

## THE NEXT AIA LAW CHANGE IS FAST APPROACHING

On March 16, 2013, the USPTO will implement the First-To-File provisions of the AIA. This impending transition from the pre-AIA first-to-invent patent system to the AIA's first-inventor-to-file patent system has been the subject of many recent articles and commentary recommending a rush to file patent applications before March 16, 2013. In general, filing a new application before March 16, 2013 may be beneficial, for simply avoiding enlarged prior art and the potential risk of a Post Grant Review under the AIA. Foreign filers may also want to consider filing their foreign applications before March 16, 2013 in order to preserve a potential option to take advantage of either pre-AIA or AIA provisions. However, the pros and cons for filing before or after March 16, 2013 vary depending on each applicant's circumstances. Ken Hattori provides some insights on this in his article posted on: <http://www.ipwatchdog.com/2012/10/14/the-aia-is-the-first-universally-equal-patent-law-in-the-world/id=28850/>. Mr. Hattori will post another article on this subject around the beginning of March on IPWatchdog.

Pre-AIA applies if all the claims presented in a U.S. application filed on or after March 16, 2013 have an effective filing date before March 16, 2013 (i.e., claims entitled to the benefit of the foreign priority date). This

would be true even if newly added subject matter is present, but never claimed, in the U.S. application filed on or after March 16, 2013. Conversely, AIA irreversibly applies if, at any time, a claim having an effective filing date on or after March 16, 2013 is presented (i.e., a claim covering the newly added subject matter). The same potential option for either pre-AIA or AIA provisions may also exist for a continuing application (continuations, continuations-in-part, or divisionals) filed on or after March 16, 2013. A strategy to transition from a pre-AIA to an AIA application, however, requires careful consideration and handling. For instance, a transitional AIA application may also remain subject to pre-AIA section 102(g) prior art if such an application or its U.S. parent includes or included at any time a claim having an effective filing date before March 16, 2013. Therefore, please contact us for any questions you may have.

If an applicant desires to file a new application prior to the March 16, 2013 date in order to be treated under pre-AIA rules, please alert us of such filings as soon as possible. It is anticipated that the increased number of filings may cause delays on the USPTO electronic filing system.

Ken Hattori has published a book on the AIA rules, which is available on Amazon.co.jp. The title of the book is 新米国特許法 (America Invents Act) 対訳付き.

*If you have any questions regarding the content of this newsletter, please contact [cboyer@whda.com](mailto:cboyer@whda.com). The WHDA Newsletter is an official publication of Westerman, Hattori, Daniels and Adrian, LLP. This newsletter is for informational purposes only.*

## USPTO Fee Increase

The USPTO will increase their fees on March 19, 2013. Below is a list of some of the new fees:

### Utility Applications

Filing fee	\$280*
Search fee	\$600*
Examination fee	\$720*
Independent claims in excess of 3	\$420 ea.*
Claims in excess of 20	\$80 ea.*
Multiple dependent claims	\$780*
Utility application size fee	\$400*
(for each 50 sheets that exceeds 100)	

### Design Applications

Filing Fee	\$180*
Search Fee	\$120*
Examination Fee	\$460*

### National Stage Applications

Filing fee	\$280*
Search fee	\$480*
(Provided to USPTO)	
Search Fee	\$600*
(All other Situations)	
Examination fee	\$720*
Independent claims in excess of 3	\$420 ea.*
Claims in excess of 20	\$80 ea.*
Multiple dependent claims	\$780*
Utility application size fee	\$400*
(for each 50 sheets that exceeds 100)	

### Request for Continued Examination (RCE)

\$1,200.00*	(First Request)
\$1,700.00*	(Second and Subsequent RCE Request)

### Extensions of Time Fees

1 month	\$200*
2 months	\$600*
3 months	\$1,400*
4 months	\$2,200*
5 months	\$3,000*

\*=50% reduction of fees for small entity

To view the additional fee increases, please visit the USPTO website at [www.uspto.gov](http://www.uspto.gov).

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