



One Firm Worldwide<sup>SM</sup>



# America Invents Act of 2011

## Part 1: Impact on Litigation Strategy

## Part 2: Strategic Considerations of the FTF Transition

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# Part 1: Impact on Litigation Strategy

- Post grant review proceedings
- Prior art submissions
- Supplemental examination
- Joinder
- Expanded prior commercial use defense
- Best mode defense

# Post Grant Review – Some History

**Ex Parte Reexamination  
(1980)**  
Quality Check  
Requester can't participate

**Inter Partes Reexamination  
(November, 1999)**  
Allowed requester to  
participate...but still limited

**Post Grant Procedures  
Take Effect  
(September, 2012)**

**1980s**

**1990s**

**2000s**

**2010s**

**Federal Circuit Court of Appeals  
(1982)**  
Exclusive jurisdiction over patent  
appeals

**America Invents Act  
(September, 2011)**  
Change to First to File  
Added new post grant  
proceedings

# What are the new procedures?

- *Post Grant Review*
  - Only during the first 9 months from grant
  - Applies to first-to-file patents (March, 2013) and certain business methods
  - Broad validity challenge
- *Inter Partes Review*
  - After the first 9 months from grant
  - Applies to all patents
  - Limited validity challenge

# What are the new procedures?

- *Both Post Grant and Inter Partes Review*
  - Must identify the real party – no anonymity
  - Estoppel – raised or could have raised
  - Discovery permitted
  - Hearing before three Administrative Law Judges
  - 12-18 months to completion
  - Both parties appeal directly to CAFC

# Ex parte reexamination (problems)

- Petitioner not involved after request; no appeal
- High percentage of claims allowed, at least in amended form (90%)
- Patent comes out stronger
- Cannot be settled
- Additional claims
- Examiner interviews

# Ex parte reexamination (benefits)

- Can file anonymously
- May result in cancelation or amendment
- May result in stay of litigation

# Inter partes review

- Similarities with inter partes reexamination:
  - Limited to 102/103 on patents or publications
  - Similar estoppel provision...but timing is different
  - Can't broaden claims
- Changes from inter partes reexamination:
  - Can't file until 9 months after grant or PGR done
    - Bill introduced to eliminate 9 month gap
  - Patent owner can file preliminary response
  - Applies to all issued patents

# Inter partes review (cont'd)

## Changes from inter partes reexamination (cont'd):

- Higher threshold: “reasonable likelihood that the petitioner would prevail” v. “substantial new question of patentability”
- No review if petitioner has filed a civil action challenging validity or if more than one year has passed since the petitioner was served with a complaint alleging infringement
- PTO has authority to stay, transfer, consolidate, or terminate a related interference, reissue, or ex parte reexamination

## Inter partes review (cont'd)

### Changes from inter partes reexamination (cont'd):

- Allows limited discovery: depositions of witnesses on their written testimony and what is otherwise necessary in interests of justice
- Gives new Patent Trial and Appeal Board (PTAB), not the Central Reexamination Unit, the authority to conduct inter partes reviews
- Parties can settle and terminate
- Supposed to be completed within 12 months from initiation (+6 months if needed)

## Inter partes review (cont'd)

### Potential benefits to litigation strategy:

- Higher likelihood of stay pending review?
- Better forum for litigating validity defenses
  - But how good will the PTAB be?
- Lower burden of proof; broader claim construction
- Beware of one year deadline from complaint

## Inter partes review (cont'd)

### Potential negatives to litigation strategy:

- Increased expense
- Estoppel effect – particularly the timing issue
- May delay resolution of dispute
- Must identify the real party in interest
- Claims can be modified

# Post-grant review

## Similarities with inter partes review:

- Estoppel provision
- Allows a preliminary response by the patent owner to explain why review should not go forward
- Cannot be instituted if the petitioner has filed a civil action challenging validity
- Handled by the PTAB with appeals to the CAFC
- May be settled

# Post-grant review (cont'd)

## Differences from inter partes review:

- Timing:
  - *Post-grant review:* Within 9 months of issuance
  - *Inter-partes review:* After 9 months or PGR done
- Available arguments:
  - *Post-grant review:* Any ground that can be raised under § 282(b)(2)-(3) (101, 102/103, 112)
  - *Inter-partes review:* Prior-art patents and printed publications

# Post-grant review (cont'd)

## Differences from inter partes review (cont'd):

- Threshold for institution
  - *Post-grant review*: “information presented in the petition, if not rebutted, would demonstrate that it is more likely than not that at least 1 of the claims challenged in the petition is unpatentable”
  - *Inter partes review*: “reasonable likelihood that the requester would prevail”
- Effective date: PGR only applies to FTF patents

## Post-grant review (cont'd)

- Less likely to be used after litigation is filed, because post-grant review must be requested within 9 months of patent issuance
- Will this become similar to EPO opposition practice?
  - Monitor competitor patents?

## Special PGRs for CBMs – Section 18

- A “*covered business method patent*” is a “patent that claims a method or corresponding apparatus for performing data processing operations or other operations utilized in the practice, administration or management of a financial product or service, ***except that the term shall not include patents for technological inventions***”
- Same rules as PGR, but applies now to all CBMs
- But...petitioner must have been sued or charged with infringement
- Expires eight years after enactment

# Section 18 PGR – Restrictions

## What are “technological inventions”?

- Proposed rules (adopted in the final rules): this will be decided on a case-by-case basis
- Considerations:
  - Whether the claimed subject matter as a whole: (1) recites a technological feature that is novel and unobvious over the prior art; and (2) solves a technical problem using a technical solution
  - Class 705 are likely presumed to be CBMs

# Section 18 PGR - Practice Tips

- If thinking about filing such a petition:
  - May want to wait to see how the first set of petitions are treated
    - How are they interpreting “Technological Inventions”?
    - Are they including all, some, or most e-commerce type patents?
- If you are on the receiving end:
  - See if can challenge standing (DJ standard) in the PO’s preliminary response
  - Accordingly, if sending out a threat letter, word it without a threat of infringement (invitation to license)

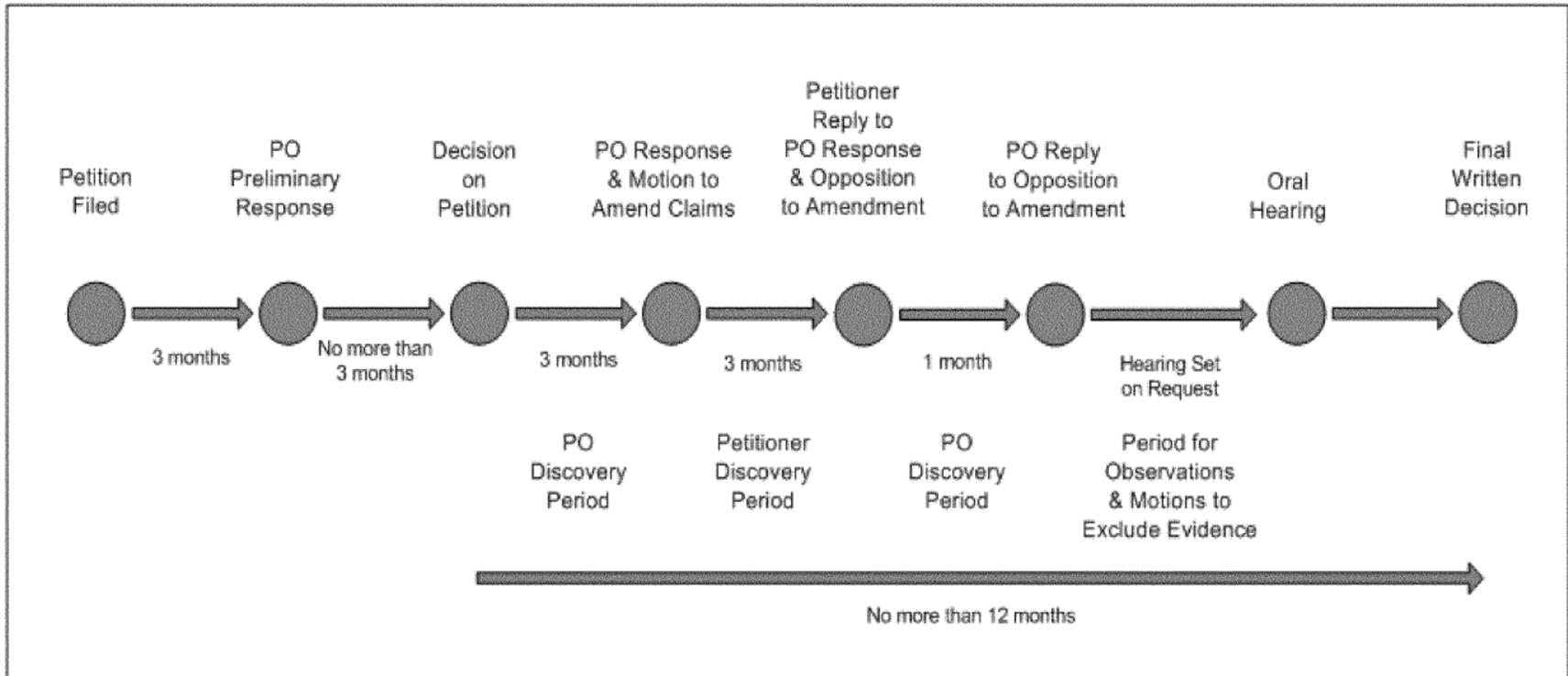
# Section 18 Practice Tips (continued)

- When drafting Business Method type applications:
  - How does the spec characterize the invention
  - Place items in spec and claims to give arguments that this is not a Covered Business Method
    - Point to limitations in the claims that refer to a technological structure
    - Lowry claims (data structure claims)

## Section 18 PGR – Advantages over IPR

- Review based on more statutory provisions
- Can request a stay of any corresponding litigation
- File an interlocutory appeal to the Federal Circuit if the district court denies the request for a stay
- Estoppel is less restrictive

# Post Grant Review - Timeline



# Pre-Issuance Submissions

- Applies to any application filed before or after 9/2012
  - Does not apply to issued patents, reissues or reexams
- Any third party can submit
- Limited to published documents
  - Patents, published applications, printed publications
  - Submitted documents need not qualify as prior art
- Considered with next office action
- Filed similar to an IDS and can use PTO/SB/429
  - Must include a concise summary of the art and relevance
    - Claim charts permitted, but not proposed rejections
  - Relevant portions of foreign language documents should include an English translation

# Pre-Issuance Submissions - Deadlines

- Must be submitted by the later of
  - Six months after the date of first publication
  - Or... date of the first rejection of any claim
  - And...before notice of allowance
- No extensions possible
  - Late submissions will not be entered or considered

# Supplemental examination

- A patent owner can request supplemental examination to consider, reconsider, or correct information believed to be relevant to the patent
- If the patent owner's request raises "a substantial new question of patentability," a reexamination similar to existing *ex parte* reexamination is instituted
- Can raise any issues, not just 102/103 on patents/publications
- Can prevent a later inequitable conduct charge

## Expanded prior commercial use defense

- “Prior user” defense under 35 U.S.C. § 273 is expanded to patents of any subject matter; previously limited to business method patents
- “University exception” included, preventing assertion of this defense against patents on inventions which, at the time the invention was “made,” belonged to universities and technology transfer organizations
- Applies to patents issued on or after date of enactment of AIA

# Limitations on joinder of parties

- New 35 U.S.C. § 299 modifies the requirements for joinder under Fed. R. Civ. P. 20(a)(2):
  - Plaintiff must show that questions of fact common to all defendants will arise in the action; common questions of law alone are insufficient;
  - An allegation that all defendants infringe the same patent is no longer sufficient to justify suit against multiple unrelated defendants
- Accused infringers may waive the requirement
- Joinder section is effective for civil actions commenced on or after September 16, 2011

## No invalidity for failure to disclose best mode

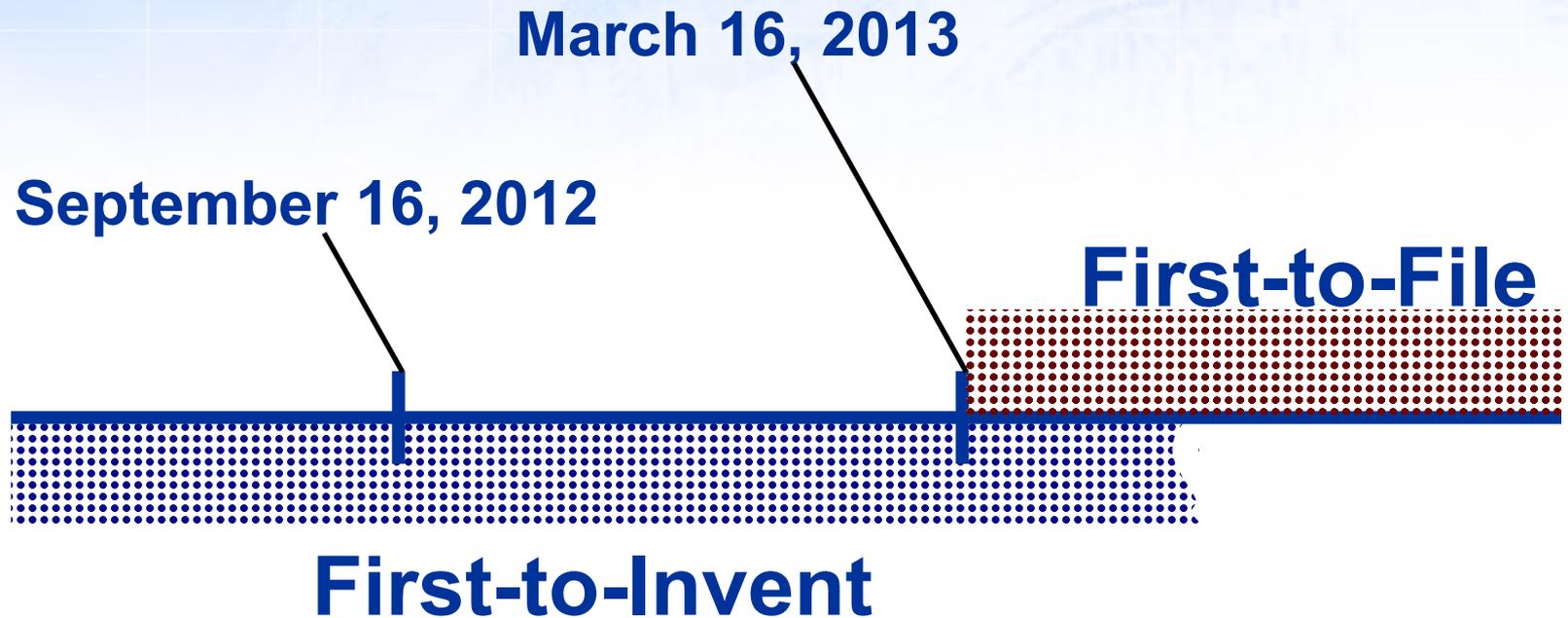
- 35 U.S.C. § 282 is amended to carve out the failure to disclose the best mode from the other § 112-based litigation defenses
- The Act does not eliminate the best-mode requirement from § 112 for patent applications
- As a result, a patent applicant must disclose the best mode to get a patent but seemingly cannot be penalized for failing to do so once a patent is issued
- No best mode attack under PGR

# End of Part 1

## Part 2: Transition to FTF System

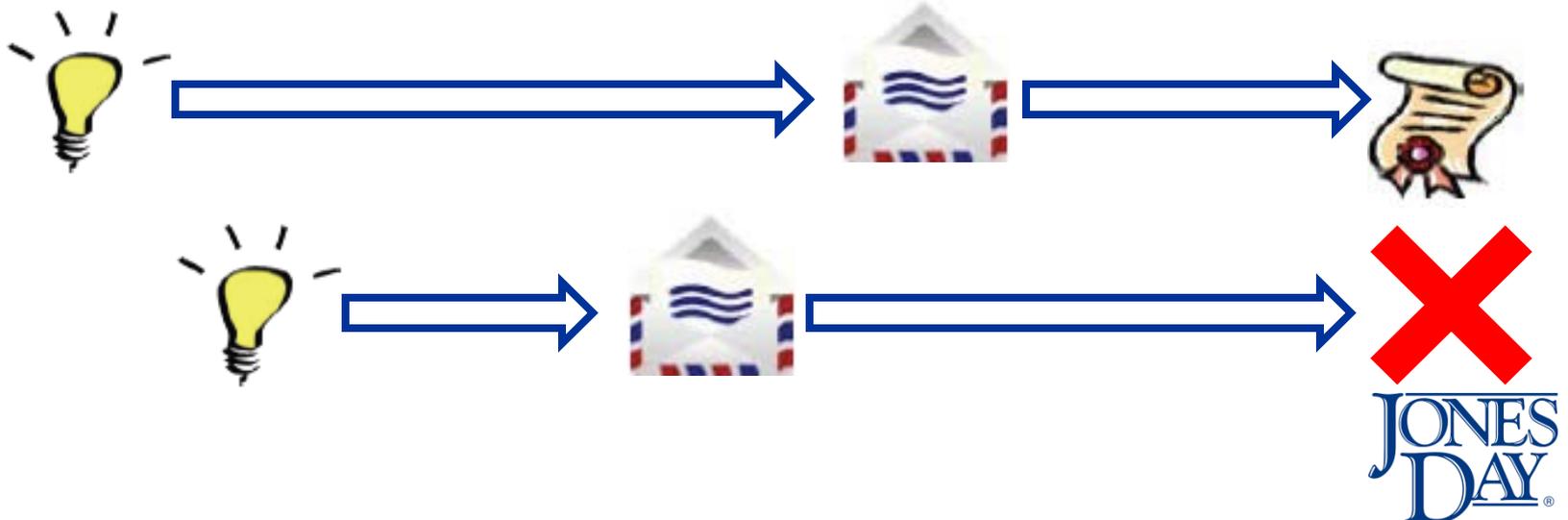
- The Move From FTI to FTF
- Historical Perspective – the FTI System in the US
- Highlights of the New FTF System
- FTI or FTF – Practice Tips

# The Move From FTI to FTF System in the US



# Historical Perspective – the FTI System

- First-to-Invent in the US means that an inventor is entitled to a patent if, subject to some conditions, he invented first:
  - filing date not material; but
  - applicant/patentee must prove invention date



# Historical Perspective (cont'd)

## Distinguishing Characteristics of FTI

- many pertinent facts about a patent application confidential or not publicly known
- in ***prosecution***, applicant could “swear behind” a reference to overcome it as prior art
- in ***litigation***, a major part of nearly all US patent infringement actions included:
  - determining the invention date, which can be different from claim to claim in a patent
  - establishing what is prior art

# First-to-File: Purpose

- (1) Converts the United States patent system from a “first to invent” system to a “first inventor to file” system;
- (2) Treats U.S. patents and U.S. patent application publications as prior art as of their earliest effective filing date, regardless of whether the earliest effective filing date is based upon an application filed in the U.S. or in another country; (so long *Hilmer*)
- (3) Eliminates the requirement that a prior public use or sale be “in this country” to be a prior art activity; and
- (4) Treats commonly owned or joint research agreement patents and patent application publications as being by the same inventive entity for purposes of 35 U.S.C. 102, as well as 35 U.S.C. 103.

## First-to-File: Timeline

- First-Inventor-to-File Proposed Rules (77 Fed. Reg. 43742, July 26, 2012)
- First-Inventor-to-File Proposed Examination Guidelines (77 Fed. Reg. 43759, July 26, 2012)
- First-Inventor-to-File Roundtable at the U.S. Patent and Trademark Office (September 6, 2012)
- Comments Due: October 5, 2012
- Effective Date: March 16, 2013

## 35 U.S.C. 102(a)(1): Prior Art

- Precludes a patent if a claimed invention was, before the effective filing date of the claimed invention:
  - Patented;
  - Described in a Printed Publication;
  - In Public Use (anywhere);
  - On Sale (anywhere); or
  - Otherwise Available to the Public
- Generally corresponds to the categories of prior art in pre-AIA 35 U.S.C. 102(a) and 35 U.S.C. 102(b)
- Do “secret sales” or non-public uses count as prior art under the AIA?

## 35 U.S.C. 102(b): Exceptions

- Provides that certain “disclosures” shall not be prior art
- Disclosure is understood to be a generic term intended to encompass the documents and activities enumerated in AIA 35 U.S.C. 102(a)

# Grace Period Inventor and Non-inventor Disclosure Exception

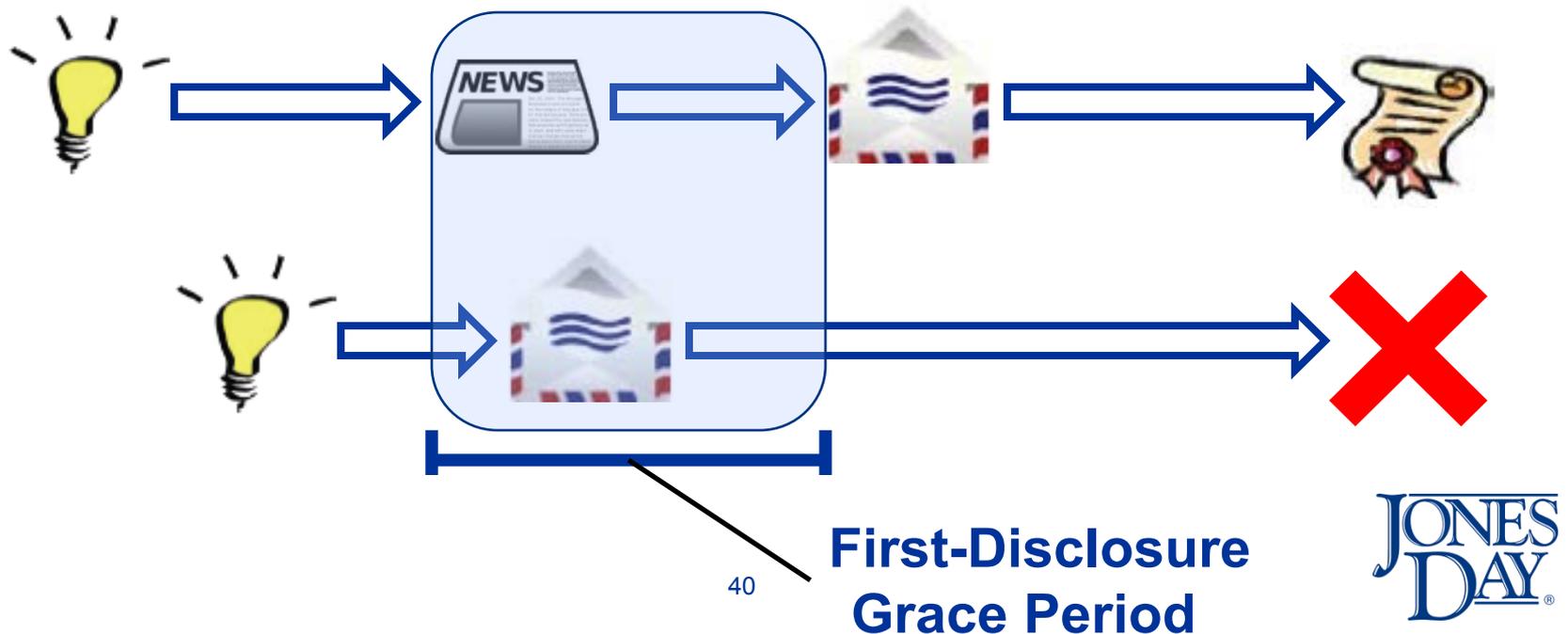
- Grace period exceptions under 35 U.S.C. 102(b)(1) for prior art under 35 U.S.C. 102(a)(1)
- 35 U.S.C. 102(b)(1)(A):
  - A disclosure made one year or less before the effective filing date of the claimed invention shall not be prior art under 35 U.S.C. 102(a)(1) if:
    - The disclosure was made by:
      - the inventor or joint inventor; or
      - another who obtained the subject matter directly or indirectly from the inventor or joint inventor.

# Grace Period Intervening Disclosure Exception

- Grace period exceptions under 35 U.S.C. 102(b)(1) for prior art under 35 U.S.C. 102(a)(1)
- 35 U.S.C. 102(b)(1)(B):
  - A disclosure made one year or less before the effective filing date of the claimed invention shall not be prior art under 35 U.S.C. 102(a)(1) if:
    - The subject matter disclosed was, before such disclosure, publicly disclosed by:
      - the inventor or joint inventor; or
      - another who obtained the subject matter directly or indirectly from the inventor or joint inventor.

# WARNING: Reliance on disclosure is risky

- The following diagram illustrates the filing by another within the grace period exception under 102(b)(2)(B) following publication by the first inventor
- The PTO is taking a very narrow view of this exception – only applies where the second disclosure is identical or includes only trivial differences



## 35 U.S.C. 102(a)(2): Prior Art

- Precludes a patent to a different inventive entity if a claimed invention was described in a:
  - U.S. Patent;
  - U.S. Patent Application Publication; or
  - WIPO PCT Application Publication that was effectively filed before the effective filing date of the claimed invention.
- Generally corresponds to the categories of prior art in pre-AIA 35 U.S.C. 102(e)

# Non-inventor Disclosure Exception

- Exceptions under 35 U.S.C. 102(b)(2) for prior art under 35 U.S.C. 102(a)(2)
- 35 U.S.C. 102(b)(2)(A):
  - A disclosure in an application or patent shall not be prior art under 35 U.S.C. 102(a)(2) if:
    - the disclosure was made by another who obtained the subject matter directly or indirectly from the inventor or joint inventor

## Intervening Disclosures Exception

- Exceptions under 35 U.S.C. 102(b)(2) for prior art under 35 U.S.C. 102(a)(2)
- Exception 2 (35 U.S.C. 102(b)(2)(B)):
  - A disclosure in an application or patent shall not be prior art under 35 U.S.C. 102(a)(2) if:
    - the subject matter disclosed was, before such subject matter was effectively filed, publicly disclosed by:
      - the inventor or joint inventor; or
      - another who obtained the subject matter directly or indirectly from the inventor or joint inventor

# Commonly Owned Disclosure Exception

- Exceptions under 35 U.S.C. 102(b)(2) for prior art under 35 U.S.C. 102(a)(2)
- 35 U.S.C. 102(b)(2)(C):
  - A disclosure made in an application or patent shall not be prior art under 35 U.S.C. 102(a)(2) if:
    - the subject matter and the claimed invention were commonly owned or subject to an obligation of assignment to the same person not later than the effective filing date of the claimed invention

## First-to-File: Effective Date

- AIA's FITF provisions apply to any application or patent that contains, or contained at any time, a claimed invention having an effective filing date that is on or after March 16, 2013; or
- AIA's FITF provisions apply to any application or patent that contains, or contained at any time, a specific reference under 35 U.S.C. 120, 121, or 365(c) to an application which contains, or contained at any time, a claimed invention having an effective filing date on or after March 16, 2013.

## Proposed Rule: Affidavits or Declarations

- Proposed 37 C.F.R. 1.130: Applicants may submit affidavits or declarations showing that:
  - disclosure upon which a rejection is based was by the inventor or joint inventor, or by another who obtained the subject matter disclosed directly or indirectly from the inventor or joint inventor; or
  - there was a prior public disclosure of the subject matter by the inventor or joint inventor, or by another who obtained the subject matter disclosed directly or indirectly from the inventor or joint inventor

## Proposed Rule: Required Statements

- Proposed rules 1.55(a)(4), 1.78(a)(3), and 1.78(c)(2): For nonprovisional applications that are:
  - Filed on or after March 16, 2013; and
  - Claim priority/benefit of a foreign, provisional, or nonprovisional application filed prior to March 16, 2013:
    - Applicant must indicate if the application:
      - contains, or contained at any time, a claim having an effective filing date on or after March 16, 2013; or
      - discloses subject matter not also disclosed in the prior foreign, provisional, or nonprovisional application

# First-to-File: Practice Tips

- File a patent application first, do not publish first
- If given the choice in March 2013 to file a patent application before or after March 16, 2013, what factors should an Applicant consider?

First, the world of prior art that can be used to reject a pre-FTF application is smaller than a later filing. In addition, public use and on sale activity outside the United States are not counted as prior art.

Second, you can “swear behind” certain prior art in a pre-FTF application, but you lose that ability for filings after March 16, 2013.

Third, a pre-FTF application will not be subject to a post grant review proceeding.

# First-to-File: Practice Tips

- Why choose to wait until after March 16, 2013 to file?
- (1) Likely demise of *Metallizing Engineering* forfeiture
- (2) Expanded CREATE Act and common ownership under 102(c)
- (3) Avoid dealing with the alphabet soup of 102 issues

# First-to-File: Practice Tips

- Maintaining lab notebooks or other invention records is still important due to derivation proceedings
- Consider filing multiple provisional applications to establish priority dates
- Consider filing FTI and FTF applications on the same invention to get benefits of both systems – but of course with different claims
- Avoid mixed priority applications after the transition
  - Subject to FTF prior art and PGRs
  - Cannot antedate a prior patent or publication

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# Appendix 1 – PTAB Rules

# Rules of Practice for Trials Before the Patent Trial and Appeal Board

## Constitution and Duties of the Board

- Board members include Director, Deputy Director, Commissioner for Patents, Commissioner for Trademarks, and administrative patent judges.
- Duties of Board are to:
  - (1) review adverse decisions of examiners upon an application for a patent;
  - (2) review appeals of reexaminations;
  - (3) conduct derivation proceedings; and
  - (4) conduct *inter partes* reviews and post-grant reviews (including business method patent review).
- Each appeal, derivation proceeding, post-grant review and *inter partes* review must be heard by at least 3 members of the Board.

# Rules of Practice for Trials Before the Patent Trial and Appeal Board

## Fees (§ 42.15)

- Petition for *Inter Partes* Review:

- (1) 1 to 20 claims -- \$27,200
- (2) Each claim in excess of 20 -- \$600

- Petition of Post Grant Review:

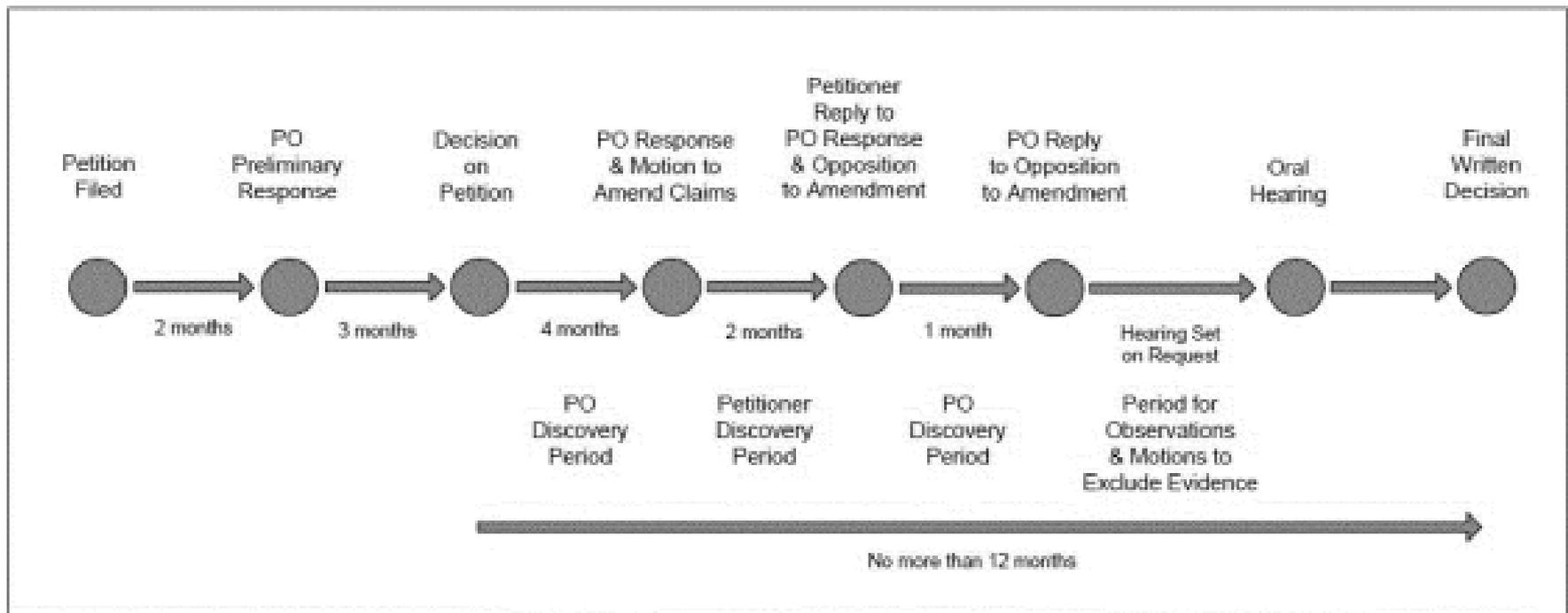
- (1) 1 to 20 claims -- \$35,800
- (2) Each claim in excess of 20 -- \$800

- Petition for Derivation Proceeding:

\$400

# Rules of Practice for Trials Before the Patent Trial and Appeal Board

## Representative Timeline



# Rules of Practice for Trials Before the Patent Trial and Appeal Board

## General Provisions

- As a rule of construction, all Board rules must be construed to achieve the just, speedy and inexpensive resolution of Board proceedings. (§ 42.1(b))
- Default evidentiary standard for each issue in a Board proceeding is a preponderance of the evidence. (§ 42.1(d))
- Final decision of Board must be issued not less than 1 year after the institution of the review, extendable for good cause shown. (35 U.S.C. 326(a)(11))
- *Ex parte* communications may result in sanctions against the initiating party. Prohibition includes communicating with any member of a panel without including the opposing party in the communications. (§ 42.5(d))

# Rules of Practice for Trials Before the Patent Trial and Appeal Board

## General Briefing Provisions

- Papers filed with Board required to meet standards similar to those required in patent prosecution under 37 C.F.R. § 1.52(a), and in filings at the Federal Circuit under Fed. R. App. P. 32.
- Documents must be filed electronically. Filing by other means requires a motion explaining the need to file in a non-electronic format. (§ 42.6(b))
- Page Limits on petitions, motions, oppositions and replies (§ 42.24(a)) :
  - Petitions requesting *inter partes* review and derivation proceedings - 60 page limit
  - Petitions requesting post-grant review and covered business method patents - 80 page limit
  - Motions - 15 page limit
  - Oppositions – page limits for oppositions are the same as those for corresponding petitions or motions.
  - Replies to patent owner responses to petitions – 15 page limit
  - Replies to motions -- 5 page limit

# Rules of Practice for Trials Before the Patent Trial and Appeal Board

## Mandatory Notice Provisions

- Certain mandatory notices would be required, including identification of the real parties in interest, related matters, lead and back-up counsel, and service information. (§ 42.8)
- Examples of related matters include every application and patent claiming, or which may claim, the benefit of the priority of the filing date of the parties involved patent or application, as well as any *ex parte* and *inter partes* reexaminations for an involved patent.
- Board may require designation of lead counsel. Should also designate back-up counsel who can conduct business on behalf of the lead counsel. (§ 42.10(a))

# Rules of Practice for Trials Before the Patent Trial and Appeal Board

## Petition and Motion Practice

- Relief, other than a petition to institute a trial, must be in the form of a motion. (§ 42.20)
- Motions will not be entered absent Board authorization. (§ 42.20(b)) Generally, the Board expects that authorization would follow the current Board practice where a conference call would be required before an opposed motion is filed.
- Each petition or motion must be filed as a separate paper and must include: (1) a statement of the precise relief requested; and (2) a full statement of the reasons of the relief requested, including a detailed explanation of the significance of the evidence including material facts, and the governing law, rules, and precedent. (§ 42.22(a))
- Each petition or motion must include a statement of material facts with each material fact set forth as a separately numbered paragraph with specific citations to the record.

# Rules of Practice for Trials Before the Patent Trial and Appeal Board

## Testimony and Production

- **Limited Discovery**: The burden of justifying discovery in Board proceedings lies with the party seeking discovery.
- **Routine Discovery**: The proposed rules provide for the routine discovery of exhibits cited in a paper or testimony and provide for cross examination of affidavit testimony without the need to request Board authorization.
- **Inconsistent Positions**: Parties are required to provide information that is inconsistent with a position advanced by the patent owner or petitioner during the course of the proceeding.
  - This rule does not override legally-recognized privileges such as attorney-client or attorney work product.

# Rules of Practice for Trials Before the Patent Trial and Appeal Board

## Testimony and Production (cont.)

- Additional Discovery - The parties may agree to additional discovery among themselves. Any additional discovery not agreed upon by the parties must be approved by the Board.
  - Inter Partes Reviews and Derivation Proceedings – Additional discovery granted upon a showing that the additional discovery sought is in the interests of justice. This standard places an affirmative burden on the party seeking discovery to show how the proposed discovery would be productive. The moving party would be required to show that it was fully diligent in seeking discovery and that there is no undue prejudice to the non-moving party.
  - Post-Grant Proceedings -- Additional discovery in post grant proceedings and covered business method patent reviews is granted upon a showing of good cause. To show good cause a party would be required to make a particular and specific demonstration of fact. This is a slightly lower standard than the interests of justice standard.<sup>61</sup>

# Rules of Practice for Trials Before the Patent Trial and Appeal Board

## Testimony and Production (cont.)

- Compelling Testimony - A party seeking a subpoena to compel testimony must first obtain Board authorization. (Proposed § 42.52)
- Direct testimony to be generally provided in the form of an affidavit. (Proposed § 42.53)
- Cross-examination testimony and redirect testimony to be generally provided in the form of a deposition transcript.
- Live testimony may be authorized or required by the Board if the nature of the testimony makes direct observation of witness demeanor necessary or desirable. (Proposed § 42.53)

# Rules of Practice for Trials Before the Patent Trial and Appeal Board

## Protective Orders

- **Board may, for good cause, issue a protective order:**
  - (1) **Forbidding disclosure or discovery;**
  - (2) **Specifying terms, including time and place, for disclosure or discovery;**
  - (3) **Prescribing a discovery method other than the one selected by the party seeking discovery;**
  - (4) **Forbidding inquiry into certain matters, or limiting the scope of disclosure or discovery to certain matters;**
  - (5) **Designating the persons who may be present while the discovery is conducted;**
  - (6) **Requiring that a deposition be sealed and opened only by order of the Board;**
  - (7) **Requiring that a trade secret or other confidential research, development, or commercial information not be revealed or be revealed only in a specific way; and/or**
  - (8) **Requiring that the parties simultaneously file specified documents or information in sealed envelopes, to be opened as the Board directs.**

# Rules of Practice for Trials Before the Patent Trial and Appeal Board

## Oral Argument

- A party may request oral argument on an issue raised in a paper. (§ 42.70)
- Federal Rules of Evidence generally apply. (§ 42.62)
- All evidence must be filed in the form of an exhibit, including affidavits, deposition transcripts and documents.

## Termination/Settlement

- A trial may be terminated upon joint request of the petitioner and the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed. (§ 42.72)
- The Board is not a party to a settlement agreement and may take any necessary action, including determination of patentability notwithstanding a settlement. The Board may proceed to a final written decision even if no petitioner remains in the proceeding. (§ 42.74)

# Rules of Practice for Trials Before the Patent Trial and Appeal Board

## Estoppel (§ 42.73(d))

- Patent Owner – A patent owner whose claim is canceled is precluded from taking action inconsistent with the adverse judgment, including in any patent:
  - (1) A claim that is not patentably distinct from a finally refused or canceled claim; or
  - (2) An amendment of a specification or of a drawing that was denied during the trial proceeding, but this provision does not apply to an application or patent that has a different written description.
- Petitioner -- The petitioner (other than in a derivation proceeding) is estopped in the Office from taking an action that is inconsistent with a judgment as to any ground that the petitioner could have raised during the trial. Does not apply to a petitioner who has settled.

# Rules of Practice for Trials Before the Patent Trial and Appeal Board

## Appeal of Board Decisions

- Board decisions may be appealed only to the U.S. Court of Appeals for the Federal Circuit
- Provides for judicial review of the final decisions of the Board in *inter partes* reviews, post-grant reviews, covered business method patent reviews, and derivation proceedings.
- Also extends to any final decision in an interference commenced before the effective date.

# Appendix 2 – Inventor Oath or Declaration

# Inventor's Oath or Declaration: Effective Date 09/16/2012

- The new procedures apply to any application filed under 35 U.S.C. 111(a) or 363 on or after 09/16/2012
- This includes original applications, CONs, DIVs, CIPs and PCTs that are filed on or after 09/16/2012 with priority filing dates before 09/16/2012

# Inventor's Oath or Declaration: Who, What & When to File

- Who: the Applicant
- What:
  - Declarations *or* Substitute Statements
  - Assignment including Declaration
  - Application Data Sheet
- When: may be postponed until responding to Notice of Allowability

# Inventor's Oath or Declaration: The Applicant

- Rule 42: Applicant for Patent
  - The word “applicant” ...refers to the inventor or all of the joint inventors, or to the person applying for a patent as provided in Rules 43, 45 or 46
  - 43 legal rep./45 another joint inventor/46 assignee or holder of proprietary interest

# Inventor's Oath or Declaration: Rule 63

- New form PTO/AIA/01
- Each form names only one inventor
- Respective separate forms for joint inventors
- Must be accompanied by application data sheet  
ADS

# Inventor's Oath or Declaration: Substitute Statements, Rule 64

- New form PTO/AIA/02
- In lieu of declaration for inventor who is deceased, incapacitated, refuses, or cannot be found
- Rule 43: legal rep.
- Rule 45: another joint inventor
- Rule 46: assignee or holder of proprietary interest

# Inventor's Oath or Declaration: No ADS ?

- ADS is required for all priority claims
- If not, new declaration form PTO/AIA/08, with supplemental sheets at PTO/AIA/10, is available to list all of the joint inventors in the declaration instead of in an ADS

# Inventor's Oath or Declaration: Other Situations

- New declaration forms are also provided for Design, Plant, and Reissue applications, and are likewise simplified relative to the FTI forms

# Inventor's Oath or Declaration: When to File

- Rule 53(f)(3)(i) & (ii): If the application has an ADS listing the inventors with residence and mailing addresses, then the filing of the declarations or substitute statements may be postponed until the expiration of the time period set in a Notice of Allowability

# Inventor's Oath or Declaration: Correcting Inventorship

- 35 U.S.C. 115(h)(1): “Any person making a statement under this section may withdraw, replace, or otherwise correct the statement at any time.”
- Rule 48: submit a new ADS, with a declaration or substitute statement regarding added inventor

# Inventor's Oath or Declaration: Combined Assignment & Declaration

- The declaration and the substitute statement provide the legal name of the applicant, identify the application, and include statements of inventorship and authorization to file
- Rule 63(e)(1)(i): This information can be provided in an Assignment instead of a declaration or substitute statement
- Jones Day form is available

# Inventor's Oath or Declaration: Practice Tips

- The new declaration does not include a statement that the inventor has reviewed and understands the application and is aware of the duty of disclosure
- Rule 63(c): A person may not execute a declaration unless...
- Client needs a written reminder of 63(c) and duty of disclosure