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Submitting Comments on AIA

**Question C1**: If I would like to submit comments on the Notices of Proposed Rule Making that the Office will be issuing, but cannot finish my comments by the due date, may I have an extension to submit them?

**Answer C1**: Due to the tight enactment time frames of the Leahy-Smith America Invents Act and the rule making process, the Office does not anticipate being able to accommodate extension requests to submit comments.

**Question C2**: Do I have to wait for a Notice of Proposed Rule Making to comment on a specific provision of the America Invents Act?

**Answer C2**: No. The Office encourages you to submit your comments to aia_implementation@uspto.gov and requests that your subject line reference the topic or AIA provision(s) that your comments address. Given the tight implementation time frames resulting from the Leahy-Smith America Invents Act, preliminary input from our stakeholders and the public on implementation of the key provisions would facilitate our review process.

**Question C3**: I already submitted comments through the aia_implementation@uspto.gov email address. May I also submit comments in response to a Notice of Proposed Rule Making on the same topic(s)?

**Answer C3**: Yes. Comments submitted through the aia_implementation@uspto.gov email address are being considered before the Office issues a Notice of Proposed Rule Making (NPRM). Timely filed comments responding to a NPRM should address what is promulgated in the proposed rules. These comments should be submitted to the email address designated in the NPRM.

Best Mode

**Question BM1**: What is the effective date for the Best Mode provision in the AIA?

**Answer BM1**: The effective date for the Best Mode provision in the AIA is September 16, 2011.

**Question BM2**: Does AIA’s amendment to 35 U.S.C. 282(a)(3) impact current patent examination practice regarding evaluation of an application for compliance with the best mode requirement of 35 U.S.C. 112?

**Answer BM2**: No. As this change is applicable only in patent validity or infringement proceedings, it does not change current patent examination practices set forth in MPEP § 2165.

**Question BM3**: What is the impact of AIA’s amendment to 35 U.S.C. 282(a)(3) concerning Best Mode?

**Answer BM3**: The failure to disclose the best mode shall no longer be a basis, in patent validity or infringement proceedings, on which any claim of a patent may be canceled or held invalid or otherwise unenforceable. As stated above, this new practice does not affect the patent examination practice.

Derivation Proceedings
Question D1: What is a Derivation proceeding?

Answer D1: A petitioner must claim the same or substantially the same invention as the earlier application’s claimed invention. The petition must be supported by substantial evidence that the earlier claimed invention was derived from petitioner, and filed without authorization.

Question D2: What is the effective date of the Derivation provision?

Answer D2: The effective date of the Derivation provision is September 16, 2012.

Question D3: Who may file a petition for a Derivation proceeding and when should the petitioner file?

Answer D3: An applicant for patent may file a petition for a derivation proceeding. The petition must be filed within one year of first publication of a claim to an invention that is the same or substantially the same as the earlier application’s claim to the invention.

Fees

Question FEE1: On what date will I have to begin paying the 15% increase on patent fees?

Answer FEE1: The 15% increase in fee rates will become effective at 12:00 a.m. on Monday, September 26, 2011.

Question FEE2: I would like to ensure that I am paying the proper amount. How do I determine the new fee rates after applying the 15% increase?

Answer FEE2: The specific fees that will be increased by 15% are listed in the table below. The entire updated fee schedule can be found at [http://www.uspto.gov/about/offices/cfo/finance/fees.jsp](http://www.uspto.gov/about/offices/cfo/finance/fees.jsp).

Question FEE3: Are there any patent fees that will not be increasing by 15%?

Answer FEE3: Yes. Fees such as international stage PCT fees, certain petition fees, enrollment fees, and service fees will not be increasing by 15%.

Question FEE4: If I meet the micro entity of the AIA, will I be able to pay a micro entity fee beginning on the date of enactment – September 16, 2011?

Answer FEE4: No. The AIA does not permit the USPTO to apply the 75% micro entity fee discount until the micro entity fee for a specific item is set or adjusted using the fee setting authority provided in section 10 of the Act.

Question FEE: When will the USPTO set or adjust fees using the fee setting authority outlined in section 10 of the Act?

Answer FEE5: The USPTO has begun planning for resetting fees using the section 10 authority that is effective on the date of enactment. As our plan develops, more information will be made available.

Question FEE6: How much is the fee for prioritized examination and when will it be effective?

Answer FEE6: The new fee for prioritized examination will be effective at 12:00 a.m. on Monday, September 26, 2011. The fee rates for large and small entities are listed below. Like all fees, the USPTO is not authorized to apply a micro entity discount to the prioritized exam fee without setting the fee using the section 10 fee setting process.

<table>
<thead>
<tr>
<th>CFR section</th>
<th>Fee Code</th>
<th>Description</th>
<th>9/26/2011 Fee (i.e., post-AIA enactment)</th>
</tr>
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<tr>
<td>1.17(c)</td>
<td>1817</td>
<td>Request for Prioritized Examination</td>
<td>$4,800.00</td>
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<tr>
<td>1.17(c)</td>
<td>2817</td>
<td>Request for Prioritized Examination</td>
<td>$2,400.00</td>
</tr>
</tbody>
</table>

Question FEE7: Are there any other fees required upon filing a Request for Prioritized Examination (Track I)? What happens if
one of the required fees is not present upon filing?

**Answer FEE7:** The fees required to be paid upon filing for prioritized examination are:

i. Basic filing fee, as set forth in 37 CFR 1.16(a), or for a plant application, 37 CFR 1.16(c).

ii. Search fee, as set forth in 37 CFR 1.16(k), or for a plant application, 37 CFR 1.16(m).

iii. Examination fee, as set forth in 37 CFR 1.16(o), or for a plant application, 37 CFR 1.16(q).

iv. Publication fee, as set forth in 37 CFR 1.18(d).

v. Track I processing fee, as set forth in 37 CFR 1.17(i).

vi. Track I prioritized examination fee of $4800.00 ($2400.00 for small entities).

vii. If applicable, any application size fee, due because the specification and drawings exceed 100 sheets of paper, as set forth in 37 CFR 1.16(s).

viii. If applicable, any excess independent claim fee, due because the number of independent claims exceeds three, as set forth in 37 CFR 1.16(h).

ix. If applicable, any excess claim fee, due because the number of claims exceeds twenty, as set forth in 37 CFR 1.16(i).

If any fee is unpaid at the time of filing of the application, the request for Prioritized Examination will be dismissed. However, if an explicit authorization to charge any additional required fees has been provided in the papers accompanying the application and the request, the fees will be charged in accordance with the authorization, and the request will not be dismissed for nonpayment of fees.

**Question FEE8:** Will I have an opportunity to provide input into the fee amounts that might be revised using the USPTO’s new fee setting authority under section 10 of the AIA?

**Answer FEE8:** When the USPTO sets fees using the authority outlined in section 10 of the AIA, the public will have at least three (3) opportunities to provide suggestions and comments. The first opportunity is now. While the USPTO is deliberating internally about fees, you can provide suggestions or ideas for the USPTO to consider by emailing the USPTO at aia_implementation@uspto.gov (mailto:aia_implementation@uspto.gov). The second opportunity will be during the public hearing held by the Patent Public Advisory Committee (watch for the date(s) on our AIA calendar of events). The third opportunity will be during the 60-day public comment period after the USPTO publishes the notice of proposed rulemaking.

**Question FEE9:** When will the USPTO begin collecting the additional $400 (and $200 for small entity) for an original patent application (except for a design, plant, or provisional application) that is not filed electronically?

**Answer FEE9:** This new fee will be effective at 12:00 a.m. on Tuesday, November 15, 2011. This fee applies to a patent application filed by mail, rather than via the Office’s electronic filing system (EFS-Web). This includes PCT international applications filed with the USPTO as the Receiving Office as well as national stage applications under 35 U.S.C. 371. All applications filed by mail or hand delivery on or after November 15, 2011, must include the additional $400 ($200 for small entity) fee.

**Question FEE10:** What will happen if I forget to pay the increased fee amount on or after September 26, 2011?

**Answer FEE10:** The applicable fee amount is the amount in effect on the day the fee is paid. If the applicable fee amount is not paid, the USPTO will treat the submission as having an insufficient payment of fees. Applicants are encouraged to provide authorization in the application file to charge fees to a specified Deposit Account to avoid insufficient payment of fees.

**Question FEE11:** On June 27, 2011, the USPTO issued a notice of proposed rulemaking to adjust certain patent fee amounts for fiscal year 2012 to reflect fluctuations in the Consumer Price Index (CPI). Does the office plan to implement this increase in addition to the 15% patent fee increase in the AIA?

**Answer FEE11:** No. Given the timing of the enactment of the AIA so close to the beginning of fiscal year 2012, the USPTO does not plan on implementing the CPI for fiscal year 2012.

**First Inventor to File**

**Question FITF1:** What is the effective date of the First Inventor to File provision of AIA?
**Answer FITF1**: The effective date for the First Inventor to File provision of AIA is March 16, 2013.

**Question FITF2**: I’m an independent inventor planning on filing a new nonprovisional patent application on October 1, 2011. Will my patent application be subject to the first-inventor-to-file provisions?

**Answer FITF2**: No. The first-inventor-to-file provisions become effective on March 16, 2013. Thus, an application filed before that date would not be subject to the first-inventor-to-file provisions. The application will be treated under the first-to-invent provisions of the law in effect on September 15, 2011.

**Question FITF3**: Once the first-inventor-to-file provisions take effect on March 16, 2013, would someone who copies my idea and files a patent application on the subject matter before I do be entitled to a patent?

**Answer FITF3**: No. Only inventors are entitled to a patent. Someone who copies another’s idea cannot be the inventor.

**Question FITF4**: My co-inventor disclosed our invention at a trade show one month before the filing date of our application. Will that disclosure prevent us from obtaining a patent?

**Answer FITF4**: No. Regardless of whether the application was filed before or after the first-inventor-to-file provisions take effect on March 16, 2013, disclosure one month prior to a filing date is not prior art to the claimed invention by virtue of a one year grace period.

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**Inter Partes Reexamination**

**Question R1**: What is the effective date of the provisions effecting inter partes reexamination?

**Answer R1**: The effective date of the inter partes reexamination provisions is September 16, 2011.

**Question R2**: Did the America Invents Act change the standard for inter partes reexamination?

**Answer R2**: Yes. Section 6 of the America Invents Act elevates the standard for granting a request for inter partes reexamination. Under the new standard, the information presented in an inter partes reexamination request must provide a showing that there is a reasonable likelihood that the requester will prevail with respect to at least one of the patent claims challenged in the request. The standard for ex parte reexamination remains unchanged.

**Question R3**: If a request for inter partes reexamination was filed before the enactment date of the America Invents Act, but a determination on the request has not yet been issued, which standard will be applied in determining whether to grant inter partes reexamination?

**Answer R3**: The Substantial New Question of patentability (SNQ) standard is applicable in determining whether the request for inter partes reexamination will be granted for any inter partes reexamination proceeding with a request filed prior to the date of enactment of the America Invents Act (i.e., September 16, 2011).

**Question R4**: If a request for inter partes reexamination was granted under the SNQ standard, will the resulting proceeding continue until its conclusion under the SNQ standard?

**Answer R4**: Yes. If reexamination was ordered based on the SNQ standard, the SNQ standard will continue to be applied until the conclusion of the proceeding.

**Question R5**: What is inter partes review and when is it available?

**Answer R5**: inter partes review replaces inter partes reexamination as an avenue for a third party’s patentability challenge and the provision in the AIA for inter partes review is effective on September 16, 2012.

**Question R6**: When inter partes review under section 6 of the America Invents Act takes effect on September 16, 2012, will pending inter partes reexaminations be converted to inter partes review proceedings?

**Answer R6**: No. Pending inter partes reexaminations will not be converted into inter partes review proceedings. Proceedings for inter partes reexamination filed prior to September 16, 2012, will proceed to conclusion even if the proceedings last beyond September 16, 2012.

**Question R7**: If a request for inter partes reexamination is filed on September 16, 2012, how will it be treated?

**Answer R7**: Any request for inter partes reexamination filed on or after September 16, 2012, will not be granted.
Inter Partes Review

**Question IPR1:** What is an *Inter Partes Review* proceeding?

**Answer IPR1:** A petitioner may request to cancel as unpatentable 1 or more claims of a patent based on §§ 102, 103 using patents or printed publications.

**Question IPR2:** What is the effective date of the provisions for *inter partes* review?

**Answer IPR2:** The effective date of the provisions for *inter partes* review is September 16, 2012.

**Question IPR3:** Who may file a petition for an *Inter Partes Review* and when should the petitioner file?

**Answer IPR3:** A person who (a) is not the owner of the patent and (b) has not previously filed a civil action challenging the validity of a claim of the patent may file, accompanied by payment of the required fee, a petition to institute an *Inter Partes Review* of the patent. The petition must demonstrate a reasonable likelihood that the petitioner will prevail on at least one claim challenged. The petition cannot be filed until after the later of: 1) 9 months after the grant of a patent or issuance of a reissue of a patent, or 2) the date of termination of any post grant review of the patent.

Post Grant Review

**Question PGR1:** What is a Post Grant Review proceeding?

**Answer PGR1:** A petitioner may request to cancel as unpatentable 1 or more claims of a patent on any ground that could be raised under paragraph (2) or (3) of section 282(b) (relating to invalidity), i.e., § 101, 102, 103, 112 (except best mode). A Post Grant Review is generally limited to patents issuing from an application filed under the first-inventor-to file system.

**Question PGR2:** What is the effective date of the provisions for post grant review?

**Answer PGR2:** The effective date of the provisions for post grant review is September 16, 2012.

**Question PGR3:** Who may file a petition for a Post-Grant Review and when should the petitioner file?

**Answer PGR3:** A person who (a) is not the owner of the patent and (b) has not previously filed a civil action challenging the validity of a claim of the patent may file, accompanied by payment of the required fee, a petition to institute a Post Grant Review of the patent. The petition must demonstrate that it is more likely than not that the petitioner will prevail on at least one claim challenged or raises a novel question that is important to other patents or publications. The petition may be filed only within 9 months after the grant of a patent or issuance of a reissue patent.

Prioritized Examination (Track 1)

**Question PE1:** What is prioritized examination?

**Answer PE1:** Prioritized examination is a procedure for expedited review of a patent application for an additional fee. The Office’s goal for prioritized examination is to provide a final disposition within twelve months of prioritized status being granted.

**Question PE2:** What is the effective date of prioritized examination?

**Answer PE2:** The effective date of prioritized examination is September 26, 2011.

**Question PE3:** What types of applications are eligible for Prioritized Examination (Track I)? How may I file a Request for Prioritized Examination?

**Answer PE3:** Nonprovisional utility and plant patent applications with no more than 4 independent claims, 30 total claims, and no multiple dependent claims filed on or after September 26, 2011 are eligible for Prioritized Examination (Track I). Requests for Prioritized Examination of utility patent applications must be filed using EFS-Web. Requests for Prioritized Examination of plant patent applications must be filed in paper. For both utility and plant patent applications, it is strongly recommended that applicants use Form PTO/SB/424 to request prioritized examination, but the form is not required.

**Question PE4:** What fees are required upon filing a Request for Prioritized Examination (Track I)? What happens if one of the required fees is not present upon filing?

**Answer PE4:** The fees required to be paid upon filing for Prioritized Examination are:
i. Basic filing fee, as set forth in 37 CFR 1.16(a), or for a plant application, 37 CFR 1.16(c).

ii. Search fee, as set forth in 37 CFR 1.16(k), or for a plant application, 37 CFR 1.16(m).

iii. Examination fee, as set forth in 37 CFR 1.16(o), or for a plant application, 37 CFR 1.16(q).

iv. Publication fee, as set forth in 37 CFR 1.18(d).

v. Track I processing fee, as set forth in 37 CFR 1.17(i).

vi. Track I prioritized examination fee of $4800.00 ($2400.00 for small entities).

vii. If applicable, any application size fee, due because the specification and drawings exceed 100 sheets of paper, as set forth in 37 CFR 1.16(s).

viii. If applicable, any excess independent claim fee, due because the number of independent claims exceeds three, as set forth in 37 CFR 1.16(h).

ix. If applicable, any excess claim fee, due because the number of claims exceeds twenty, as set forth in 37 CFR 1.16(i).

If any fee is unpaid at the time of filing of the application, the request for Prioritized Examination will be dismissed. However, if an explicit authorization to charge any additional required fees has been provided in the papers accompanying the application and the request, the fees will be charged in accordance with the authorization, and the request will not be dismissed for nonpayment of fees.

**Question PE5:** Who can I contact if I have questions about a decision dismissing my Request for Prioritized Examination or about how to file a Request for Prioritized Examination via EFS-Web?

**Answer PE5:** Contact the person who signed the decision dismissing the Request if there is a question about the dismissal. Questions related to the filing of a Request for Prioritized Examination via EFS-Web can be directed to the Patent Electronic Business Center at (866) 217-9197 or ebc@uspto.gov. General questions about the Prioritized Examination (Track I) program can be directed to the Office of Patent Legal Administration at (571) 272-7701 or patent.practice@uspto.gov.

**Tax Strategies**

**Question TAX1:** How does Section 14 of the America Invents Act affect the patentability of tax strategies?

**Answer TAX1:** Applicants will no longer be able to rely solely on the novelty or non-obviousness of a tax strategy embodied in their claims in order to distinguish the claims from the prior art.

**Question TAX2:** What is the effective date of the tax strategy provisions in the AIA?

**Answer TAX2:** The effective date of the tax strategy provisions is September 16, 2011.

**Question TAX3:** Which patent applications will be subject to section 14 of the America Invents Act?

**Answer TAX3:** Section 14 of the America Invents Act applies to any patent application that is pending on, or filed on or after, September 16, 2011.

**Question TAX4:** If I have a patent issued before September 16, 2011, that undergoes reexamination, will Section 14 of the America Invents Act apply during the reexamination?

**Answer TAX4:** No. Section 14 of the America Invents Act applies to patents issued on or after September 16, 2011.

**Transitional Program for Covered Business Method Patents**

**Question TPG1:** What is the Transitional Program for Covered Business Method Patents?

**Answer TPG1:** Like a Post Grant Review proceeding, the Covered Business Method Patent Program involves a request to cancel as unpatentable 1 or more claims of a patent and generally applies the provisions for Post Grant Review. The Transitional Program for Covered Business Method Patents applies to patents issuing from appeals filed under a first-inventor-to-file system, and unlike Post Grant Review, it also applies to patents issuing from applications filed under the current first-to-invent system. Additionally, there are limitations on the type of prior art that may be used as set forth in Section 18 of the AIA.

**Question TPG2:** What is the effective date of the Transitional Program for Covered Business Method Patent?
**Answer TPGR2**: The effective date of the Covered Business Method Patent Program is September 16, 2012.

**Question TPGR3**: Who may file a petition for a Transitional Program for Covered Business Method Patent proceeding and when should the petitioner file?

**Answer TPGR3**: In addition to the requirements for a PGR petitioner, the petitioner must have been sued or charged with infringement under a covered business method patent. The petition may be filed one year after the date of enactment, but prior to 8 years after regulations take effect.