

Training Module Number 29 for Supplemental Materials 7 Through 15

(Prepared January 14, 2012)

Introduction:

This Training Module covers the Leahy-Smith American Invents Act (AIA) passed on September 16, 2011. The AIA substantially changes the way the U.S. Patent and Trademark Office does business. It may be viewed as a once-in-a-decade (or so) transformation – with most of the provisions going into effect on September 16, 2012, one year after the AIA was passed.

Here is a brief listing of the major changes:

- The function of the old Board of Patent Appeals and Interferences has been so changed that it has been renamed the Patent Trial and Appeal Board - because interferences have been eliminated.
- Under the AIA, patents will be awarded to first-inventor-to-file rather than first-to-invent.
- A new Post Grant Review has been introduced for patents issuing from applications subject to the first-inventor-to-file provision.
- The old Inter Partes Reexamination procedure will be replaced by a new Inter Partes Review procedure.
- A new Preissuance Submission by Third Parties will substantially replace and broaden the old Protest procedures for patent applications.
- A new Supplemental Examination will be preformed by the USPTO on issued patents, at a substantial fee, if requested by the owner or assignee.
- Under the AIA, an assignee, rather than just the inventor(s), may file and prosecute a patent application as the applicant. Previously, the inventor was considered to be the applicant.
- The failure to disclose the best mode will 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.

- A “fast-track” (Track 1) examination for new applications may be requested by paying a premium fee. The objective is to complete an examination within 12 months.

These changes are fully described in Supplemental Materials 7 through 15 that follow in Brief Reviews of each of these items. Each Brief Review is followed by a link to the entire item that has been marked up in yellow, similar to the MPEP chapters in the previous training modules, to highlight the most relevant material.

BRIEF REVIEWS

7. Changes to Implement the Prioritized Examination Track (Track 1) of the Enhanced Examination Timing Control Procedures Under the Leahy-Smith American Invents Act.

Overview:

Nonprovisional utility and plant patent applications 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.

Detailed Review:

[\(Source Material 7\)](#)

8. Revision of Standard for Granting an Inter Parte Reexamination Request

Overview:

During the period of September 16, 2011 to September 16, 2012, there will be a change in the requirements to proceed with an Inter Partes Reexamination of a patent. The old requirement is for a substantial new question of patentability (SNQ) while the new requirement is 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.

After the above period, the Inter Partes Reexamination will be replaced by a new Inter Partes Review.

(The standard for Ex Parte Reexamination remains unchanged.)

Detailed Review:

(Source Material 8)

9. Rules of Practice Before the Board of Patent Appeals and Interferences in Ex Parte Appeals

Overview:

This supplemental material is not directly related to the AIA. Rather, it's origin is a consequence of the Federal Paperwork Reduction Act (PWA). As such, it results in several simplifications to Ex Parte Appeals, including: (1) removal of several briefing requirements for an appeal brief, and (2) a change so that the Board will presume that the appeal is taken from the rejection of all claims under rejection, unless canceled by an applicant's amendment.

These changes become effective on January 23, 2012.

Detailed Review:

(Source Material 9)

10. The Leahy-Smith America Invents Act: PUBLIC LAW 112-29 –September 16, 2011

Overview:

This source material is the entire Leahy-Smith America Invents Act. Since it is rather complex and lengthy (xxx pages) and the relevant materials are covered in other

Supplements, it is recommended that your review be limited to scanning the Table of Contents that is highlighted in Yellow under the Detailed Review that follows.

Detailed Review:

(Source Material 10)

11. Changes to Implement the Preissuance Submission by Third Parties Provision of the Leahy-Smith America Invents Act

Overview:

A third party may file a Preissuance Submission in any non-provisional utility, design, or plant application, as well as in any continuing or reissue application. The submission may include any patents, published patent applications, or other printed publications of potential relevance to the examination of a patent application.

The time window for making a Preissuance Submission is broader than for making the older Protest Submission.

Specifically, a third-party Preissuance Submission must be made in a patent application before the earlier of: (a) the date a notice of allowance 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 by the Office, or (ii) the date of the first rejection of any claim by the examiner during the examination of the application.

Detailed Review:

(Source Material 11)

12. Changes to Implement Miscellaneous Post Patent Provisions of the Leahy-Smith America Invents Act

Overview:

This supplement describes a new Post Grant Review proceeding and the replacement of the old Inter Partes Reexamination with a new Inter Partes Review proceeding.

This supplement also establishes that either a third party or the patent owner may cite patent owner statements in a patent file. In addition, a third party can request in writing to maintain his/her identity in confidence, and it will be excluded from the patent file.

Detailed Review:

(Source Material 12)

13. Changes to Implement the Inventor's Oath or Declaration Provisions of the Leahy-Smith America Invents Act

Overview:

Under this change, 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.

Any of the following entities may file a substitute statement on behalf of an inventor: (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.

Detailed Review:

(Source Material 13)

14. Changes to Implement the Supplemental Examination Provisions of the Leahy-Smith America Invents Act and To Revise Reexamination Fees

Overview:

Under the new Supplemental Examination provision, a patent owner may request a supplemental examination for a patent so that the USPTO can consider, reconsider, or correct information believed to be relevant to the patent. The purpose this provision is to permit a patent owner to address certain challenges to the enforceability of the patent. (A patent owner may file a Supplemental Examination but not a third party.)

The fees associated with a Supplemental Examination are substantial: \$5,140 for processing a

request for Supplemental Examination and \$16,120 for an Ex Parte Reexamination ordered as a result of 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.

A request for supplemental examination may include up to twelve items of information (including declarations and affidavits).

Detailed Review:

(Source Material 14)

15. Changes to Implement Inter Partes Review Proceedings, Post-Grant Review Proceedings, and Transitional Program for Covered Business Method Patents

Overview:

I. Inter Partes Review

Any 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.

A petition for an 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.

A petitioner for an 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.

To initiate an Inter Partes Review, a party must file a petition establishing certain statutory Requirements, including: (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.

II. Post-Grant Review

NOTE: 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. The first-inventor-to-file provision of the AIA is not effective until March 16, 2013.

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.

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.

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).

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

Detailed Review:

(Source Material 15)