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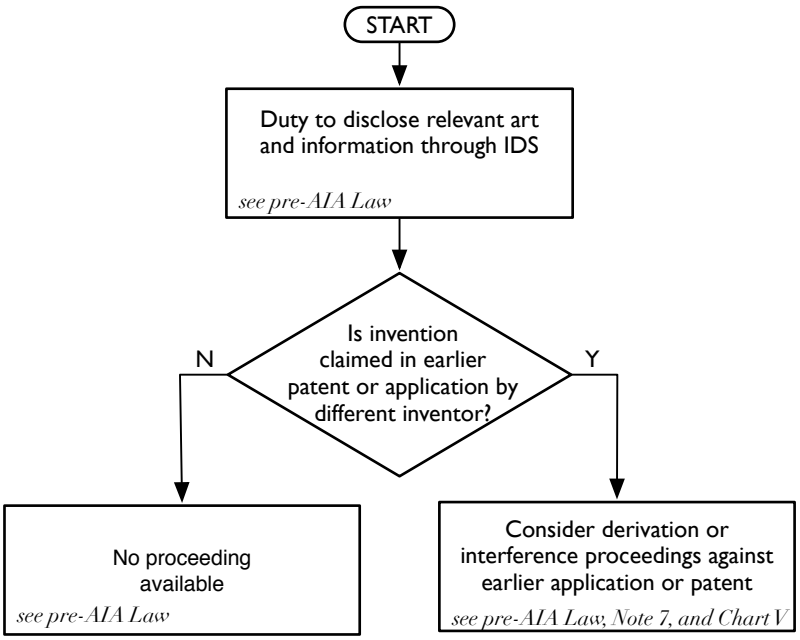
CHART I. APPLICANT (OWNER) ACTIONS TO STRENGTHEN PATENT

PRE-GRANT



POST-GRANT

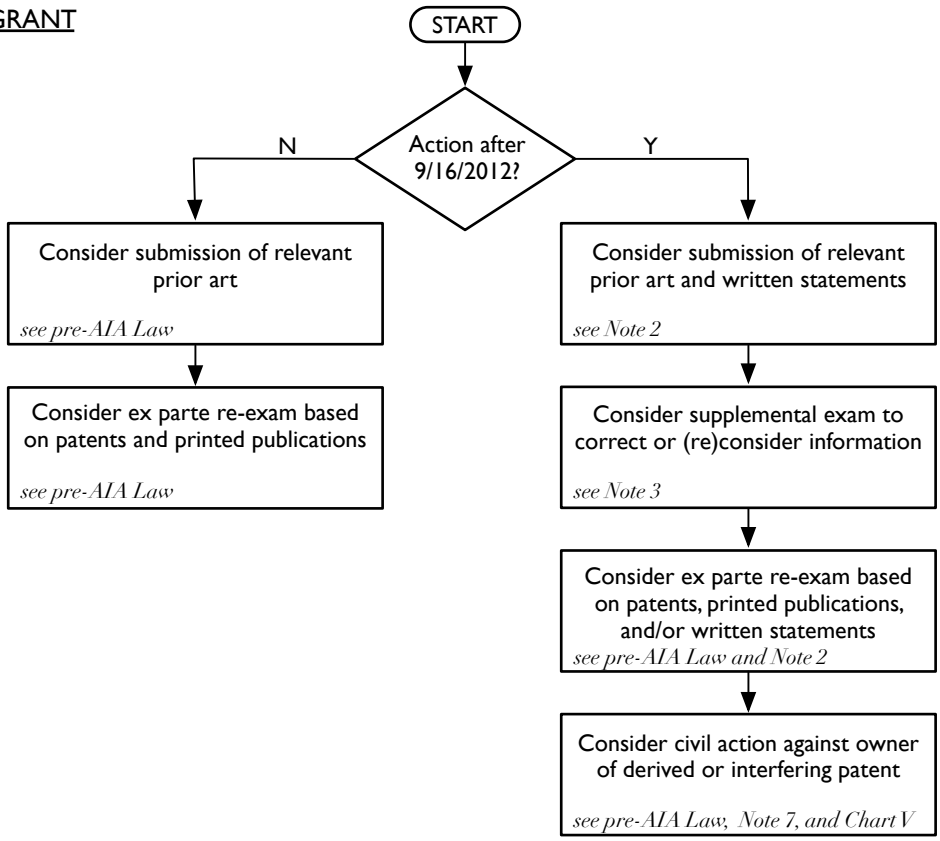


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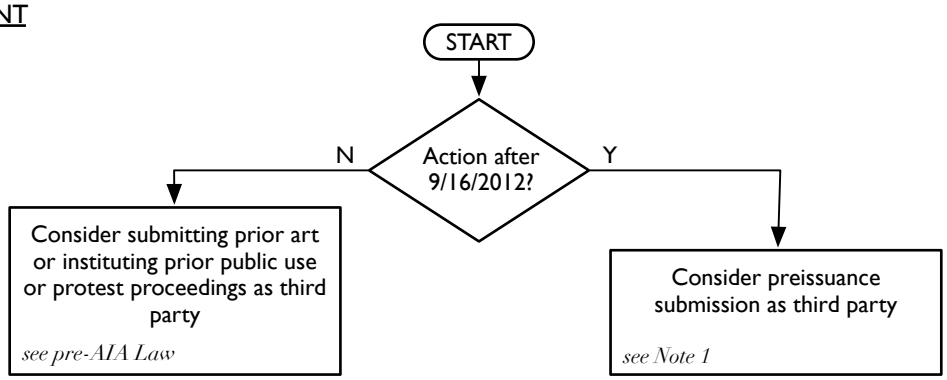
CHART II. ACTIONS TO CHALLENGE ANOTHER PATENT/APPLICATION

PRE-GRANT



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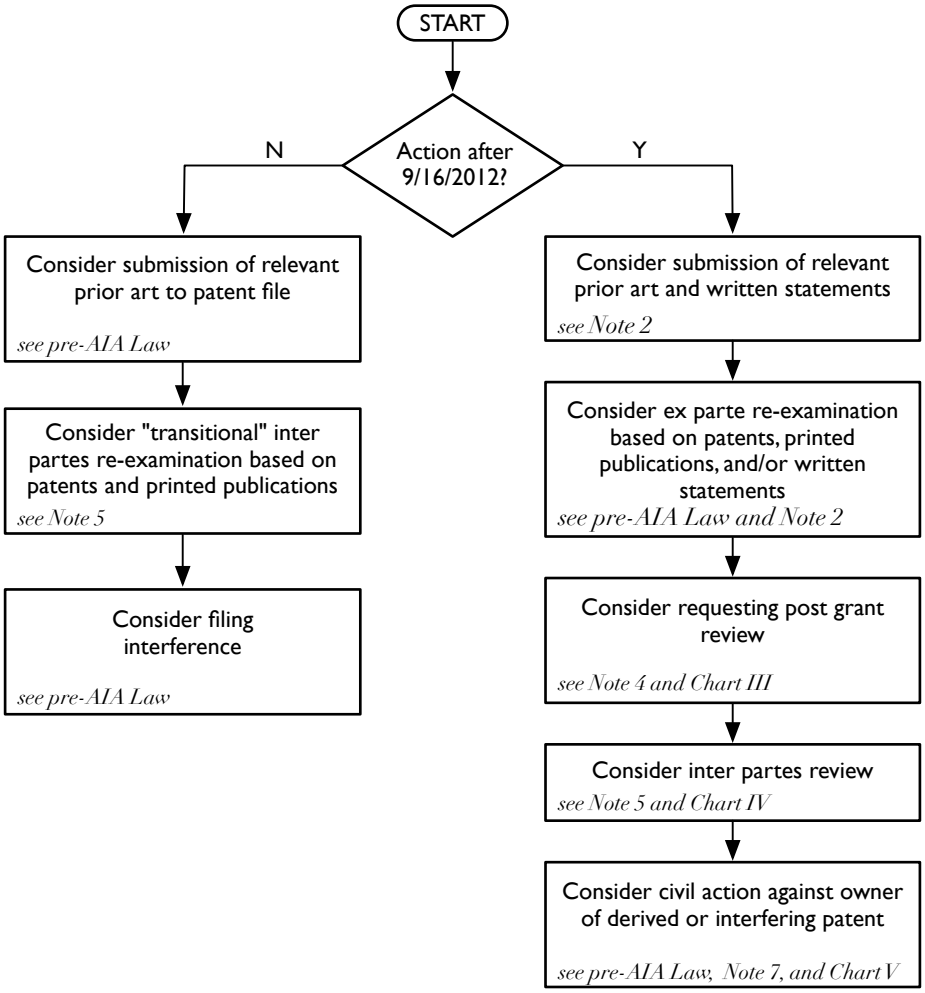

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CHART III. POST GRANT REVIEW

Goes into effect on 9/16/2012.

With the exception of Business Method Patents, post grant review is only available to patents that have or had at least one claim or claim of priority with an effective filing date of 3/16/2013 or later.

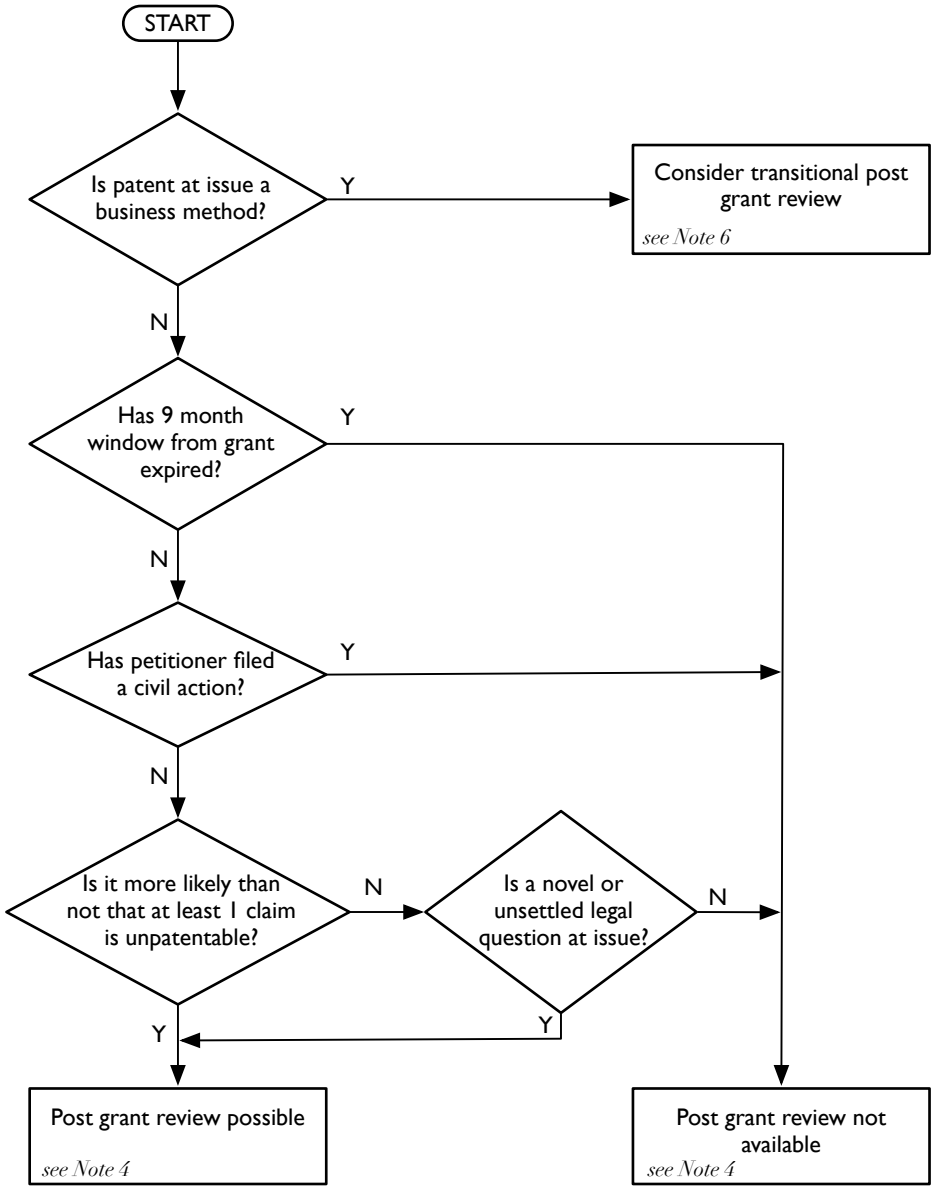

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CHART IV. INTER PARTES REVIEW

Goes into effect on 9/16/2012.

Inter partes review applies to any patent issued before, on, or after 9/16/2012.

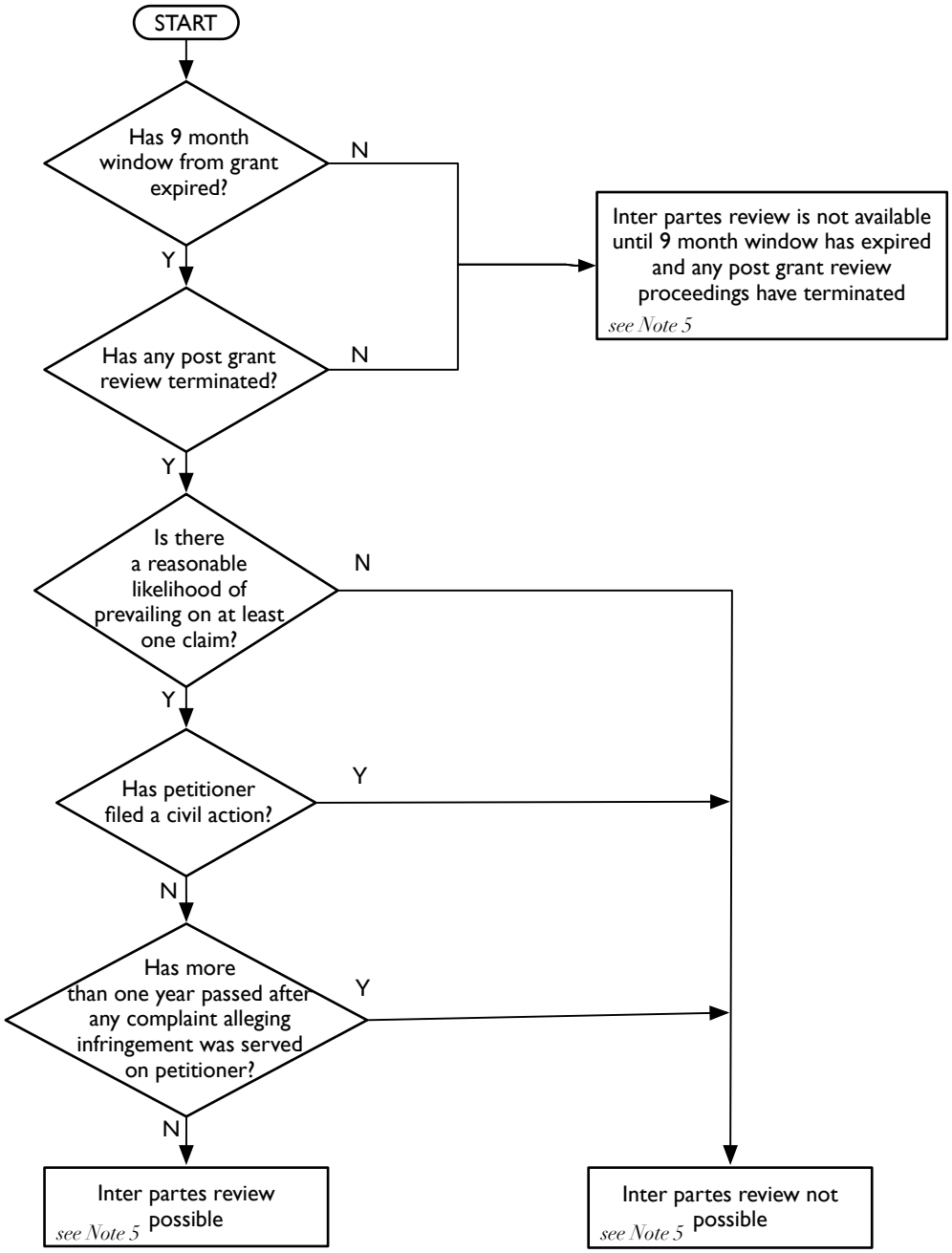

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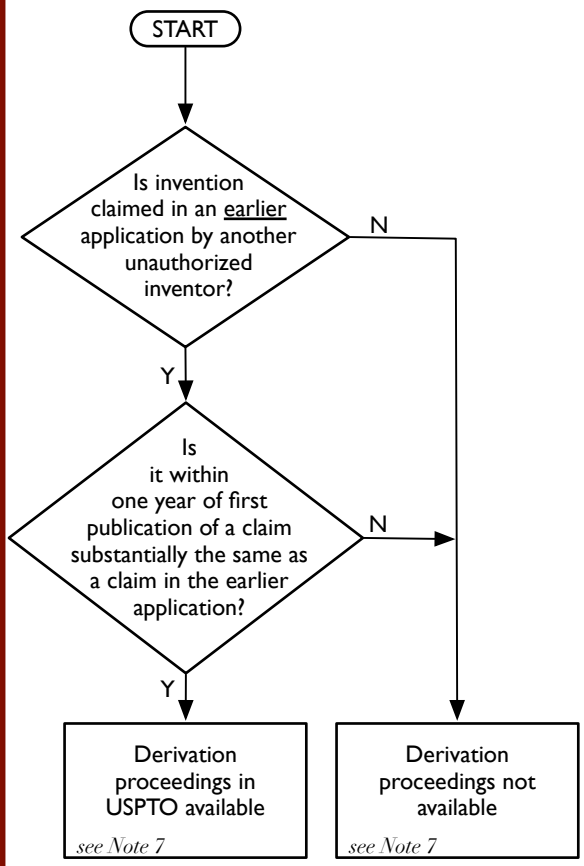
CHART V. DERIVATION PROCEEDINGS AND DERIVED PATENT ACTIONS

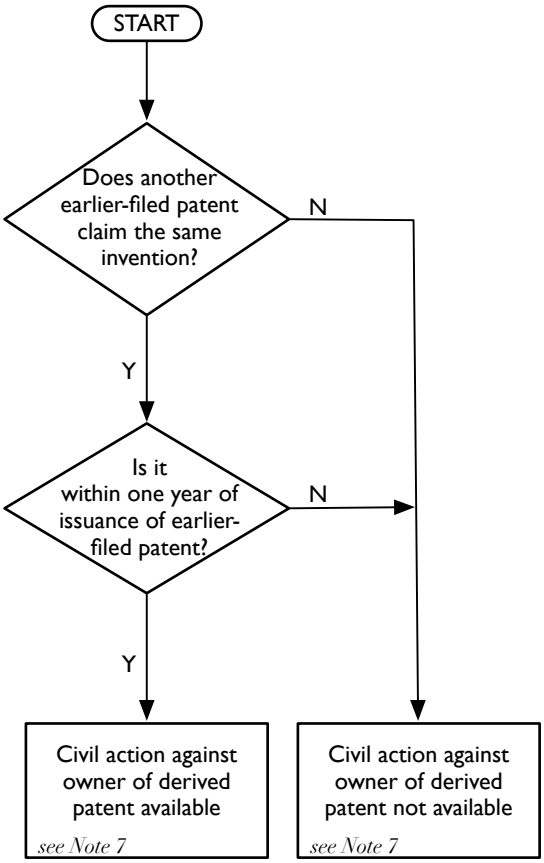
Goes into effect on 3/16/2013.

Derivation proceedings and derived patent actions are only available to an application for patent filed or a patent issued, respectively, on or after 3/16/2013 and if the application or patent has or had at least one claim with an effective filing date or a claim of priority of 3/16/2013 or later.

PETITIONER IS APPLICANT FOR PATENT



PETITIONER IS PATENT OWNER



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America Invents Act
Patent Reform Law of 2011

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Note	Section of AIA, Effective date	Summary of Main Issues
1	**Preissuance submissions by third parties**, Sec. 8 Sept. 16, 2012[1]	• A third party may submit a patent, published application, or other printed publication of relevance to the examination to be considered and included in the file. • The third party must provide a concise description of the asserted relevance of each submitted document. • The submissions must be made before the earlier of (1) the notice of allowance or (2) the later of (a) six months after publication or (b) the first rejection.
2	**Citation of prior art and written statements**, Sec. 6 Sept. 16, 2012[2]	• Any person at any time may cite prior art that is a patent, publication, or statement of the patent owner filed in a Federal court or PTO proceeding in which the patent owner took a position on the scope of a claim. • The citation will be used only to determine the scope of the claim(s) in a reexamination, inter partes review, or post grant review. • Must explain the pertinence and manner of applying the prior art to at least one claim of the patent to become part of file. • *Differs from existing law*: Pre-AIA citation of prior art was limited to patents and printed publications.
3	**Supplemental Examination**, Sec. 12 Sept. 16, 2012[2]	• A patent owner may request supplemental examination to consider, reconsider, or correct any information believed to be relevant to the patent. • The information is not limited to patents and published applications. • The Director shall order a reexamination if at least one item of information raises a substantial new question of patentability. • During reexamination, the patent owner waives the right to file a 304 statement to address a substantial new question of patentability, amendments to claims, or new claims. • A patent cannot be held unenforceable on the basis of information that was not considered, was inadequately considered, or was incorrect in a prior examination if the information was considered, reconsidered, or corrected during supplemental examination. This effect does not apply to a civil action filed before the supplemental examination request was filed where the allegations were based on the information or to defenses based on the information unless the supplemental examination and any reexamination ordered are concluded before the action is brought. • Cases of material fraud may be referred to the Attorney General for further action.
4	**Post grant review** (PGR), Sec. 6 Sept. 16, 2012[3]	• A person other than the patent owner may petition the PTO to cancel at least one claim under 101, 102, 103, or 112 (except best mode). • Petitioner may use any prior art, not limited to patents and published applications. • The patent owner has the right to file a preliminary response to the petition. • Petition granted if (1) the third party, if not rebutted, demonstrates that it is more likely than not that a challenged claim is unpatentable or (2) the petition raises a novel or unsettled legal question. • Petition must be filed on or within nine months of issue date of patent or reissued patent. • A final determination in PGR proceeding will issue within one year of institution of the proceeding. • PGR applies to patents filed on or after, or patents having a priority claim dated on or after, Mar. 16, 2013. PGR does not apply to business method patents (see Sec. 18 of the AIA) but may apply to interferences pending on Sept. 16, 2012. • Patent owner may file one motion to cancel or substitute claims for challenged claims, but cannot broaden claims. • The petitioner may not request or maintain a proceeding before the PTO or assert a civil action or ITC proceeding that the claim is invalid on any ground that was raised or could have been raised during a PGR. • If a civil action alleging infringement is filed within three months of the issue date, the court may not stay consideration of preliminary injunction on the basis of PGR. • If a petitioner, after requesting PGR, files a civil action challenging the validity of a claim of the patent on or after the date the petition is filed, the civil action will be automatically stayed until the patent owner moves to lift the stay or files a civil action or counterclaim alleging infringement, or the petitioner moves the court to dismiss the action.

[1] Applies to patent applications filed before, on, or after the effective date.
[2] Applies to patents issued before, on, or after the effective date.
[3] Applies to patent applications or patents that contain(ed) a claim having an effective filing date on or after Mar. 16, 2013.

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Note	Section of AIA, Effective date	Summary of Main Issues
5	**Inter partes review**, Sec. 6 Sept. 16, 2012[2] with transitional rules between Sept. 16, 2011 and Sept. 16, 2012	• A person other than the patent owner may petition the PTO to cancel at least one claim under 102 or 103. • Prior art is limited to patents and published applications. • The patent owner has the right to file a preliminary response to the petition. • Petition is granted if there is a reasonable likelihood that the petitioner would prevail on at least one claim. • A petition must be filed after the later of (1) nine months after issuance or (2) the date of termination of the post-grant review, if applicable. • A final determination in an inter partes review proceeding will issue within one year of institution of the proceeding. • For requests filed between Sept. 16, 2011, and Sept. 16, 2012, the existing inter partes reexamination is available with the standard of "a reasonable likelihood that the requester will prevail with respect to at least one claim" (instead of "a substantial new question of patentability"). • Patent owner may file one motion to cancel or substitute claims for challenged claims, but cannot broaden claims. • The petitioner may not request or maintain a proceeding before the PTO or assert a civil action or ITC proceeding that the claim is invalid on any ground that was raised or could have been raised during an inter partes review. • An inter partes review may not be instituted if, before the petition is filed, the petitioner filed a civil action challenging the validity of a claim of the patent. • An inter partes review may not be instituted if the petition is filed over one year after the petitioner is served with a complaint alleging infringement. • If a petitioner, after requesting inter partes review, files a civil action challenging the validity of a claim of the patent on or after the date the petition is filed, the civil action will be automatically stayed until the patent owner moves to lift the stay or files a civil action or counterclaim alleging infringement, or the petitioner moves the court to dismiss the action. • *Differs from existing law*: Pre-AIA inter partes reexamination was available if a substantial new question of patentability affecting any claim was raised under 101, 102, 103, or 112.
6	**Transitional PGR for business method patents**, Sec. 18 Sept. 16, 2012[2]	• The petitioner must have been sued or charged with infringement and may challenge at least one claim under 102 or 103 on the basis of 102(a) prior art. • The petition may be filed at any time (i.e., not limited to nine months after issuance as under PGR). • The petitioner may not request or maintain a proceeding before the PTO or assert a civil action or ITC proceeding that the claim is invalid on any ground that was raised during a PGR under Sec. 18. • This provision sunsets on Sept. 16, 2020.
7	**First inventor to file**, Sec. 3 March 16, 2013[3]	Derived patents: • A patent owner may file a civil action against the owner of another patent that claims the same invention and has an earlier filing date if the invention claimed in the other patent was derived from the patent owner who is suing. • A civil action must be filed within one year from issuance of the earlier filed patent. Derivation proceedings: • An applicant for a patent may petition the PTO to institute a derivation proceeding stating that an inventor of an earlier application derived the claimed invention from an invention in petitioner's application. • A derivation proceeding must be filed within one year of first publication of a claim that is at least substantially the same as the earlier application's claim to the invention. • Once the Director institutes the proceeding, the PTAB determines whether an invention was derived. • *Differs from existing law*: Priority contests between two applications or an application and a patent were decided by the BPAI. Interference proceedings • The provisions of Sec. 102(g), 135, and 291 as in effect on the day before Mar. 16, 2013, shall apply to each claim of an application for patent, and any patent issued thereon, for which the amendments made by Sec. 3 of the AIA also apply, if such application or patent contains or contained at any time (A) a claim to an invention having an effective filing date that occurs before Mar. 16, 2013, or (B) a specific reference under Sec. 120, 121, or 365(c) to any patent or application that contains or contained at any time such a claim.

[1] Applies to patent applications filed before, on, or after the effective date.
[2] Applies to patents issued before, on, or after the effective date.
[3] Applies to patent applications or patents that contain(ed) a claim having an effective filing date on or after Mar. 16, 2013.

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