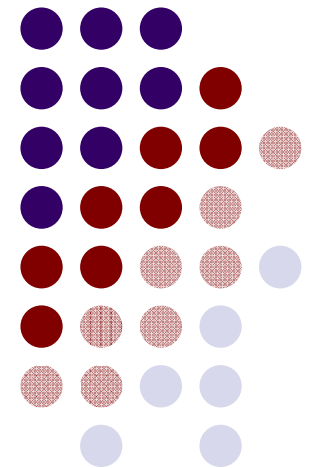
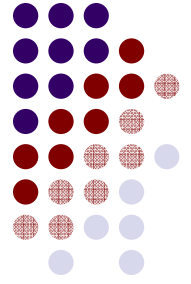


How the USPTO Rules Implement the AIA: Prosecution Strategies and Tips

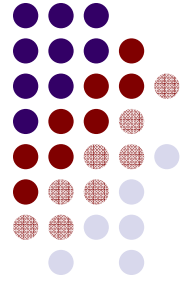
by Andrew D. Meikle
Birch Stewart Kolasch & Birch LLP





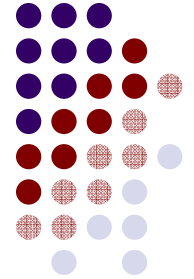
USPTO Rule Jargon

- AIA (America Invents Act)
- FITF (first-inventor-to-file system of AIA)
- FTI (first to invent system of pre-AIA)
- “effective filing date” of a patent claim
 - earliest filing date of an application (U.S. or non-U.S.) that supports (written description, enablement) the patent claim
- ADS (Application Data Sheet, now a much more important document)



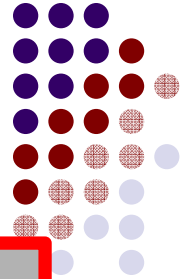
New USPTO Rules

- USPTO AIA microsite has a lot of helpful info:
http://www.uspto.gov/aia_implementation/index.jsp
- Link to USPTO Examination Rules and Policies
http://www.uspto.gov/aia_implementation/patents.jsp
- FITF Final Rules (implementing AIA):
78 Fed. Reg. 11024-59, Feb. 14, 2013
- FITF Final Guidance (USPTO Examiner policies):
78 Fed. Reg. 11059-88, Feb. 14, 2013



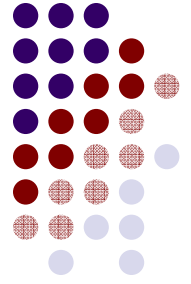
USPTO INTERPRETS AIA FITF: RULES AND EXAMINATION GUIDELINES

From USPTO: AIA Statutory Framework Summary for 35 USC 102(a),(b),(d)



| Prior Art 35 U.S.C. 102(a) (Basis for Rejection) | Exceptions 35 U.S.C. 102(b) (Not Basis for Rejection) | |
|---|---|--|
| 102(a)(1) Disclosure with Prior Public Availability Date | 102(b)(1) | (A) Grace Period Disclosure by Inventor or Obtained from Inventor |
| | | (B) Grace Period Intervening Disclosure by Third Party |
| 102(a)(2) U.S. Patent, U.S. Patent Application, and PCT Application with Prior Filing Date also see 102(d) | 102(b)(2) | (A) Disclosure Obtained from Inventor |
| | | (B) Intervening Disclosure by Third Party |
| | | (C) Commonly Owned Disclosure |

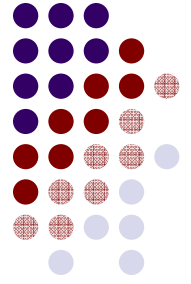
USPTO Examination Guidelines: 35 USC 102(a)



102(a)(1) prior art

- “described in a printed publication, or in public use, on sale, or ***otherwise available to the public***” before effective filing date (EFD) of claimed invention
- “use” and “sale” may occur outside U.S. (unlike pre-AIA), but must be “available to the public”
- appears from USPTO comments that public sales of a product made by a secret process, wherein the product cannot be “reverse engineered”, do not constitute prior art
 - AIA overrules *Metallizing Engineering v. Kenyon*?

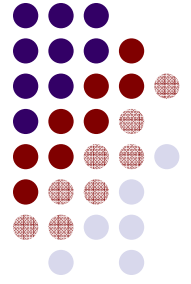
USPTO Examination Guidelines: 35 USC 102(a) (continued)



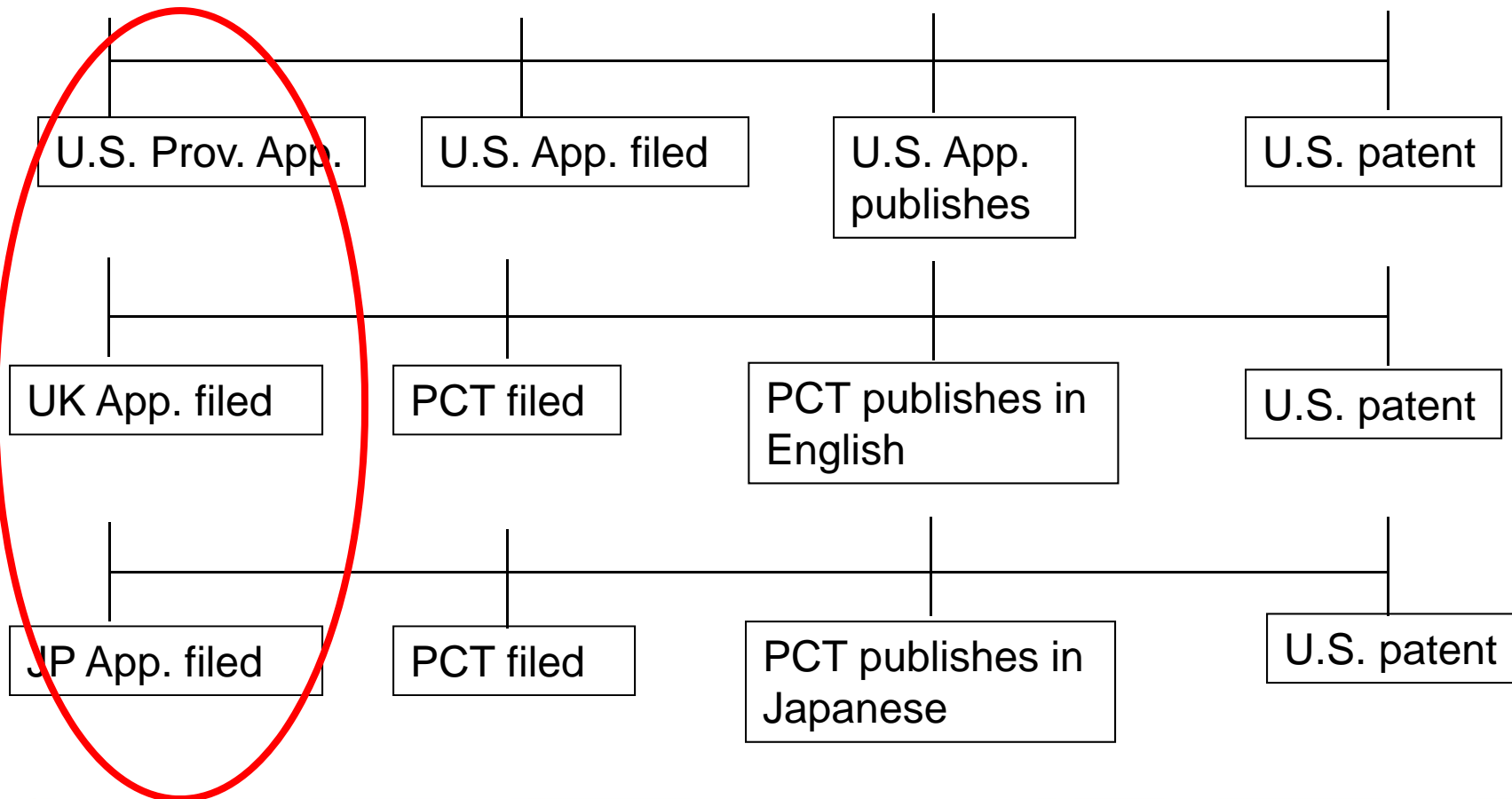
102(a)(2) and 102(d)

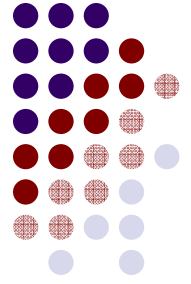
- U.S. patents/published applications and published PCT applications (designating US) have effective prior art dates reaching back to the *priority filing date*
 - novelty **and inventive step** (non-obviousness)
 - EPO and JPO limit this prior art to novelty issues only
 - any language (not limited to English in any respect)
 - extends prior art date of many non-U.S. originating published applications back in time by up to 18 months (a source of secret prior art)

Examples of § 102(a)(2)/(d)



- What is the prior art date under AIA FITF?

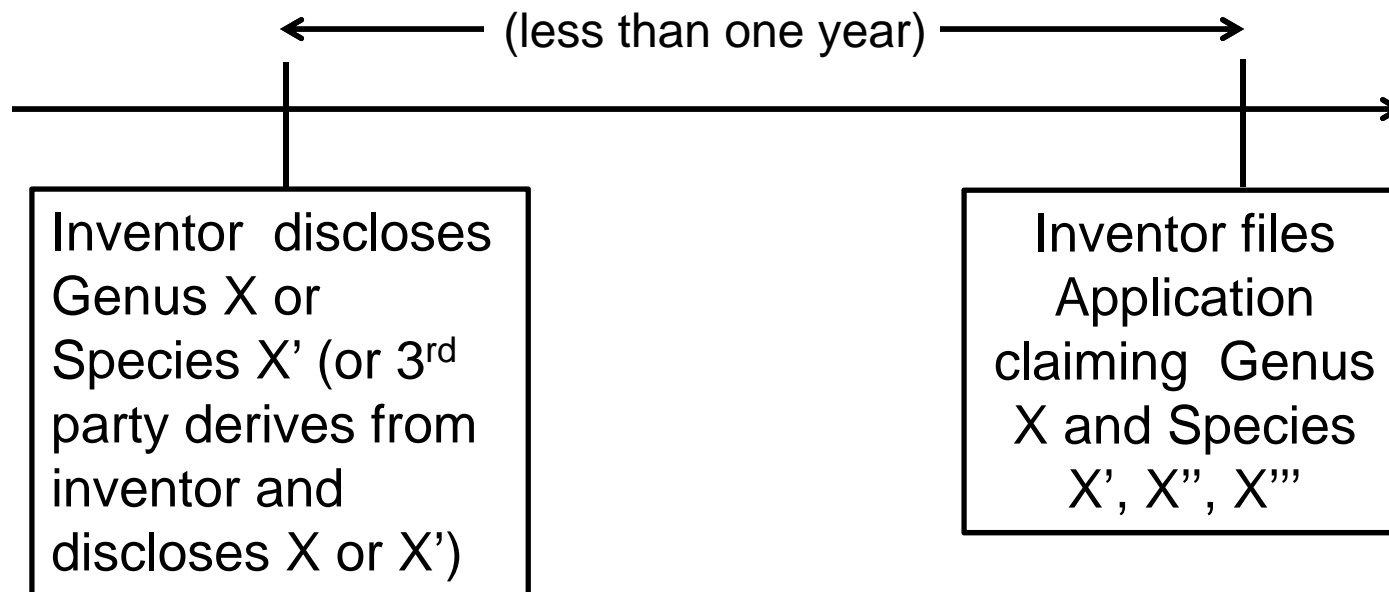




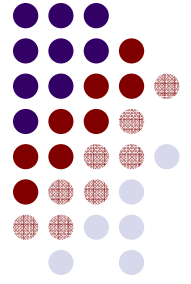
Grace Period: USPTO Guidelines

35 USC 102(b) scenarios

- Grace Period inventor disclosure or inventor-originated disclosure exceptions
 - No prior art here, regardless of what inventor discloses:



Genus-Species Example: *Crocs Case*



- One way to more clearly envision Genus-Species examples is to reflect on an actual patented invention:

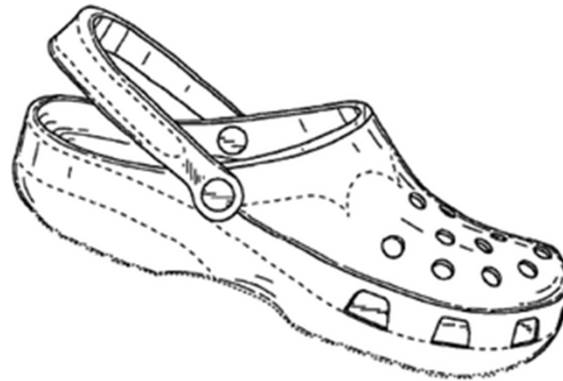
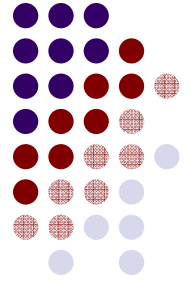


Figure 1

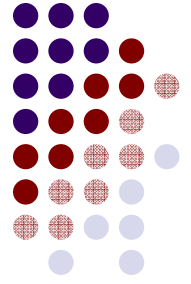
- *Crocs, Inc. v. ITC*, 93 USPQ2d 1777 (Fed. Cir. 2010)



Crocs, Inc. v. ITC

Advantages of strap construction

- Because base section and strap both made of foam, friction allowed strap to maintain its position after pivoting
- Loose fit of heel strap improved comfort of wearer because strap contacted foot only when needed to reposition foot in shoe, in contrast to prior art straps that constantly contacted foot so as to reduce comfort



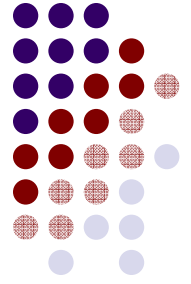
Crocs, Inc. v. ITC

Genus X: footwear claimed in patent including:

- one-piece molded foam base section formed the “upper” (top of shoe) and the sole
- strap also made of foam attached to foot opening of the upper
- strap attached via connectors to contact base section

Species X’: the shoe with holes in the drawing

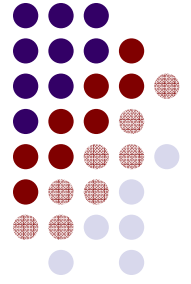
Species X’’: inserted fur liner interior with no holes



Grace Period: USPTO Guidelines

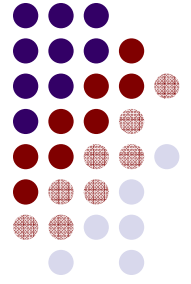
- No requirement for Applicant to identify any pre-filing disclosure by inventor within one year of application filing date
 - Duty of Disclosure issue?
 - maybe not under *Therasense* “but for” standard
- If patent claim is rejected by USPTO, then Applicant may invoke Grace Period exceptions by submitting Declaration under 37 CFR 1.130

Establishing Grace Period Protection



USPTO Rule 37 CFR 1.130 Declarations filed to overcome patent claim rejections based on third party disclosures:

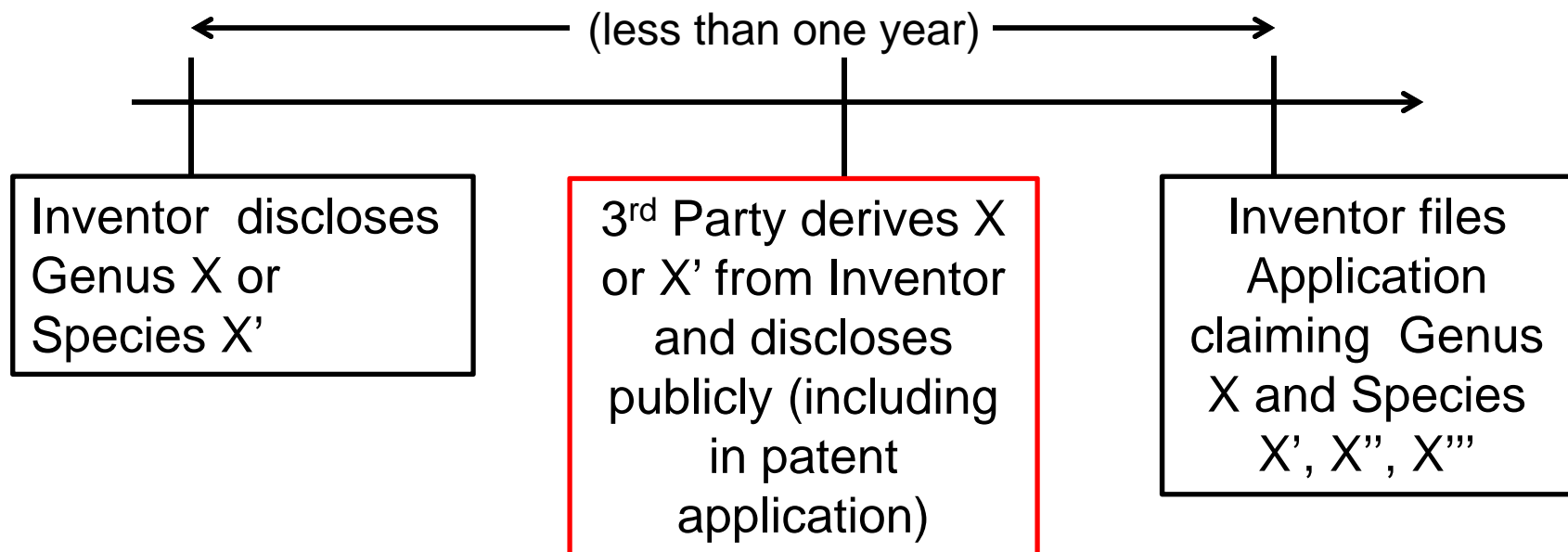
- 1.130(a) Declaration of “attribution”
 - cited disclosure was made by inventor or made by someone who directly/indirectly obtained subject matter from inventor
- 1.130(b) Declaration of “prior public disclosure”
 - subject matter of cited disclosure was previously publicly disclosed by inventor (or by someone who obtained the subject matter from the inventor)



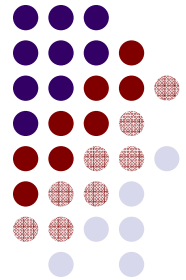
Grace Period: USPTO Guidelines

35 USC 102(b) scenarios

- Grace Period inventor disclosure and intervening 3rd party inventor-originated disclosure exception
 - No prior art here:

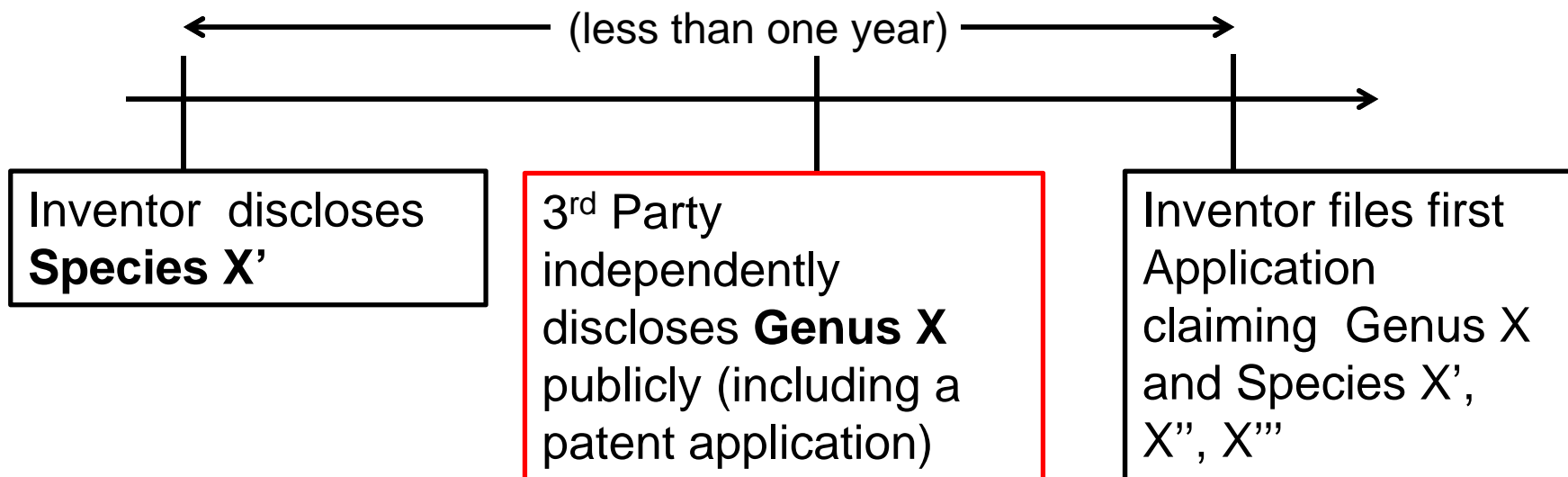


Grace Period: USPTO Guidelines

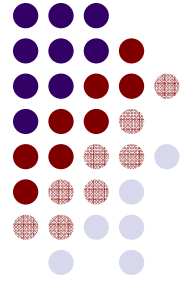


35 USC 102(b)(1) and (2) scenarios

- Prior art exception: earlier inventor disclosure and intervening 3rd party disclosure
 - No prior art here (“simply a more general description of the subject matter...disclosed by inventor”):

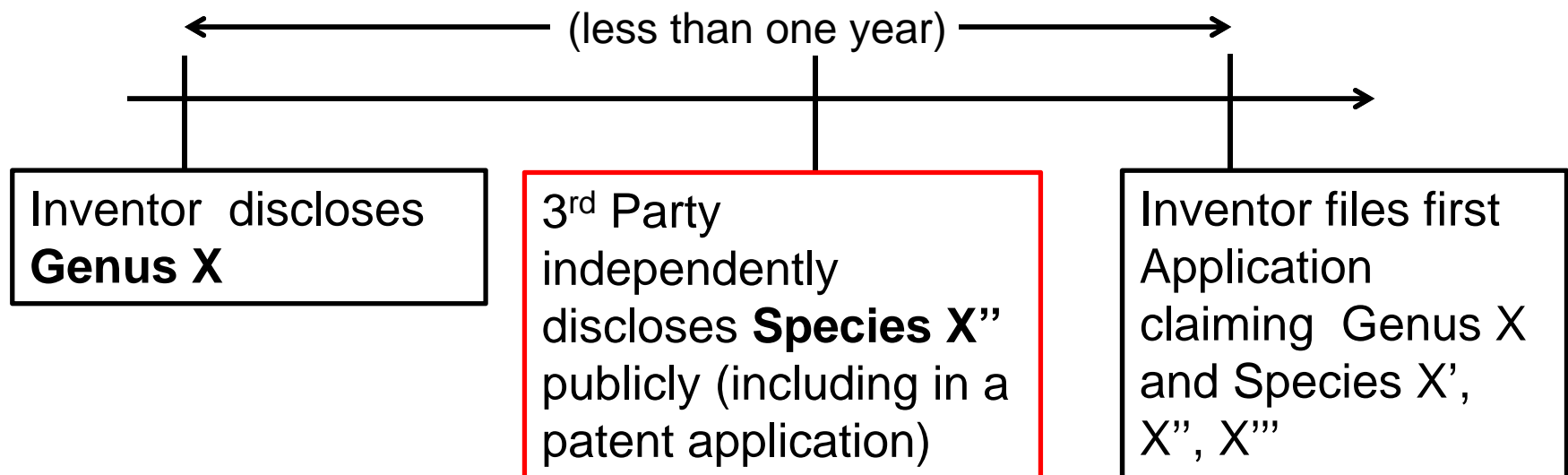


Grace Period: USPTO Guidelines

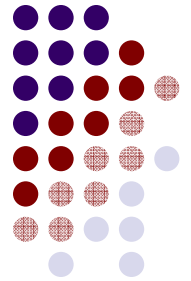


35 USC 102(b)(1) and (2) scenarios

- No Grace Period protection here...
 - USPTO: 3rd Party disclosure of species (versus genus) *is prior art* here:

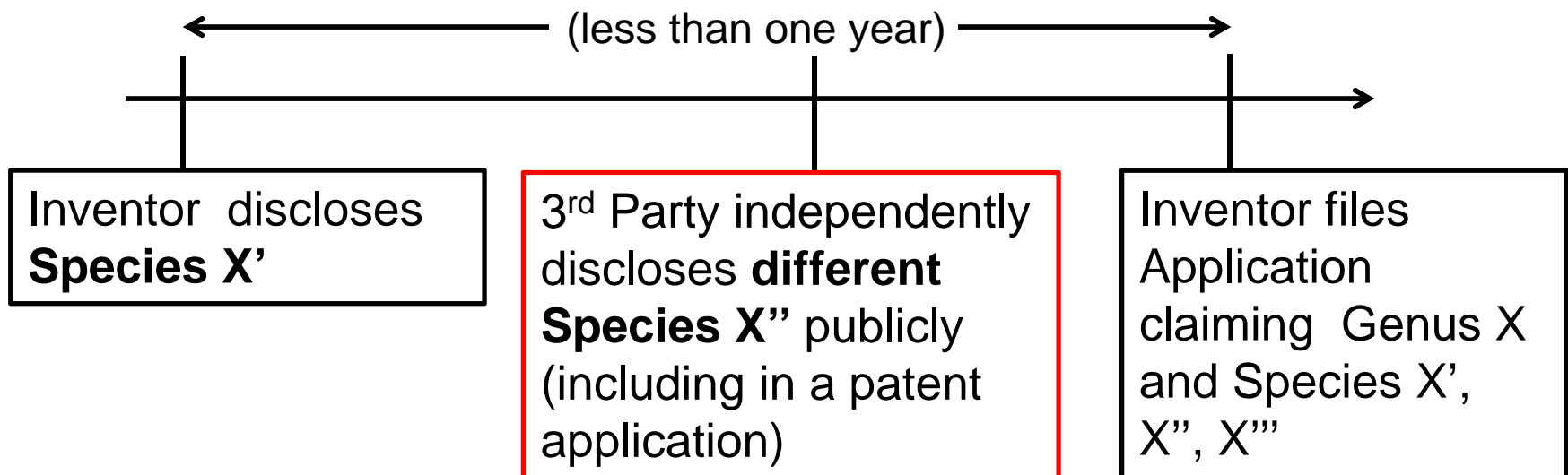


Grace Period: USPTO Guidelines

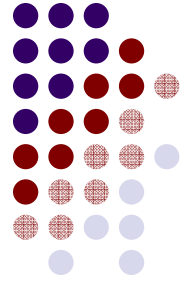


35 USC 102(b)(1) and (2) scenarios

- Also...
 - USPTO: 3rd Party disclosure of different species is prior art here:



Determining Scope of Grace Period Protection

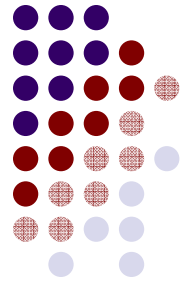


Grace Period protection applies if 3rd party disclosure contains subject matter

- **derived** from inventor
- **exactly corresponding** to inventor's previous public disclosure, or
- corresponding to a **more general description** of the inventor's previous public disclosure

Any subject matter in 3rd party disclosure **outside the exact scope** of the inventor's pre-filing disclosure (and not merely a more general description) is **not protected by the Grace Period**

- Keep good records of any pre-filing disclosures

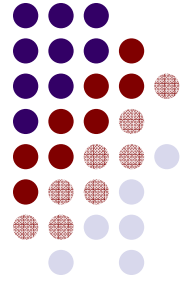


Obvious Variants Excluded from AIA Grace Period Protection?

Continued debate on scope of AIA Grace Period protection

- USPTO interpretation excludes ***obvious variants*** from Grace Period protection
 - Also See Matal, “A Guide to the Legislative History of the America Invents Act: Part I of II,” 21 Fed. Cir. Bar J., no. 3, pp. 484-85 (2012).
- Others believe there is some “wobble room” to include obvious variants
- Avoid the downside risks of relying on Grace Period protection if you can!

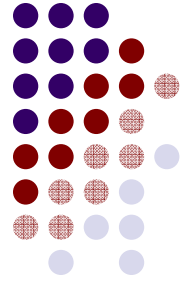
Establishing Common Ownership or JRA to Remove Potential Prior Art



Can restrict effective prior art date of previously filed patent or application to its publication date by establishing common ownership or that a proper joint research agreement (JRA) was in effect

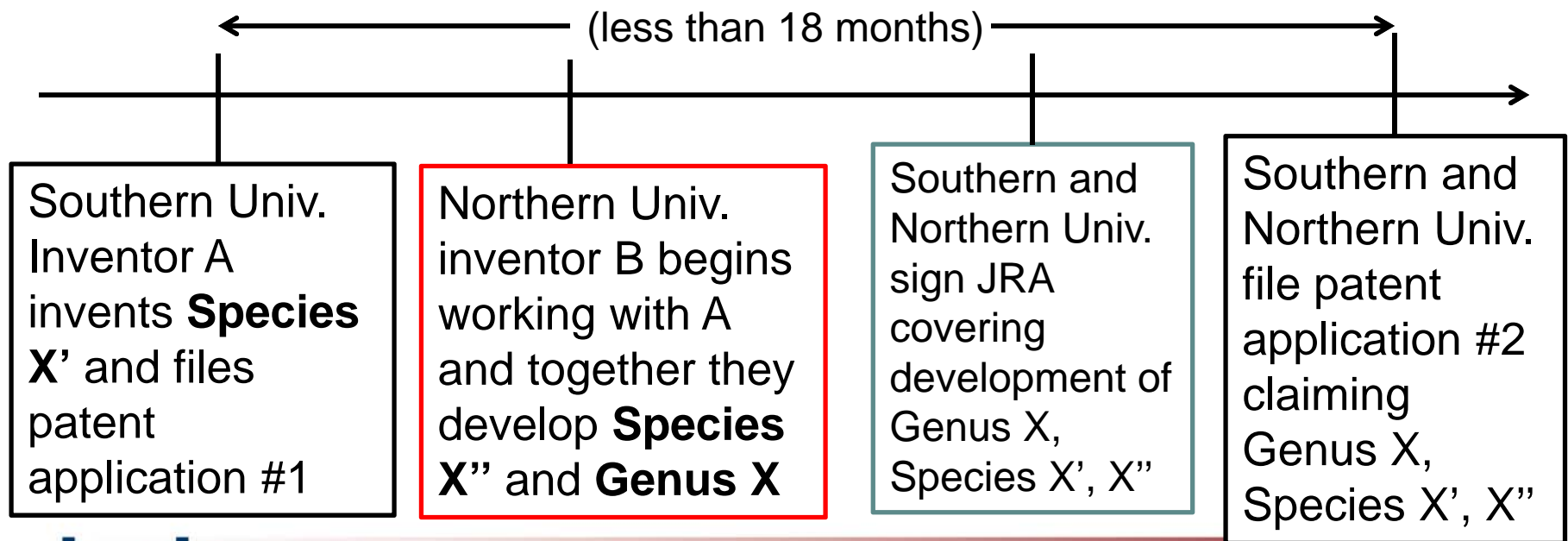
- simple statement by US practitioner that previous patent/application was commonly owned before EFD establishes common ownership
- likewise, statement that JRA in place before EFD
 - subject matter of previous patent/application and claimed invention was subject to JRA
 - JRA was in effect before EFD
 - claimed invention made as a result of activities within scope of JRA
 - must amend application to disclose names of parties to JRA

Establishing Common Ownership or JRA

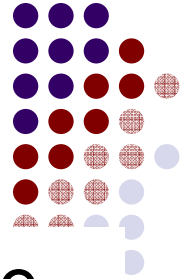


Can establish JRA after a patent application is filed

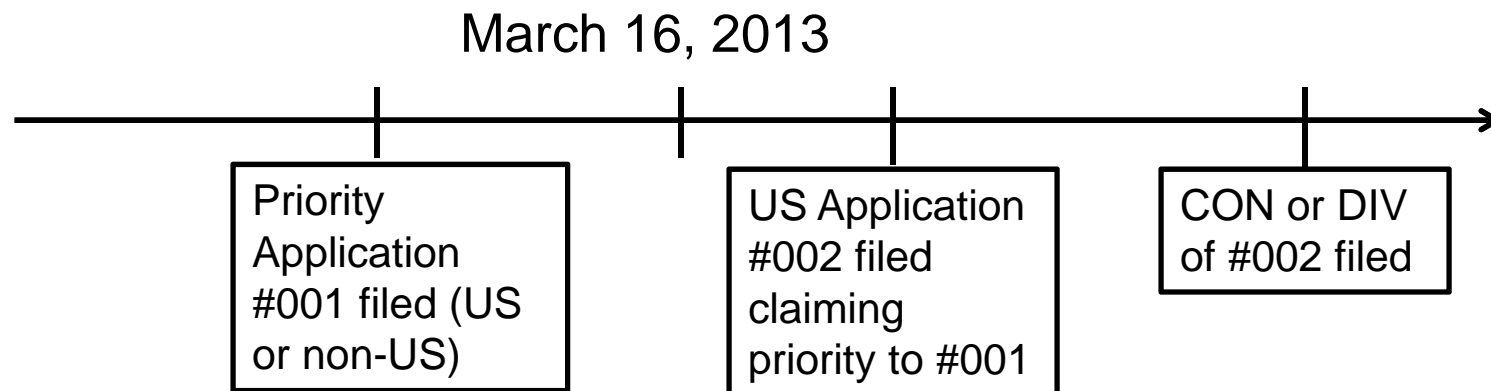
- Here, patent application #1 is prior art until the date that the JRA is signed



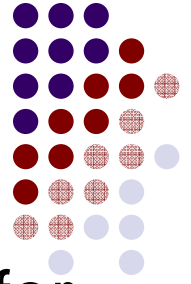
“Transition” Applications



- Does your “transition” application fall under pre-AIA (FTI) or AIA (FITF)?
 - “transition” applications are U.S. applications filed on/after March 16, 2013 (transition date) that claim priority to an application (U.S. or non-U.S.) filed before March 16, 2013

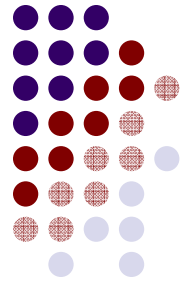


“Transition” Applications



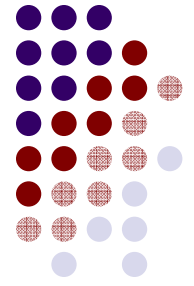
- If “transition” U.S. application ever contains (even for one day) a patent claim supported only by an application filed on/after March 16th, that entire application is now subject to AIA-FITF standards
 - cannot file DIV or CON to return to pre-AIA
 - must file a “statement” informing USPTO
- Note: if patent claim is not supported (written description, enablement) by *any* of the priority or U.S. applications, then USPTO will reject claim based on “new matter” (See response to comment #24, p 11043)
 - application will not be treated as falling under AIA (because patent claim was not supported by priority application)
 - this does not apply to a patent claim submitted in a Preliminary Amendment on the US application filing date

“Statement” for AIA Applications



Must file “Statement” confirming application falls under AIA

- not required if post-March 16th US application **discloses** additional subject matter, but does **not claim** that subject matter
- check box on ADS
- submit within 16/4 months (16 months from priority date or 4 months from US filing date, whichever later)
- submit immediately upon addition of such a patent claim during prosecution
- if late, must file Petition with fee (\$1420 USPTO fee)
- See 37 CFR 1.78, especially (a)(6) and (b)

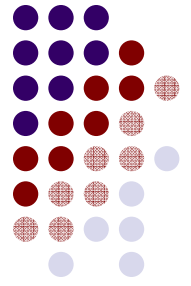


“Statement” for AIA Applications

Duty to file statement confirming AIA status

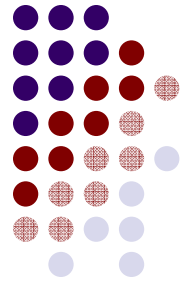
- falls under “duty of disclosure” 37 CFR 1.56
 - Includes individuals associated with filing and prosecution of application (inventors, U.S. attorney/agent, others involved in prep. , etc.)
- No statement required if applicant “reasonably believes” no AIA-patent claim was ever present

Transition Application Filing Strategies

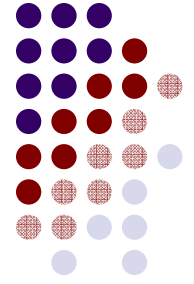


- File first and maintain only pre-AIA claims in U.S. transition application
 - If priority application is in non-English language that you do not understand, consider confirming with Applicant *before* filing in USPTO that all claim changes are fully supported by priority application
- If Applicant desires to pursue any AIA-FITF claims
 - File DIV or CON containing only AIA-FITF claims
- Keep pre-AIA and AIA application bloodlines separate

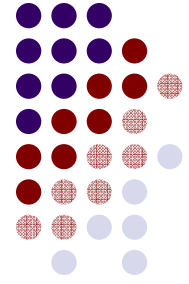
Mixing Pre-AIA and AIA Claims: Bad Idea



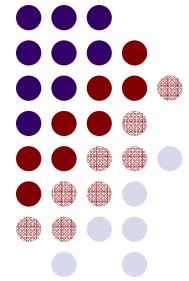
- If a transition application ever contains at least one pre-AIA and one AIA patent claim at any time
 - All claims of application are subject to prior art based on *both*
 - pre-AIA prior art (including pre-AIA “secret” prior art under 102(g), and possible “interference” proceeding) *and*
 - AIA prior art (which extends back in time the effective prior art date of U.S. and PCT patents/published applications to the priority date)



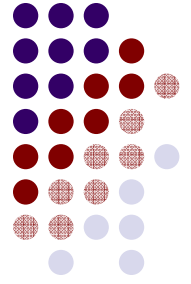
Mosaic of Our Lady of Prompt Succor



18th Century Map of Southeast Louisiana

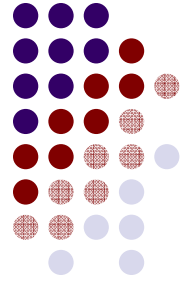


The Battle of New Orleans at Chalmette
by Jean Hyacinthe de Laclotte (1766 - 1829)



1910 painting by Edward Percy Moran

The Battle of New Orleans Ends...

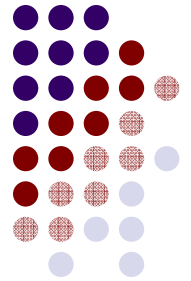


On the morning of January 8th, the Very Rev. William Dubourg, Vicar General, offered Mass at the altar on which the statue of Our Lady of Prompt Succor had been placed. At the very moment of communion, a courier ran into the chapel to inform all those present that the British had been defeated.

General Jackson went to the convent himself to thank the nuns for their prayers: "By the blessing of heaven, directing the valor of the troops under my command, one of the most brilliant victories in the annals of war was obtained."

See http://en.wikipedia.org/wiki/Battle_of_New_Orleans

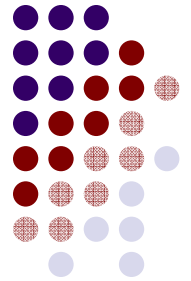
Claiming Priority: New Requirements



USPTO Rules under AIA have increased requirements/responsibilities on Applicant for claiming priority benefit (37 CFR 1.55)

- must claim priority within 16/4 months
 - if late, must file Petition and fee (\$1420)
- must claim priority on ADS
 - USPTO will ignore attempt to claim priority in specification or in an accompanying cover letter
 - If fail to properly and timely claim priority, Applicant's claim for priority is deemed waived

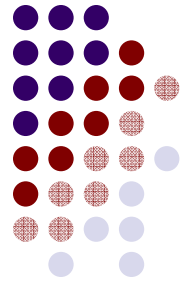
Filing Certified Copy of Non-U.S. Priority Document: New Requirements



Must comply with non-U.S. priority document filing requirements by either:

- submitting actual certified copy to USPTO within 16/4 months (or file Petition with \$200 fee if late)
or
- identifying on the ADS the non-U.S. priority document which is obtainable from an IP office of a country participating in the Priority Document Exchange (PDX) or Digital Access Service (DAS) programs
(WIPO-IB, EPO, GB, JPO, KIPO, AU, CN, ES, DK, SE, FI)
 - this is considered a formal request that the USPTO obtain the document

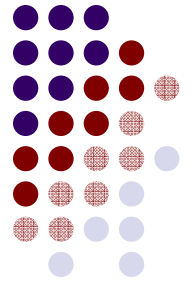
Filing Certified Copy of non-U.S. Priority Document: New Requirements



Burden remains ultimately on Applicant to make sure that certified copy is received

- If use PDX or DAS and USPTO website (PAIR) does not show that certified priority document was received reasonably before grant (e.g. by Issue Fee payment date), can contact “Priority Examiner” at USPTO by phone or e-mail (PDX@uspto.gov) to attempt to resolve
- If unable to initially obtain certified copy, can file “interim copy”
 - must file interim copy within 16/4 months
 - must still ultimately file certified copy

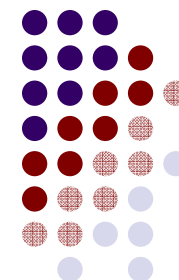
Track One Prioritized Examination



- Pay large fee (\$4800 for large entity)
- Some limits
 - 30 total claims, 4 independent
 - No multiple dependent claims
- “final disposition” within one year
- can challenge any restriction requirement
- no heavy burden on Applicant to discuss all relevant prior art (as with “Accelerated Examination” procedure)

From USPTO: Prioritized Exam Statistics

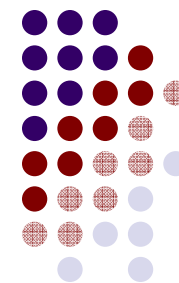
(Data from Sept 26, 2011 to Feb19, 2013)



| Petitions Filed | % of Decided Petitions Granted | Days from Petition Grant to First Office Action | Average Days to Final Disposition |
|------------------------|---------------------------------------|--|--|
| 8,554 | 94% | 55 | 168 |

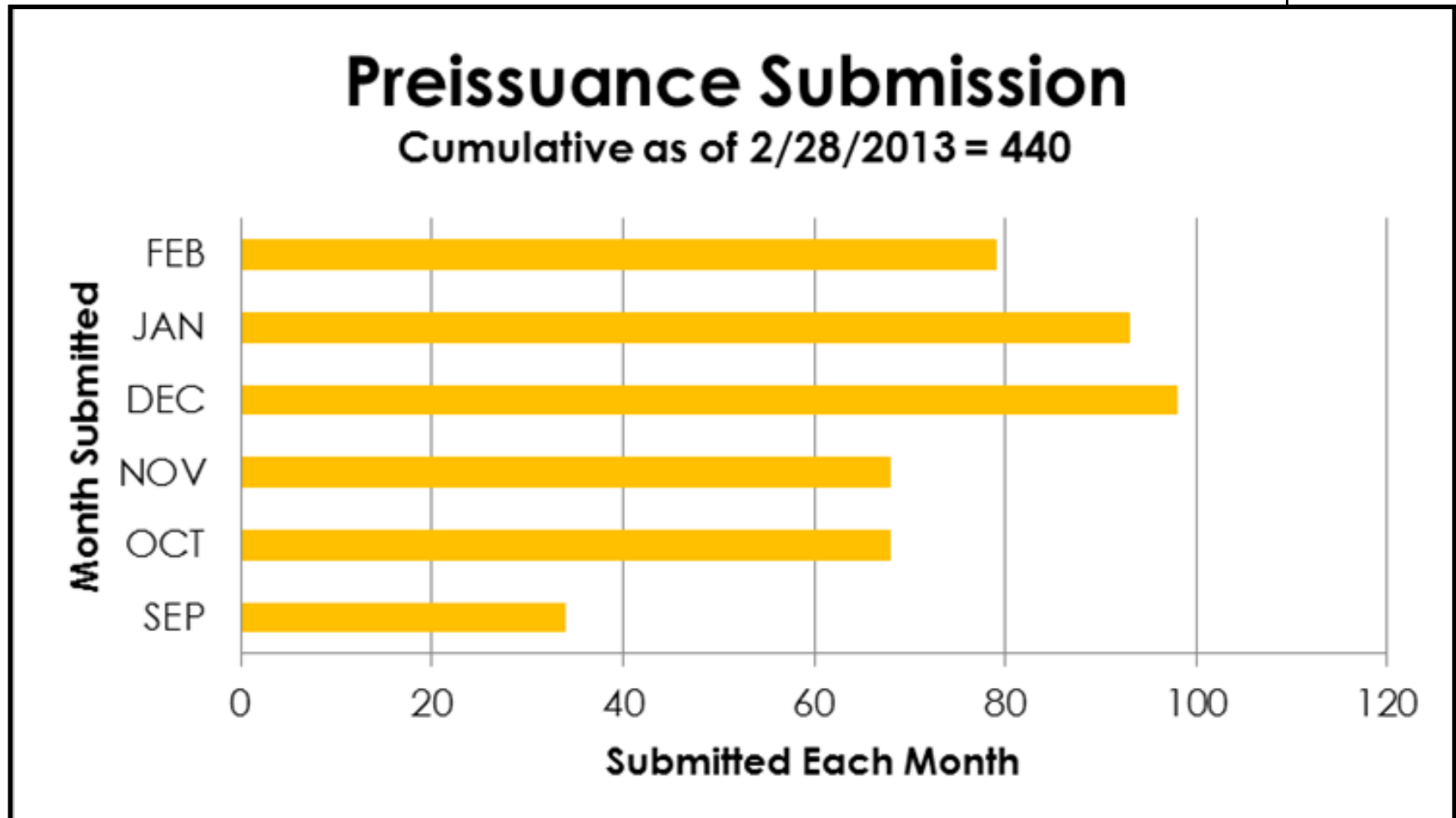
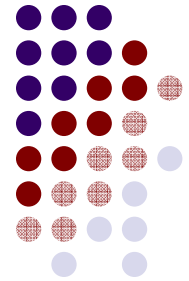
| First Action on Merits Mailed | Final Dispositions Mailed | Allowances Mailed | Percent of Petitions From Small Entities |
|--------------------------------------|----------------------------------|--------------------------|---|
| 5,503 | 3,667 | 1,828 | 43% |

Preissuance Submissions

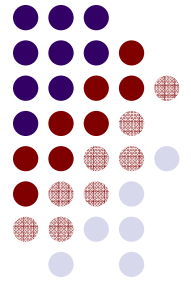


- 3rd Party can submit published prior art references into file of another pending application
 - No fee if 3 or less references
 - Fee of \$180 (large entity) for up to 10 references
- Must file:
 - within six months of publication date of application or
 - by date of first Office Action on merits or by Notice of Allowance if it is earlier

From USPTO: Preissuance Submissions (Data from Sept 16, 2012 to Feb 28, 2013)

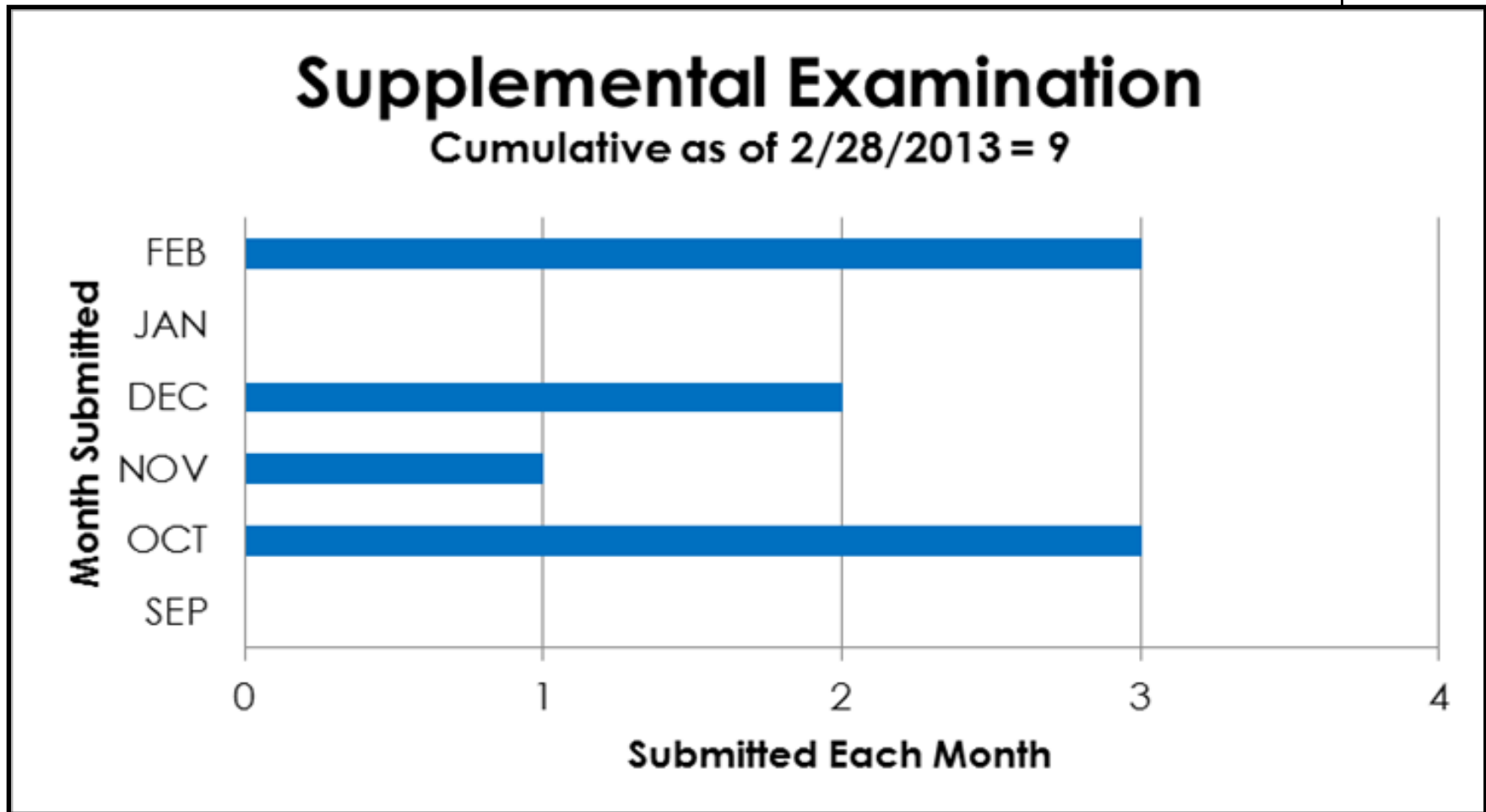
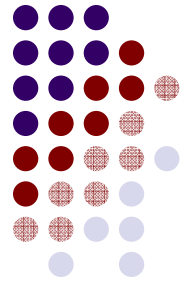


Supplemental Examination



- Patent Owner files request for USPTO to consider, reconsider, or correct information believed to be relevant to the patent
 - Consider *Therasense* standard
- Standard for granting request: does information raise a “substantial new question” (SNQ) of patentability?
- Fees (large entity)
 - \$5140 for processing request for SE
 - \$16,120 for ex parte reexamination ordered as a result of SE request

From USPTO: Supplemental Examination (Data from Sept 16, 2012 to Feb 28, 2013)



Questions?

adm@bskb.com

