

Implementation of the America Invents Act (AIA)

Summary of Provisions and Effective Dates

Public Law Number 112-29 (Signed: September 16, 2011)

www.uspto.gov/aia_implementation/

Provision	Section	Description	Effective Date
Virtual Marking and Limits on False Marking Litigation	16	<ul style="list-style-type: none"> Provides for virtual marking → posting patent information on the Internet Marking provisions apply to all pending and future litigations Provides that only the U.S. may sue for penalty authorized by the false marking statute Civil suits regarding false marking are limited to persons who suffer competitive injury and compensatory damages 	September 16, 2011
Expansion of the Existing Prior User Defense	5	<ul style="list-style-type: none"> Expands prior commercial use defense to affiliates and to processes or a machine, manufacture, or composition of matter used in manufacturing or other commercial processes (beyond previous restriction to business methods) Requires showing of commercial use at least 1 year before effective filing date Provides exceptions for patents owned by universities or their tech transfer organizations 	September 16, 2011
Tax Strategies are deemed within the Prior Art	14	<ul style="list-style-type: none"> Any strategy for reducing, avoiding, or deferring tax liability is deemed insufficient to differentiate the claimed invention from the prior art Two exceptions for method, apparatus, technology, computer program product, or system used solely (i) to prepare a tax return; or (ii) for financial management 	September 16, 2011
Best Mode Requirement	15	<ul style="list-style-type: none"> Not available as a defense in infringement actions Not available for post-grant review allegations of failure to disclose the best mode for carrying out the subject invention 	September 16, 2011
Pro Bono Program	32	<ul style="list-style-type: none"> Directs USPTO to work with IP law associations to establish pro bono programs to assist financially under-resourced independent inventors and small businesses 	September 16, 2011

Human Organism Prohibition	33	<ul style="list-style-type: none"> Prohibits a patent with claims directed to or encompassing a human organism 	September 16, 2011
Venue Change from DDC to EDVA for suits brought under 35 U.S.C. §§ 32, 145, 146, 154 (b)(4)(A), and 293	9	<ul style="list-style-type: none"> The venue for certain district court challenges of USPTO decisions is changed from the U.S. District Court for the District of Columbia to the U.S. District Court for the Eastern District of Virginia: <ul style="list-style-type: none"> 35 U.S.C. § 32 – OED Actions 35 U.S.C. § 145 – Appeals of patentability decisions from BPAI 35 U.S.C. § 146 – Appeals of interference decision from BPAI 35 U.S.C. § 154(b)(4)(A) – Patent Term Adjustment 35 U.S.C. § 293 – Service for nonresident patentee 	September 16, 2011
OED Statute of Limitations	3	<ul style="list-style-type: none"> The earlier of (i) 1 year before the date on which the misconduct is made known to a USPTO officer or employee; or (ii) 10 years after the date on which the misconduct forming the basis of the proceeding occurred 	September 16, 2011
Advice of Counsel	17	<ul style="list-style-type: none"> The failure of an accused infringer to obtain advice of counsel cannot be used to prove willfulness or induced infringement 	September 16, 2011
Prioritized Examination	11	<ul style="list-style-type: none"> Establishes prioritized examination for a fee of \$4800 (above usual fees) with 50% reduction for small entities Applies to utility and plant applications if certain limitations on the number of claims are met and the application is electronically filed Goal of a final disposition in 12 months (on average) from the date prioritized examination is granted Limited to 10,000 prioritized examinations per fiscal year until the Director promulgates regulations for the condition and number 	September 26, 2011
Surcharge on patent fees	11	<ul style="list-style-type: none"> Automatically implements 15% surcharge on most patent fees 	September 26, 2011
USPTO Funding	22	<ul style="list-style-type: none"> Establishes in the Treasury a “Patent and Trademark Fee Reserve Fund” Fees collected in excess of the appropriated amount in any given fiscal year would be deposited in the Reserve Fund and made available until expended for USPTO operations “to the extent and in the amounts provided in appropriations Acts” 	October 1, 2011

Provide USPTO Fee-Setting Authority	10	<ul style="list-style-type: none"> • Provides authority for the Director to set or adjust by rule any fee established, authorized, or charged under Title 35 and the Trademark Act, so that the aggregate revenue from fees equals the aggregate estimated cost, include administrative costs • Defines “micro entity” and provides for 75% fee reduction for micro entities once the Director sets the new fees under this section 	New fees will become effective after rulemaking
Post-Grant and <i>Inter Partes</i> Review Procedures	6	<ul style="list-style-type: none"> • <i>Inter partes</i> review is a new trial proceeding conducted at the Board to review the patentability of one or more claims in a patent only 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 • <i>Inter partes</i> review process begins with a third party filing a petition after the later of either: (1) 9 months after the grant of the patent or issuance of a reissue patent; or (2) if a post grant review is instituted, the termination of the post grant review. The patent owner may file a preliminary response to the petition. <ul style="list-style-type: none"> ○ <i>Inter partes</i> review may be instituted upon a showing that there is a reasonable likelihood that the petitioner would prevail with respect to at least one claim challenged • Post grant review is a new trial proceeding conducted at the Board to review the patentability of one or more claims in a patent on any ground that could be raised under § 282(b)(2) or (3) • Post grant review process begins with a third party filing a petition on or prior to the date that is 9 months after the grant of the patent or issuance of a reissue patent. The patent owner may file a preliminary response to the petition • A post grant review may be instituted upon a showing that, it is more likely than not that at least one claim challenged is unpatentable 	September 16, 2012
Transitional Program for Covered Business Method Patents	18	<ul style="list-style-type: none"> • Establishes eight (8) year transitional post-grant review proceeding Available for patents that claim a method or corresponding apparatus for performing data processing operations utilized in the practice, administration, or management of a financial product or service, but not for patents claiming “technological inventions” • Director to define “technological invention” by regulation 	September 16, 2012

Supplemental Examination Procedure	12	<ul style="list-style-type: none"> • Process for a patent owner to request supplemental examination of a patent to consider, reconsider, or correct information believed to be relevant to the patent • Upon determination that a “substantial new question of patentability” (SNQ) is raised, the Director must order an <i>ex parte</i> reexamination • Patent shall not be held unenforceable in litigation on the basis of conduct relating to information considered during supplemental examination if supplemental examination is concluded before litigation is brought 	September 16, 2012
3 rd Party Submissions of Prior Art	8	<ul style="list-style-type: none"> • Allows third parties to submit printed publications (including patents) of potential relevance to examination • Submissions may be made by (1) the later of (i) 6 months after the date of publication, or (ii) the date of a first Office action on the merits rejecting any claims; or (2) before the date of a notice of allowance, if earlier. Section 122(e) also provides for such fees as the Director may prescribe 	September 16, 2012
Priority Examination for Important Technologies	25	<ul style="list-style-type: none"> • Director may promulgate regulations for the examination of applications for products, processes, or technologies that are important to the national economy or national competitiveness 	September 16, 2012
Inventor’s Oath of Declaration	4	<ul style="list-style-type: none"> • Provides for assignee filing when the inventor is unable or unwilling to do so • Removes requirements for statements of lack of deceptive intent 	September 16, 2012
Transition to First-Inventor-to-File And Definition of Prior Art (§ 102)	3	<ul style="list-style-type: none"> • Transitions the US to a first-inventor-to-file patent system from a first-to-invent system • Maintains a 1 year grace period for disclosures by inventor or a party who obtained from the inventor • Establishes a derivation proceeding: If a party named as an inventor in an earlier application derived the invention from actual inventor, then the derived claims will be refused or cancelled • Establishes “derivation proceedings” • Prior art defined as: <ul style="list-style-type: none"> ○ (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 a patent issued under section 151, or in an application for patent published or deemed published under section 122(b), in which the patent or application . . . names another inventor and was effectively filed before the effective filing date of the claimed invention. 	March 16, 2013