

Changes To Implement the First Inventor To File Provisions of the Leahy-Smith America Invents Act Final Rules

FOR: NEIFELD IP LAW, PC, ALEXANDRIA
VA

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SUMMARY

- This Presentation Covers The Final Rules For The First Inventor To File Provisions Of The AIA, Promulgated 2-14-2013. It does not cover the Examination Guidelines.
- 78 FR 11024 (2-14-2013) (FINAL RULES)
- 78 FR 11059 (2-14-2013) (EXAM GUIDELINES)

EFFECTIVE AND APPLICABILITY DATES

- EFFECTIVE – MARCH 16, 2013
- APPLICABILITY DATE IS RULE DEPENDENT
- SEE APPLICABILITY DATES IN THE FOLLOWING SLIDES

APPLICABILITY DATES 1

- **Rules for foreign and domestic priority claims:**
- **“changes to 37 CFR 1.55 and 1.78 apply to any application filed under 35 U.S.C. 111 or 363 on or after March 16, 2013”**

APPLICABILITY DATES 2

- **Rules removed because statutory invention registrations eliminated:**
- **“1.17 and 37 CFR 1.293 through 1.297 as in effect on March 15, 2013, apply to any request for a statutory invention registration filed prior to March 16, 2013.”**
- **“§§ 1.293 through 1.297 [Removed and Reserved]”**
- **1.293 – 1.297 refer to Statutory Invention Registrations**

APPLICABILITY DATES 3

- **Rules added that apply to applications subject to AIA first inventor to file law:**

- **“37 CFR 1.109** applies to any application for patent, and to any patent issuing thereon, that contains, or contained at any time, a claim to a claimed invention that has an effective filing date as defined in 35 U.S.C. 100(i) that is on or after March 16, 2013... [and also] applies ... to any application for patent, and to any patent issuing thereon, that contains, or contained at any time, a specific reference under 35 U.S.C. 120, 121, or 365(c) to any patent or application that contains, or contained at any time, a claim to a claimed invention that has an effective filing date as defined in 35 U.S.C. 100(i) that is on or after March 16, 2013.”

APPLICABILITY DATES 4

- **All other rule changes:**
- Applicable on the effective date of March 16, 2013

RULE BY RULE REVIEW

- PTO summary; PTO comments in response to public comments; rules; and my notes follow
- Font size used to indicate significance
- Rules quoted in all small font indicate no substantive change from existing rule requirements
- Text of many, but not all, revised and new rules are included in the slides for reference

“1.9 Definitions”

“INVENTOR” – “collectively who invented or discovered the subject matter of the invention”

“JOINT INVENTOR OR COINVENTOR” – “any one of the individuals”

“JOINT RESEARCH AGREEMENT” (JRA) – “written contract, grant, or cooperative agreement entered into by two or more persons or entities for the performance of experimental, developmental, or research work in the field of the claimed invention.”

“CLAIMED INVENTION” – “the subject matter defined by a claim”

1.9 - Notes

- Definitions distinguish between claimed invention and what defines inventorship (“the subject matter of the invention”)
- Definitions, except for “inventorship”, are statutory. 35 USC 100(f)-(h)
- The “for performance of ... work” is still required for an agreement to qualify as a JRA

1.17 – PTO Summary

“Section 1.17 is amended to eliminate the provisions pertaining to statutory invention registrations in § 1.17(g), (n), and (o). See discussion of the provisions of §§ 1.293 through 1.297.”

“Sections 1.17(g) and (i) are also amended for consistency with the changes to § 1.55. See discussion of § 1.55.”

“1.17 - Patent application and reexamination processing fees”

“(g) For filing a petition under one of the following sections which refers to this paragraph: \$200.00”

“(i) Processing fee for taking action under one of the following sections which refers to this paragraph: \$130.00”

1.17(g) Fee (\$200)

1.17(g) fee required for:

“§ 1.12—for access to an assignment record.

§ 1.14—for access to an application.

§ 1.46—for filing an application on behalf of an inventor by a person who otherwise shows sufficient proprietary interest in the matter.

§ 1.55(f)—for filing a belated certified copy of a foreign application.

§ 1.59—for expungement of information.

§ 1.103(a)—to suspend action in an application.

§ 1.136(b)—for review of a request for extension of time when the provisions of § 1.136(a) are not available.

§ 1.377—for review of decision refusing to accept and record payment of a maintenance fee filed prior to expiration of a patent.

§ 1.550(c)—for patent owner requests for extension of time in *ex parte* reexamination proceedings.

§ 1.956—for patent owner requests for extension of time in *inter partes* reexamination proceedings.

§ 5.12—for expedited handling of a foreign filing license.

§ 5.15—for changing the scope of a license.

§ 5.25—for retroactive license.”

§ 1.17(i) Fee (\$130)

1.17(i) fee required for:

“§ 1.28(c)(3)—for processing a nonitemized fee deficiency based on an error in small entity status.

§ 1.41(b)—for supplying the name or names of the inventor or joint inventors in an application without either an application data sheet or the inventor’s oath or declaration, except in provisional applications.

§ 1.48—for correcting inventorship, except in provisional applications.

§ 1.52(d)—for processing a nonprovisional application filed with a specification in a language other than English.

§ 1.53(c)(3)—to convert a provisional application filed under § 1.53(c) into a nonprovisional application under § 1.53(b).

§ 1.55—for *entry of a* priority claim or *certified copy* of a foreign application after payment of the issue fee.

§ 1.71(g)(2)—for processing a belated amendment under § 1.71(g).

§ 1.103(b)—for requesting limited suspension of action, continued prosecution application for a design patent (§ 1.53(d)).

§ 1.103(c)—for requesting limited suspension of action, request for continued examination (§ 1.114).

§ 1.103(d)—for requesting deferred examination of an application.

§ 1.217—for processing a redacted copy of a paper submitted in the file of an application in which a redacted copy was submitted for the patent application publication.

§ 1.221—for requesting voluntary publication or republication of an application.

§ 1.291(c)(5)—for processing a second or subsequent protest by the same real party in interest.

§ 3.81—for a patent to issue to assignee, assignment submitted after payment of the issue fee.”

1.17(i) – PTO Summary

•“If a certified copy of the foreign application is filed after the date the issue fee is paid, it ***must*** be accompanied by the processing fee set forth in § 1.17(i), ***but the patent will not include the priority claim*** unless corrected by a certificate of correction under 35 U.S.C. 255 and § 1.323.”

1.17(i) – Notes

- Ensure processing fee paid with belated PD submission to obtain entry
- Docket/file COC, if certified copy filed belatedly
- Change in law: Failure to secure entry of priority document (PD) during pendency cannot be cured in a non pending application

“1.53 Application number, filing date, and completion of application”

1.53(b) “*Application filing requirements - Nonprovisional application.* The filing date of an application for patent filed under this section, except for a provisional application under paragraph (c) of this section or a continued prosecution application under paragraph (d) of this section, is the date on which a specification as prescribed by 35 U.S.C. 112 containing a description pursuant to § 1.71 and at least one claim pursuant to § 1.75, and any drawing required by § 1.81(a) are filed in the Patent and Trademark Office. No new matter may be introduced into an application after its filing date. A continuing application, which may be a continuation, divisional, or continuation-in-part application, may be filed under the conditions specified in 35 U.S.C. 120, 121, or 365(c) and § 1.78(c) and (d).”

1.53 - PTO Summary

- “Section 1.53(b) is amended for consistency with the reorganization of § 1.78.”
- “Section 1.53(c) is amended to eliminate the provisions pertaining to statutory invention registrations.”
- “Section 1.53(j) is removed as the provisions of § 1.53 pertain to applications filed under 35 U.S.C. 111 and the discussion of former § 1.53(j) pertained to applications filed under the Patent Cooperation Treaty (PCT).”

“1.55 Claim for foreign priority”

- **PTO Summary:** “Section 1.55 is reorganized into paragraphs (a) through (l) for clarity.”
- **Note:** Rule 1.55 contains many new requirements relating to timely submission of the certified copy of the PD

1.55 – Note

Rule 1.55 organization:

- 1.55(a)-(b): Priority right, 1 year time limit
- 1.55(c)-(f): Priority claim time limits for 371 and 111(a) (and 172) applications
- 1.55(g)-(i): What must be filed
- 1.55(j) – AIA statement requirement
- 1.55(k) – Inventor certificate declaration requirement

1.55(a)-(b)

“(a) *In general.* An applicant in a nonprovisional application may claim priority to one or more prior foreign applications under the conditions specified in 35 U.S.C. 119(a) through (d) and (f), 172, and 365(a) and (b) and this section.

(b) *Time for filing subsequent application.* The nonprovisional application must be filed not later than twelve months (six months in the case of a design application) after the date on which the foreign application was filed, or be entitled to claim the benefit under 35 U.S.C. 120, 121, or 365(c) of an application that was filed not later than twelve months (six months in the case of a design application) after the date on which the foreign application was filed. The twelve-month period is subject to 35 U.S.C. 21(b) (and § 1.7(a)) and PCT Rule 80.5, and the six-month period is subject to 35 U.S.C. 21(b) (and § 1.7(a)).

1.55(c) – Timing of Foreign Priority Claim in 371 Applications

“(c) Time for filing priority claim and certified copy of foreign application in an application entering the national stage under 35 U.S.C. 371. In an international application entering the national stage under 35 U.S.C., the claim for priority must be made and a certified copy of the foreign application must be filed within the time limit set forth in the PCT and the Regulations under the PCT.”

1.55(c) - PTO Summary

“Note that it is permissible, but not required under § 1.55(c), to present the claim for priority in an application data sheet *in an international application* entering the national stage under 35 U.S.C.”

1.55(c) - PTO Comment

•RESPONSE TO COMMENT 10: **PCT ISSUES**

“if the applicant submitted a certified copy of the foreign priority document in compliance with PCT Rule 17 during the international phase, ... [then a] copy received [by the PTO] from the International Bureau is acceptable to establish that applicant has filed a certified copy of the priority document. *See MPEP* § 1893.03(c).”

1.55(c) - PTO Comment

- **RESPONSE TO COMMENT 10: PCT ISSUES**

“If, however, the International Bureau is unable to forward a copy of the certified priority document ... the applicant will need to provide a certified copy of the priority document....”

1.55(d) – PTO Summary

“Section 1.55(d) pertains to the time [limit] for filing a priority claim in an application filed under 35 U.S.C. 111(a).”

“Section 1.55(d) *does not include* the requirement of former § 1.55(a)(1)(i) for an identification of any foreign application for the same subject matter having a filing date before that of the application for which priority is claimed,”

1.55(d) - PTO Comment

- RESPONSE TO COMMENT 7:

“The Office is continuing the practice of treating a priority claim to an application filed in a participating foreign intellectual property office as a request that the Office obtain a copy of the foreign application from the participating intellectual property office.”

Rule 1.55(d)

“(d) *Time for filing priority claim in an application filed under 35 U.S.C. 111(a).* In an original application filed under 35 U.S.C. 111(a), the claim for priority must be *filed within the later of **four months** from the actual filing date of the application or **sixteen months** from the filing date of the prior foreign application.* The claim for priority *must be presented in an **application data sheet** (§ 1.76(b)(6)), and must identify the foreign application for which priority is claimed, by specifying the application number, country (or intellectual property authority), day, month, and year of its filing. **The time period in this paragraph does not apply in a design application.**”*

1.55(e) – PTO Summary

- “Section 1.55(e) pertains to a waiver of claims for priority ...”

Waiver portion of rule 1.55(e)

“(e) *Delayed priority claim in an application filed under 35 U.S.C. 111(a)*. Unless such claim is accepted in accordance with the provisions of this paragraph, any claim for priority under 35 U.S.C. 119(a) through (d) or (f) or 365(a) in an original application filed under 35 U.S.C. 111(a) not presented in an application data sheet (§ 1.76(b)(6)) within the time period provided by paragraph (d) of this section is considered to have been waived. If a *claim for priority* is presented after the time period provided by paragraph (d) of this section, the claim may be accepted if the priority claim was unintentionally delayed. ”

1.55(e) – PTO Summary

- “Section 1.55(e) also [generally] requires that a petition to accept a delayed claim for priority ***be accompanied by a certified copy*** of the foreign application....”

Petition portion of rule 1.55(e)

“(e) ... A petition to accept a delayed ***claim for priority*** under 35 U.S.C. 119(a) through (d) or (f) or 365(a) must be accompanied by:

(1) The priority claim under 35 U.S.C. 119(a) through (d) or (f) or 365(a) in an application data sheet (§ 1.76(b)(6)), identifying the foreign application for which priority is claimed, by specifying the application number, country (or intellectual property authority), day, month, and year of its filing, unless previously submitted;

(2) A *certified copy* of the foreign application if required by paragraph (f) of this section, unless previously submitted;

(3) The surcharge set forth in § 1.17(t); and

(4) A statement that the entire delay between the date the priority claim was due under paragraph (d) of this section and the date the priority claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

1.55(f) – PTO Summary

“Section 1.55(f) pertains to the *time for filing a certified copy* of the foreign application in an application filed under 35 U.S.C. 111(a) [and] ... petition including a showing of good and sufficient cause for” belated filing.

1.55(f) - PTO Comment

•RESPONSE TO COMMENT 11: **CONTINUING APPLICATION ISSUES**

“Consistent with current practice, it is not necessary to file a certified copy of a foreign application in a later-filed application that claims the benefit of an earlier nonprovisional application where: (1) Priority to the foreign application is claimed in the later-filed application (i.e., continuation, continuation-in-part, division) or in a reissue application; and (2) a certified copy of the foreign application has been filed in the earlier nonprovisional application.”

1.55(f) - PTO Comment

•RESPONSE TO COMMENT 11: CONTINUING APPLICATION ISSUES

“When making such claim for priority, the applicant must identify the earlier nonprovisional application ***containing the certified copy***. See *MPEP* § 201.14(b).”

MPEP 201.14(b) “Where the benefit of a foreign filing date based on a foreign application is claimed in a later filed application (i.e., continuation, continuation-in-part, division) or in a reissue application ... The applicant when making such claim for priority may simply ***identify the application containing the certified copy***. ... To **satisfy the requirement of [37 CFR 1.55\(a\)\(2\)](#) [sic]** for a certified copy of the foreign application, applicant may simply identify the application containing the certified copy.”

78 FR 11029 comment on rule 1.55(g)(1): “Section 1.55(g)(1) corresponds to the provisions of former § 1.55(a)(2).”

1.55(f) - NOTES

- Maintain docketing rule for continuing applications claiming foreign priority
- **DOCKETING RULE REMINDER:** file a notice identifying earlier application in which a certified copy of PD was actually filed

1.55(f) - TIME LIMIT FOR FILING CERTIFIED COPY

*“(f) Time for filing certified copy of foreign application in an application filed under 35 U.S.C. 111(a). In an original application filed under 35 U.S.C. 111(a), **a certified copy of the foreign application must be filed within the later of four months** from the actual filing date of the application or **sixteen months** from the filing date of the prior foreign application, except as provided in paragraphs (h) and (i) of this section. ...”*

1.55(f) – PTO Summary (Continued)

“The Office is [also] including a provision in § 1.55(f) to provide for the belated filing of a certified copy of the foreign application to provide a ***lower standard (good and sufficient cause versus an extraordinary situation)*** and lower fee (\$200 petition fee set forth in § 1.17(g) versus the \$400 petition fee set forth in § 1.17(f)) than would otherwise be applicable for a petition under § 1.183 to waive or suspend a requirement of the regulations in such a situation.”

1.55(f) CONTINUED PETITION REQUIREMENTS

“(f) ... If a certified copy of the foreign application is not filed within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior foreign application, and the exceptions in paragraphs (h) and (i) of this section are not applicable, the certified copy of the foreign application must be accompanied by a ***petition*** including a ***showing of good and sufficient cause for the delay*** and the ***petition fee*** set forth in § 1.17(g).”

1.55(g)(1) – PTO Summary

“Section 1.55(g)(1) provides that the claim for priority and the certified copy of the foreign application specified in 35 U.S.C. 119(b) or PCT Rule 17 must, in any event, be filed in or received by the Office within the pendency of the application and before the patent is granted.”

1.55(g)(1) - PTO Summary

- **BURDEN REMAINS ON THE APPLICANT!**

“Applicants continue to bear the ultimate responsibility for ensuring that the priority document is filed by the time required under § 1.55(g)(1). Accordingly, applicants are encouraged to check as necessary to confirm receipt by the Office of appropriate documents. Priority documents retrieved from a participating foreign intellectual property office will bear the document description: **“Priority documents electronically retrieved by USPTO from a participating IP Office.”**”

- **PRACTICE POINT - DOCKET CONFIRMATION PTO RECEIVED CERTIFIED PRIORITY DOCUMENT**

1.55(g)(1) PRIORITY MUST BE PREFECTED DURING PENDENCY

*“(g) Requirement for filing priority claim, certified copy of foreign application, and translation in any application. (1) The claim for priority **and the certified copy of the foreign application specified in 35 U.S.C. 119(b) or PCT Rule 17 must**, in any event, **be filed** within the **pendency of** the application and before the patent is granted.”*

1.55(g)(1) - *CONSEQUENCES OF BELATED CLAIM OR COPY*

“(g)(1) ... If the claim for priority or the certified copy of the foreign application is filed after the date the issue fee is paid, it must also be accompanied by the processing fee set forth in § 1.17(i), but the patent will not include the priority claim unless corrected by a certificate of correction under 35 U.S.C. 255 and § 1.323.”

- REQUEST FOR A CERTIFICATE OF CORRECTION MUST BE FILED TO EFFECT PRIORITY RIGHT, IF PRIORITY WAS PERFECTED AFTER PAYING THE ISSUE FEE.

1.55(g)(2) WHEN THE OFFICE MAY REQUIRE EARLY PERFECTION OF PRIORITY CLAIM

“Section 1.55(g)(2) corresponds to the provisions of former § 1.55(a)(3).”

“(2) The Office may require that the claim for priority and the certified copy of the foreign application be filed earlier than otherwise provided in this section:

- (i) When the application is involved in an interference (see § 41.202 of this title) or derivation (see part 42 of this title) proceeding;
- (ii) When necessary to overcome the date of a reference relied upon by the examiner; or
- (iii) When deemed necessary by the examiner.”

1.55(g)(3) WHEN THE OFFICE MAY REQUIRE AN ENGLISH LANGUAGE TRANSLATION

“Section 1.55(g)(3) corresponds to the provisions of former § 1.55(a)(4)(i).”

- “ (3) An English language translation of a non-English language foreign application is not required except:
- (i) When the application is involved in an interference (see § 41.202 of this title) **or derivation (see part 42 of this title) proceeding;**
 - (ii) When necessary to overcome the date of a reference relied upon by the examiner; or
 - (iii) When specifically required by the examiner.”

1.55(g)(4) CERTIFICATION THAT THE ENGLISH LANGUAGE TRANSLATION IS ACCURATE

“Section 1.55(g)(3) corresponds to the provisions of former § 1.55(a)(4)(i).”

“(4) If an English language translation of a non-English language foreign application is required, it must be filed together with a statement that the translation of the certified copy is Accurate.”

- **PRACTICE POINT – REQUIRE TRANSLATOR IDENTITY, CONTACT INFORMATION, AND TRANSLATOR TO PROVIDE A SIGNED CERTIFICATION OF ACCURACY OF TRANSLATION.**

1.55(h) – PTO Summary

“Section 1.55(h) provides that the requirement... for a certified copy of the foreign application ... will be considered satisfied if the Office receives a copy of the priority document through the priority document exchange program within the period specified in § 1.55(g)(1).”

1.55(h) - PTO Summary

EXPRESS PDX REQUEST NO LONGER

REQUIRED “because the Office treats a priority claim (presented in an application data sheet) to an application filed in a participating foreign intellectual property office as such a request, and any priority claim must be filed within the later of four months from the filing date of the application filed under 35 U.S.C. 111(a) or sixteen months from the filing date of the foreign application (except as provided in § 1.55(e)).”

1.55(h) - PTO Summary

- PDX UNAVAILABLE FOR DESIGN APPLICATIONS

“Note that the Office cannot obtain a copy of a design application to which priority is claimed, or a foreign application to which priority is claimed in a design application, through the priority document exchange program”

1.55(h) PRIORITY DOCUMENT (*PD*) EXCHANGE (*PDX*) AGREEMENTS

“(h) *Foreign intellectual property office participating in a **priority document exchange** agreement. The requirement in paragraphs (c), (f), and (g) for a certified copy of the foreign application to be filed within the time limit set forth therein will be considered satisfied if:*”

[THE FOLLOWING REQUIREMENTS ARE MET]

1.55(h) - REQUIREMENTS

(h)(1): PARTICIPATING FOREIGN IP OFFICE

“(1) The foreign application was filed in a foreign intellectual property office participating with the Office in a bilateral or multilateral priority document exchange agreement (participating foreign intellectual property office), or a copy of the foreign application was filed in an application subsequently filed in a participating foreign intellectual property office that permits the Office to obtain such a copy;”)

(h)(2): PRIORITY CLAIM FILED IN AN ADS

“(2) The claim for priority is presented in an application data sheet (§ 1.76(b)(6)), identifying the foreign application for which priority is claimed, by specifying the application number, country (or intellectual property authority), day, month, and year of its filing, and the applicant provides the information necessary for the participating foreign intellectual property office to provide the Office with access to the foreign application;”)

(h)(3): PTO ACTUALLY RECEIVES THE PDX DOCUMENT

“(3) The copy of the foreign application is received by the Office from the participating foreign intellectual property office, or a certified copy of the foreign application is filed, within the period specified in paragraph (g)(1) of this section; and”)

1.55(h)(4) - CONDITIONAL 4TH REQUIREMENT

- IF PD ISSUED BY AN IP OFFICE LACKING A PDX AGREEMENT WITH THE PTO, APPLICANT MUST MAKE A TIMELY AND SPECIFIC REQUEST TO PTO

((“(4) The applicant files a request in a separate document that the Office obtain a copy of the foreign application from a participating intellectual property office that permits the Office to obtain such a copy if the foreign application was not filed in a participating foreign intellectual property office but a copy of the foreign application was filed in an application subsequently filed in a participating foreign intellectual property office that permits the Office to obtain such a copy. The request must identify the participating intellectual property office and the subsequent application by the application number, day, month, and year of its filing in which a copy of the foreign application was filed. The request must be filed within the later of sixteen months from the filing date of the prior foreign application or four months from the actual filing date of an application under 35 U.S.C. 111(a), within four months from the later of the date of commencement (§ 1.491(a)) or the date of the initial submission under 35 U.S.C. 371 in an application entering the national stage under 35 U.S.C. 371, or with a petition under paragraph (e) of this section.”))

1.55(h)(4) - PTO Comment

RESPONSE TO COMMENT 3:

“Applicants can use *Form PTO/SB/38 (Request to Retrieve Electronic Priority Application(s))* to file such a request. ...”

1.55(h)(4) - PTO Comment

Response to comment 3:

“As a specific example, an application filed in the DPMA (which is not currently a participating foreign intellectual property office) may be retrieved via the priority document exchange program if it is identified in the claim for priority on the application data sheet, a subsequent application filed in the European Patent Office (EPO) or the Japan Patent Office (JPO) contains a certified copy of the DPMA application, and the applicant timely files a separate request for the Office to obtain from the EPO (or JPO) a copy of the certified copy of the DPMA application, wherein the request identifies the DPMA application and the subsequent application by their application number, country (EPO, JPO, or DE), day, month, and year of their filing.”

1.55(i) Interim Copy

“(i) *Interim copy.* The requirement in paragraph (f) for a certified copy of the foreign application to be filed within the time limit set forth therein will be considered satisfied if:”

[THE FOLLOWING REQUIREMENTS ARE MET]

1.55(i) *Interim Copy*

(i)(1): UNCERTIFIED *INTERIM COPY* OF THE PD, IDENTIFICATION, AND ASSERTION FILED IN PTO

“(1) A copy of the original foreign application clearly labeled as “Interim Copy,” including the specification, and any drawings or claims upon which it is based, is filed in the Office together with a separate cover sheet identifying the foreign application by specifying the application number, country (or intellectual property authority), day, month, and year of its filing, and stating that the copy filed in the Office is a true copy of the original application as filed in the foreign country (or intellectual property authority);)

(i)(2) : UNCERTIFIED COPY FILING IS TIMELY

(4/16)

“(2) The copy of the foreign application and separate cover sheet is filed within the later of sixteen months from the filing date of the prior foreign application or four months from the actual filing date of an application under 35 U.S.C. 111(a), or with a petition under paragraph (e) of this section; and”)

(i)3): CERTIFIED COPY FILED DURING PENDENCY

“(3) A certified copy of the foreign application is filed within the period specified in paragraph (g)(1) of this section.”)

1.55(i) – *PTO* Comment

“Section 1.55(i) as adopted in this final rule permits an applicant to provide an “interim copy” of the original foreign application ***from the applicant’s own records*** to provide for the situation in which the applicant cannot obtain a certified copy of the foreign application within the time limit set forth in § 1.55(f).”

PTO definition: “Transition Application”

“The Office is also adopting the following requirement for a *nonprovisional application filed on or after March 16, 2013, that claims priority to or the benefit of the filing date of an earlier application (i.e., foreign, provisional, or nonprovisional application, or international application designating the United States) filed prior to March 16, 2013 (a **transition application**)*:”

1.55(J) *Requirement To Identify AIA Transition Application*

- The applicant ***MUST*** file a statement identifying an application that is subject to AIA first inventor to file provisions, if the application is filed after and the priority date is before, March 16, 2013
- The statement ***MUST*** be timely filed (4/16 months)
- An AIA invoking claim filed after (4/16 months), ***MUST*** be accompanied by such a statement

1.55(J) Requirement To Identify AIA Transition Application

“(j) *Requirements for certain applications filed on or after March 16, 2013. If a nonprovisional application filed on or after March 16, 2013, claims priority to a foreign application filed prior to March 16, 2013, and also contains, or contained at any time, a claim to a claimed invention that has an effective filing date on or after March 16, 2013, the applicant must provide a statement to that effect within the later of four months from the actual filing date of the nonprovisional application, four months from the date of entry into the national stage as set forth in § 1.491 in an international application, sixteen months from the filing date of the prior filed foreign application, or the date that a first claim to a claimed invention that has an effective filing date on or after March 16, 2013, is presented in the nonprovisional application. An applicant is not required to provide such a statement if the applicant reasonably believes on the basis of information already known to the individuals designated in § 1.56(c) that the nonprovisional application does not, and did not at any time, contain a claim to a claimed invention that has an effective filing date on or after March 16, 2013.*”)

1.55(k) *INVENTOR'S CERTIFICATES*

- PRIORITY CLAIM BASED UPON INVENTOR CERTIFICATE (IC)
- REQUIRES DECLARATION
- MUST DECLARE THAT THE APPLICANT “had the option to file an application for either a patent or an inventor’s certificate as to the subject matter of the identified claim”

1.55(I) *TIME PERIODS NOT EXTENDABLE*

“(I) The time periods set forth in this section are not extendable.”

1.55(I) – PTO Comment

- RESPONSE TO COMMENT 12: EOTs FOR PD TRANSLATION *NOT GOVERNMED BY RULE 1.55(I)*

“The provisions of § 1.55(I) as adopted in this final rule apply to time periods actually set in § 1.55, and not to time periods that are set in an Office action. Thus, an applicant may obtain an extension of time to file an English-language translation when filing the English language translation in response to an Office action, unless the Office action indicates that extensions of time are not available.”

1.71 – PTO Comment

- 1.71 “amended to remove reference to pre-AIA 35 U.S.C. 103(c)(2)(C)”
- 1.71 refers to “(JRA) *as set forth in § 1.9(e)* in order to provide for both pre-AIA and AIA applications and patents”

1.71 – PTO Comment

RESPONSE TO COMMENT 47:

- AIA 35 USC 102(c): “does not require that a [JRA] be made of record in the application”
- AIA 35 USC 102(c):“does require the application to disclose or be amended to disclose the names of the parties to the [JRA].”
- 1.71(g)(2) fee required for entry of belated JRA amendment

1.71 Detailed description and specification of the invention

“Section 1.71 is amended by revising paragraph (g)(1) to read as follows:”

“(g)(1) The specification may disclose or be amended to disclose the names of the parties to a joint research agreement *as defined in § 1.9(e).*”

1.76 Application data sheet

- “*Section 1.76: Sections 1.76(b)(5) and (b)(6) are amended for consistency with the changes to and reorganization of §§ 1.55 and 1.78. See discussion of §§ 1.55 and 1.78.*”
- “Section 1.76 is amended by revising paragraphs (b)(5) and (6)”

1.76(b)(5)-(6)

Application data sheet

(b) “(5) *Domestic benefit information.* This information includes the application number, the filing date, the status (including patent number if available), and relationship of each application for which a benefit is claimed under 35 U.S.C. 119(e), 120, 121, or 365(c). Providing this information in the application data sheet constitutes the specific reference required by 35 U.S.C. 119(e) or 120, and § 1.78.

“(6) *Foreign priority information.* This information includes the application number, country, and filing date of each foreign application for which priority is claimed. Providing this information in the application data sheet constitutes the claim for priority as required by 35 U.S.C. 119(b) and § 1.55.”

1.77 - PTO Comment

- “Section 1.77(b) is amended to provide for any statement regarding prior disclosures by the inventor or a joint inventor.”
- “identifying any prior disclosures ... may ... expedite examination of the application.”

1.77 - Arrangement of application elements

“(b) * * *

(2) Cross-reference to related applications.

* * * * *

(6) Statement regarding prior disclosures by the inventor or a joint inventor.”

1.78 – Note

1.78 is reorganized as follows:

- 1.78(a)-(b): 119(e) claims and delayed claims
- 1.78(c)-(d): 120, 121, or 365(c) claims and delayed claims
- 1.78(e)-(f): patentably indistinct claims for the same and different inventors; and
- 1.78(g): 1.78 time periods “are not extendable.”

1.78 – Note

DISTINGUISH BETWEEN:

- INVENTION CLAIM HAVING BENEFIT OF EARLIER FILING DATE
- DISCLOSURE OF AN FILED EARLIER APPLICATION BEING PRIOR ART AGAINST OTHERS

1.78(a) – PTO Summary

“Section 1.78(a), however, does not require (as did former § 1.78(a)(4)) that the provisional application must disclose *the invention claimed in at least one claim* of the later-filed application in the manner provided by 35 U.S.C. 112(a) (except for the requirement to disclose the best mode) because § 1.78 pertains to claims to the benefit of a prior-filed application.”

1.78 – PTO Summary

“The AIA draws a distinction between [sic a claim] being entitled to the benefit of a prior-filed application and being entitled to claim the benefit of a prior-filed application. See *157 Cong. Rec. S1370* (2011) (explaining the distinction between being entitled to actual priority or benefit for purposes of 35 U.S.C. 100(i) and being entitled only to claim priority or benefit for purposes of AIA 35 U.S.C. 102(d)).”

1.78(a) – PTO Summary

“In contrast, the prior-filed application must describe the subject matter for the later-filed application to be considered effectively filed under AIA 35 U.S.C. 102(d) on the filing date of the prior filed application with respect to that subject matter.”

1.78(a)(6) – PTO Summary

“Section 1.78(a)(6) requires that ... the applicant **MUST** provide a statement [in a transition application if the application is subject to the AIA first to file provisions] ... within [4/16 months] ...or ... [when an AIA triggering] claim ... is presented in the nonprovisional application.”

1.78(c) – PTO Summary

“Section 1.78(c) [for the same reason as 1.78(a)(6)] does not contain a provision (as did former § 1.78(a)(1)) that the prior-filed application disclose the invention claimed in at least one claim of the later-filed application in the manner provided by 35 U.S.C. 112(a).”

1.78(c) – PTO Summary

“Section 1.78(c) [for the same reason as 1.78(a)(6)] does not contain a provision (as did former § 1.78(a)(1)) that the prior-filed application disclose the invention claimed in at least one claim of the later-filed application in the manner provided by 35 U.S.C. 112(a).”

1.78(c)(2) – PTO Summary

“Section 1.78(c)(2) is amended to clarify that identifying the relationship of the applications means identifying whether the later-filed application is a continuation, divisional, or continuation-in-part of the prior-filed nonprovisional application or international application. *See MPEP* section 201.11.”

1.78(c)(5) – PTO Summary

“Section 1.78(c)(5) also provides that cross-references to applications for which a benefit is not claimed ***must not*** be included in an application data sheet (§ 1.76(b)(5)).”

1.78(c)(6) – PTO Summary

“Section 1.78(c)(6) [like 1.78(a)(6) and for the same reason] requires that ... the applicant **MUST** provide a statement [in a transition application if the application is subject to AIA first to file provisions] ... within [4/16 months] ...or ... [when an AIA triggering] claim ... is presented in the nonprovisional application.”

1.78(e) – PTO Summary

“Section 1.78(e), however, uses the term “patentably indistinct” rather than “conflicting” for clarity as the term “conflicting” is not otherwise employed in the rules of practice. *See Changes To Implement Derivation Proceedings*, 77 FR at 56070, 56071–72, and 56090 (adding new § 42.401, which includes defining same or substantially the same as meaning patentably indistinct).”

1.78(f) – PTO Summary

“Section 1.78(f) addresses applications or patents under reexamination that name different inventors and contain patentably indistinct claims. The provisions are similar to the provisions of former § 1.78(c), but the language has been amended to refer to ‘on its effective filing date (as defined in § 1.109) or on its date of invention, as applicable’ ... [and to] ‘patentably indistinct’ rather than ‘conflicting’ for clarity.”

1.55 and 1.78 – PTO Comment

RESPONSE TO COMMENT 16:

“Sections 1.55 and 1.78 as adopted in this final rule do not require a statement if a transition application ***discloses, but does not claim***, subject matter that is not supported in a benefit or priority application filed before March 16, 2013.”

1.78 – PTO Comment

RESPONSE TO COMMENT 18:

“However, § 1.56 also includes a general duty of candor and good faith in dealing with the Office, which could be implicated if an applicant is aware that a transition application contains a claim to a claimed invention that has an effective filing date on or after March 16, 2013, but nonetheless chooses not to provide the statement when required under § 1.55 or 1.78.”

1.78 – PTO Comment

RESPONSE TO COMMENT 19:

“Therefore, after March 16, 2014, (or May 16, 2014[)], the statement required by §§ 1.55 and 1.78 as adopted in this final rule for certain transition applications should be necessary only in certain continuation-in-part applications.”

1.78 – PTO Comment

RESPONSE TO COMMENT 21:

“The Office is revising the application data sheet to include a check box to allow applicants to easily indicate whether a transition application contains or ever contained a claim to a claimed invention having an effective filing date that is on or after March 16, 2013.”

1.78 – PTO Comment

RESPONSE TO COMMENT 23:

“The addition of a claim in a transition application that is directed to subject matter fully supported in a pre-AIA benefit or priority application would not itself trigger the statement requirement under § 1.55 or § 1.78 and would not make the application subject to AIA 35 U.S.C. 102 and 103.”

1.78 – PTO Comment

RESPONSE TO COMMENT 24:

“an amendment (other than a preliminary amendment filed on the same day as such application) ***seeking to add a claim to a claimed invention that is directed to new matter*** would not convert the application into an AIA application. 35 U.S.C. 132(a) prohibits the **introduction of new matter** into the disclosure and thus an application may not actually “contain” a claim to a claimed invention that is directed to new matter.”

1.78 – PTO Comment

RESPONSE TO COMMENT 25:

“For an application filed on or after March 16, 2013, ... An amendment ... seeking to add a claim ... directed to new matter would not convert the application into an AIA application. 35 U.S.C. 132(a) prohibits the introduction of new matter ... thus an application may not actually “contain” a claim ... to new matter.”

1.78 – TEXT OF RULE

The text of rule 1.78 is not included in this presentation.

1.84 and 1.103

“Section 1.84(a) is amended to eliminate the provisions pertaining to statutory invention registrations.”

“Section 1.103(g) is removed to eliminate the provisions pertaining to statutory invention registrations.”

1.84 and 1.103

“*Section 1.84(a)* is amended to eliminate the provisions pertaining to statutory invention registrations.”

“*Section 1.103(g)* is removed to eliminate the provisions pertaining to statutory invention registrations.”

1.104 – PTO Summary

“Section 1.104(c)(4) is amended to include the provisions that pertain to commonly owned or joint research agreement subject matter for applications and patents subject to AIA 35 U.S.C. 102 and 103.”

1.104 – PTO Comments

Response to comment 47:

- “AIA 35 U.S.C. 102(c) does not require that a joint research agreement be made of record in the Application”
- “AIA 35 U.S.C. 102(c) does ... require the application to disclose or be amended to disclose the names of the parties to the joint research agreement”

1.104(c)(4)

“(c) * * *(4)(i) Subject matter which would otherwise qualify as prior art under 35 U.S.C. 102(a)(2) and a claimed invention will be treated as commonly owned for purposes of 35 U.S.C. 102(b)(2)(C) if the applicant or patent owner provides a statement to the effect that the subject matter 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. (ii) Subject matter which would otherwise qualify as prior art under 35 U.S.C. 102(a)(2) and a claimed invention will be treated as commonly owned for purposes of 35 U.S.C. 102(b)(2)(C) on the basis of a joint research agreement under 35 U.S.C. 102(c) if:

(A) The applicant or patent owner provides a statement to the effect that the subject matter was developed and the claimed invention was made by or on behalf of one or more parties to a joint research agreement, within the meaning of 35 U.S.C. 100(h) and § 1.9(e), **that was in effect on or before *the effective filing date of the claimed invention***, and the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement; and

(B) The application for patent for the claimed invention discloses or is amended to disclose the names of the parties to the joint research agreement.”

1.104(c)(4) and (5) - Note

- Pre AIA requirement is relative to an obligation or JRA in effect on or before “date the claimed invention was made”
- Post AIA requirement is relative to the effective filing date of the claimed invention.

1.109 – PTO Summary

- “Section 1.109 is added to specify the effective filing date of a claimed invention under the AIA.”
- “Section 1.109 applies to any application for patent, and to any patent issuing thereon, that” is subject to the AIA first inventor to file law.

1.109

“(a) The effective filing date for a claimed invention in a patent or application for patent, other than in a reissue application or reissued patent, is the earliest of:

- (1) The actual filing date of the patent or the application for the patent containing a claim to the invention; or
- (2) The filing date of the earliest application for which the patent or application is entitled, as to such invention, to a right of priority or the benefit of an earlier filing date under 35 U.S.C. 119, 120, 121, or 365.

(b) The effective filing date for a claimed invention in a **reissue application or a reissued patent is determined by deeming the claim to the invention to have been contained in the patent for which reissue was sought.**” 99

1.110 – PTO Summary

“Section 1.110 is revised to provide for both AIA applications and pre-AIA applications.”

1.110 – PTO Summary

- “Section 1.110 is revised to provide for both AIA applications and pre-AIA applications.”
- “Section 1.110 specifically provides that when one or more joint inventors are named in an application or patent, the Office may require an applicant or patentee to identify the inventorship and ownership or obligation to assign ownership, of each claimed invention on its effective filing date (as defined in § 1.109) or on its date of invention, as applicable....”

1.130 and 1.131– PTO Summary

- “§ 1.130 applies to applications for patent (and patents issuing thereon) that are subject to AIA 35 U.S.C. 102 and 103”
- “and § 1.131 would apply to applications for patent (and patents issuing thereon) that are subject to pre-AIA 35 U.S.C. 102 and 103....”

1.130 – PTO Summary

“Section 1.130 [provides for disqualifying a disclosure as prior art] ...

(1) ... by establishing that the disclosure was ... a disclosure of the inventor’s or a joint inventor’s own work (affidavit or declaration of attribution); and

(2) ... by establishing that there was a prior public disclosure of the subject matter disclosed by the inventor or a joint inventor or ... by another of the inventor’s or a joint inventor’s own work....”

1.130 – Note

- 130(a): disclosure of the inventor's or a joint inventor's own work
- 130(b): prior public disclosure of the ... of the inventor's or a joint inventor's own work
- 130(c): 1 year statutory bar based upon *public* disclosure (non public disclosure not barred)
- 130(c): 130 ineffective if (patent) disclosure claims the same or substantially the same invention
- See rule 42.401 (Petition for Derivation Proceeding)

1.130 – PTO Comment

Response to comment 28:

- “Section 1.130 as adopted in this final rule has been revised to ... set forth ***only the procedural requirements*** for submitting a declaration or affidavit of attribution under § 1.130(a) and ... § 1.130(b).”
- “The ***showing required*** for establishing sufficiency of a declaration or affidavit under § 1.130 is discussed in the Examination Guidelines for Implementing the First Inventor To File Provisions of the Leahy-Smith America Invents Act.”

1.130 – PTO Comment

Response to comment 31:

- “the public needs to know what evidence the examiner relied upon in determining the patentability of the claims”
- “However, applicants may submit proprietary information with a petition to expunge under limited circumstances as explained in MPEP § 724.”

1.130 – PTO Comment

Response to comment 32:

“An applicant is not ‘required’ to identify any prior disclosures by the inventor or a joint inventor unless the prior disclosure is not a grace period disclosure and is ‘material to patentability’.”

1.130 – PTO Comment

Response to comment 34:

“The Office does not consider a *per se requirement* for corroboration to be necessary in *ex parte* examination (i.e., application examination or *ex parte patent* reexamination) proceedings. The need for corroboration in *ex parte* proceedings is a case-by-case determination based upon the specific facts of the case.”

1.130 – PTO Comment

Response to comment 35:

“The term ‘disclosure’ includes disclosures that are not public. For example, prior filed, later published U.S. patent applications are considered disclosures on their earliest effective filing dates, which is not the date on which the disclosure was made publicly available.”

1.130 – PTO Comment

Response to comment 38:

“The Office plans to include information on the cover sheet of U.S. patents if an affidavit or declaration containing evidence of a prior public disclosure under § 1.130(b) was filed during the prosecution of the application for that patent in order to facilitate search by examiners and the public of prior public disclosures brought to the Office’s attention under § 1.130(b).”

1.130 – PTO Comment

Response to comment 39:

“Section 1.130 as adopted in this final rule ***does not include a requirement to file a petition for a derivation proceeding*** and instead provides that an applicant or patent owner may file a petition for a derivation proceeding....”

1.130 – PTO Comment

Response to comment 39:

“In the event that a patent is issued on a later filed application claiming subject matter disclosed in an earlier filed application, the applicant in the earlier filed application may request early publication of the application under § 1.219 and may cite the resulting patent application publication in the file of the patent on the later filed application under 35 U.S.C. 301 and § 1.501.....”

1.130(a)

“(a) **Affidavit or declaration of attribution.** When any claim of an application or a patent under reexamination is rejected, the applicant or patent owner may submit an appropriate affidavit or declaration to disqualify a disclosure as prior art by establishing that the disclosure was made by the inventor or a joint inventor, or the subject matter disclosed was obtained directly or indirectly from the inventor or a joint inventor.”

1.130(b)

“(b)Affidavit or declaration of prior public disclosure. When any claim of an application or a patent under reexamination is rejected, the applicant or patent owner may submit an appropriate affidavit or declaration to disqualify a disclosure as prior art by establishing that the subject matter disclosed had, before such disclosure was made or before such subject matter was effectively filed, 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.”

1.130(b)

“(b) An affidavit or declaration under this paragraph must identify the subject matter publicly disclosed and provide the date such subject matter was 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.”

1.130(b)(1)

(b) ... “(1) If the subject matter publicly disclosed on that date was in a printed publication, the affidavit or declaration *must be accompanied by a copy of the printed publication.*”

1.130(b)(2)

(b) ... “(2) If the subject matter publicly disclosed on that date was not in a printed publication, the *affidavit or declaration must describe the subject matter with sufficient detail and particularity to determine what subject matter had been publicly disclosed* on that date 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.”

1.130(c)

“(c) When this section is not available. The provisions of this section are not available if the rejection is based upon a disclosure made more than one year before the effective filing date of the claimed invention.”

1.130(c)

“(c) ... The provisions of this section may not be available if the rejection is based upon a U.S. patent or U.S. patent application publication of a patented or pending application naming another inventor, the patent or pending application claims an invention that is the same or substantially the same as the applicant’s or patent owner’s claimed invention, and the affidavit or declaration contends that an inventor named in the U.S. patent or U.S. patent application publication derived the claimed invention”

1.130(d)

“(d) Applications and patents to which this section is applicable. The provisions of this section apply to any application for patent, and to any patent issuing thereon, that contains, or contained at any time: (1) A claim to a claimed invention that has an effective filing date as defined in 35 U.S.C. 100(i) that is on or after March 16, 2013; or (2) A specific reference under 35 U.S.C. 120, 121, or 365(c) to any patent or application that contains, or contained at any time, a claim to a claimed invention that has an effective filing date as defined in 35 U.S.C. 100(i) that is on or after March 16, 2013.”

1.131

Text of rule 1.131 is not included in the presentation.

THANK YOU! QUESTIONS

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