

## Topics for Open Round Table Discussion (2:15-3:45pm)

### Panelists (In alphabetical order):

Don Hajec, (1600 Director)

Jerry Lorengo (1600 Director)

Angela Sykes (Panel Moderator; 3700 Director);

Mary Till, (Legal Advisor, Office of Patent Legal Administration)

Wanda Walker (1600 Director)

Andrew Wang (3700 Director)

### AIA

- The impact of AIA and new PTO proceedings on small entities and startup companies with limited resources
- First Inventor to file: As of March 16, 2013, the US patent system will shift from the current “first to invent” system to a “first-inventor-to-file” system.
  - Invention that is commonly owned-Impact on filing applications by different inventive entities
  - Public disclosure prior to the effective filing date of the application by the inventors
  - Publication by another within one year of the filing date of the patent application
  - Public disclosure before filing date, and its effect on foreign patent rights
  - Procedural differences between applications filed before 3/16/13 vs on or after 3/16/13.
  - Effect on obviousness analysis for biotechnological process
  - FAQ: ([http://www.uspto.gov/aia\\_implementation/faqs\\_first\\_inventor.jsp](http://www.uspto.gov/aia_implementation/faqs_first_inventor.jsp))
- Claims that encompass human organisms (Section 33(a) AIA); Examples of claims that encompass human organisms.
- Derivation Proceedings; FAQ ([http://www.uspto.gov/aia\\_implementation/faqs\\_derivation\\_proceedings.jsp](http://www.uspto.gov/aia_implementation/faqs_derivation_proceedings.jsp))
- PTAB Procedures; FAQ: ([http://tampa-wip.uspto.gov/ip/boards/bpai/procedures/bpai\\_faq\\_2011.jsp](http://tampa-wip.uspto.gov/ip/boards/bpai/procedures/bpai_faq_2011.jsp))
- Updates on Third Party Submissions for biotechnology/Medical Devices Applications

### Interview

- First action interview pilot (Time extension for the pilot; its overall effectiveness; Do's and don'ts for attorneys)

- Pre-first office action interviews (Policies on applicants requests and timing)
- General tips on conducting effective interviews with examiners
- Examiner Interview - videoconference locations
- Procedures for conducting interviews in the Satellite offices.

### 101 Related

- 101 discussion in light of Prometheus– Should diagnostic claims even be filed in a patent application?
- Additional resources and guideline on Prometheus type of claims

### Obviousness

- Trend in recent board decisions on obviousness in biotech and medical devices applications

### CPC

- Training resources for outside stakeholders/users
- Availability of user searching tools
- Impact of CPC on examination quality
- Impact on Patent Prosecution Highway
- Impact on IDS filing including foreign patent references and International Search Reports

### Pilot Programs

- After Final Consideration Pilot (AFCP) (updates; time extension)
- QPIDS (Quick Path Information Disclosure Statements) (updates; time extension)
- Ombudsman pilot (procedure and response time)

### General Question

- The benefits of a more comprehensive first office action/effective examination; How can practitioners facilitate comprehensive first office action/effective examination?
- Discuss the feasibility of automatically granting a patent on a medical device if the product makes it through the Food and Drug Administration's Premarket Approval (PMA) process.