

USPTO Proposes More Rules for Implementing AIA Provisions

By Donald Zuhn -- February 13, 2012



Last November, officials from the U.S. Patent and Trademark Office indicated that ten notices of proposed rulemaking to implement various provisions of the Leahy-Smith America Invents Act were being drafted and vetted by the Office, and that the notices would be published in January 2012 (see "[USPTO News Briefs](#)"). By the end of its self-imposed deadline, the Office had released five notices offering proposed rulemaking regarding:

- Changes To Implement Miscellaneous Post Patent Provisions of the Leahy-Smith America Invents Act ([77 Fed. Reg. 442](#)) -- *Patent Docs* [report](#);
- Changes To Implement the Preissuance Submissions by Third Parties Provision of the Leahy-Smith America Invents Act ([77 Fed. Reg. 448](#)) -- *Patent Docs* [report](#);
- Implementation of Statute of Limitations Provisions for Office Disciplinary Proceedings ([77 Fed. Reg. 457](#)) -- *Patent Docs* [report](#);
- Changes To Implement the Inventor's Oath or Declaration Provisions of the Leahy-Smith America Invents Act ([77 Fed. Reg. 982](#)) -- *Patent Docs* [report](#); and
- Changes To Implement the Supplemental Examination Provisions of the Leahy-Smith America Invents Act and To Revise Reexamination Fees ([77 Fed. Reg. 3666](#)) -- *Patent Docs* [report](#).

On Thursday, the Office released a set of seven notices requesting comments and/or providing additional proposed rulemaking. Among the recent set of notices were the following:

- Practice Guide for Proposed Trial Rules ([77 Fed. Reg. 6868](#));
- Rules of Practice for Trials Before the Patent Trial and Appeal Board and Judicial Review of Patent Trial and Appeal Board Decisions ([77 Fed. Reg. 6879](#));
- Changes To Implement Derivation Proceedings ([77 Fed. Reg. 7028](#));
- Changes to Implement Inter Partes Review Proceedings ([77 Fed. Reg. 7041](#)); and
- Changes To Implement Post-Grant Review Proceedings ([77 Fed. Reg. 7060](#)).

As with the first set of proposed rules, *Patent Docs* plans to discuss each of the notices published last week, beginning with the notice to implement the derivation proceedings provisions of the AIA. Subsequent posts will address the other notices.

Section 3(i) of the Leahy-Smith America Invents Act amends 35 U.S.C. § 135 to provide for derivation proceedings in which an applicant may seek a determination that "an inventor named in an earlier application derived the claimed invention from an inventor named in the petitioner's application and, without authorization, the earlier application claiming such invention was filed" (see "[AIA Overview: First-Inventor-to-File Provisions](#)"). The 14-page notice of proposed rulemaking on derivation proceedings addresses the manner in which the Patent Trial and Appeal Board will resolve disputes as to which of two applicants is a true inventor. In addition to the derivation proceedings provisions provided in AIA § 3(i), the notice indicates that:

Derivation proceedings will be conducted in a manner similar to *inter partes* reviews and post-grant reviews. Unlike patent interferences, derivations will be conducted in a single phase without the use of a "count." An inventor seeking a derivation proceeding must file an application. 35 U.S.C. 135(a). An inventor, however, may copy an alleged deriver's application, make any necessary changes to reflect accurately what the inventor invented, and provoke a derivation proceeding by the timely filing of a petition and fee.

Pursuant to § 135(a), the Director shall determine whether to institute a derivation proceeding in response to a petition demonstrating that the standards for instituting a derivation proceeding have been met. However, the notice states that "[a] derivation is unlikely to be declared even where the Director thinks the standard for instituting a derivation proceeding is met if the petitioner's claim is not otherwise in condition for allowance."

Under new § 135(f), the Director is not precluded from determining the patentability of the claimed inventions involved in the proceeding. The notice indicates that "[t]he Director will delegate to the Board authority to resolve patentability issues that arise during derivation proceedings when there is good cause to do so."

Following a discussion of the changes to 35 U.S.C. § 135, the notice provides a discussion of specific rules for instituting and conducting derivation proceedings before the Board. In particular, the notice proposes adding new subpart E to 37 C.F.R. part 42 to provide rules specific to derivation proceedings. In three of the other notices issued last week, the Office proposes adding subpart A to 37 C.F.R. part 42, which sets forth the policies, practices, and definitions common to all trial proceedings (including derivation proceedings) before the Board; subpart B, which provides rules specific to *inter partes* review; subpart C, which provides rules specific to post-grant review; and subpart D, which provides rules specific to transitional program covered business method patents.

A brief discussion of the proposed rules for instituting and conducting derivation proceedings can be found on pages 7030-31 of the notice, and the text of the new rules can be found on pages 7039-41 of the notice.

Comments regarding the notice can be submitted by e-mail to derivation@uspto.gov; by regular mail addressed to: Mail Stop Patent Board, Director of the United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450, marked to the attention of Lead Judge Michael Tierney, Derivation Proposed Rules; or via the Federal [eRulemaking Portal](#). The deadline for submitting comments is April 10, 2012. Additional information regarding the submission of comments can be found in the Office's Federal Register notice ([77 Fed. Reg. 7028](#)).

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