

2012
MIPLA Stampede
Patents Overview



Drew Hirshfeld
Deputy Commissioner for Patent Examination Policy
U.S. Patent and Trademark Office

May 21, 2012

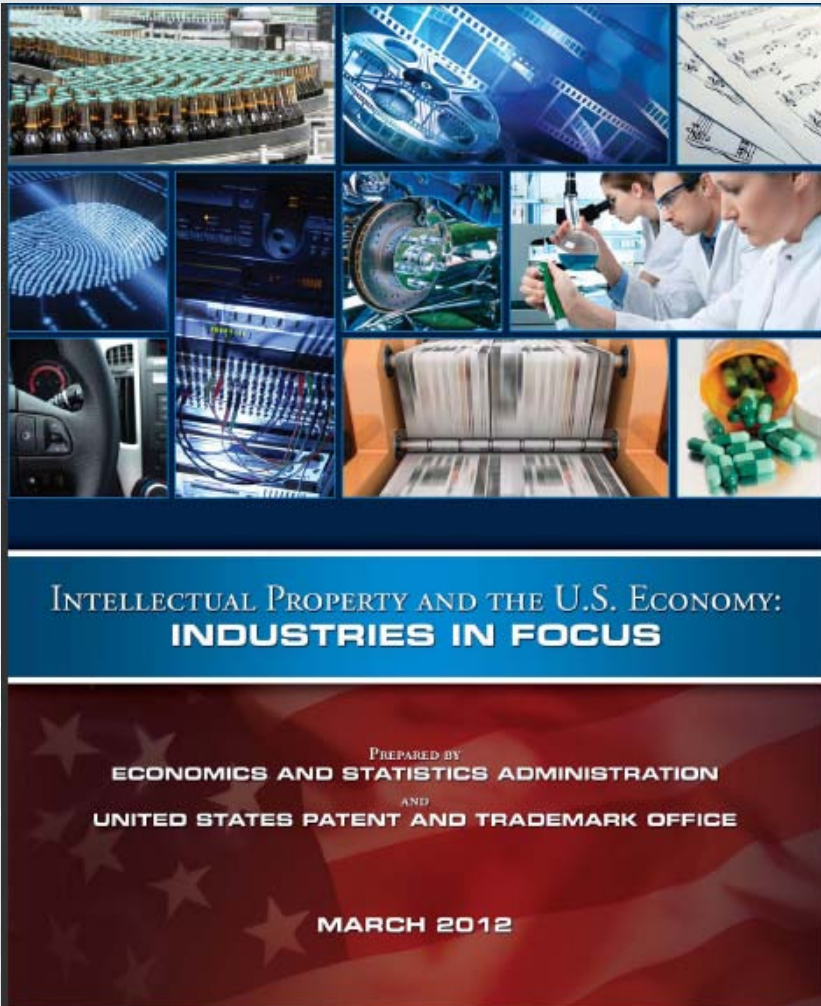


Overview

- **Importance of IP**
- **America Invents Act**
- **Patents Operational Status**
- **New Initiatives**



IP Jobs Report



- **IP-intensive industries accounted for about \$5.06 trillion in value added, or 34.8% of U.S. gross domestic product (GDP), in 2010.**
- **Every 2 jobs in IP-intensive industries supports an additional 1 job elsewhere in the economy.**
- **In total, 40.0 million jobs, or 27.7% of all jobs, were directly or indirectly attributable to the most IP-intensive industries.**
- **The AIA is strengthening IPR to allow those industries to continue to flourish and add jobs.**

What we have implemented:

What remains to be implemented:

(60-Day and Under Effective Dates)

- Reexamination transition for threshold
- Tax strategies are deemed within the prior art
- Best mode
- Human organism prohibition
- Patent term extension for drugs
- Virtual and false marking
- Venue change from DDC to EDVA for certain suits
- OED Statute of Limitations
- Fee Setting Authority (Sec. 10)
- Establishment of micro-entity (effective after Sec. 10 rulemaking completed)
- **Prioritized examination**
- 15% transition surcharge
- Electronic filing incentive
- Reserve fund

(12-Month Effective Date)

- Inventor's oath/declaration
- Third party submission of prior art for patent application
- Supplemental examination
- Citation of prior art in a patent file
- Priority examination for important technologies
- *Inter partes* review
- Post-grant review
- Transitional post-grant review program for covered business method patents

(18-Month Effective Date)

- First-to-File
- Derivation proceedings
- Repeal of Statutory Invention Registration



Prioritized Examination (Track One)

- **Original utility or plant patent application for expedited examination if:**
 - **\$4,800 fee, reduced by 50% for small entity;**
 - **no more than 4 independent claims, 30 total claims, and no multiple dependent claims; and**
 - **must file utility application electronically**
- **May be requested for a continuing application and RCE**
- **USPTO goal for final disposition is on average 12 months from date of prioritized status**



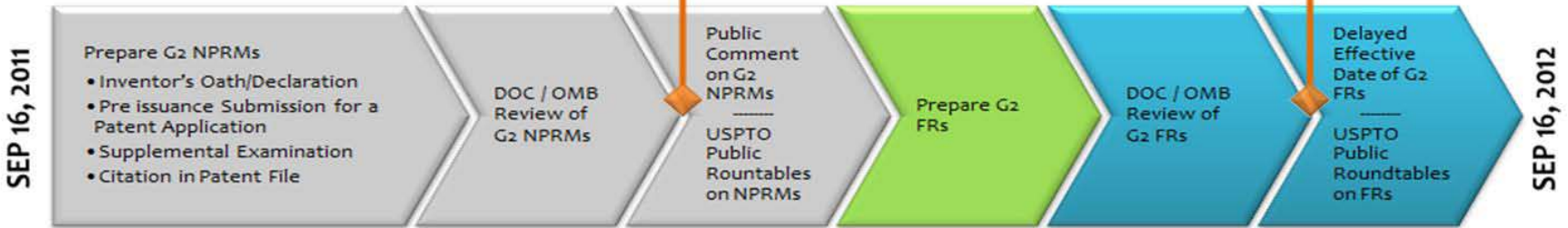
Track One Statistics (through 5/7/12)

	Petitions Filed	Days to Petition Decision	% of Decided Petitions Granted	Days from Petition to first Office action
Number of Track One	3,502	48.2	97%	48.3
Examination Status	First Action on Merits mailed	Final Dispositions mailed	Allowances Mailed	
Number of Track One applications	1,982	226	335	

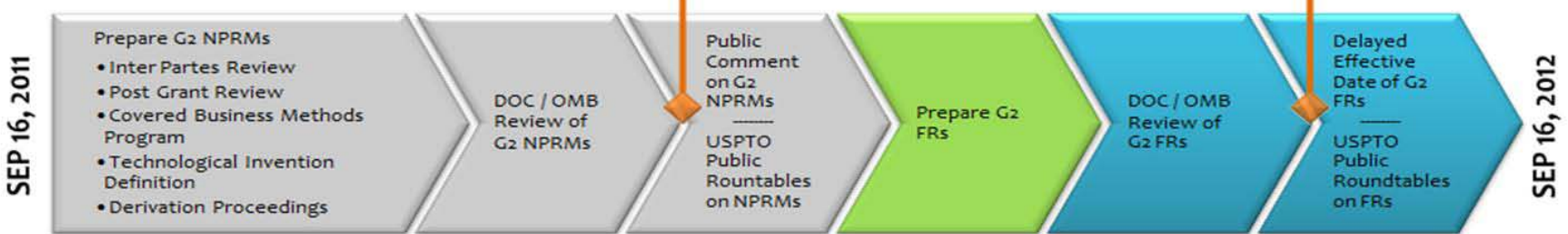


12 Month Timeline

PATENT RULES



BOARD RULES



Completed
 In Progress
 Not Started



Patent Related Notices of Proposed Rulemaking

	AIA Provision	Comment Period End	Comments Received
1	Preissuance Submissions	March 5, 2012	36
2	Citation of Patent Owner Statement in a Patent File		17
3	OED Statute of Limitations		5
4	Inventor's Oath/Declaration Supplemental Examination	March 6, 2012	30
5	Supplemental Examination	March 25, 2012	35
	TOTAL	--	123



Board Related Notices of Proposed Rulemaking for Trials

	AIA Provision	Comment Period End	Comments Received
6	Inter partes review	April 10, 2012	49
7	Post-grant review		48
8	Derivation		19
9	Covered business method review		41
10	Technological invention Definition		28
11	Umbrella Rules	April 9, 2012	66
12	Trial Practice Guide		
	TOTAL	--	251



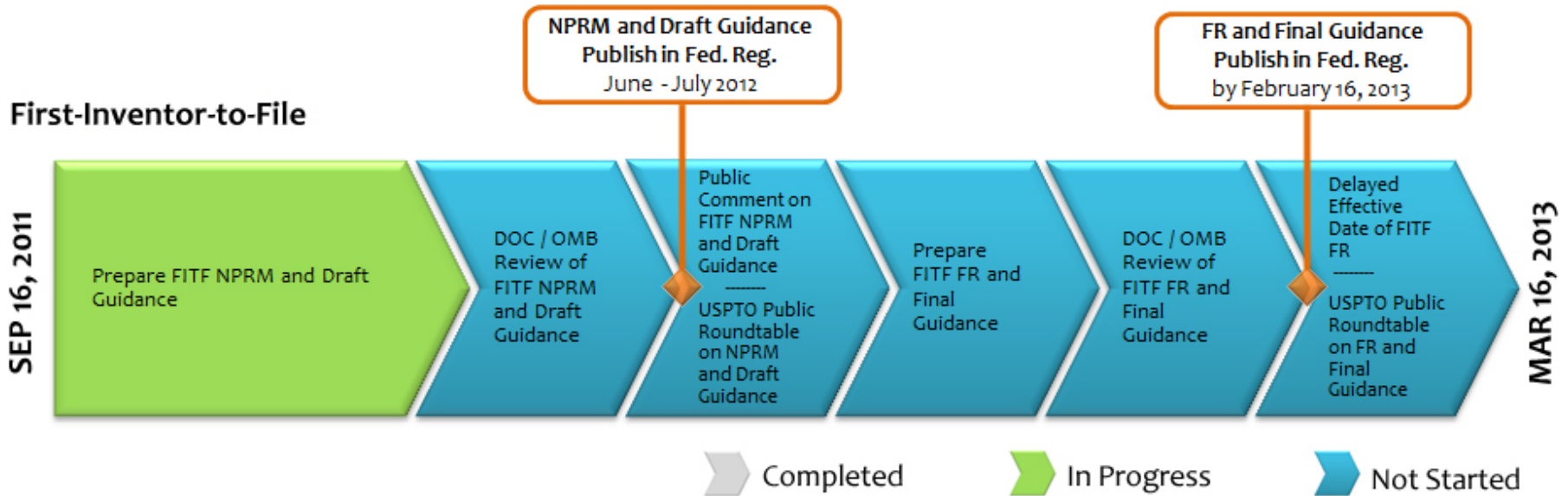
Trial Proceedings

Proceeding	Petitioner	Available	Standard	Basis	Applicable	Estoppel	Timing
Post Grant Review (PGR)	Must identify real party in interest	Patent grant to 9 months from patent grant	More likely than not OR Novel or unsettled legal question important to other patents/ applications	101, 102, 103, 112, double patenting but not best mode	Patent issued under first-inventor-to-file	Raised or reasonably could have raised Applied to subsequent USPTO/district court/ITC action	Must complete within 12 months from institution, with 6 months good cause exception possible
Inter Partes Review (IPR)	Must identify real party in interest	10 months from patent grant for life of patent or termination of a PGR; Director may limit number during first 4 years	Reasonable likelihood	102 and 103	Any patent pending on or after September 16, 2012	Raised or reasonably could have raised Applied to subsequent USPTO/district court/ITC action	Must complete within 12 months from institution, with 6 months good cause exception possible



First-to-File

First-Inventor-to-File

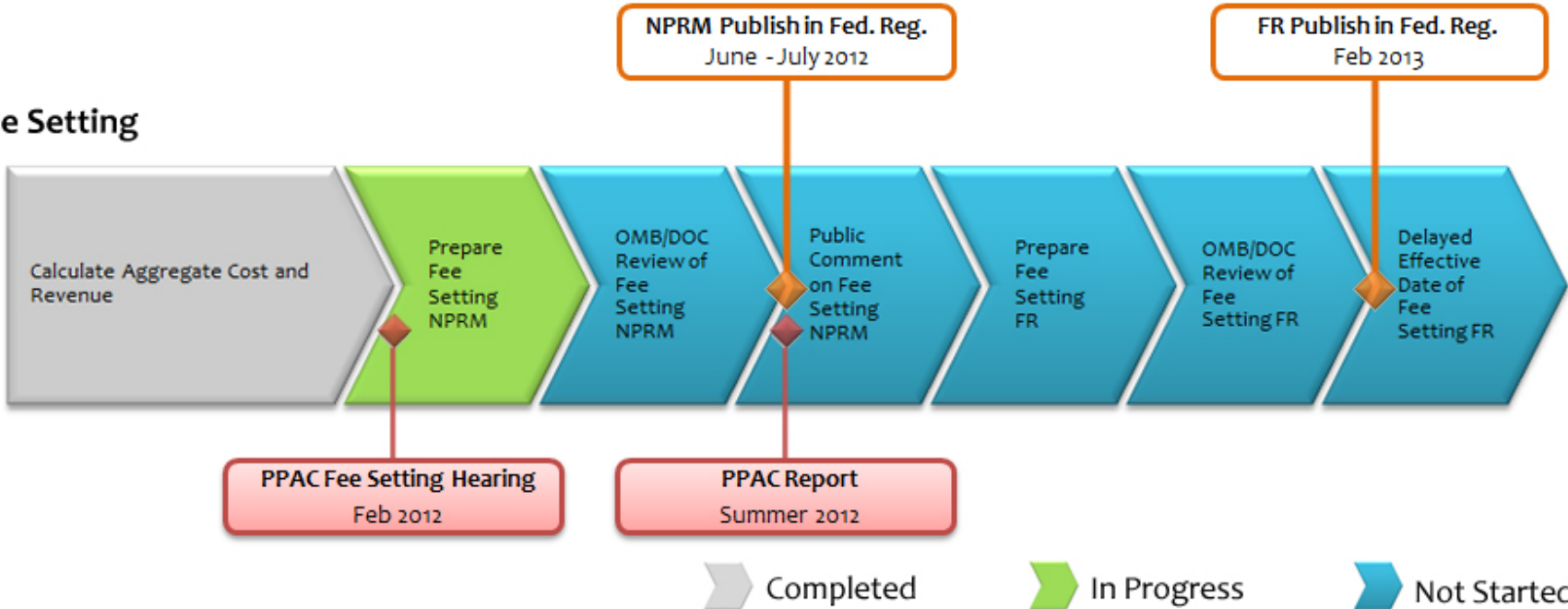




Fee Setting

Fee Setting

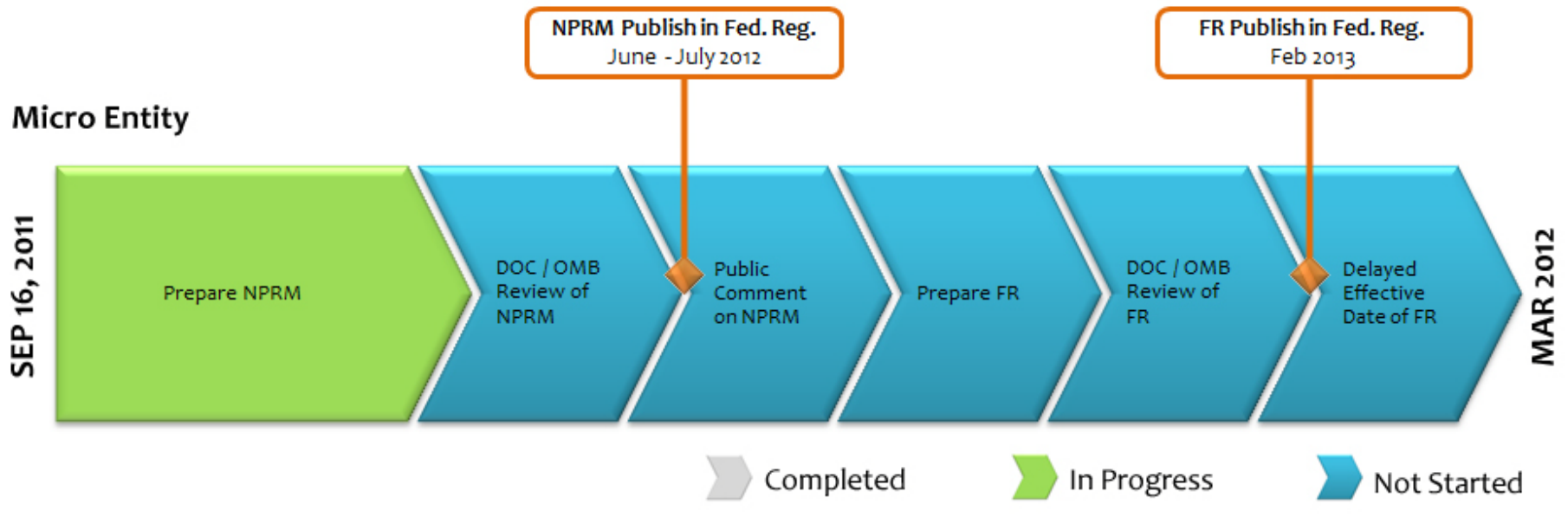
SEP 16, 2011



MAR 2013



Micro Entity





Pro Bono Program

- **AIA Section 32**: The Director shall work with and support intellectual property law associations across the country in the establishment of pro bono programs designed to assist financially under-resourced independent inventors and small businesses.
- Provides pro bono legal assistance to financially under-resource independent inventors and small businesses to file and prosecute patent applications
- 2011 = Minnesota program established
- 2012 = 5 programs planned
- 2013 = 11 programs planned



Satellite Offices

- **USPTO required to open 3 satellite offices in 3 years**
- **Initial office planned for Detroit; opening July 13, 2012**
- **USPTO screening comments received in response to Federal Register Notice regarding location of remaining 2 offices**
 - **100 locations suggested**
 - **Narrow to 6 locations by June 2012**

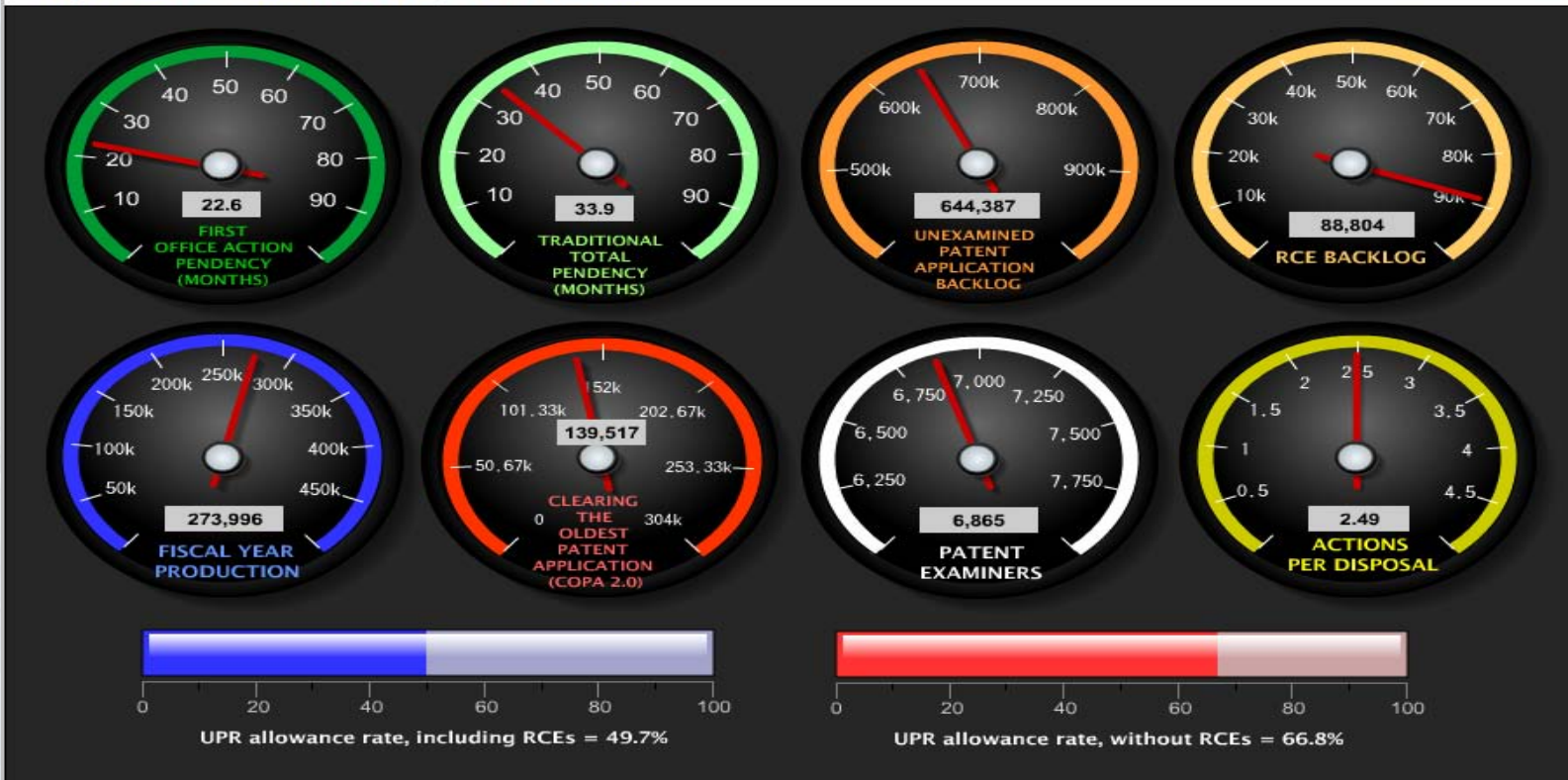




Patents Dashboard

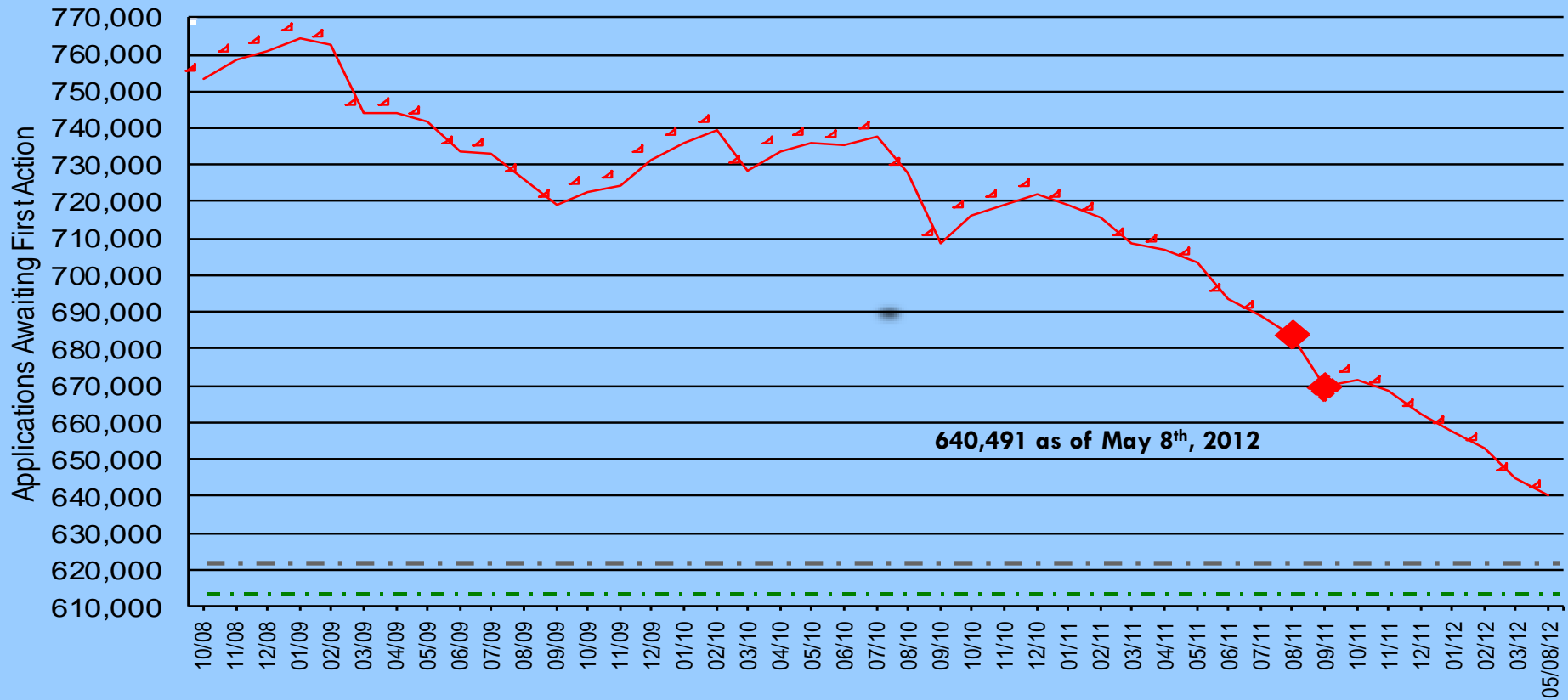


April 2012 Patents Data, at a Glance





Unexamined Patent Application Backlog FY 2009 – FY 2012 (through May 8th, 2012)



--- FY 2012 Target (2013 President's Budget): 621,800 – Includes Cooperative Patent Classification (CPC) Production Adjustment.

--- Target Less CPC Adjustment: 615,000.



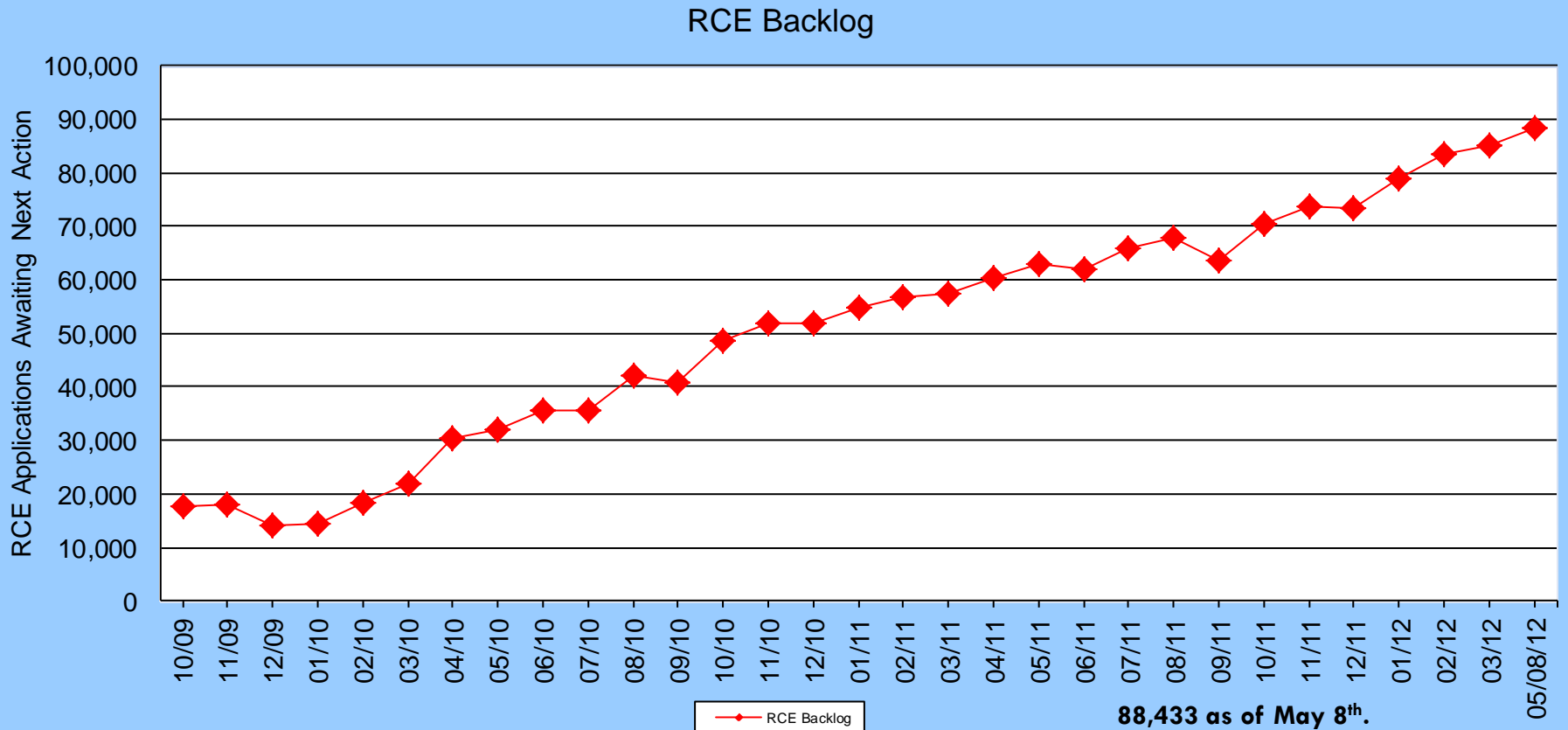
First Action Interview Program

- **Total Applicants - 3,208**
- **Allowances - 992**
- **First Action Allowance Rate - 27.3%**
- **FA Allowance Rate all Applications - 17%**



RCE Backlog

FY 2010 – FY 2012 (through May 8th, 2012)





After Final Consideration Pilot (AFCP)

- **Determine if a limited amount of further consideration of responses filed after a final rejection will increase the number of allowances at that stage of prosecution, thereby reducing the number that proceed to an RCE filing.**
- **Examiners are encouraged to consider modest responses after a final rejection by authorization of a limited amount of additional time for that purpose, if they believe that full and complete consideration can be done and will lead to allowance of the application.**
- **Pilot runs 3rd Quarter of FY12 (March 25, 2012 – June 16, 2012)**



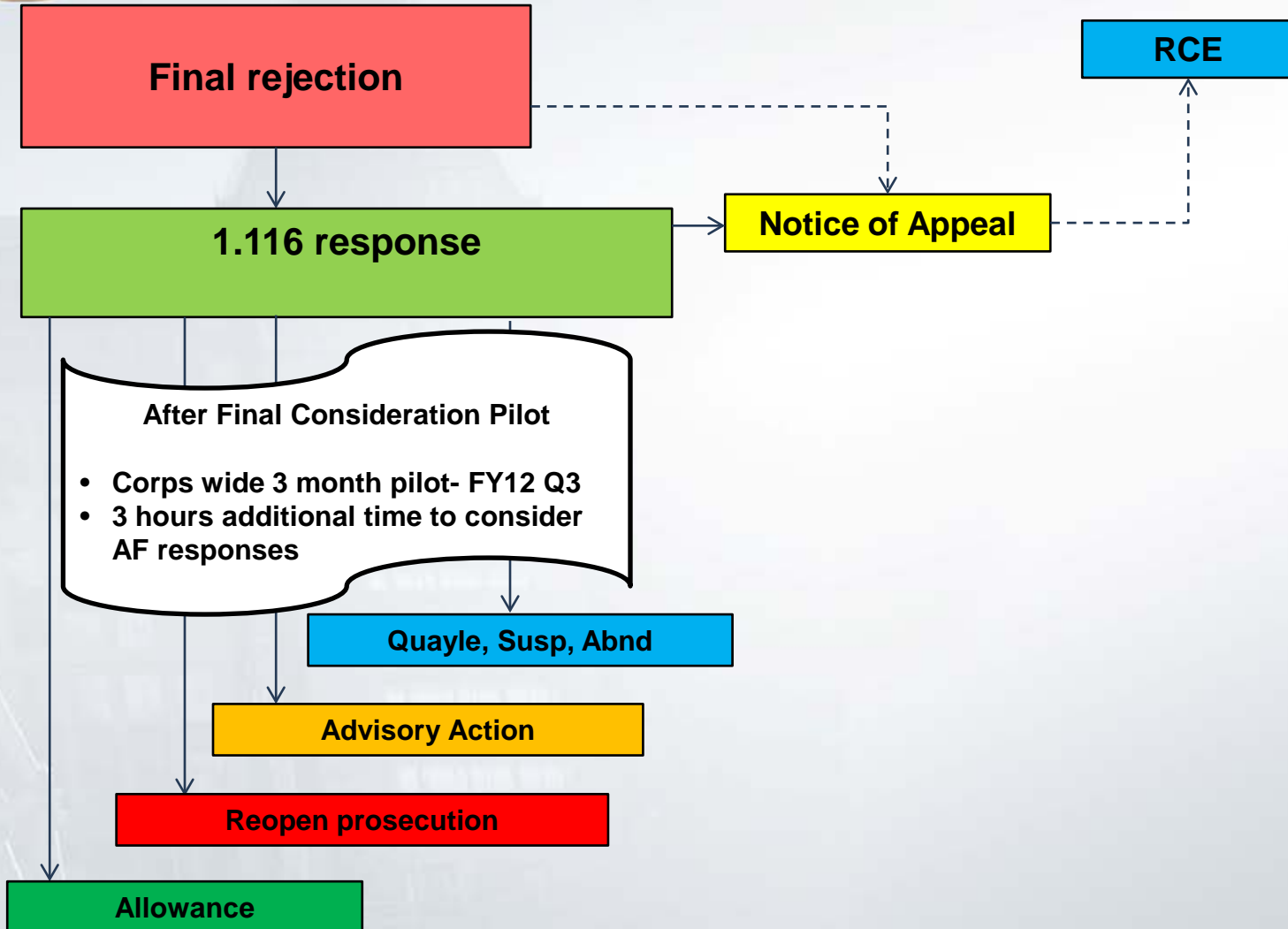
After Final Consideration Pilot (cont.)

In the first 4 weeks of the Pilot:

- **8557 after-final (AF) responses were acted on by examiners**
- **2776 AF responses were given enhanced consideration using the pilot (32% of the total)**
- **The allowance rate for pilot AF responses was 31.4%**
- **The allowance for non-pilot AF responses was 28.1%**
- **Overall the increase in the allowance rate after final was 1.1% (91 additional allowances)**
- **As a comparison, the 2011 allowance rate after the filing of a response after-final rejection was 27.4%**



After Final Consideration Pilot (cont.)



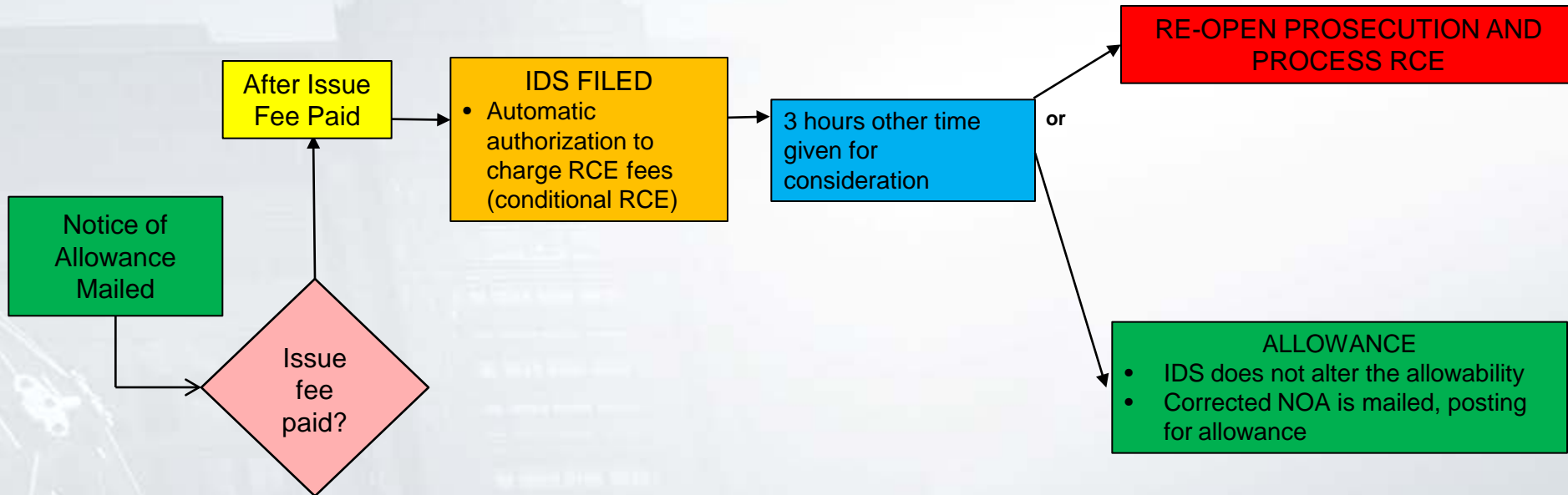


Quick Path IDS (QPIDS) Pilot

- **Eliminate the need for an RCE with an IDS after payment of the issue fee.**
- **Program Requirements:**
 - **Transmittal Form**
 - **IDS with Timeliness Statement and Fee**
 - **Web-based ePetition and Fee**
 - **RCE and Fee**
- **Effective 5/16/12 – 9/30/12**



Quick Path IDS (QPIDS) Pilot



Thank You

