

Prioritized Examination and New Prior Art defined for First-Inventor-to-File

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Expedited Examination

- ▶ USPTO Concerns
 - Increasing number of new applications filed
 - Greater complexity of applications
 - Growing backlog of unexamined applications



Programs to Accelerate Exam

- ▶ Prioritized Examination Track One (PE)
- ▶ Accelerated Examination (AE)
- ▶ Patent Prosecution Highway (PPH)
- ▶ Petition to Make Special (age, health)



PE = Track One of Three



- ▶ USPTO Proposal for Multitrack System
- ▶ Applicant chooses pace of Examination
 - Track One – speedy examination for fee
 - Track Two – traditional pace
 - Track Three – delayed examination
- ▶ Track One mandated by America Invents Act

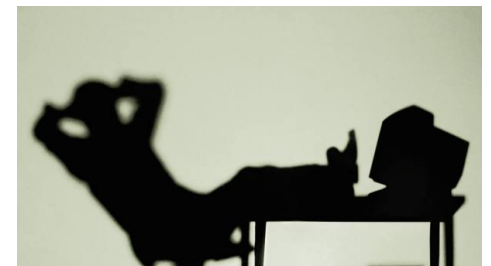
PE Track One – Meeting Goals

- ▶ Reduce backlog of unexamined applications
- ▶ Recoup PTO costs for acceleration
- ▶ Not overburden patent examiners
- ▶ Put inventions to work more quickly
 - Complete examination within 12 months



PE Track One– Simple Application

- ▶ One page Request form
 - No Examination Support Document Required
- ▶ Only “new” Utility or Plant applications
 - Con, Div, CIP, 1st RCE
 - Not multiple RCEs, not PCT National Stage
- ▶ Complete application and fees
 - No “missing parts” and ready for examination
 - Agreement to hold examiner interviews
 - ≤ 4 independent claims; ≤ 30 total claims



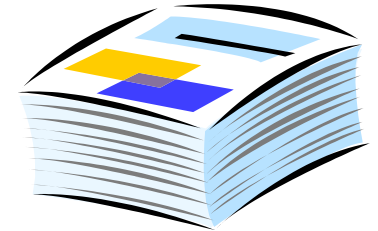
PE – Accelerated “Special” Docket



- ▶ Advanced out of normal turn
 - Placed ahead of others filed sooner
 - Placed on Examiner’s Special Dispatch docket
 - Number of petitions granted is limited

- ▶ Applicant participation expected
 - Be prepared for speed, interviews, amendments
 - No extensions of time
 - Failure can cause removal from “special” docket

Accelerated Examination (AE)



- ▶ Accelerated Examination
 - Final disposition within 12 months
 - No Special fee like PE
- ▶ Examination Support Document Required
 - Provided by Applicant at time Request filed
 - Comprehensive Search and Examination Reports
- ▶ Less Popular due to ESD
 - <5000 requests from 2006 to March 2013

AE versus PE – Statistics

- ▶ Fewer Petitions for AE filed
- ▶ Fewer Petitions for AE granted
- ▶ Higher allowance rate for when reach final disposition
 - <5000 requests 2006–March 2013
 - About 62% requests for AE granted
 - About 20% failed to comply with filing requirements
 - 64% allowance rate of applications examined to final disposition



Patent Prosecution Highway

- ▶ PPH = work sharing
 - Reduce pendency
 - Increase efficiency
- ▶ Claims allowable in First Patent Office
- ▶ Search and Exam Reports to Second Office
 - Before first action:
 - Document showing allowable claims
 - Copy of search and examination reports
 - Table showing claims “comparable”
- ▶ Rate of allowance = 87%



PPH Easy to Use

- ▶ Simple Request Forms
- ▶ Petition fee eliminated in 2010
- ▶ High allowance rate
- ▶ Few requirements
 - Claims must “correspond”
 - Document first indication of allowable claims



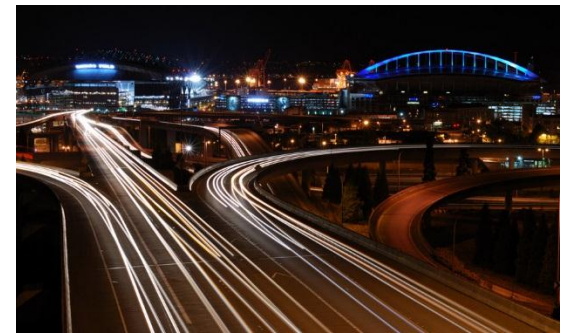
Other Special Petitions

- ▶ Applications Examined by filing date
- ▶ Generally not taken out of turn (37 CFR 1.102(a))
- ▶ Exceptions (1.102(b)):
 - Public need
 - To expedite PTO business
 - Age or failing health of inventor
 - To stimulate innovation in areas of need:
 - Enhancing environment
 - Conserving energy
 - Counter terrorism



Programs to Accelerate Examination

	PE Track 1	AE	PPH	Traditional
Fees	\$4000	\$130	-0-	-0-
Applicant's burden	Moderate	Extensive	Minimal	Minimal
Examiner's burden	Extensive	Moderate	Minimal	Moderate
First Action	< 3 months	< 4 months	< 6 months	< 10 months
Final Action	< 6 months	< 13 months	< 12 months	< 32 months
% Allowance	~ 50%	~ 50%	~ 87%	~ 50%
Popularity	High	Low	High	-



Questions?



Prior Art Redefined in the AIA



AIA: First Inventor to File

A person shall be entitled to a patent unless:

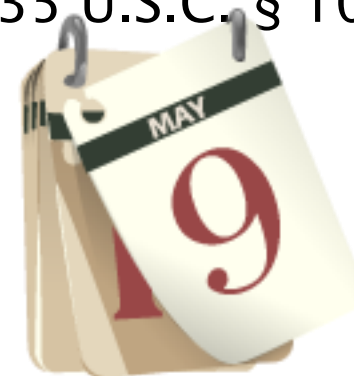
- (1) the claimed invention was patented, described in a printed publication, or in public use, on sale, or otherwise **available to the public** before the **effective filing date** of the claimed invention; or
- (2) the claimed invention was described in [an issued U.S. **patent**], or in [a published U.S. patent **application** or a published **PCT** application designating the U.S.], in which the patent or application, as the case may be, names another inventor and was effectively **filed before the effective filing date** of the claimed invention.

35 USC §102(a)

Effective Filing Date

- ▶ Prior art is applied to the "**effective filing date**" of a patent application
- ▶ The **effective filing date** is defined as the date of the **earliest application** for which the patent or application is entitled to a right of priority under section 119, 365(a), or 365(b) or to the benefit of an earlier filing date under section 120, 121, or 365(c).

35 U.S.C. § 100(i)(1)



Available to the Public



- ▶ AIA: invention **available to the public** before the effective filing date of the US patent application.
- ▶ “...or otherwise made available to the extent that persons interested ... skilled in the subject matter....exercising **reasonable diligence**, can locate it.”

Prior Art Defined Globally



- ▶ Pre-AIA: invention **known or used** by others in the US, or described in a patent or **printed publication** in US or a non-US country, before invention by applicant (35 USC §102)
- ▶ AIA: invention **available to the public** before the effective filing date of the US patent application. (No US requirements)
- ▶ China: **known to the public** before the filing date in China or abroad.

Inventor's Limited Grace Period

35 USC 102(c) EXCEPTIONS.—

(1) DISCLOSURES MADE 1 YEAR OR LESS BEFORE THE EFFECTIVE FILING DATE OF THE CLAIMED INVENTION.—

A disclosure **made 1 year or less** before the effective filing date of a claimed invention **shall not be prior art** to the claimed invention under subsection (a)(1) if—

- (A) the disclosure was **made by the inventor** or joint inventor or by another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor; or
- (B) the subject matter disclosed had, before such disclosure, been **publicly disclosed by the inventor** or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor.

Inventor's Limited Grace Period

35 USC 102(c) EXCEPTIONS.—

(2) DISCLOSURES APPEARING IN APPLICATIONS AND PATENTS.—A disclosure **shall not be prior art** to a claimed invention under subsection (a)(2) if—

(A) the subject matter disclosed was **obtained** directly or indirectly **from the inventor** or a joint inventor;

(B) the subject matter disclosed had, before such subject matter was effectively filed under subsection (a)(2), been **publicly disclosed by the inventor** or a joint inventor or another who **obtained** the subject matter disclosed directly or indirectly from the inventor or a joint inventor; or

(C) the subject matter disclosed and the claimed invention, not later than the **effective filing date** of the claimed invention, were **owned by the same person** or subject to an **obligation of assignment** to the same person

Joint Research Agreement

35 USC 102(d) COMMON OWNERSHIP UNDER JOINT RESEARCH AGREEMENTS.— Subject matter disclosed and a claimed invention shall be **deemed** to have been **owned by the same person** or subject to an **obligation of assignment** to the same person in applying the provisions of subsection (b)(2)(C) if—

- (1) the subject matter disclosed was developed and the claimed invention was made by, or on behalf of, 1 or more **parties to a joint research agreement** that was in effect on or before the effective filing date of the claimed invention;
- (2) the claimed invention was made as a **result** of activities undertaken within the scope **of the joint research agreement**; and
- (3) the application for patent for the claimed invention discloses or is **amended to disclose the names of the parties** to the joint research agreement.

Expanded scope of “Inventor”

- ▶ “Inventor” = single or joint inventors
 - ▶ “One who obtained” from the inventor
 - ▶ Common owners or subject to assignment
 - ▶ Parties to a joint research agreement
- Pre-filing disclosures of any of these **is not prior art** to the “inventor” if within one year of the effective filing date.

Effective Filing Date

- ▶ In practice, the **effective filing date** of the claimed invention is paramount to the first-inventor-to-file system.
- ▶ Expanded definition of “**inventor**” can protect against prior disclosures of an inventive team, helpful to collaborations and corporate research groups.
- ▶ The inventor’s grace period exceptions will require diligent bookkeeping and proofs.

Summary of the New Prior Art

- ▶ The AIA created a patent system that protects the inventor while moving the USPTO into a first-to-file system.
- ▶ New policies and procedures for proving “obtained from” and “derivation” will become more routine.
- ▶ Prior art now has no geographic limitations in the new law.
- ▶ Prior art expansion via “or otherwise known to the public” will be defined by new case law.

Discussion

