AIA Technical Amendment (H.R. 6621) Moving Forward

December 17, 2012 Dennis Crouch

By Dennis Crouch

Representative Lamar Smith has put forward an amended version of H.R. 6621 (/media/docs/2012/12/BILLS-112hr6621-SUS.pdf). The amended bill removes the provision that would have crippled the value of pending pre-Uruguay Round Agreement Act (URAA). In my estimation about 200 of those applications filed prior to June 8, 1995 are still in prosecution at the USPTO. That change makes the bill less controversial and sets up easy passage in the House leadership has set the bill up for a voice vote this week, perhaps as early as Tuesday, December 18. At this point no opposition to the bill has been raised in Congress. To become law, the Senate would need to pass the bill before its December recess.

Important changes include the following:

Less Patent Term Adjustment: The current language of Section 154(b) suggests an applicant may begin accumulating PTA as of the filing date of an international PCT application that is later followed by a US national stage application. The proposed amendment would eliminate that option by clarifying that the PTA calculations only begin "commencement of the national stage under section 371 in an international application." The change also provides that the PTO calculate PTA with the issuance rather than at the notice of allowance. This is obviously problematic for some because it blocks patentees from clearing-up PTA issues prior to patent issuance. See 35 U.S.C. 154(b)(3)(C). This also effectively limits the timing for administratively challenging PTA determinations to a two-month period. In my first

amendment would require an administrative challenge prior to filing a district court challenge. Thus, the two-month-from-issuance deadline becomes a fairly hard deadline for correcting PTA. The statute does not clarify what happens if the USPTO fails to decide the PTA challenge prior to the six-month deadline for filing a district court case. Courtenay Brinkerhoff has a nice post criticizing the provision here: http://www.pharmapatentsblog.com/2012/12/11/hr-6621-adds-new-roadblocks-to-patent-term-adjustment-appeals/.

Post-Grant Dead Zone: Once the AIA is fully implemented, an issued patent will be immediately challengeable through a post-grant review. Then, after a nine-month window, challenges will be available through *inter partes* review. However, the AIA has bit of an implementation issued because (1) post-grant reviews will only be available for patents issued on applications filed on or after March 16, 2013; (2) *inter partes* reviews are available for all patents, but only those that have been issued for at least 9-months; and (3) the old *inter partes* reexaminations are no longer available. This creates something of a dead zone in that for the next couple of years patents will not be challengeable through any *inter partes* system until 9-months after issuance. H.R. 6621 would eliminate that 9-month dead zone by allowing *inter partes* reviews to be filed at any time for applications with an effective filing date before March 16, 2013.

Delaying Inventor's Oath: Section 115(f) of the AIA indicates that an either (1) an oath, (2) a substitute statement, or (3) sufficient assignment must be submitted prior to the notice of allowance of a patent application. The amendment would push that deadline back to be "no later than the date on which the issue fee for the patent is paid."

Sharing Fees Between the Patent and Trademark Side: The AIA requires that, for the most part, fees collected on patents be used to cover "administrative costs of the Office relating to patents" while fees collected on the trademark side be used to cover "administrative costs of the Office relating to

tion and thus allow patent fees to pay for trademark operations and vice versa.

Derivation Proceedings: The AIA eliminated the ongoing viability of interference proceedings (although some will be pending for years) but created a new beast known as a derivation proceeding. H.R. 6621 would clean up the language for initiated a derivation proceeding under 35 U.S.C. §135(a). I need to think some about the language to understand the substance. I have created a rough mark-up of this language. (/media/docs/2012/12/CompareNewOldDerivation.docx).

About Dennis Crouch

Law Professor at the University of Missouri School of Law View all posts by Dennis Crouch →

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