

## Important Rule and Fee Changes for Patents and Patent Applications (February 2013)

The final stages of the America Invents Act (AIA) go into effect on **March 16, 2013**. This newsletter highlights some of the upcoming changes and provides suggestions for patent owners to prepare for the date. The AIA was signed into law on September 16, 2011, bringing about significant changes in U.S. patent law. Many features of the AIA have already been implemented. However, there are important changes in U.S. patent law scheduled to take effect on **March 16, 2013**.

In particular, the AIA implements a "first to file" instead of "first to invent" standard. In addition, the AIA redefines and broadens the scope of prior art. For example, new §102(a) (1) precludes a patent on an invention if the invention was patented, described in a printed publication, in public use, on sale, or otherwise available to the public before the effective filing date of the application. On a first read, the language used in new §102(a) (1) is deceptively similar to terms found in pre-AIA §102(b), e.g. patented, printed publication, public use, and on sale. Unlike §102(b) prior to the AIA, however, a public use and sale is *not* limited to an event occurring in the U.S. Additionally, new § 102(a) (1) of the AIA includes a catch-all category defined as "otherwise available to the public."

At the same time, the AIA has scaled back the scope and effect of the grace period in new §102(b) that provides an exception to prior art under §102(a). The grace period applies to the public disclosure of an invention within one year of the effective filing date of the application disclosing and claiming that invention, but only if the disclosure was by an inventor or one who obtained the invention from an inventor. No longer can an inventor antedate ("swear behind") a disclosure by another within one year of the effective filing date.

**A key determination to be made right now is whether to file an application by March 15, 2013, in order to remain under the current first to invent law. This is particularly important if others are simultaneously working on similar inventions.**

There are two other key reasons to file some patent applications by March 15, 2013:

1. There is currently less prior art available to patent examiners to reject an application; and
2. Any patent issuing on the application will not be subject to the new Post Grant Review proceeding (a proceeding with broadened grounds for an invalidity attack).

There are also three primary scenarios that may warrant filing by March 15, 2013:

1. A provisional application is already on file, but more subject matter is ready to be added to further define the invention in a non-provisional application;
2. A non-provisional application is already on file, but a new continuation-in-part application or an entirely new application is desired to add new matter to the original invention; or
3. An invention is ready to be described and filed in the form of a new provisional or non-provisional application.

These points are guidelines to help with making informed decisions in the coming weeks. Every situation is different. Feel free to contact us to help with patent filing strategy before March 15, 2013.

**Patent Fee Changes Effective March 19, 2013**

Many patent fees are scheduled to substantially increase on March 19, 2013, as shown in the chart, below. One example affecting all patent owners is maintenance fees. Thus, if you have a maintenance fee that will be due anytime between now and March 18, 2014, we recommend that you pay the lower fee now and avoid the huge increase in maintenance fees. Please note that the chart below shows only large entity fees. Small entity fees are half of the large entity fees.

<b>Patent Fee Description</b>	<b>Current Fee (large entity)</b>	<b>New Fee (large entity)</b>
<b>Standard Patent Filing and Prosecution Fees</b>		
Basic utility filing, search and examination fee	\$1,260	\$1,600
Extensions for Response within 1 <sup>st</sup> month	\$150	\$200
Extensions for Response within 2 <sup>nd</sup> month	\$570	\$600
Extensions for Response within 3 <sup>rd</sup> month	\$1,290	\$1,400
Extensions for Response within 4 <sup>th</sup> month	\$2,101	\$2,200
Extensions for Response within 5 <sup>th</sup> month	\$2,730	\$3,000
First Request for Continued Examination (RCE)	\$930	\$1,200
Second and Subsequent RCEs	\$930	\$1,700
Notice of Appeal	\$630	\$800
Utility Issue Fee	\$1,770	\$960
<b>Reexamination Fees</b>		
Ex Parte Reexamination	\$17,750	\$12,000
Reexamination ordered as a result of supplemental examination	\$16,120	\$12,100
Inter Partes Review Request – Up to 20 claims (per claim fee for each claim in excess of 20 is \$200)	NEW	\$9,000
Inter Partes Review Post Institution Fee – Up to 15 Claims (per claim fee for each claim in excess of 15 is \$400)	NEW	\$14,000 (returned to petitioner if PTO does not institute a trial)
Total Inter Partes Review Fees (NEW) (For current fees, per claim fee for each claim in excess of 20 is \$600)	\$27,200	\$23,000
Post Grant Review or Covered Business Method Patent Review Request – Up to 20 claims (per claim fee for each claim in excess of 20 is \$250)	NEW	\$12,000
Post Grant Review or Covered Business Method Patent Review Post Institution Fee – Up to 15 claims (per claim fee for each claim in excess of 15 is \$550)	NEW	\$18,000 (returned to petitioner if PTO does not institute a trial)

Total Post Grant Review or Covered Business Method Patent Fees (for current fees, per claim fee for each claim in excess of 20 is \$800)	\$35,800	\$30,000
<b>Maintenance Fees</b>		
	<b>If Paid by 3/18/13</b>	<b>If Paid after 3/18/13</b>
Due at 3.5 years (one year window between 3-4 years)	\$1,150	\$1,600
Due at 7.5 years (one year window between 7-8 years)	\$2,900	\$3,600
Due at 11.5 years (one year window between 11-12 years)	\$4,810	\$7,400
Surcharge after 3.5 years (payment within 6 months)	\$150	\$160
Surcharge after 7.5 years (payment within 6 months)	\$150	\$160
Surcharge after 11.5 years (payment within 6 months)	\$150	\$160

Please contact us as soon as possible regarding your particular patent portfolio as these changes are significant, both from a legal and cost standpoint. We would be happy to help you with filing and payment strategies.

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