

Further AIA Changes Effective In September

By [Joseph D. Kuborn](#)

On September 16, 2011, the Leahy-Smith America Invents Act (AIA) was enacted into law. The AIA is the most significant reform of U.S. patent law in the past 50 years and the changes to the patent system are being phased in between the enactment date and March 16, 2013. Although the first-to-file provisions of the AIA have garnered the most public attention and will not become effective until March 16, 2013, the AIA includes other important changes that go into effect on September 16, 2012. This article summarizes some of the more important and potentially useful changes that are being implemented on September 16, 2012.

Supplemental Examination

The supplemental examination provisions of the AIA permit a patent owner to request supplemental examination of a patent by the USPTO after the patent has issued. Supplemental examination will be available for any patent issued before, on, or after September 16, 2012. Supplemental examination is a new concept previously not available in the U.S. that allows the USPTO to consider, reconsider, or correct information that the patent owner believes is relevant to an issued patent. The use of supplemental examination could assist a patent owner in addressing challenges to the enforceability of a patent raised during litigation, such as allegations of inequitable conduct based on the failure to submit prior art references.

Supplemental examination of a patent must be filed by the patent owner and third parties are prohibited from partici-

pating in the proceeding. A request for supplemental examination can be filed any time during the enforceability of the patent. Each request for supplemental examination may include up to 12 items of information that are requested to be considered, reconsidered, or corrected by the USPTO. These items of information can include any documents that are believed to be relevant to the patent and, unlike traditional re-examination, are not limited to patents and printed publications.

Although a request for supplemental examination may be useful in removing issues from litigation, the supplemental examination process will be costly. The initial fee for filing the request is \$5,140. In addition to this filing fee, a fee of \$16,120 must be submitted at the time of filing the request to cover the costs of *ex parte* reexamination if *ex parte* reexamination is ordered as a result of the supplemental examination process. If the supplemental examination process determines that an *ex parte* reexamination is not required, the reexamination fee is returned to the patent owner.

After filing the supplemental examination request, the USPTO will determine within three months whether a substantial new question of patentability affecting any claims in the patent has been raised. The supplemental examination proceeding will conclude with the issuance of a supplemental examination certificate, which will indicate whether a substantial new question of patentability was raised. If a substantial new question of patentability was raised, the *ex parte* reexamination process will begin. If not, the reexamination certifi-

(Continued on page 2)

FIRM NEWS

Christopher Liro Joins Andrus - Andrus is proud to announce that attorney Christopher Liro has joined the firm as of September 4, 2012. Chris specializes in intellectual property litigation at both the federal and appellate court levels, as well as in the International Trade Commission.

Jury Finds for Andrus Client National Pasteurized Eggs in Patent Trial - Ed Williams, Aaron Olejniczak, and Ryann Beck recently represented National Pasteurized Eggs in a patent case in the Western District of Wisconsin. The case involved three of National's patents and three of defendant Michael Foods' patents relating to the pasteurization of in-shell eggs. The jury found that all of National's patents-in-suit were valid and infringed and that all of defendant's patents-in-suit were invalid on written description and enablement grounds. The jury awarded approximately \$6 million in damages to National.

Emily Hinkens Now a Registered Patent Attorney - Emily Hinkens recently received official notification that she passed the Patent Bar, and has been named as a Registered Patent Attorney with the USPTO.

(Continued from page 1)

cate will indicate that no new question was raised and the \$16,000 reexamination fee will be refunded.

The implementation of the supplemental examination process will allow patent owners to address issues that were previously unable to be handled by the USPTO during reexamination. However, the fees associated with this process will be high, which will require careful consideration before beginning the process.

Correction of Inventorship

Another important change implemented by the AIA that goes into effect on September 16, 2012 is the simplification of the procedures necessary to correct inventorship in a pending application. Previously, the procedure to correct inventorship issues, such as adding or removing an inventor after the application was filed, required a series of statements from the assignee and re-execution of a declaration by all of the inventors, including those originally named in the application. Under the new rules, the correction of inventorship in a non-provisional application will require only an Application Data Sheet (ADS) that lists the correct inventors, the required processing fee of \$130, and an inventor's oath/declaration that is executed by any inventors added to the application. Thus, the new rules do not require that the previously named inventors re-execute a declaration when an inventor is added to the application after filing.

The new rules implemented by the AIA also eliminate the requirement that the applicants make a statement that errors in inventorship arose "without deceptive intent" in order to seek correction of those errors. The changes to inventorship can now be made without any party needing to state that the errors in naming inventors arose "without deceptive intent".

Third Party Submissions

Under the new rules that come into effect September 16, 2012, third parties have the enhanced ability to bring relevant information to the attention of the USPTO during prosecution of a pending application. Although third parties previously had the limited ability to bring prior art to the attention of an Examiner during prosecution, the new third-party submission procedures expand the opportunity for a third party to make the Examiner at the USPTO aware of relevant prior art.

Under the new rules, a third party may submit any patent, published patent application, or other printed publication of potential relevance to the Examiner during examination of the application. There is no requirement to identify the third party making the submission and no requirement to provide notice to the patent applicant.

The submission of prior art to the USPTO during prosecution of a pending application must be filed earlier than (i) the date of the Notice of Allowance or (ii) the later of six months after the date of publication or the date of first rejection of the application on the merits. Thus, information can be submitted by a third party during the pendency of a patent application at any time prior to the issuance of a first rejection on the merits or a Notice of Allowance.

When an interested third party submits documents for consideration by the Examiner during prosecution, the submission must include a list of the documents being submitted, a concise description of the relevance of each item in the list and a legible copy of each item in the list. The fee for third party submissions is \$180 for every ten items submitted.

Filing by Assignee

Another substantial change to the U.S. Patent System implemented by the AIA is the ability of an assignee to file an application on behalf of an inventor that has assigned or is under an obligation to assign the invention to the assignee. Previously, each inventor was required to execute a declaration and the application had to be filed by the inventors, rather than the assignee.

If the application is filed by the assignee, the assignee must record evidence of ownership no later than the date the issue fee is paid in the application.

Inter Partes Review

Inter partes review (IPR) replaces *inter partes* reexamination starting September 16, 2012. A request for *inter partes* review can be filed nine months after the date of patent grant for any issued patent. Although *inter partes* review is substantively similar to *inter partes* reexamination, the fee for IPR will be \$27,200 for twenty or fewer claims, as compared to \$8,800 for *inter partes* reexamination.

Ex Parte Reexamination Fee Increase

In addition to the substantive changes discussed, the cost of *ex parte* reexamination will increase substantially on September 16. The *ex parte* reexamination fee will increase from \$2,520 to \$17,750.

Future Patent Reform Updates

Some of the most significant changes in the Patent Laws will take place on March 16, 2013 when the U.S. patent system moves to a first-to-file system. We will be providing further updates, explanations and guidance regarding these aspects of patent reform in advance of the provisions taking effect.