PART I. SUBSTANTIVE PATENT LAW REVISIONS

CHAPTER 1. NEW DEFINITIONS

- § 1:1 Explicit definitions in the AIA
- § 1:2 Definitions missing from the AIA

CHAPTER 2. FIRST INVENTOR TO FILE

- § 2:1 Introduction
- § 2:2 Constitutionality
- § 2:3 The old section 102
- § 2:4 Congressional intent
- § 2:5 Statutory language—35 U.S.C. § 102
- § 2:6 The five prior art categories of § 102(a)(1) and the exceptions thereto
- § 2:7 The patent prior art categories of § 102(a)(2) and exceptions thereto, § 102(d)
- § 2:8 35 U.S.C. § 103 obviousness
- § 2:9 Effective date and applicability of first inventor to file provisions
- § 2:10 Prior § 102 can be litigated into the 2040's
- § 2:11 Examples of the new section 102 at work
- § 2:12 —Example 1: First to Invent is Second to File
- § 2:13 —Example 2: Public Disclosure by First to Invent But Second to File
- § 2:14 —Example 3: Burglar Files a Derived Application Prior to the First Inventor's Application
- § 2:15 —Example 4: Same as Ex. 3, but First Inventor Publicly Discloses First
- § 2:16 —Example 5: Common Ownership; First to Invent is Second to File
- § 2:17 —Example 6: Same as Ex. 5, but First to Invent Publicly Discloses
- § 2:18 —Example 7: Common Ownership; Independent Investors Both Disclose Publicly Before Filing Applications
- § 2:19 —Example 8: Second Inventor Files First, Outside U.S.; Common Ownership

- § 2:20 —Example 9: Second Inventor to File Publishes First; Common Ownership
- § 2:21 —Example 10: First Inventor to File Publicly Discloses First; Common Ownership
- § 2:22 —Example 11: Two Public Disclosures Prior to Filing Dates; Common Ownership

CHAPTER 3. BEST MODE AND SECTION 112

- § 3:1 Background
- § 3:2 Congressional intent
- § 3:3 Changes by the America Invents Act re the best mode requirement
- § 3:4 Applicable USPTO final rules re best mode
- § 3:5 Best mode applicability in patent prosecution
- § 3:6 Inapplicability to post-grant review
- § 3:7 Effective date of best mode amendments
- § 3:8 Section 112 Requirements Other Than Best Mode.

CHAPTER 4. UNPATENTABILITY OF "HUMAN ORGANISMS"

- § 4:1 Background and congressional intent re "human organisms"
- § 4:2 Patents on "human organisms" banned
- § 4:3 USPTO interpretation re "human organism" ban
- § 4:4 Analysis re human organism ban
- § 4:5 35 U.S.C. § 101 subject matter eligibility

CHAPTER 5. LIMITED PATENTABILITY OF TAX STRATEGIES

- § 5:1 Congressional intent re tax strategies
- § 5:2 AIA statutory provisions regarding tax strategies and patentability
- § 5:3 USPTO guidance on AIA section 14 re tax strategies
- § 5:4 Analysis of AIA section 14 re tax strategies

CHAPTER 6. PATENT MARKING

- § 6:1 Patent marking—Background
- § 6:2 Congressional intent re patent marking
- § 6:3 AIA statutory changes re patent marking
- § 6:4 Effective date
- § 6:5 General comments re marking

CHAPTER 7. MISCELLANEOUS SUBSTANTIVE PATENT LAW PROVISIONS

§ 7:1 Generally

PART II. PATENT ENFORCEMENT ISSUES

CHAPTER 8. THE PRIOR USER DEFENSE

- § 8:1 Background: the First Inventor's Defense Act of 1999
- § 8:2 Congressional intent re the prior user defense
- § 8:3 AIA revisions to the prior user defense—The statute
- § 8:4 Analysis of the expanded prior use defense

CHAPTER 9. FALSE PATENT MARKING (MISMARKING)

- § 9:1 False patent marking—Background
- § 9:2 Congressional intent re false patent marking
- § 9:3 AIA statutory changes re false patent marking
- § 9:4 Effect on pending litigation
- § 9:5 The meaning of "competitive injury"
- § 9:6 Pleading requirements for false marking "competitive injury"
- § 9:7 Standing to sue for false marking
- § 9:8 Standing—Declaratory judgment actions for no false marking
- § 9:9 Constitutional challenges to AIA § 16(b)
- § 9:10 Preemption of state causes of action

CHAPTER 10. ENHANCED DAMAGES AND ADVICE OF COUNSEL

- § 10:1 Background to new 35 U.S.C. § 298
- § 10:2 Congressional intent re advice of counsel
- § 10:3 AIA provisions re advice of counsel
- § 10:4 Effective date of AIA provisions re advice of counsel
- § 10:5 Discussion of new 35 U.S.C. § 298

CHAPTER 11. VENUE FOR REVIEW OF USPTO DECISIONS

- § 11:1 Background to the venue changes
- § 11:2 Congressional intent re venue changes
- § 11:3 The AIA amendment to the venue statutes
- § 11:4 Discussion of venue changes

CHAPTER 12. JURISDICTION

- § 12:1 Background re jurisdiction
- § 12:2 Congressional intent re jurisdiction statutes
- § 12:3 AIA provisions re jurisdiction statutes
- § 12:4 Discussion re AIA changes to jurisdiction statutes

CHAPTER 13. JOINDER AND CONSOLIDATION

- § 13:1 Background re joinder and consolidation
- § 13:2 Congressional intent
- § 13:3 America Invents Act changes to joinder and consolidation
- § 13:4 Applicability—Generally
- § 13:5 Effective date
- § 13:6 Required conditions for joinder or consolidation for trial
- § 13:7 Specific applications—Motions for joinder of parties or claims
- § 13:8 Specific topics—"Any" Claim
- § 13:9 Specific applications—Same transaction, occurrence, or series thereof
- § 13:10 —Same patent(s)
- § 13:11 —Same or different products
- § 13:12 —Same industry standard
- § 13:13 —Joining peripheral parties for venue
- § 13:14 —Joining multiple products/one defendant
- § 13:15 Motions to sever
- § 13:16 Consolidation for pre-trial or trial
- § 13:17 Multidistrict litigation
- § 13:18 Waivability

CHAPTER 14. MISCELLANEOUS ENFORCEMENT ISSUES

- § 14:1 Introduction
- § 14:2 The best mode defense is eliminated
- § 14:3 The deceptive intent defense is eliminated

xxxvi

 $\ 14:4$ The biotechnology composition of matter exception in $\ 282$

PART III. USPTO TRIAL PROCEEDINGS

CHAPTER 15. PTAB TRIAL PRACTICE

§ 15:1	The Patent Trial and Appeal Board and its rules—Generally
§ 15:2	PTAB "trials"—Generally
§ 15:3	Starting a preliminary proceeding—The petition generally
§ 15:4	—Claim construction
§ 15:5	Mandatory notices—Real party in interest
§ 15:6	—Counsel in a PTAB trial
§ 15:7	Form of the petition and other filings
§ 15:8	Public availability; default protective order
§ 15:9	Non-default protective orders
§ 15:10	Initial handling of petitions at the PTAB; notice of filing date
§ 15:11	Patent owner's responses prior to institution of trial—Mandatory notices, optional preliminary response, and initial disclosures
§ 15:12	—Mandatory notice
§ 15:13	—Preliminary response
§ 15:14	—Agreed mandatory initial disclosures
§ 15:15	Petitioner's reply to patent owner preliminary response
§ 15:16	Ruling on the petition; institution of trial
§ 15:17	Ruling on the petition: institution denied
§ 15:18	—Judges are not expected to ferret out support for holding claims invalid
§ 15:19	—Lack of clarity
§ 15:20	—Not what the reference teaches
§ 15:21	—Unsupported attorney argument: no evidence in support
§ 15:22	—Conclusory testimony
§ 15:23	—Missing testimony—complex/unpredictable technology
§ 15:24	—Expert Opinion Entitled to Little or No Weight
§ 15:25	—Missing a claim element or feature (gap in evidence)
§ 15:26	—No obviousness analysis

AIA: A Guide to Patent Litigation & Procedure

§ 15:27	—Insufficient analysis of the reference(s)
§ 15:28	—Insufficient reason to combine references
§ 15:29	—No showing of reasonable expectation of
	success
§ 15:30	—No showing of whole combination
§ 15:31	—Statutory disclaimer filed
§ 15:32	—Unable to construe a claim term
§ 15:33	—Discretion not to institute where art was previously presented (35 U.S.C. § 325(d))
§ 15:34	—Discretion not to institute when art was not previously presented
§ 15:35	—Petitioner is estopped
§ 15:36	—IPR Petition filed too soon
§ 15:37	—Sovereign immunity
§ 15:38	The scheduling order and initial status
Ü	conference
§ 15:39	Objections to petition evidence
§ 15:40	Due date 1A: patent owner's motion to amend the claims
§ 15:41	Due date 1B: patent owner response to the
	petition and close of patent owner's discovery and motion period
§ 15:42	Due date 2: petitioner's discovery, petitioner's reply to the patent owner response, petitioner's opposition to motion to amend
§ 15:43	Due date 3: patent owner's further discovery period; patent owner's sur-reply to reply; patent owner's reply to opposition to motion to amend
§ 15:44	Due date 4: Petitioner's sur-reply to reply to
, 10.11	opposition to motion to amend; motion to
	exclude evidence; deadline for parties to
	request oral argument.
§ 15:45	Due date 5: Opposition to motion to exclude
§ 15:46	Due date 6: replies to motions to exclude
	evidence
§ 15:47	Due date 7: oral argument
§ 15:48	Discovery—Generally
§ 15:49	—Mandatory Initial Disclosures
§ 15:50	—Routine Discovery and Additional Discovery
§ 15:51	—"Interests of justice" standard
§ 15:52	—"Good cause" standard
§ 15:53	Correcting Mistakes
§ 15:54 to	o 15:55 [Reserved]
§ 15:56	Motions—generally
§ 15:57	Motions—For joinder
	-

§	15:58	—For termination
§	15:59	—To exclude evidence
§	15:60	Motions-To strike
§	15:61	Evidence
§	15:62	Supplemental evidence and supplemental information
§	15:63	Settlement
§	15:64	Decisions on motions and petitions; final written decision
§	15:65	Decisions on motions and petitions; final decision—Final written decisions on the merits
§	15:66	—Rulings on motions to amend in final written decisions
§	15:67	—Prior judicial rulings
§	15:68	Rehearing requests
§	15:69	Expungement of confidential information
§	15:70	Appeals from final written decisions and other rulings
§	15:71	Appeals—court review of PTAB decisions whether to institute
§	15:72	—The "case or controversy" requirement for Art. III judicial review
§	15:73	—Standard of review of final written decisions
§	15:74	—Burden shifting
Ş	15:75	—Procedural issues
		to 15:91 [Reserved]
	15:92	
§	15:93	PTAB Statistics & Retrospective on the AIA 10 years in

CHAPTER 16. POST-GRANT REVIEW

_	
§ 16:1	Background and congressional intent
§ 16:2	The new statute—Post-grant review
§ 16:3	Post-grant review procedures generally
§ 16:4	Filing a petition for post-grant review
§ 16:5	Patent owner preliminary response (three months after the petition)
§ 16:6	Institution of post-grant review: beginning of "trial"
§ 16:7	Trial proceedings; initial conference call (1 month)
§ 16:8	Patent owner response and amendment (3 months after trial commences)
§ 16:9	Multiple proceedings and joinder

AIA: A Guide to Patent Litigation & Procedure

§ 16:	10 Submitting supplemental information
§ 16:	
§ 16:	12 Relationship of post-grant review to civil litigation
§ 16:	13 Estoppels
§ 16:	14 Settlements
§ 16:	15 USPTO certificate and intervening rights
§ 16:	16 Rehearing and judicial review
§ 16:	17 Effective dates
CII	ADTED 17 DEVIEW OF COVEDED
_	APTER 17. REVIEW OF COVERED
	SINESS METHOD PATENTS
§ 17:	e e
§ 17:5	The new statute—Review of business method patents
§ 17:3	
§ 17:	e
§ 17:	
§ 17:0	
§ 17:	•
§ 17:8	•
§ 17:	1 0
§ 17:	
§ 17:	11 Effect of CBM review on civil litigation
§ 17:	
§ 17:	13 —Stay of litigation
§ 17:	14 —Preliminary injunctions
§ 17:	15 Estoppels
§ 17:	16 PTAB statistics re CBM reviews
СН	APTER 18. INTER PARTES REVIEW
§ 18:	1 Background and congressional intent
§ 18:	-
§ 18:	3 Inter partes review procedures generally
§ 18:4	
§ 18:	
5	after the petition)
§ 18:0	Institution of <i>inter partes</i> review: beginning of "trial"
§ 18:	7 Trial proceedings; initial conference call (1 month)
§ 18:	Patent owner response and amendment (3 months after trial commences)

§ 18:9	Multiple proceedings and joinder
§ 18:10	Submitting supplemental information
§ 18:11	Discovery and trial procedure
§ 18:12	Relationship of IPR to civil litigation—
	Automatic stays
§ 18:13	—Permissive stays
§ 18:14	Estoppels
§ 18:15	Settlements
§ 18:16	USPTO certificate and intervening rights
§ 18:17	Rehearing and judicial review
§ 18:18	Effective dates
§ 18:19	PTAB Statistics

CHAPTER 19. DERIVATION PROCEEDINGS REPLACE INTERFERENCES

§ 19:1	Background
§ 19:2	Congressional intent
§ 19:3	The new statute re derivation proceedings and
	derived patents
§ 19:4	Derivation proceedings—Generally
§ 19:5	Filing a petition
§ 19:6	The respondent's responses
§ 19:7	Institution of a derivation proceeding
§ 19:8	After institution of derivation proceeding
§ 19:9	Derivation actions between owners of issued
	patents
§ 19:10	Effective date
§ 19:11	Statistics

PART IV. USPTO NON-TRIAL SUBMISSIONS OF ART OR INFORMATION; REEXAMINATIONS

CHAPTER 20. PRE-ISSUANCE SUBMISSIONS

$\S 20:1$	Background
$\S 20:2$	Congressional intent
§ 20:3	The amended statute
§ 20:4	New rule 1.290 for third party preissuance
	submissions

- § 20:5 Filing a preissuance submission under the new rule
 § 20:6 The timing requirement
 § 20:7 Subsequent handling of § 1.290 submissions
 § 20:8 Protests under 35 U.S.C. § 122(c) and 37 C.F.R.
- § 1.291 survive § 20:9 USPTO statistics re pre-issuance submissions

CHAPTER 21. POST-ISSUANCE SUBMISSIONS

- § 21:1 Background
- § 21:2 Congressional intent
- § 21:3 The amended statute regarding post-issue submissions
- § 21:4 New regulation 37 C.F.R. § 1.501
- § 21:5 Filing a post-issue citation of art or information
- § 21:6 USPTO use of a post-issue submission

CHAPTER 22. SUPPLEMENTAL EXAMINATION

- § 22:1 Background
- § 22:2 Congressional intent
- § 22:3 The new statute for supplemental examination
- § 22:4 General overview of supplemental examination
- § 22:5 Requesting supplemental examination
- § 22:6 USPTO determination re a substantial new question of patentability
- § 22:7 Conclusion of supplemental examination
- § 22:8 Benefits of supplemental examination
- § 22:9 USPTO statistics re supplemental examinations

CHAPTER 23. REEXAMINATIONS (INTER PARTES AND EX PARTE)

- § 23:1 Reexaminations generally
- § 23:2 Congressional intent
- § 23:3 AIA provisions re *inter partes* reexamination statute
- § 23:4 New USPTO rules re inter partes reexamination
- § 23:5 AIA provisions re ex parte reexamination
- § 23:6 New USPTO rules re ex parte reexamination
- § 23:7 Appeals from ex parte reexamination

PART V. MISCELLANEOUS PROVISIONS

CHAPTER 24. ASSIGNEE FILING AND INVENTOR'S OATH

§ 24:1	Background
§ 24:2	Congressional intent
§ 24:3	The amended and new statutes
§ 24:4	The new and amended regulations
§ 24:5	Practice—The applicant
§ 24:6	—The name of the inventor
§ 24:7	—The oath or declaration
§ 24:8	—Substitute statements
§ 24:9	—Priority claims
§ 24:10	—Application data sheet
§ 24:11	—USPTO recommendations
§ 24:12	Litigation—Assignor estoppel

§ 24:13 Litigation—Licensee estoppel

CHAPTER 25. PTO FEE SETTING AND FEES

- § 25:1 Background and congressional intent
- § 25:2 The amended statutes
- § 25:3 Discussion of AIA Section 10 fee setting
- § 25:4 Discussion of AIA Section 11 fees

CHAPTER 26. FEE DIVERSION-PTO FUNDING

- § 26:1 Background and congressional intent
- § 26:2 The amended statute
- § 26:3 Discussion of revisions to 35 U.S.C. § 42

CHAPTER 27. REMOVAL OF DECEPTIVE INTENT FROM STATUTE

- § 27:1 Background and congressional intent
- § 27:2 The AIA eliminates all deceptive intent requirements from the patent statute
- § 27:3 Discussion of AIA amendments re error and deceptive intent

CHAPTER 28. SATELLITE OFFICES

§ 28:1 Background and congressional intent

- § 28:2 AIA provisions re satellite offices
- § 28:3 Discussion of satellite office provisions

CHAPTER 29. PRIORITIZED EXAMINATION & PRIORITY EXAMINATION FOR IMPORTANT TECHNOLOGIES

- § 29:1 Background
- § 29:2 Congressional intent
- § 29:3 The amended statutes re accelerated examination
- § 29:4 Non-fee based revised accelerated examination provisions
- § 29:5 Fee-based accelerated examination provisions
- § 29:6 Fee-based accelerated examination—Conditions
- § 29:7 USPTO statistics on Track One petitions

CHAPTER 30. PATENT TERM EXTENSION CALCULATION

- § 30:1 Background and congressional intent
- § 30:2 The amended statute
- § 30:3 Discussion of patent term extension provisions

CHAPTER 31. OTHER AIA PROVISIONS AND PTO PROGRAMS

- § 31:1 Background
- § 31:2 Funding agreements (AIA § 3(g)(7)(A, B); § 13(a); § 20(i)(2))
- § 31:3 Travel expenses; payment of administrative law judges (AIA § 21)
- § 31:4 Study on AIA implementation (AIA § 26)
- § 31:5 Study on genetic testing (AIA § 27)
- § 31:6 The patent ombudsman program (AIA § 28)
- § 31:7 Studying the diversity of applicants (AIA § 29)
- § 31:8 Sense of congress re small businesses and inventors (AIA § 30)
- § 31:9 Study on international patent protection for small business (AIA § 31)
- § 31:10 Pro bono program (AIA § 32)
- § 31:11 Study on patent litigation by non-practicing entities (AIA § 34)
- § 31:12 Budgetary effects (AIA § 36)

CHAPTER 32. EFFECTIVE DATES

§ 32:1 Background and congressional intent

- § 32:2 The AIA effective date provision
- § 32:3 Table of AIA effective dates

APPENDICES

- Appendix 1. House Report Excerpts
- Appendix 2. The Leahy-Smith America Invents Act
- Appendix 3. Trial Practice Before the Patent Trial and Appeal Board (37 C.F.R. Part 42)
- $\begin{array}{ccc} {\bf Appendix\ 4.} & {\bf Requirement\ For\ a\ Disclosure\ of\ The\ Best} \\ & {\bf Mode} \end{array}$
- Appendix 5. Claims Directed To Or Encompassing a Human Organism
- Appendix 6. Tax Strategies Are Deemed To Be Within the Prior Art
- Appendix 7. HR 6621 as Passed by Congress
- Appendix 8. PTAB Representative Decision on Additional Discovery in an IPR
- Appendix 9. PTAB Trial Practice Guide Update (July 2019)

Table of Laws and Rules

Table of Cases

Index