Implementation of the American Inventors Protection Act of 1999 (Public Law 106-113) and the Patent Business Goals

Hiram H. Bernstein
Senior Legal Advisor
Office of Patent Legal Administration
April 17, 2001
USPTO Web site

Go to:
www.uspto.gov

Click on:
American Inventors Protection Act
The American Inventors Protection Act was enacted November 29, 1999, as Public Law 106-113. The material presented on this web site reflects this enacted law.

The contents of the AIPA web site are organized as follows:

- **Laws, Consolidated Patent (December 14, 2000)**: Contains the most recent revisions to the Laws.
- **Rules, Consolidated Patent (December 18, 2000)**: Contains the most recent revisions to the Rules.
- **Legislation**: The full text of new legislation.
- **Changes**: Changes to Title 35.
- **Summary**: Overview of the legislation.
- **Articles**: PTO Today On-Line articles, written by Tod Preston regarding the AIPA.
- **Rule Changes**: Rule changes that have been published to implement the American Inventors Protection Act of 1999.
- **Presentations**: Training slides, Concept of Operations, Charts and other
The Eighteen-Month Publication
Provisions of the
American Inventors Protection Act of 1999

UNITED STATES PATENT AND TRADEMARK OFFICE
Eighteen-Month Publication

- Entitled “Domestic Publication of Patent Applications Published Abroad”

- 35 U.S.C. § 122(b) requires publication of applications at eighteen months from the earliest filing date claimed under title 35 eighteen-month date measured from the earliest filing date claimed under 35 U.S.C. §§ 119(a)-(d), (e), 120, 121, or 365
Eighteen-Month Publication

- Applies to applications filed on or after November 29, 2000
  - A CPA filed on/after November 29, 2000 is subject to publication
  - Filing an RCE on/after November 29, 2000 in an application filed before November 29, 2000 does not make the application subject to publication
- An international (PCT) application entering the national stage under 35 U.S.C. § 371 is subject to publication if the PCT application was filed (35 U.S.C. § 363) on or after November 29, 2000
Eighteen-Month Publication

- Also, provides, at the applicant’s request, for publication
  - of an application pending on November 29, 2000 (voluntary publication)
  - of an application earlier than at eighteen months from the earliest filing date claimed under title 35 (early publication)
Eighteen-Month Publication

- *Exceptions to eighteen-month publication*:
  - Applications no longer pending (e.g., abandoned)
    - File petition under 37 CFR 1.138(c) to expressly abandon application to avoid publication
  - Applications under secrecy order or whose disclosure would be detrimental to national security
  - Provisional applications
  - Design applications
Eighteen-Month Publication

- **Exceptions to eighteen-month publication:**
  - An applicant may request that an application not be published if
    - the invention **has not been** and **will not be** the subject of an application **filed** in another country (or under international agreement) that requires eighteen-month publication
  - Request must be made **upon filing** (required by statute)
  - See PTO form PTO/SB/35
Nonpublication Request

PTO/SB/35
Eighteen-Month Publication

- *Exceptions to eighteen-month publication:*
  - The “nonpublication” request may be rescinded at any time (see PTO form PTO/SB/36)
  - If an application is subsequently filed in another country (or under international agreement) that requires eighteen-month publication
    - the applicant must notify the USPTO within forty-five days **or the application will become abandoned**
    - application may be revived if the delay in providing notice was unintentional
Rescind Nonpublication Request

PTO/SB/36
Eighteen-Month Publication

- *Exceptions to eighteen-month publication:*
  - If corresponding foreign applications have a less extensive description than the U.S. application
    - the applicant may submit a *redacted* copy of the application for publication that eliminates subject matter not in *any* of the corresponding foreign applications
  - Such a redacted copy must be submitted within sixteen months after the earliest filing date for which a benefit is sought under title 35
Eighteen-Month Publication

- **Priority/continuity claims:**
  - 35 U.S.C. §§ 119(b) (foreign priority), 119(e) (domestic priority - provisional), and 120 (domestic continuity - nonprovisional) amended to:
    - Provide that the USPTO may set time periods within which priority/continuity claims must be filed or are waived
  - Priority/continuity claims must be timely filed to permit publication as close as possible to eighteen months from earliest claimed filing date
**Priority/continuity claims:**

The period set in 37 CFR 1.55 and 1.78 for presenting claims under 35 U.S.C. §§ 119(b), (e), 120, 121, or 365 is the later of:

- **sixteen** months from the claimed priority date, or
- **four** months from the application filing date

( cf. PCT Rule 26\textsuperscript{bis}.1(a) )

35 U.S.C. §§ 119 and 120 also permit the USPTO to accept unintentionally delayed priority/continuity claims (subject to a surcharge)
Eighteen-Month Publication

- **Priority/continuity claims:**
  - A translation is no longer required to be filed in non-English language provisional application.
  - 37 CFR 1.52(d) and 1.78(a)(5) instead require that any nonprovisional application claiming benefit of a non-English language provisional application contain a translation of the provisional application.
  - Allows filing of a translation to be deferred until a nonprovisional application claiming benefit of the non-English language provisional is actually filed.
Eighteen-Month Publication

- **Publication process:**
  - Publication will include creating a publication document (patent application publication)
  - The patent application publication will become the predominant U.S. prior art document
  - Patent application publications will be available on the USPTO’s electronic search systems (image and full text searchable)
Eighteen-Month Publication

- **Publication process:**
  - Patent application publication will be similar to a patent in format and content
    - front page with title, bibliographic data, abstract, drawing figure, and IPC/US classifications
    - specification (including claims) in a two column arrangement
  - a patent application publication will not list cited prior art
  - no Official Gazette for patent application publications
A distributed digital data processing system including a host and at least one node interconnected by a communication link. In response to a boot command, the node requests its boot image from the host over the communications link. The host then provides pointers to portions of the boot image to the node. The node then retrieves the portions of the boot image identified by the pointers. These operations are repeated until node retrieves the entire boot image. By having the host supply pointers to the boot image and the node perform the retrieval operations in response to the pointers, the host is freed to perform other operations while the node is actually performing the retrieval operations.
Eighteen-Month Publication

- **Publication process:**
  - Content based on the application at time of release to Technology Center (TC) for examination (basically “as-filed”),
    - except that preliminary amendments will not be included
  - unless applicant submits an EFS copy of the application for publication (as discussed below)
Eighteen-Month Publication

- **Publication process:**
  - The USPTO currently has an electronic record of applications “as-filed” (PACR database) created by image scanning application papers during pre-examination processing.
  - The USPTO will augment the PACR database to also contain subsequent papers/drawings necessary to create a patent application publication.

Eighteen-Month Publication

- **Publication process:**
- USPTO must require that each utility and plant application be in condition for publication when released to TC for examination
  - contains the filing fee and an executed oath/declaration
  - specification of sufficient quality for optical character recognition (OCR) conversion of image to text
  - title and abstract in compliance with 37 CFR 1.72
  - drawings acceptable for use in the patent application publication as a prior art document
    - drawings may be “acceptable” even if designated as “informal” by the applicant
  - sequence listing CRF in compliance with 37 CFR 1.821 *et seq.*
Eighteen-Month Publication

- **Publication process:**
- If applicant wants the patent application publication to reflect the application as amended during examination (or with preliminary amendments),

  the applicant must file a copy of the application (as amended) in compliance with the USPTO’s electronic filing system (EFS) in a timely manner.
Eighteen-Month Publication

- Publication process:
- The patent application publication will be based upon the EFS copy of the application if the EFS copy is filed:
  - within the later of:
    - fourteen months from the earliest claimed priority date, or
    - one month from the application’s actual filing date, or
  - before the USPTO has started publication process
Eighteen-Month Publication

- Publication process:
  - Since a confirmation number is needed to file an EFS copy
    The patent application publication will also be based upon the EFS copy if it is filed within one month of the mail date of the first Filing Receipt indicating the application’s confirmation number
Eighteen-Month Publication

- Publication process:
- The applicant must also file an EFS copy of the application:
  - for “voluntary” publication of an application pending on November 29, 2000
  - for publication of an application as redacted
  - for republication of an application
Eighteen-Month Publication

- Publication process:

- If drawings are “acceptable,” applicant may submit better quality drawings for publication:
  - with an EFS copy of the application, or
  - with a petition under 37 CFR 1.182 (and $130 fee) within the later of fourteen months from the earliest claimed priority date or one month from the actual filing date of the application

  - submit to Box PGPUB Drawings

Eighteen-Month Publication

- **Access:**
  - Applications are no longer maintained in confidence once they are published
  - USPTO will **not** provide direct physical access to a pending published application
  - USPTO will provide (for a fee) a copy of the file wrapper and content of a published application
    - The fee is $200 for the first 400 pages and $40 for each additional 100 pages
Eighteen-Month Publication

- **Access:**
  - If the patent application publication is based on a redacted copy of the application
    - the copy of the file wrapper content will also be redacted if applicant timely submits appropriately redacted copies of USPTO correspondence and applicant submissions
  - otherwise, the USPTO will provide a copy of the complete file wrapper content of the application
Eighteen-Month Publication

- *Third party submission after publication:*

- 35 U.S.C. § 122(c) provides for procedures to ensure that there is no protest or pre-issuance opposition to a published application (without express consent of applicant)
Eighteen-Month Publication

- Third party submission after publication:

- 37 CFR 1.99 permits submission of patents and printed publications by third parties

- 37 CFR 1.99 does not permit any activity that amounts to a protest or opposition by the third party
Eighteen-Month Publication

- *Third party submission after publication:*
  - 37 CFR 1.99 requires that such a submission:
    - be limited to patents and publications
    - not include any explanation of the patents, publications, or include any other information (will be deleted if included)
      - including underlining/highlighting
    - be served upon the applicant in accordance with 37 CFR 1.248
    - be limited to ten total patents or publications
Eighteen-Month Publication

- *Third party submission after publication:*
- 37 CFR 1.99 also requires that such a submission:
  - Be filed within two months of the date of publication of the application or prior to the mailing of a notice of allowance (whichever is earlier)
    - Unless the patents or publications could not have been submitted to the USPTO earlier
Prior art effect of published applications and patents under 35 U.S.C. § 102(e)

35 U.S.C. § 102(e) provides that a person shall be entitled to a patent unless the invention was described in—

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a)
Eighteen-Month Publication

Prior art effect of published applications and patents under 35 U.S.C. § 102(e)
Section 4508 provides that:

The amendment to 35 USC 102(e) shall take effect on the date that is 1 year after the date of the enactment of this Act and shall apply to all applications filed under section 111 of title 35, United States Code, on or after that date, and all applications complying with section 371 of title 35, United States Code, that resulted from international applications filed on or after that date.

The amendment to 35 USC 102(e) shall apply to any such application voluntarily published by the applicant under procedures established under this subtitle that is pending on the date that is 1 year after the date of the enactment of this Act.
Eighteen-Month Publication

- Prior art effect of published applications and patents under 35 U.S.C. § 102(e)

35 U.S.C. § 374 provides that:

The publication under the treaty defined in section 351(a) of this title, of an international application designating the United States shall confer the same rights and shall have the same effect under this title as an application for patent published under section 122(b),

except as provided in sections 102(e) and 154(d) of this title.
Eighteen-Month Publication

- *Prior art effect of published applications and patents under amended 35 U.S.C. § 102(e):*
  - 35 U.S.C. § 102(e)(1) sets forth conditions under which a published application is prior art as of its filing date
    - includes U.S. patent application publications (including voluntary publication), whether filed under 35 U.S.C. § 111(a) or resulting from a PCT application
    - includes PCT applications published by the International Bureau (IB) (by virtue of 35 U.S.C. § 374)
  - 35 U.S.C. § 102(e)(2) sets forth conditions under which a patent is prior art as of its filing date
Eighteen-Month Publication

- 35 U.S.C. § 135(b)

- 35 U.S.C. § 135(b) bars a claim not made within one year of the date an application is published containing the same (substantially same) claim
  - only if application filed after date of publication

- 35 U.S.C. § 374 equates IB publication under the PCT with publication under 35 U.S.C. § 122(b), with conditions for:
  - 35 U.S.C. § 102(e) (English language)
  - 35 U.S.C. § 154(d) (English translation)

- 35 U.S.C. § 374 contains no “in English” or national stage entry condition for 35 U.S.C. § 135(b)
Eighteen-Month Publication

- **Suspension of action (deferred examination):**
- 37 CFR 1.103(d) provides for deferral of examination for up to three (3) years from the effective filing date provided that:
  - the application is a utility or plant application in which no Office action has been issued
  - the application is in condition for publication, and a nonpublication request has not been filed (or has been rescinded)
  - the applicant requests the deferral and pays the publication fee and processing fee
Eighteen-Month Publication

- **Publication fee ($300)**
- The cost of publication required by 35 U.S.C. § 122(b) is recovered by charging a publication fee after the notice of allowance is mailed
  - If application is abandoned, no publication fee needed
- A publication fee will have to be paid at the time of the request for “voluntary” publication, early publication, or republication
  - For requests for republication, and voluntary publication, a processing fee of $130 is also required in addition to the publication fee
Eighteen-Month Publication

- *Provisional rights:*
- If an application is published, the patent includes the right to a reasonable royalty for the period between the date of publication and date of patent grant
  - Actual notice of the published application must be provided
  - Patent claims must be substantially identical to the claims in the published application
For Further Information Contact

The American Inventors Protection Act of 1999 in general-
www.uspto.gov click on American Inventors Protection Act

The Patent Business Goals rule change in general- www.uspto.gov click on PBG final rule

Electronic Filing System (EFS) - Jay Lucas (703) 308-6868
(jay.lucas@uspto.gov) www.uspto.gov click on Patents Electronic Business Center

Fees- Matthew Lee- (703) 305-8051

Invention Promotion Companies/Complaints- Dick Apley (703) 306-5568

PAIR (Patent Application Information Retrieval)- PEBC helpdesk (703) 305-3028
www.uspto.gov click on Patents Electronic Business Center
For Further Information Contact

Each rule notice has more detailed contact information - Robert Spar- (703) 308-5107

Patent Business Goals (PBG) - Hiram Bernstein (703) 305-8713
Patent Term Adjustment (PTA)- Karin Tyson (703) 306-3159, Robert Clarke (703) 305-9177
Eighteen-Month Publication - Robert Bahr - (703) 305-8850
Provisional Applications- Fred Silverberg (703) 305-8986
Reexamination- Jerry Dost (703) 305-8610 or Ken Schor (703) 308-6710
Reissue- Joe Narcavage (703) 305-1795
Request for Continued Examination (RCE)- Gena Jones (703) 306-5586
Sections 102(e), 102(g) and/or 103(c) - Robert Clarke 9703) 305-9177 or Jeanne Clark (703) 306-5603
Thank You