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USPTO Issues Rules Implementing America Invents Act

On August 14, 2012, the U.S. Patent and Trademark Office issued rules implementing various provisions of the Leahy-Smith America Invents Act (AIA). The following articles outline the finalized and proposed rules and how the changes will affect your organization. Please click on any of the headlines below to read the complete articles on the respective topics.

[First Inventor to file](#)

The U.S. Patent and Trademark Office has issued proposed rules to implement the “first-to-file” provisions of the AIA. The rules are open for comment until October 5, 2012. The first-to-file system goes into effect on March 16, 2013. All patent applications with an effective filing date of March 16, 2013 or later will be subject to the first-to-file rules. The first-to-file system grants patent rights to the first inventor to file a patent application regardless of who was the first to invent. Current interference practice will be eliminated for all patent applications subject to the first to file system. The rules are the last steps in the conversion of the U.S. patent laws from a first-to-invent system to a first-to-file system. This change continues the process of harmonizing the U.S. patent laws with the rest of the world.

[Inventor’s Oath or Declaration](#)

The U.S. Patent and Trademark Office issued final rules, effective September 16, 2012, that implement provisions of the Leahy-Smith America Invents Act related to an inventor’s oath or declaration. See 77 Fed. Reg. 48776 (2012). The rules streamline the statements required in an inventor’s oath or declaration and permit these statements to be included in an assignment. In lieu of an inventor’s oath or declaration, a substitute statement can be filed in certain circumstances. Further, the filing of the inventor’s oath or declaration can now be delayed until an application is in condition for allowance. The rules also modify existing practice by relaxing the requirement that only inventors may be an applicant for a patent application and now permitting an assignee to be an applicant for a patent application.

[Supplemental Examination and Post-Grant Proceedings](#)

The U.S. Patent and Trademark Office issued rules implementing provisions of the Leahy-Smith America Invents Act relating to supplemental examination and post-grant proceedings (*inter partes* review, post-grant review, and transitional program for covered business method patents) effective September 16, 2012. As of that date *inter partes* review will replace *inter partes* reexaminations. After passage of the AIA, the USPTO issued final rules relating to changing the standard of *inter partes* reexaminations effective September 16, 2011 for the transitional period until the implementation of *inter partes* review.

[Third Party Submission](#)

On September 16, 2012, final rules issued by the U.S. Patent and Trademark Office that implement provisions of the Leahy-Smith America Invents Act related to preissuance submissions by third parties become effective. The rules modify existing practice by allowing third parties to submit documents with a concise description of relevance of each document submitted in the same or greater time period than previously allowed. The rules, once effective, apply to any application filed before, on, or after September 16, 2012.

[Citation of Prior Art and Written Statements in a Patent File](#)

On September 16, 2012, final rules issued by the U.S. Patent and Trademark Office that implement provisions of the Leahy-Smith America Invents Act related to citation of prior art and written statements in a patent file become effective. The rules modify existing practice by allowing any person to file a written submission directed to (1) prior art consisting of patents or printed publications that the person making the submission believes to have a bearing on the patentability of any claim of the patent; or (2) statements of

the patent owner filed by the patent owner in a proceeding before a federal court or the U.S. Patent and Trademark Office in which a patent owner took a position on the scope of any claim of the patent.

Prioritized Examination

Prioritized examination (PE) has been implemented under the AIA to give applicants more control over when their applications are examined. The goal is to provide a final disposition within twelve months, on average, of prioritized status being granted. As of September 26, 2011, so-called Track I requests for prioritized status may be filed for original utility or plant applications. The program was extended on December 19, 2011 to permit a single request for prioritized status upon filing an RCE or after an RCE is filed but prior to a 1st Examiner's Action.

Definitions for the Transitional Program for Covered Business Method Patents

The U.S. Patent and Trademark Office issued final rules, effective September 16, 2012, that implement provisions of the Leahy-Smith America Invents Act related to definitions for the transitional program for covered business method patents. See 77 Fed. Reg. 48734 (2012). The rules set forth definitions for a covered business method patent and a technological invention.

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