

# Kluwer Patent Blog

## U.S. Patent System Changes Taking Effect September 16, 2012

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The next wave of U.S. patent reform changes embodied in the Leahy-Smith America Invents Act takes effect on September 16, 2012. The following is a list of some key changes that may impact granted, pending and new U.S. patent portfolios.

### PATENT PROSECUTION CHANGES

The following changes apply to U.S. patent applications *filed* on or after September 16, 2012:

- Prosecution By Assignee

An assignee (or party to whom the inventors are obligated to assign the invention) can act as the applicant. In such cases, the assignee (not the inventors) should execute a power of attorney document.

- Inventor Oath/Declaration

The executed inventor oath/declaration can be submitted at the close of prosecution, in response to a Notice of Allowability, as long as the inventor information is provided in an Application Data Sheet at the time the application is filed or within the Missing Parts/Missing Requirements response period.

The statements required in the inventor oath/declaration are different, so new forms are required.

The inventor oath/declaration statements can be included in a combined assignment/declaration document.

As noted above, these changes apply to any U.S. patent application “filed” on or after September 16, 2012, which includes new continuation and divisional applications filed on or after September 16, 2012. However, only U.S. national phase applications that are based on *PCT applications* filed on or after September 16, 2012 are subject to these changes.

- Reissue Application Practice

The requirements for the reissue oath/declaration are simplified, but include a new requirement to identify a claim that the application seeks to broaden, if the reissue application is a broadening reissue application.

The following changes apply to U.S. patent applications that are *pending* on or after September 16,

2012:

- **Correction Of Inventorship**  
The requirements for correction of inventorship and changing the order of inventors are simplified.
- **Preissuance Submissions By Third Parties**  
Third parties can submit any patent, published patent application, or other printed publication of potential relevance to the examination of an application. The submission must be filed within a strict time period, generally before the earliest of a first Office Action on the merits or Notice of Allowance.

## POST-GRANT CHANGES

The following changes apply to U.S. patents that are *in force* on or after September 16, 2012:

- **Supplemental Examination**  
Patent owners can request a supplemental examination proceeding to obtain consideration, reconsideration, or correction of information believed to be relevant to the patent. Under certain circumstances, pursuing supplemental examination can shield the patent from unenforceability arising out of inequitable conducts charges surrounding the information at issue. The basic filing fee for supplemental examination is \$5,140 plus the (refundable) \$16,120 fee for the ex parte reexamination that may be ordered as a result of the supplemental examination.
- **Third Party Requests for Ex Parte Reexamination**  
Third party requesters must certify that their request is not barred by statutory estoppel arising out of an inter partes review or post-grant review proceeding. The basic filing fee for a request for ex parte reexamination will increase to \$17,750.
- **Inter Partes Review**  
Inter partes review replaces inter partes reexamination, which is no longer available. Inter partes review is more “trial-like” and will be conducted in front of the new Patent Trial and Appeal Board within the USPTO. The basic filing fee for a petition challenging up to 20 claims is \$27,200.
- **Submission of Written Statements Of Patent Owner**  
Third parties may submit in the file of a granted patent certain written statements filed by the patent owner in a Federal court or USPTO proceeding in which the patent owner took a position on the scope of any claim in the patent.

The following changes apply to *certain business method patents*:

- **Post grant review**  
Certain business method patents are subject to post grant review by parties who have been charged with infringement. The basic filing fee for a petition challenging up to 20 claims is \$35,800.

## USPTO WEBINAR

The USPTO is hosting a webinar on these changes on Friday, September 7, 2012, from 12:30 to 1:30 pm eastern. Access information is available on the [USPTO's AIA Implementation webpage](#).

## Ongoing Updates

For ongoing updates on U.S. patent reform, including in-depth analysis of the first-to-file changes taking effect on March 16, 2013, please visit [PharmaPatentsBlog](#).

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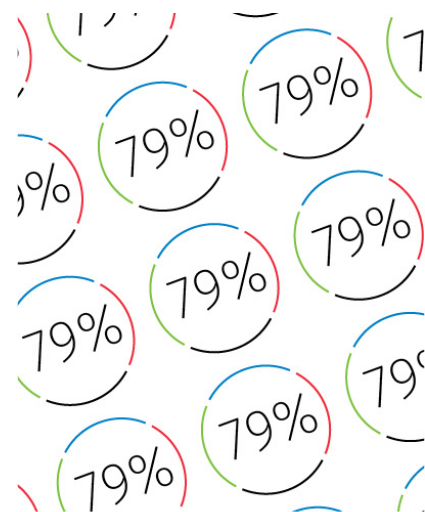
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This entry was posted on Monday, September 3rd, 2012 at 6:00 am and is filed under [Opposition, Procedure, Revocation, United States of America](#)

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