A review of HR 6621, dated November 30, 2012

By Richard Neifeld, Neifeld IP Law, PC[1]

HR 6621 is titled "A BILL To correct and improve certain provisions of the Leahy-Smith America Invents Act and title 35, United States Code." It is being considered in the lame duck session of Congress.

The following summarizes HR 6621 Technical corrections that are in fact substantive changes to the law.

35 USC 298 (providing that failure to present evidence of advice of counsel cannot be used to prove will ful infringement) made effective on date of enactment of HR 6621.

35 USC 311(c)(precluding an IPR petition during the first 9 months after issuance of a patent and from the date a PGR is instituted until the date the PGR is terminated) amended to not apply to a "patent described in section 3(n)(1) of the" AIA. This provision allows an IPR petition to be filed from the date of issuance of any patent not subject to the first inventor to file provisions of the AIA.

35 USC 325(f) is repealed. (325(f) precluded a PGR for a reissued patent that did not include broader claims at a time after the deadline for filing a PGR against the original patent.)

35 USC 115(f)(providing the deadline for filing all inventor declarations) revised to reset the deadline for filing all inventor declarations to the date the issue fee is paid.

35 USC 154(b)(patent term adjustment provisions) amended.

First, to clarify that the 35 USC 154(b)(1)(A)(i)(II), "A" time periods start upon commencement of the national stage of the PCT application. National stage commences pursuant to 35 USC 371(b) at expiration of 30 months from PCT priority date, but will commence earlier only if the applicant files an express request for national stage entry prior to that date. See 35 USC 371(b) and (f); and PCT article 39(1)(a).

Second, to clarify that the 35 USC 154(b)(1)(B), "B" time period starts upon the filing date of a US application and filed under 111(a), and upon the national stage commencement date for a PCT 371 national stage entry of a PCT application.

Third, by amending 35 USC 154(b)(3) to relieve the USPTO from having to notify the applicant of PTA at time of allowance and requiring the USPTO to notify the applicant no later than the date of issuance.

Fourth, by making the exclusive remedy for review of a decision by the USPTO in response to a request by the patentee for reconsideration of PTA, to be a civil action in the EDVA as otherwise specified in 35 USC 154(b)(4).

Fifth, by amending 35 USC 154(b)(4)(B) to allow a third party to challenge the USPTO's PTA determination after the USPTO has issued a decision on an applicant's request for reconsideration of PTA pursuant to the amendment to 35 USC 154(b)(3).

35 USC 372 is repealed. (372 was the "Improper Applicant" provision, which provided that the USPTO would not accept a PCT application into the US national stage, unless the PCT application had been filed by an entity qualified to be the applicant of a US 111(a) application. That provision required filing a PCT application in the names of the inventors for purposes of the US national stage under our pre AIA law. Now that the applicant may be a juristic entity, under

the AIA law, 35 USC 372 no longer served that limiting purpose.)

35 USC 135(a), as amended by the AIA, with bill line numbering preserved, is revised to read as follows:

‘‘(a) INSTITUTION OF PROCEEDING.—
‘‘(1) IN GENERAL.—An applicant for patent may file a petition with respect to an invention to institute a derivation proceeding in the Office. The petition shall set forth with particularity the basis for finding that an individual named in an earlier application as the inventor or a joint inventor de rived such invention from an individual named in the petitioner’s application as the inventor or a joint in ventor and, without authorization, the earlier appli cation claiming such invention was filed. Whenever the Director determines that a petition filed under this subsection demonstrates that the standards for instituting a derivation proceeding are met, the Di rector may institute a derivation proceeding.
‘‘(2) TIME FOR FILING.—A petition under this section with respect to an invention that is the same or substantially the same invention as a claim con tained in a patent issued on an earlier application, or contained in an earlier application when published or deemed published under section 122(b), may not be filed unless such petition is filed during the 1- year period following the date on which the patent containing such claim was granted or the earlier ap plication containing such claim was published, whichever is earlier.
‘‘(3) EARLIER APPLICATION.—For purposes of this section, an application shall not be deemed to be an earlier application with respect to an inven tion, relative to another application, unless a claim to the invention was or could have been made in such application having an effective filing date that is earlier than the effective filing date of any claim to the invention that was or could have been made in such other application.
‘‘(4) NO APPEAL.—A determination by the Di rector whether to institute a derivation proceeding under paragraph (1) shall be final and not appeal

19 able.’’.
20 (2) EFFECTIVE DATE.—The amendment made
21 by paragraph (1) shall be effective as if included in
22 the amendment made by section 3(i) of the Leahy-
23 Smith America Invents Act.
24 (3) REVIEW OF INTERFERENCE DECISIONS.—
25 The provisions of sections 6 and 141 of title 35,
1 United States Code, and section 1295(a)(4)(A) of
2 title 28, United States Code, as in effect on Sep
3 tember 15, 2012, shall apply to interference pro
4 ceedings that are declared after September 15,
5 2012, under section 135 of title 35, United States
6 Code, as in effect before the effective date under sec
7 tion 3(n) of the Leahy-Smith America Invents Act.
8 The Patent Trial and Appeal Board may be deemed
9 to be the Board of Patent Appeals and Interferences
10 for purposes of such interference proceedings.

The proposed 35 USC 135(a)(2), attempts to clarify that the 1 year deadline to file a petition runs from date of publication of the respondent's claim. It applies the "same or substantially the same invention" language to define the scope of claim correspondence for the time bar.

35 USC 154(c)(1), has its applicability amended, so that the grand fathered seventeen year from grant patent term provision for applications filed prior to June 8, 1995, does not apply to a patent issued from such an application pending after 1 year after enactment of HR 6621.

1. I can be reached at 703-415-0012 or via the firm web site: Neifeld.com.