standard for granting a request for inter partes reexamination. Under the new standard, the information presented in an inter partes reexamination request must provide a showing that there is a reasonable likelihood that the requester will prevail with respect to at least one of the patent claims challenged in the request. The standard for ex parte reexamination remains unchanged.

Question R3: If a request for inter partes reexamination was filed before the enactment date of the AIA, but a determination on the request has not yet been issued, which standard will be applied in determining whether to grant inter partes reexamination?

The Substantial New Question of patentability (SNQ) standard is applicable in determining whether the request for inter partes reexamination will be granted for any inter partes reexamination proceeding with a request filed prior to the date of enactment of the AIA (i.e., September 16, 2011).

Question R4: If a request for inter partes reexamination was granted under the SNQ standard, will the resulting proceeding continue until its conclusion under the SNQ standard?

Yes. If reexamination was ordered based on the SNQ standard, the SNQ standard will continue to be applied until the conclusion of the proceeding.

Question R5: What is inter partes review and when is it available?

Inter partes review replaces inter partes reexamination as an avenue for a third party's patentability challenge and the provision in the AIA for inter partes review is effective on September 16, 2012.

Question R6: When inter partes review under section 6 of the AIA takes effect on September 16, 2012, will pending inter partes reexaminations be converted to inter partes review proceedings?

No. Pending inter partes reexaminations will not be converted into inter partes review proceedings. Proceedings for inter partes reexamination filed prior to September 16, 2012, will proceed to conclusion even if the proceedings last beyond September 16, 2012

Question R7: If a request for inter partes reexamination is filed on September 16, 2012, how will it be treated?

Any request for inter partes reexamination filed on or after September 16, 2012, will not be granted.

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G. Inter Partes Review

Effective Date

Question IPR1: What is the effective date for the inter partes review provision in the AIA?

The effective date for the inter partes review provision in the AIA is September 16, 2012.

Eligibility

Question IPR2: What patents are eligible for an inter partes review?

All patents issuing from applications subject to first-inventor-to-file provisions of the AIA as well as those patents issuing from applications subject to the first-to-inventor provisions in current Title 35.

Petition for an Inter Partes Review

Question IPR3: When can a petitioner bring an inter partes review for a patent?

A petition for inter partes review cannot be filed until after the later of:

- (i) 9 months after the grant of a patent or issuance of a reissue of a patent; or
- (ii) the date of termination of any post-grant review of the patent.

Question IPR4: Who may file for an inter partes review?

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 petition for an inter partes review of the patent.

Question IPR5: On what grounds may a petitioner challenge a patent in an inter partes review?

A petitioner for inter partes review may request to cancel as unpatentable one or more claims of a patent 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.

Question IPR6: How does a party request an inter partes review?

To initiate an inter partes review, a party must file a petition establishing certain statutory requirements.

Question IPR7: What statutory and regulatory requirements must a petitioner meet in a petition for an inter partes review?

In a petition for an inter partes review, the petitioner must by statute (i) identify all real parties in interest; (ii) identify all claims challenged and all grounds on which the challenge to each claim is based; and (iii) provide copies of evidence relied upon. The petition must be accompanied by a fee. In addition, the petitioner must by rule (i) identify the grounds for standing; (ii) provide a claim construction for each challenged claim; (iii) specifically explain the grounds for unpatentability; and (iv) specifically explain the relevance of evidence relied upon.

Question IPR8: What is the fee for filing an inter partes review petition?

The AIA requires the Director to set the fee for a post grant review in such amounts as the Director determines to be reasonable, considering the aggregate costs of the review. The fee for filing a petition challenging the patentability of up to 20 claims is \$27,200. For each additional claim challenged, there is a fee of \$600.00.

Question IPR9: Can a patent owner respond to a petition for an inter partes review?

Yes, a patent owner may file a preliminary response to the petition to provide reasons why no inter partes review should be instituted.

Question IPR10: How long does a patent owner have to file a preliminary response after receiving notice that a petition has been filed challenging the patentability of one or more of its claims?

A patent owner will have three months to submit a preliminary response.

Question IPR11: Does a patent owner have to file a preliminary response to avoid having a proceeding instituted?

No, a patent owner does not have to file a preliminary response. If the petition does not meet the standard set for instituting the proceeding, then the petition will be denied even if there is no preliminary response from the patent owner. The patent owner may, but is not required to, inform the Board if it does not intend to file a preliminary response.

Question IPR12: May a patent owner challenge the standing of a petitioner in the preliminary response?

A patent holder may challenge the standing of a petitioner in the preliminary response. For example, a patent holder may provide evidence that the petitioner has filed a civil action challenging patentability prior to filing the petition or that the petitioner otherwise is estopped from challenging the patent owner's claims.

Standard to Institute an Inter Partes Review

Question IPR13: What is the standard for instituting an inter partes review and who will decide whether the standard is met?

The petitioner must demonstrate that there is a reasonable likelihood that he/she would prevail as to at least one of the claims challenged to trigger an inter partes review. The Board of Patent Appeals and Interferences (soon to be renamed the Patent Trial and Appeal Board) will decide petitions for inter partes review and conduct any ensuing reviews. In instituting a review, the Board may take into account whether, and reject the petition or request because, the same or substantially same prior art or arguments previously were presented to the Office.

Question IPR14: Can a party request rehearing of the Board's decision denying its petition?

Yes, a party may request rehearing of the Board's decision. The request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was addressed.

Question IPR15: Can a party appeal the Board's decision whether to institute an inter partes review?

No, a party is statutorily precluded from appealing the Board's decision whether to institute an inter partes review.

Trial

Question IPR16: If an inter partes review is instituted, can the patent owner respond during the review?

Yes, a patent owner may file a response after the institution of an inter partes review.

Question IPR17: If an inter partes review is instituted, can the patent owner amend the claims during the review?

A patent owner may file one motion to amend the challenged patent claims, subject to the standards and procedures set by the Office, during an inter partes review. Amendments may cancel any challenged patent claim and/or propose a reasonable number of substitute claims.

Question IPR18: How much time does a patent owner have to file a response and/or amendment after review is instituted?

The schedule for each proceeding will be set by the Board. Ordinarily, a patent owner will have three months to file a response and/or amendment.

Question IPR19: If an inter partes review is instituted, can the petitioner file additional information?

Yes, a petitioner may supplement information provided in the petition for inter partes review by filing motion within one month of the date trial is instituted.

Question IPR20: May a party submit supplemental information after one month from institution?

A party may be authorized to file a motion to submit supplemental information belatedly. A party will not be permitted to submit supplemental information belatedly except upon a showing that the information could not have been earlier presented and that it is in the interests of justice for the Board to consider the information.

Question IPR21: How can a party to an inter partes review protect confidential information?

The AIA provides that the file of an inter partes review is open to the public, except that a party may seek to have a document sealed by filing a motion to seal. The AIA also provides for protective orders to govern the exchange and submission of confidential information.

Question IPR22: Is discovery permitted during an inter partes review?

The AIA authorizes the Office to set standards and procedures for the taking of discovery during an inter partes review, including that discovery be limited the depositions of witnesses submitting affidavits or declarations and what is otherwise necessary in the interest of justice.

Question IPR23: What type of discovery is permitted during an inter partes review?

Routine discovery includes cited documents, cross-examination of declaration testimony, and information inconsistent with positions advanced during the proceeding. The parties may agree mutually to provide additional discovery or either party may file an authorized motion seeking additional discovery.

Question IPR24: During an inter partes review, how can a party seek relief?

The AIA provides that a party may request relief during an inter partes review by filing a motion. In addition, the use of conference calls to raise and resolve issues in an expedited manner is encouraged. A party seeking relief may contact the Board and request a conference call, explaining why the call is needed. The Office envisions that most of the procedural issues arising during a proceeding will be handled during a conference call or shortly thereafter, i.e., in a matter of days.

Question IPR25: May a party file a motion seeking relief at any time during the inter partes review proceeding?

A motion will not be entered without Board authorization. Authorization may be provided in an order of general applicability, e.g., a scheduling order entered at the start of the trial, or during the proceeding after conferring with the Board.

Question IPR26: Is an oral hearing permitted during an inter partes review?

Yes, the AIA permits either party to a inter partes review to request an oral hearing.

Question IPR27: How long will an inter partes review take?

An inter partes review is statutorily required to be complete within one year of institution, except that the time may be extended up to six months for good cause.

Question IPR28: How will the Board conclude an inter partes review?

The AIA provides that where an inter partes review is instituted and not dismissed, the Board shall issue a final written decision. The decision shall address the patentability of any challenged patent claim and any new claim added via amendment during the inter partes review.

Question IPR29: May a party request rehearing of the final written decision?

Yes, either party may request rehearing of the Board's decision. The request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was addressed in the petition.

Estoppel

Question IPR30: After the Board renders a final decision in an inter partes review, do any estoppels apply against the petitioner?

Yes, a petitioner in an inter partes review may not request or maintain a subsequent proceeding before the Office with respect to any challenged patent claim on any ground that was raised or reasonably could have been raised in the inter partes review. Similarly, a petitioner in an inter partes review may not assert in a subsequent district court or ITC action that a claim is invalid on any ground that the petitioner raised or reasonably could have been raised in the inter partes review.

Question IPR31: After the Board renders a final decision in an inter partes review, do any estoppels apply against the patent owner?

Yes, a patent owner is estopped from taking action inconsistent with any adverse judgment including obtaining in a patent a claim that is patentably indistinct from a finally refused or cancelled claim or amending its specification or drawing in a way that it was denied during the proceeding.

Appeal

Question IPR32: Can a party to an inter partes review appeal the Board's final decision?

Yes, a party dissatisfied with the final written decision in an inter partes review may appeal to the Federal Circuit.

Other

Question IPR33: How will the Board handle multiple proceedings such as two or more inter partes reviews on the same patent?

Where another matter involving the same patent is before the Office during the pendency of the inter partes review, the Board may enter any appropriate order regarding the additional matter including providing for the stay, transfer, consolidation, or termination of any such matter. Joinder may be requested by a patent owner or petitioner.

Question IPR34: Can the parties to an inter partes review settle?

The AIA permits the parties to an inter partes review to settle. A settlement terminates the proceeding with respect to the petitioner, and the Board may terminate the proceeding or issue a final written decision.

Question IPR35: Can a party to an inter partes review be sanctioned?

Yes, then AIA requires the Office to prescribe sanctions for abuse of discovery, abuse of process, or any other improper use of an inter partes review, such as to harass or cause unnecessary delay or an unnecessary increase in the cost of the proceeding.

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H. Post Grant Review

Effective Date

Question PGR1: What is the effective date for the post grant review provision in the AIA?

The effective date for the post grant review provision in the AIA is September 16, 2012.

Eligibility

Question PGR2: What patents are eligible for a post grant review?

With limited exceptions, only those patents issuing from applications subject to first-inventor-to-file provisions of the AIA. The first-inventor-to-file provision of the AIA is not effective until March 16, 2013.

Petition for a Post Grant Review

Question PGR3: When can a petitioner bring a post grant review for a patent?

A post grant review may be requested on or prior to the date that is 9 months after the grant of a patent or issuance of a reissue patent.

Question PGR4: Who may file for a post grant review?

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 petition for a post grant review of the patent.

Question PGR5: On what grounds may a petitioner challenge a patent in a post grant review?

A petitioner for post grant review may request to cancel as unpatentable one or more claims of a patent on any ground that could be raised under paragraph (2) or (3) of 35 U.S.C. 282(b) relating to invalidity (i.e., novelty, obviousness, written description, enablement, indefiniteness, but not best mode).

Question PGR6: How does a party request a post grant review?

To initiate a post grant review, a party must file a petition establishing certain statutory requirements.

Question PGR7: What statutory and regulatory requirements must a petitioner meet in a petition for a post grant review?

In a petition for a post grant review, the petitioner must by statute (i) identify all real parties in interest; (ii) identify all claims challenged and all grounds on which the challenge to each claim is based; and (iii) provide copies of evidence relied upon. The

petition must be accompanied by a fee. In addition, the petitioner must by rule (i) identify the grounds for standing; (ii) provide a claim construction for each challenged claim; (iii) specifically explain the grounds for unpatentability; and (iv) specifically explain the relevance of evidence relied upon.

Question PGR8: What is the fee for filing a post grant review petition?

The AIA requires the Director to set the fee for a post grant review in such amounts as the Director determines to be reasonable, considering the aggregate costs of the review. The fee for filing a petition challenging the patentability of up to 20 claims is \$35,800. For each additional claim challenged, there is a fee of \$800.00.

Question PGR9: Can a patent owner respond to a petition for a post grant review?

Yes, a patent owner may file a preliminary response to a post grant review petition to provide reasons why no post grant review should be instituted.

Question PGR10: How long does a patent owner have to file a preliminary response after receiving notice that a petition has been filed challenging the patentability of one or more of its claims?

A patent owner will have three months to submit a preliminary response.

Question PGR11: Does a patent owner have to file a preliminary response to avoid having a proceeding instituted?

No, a patent owner does not have to file a preliminary response. If the petition does not meet the standard set for instituting the proceeding, then the petition will be denied even if there is no preliminary response from the patent owner. The patent owner may, but is not required to, inform the Board if it does not intend to file a preliminary response.

Question PGR12: May a patent owner challenge the standing of a petitioner in the preliminary response?

Yes, a patent holder may challenge the standing of a petitioner in the preliminary response. For example, a patent holder may provide evidence that the petitioner has filed a civil action challenging patentability prior to filing the petition or that the petitioner otherwise is estopped from challenging the patent owner's claims.

Standard to Institute a Post Grant Review

Question PGR13: What is the standard for instituting a post grant review and who will decide whether the standard is met?

The petitioner must demonstrate that it is more likely than not that at least one of the claims challenged in the petition is unpatentable to trigger a post grant review. Alternatively, the petitioner may show that the petition raises a novel or unsettled legal question that is important to other patents or patent applications. The

Board of Patent Appeals and Interferences (soon to be renamed the Patent Trial and Appeal Board) will decide petitions for post grant review and conduct any ensuing reviews. In instituting a review, the Board may take into account whether, and reject the petition or request because, the same or substantially same prior art or arguments previously were presented to the Office.

Question PGR14: Can a party request rehearing of the Board's decision on the petition?

Yes, a party may request rehearing of the Board's decision. The request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was addressed.

Question PGR15: Can a party appeal the Board's decision whether to institute a post grant review?

No, a party is statutorily precluded from appealing the Board's decision whether to institute a post grant review.

Trial

Question PGR16: If a post grant review is instituted, can the patent owner respond during the review?

Yes, a patent owner may file a response after the institution of a post grant review.

Question PGR17: If a post grant review is instituted, can the patent owner amend the claims during the review?

A patent owner may file one motion to amend the challenged patent claims, subject to the standards and procedures set by the Office, during a post grant review. Amendments may cancel any challenged patent claim and/or propose a reasonable number of substitute claims.

Question PGR18: How much time does a patent owner have to file a response and/or amendment after review is instituted?

The schedule for each proceeding will be set by the Board. Ordinarily, a patent owner will have three months to file a response and/or amendment.

Question PGR19: If a post grant review is instituted, can the petitioner file additional information?

A petitioner may supplement information provided in the petition for post grant review by a motion within one month of the date trial is instituted.

Question PGR20: May a party submit supplemental information after one month from institution?

A party may be authorized to file a motion to submit supplemental information belatedly. A party will not be permitted to submit supplemental information belatedly except upon a showing that the information could not have been earlier presented and that it is in the interests of justice for the Board to consider the information.

Question PGR21: How can a party to a post grant review protect confidential information?

The AIA provides that the file of a post grant review is open to the public, except that a party may seek to have a document sealed by filing a motion to seal. The AIA also provides for protective orders to govern the exchange and submission of confidential information.

Question PGR22: Is discovery permitted during a post grant review?

The AIA authorizes the Office to set standards and procedures for the taking of discovery during a post grant review, including that discovery be limited to evidence directly related to factual assertions advanced by either party in the proceeding.

Question PGR23: What type of discovery is permitted during a post grant review?

Routine discovery includes cited documents, cross-examination of declaration testimony, and information inconsistent with positions advanced during the proceeding. The parties may agree mutually to provide additional discovery or either party may file an authorized motion seeking additional discovery.

Question PGR24: During a post grant review, how can a party seek relief?

The AIA provides that a party may request relief during a post grant review by filing a motion. In addition, the use of conference calls to raise and resolve issues in an expedited manner is encouraged. A party seeking relief may contact the Board and request a conference call, explaining why the call is needed. The Office envisions that most of the procedural issues arising during a proceeding will be handled during a conference call or shortly thereafter, i.e., in a matter of days.

Question PGR25: Can a party file a motion seeking relief at any time during the post grant review proceeding?

A motion will not be entered without Board authorization. Authorization may be provided in an order of general applicability, e.g., a scheduling order entered at the start of the trial, or during the proceeding after conferring with the Board.

Question PGR26: Is an oral hearing permitted during a post grant review?

Yes, the AIA permits either party to a post grant review to request an oral hearing.

Question PGR27: How long will a post grant review take?

A post grant review is statutorily required to be complete within one year of institution, except that the time may be extended up to six months for good cause.

Question PGR28: How will the Board conclude a post grant review?

The AIA provides that where a post grant review is instituted and not dismissed, the Board shall issue a final written decision. The decision shall address the patentability of any challenged patent claim and any new claim added via amendment during the post grant review.

Question PGR29: May a party request rehearing of the final written decision?

Yes, either party may request rehearing of the Board's decision. The request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was addressed in the petition.

Estoppel

Question PGR30: After the Board renders a final decision in a post grant review, do any estoppels apply against the petitioner?

Yes, a petitioner in a post grant review may not request or maintain a subsequent proceeding before the Office with respect to any challenged patent claim on any ground that was raised or reasonably could have been raised in the post grant review. Similarly, a petitioner in a post grant review may not assert in a subsequent district court or ITC action that a claim is invalid on any ground that the petitioner raised or reasonably could have been raised in the post grant review.

Question PGR31: After the Board renders a final decision in a post grant review, do any estoppels apply against the patent owner?

Yes, a patent owner is estopped from taking action inconsistent with any adverse judgment including obtaining in a patent a claim that is patentably indistinct from a finally refused or cancelled claim or amending its specification or drawing in a way that it was denied during the proceeding.

Appeal

Question PGR32: Can a party to post grant review appeal the Board's final decision?

Yes, a party dissatisfied with the final written decision in a post grant review may appeal to the Federal Circuit.

Other

Question PGR33: How will the Board handle multiple proceedings for the same patent, such as two or more post grant reviews on the same patent?

Where another matter involving the same patent is before the Office during the pendency of the post grant review, the Board may enter any appropriate order regarding the additional matter including providing for the stay, transfer, consolidation, or

termination of any such matter. Joinder may be requested by a patent owner or petitioner.

Question PGR34: Can the parties to a post grant review settle?

The AIA permits the parties to a post grant review to settle. A settlement terminates the proceeding with respect to the petitioner, and the Board may terminate the proceeding or issue a final written decision.

Question PGR35: Can a party to a post grant review be sanctioned?

Yes, then AIA requires the Office to prescribe sanctions for abuse of discovery, abuse of process, or any other improper use of a post grant review, such as to harass or cause unnecessary delay or an unnecessary increase in the cost of the proceeding.

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I. Prioritized Examination (Track 1)

Prioritized Examination

Question PE1: What is prioritized examination?

Prioritized examination is a procedure for expedited review of a patent application for an additional fee. The Office's goal for prioritized examination is to provide a final disposition within twelve months of prioritized status being granted.

Question PE2: Who can I contact if I have questions about a decision dismissing my Request for Prioritized Examination or about how to file a Request for Prioritized Examination via EFS-Web?

Contact the person who signed the decision dismissing the request if there is a question about the dismissal. In addition, each Technology Center (TC) will have a few representatives who can be contacted about a specific decision dismissing a request for prioritized examination. Questions related to the filing of a request for prioritized examination via EFS-Web can be directed to the Patent Electronic Business Center at 866-217-9197 or ebc@uspto.gov. General questions about the prioritized examination program can be directed to the Office of Patent Legal Administration at (571) 272-7704 or patent.practice@uspto.gov.

Question PE3: Is applicant required to use the Office's certification and request form PTO/SB/424?

It is strongly recommended that applicants use the Office's certification and request form PTO/SB/424 to request prioritized examination, but the form is not required. The form is available on EFS-Web and on the Office's Internet Web site at <http://www.uspto.gov/forms/index.jsp>. Failure to use form PTO/SB/424 could result in the Office not recognizing the request or delays in processing the request. If applicant

decides to use an applicant-created form for requesting prioritized examination, applicant's form should be an equivalent to the Office's form.

Question PE4: How will I know if the limit of 10,000 granted requests for prioritized examination for the fiscal year has been reached?

The Office posts statistics, including the number of granted prioritized examination requests, on its Web site at http://www.uspto.gov/aia_implementation/patents.jsp. In addition, the Office will post a message in EFS-Web if/when the number of granted requests is close to the limit. If the limit is reached, the Office will turn off the ability to file a request for prioritized examination in EFS-Web.

Question PE 5: The prioritized examination fee set forth in 37 CFR 1.17(c) is \$4,800 for a non-small entity and \$2,400 for a small entity. Is there a micro entity fee available for the prioritized examination fee under 37 CFR 1.17(c)?

No. This final rule implements the fee for prioritized examination as set forth in section 11(h) of the Leahy-Smith America Invents Act, and is not an exercise of the Office's fee-setting authority under section 10 of the Leahy-Smith America Invents Act such that a micro entity fee would apply.

Question PE6: My application has been granted special status under the prioritized examination (Track I) program. Will the application remain in that special status until either issuance or abandonment of the application?

The prioritized examination program grants special status until one of the following occurs:

- i. Applicant files a petition for extension of time to extend the time period for filing a reply.
- ii. Applicant files an amendment to amend the application to contain more than four independent claims, more than thirty total claims, or a multiple dependent claim.
- iii. Applicant subsequently files a request for continued examination (RCE).
- iv. Applicant files a notice of appeal.
- v. Applicant files a request for suspension of action.
- vi. A notice of allowance is mailed.
- vii. A final Office action is mailed.
- viii. The application is abandoned.
- ix. Examination is completed as defined in 37 CFR 41.102.

Question PE7: My application has been granted special status under the prioritized examination program. When can I expect the final disposition of the application?

The goal of the Office is to provide a final disposition within twelve months, on average, of the date that prioritized status was granted.

Question PE8: I received a decision dismissing my request for prioritized examination. Can I file a petition if I think the decision is not proper?

Applicant can file a petition under 37 CFR 1.181 if applicant believes that a decision dismissing the request for prioritized examination is not proper. Applicant should review the reason(s) stated in the decision dismissing the request and make a determination that an error was made by the Office in not granting the request before filing such a petition under 37 CFR 1.181.

Question PE9: May I file a petition for extension of time to extend the time period for filing a reply to an Office action?

While such a request will be acted upon as per MPEP 710.02, if applicant files a petition for an extension of time to file a reply or a request for a suspension of action, the prioritized examination of the application will be terminated.

Question PE10: What types of applications are eligible for Prioritized Examination?

Nonprovisional utility and plant patent applications filed under 35 U.S.C. 111(a), having no more than 4 independent claims, 30 total claims, and no multiple dependent claims, and filed on or after September 26, 2011, are eligible for Prioritized Examination (Track I). See FAQs labeled PE-TI below for details.

Original nonprovisional utility and plant patent applications filed under 35 U.S.C. 111, or having entered the national stage under 35 U.S.C. 371, in which a request for continued examination (RCE) has been filed, or is concurrently being filed, are eligible for Prioritized Examination. A request for prioritized examination must be made before an Office action responsive to the RCE has been mailed. See FAQs labeled PE-RCE below for details.

Prioritized Examination Track I (for original application filings)

Question PE-TI1: What is the effective date of prioritized examination (Track I)?

The effective date of prioritized examination for new applications (Track I) is September 26, 2011.

Question PE-TI2: What types of applications are eligible for Prioritized Examination (Track I)? How may I file a Request for Prioritized Examination?

Nonprovisional utility and plant patent applications filed under 35 U.S.C. 111(a), having no more than 4 independent claims, 30 total claims, and no multiple dependent claims, and filed on or after September 26, 2011, are eligible for Prioritized Examination (Track I). Requests for Prioritized Examination of utility patent applications must be filed using EFS-Web. Requests for Prioritized Examination of plant patent applications must be filed in paper. The request for prioritized examination must be present on filing of the utility or plant application.

Question PE-TI3: What fees are required upon filing a Request for Prioritized Examination (Track I)? What happens if one of the required fees is not present upon filing?

Consult the current fee schedule, available at <http://www.uspto.gov/about/offices/cfo/finance/fees.jsp>, for the correct fee amounts. The fees required to be paid upon filing for Prioritized Examination are:

- i. Basic filing fee, as set forth in 37 CFR 1.16(a), or for a plant application, 37 CFR 1.16(c).
- ii. Search fee, as set forth in 37 CFR 1.16(k), or for a plant application, 37 CFR 1.16(m).
- iii. Examination fee, as set forth in 37 CFR 1.16(o), or for a plant application, 37 CFR 1.16(q).
- iv. Publication fee, as set forth in 37 CFR 1.18(d).
- v. Track I processing fee, as set forth in 37 CFR 1.17(i).
- vi. Track I prioritized examination fee of \$4800.00 (\$2400.00 for small entities).
- vii. If applicable, any application size fee, due because the specification and drawings exceed 100 sheets of paper, as set forth in 37 CFR 1.16(s).
- viii. If applicable, any excess independent claim fee, due because the number of independent claims exceeds three, as set forth in 37 CFR 1.16(h).
- ix. If applicable, any excess claim fee, due because the number of claims exceeds twenty, as set forth in 37 CFR 1.16(i).

If any fee is unpaid at the time of filing of the application, the request for Prioritized Examination will be dismissed. However, if an explicit authorization to charge any additional required fees has been provided in the papers accompanying the application and the request, the fees will be charged in accordance with the authorization, and the request will not be dismissed for nonpayment of fees.

Question PE-TI4: I have an international application pending. Is there any way that I can file a U.S. application based on that international application and have the U.S. application be eligible for prioritized examination (Track I)?

Yes. An applicant may file a U.S. application under 35 U.S.C. 111(a), and in that application, claim the benefit of the earlier international application under 35 U.S.C. 365(c), or claim the right of priority of the earlier international application under 35 U.S.C. 365(a), subject to the conditions of 35 U.S.C. 365. Such an application is eligible for prioritized examination. However, an applicant may not request prioritized examination (Track I) of a national stage application (submitted under 35 U.S.C. 371) of an international application.

Question PE-TI5: I have a foreign application pending. Is there any way that I can file a U.S. application that claims priority to the foreign application under 35 U.S.C. 119(a)-(d) or (f), and have the U.S. application be eligible for prioritized examination (Track I)?

Yes. Any original utility or plant nonprovisional application filed under 35 U.S.C. 111(a) and claiming priority to a foreign application under 35 U.S.C. 119(a)-(d) or (f) is eligible for prioritized examination.

Question PE-TI6: I am filing an application, but one of the joint inventors has refused to execute an oath or declaration. I have prepared a petition under 37 CFR 1.47 to permit the

application to be made by the other inventor(s). Can I request prioritized examination (Track I) for this application?

Yes; however, the petition under 37 CFR 1.47 must be filed with the filing of the application. Prioritized examination status will not be granted if the petition under 37 CFR 1.47 is dismissed for any reason. Applicants should consult MPEP 409.03- 409.03(g) for guidance regarding petitions under 37 CFR 1.47 to ensure that a grantable petition under 37 CFR 1.47 is filed with the application. 37 CFR 1.102(e) requires that the application must be complete upon filing as defined by 37 CFR 1.51(b), which requires an oath or declaration having the attributes set forth in 37 CFR 1.63 and 37 CFR 1.68.

Question PE-TI7: Can I file an application under 35 U.S.C. 111(a) with a nonpublication request and a request for prioritized examination (Track I)?

Yes. However, the \$300 publication fee set forth in 37 CFR 1.18(d) must still be submitted with the request for prioritized examination (along with the other required fees), even though nonpublication is being requested.

Question PE-TI8: I just filed my utility application and the form for the request for prioritized examination (Track I) through EFS-Web, but I inadvertently omitted an item. Can I supplement my original EFS-Web filing with a follow-on submission that supplies the missing item?

Yes, but only if the follow-on EFS-Web submission is submitted on the same day that the utility application and the prioritized examination request form are filed. For example, if the oath or declaration or the filing fees are inadvertently omitted when the application is filed via EFS-Web, then applicant may submit the oath or declaration or the filing fees as a follow-on submission directly into the application on the same day as the filing date of the application. Applicants are also reminded that only registered users of EFS-Web can submit follow-on documents via EFS-Web and that follow-on documents are documents filed after the initial submission of the application. Thus, applicant would need to be a registered user of EFS-Web to submit such a follow-on document on the same day the application was filed. See also MPEP 502.05, III, D. for examples describing implications raised when applicant inadvertently omits an item when filing an application electronically via EFS-Web.

Question PE-TI9: I received a pre-examination notice from the Office of Patent Application Processing that identifies missing items or informalities in my original application filing. When will I receive a decision on my request for prioritized examination? Will my request for prioritized examination (Track I) be dismissed? Can I file an extension of time to respond to the notice?

Requests for prioritized examination will be acted upon once the application has met all formal requirements such that it is ready for examination. A description of what it means for an application to be in condition for examination is provided at MPEP 708.02, subsection VIII.C. Any pre-examination notice from the Office of Patent Application Processing will delay a decision on the request for prioritized examination until after applicant has filed a complete and timely reply to the pre-examination notice. A proper request for prioritized examination requires that the application be complete as

set forth in 37 CFR 1.51(b). Thus, the application must include a specification as prescribed by 35 U.S.C. 112 including claim(s), any required drawings, an executed oath or declaration under 37 CFR 1.63, and the required fees. If the application is not complete on filing as set forth in 37 CFR 1.51(b), then the request will be dismissed. Applicants may, however, receive a notice regarding informalities in their application (e.g., a notice to file corrected application papers because the application papers are not in compliance with 37 CFR 1.52) that results in the application not being in condition for examination. These other informalities or deficiencies in the application will delay a decision on the request for prioritized examination, as noted above. However, the request for prioritized examination may still be granted if the application is complete as set forth in 37 CFR 1.51(b).

Any request for an extension of time, including an extension of time for the purpose of responding to a pre-examination notice (e.g., Notice to File Missing Parts), will cause the application to be ineligible for further treatment under the prioritized examination (Track I) program. A request for an extension of time prior to the grant of prioritized examination status will prevent such status from being granted.

Question PE-TI10: May I file a request for prioritized examination (Track I) in a continuing application?

In order for a request for prioritized examination to be grantable, the application must be an original utility or plant application. The term "original application" includes both first filings and continuing applications; see MPEP 201.04(a). Thus, continuation, continuation-in-part, and divisional applications are eligible for prioritized examination, but reissue applications are not.

Question PE-TI11: If I file a preliminary amendment in an application that includes a request for prioritized examination (Track I), will that cause a pending request to be dismissed? Will it cause termination of the special status under prioritized examination if the request has already been granted?

A preliminary amendment filed in an application that includes a request for prioritized examination will not result in dismissal of a pending request, or termination of special status if a request has already been granted, so long as the preliminary amendment does not cause the application to contain more than four independent claims, more than thirty total claims, or a multiple dependent claim.

Question PE-TI12: I understand that the publication fee as set forth in 37 CFR 1.18(d) must be paid when filing a request for prioritized examination. May I submit a nonpublication request under 35 U.S.C. 122(b)(2)(B)(i)? If I submit a nonpublication request, must I still pay the publication fee? May I request a refund of the publication fee if I submit a nonpublication request?

You may submit a nonpublication request for an application even if prioritized examination is requested. However, the publication fee still must be paid. You may request a refund of the publication fee in accordance with MPEP 1126 if the application is not published under 35 U.S.C. 122(b).

Question PE-TI13: I filed a U.S. application under 35 U.S.C. 111(a) and claimed the benefit of an earlier international application under 35 U.S.C. 365(c) (a by-pass continuation). Is it necessary that the earlier international application have been filed in English in order to request prioritized examination of the 111(a) application?

No. However, a translation is required in accordance with 37 CFR 1.52(b)(1).

Question PE-TI14: May I file an application with color drawings by EFS-Web, and is a petition necessary?

Yes, color drawings may be filed with new applications through EFS-Web. As stated at MPEP 502.05(VIII), "color drawings . . . may be submitted via EFS-Web in only the following types of applications and proceedings: . . .

(3) Nonprovisional utility patent applications under 35 U.S.C. 111(a), including reissue utility patent applications;

(4) U.S. national stage applications under 35 U.S.C. 371"

See MPEP 502.05 for filing instructions. See also the EFS-Web legal framework at 74 Fed. Reg. 55200.

Yes, a petition is still required for entry of color drawings; see MPEP 608.02(VIII).

Question PE-TI15: My request for prioritized examination (Track I) was dismissed. What fees can be refunded?

Only the Track I prioritized examination fee, set forth in 37 CFR 1.17(c), will be refunded upon the dismissal of the original request for prioritized examination. This fee will be refunded automatically (if paid) without the need for applicant to request such a refund. The Track I processing fee, set forth in 37 CFR 1.17(i), will be retained to cover the cost of processing the request. In accordance with 37 CFR 1.26, the application fees, including the basic filing fee, search fee, examination fee, and any required application size or excess claim fees cannot be refunded. Applicant may, however, request a refund of the search fee and any excess claims fees by filing a petition for express abandonment of the application in accordance with 37 CFR 1.138(d). Furthermore, applicant may request a refund of the publication fee in accordance with MPEP 1126 if the application is not published under 35 U.S.C. 122(b).

Prioritized Examination for a Request for Continued Examination (RCE)

Question PE-RCE1: What is the effective date of prioritized examination for RCE filings?

The effective date of the program for prioritized examination for requests for continued examination is December 19, 2011.

Question PE-RCE2: For what type of applications, and in which circumstances, may I file Prioritized Examination (RCE)?

Original nonprovisional utility and plant patent applications filed under 35 U.S.C. 111, or having entered the national stage under 35 U.S.C. 371, in which a request for continued

examination (RCE) has been filed, or is concurrently being filed, are eligible for Prioritized Examination. A request for prioritized examination must be made before an Office action responsive to the RCE has been mailed. The application must contain, or be amended to contain, no more than 4 independent claims, 30 total claims, and no multiple dependent claims. Requests for Prioritized Examination of utility patent applications must be filed using EFS-Web. Requests for Prioritized Examination of plant patent applications must be filed in paper.

Question PE-RCE3: When may I file a request for prioritized examination in a case in which a request for continued examination has been or will be filed?

The request for prioritized examination must be filed prior to the mailing of a first Office action after the filing of a request for continued examination, and either be filed concurrently with, or subsequently to, the filing of a request for continued examination.

Question PE-RCE4: How do I file a Request for Prioritized Examination?

The request for prioritized examination may be filed using form PTO/SB/424, which is available on EFS-Web and on the Office's Internet Web site at <http://www.uspto.gov/forms/index.jsp>. Failure to use form PTO/SB/424 could result in the Office not recognizing the request or delays in processing the request. If applicant decides to use an applicant-created form for requesting prioritized examination, applicant's form should be an equivalent to the Office's form.

Question PE-RCE5: What fees are required upon filing a Request for Prioritized Examination in a request for continued examination (RCE)? What happens if one of the required fees is not present upon filing?

Consult the current fee schedule available at <http://www.uspto.gov/about/offices/cfo/finance/fees.jsp> for the correct fee amounts. The fees required to be paid upon filing for Prioritized Examination for requests for continued examination are:

- i. If not previously paid, the publication fee, as set forth in 37 CFR 1.18(d).
- ii. Prioritized examination processing fee, as set forth in 37 CFR 1.17(i).
- iii. Prioritized examination fee of \$4800.00 (\$2400.00 for small entities).

If any fee is unpaid at the time of filing of the request for prioritized examination, the request for prioritized examination will be dismissed. However, if an explicit authorization to charge any additional required fees has been provided in the papers accompanying the request, the fees will be charged in accordance with the authorization, and the request will not be dismissed for nonpayment of fees.

Question PE-RCE6: When filing a request for prioritized examination for continued examination in an application that is national stage entry under 35 U.S.C. 371, how do I identify the proper fees in EFS-Web?

EFS-Web currently does not provide an entry for the prioritized examination fee in its "Calculate Fees" Tab for applications which are national stage entries. When filing a

request for prioritized examination for continued examination, applicants should use the "Calculate Fees" Tab to select the processing fee (listed under "Miscellaneous Patent Fees" as #1808). The "Calculate Fees" Tab should also be used to select the publication fee (listed under "Post Allowance and Post Issuance Fees" as #1504) and the RCE fee (listed under "Miscellaneous Patent Fees" as #1801) if these have not been previously paid. The fee for prioritized examination should be paid using form PTO/SB/17 and entering "Prioritized Examination Fee" and the proper fee amount in the "Other" line under section 4, "Other Fee(s)". Form PTO/SB/17 should then be included in the EFS-Web filing through the "Attach Documents" tab.

Thus, applicants will attach forms PTO/SB/424 and PTO/SB/17, as well as any forms or documents incident to the request for continued examination (if not previously filed), using the "Attach Documents" tab. Applicants will use the "Calculate Fees" tab to identify fees such as the processing fee, RCE fee (if not previously paid), and publication fee (if not previously paid). Note that this procedure only applies to applications that are national stage entries, for which prioritized examination for a request for continued examination is being sought.

Question PE-RCE7: Is prioritized examination now available for applications that were filed as a national stage entry under 35 U.S.C. 371?

Upon filing a request for continued examination, prioritized examination becomes available for an application filed as a national stage entry under 35 U.S.C. 371. Track I prioritized examination is still available only to a U.S. application under 35 U.S.C. 111(a) meeting the requirements of the program.

Question PE-RCE8: Is there a separate limit of 10,000 granted requests for prioritized examination for the fiscal year for RCE filings?

No, the 10,000 limit applies to the sum of all granted requests for prioritized examination, including both Track I and prioritized examination for RCE requests.

Question PE-RCE9: My application has previously been granted special status under the prioritized examination (Track I) program. I am now filing an RCE for that application. May I file a request for prioritized examination with that RCE filing?

Yes. The prioritized examination program permits a single request to be granted upon filing a new application under 35 U.S.C. 111(a), and a single request to be granted upon filing a request for continued examination under 37 CFR 1.114.

Question PE-RCE10: My application has previously been granted special status under the prioritized examination (RCE) program. I am now filing a second RCE for that application. May I file a request for prioritized examination with that second RCE filing?

No. The prioritized examination program permits only a single request to be granted associated with a request for continued examination under 37 C.F.R. 1.114 in that application.

Question PE-RCE11: I received a decision dismissing my request for prioritized examination for a request for continued examination. May I file a petition if I think the decision is not proper? May I file a second request for prioritized examination?

Applicant may file a petition under 37 CFR 1.181 if applicant believes that a decision dismissing the request for prioritized examination is not proper. Applicant should review the reason(s) stated in the decision dismissing the request and make a determination that an error was made by the Office in not granting the request before filing such a petition under 37 CFR 1.181. Alternately, applicant may file a new request for prioritized examination for that same request for continued examination. The new request must include the proper fees and be timely; *i.e.*, be filed prior to the mailing of a first Office action after the filing of the request for continued examination.

Question PE-RCE12: My request for prioritized examination (RCE) was dismissed. What fees can be refunded?

Only the Track I prioritized examination fee, set forth in 37 CFR 1.17(c), will be refunded upon the dismissal of the original request for prioritized examination. This fee will be refunded automatically (if paid) without the need for applicant to request such a refund. The Track I processing fee, set forth in 37 CFR 1.17(i), will be retained to cover the cost of processing the request. Applicant may request a refund of the publication fee in accordance with MPEP 1126 if the application is not published under 35 U.S.C. 122(b).

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J. Inventor's Oath or Declaration

Effective Date

Question IOD1: What is the effective date for the inventor's oath/declaration provision in the AIA?

The effective date for the inventor's oath/declaration provision in the AIA is September 16, 2012.

Inventor's Oath or Declaration

Question IOD2: Under the inventor's oath/declaration provision, what information must an inventor supply in his/her oath/declaration to be filed in the Office for a patent application?

An inventor must state in his/her oath/declaration that (i) he/she is an original inventor of the claimed invention; and (ii) he/she authorized the filing of the patent application for the claimed invention. An inventor is no longer required to (i) state that he/she is the first inventor of the claimed invention; (ii) state that the application filing is made without deceptive intent; or (iii) provide his/her country of citizenship.

Substitute Statement

Question IOD3: Does the inventor's oath/declaration provision permit a substitute statement in lieu of an inventor's oath/declaration?

Yes, the inventor's oath declaration provision permits a substitute statement to be filed in an application when the inventor is: (i) deceased; (ii) legally incapacitated; (iii) unable to be found or reached after diligent effort; or (iv) refuses to sign an oath/declaration.

Question IOD4: Who may file a substitute statement in lieu of an inventor's oath/declaration if such a statement is permitted in a patent application?

Any of the following entities may file a substitute statement on behalf of an inventor when such a statement is permitted in a patent application: (i) the inventor's legal representative; (ii) the assignee; (iii) a party to whom the inventor is under an obligation to assign; or (iv) a party who otherwise shows sufficient proprietary interest in the claimed invention.

Assignment with Statements

Question IOD5: Can an assignment document contain the statements required to be included in an inventor's oath/declaration?

Yes, an assignment may include the statements required in an oath/declaration. In such case, the applicant may file a combined inventor's oath/declaration and assignment document in the Office.

Timing

Question IOD6: Does the inventor's oath/declaration provision contain any timing restriction for filing an inventor's oath/declaration?

Yes, the inventor's oath/declaration provision permits the Office to issue a Notice of Allowance in an application only if: (i) the inventor's oath/declaration is filed; (ii) a substitute statement filed in lieu of the inventor's oath/declaration; or (iii) an assignment containing the statements required for an inventor's oath/declaration is recorded in the Office for the patent application.

Question IOD7: When is an applicant required to submit an inventor's oath/declaration?

An applicant (i) may submit the inventor's oath/declaration on filing of the application; or (ii) may postpone until the Office issues a Notice of Allowability, provided that the applicant files a signed Application Data Sheet identifying the inventive entity.

Assignee Filing

Question IOD8: Can a company, as the assignee, file a patent application for an invention on behalf of the company rather than on behalf of the inventor?

Yes, the assignee can be the applicant. However, the inventor must still execute an oath/declaration. The assignee may only execute a substitute statement in lieu of an oath/declaration where the inventor refuses to execute an oath/ declaration, cannot be found or reached after diligent effort, is deceased, or is legally incapacitated.

Question IOD9: Prior to September 16, 2012, an assignee was required to proceed via 37 C.F.R. §§ 3.71 and 3.73 to establish ownership of the application to be able to grant a power of attorney to prosecute the application. Is this still the case for a new application filed on or after September 16, 2012, where the assignee files the application as the applicant?

No, where the assignee is the applicant, the assignee may appoint a power of attorney to prosecute the application without having to comply with §§ 3.71 and 3.73.

Question IOD10: If an applicant postpones submission of the inventor's oath/ declaration until a Notice of Allowability issues, how will the Office know the inventorship to examine the application?

Where an applicant elects to postpone submission of the inventor's oath/ declaration, the applicant must submit a signed Application Data Sheet (ADS) identifying the inventive entity. The ADS must identify each inventor by his or her legal name and provide a mailing address and residence for each inventor.

Question IOD11: What type of notices will an applicant receive if he/she/it does not submit the inventor's oath/declaration on filing of an original (non-reissue) application?

The Office will not send a Notice to File Missing Parts requiring an inventor's oath/declaration if a signed Application Data Sheet (ADS) has been filed naming each inventor by his or her legal name and identifying a mailing address and residence for each inventor. Where the inventor's oath/declaration has not been submitted at the time that the application is otherwise in condition for allowance, the Office will send a Notice of Allowability (but not a Notice of Allowance and Fee(s) Due) requiring the inventor's oath/declaration.

Question IOD12: If an applicant postpones the submission of an inventor's oath/declaration until the application is otherwise in condition for allowance, when must the applicant submit an Application Data Sheet (ADS)?

The ADS should be submitted on filing of the application so that the inventive entity can be known. If there is no inventor's oath/declaration or signed ADS naming the inventive entity, the Office will send a Notice to File Missing Parts requiring the submission of either the inventor's oath/declaration or a signed ADS.

Question IOD13: If an applicant files a continuation-in-part (CIP) application after September 16, 2012, naming inventors X and Y, and the parent application named only

inventor X, can the applicant use in the CIP application a copy of the declaration signed by inventor X that was filed in the parent application?

Yes, an applicant can the declaration filed in the parent application if that declaration complies with new 35 U.S.C. 115 and a signed Application Data Sheet (ADS) is filed in the CIP application (either before or with the copy of the parent declaration) naming the inventive entity (X and Y). An oath or declaration signed by the additional inventor Y in the CIP application would also be required. But as long as a signed ADS was filed naming the inventive entity (X and Y) in the CIP application, the oath or declaration executed by the additional inventor Y in the CIP application would not need to identify inventor X.

Reissue

Question IOD14: Since the AIA has eliminated the requirement for statements of lack of deceptive intent, what will be the impact on reissue practice?

The inventor's oath/ declaration filed in the reissue proceeding need not contain a statement that the error(s) being corrected occurred without deceptive intention, and a supplemental oath or declaration is no longer required due to the filing of an amendment.

Forms

Question IOD15: What forms has the Office made available related to the inventor's oath/declaration provision?

The Office has made a variety of new forms related to the inventor's oath/declaration provision available on the Office's AIA microsite as well as on the Office's form site, including an inventor declaration for an original (non-reissue) application, inventor declaration for a reissue application, substitute statement, and Application Data Sheet (ADS).

Question IOD16: Can I continue to use the same inventor declaration form after the effective date of the inventor's oath/declaration provision on September 16, 2012?

No. There is new statutorily-mandated language that must be included in the inventor oath/declaration after September 16, 2012, that is not included on the inventor oath/declaration form available before that date. The new statutorily mandated language includes: (1) a statement that "the application was made or authorized to be made by the affiant or declarant," and (2) the acknowledgement of penalties clause must refer to "imprisonment of not more than 5 years." The Office has made a new oath/declaration form containing the necessary statutorily-mandated language available on the Office's AIA microsite as well as on the Office's form site.

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K. Tax Strategies

Question TAX1: How does Section 14 of the AIA affect the patentability of tax strategies?

Applicants will no longer be able to rely solely on the novelty or non-obviousness of a tax strategy embodied in their claims in order to distinguish the claims from the prior art.

Question TAX2: What is the effective date of the tax strategy provisions in the AIA?

The effective date of the tax strategy provisions is September 16, 2011.

Question TAX3: Which patent applications will be subject to section 14 of the AIA?

Section 14 of the AIA applies to any patent application that is pending on, or filed on or after, September 16, 2011.

Question TAX4: If I have a patent issued before September 16, 2011, that undergoes reexamination, will Section 14 of the AIA apply during the reexamination?

No. Section 14 of the AIA applies to patents issued on or after September 16, 2011.

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L. Transitional Program for Covered Business Method Patents

Effective Date

Question CBMR1: What is the effective date for the covered business method review provision in the AIA?

The effective date for the covered business method review provision in the AIA is September 16, 2012.

Availability

Question CBMR2: How long will covered business method reviews be available?

The AIA provides that the covered business review provision sunsets after 8 years from the effective date of the provision. Accordingly, the Office will not accept new petitions for covered business method review filed on or after September 16, 2020.

Eligibility

Question CBMR3: What patents are eligible for a covered business method review?

A covered business method review is available for all patents issuing from applications subject to first-inventor-to-file provisions of the AIA as well as those patents issuing from applications subject to the first-to-inventor provisions in current Title 35, provided that the patent is drawn to a covered business method. The AIA specifies that a covered business method patent is a patent that claims a method or corresponding apparatus for performing data processing or other operations used in the practice, administration, or management of a financial product or service, except that the term does not include patents for technological inventions. The AIA does not specify what a patent for a technological invention covers, and therefore, the Office has promulgated a rule for technological invention.

Question CBMR4: What is a patent for a technological invention?

In determining whether a patent is for a technological invention, the following will be considered on a case-by-case basis: whether the claimed subject matter as a whole recites a technological feature that is novel and unobvious over the prior art; and solves a technical problem using a technical solution.

Question CBMR5: How will the Office interpret the term “financial product or service” provided in the covered business method definition?

In administering the program, the Office will consider the legislative intent and history behind the public law definition and the transitional program itself. For example, the legislative history explains that the definition of covered business method patent was drafted to encompass patents “claiming activities that are financial in nature, incidental to a financial activity or complementary to a financial activity.” 157 Cong. Rec. S5432 (daily ed. Sept. 8, 2011) (statement of Senator Schumer). This remark tends to support the notion that “financial product or service” should be interpreted broadly.

Question CBMR6: Is it the subject matter of the patent or the claims themselves that will be evaluated in determining whether a patent is a covered business method patent?

The definition for a covered business method patent provided in the AIA provides that a covered business method patent is “a patent that claims a method or corresponding apparatus for performing data processing . . . , except that the term does not include patents for technological inventions.” (Emphasis added.) The determination of whether a patent is a covered business method patent subject for review therefore will be based on what the patent claims.

Question CBMR7: Who bears the burden to demonstrate that at least one claim of the challenged patent is to a covered business method patent and not directed to a technological invention?

The petitioner bears the burden to demonstrate that the challenged patent is a covered business method patent and that at least one claim of the challenged patent is not directed to a technological invention to show that the petitioner has standing to proceed. The showing for both covered business method patent and technological invention is based on what is claimed.

Petition for a Covered Business Method Review

Question CBMR8: Who may file for a covered business method review?

Only a person who is sued or charged with infringement of a covered business method patent may petition for a covered business method review of the patent.

Question CBMR9: What does charged with infringement mean in the context of a covered business method review?

Charged with infringement means a real and substantial controversy regarding infringement of a covered business method patent exists such that the petitioner would have standing to bring a declaratory judgment action in Federal court.

Question CBMR10: When can a petitioner bring a covered business method review for a patent?

A covered business method review may be requested except during the period in which a petition for post-grant review could be filed, e.g., 9 months after the issuance of a patent that is subject to the first inventor-to-file provisions. The transitional review program is available for non-first-to-file patents, even within the first nine months of the grant of such patents.

Question CBMR11: On what grounds may a petitioner challenge a patent in a covered business method review?

A petitioner for covered business method review may request to cancel as unpatentable one or more claims of a covered business method patent granted under the first-to-file provisions of the AIA on any ground, but limited prior art shall apply for those challenged covered business method patents granted under the first-to-invent provisions of Title 35.

Trial

Question CBMR12: How will covered business method reviews be conducted?

Generally, the AIA provides that covered business method reviews will employ the standards and procedures of a post grant review, subject to certain exceptions such as the grounds for challenge and the scope of estoppel.

Question CBMR13: How long will a covered business method review take?

A covered business method review is statutorily required to be complete within one year of institution, except that the time may be extended up to six months for good cause.

Question CBMR14: How will the Board conclude a covered business method review?

Like in a post grant review, where a covered business review is instituted and not dismissed, the Board shall issue a final written decision. The decision shall address the patentability of any challenged patent claim and any new claim added via amendment during the covered business review.

Question CBM15: May a party request rehearing of the final written decision?

Yes, either party may request rehearing of the Board's decision. The request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was addressed in the petition.

Estoppel

Question CBMR16: After the Board renders a final decision in a covered business method review, do any estoppels apply against the petitioner?

Yes, a petitioner in a covered business method review may not request or maintain a subsequent proceeding before the Office with respect to any claim on any ground raised or reasonably could have been raised in the covered business method review. By contrast, a petitioner in a covered business method review may not assert in a subsequent district court or ITC action that a claim is invalid on any ground that the petitioner raised.

Question CBMR17: After the Board renders a final decision in a covered business method review, do any estoppels apply against the patent owner?

Yes, a patent owner is estopped from taking action inconsistent with any adverse judgment including obtaining in a patent a claim that is patentably indistinct from a finally refused or cancelled claim or amending its specification or drawing in a way that it was not permitted to do during the proceeding.

Appeal

Question CBMR18: Can a party to covered business method review appeal the Board's final decision?

Yes, a party dissatisfied with the final written decision in a covered business method review may appeal to the Federal Circuit.

Other

Question CBMR19: How will the Board handle multiple proceedings for the same patent, such as two or more covered business method reviews on the same patent?

Where another matter involving the same patent is before the Office during the pendency of the covered business method review, the Board may enter any appropriate order regarding the additional matter including providing for the stay, transfer,

consolidation, or termination of any such matter. Joinder may be requested by a patent owner or petitioner.

Question CBMR20: Can the parties to a covered business method review settle?

Like in a post grant review, parties to a covered method patent review are permitted to settle. A settlement terminates the proceeding with respect to the petitioner, and the Board may terminate the proceeding or issue a final written decision.

Question CBMR21: Can a party to a covered business review be sanctioned?

Yes, the AIA requires the Office to prescribe sanctions for abuse of discovery, abuse of process, or any other improper use of the review, such as to harass or cause unnecessary delay or an unnecessary increase in the cost of the proceeding.

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M. Preissuance Submissions

General

Question PS1: What is the effective date for the preissuance submission provision in the AIA?

The effective date for the preissuance submission provision in the AIA is September 16, 2012.

Question PS2: Who may file a preissuance submission?

A third party may file a preissuance submission in any non-provisional utility, design, or plant application, as well as in any continuing application, even if the application to which the submission is directed has been abandoned or has not been published. Third-party preissuance submissions may not be filed in any reissue application or reexamination proceeding.

Question PS3: What can a third party file in a preissuance submission?

A third party may file any patents, published patent applications, or other printed publications of potential relevance to the examination of a patent application.

Filing a Preissuance Submission

Question PS4: When can a third party make a preissuance submission in a patent application?

A third-party preissuance submission statutorily must be made in a patent application before the earlier of: (a) the date a notice of allowance under 35 U.S.C. 151 is given or mailed in the application; or (b) the later of (i) six months after the date on which the application is first published under 35 U.S.C. 122 by the Office, or (ii) the date of the first

rejection under 35 U.S.C. 132 of any claim by the examiner during the examination of the application.

Question PS5: How can a third party file a preissuance submission?

Third parties are encouraged to file third-party submissions electronically through the Office's dedicated web-based interface for third-party submissions, which can be accessed via EFS-Web. Submissions may also be submitted in paper through first-class mail, United States Postal Service (USPS) Express Mail service pursuant to 37 CFR 1.10, or by hand delivery. However, processing delays will be associated with paper submissions due to the scanning and indexing of these papers by the Office. Third-party submissions may not be filed by facsimile.

Question PS6: In what types of applications may a third party file a preissuance submission?

A third party may file a submission in any non-provisional utility, design, or plant application, as well as in any continuing application, even if the application to which the submission is directed has been abandoned or has not been published. Third-party submissions may not be filed in any issued patent, reissue application, or reexamination proceeding.

Content of a Preissuance Submission

Question PS7: What items must be included in a preissuance submission?

There are several items that must be included for a compliant preissuance submission:

1. Form PTO/SB/429 (or equivalent document list), identifying the publications, or portions of publications, being submitted [NOTE: use form PTO/SB/429 for paper submissions only; a completed form PTO/SB/429 will be automatically generated for electronic submissions];
2. A concise description of the asserted relevance of each item identified in the document list;
3. A legible copy of each item identified in the document list, other than U.S. patents and U.S. patent application publications;
4. An English language translation of any non-English language item identified in the document list;
5. Statements by the party making the submission that:
 - i. The party is not an individual who has a duty to disclose information with respect to the application under § 1.56; and
 - ii. The submission complies with the requirements of 35 U.S.C. 122(e) and § 1.290; and
6. Any required fee, or the statement that the fee exemption applies to the submission.

Question PS8: Is it an absolute requirement to include form PTO/SB/429 with a preissuance submission?

No, but it is highly recommended for paper submissions. Use of form PTO/SB/429 will help to ensure that important requirements are not overlooked, such as the document listing requirements and the required statements pursuant to § 1.290(d)(5). The form PTO/SB/429 will also enable the third party to indicate whether a fee is due or to select the “first and only” statement where the fee exemption applies.

Use of this form will not be necessary for preissuance submissions filed electronically via the Office’s dedicated Web-based interface for preissuance submissions, as this interface will prompt the third party to complete the fields that are provided on the form and will automatically format the entered information into an electronic version of the form PTO/SB/429 for electronic submission.

Question PS9: How should a third party request that the Office provide notification if a preissuance submission is non-compliant?

If filing electronically via the dedicated Web-based interface in EFS-Web, the request must be made on the “Applicant Data” screen under the heading “REQUEST FOR NOTIFICATION OF NON-COMPLIANT THIRD PARTY PREISSUANCE SUBMISSION.” Check the box requesting the notification and enter an email address in the box provided. The email address will not be made of record in the application should the submission be deemed compliant.

If filing in paper, the request must be made on a separate sheet of paper. The paper should be clearly titled “REQUEST FOR NOTIFICATION OF NON-COMPLIANT THIRD PARTY PREISSUANCE SUBMISSION” and identify the email address to which the notification should be directed. This separate paper must be clearly labeled so the paper is not made of record in the application.

Question PS10: If the publication date of a printed publication is not known, can a third party still include that document in the preissuance submission?

Yes, the third party may include a document for which the publication date is unknown in a preissuance submission. However, the third party must supply evidence of publication. At a minimum, the third party must provide a date of retrieval or a time frame when the document was available as a publication as well as include evidence that establishes the document as a publication. Such evidence may be in the form of affidavits, declarations, or any other appropriate format.

Question PS11: Can a third party use the requirement for a concise description of relevance to propose rejections of the claims to the examiner?

No, a third party should not through the concise description requirement propose rejections of the claims or set forth arguments relating to an Office action or applicant’s reply to an Office action. Instead, the third party should use the concise description requirement to set forth facts explaining how an item listed is of potential relevance to the examination of the application in which the submission has been filed. This is done, most effectively, by pointing out relevant pages or lines of the respective document and providing a focused description to draw the examiner’s attention to the relevant issues.

Question PS12: Where should a third party list an Office action on the form PTO/SB/429?

All non-patent publications, such as Office actions, journal articles, communications from foreign patent offices, court documents, etc. that qualify as publications should be listed under the “Non-Patent Publications” section of the form PTO/SB/429 (or entered in the “Non-Patent Publications” section of the “Application Data” screen when filing electronically).

Question PS13: Can a third party file an annotated copy of a listed document as the concise description of relevance for that listed document?

No, merely annotating or highlighting the copy of the listed document itself will not be deemed a proper concise description of relevance.

Question PS14: How should a third party include the concise description of relevance when filing electronically?

Concise descriptions may be entered as text in the provided text box on the “Application Data” screen. Alternatively, the concise description may be uploaded as a separate document on the “Attach Documents” screen. When entering a concise description of relevance in the provided text box, up to 250 characters may be entered. A concise description of relevance that exceeds 250 characters must be uploaded as a separate document on the “Attach Documents” screen. When filed as a separate paper, the concise description of relevance should clearly identify the document to which it pertains

Question PS15: If a third party is required to submit a translation for a non-English language document, can the third party submit a machine translation?

Yes, a reliable machine translation is acceptable. The translation need not be certified.

Question PS16: Can a third party submit a compact disc (CD) containing a software program in a preissuance submission?

No, a preissuance submission is required to be made in writing and contain printed publications. A software program may be submitted only if reduced to writing, such as in the form of screen shots. Additionally, evidence of publication may be required.

Timing of a Preissuance Submission

Question PS17: How can a third party determine if a planned preissuance submission will be timely given the limited statutory time window for such submissions to be made?

First, check Public PAIR to determine if a Notice of Allowance (NOA) has been issued in the application. If the NOA has been issued, you may not file a third-party submission. If the NOA has not been issued, determine if a first rejection has been issued by the examiner or if the application has been published for six months or longer. You may file as long as the first rejection has not been issued or the application has not been published for six months.

Question PS18: What happens if a third party files a preissuance submission on the same date the first rejection is mailed and the application has been published for more than six months?

If a third party files a preissuance submission on the same date the first rejection is mailed and the application has been published for more than six months, the submission would not be timely and would not be entered. All third-party submissions must be filed prior to, not on, the critical date. Where the application has been published for more than six months and no notice of allowance has been mailed, the critical date is the mailing date of the first rejection such that the third-party submission would need to be filed prior to the mailing date of the first rejection.

Question PS19: Does the holiday/weekend rule set forth in 37 CFR 1.7(a) apply to a preissuance submission?

Yes, the holiday/weekend rule set forth in 37 CFR 1.7(a) applies to a preissuance submission.

Fees

Question PS20: Is there a fee to file a preissuance submission?

Yes, a third party must submit a fee of \$180 for every ten documents listed or fraction thereof, unless the fee exemption applies to the submission. A third party is exempt from paying a fee for a submission of three or fewer documents, provided it is the party's first such submission and the party files a "first and only" statement.

Question PS21: If another third party has already taken advantage of the fee exemption in the application, may a second third party also benefit from the fee exemption in the same application?

Yes, a second third party may take advantage of the fee exemption in the same application as long as the submission includes three or fewer items and is accompanied by the "first and only" statement. However, such statement could not be made where the third parties are in privity with each other.

Question PS22: If an applicant took advantage of the fee exemption when he/she/it filed the first preissuance submission in an application, can the third party file a subsequent preissuance submission in the same application?

Yes, a third party may file a subsequent preissuance submission if the need for the subsequent submission was not known at the time of the earlier submission. Any such subsequent submission would not be exempt fee requirement.

Question PS23: Can an applicant electronically file a preissuance submission and pay the required fee at a later time?

No, the fee must accompany a preissuance submission at the time of filing. Registered e-Filers who authenticate can save "in-progress" submissions and return to edit them prior

to completing filing. Payment, in this instance, will be due when the filing is complete. Unregistered users, by contrast, must complete the filing and pay the fee at the time the submission is initiated.

Question PS24: If an applicant wishes to file a third-party submission of twelve documents, what is the required fee?

The required fee is \$180 for every ten items or fraction thereof identified in the document list. Therefore, the applicant would have to pay a fee of \$360 for twelve listed documents. If filing electronically, the applicant will need to split the twelve documents into two separate submissions, paying \$180 for each submission.

Question PS25: How can a third party pay the required fee for a preissuance submission?

When filing electronically, payment may be made on the "Pay Fees" screen by credit card, USPTO deposit account, or electronic funds transfer.

When filing in paper, payment may be made by check, money order, credit card, or deposit account. Checks and money orders must be made payable to the Director of the United States Patent and Trademark Office. Credit Card Payment Form (PTO-2038) should be used when paying by credit card. Form PTO-2038 may be downloaded at <http://www.uspto.gov/forms/index.jsp>. To protect your credit card information, do not submit this form electronically through EFS-Web. Credit card information for electronic credit card payments should be entered exclusively on the USPTO Web site providing electronic payment capability.

Processing of Preissuance Submissions

Question PS26: What happens if a preissuance submission is found non-compliant?

Third-party submissions that are not compliant with the statute will not be entered into the image file wrapper (IFW) record of an application or considered by the examiner. Instead, non-compliant preissuance submissions will be discarded. The Office will not refund the required fees or toll the statutory time period for making a third-party submission. Additionally, the Office will not accept amendments to a non-compliant submission, but the party may file another complete submission, provided the statutory time period for filing a submission has not closed.

Question PS27: Will a third party be notified if his/her/its preissuance submission is found non-compliant?

Yes, if a third party provides an electronic mail message (email) address with a preissuance submission, whether filed electronically or in paper, the Office will notify the third party of such non-compliance at the email address provided and will include the reason(s) for non-compliance. No notification will be issued where a third party does not provide an email address with the submission.

Question PS28: Does the applicant have any duty to respond to a preissuance submission?

No, absent a request by the Office, an applicant has no duty to, and need not, reply to a preissuance submission.

Question PS29: Will the applicant be notified when a preissuance submission is entered into his/her/its application?

Yes, the Office will notify the applicant upon entry of a compliant preissuance submission in an application file if the applicant participates in the Office's e-Office Action program. The contents of a compliant third-party submission will be made available to the applicant via its entry in the IFW of the application.

Question PS30: Can a third party file a preissuance submission electronically if the third party does not know the Confirmation Number for the application?

No, a third party cannot electronically file a preissuance submission without a Confirmation Number for the application. The Confirmation Number can be obtained by looking up the application number in the Public Patent Application Information Retrieval (PAIR) System located at <http://portal.uspto.gov/external/portal/pair> and viewing the Bibliographic Data. If the Confirmation Number is not available or not known, the preissuance submission cannot be filed electronically and instead must be filed in paper.

Question PS31: As a Registered eFiler, how should a third party access the preissuance submission interface of EFS-Web?

After user authentication, a third party must select "Existing application/patent" under the "Main Functions" heading and then select the radio button for "Third-Party Preissuance Submission under 37 CFR 1.290." Do not file a third-party submission by selecting "Documents/Fees for an existing application" because only an applicant and/or an applicant's representative may file follow-on papers in an application's file.

Question PS32: Can a third party file a protest using the preissuance submission interface of EFS-Web?

No, a protest under § 1.291 must not be filed via EFS-Web. Instead, all protests must continue to be filed in paper.

Question PS33: Can a third party file a preissuance submission via USPS Express Mail service?

Yes, the USPS Express Mail service provisions of § 1.10 apply to a preissuance submission under § 1.290.

Question PS34: How should a third party upload the form PTO/SB/429 using the preissuance submission interface of EFS-Web?

Form PTO/SB/429 cannot be uploaded to EFS-Web. Filing through EFS-Web is an electronic alternative to paper filing using form PTO/SB/429. Instead of uploading the form, EFS-Web will automatically generate and complete the form after a third party provides all of the necessary information on the "Application Data" screen. A third party

may click on the “Third-party-preissuance-submission.pdf” hyperlink to preview the generated form on the “Attach Documents” screen, and may make any necessary corrections by going back to the “Application Data” screen. Instructions for filing electronically are located at http://www.uspto.gov/patents/process/file/efs/guidance/QSG_Third_Party_Preissuance.pdf. Instructions for filing in paper using form PTO/SB/429 are located at http://www.uspto.gov/forms/3prsubmission_instructions.pdf.

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N. Citation of Patent Owner Statements in a Patent File

Question CPOS1: What is the effective date for the citation of patent owner statements provision in the AIA?

The effective date for the citation of patent owner statements provision in the AIA is September 16, 2012.

Question CPOS2: Who is permitted to submit patent owner statements?

Either a third party or the patent owner may cite patent owner statements in a patent file.

Question CPOS3: If a third party cites a patent owner statement, can a third party keep his/her identity confidential?

Yes, a third party can request in writing to maintain his/her identity in confidence, and it will be excluded from the patent file.

Question CPOS4: What types of written statements by a patent owner may be submitted into the official file of a patent?

A statement of the patent owner filed by the patent owner 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 the patent may be filed.

Question CPOS5: Is a written statement of the patent owner regarding claim scope filed in a proceeding before the International Trade Commission (ITC) eligible for submission?

No, the ITC is a Federal agency, not a Federal court. The citation of patent owner statements provision expressly provides for the submission of a statement filed in a proceeding before a Federal court or the Office only.

Question CPOS6: Is a deposition transcript of the patent owner filed by an accused infringer in a Federal court proceeding eligible for submission into the official file of a patent?

No, the deposition transcript does not qualify as a written statement by the patent owner because the transcript was not filed by the patent owner in the Federal court proceeding. Instead, it was filed by the accused infringer. Thus, the content of the

transcript are not taken to be a position by the patent owner in the Federal court proceeding.

Question CPOS7: Is a written statement by the patent owner regarding the scope of a claim of a particular patent eligible for submission into the official files of related patents?

No, the written statement of the patent owner must be directed to the claims of the particular patent to which the statement is directed for the statement to be eligible for entry into the official file of that patent.

Question CPOS8: What are the filing requirements for submitting a patent owner claim scope statement into the official file of a patent?

There are several items that must be included for a patent owner claim scope statement to be entered into the official file of a patent:

1.
 1. An explanation of the pertinence and manner of applying the written statement to at least one claim of the patent;
 2. Any other documents, pleadings, and evidence from the proceeding in which the statement was filed that address the written statement;
 3. Identification of the forum and proceeding in which patent owner filed the statement;
 4. Identification of the specific papers and portions of the papers submitted that contain the statement;
 5. Explanation of how each statement submitted constitutes a position taken by patent owner on the scope of any claim of the patent; and
 6. Proof of service upon the patent owner if the statement is submitted by a third party.

Question CPOS9: Can a patent owner include an explanation of how the claims remain patentable when submitting a patent owner claim scope statement?

Yes, a patent owner submitter may state how any claim is patentable over any submitted patent owner claim scope statement.

Question CPOS10: When can third party or patent owner file a citation of patent owner statements?

A third party or the patent owner may cite patent owner statements at any time.

Question CPOS11: Will the Office consider a patent owner claim scope statement when deciding whether to order reexamination?

No, the Office will only consider such a statement after reexamination has been ordered and only to inform the Office's determination of the proper scope and meaning of the claims.

Question CPOS12: Will the Office consider a patent owner claim scope statement when deciding whether to institute an administrative trial such as a post grant review, inter partes review, or covered business method review?

No, the Office may not consider such a patent owner claim scope statement when deciding whether to order or institute an administrative trial proceeding.

Question CPOS13: Will the examiner in a reexamination adopt the claim interpretation provided in the patent owner claim scope statement?

No, the examiner in a reexamination will not necessarily adopt the interpretation of the claims based solely upon a written statement of the patent owner. Claim construction standards for reexamination are unaffected. A written statement of the patent owner will be weighed with all other relevant information in making an independent determination of the proper claim scope and meaning of the claims by the Office once a reexamination proceeding is ordered.

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O. Supplemental Examination

General

Question SE1: What is the effective date for the supplemental examination provision in the AIA?

The effective date for the supplemental examination provision in the AIA is September 16, 2012.

Question SE2: What is the purpose for a supplemental examination?

The patent owner may request a supplemental examination for a patent so that the Office can consider, reconsider, or correct information believed to be relevant to the patent.

Question SE3: What type of information can a patent owner present to the Office in a supplemental examination?

The patent owner may present any information believed to be relevant to the patent. The information is not limited to patents or printed publications, but instead may include information concerning any ground of patentability, i.e., patent eligible subject matter, anticipation, obviousness, written description, enablement, best mode, and indefiniteness.

Filing a Request for Supplemental Examination

Question SE4: Who may file a supplemental examination?

The patent owner may file a supplemental examination; a third party is not permitted to seek a supplemental examination.

Question SE5: Which patents are eligible for supplemental examination?

A patent owner may request supplemental examination of any patent during the period of enforceability of the patent.

Question SE6: May a request for supplemental examination be filed by fewer than all of the joint owners of the patent, if the patent for which supplemental examination is requested is jointly owned by more than one party?

No, all parties having an ownership interest in the patent must act together as a composite entity in proceedings before the Office. This policy is consistent with *ex parte* reexamination practice. Under rare circumstances, such as in the case of a deceased or legally incapacitated joint owner, the Office may permit less than all of the joint owners to file a request if a grantable petition under 37 C.F.R. § 1.183 requesting waiver of the provisions of 37 C.F.R. §§ 3.71 and 3.73(c) is filed. If the owner of all or a portion of the entire right, title, and interest in the patent is an organization that is dissolved, the Office may require that a determination of the ownership of the patent be obtained from a court of competent jurisdiction.

Question SE7: May a supplemental examination request be filed by a licensee or other party that is not the owner of the patent?

No, only a patent owner may file a request for supplemental examination. The Office is not authorized to permit a party who is not a patent owner, or a party who merely states that it is, for example, an exclusive licensee or a person with sufficient proprietary interest under 35 U.S.C. 118, to file a request for supplemental examination.

Question SE8: Is the request for supplemental examination subject to a page limit?

No, there are no page limits applicable to a request for supplemental examination. However, if any document, other than the request, is over 50 pages in length, then the patent owner must provide a summary of the relevant portions of the document with citations to the particular pages containing the relevant portions. In addition, any non-patent document over 20 pages in length that is submitted as part of the request is subject to the document size fees.

Items of Information

Question SE9: What is an “item of information”?

An item of information includes a document containing information, believed to be relevant to the patent, that the patent owner requests the Office to consider, reconsider, or correct. An item of information is not limited to patents and printed publications, and may include, for example, a sales receipt or invoice. If the information is not, at least in part, contained within or based on any document filed as part of the request, the discussion within the body of the request relative to the information will be considered

to be an “item of information.” 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 to be an item of information.

Question SE10: How many items of information may a patent owner submit in a request for supplemental examination?

A request for supplemental examination may include up to twelve items of information.

Question SE11: If the discussion within the body of the request is based, at least in part, on a supporting document, will the discussion in the body of the request be counted as an item of information?

No, 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 the item of information. For example, if the patent owner discusses a potential public use or sale of the claimed invention, and also submits a supporting document with the request as possible evidence of a 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 an item of information.

Question SE12: May an item of information, such as an image of a supporting document, be embedded within the body of the request in lieu of being submitted as a separate copy of the supporting document?

No, if the patent owner presents an image of a supporting document, such as an image of an electronic mail message or other document, within the body of the request, then a separate copy of the supporting document must be provided. The separate copy of the item of information will be considered as the item 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.

Question SE13: Is an item of information required to be in writing?

Yes, an item of information must be in writing. The Office currently does not have the capability of retaining records in unwritten form. For this reason, any audio or video recording must be submitted in the form of a written transcript in order to be considered. A transcript of a video may be submitted together with copies of selected images of the video and a discussion of the correlation between the transcript and the copies of the video images.

Question SE14: If one item of information is combined in the request with one or more additional items of information, how will the combination of items of information be counted?

Each item of information of the combination will be separately counted. 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 will be separately counted, resulting in two items of information.

Question SE15: If one or more items of information are presented by the patent owner as cumulative, how will these items of information be counted?

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

Question SE16: If one item of information is discussed in the request with respect to multiple issues of patentability, will that single item of information be counted more than one time for each patentability issue?

No, the Office will count the number of items of information, not the number of issues discussed in the request with respect to that item. For example, a document which is discussed in the request as raising an issue under 35 U.S.C. 101 and also under 35 U.S.C. 112 will be counted as one item of information.

Question SE17: Will a declaration or affidavit be counted as an item of information?

Yes, a declaration or affidavit may be counted as an item of information.

Question SE18: If a declaration or affidavit presents multiple items of information, will the declaration or affidavit be counted as one item of information?

No, if a declaration or affidavit presents one or more separate and distinct items of information, then each item of information presented may be counted separately. For example, if a declaration presents information relating to an issue under 35 U.S.C. 101 affecting patent claim 1, and also presents information relating to an issue under 35 U.S.C. 103 affecting patent claim 10, then each item of information within the declaration will be counted separately, resulting in two items of information.

Fees

Question SE19: What fees are required to be filed with a request for supplemental examination?

A request for supplemental examination must be accompanied by a total fee of \$21,260, broken down as (i) a fee of \$5,140 for processing and treating a request for supplemental examination; and (ii) a fee of \$16,120 for *ex parte* reexamination ordered as a result of a supplemental examination proceeding. In addition, a request for supplemental examination must be accompanied by any applicable document size fees.

Question SE20: Will the patent owner receive a refund of a portion of the fees if reexamination is not ordered because no substantial new question of patentability was raised by any of the items of information properly submitted as part of the request?

Yes, the fee of \$16,120 for *ex parte* reexamination ordered as a result of a supplemental examination proceeding will be refunded if the supplemental examination certificate indicates that no substantial new question of patentability was raised by any of the items of information properly submitted as part of the request and reexamination is not ordered.

Question SE21: Which documents are subject to the document size fees?

The document size fees apply only to non-patent documents that have a length of more than 20 pages. Non-patent documents having a length of 20 pages or less are not subject to the document size fees. Non-patent documents include, for example, non-patent literature, transcripts of audio or video recordings, and court documents. Patent documents, such as U.S. patents, U.S. patent application publications, published international patent applications, and foreign patents, are not subject to the document size fees.

Question SE22: Would a translation of a patent document be subject to the document size fees?

No, translations of non-English language patent documents are also not subject to the document size fees.

Question SE23: Will blank pages in a non-patent document be counted for the purposes of the document size fee?

Yes, the Office will use an automatic page counter that will not subtract blank pages from the total page count for the non-patent document. This policy is consistent with the Office policy for application size fees.

Question SE24: How are the document size fees calculated?

Non-patent documents having 21 - 50 pages are subject to a fee of \$170, which must be submitted with the request. Non-patent documents having greater than 50 pages are subject to an additional fee of \$280 for each additional 50-page increment, or a fraction thereof, which must also be paid at the time of filing the request. For example, if a journal article having a length of 145 pages is submitted as an item of information which forms part of a request for supplemental examination, a document size fee of \$730 is due upon the filing of the request. The \$730 document size fee is calculated by adding the \$170 fee for 21 – 50 pages, and two additional fees of \$280 for each additional 50 pages, or a fraction thereof (i.e., a \$280 fee for 51 – 100 pages, and a second \$280 fee for the remaining 45 pages, which is a fraction of a 50-page increment).

Question SE25: What types of documents are subject to the requirement for a summary of the relevant portions of the documents, including citations to the particular pages containing the relevant portions?

Any document, other than the request, that is over 50 pages in length is subject to the summary requirement. "Any document" includes both patent and non-patent documents.

Processing a Request for Supplemental Examination

Question SE26: How will the Office treat a request for supplemental examination from a patent owner?

Within 3 months from the filing date of a request for supplemental examination from a patent owner, the Office will determine whether any of the items of information filed with the request raises a substantial new question of patentability. If a substantial new question of patentability is found for any item of information, then the Office will order an ex parte reexamination of the patent.

Question SE27: What standard applies in a supplemental examination?

In a supplemental examination, the Office will determine whether any item of information presented in the request raises a substantial new question of patentability. The substantial new question of patentability standard is triggered when there is a substantial likelihood that a reasonable examiner would consider an item of information important in determining the patentability of the claimed invention.

Question SE28: If the Office determines that an item of information raises a substantial new question of patentability and orders an ex parte reexamination, do the existing rules for an ex parte reexamination apply?

An ex parte reexamination ordered as a result of an ex parte reexamination will be conducted in accordance with the existing rules governing ex parte reexamination, except that: (i) the patent owner will not have the right to file a patent owner statement; and (ii) the Office will address each substantial new question of patentability without regard to whether it is raised by a patent or printed publication.

Question SE29: How will a supplemental examination terminate?

The Office will conclude a supplemental examination by issuing a certificate of supplemental examination. The certificate will indicate the results of the Office's determination as to whether any item of information filed by the patent owner in the request raised a substantial new question of patentability.

Question SE30: What benefit does a patent owner gain by seeking a supplemental examination for a patent?

The patent owner can immunize the patent against allegations of inequitable conduct by completing a supplemental examination. Specifically, information considered, reconsidered, or corrected during a supplemental examination cannot be the basis for rendering a patent unenforceable for inequitable conduct, so long as the supplemental examination and any resulting ex parte reexamination are completed before the civil action is brought. The patent owner, however, cannot secure inequitable conduct immunization for information raised in a civil action brought before a supplemental examination.

Question SE31: Are there any consequences if the patent owner commits a material fraud on the Office during a supplemental examination?

If a patent owner commits a material fraud on Office during the supplemental examination, then the Office may confidentially refer the matter to the U.S. Attorney General and may take other action.

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P. Miscellaneous

Question MISC1: When will the examination for registration to practice before the Office in patent matters be updated to include questions drawn to the Smith-Leahy America Invents Act?

The Smith-Leahy America Invents Act includes a number of provisions with varying effective dates. Additionally, many of the provisions require that the USPTO issue rules to implement new procedures.

The Office presently does not have a set schedule for updates to the registration examination to include changes made by passage of the patent reform bill. However, the Office expects the registration examination will undergo a number of changes in the next eighteen months as new laws, regulations, and procedures become effective.