



UNITED STATES PATENT AND TRADEMARK OFFICE

America Invents Act¹

Potential Items for Patents²

This list is being provided to aid the public in focusing its comments to the Office regarding implementation of the America Invents Act. Please submit your comments to aia_implementation@uspto.gov, marked to the attention of Hiram Bernstein, Senior Legal Advisor, Office of Patent Legal Administration, and captioned with the specific issue addressed in the comment. Each Roman numeral represents a specific issue.

- I. First Inventor to File 35 U.S.C. 102
Effective date (pages 23-4): Takes effect 18 months from date of enactment; and Applies to any application and patent (i) with a claim having an effective date on or after enactment, or (ii) having a specific reference under sections 120, 121, or 365(c) to an application having such a claim.
 - A. Effective filing date change in 35 U.S.C. 100/102:
 - i. re Hilmer (foreign national applications now have their foreign filing date as their prior art date), and
 - ii. deemed published under 35 U.S.C. 122(b) as defined by 35 U.S.C. 374 which provides prior art date to WIPO publications as the I.A. filing date but no requirement for publication under Art 21(2) or in English but must designate U.S.
 - B. 35 U.S.C. 102(a)(1), including “Otherwise available to the public.”
 - C. (1) 35 U.S.C. 102(a)(2)/(b):
 - a. Another application/patent was “effectively filed before the effective filing date of the claimed invention,” 35 U.S.C. 102(a)(2)/ 35 U.S.C. 102(d) relating thereto, and
 - b. the 1 yr grace period exceptions in 35 U.S.C. 102(b) (to 35 U.S.C. 102(a)) limited to disclosures by an inventor or another who obtained it from the inventor. (The common ownership exception of 35 U.S.C. 102(b)(2)(C) is treated in D below).
 - (2) The language change in 35 U.S.C. 120.

¹ H.R. 1249, passed June 23, 2011. Conforming changes to other sections are not identified

² Page references are to H.R. 1249.

- D. Common Ownership: Re joint research agreements in 35 U.S.C. 102(c)/ 35 U.S.C. 102(d) relating thereto, and common ownership 102(b)(2)(C), no longer limiting rejections to be overcome to 35 U.S.C. 103, expands to all prior art under 35 U.S.C. 102(a)(2)(no longer limited to removing rejections under (e), (f) and (g)), and common ownership no longer limited to at time of the claimed invention.
 - E. Elimination of 35 U.S.C. 102(c) (abandonment of invention).
 - F. Elimination of 35 U.S.C. 102(d) (first patented in a foreign country).
 - G. Elimination of 35 U.S.C. 102(f) (other than impact on derivation) and continued handling of improper inventorship.
 - H. Elimination of 35 U.S.C. 102(g) and impact re 37 CFR 1.131 (priority of invention).
 - I. Repeal of inventions made abroad, 35 U.S.C. 104, 35 U.S.C. 102: Public use and sale no longer limited to the U.S.
- II. Change in language to 35 U.S.C. 103(a), and (b):
 Effective date (pages 23-4): Takes effect 18 months from date of enactment; and Applies to any application and patent (i) with a claim having an effective date on or after enactment, or (ii) having a specific reference under sections 120, 121, or 365(c) to an application having such a claim.
- A. Change in 35 U.S.C. 103(a) language.
 - B. Eliminating opt-in standard for nonobviousness for certain biotech processes.
- III. Repeal of Statutory Invention Registration, 35 U.S.C. 157:
 Effective date (page 11): Takes effect upon the expiration of the 18-month period from the date of enactment.
- IV. Inventor's oath/declaration:
 Effective date (page 34): Takes effect 1-year from date of enactment, and Applies to any patent application filed on or after effective date.
- A. (1) Elimination of citizenship,
 (2) new required language of "authorized to be made,"
 (3) an alternative of providing an assignment, including the required statements, in lieu of placing the statements in a separate declaration,
 (4) the Director's additional requirements, including whether a copy from a prior application is to be submitted, 35 U.S.C. 115 and 121, and
 (5) the impact on supplemental oaths in applications (35 U.S.C. 115(h)(2)).

- B. Substitute and supplemental/corrected statements for nonsigning inventor, 35 U.S.C. 115 and 118.
- C. In reissue applications, the impact of the elimination of the lack of deceptive intent requirement (35 U.S.C. 251), and the forbidding of requiring an additional oath (35 U.S.C. 115(h)(2), *e.g.*, may no longer require supplemental declarations.
- D. Change of inventorship:
 - i. 35 U.S.C. 115(h)(2) eliminating additional oaths or “other statement equivalent to those required by this section,” and
 - ii. removal of “error arose without deceptive intent in 35 U.S.C. 116 and 35 U.S.C. 251, 253 and 256 (pages 129-132):
Effective date (page 135): Takes effect upon expiration of the 1-year period from date of enactment; and
Applies to proceedings commenced on or after the effective date.
- E. Any impact of prohibition against issuing a notice of allowance before a § 1.63 oath or declaration is filed:
Effective date (page 34): Takes effect 1-year from date of enactment, and
Applies to any patent application filed on or after effective date.
- V. Third Party Preissuance Submissions, 35 U.S.C. 122:
Effective date (page 84): Takes effect 1-year from the date of enactment; and
Applies to any patent application filed before, on or after that effective date.
 - A. Requirements:
 - i. new 35 U.S.C. 122(e) allows the submission of certain types of information (any patent, published patent application, or other printed publication) later in the prosecution; but does not provide for allegations of public use and sale or improper inventorship, which current 35 U.S.C. 122(c) continues to provide for,
 - ii. certain time periods (submission must be made before the earlier of (i) allowance, or (ii) later of 6 months after the date of application publication or the date of first rejection),
 - iii. a concise description of relevance, and a statement of compliance, and
 - iv. a fee as the Director may prescribe.
 - B. How to deal with protective orders covering submitted information of third party, or other non-owned confidential information.
- VI. Supplemental Examination:
Effective date (page 114): Shall take effect upon expiration of the 1-year period beginning on the date of enactment; and
Applies to any patent issued before, on or after effective date (*i.e.*, all patents).

Consider, reconsider or correct information:

- (1) Director discretion for form, content, reviewing information, and other requirements;
- (2) Information received is not limited to patents & printed publications.
- (3) Supplemental examination must be conducted within 3 months of the receipt of the request and must conclude with a certificate stating whether a substantial new question of patentability (SNQ) is raised;
- (4) If information supplied raises at least one substantial new question of patentability, Director is required to conduct a supplemental-examination-ordered *ex parte* reexamination not limited to patents & printed publications;
- (5) If Director becomes aware of fraud either during supplemental examination or reexamination based on supplemental examination, the Director will refer the matter to the Attorney General; and
- (6) There is a rule of construction not precluding investigation of misconduct, and authorizing issuance regulations regarding sanctions.

VII. Fee Setting for Patents' Items:

- A. Authority to set or adjust fees for recovering costs for fees specified by statute (35 U.S.C 41(d)) based on 7 yr sunset provision, and for so long as Office remains in Commerce, Fee Setting Authority:
Effective date (page 93): Effective on the date of enactment.
- B. Electronic filing incentive (\$400 fee for failure to do so): Need to collect \$400 fee where application is not electronically filed.
Effective date (page 93): Expiration of the 60 day period beginning on date of enactment
- C. Section 11 new statutory amounts:
Effective date (page 109): Date of enactment.
- D. Fees for supplemental examination request: (1. Request fee, and 2. fee to consider each item of information):
Effective date (page 114): Shall take effect upon expiration of the 1-year period beginning on the date of enactment.
- E. Fee for prioritized examination (Track 1):
Effective date (page 107): The date that is 10 days after the date of enactment.
- F. 15% transition surcharge fees:
Effective date (page 108): The date that is 10 days after the date of enactment.
- G. Reserve fund, 35 U.S.C. 42:
Effective date (page 138): October 1, 2011.

- H. Refunds and error in payment for cancelled claims and additional fees:
Effective date (page 109): Date of enactment.
- VIII. Micro Entity: Director’s discretion to define micro entity, 35 U.S.C. 123(a)(1) and (d)(2) re income limits, annual filing limits, or other limits:
Effective date (page 93): Takes effect on date of enactment.
- IX. Business Method Patents:
Tax avoidance/reduction strategies deemed to be within prior art:
Effective date (pages 116): On date of enactment; and
Applies to any patent application that is pending on, or filed on or after enactment date, and to any patent that is issued on or after enactment date.
- X. Reexamination (transition): Transition *inter partes* from a “substantial new question of patentability” to a “reasonable likelihood that the requester would prevail.”
Effective date: Date of enactment; and
Applies to requests for *inter partes* reexaminations filed during the one year period beginning on that date.
- XI. Citation of prior art in a patent file, 35 U.S.C. 301: Expanded to include written statements of the patent owner filed in proceedings before a Federal court or the Office taking a position on the scope of a patent claim. Provides for submission of additional information with such statements and limits the use of such statements (not to be considered for any purpose other than to determine the proper meaning of a patent claim).
Effective date (page 74):
1-year from date of enactment, and
Applies to any patent issued before, on or after the effective date.
- XII. Priority examinations:
A. Prioritized Examination (Track 1): Director may prescribe conditions for acceptance of request, including limit on claims, and limit the number of filings:
Effective date (page 107): The date that is 10 days after the date of enactment.
B. Priority examination re important technologies:
Effective date (Page 141): No specific date is provided in this section and so the Sec. 35 date should apply: one year after the date of enactment.
- XIII. Best Mode:
A. Failure to disclose best mode is no longer a basis on which a claim may be canceled or held invalid or otherwise unenforceable.

- B. The impact of a conforming amendment to 35 U.S.C. 119(e) and 120 that modifies 35 U.S.C. 112(a) with the following language “(other than the requirement to disclose the best mode).”
Effective date (pages 116-7):
Date of enactment; and
Applies to proceedings that commence on or after date of enactment.
- XIV. Genetic testing: Study ways to provide independent, confirming genetic diagnostic test activity:
Effective date (page 144): Report due not later than 9 months after the date of enactment.
- XV. Pro bono program: Possible development of materials, providing speakers:
Effective date (page 147): Date of enactment.
- XVI. Human organism prohibition: Addresses unpatentability of human organisms:
Effective date (page 147):
Date of enactment; and
Applies to any application that is pending on or filed after the date of enactment.
- XVII. Patent term extension for drugs:
Effective date (page 150):
As of the date of enactment; and
Applies to any application for extension that is pending on, that is filed after, or to which a decision regarding the application is subject to judicial review on the date of enactment.
- XVIII. Marking (virtual):
Effective date (page 119):
As of date of enactment; and
Applies to all cases, without exception, that are pending on, or commenced on or after the date of enactment.
- XIX. Civil action under 35 U.S.C. 145: No longer available in *ex parte* reexamination
Effective date (page 75):
As of date of enactment; and
Applies to any Appeal to the BPAI pending on, brought on or after date of enactment.