



The Race to the Patent Office – The Impact of the America Invents Act

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America Invents Act

- US Patent System transitioned from First-To-Invent to First-To-File System on March 16, 2013.
- Filing an application before March 16, 2013 **created potential value** because it decreases the pool of prior art available to the Examiner.

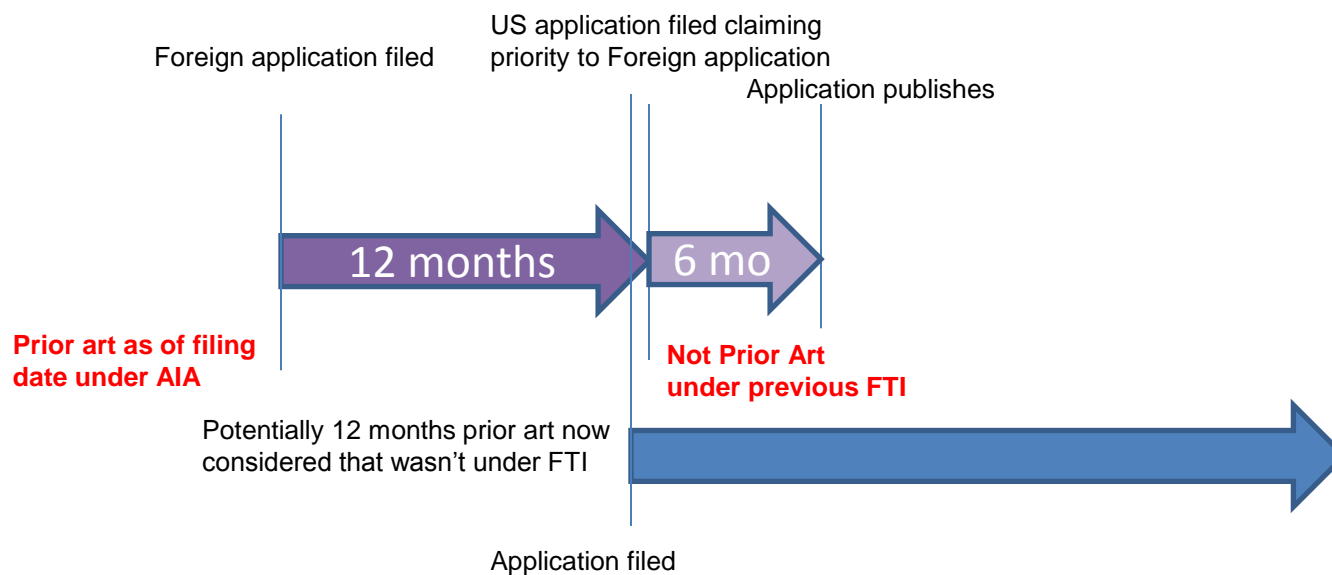


America Invents Act

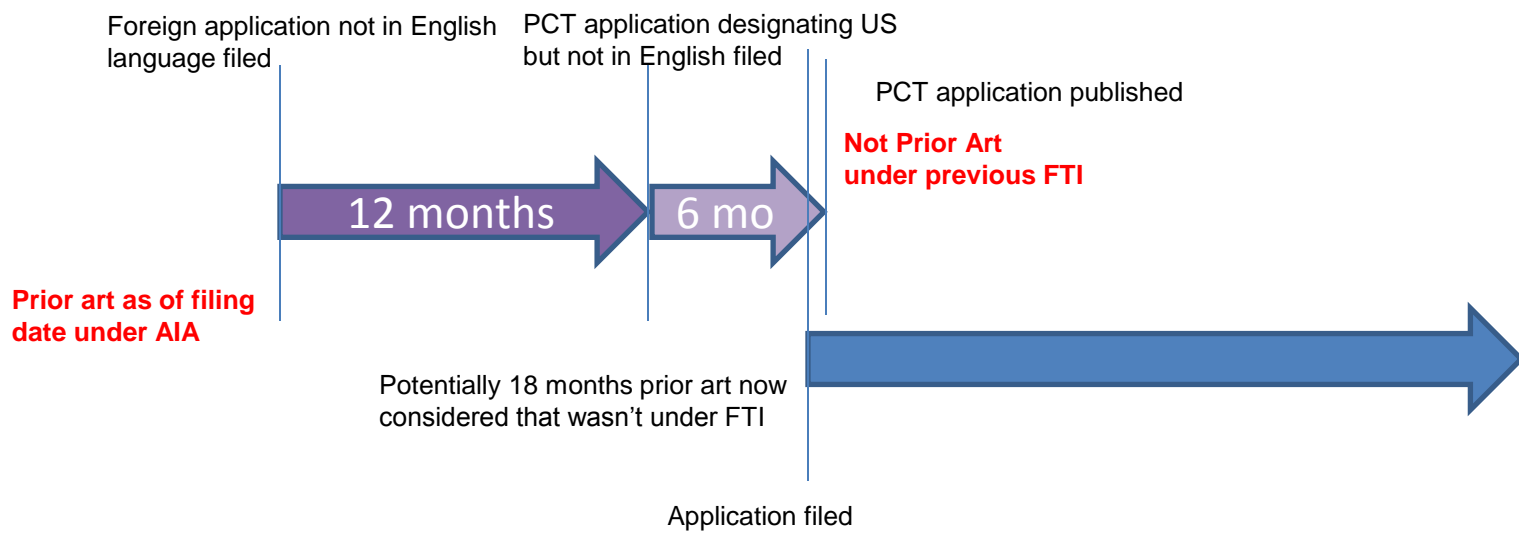
First-to-Invent (FTI) to First-Inventor-to-File (FITF) Transition

- Effective Date – March 16, 2013
 - “shall apply to any application for patent, and to any patent issuing thereon, that contains or contained at any time ... a claim to a claimed invention that has an effective filing date ... that is on or after the effective date described in this paragraph [March 16, 2013]”
- Benefits Lost under FITF
 - (1) Open to new, previously unconsidered, class of prior art
 - (2) Can't swear behind any reference
 - (3) One-year grace period limited to applicant's own disclosure of invention

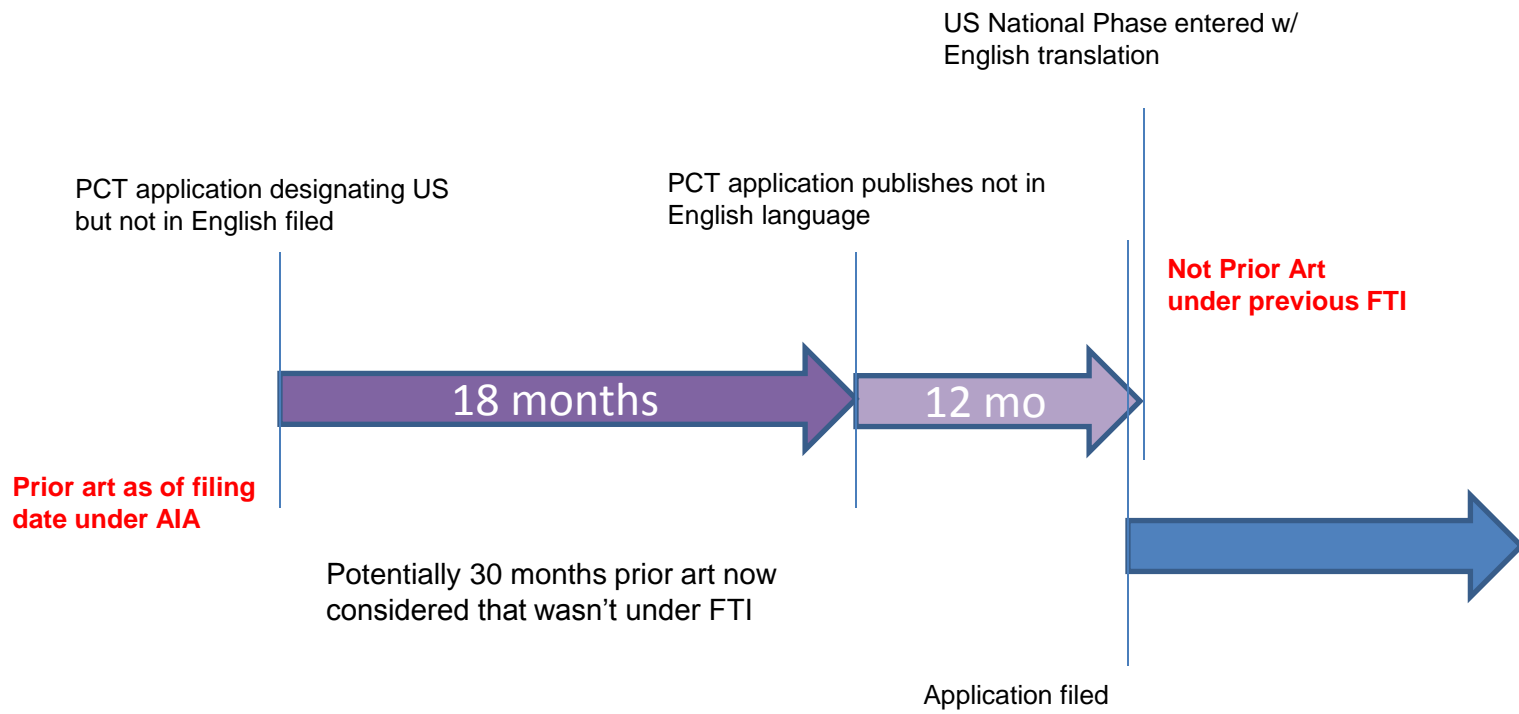
New Class of Prior Art Previously Not Considered by USPTO



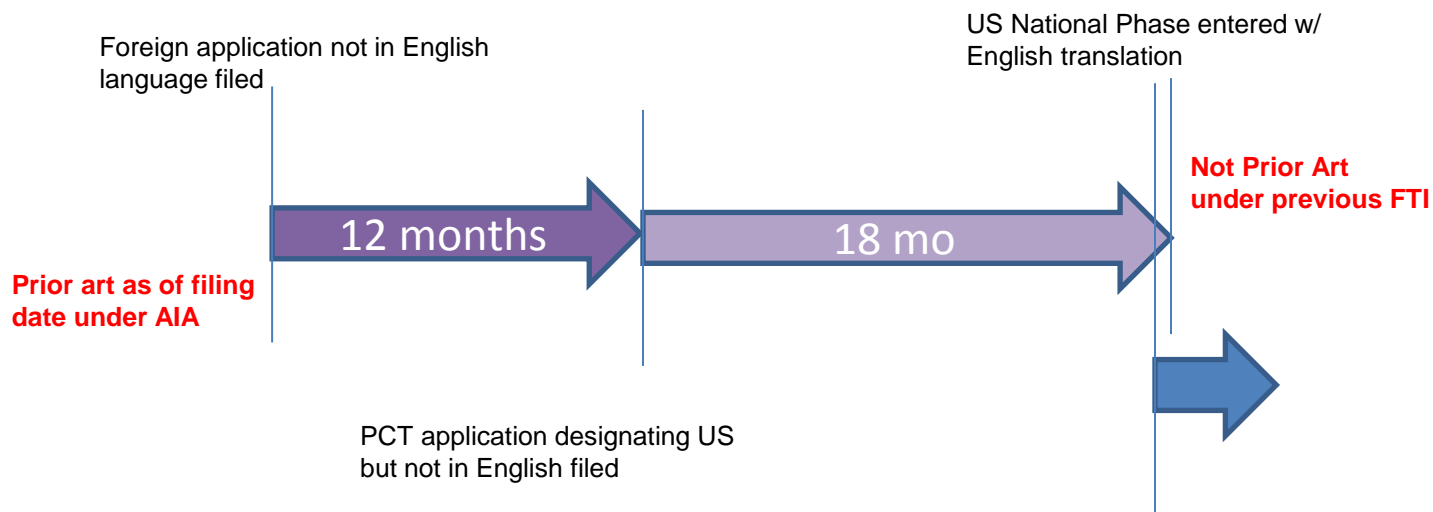
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Potentially 30 months prior art now considered that wasn't under FTI

Application filed

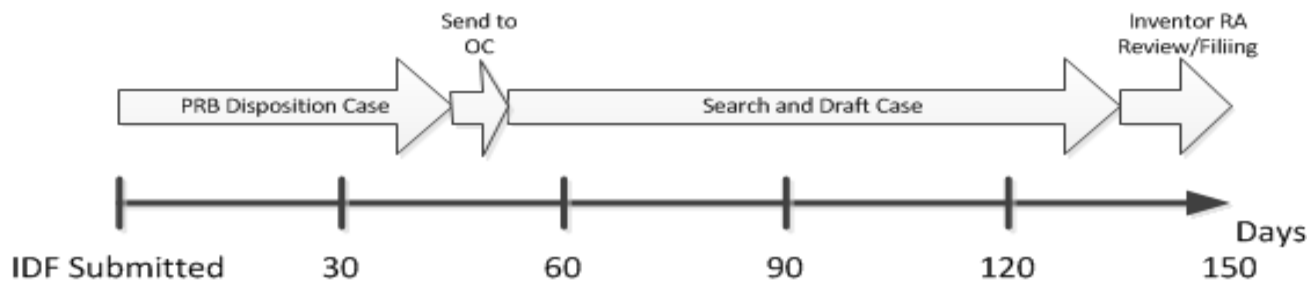


AIA Prosecution Strategy

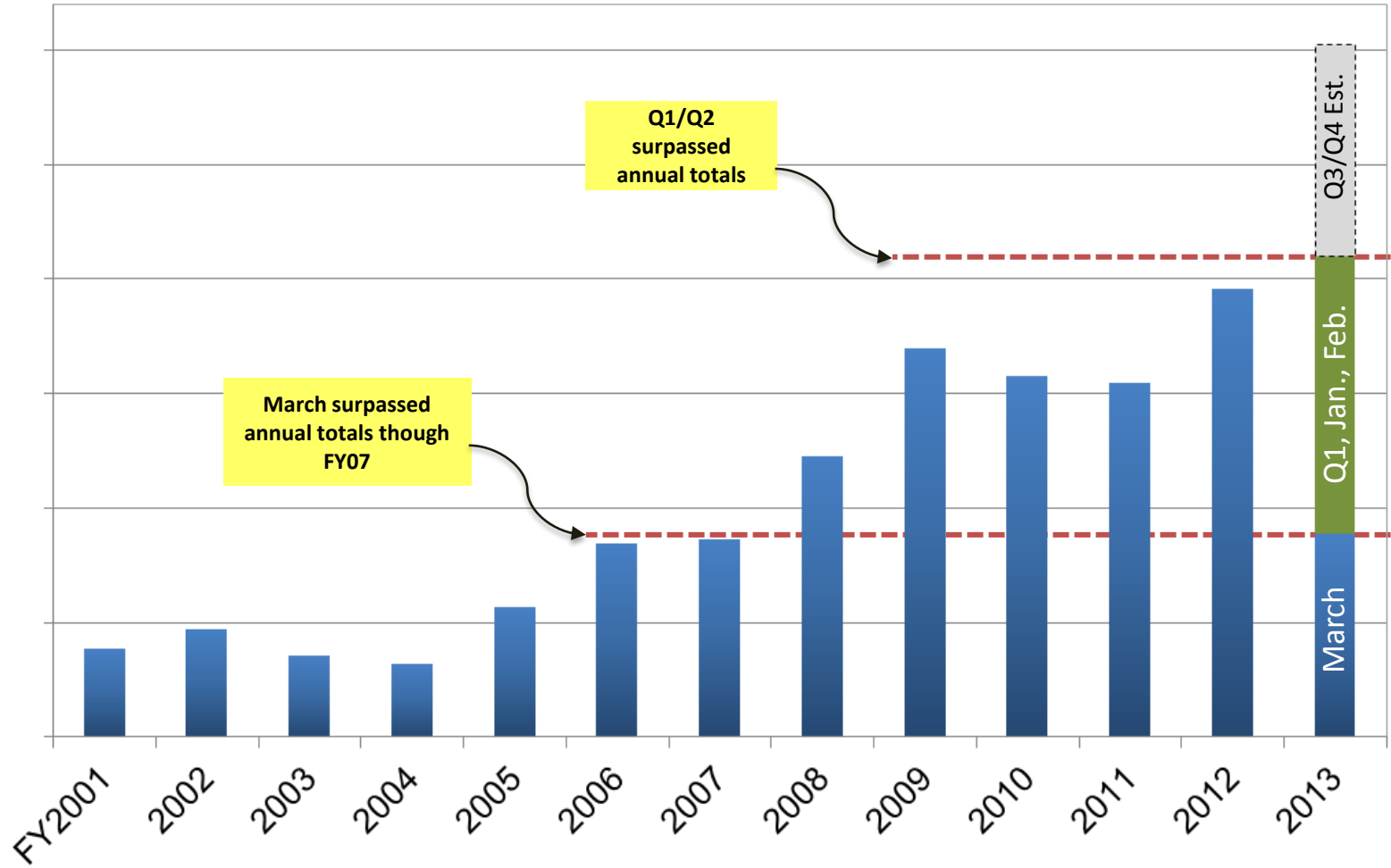
- Accelerate selected cases to ensure that they were filed before March 16, 2013 and are examined under first-to-invent system.
- Tightly manage prosecution timeline of cases, advance from invention disclosure to filing quickly

Start of the Race

- Compressed Prosecution Timeline
 - Shortened timeline for Patent Review Board disposition for a submitted IDF
 - Concurrent Search and Drafting
 - Shortened window for patent attorney to prepare draft application
 - Shortened window for inventor to review and attorney to finalize application

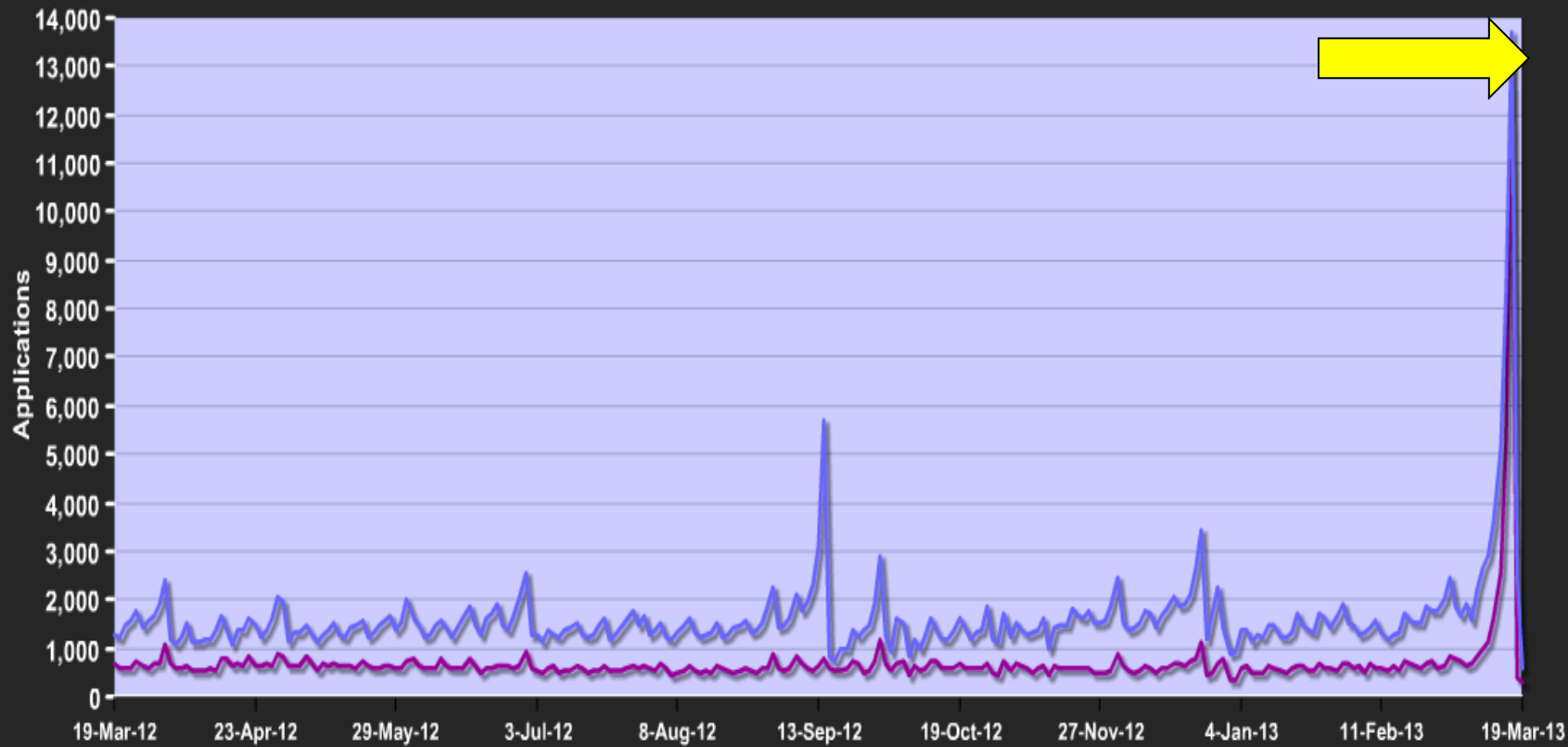


Head Start on the Race



USPTO New Filings

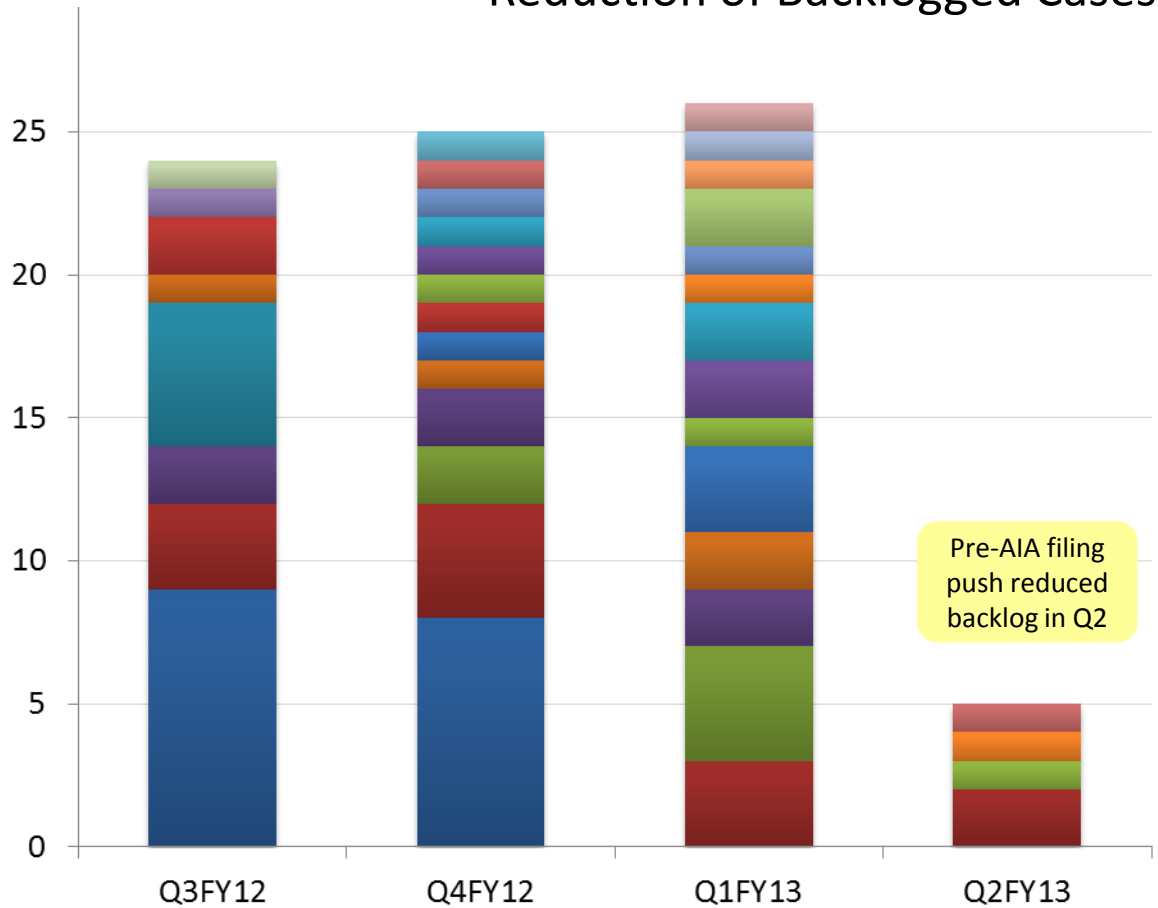
Serialized (non-RCE) and Provisional Patent Applications Received March 19, 2012 Through March 19, 2013 (preliminary)



Serialized (non-RCE) Applications Filings Provisional Application Filings

Results of the Race

Reduction of Backlogged Cases



AIA Acceleration Impact

- Avg. time to filing reduced 44%
 - Time to PRB disposition - reduced **38 days**
 - Disposition to draft received - reduced **63 days** (*concurrent PFS*)
 - Review - reduced **23 days**

