

MINUTES OF THE MEETING OF
THE PAULINE NEWMAN IP AMERICAN INN OF COURT
ON NOVEMBER 3, 2011

This was a joint meeting with the Giles S. Rich Inn of Court at the U.S. Patent & Trademark Office. There was a reception in the foyer in front of the Madison Auditorium from 6:00 p.m. until 6:55 p.m., with a photo exhibit by Senator Patrick Leahy of the signing ceremony of the America Invents Act. The PTO Museum was kept open later than usual to accommodate attendees.

At 6:55 p.m. the meeting began in the Madison Auditorium, with introductory remarks by Judge Theodore Essex, Vice President of the Giles Rich Inn of Court. Al Tramosch, President of the Pauline Newman Inn of Court, then also gave introductory remarks. Chip Molster announced that there would be a CLE sponsored by the Northern Virginia Federal Bar Association on Patent Infringement and the Rocket Docket on December 14, 2011.

David J. Kappos, Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office, gave welcoming remarks. He spoke about reducing the backlog of patent applications, modernizing information technology at the PTO, green technology, inventor outreach, patent harm, and implementation of the America Invents Act to reform the patent system. He announced that the first patent had already been allowed under the new Track 1 accelerated examination program, which only became available on September 26, 2011. He showed a video called Vision 2030 showing where the PTO hopes to be by 2030, with a montage on IP in various fields and the need for clear rights. He claimed that the U.S. would have the world's first and only truly twenty-first century patent system.

Janet Gongola, PTO Patent Reform Coordinator, gave an overview of the Leahy-Smith America Invents Act ("AIA"). Group 1 Rulemakings will take effect within 60 days of enactment on September 16, 2011. Group 2 Rulemakings will take effect within twelve months of enactment. Group 3 Rulemakings will take effect within 18 months of enactment.

Michael Tierney, Lead Administrative Patent Judge for the Trial Section of the Board of Patent Appeals and Interferences (soon to be renamed the Patent Trial and Appeal Board) was interviewed by Ben Hickman of the Giles Rich Inn and David Sosnowski of the Pauline Newman Inn regarding contested case provisions of the AIA. He said that there were many similarities in the various provisions, including post grant review, inter partes and ex parte reexamination, and business method review. Parties can settle these cases. Opposers can propose amended claims. Derivation proceedings must be brought within one year after publication of a patent application (not one year after filing). A technological invention (as opposed to a business method invention) is not well defined. The standard of review in these provisions is more likely than not.

Michelle Picard, Senior Advisor for Financial Management in the Office of the Chief Financial Officer of the PTO was interviewed by Keisha Hylton-Rodic of the Giles Rich Inn and Dennis White of the Pauline Newman Inn regarding financial provisions of the AIA. Under the PTO's

fee setting authority of the AIA, fees cannot exceed the costs of applications. He explained the rule making procedures. The 15% surcharge is across the board. Regulations will adjust specific fees later under the fee setting authority. The micro-entity discount will be implemented only when regulations have been adopted. The operating reserve maintained by the PTO for contingencies should not be confused with the fee reserve fund under the AIA. The latter is for fees that have been collected by the PTO in excess of the amount appropriated by Congress to the PTO for the fiscal year.

Robert W. Bahr, Senior Patent Counsel in the Office of the Associate Commissioner for Patent Examination Policy was interviewed by Jacob Schroeder of the Giles Rich Inn and Andrew Moyer of the Pauline Newman Inn regarding patent provisions of the AIA. Track 1 prioritized examination will co-exist with earlier forms of prioritized examination, including special status for age or health, accelerated examination, the green technology pilot program, and the patent prosecution highway. Even though under the AIA patents can no longer be invalidated for failure to disclose the best mode, examination for best mode is still in the statute. It is expected that rejections for failure to disclose the best mode will be rare. Under supplemental examination, prior sale and all other grounds for invalidity may be brought in, not just prior art as in reexamination.

Questions were then taken from the audience. Micro-entities, like small entities, will be allowed to self-certify. Examiners will be retrained to follow the AIA. The patent bar exam will be revised to reflect the AIA.

The Vice President of the Giles Rich Inn and the President of the Pauline Newman Inn then gave closing remarks. The meeting was adjourned at 8:27 p.m.

Stephen Christopher Swift
Secretary-Treasurer
Pauline Newman IP American Inn of Court