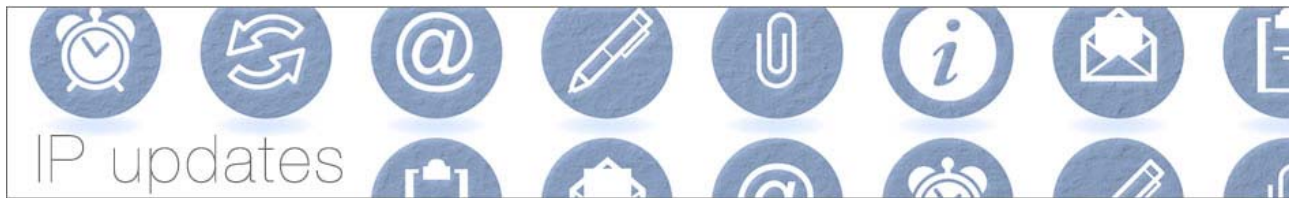


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New Bill Proposing Corrections to the America Invents Act

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Practice

Patent Office Practice

America Invents Act

On November 30, 2012, Representative Lamar Smith (R-Texas) introduced a bill “[t]o correct and improve certain provisions of the Leahy-Smith America Invents Act [‘AIA’] and title 35, United States Code.” H.R. 6621. The bill not only corrects several minor errors, but also proposes a few important changes to the AIA and other provisions of the Patent Act. This update discusses several of those important changes, including provisions that would impact the timing of the new *inter partes* proceedings, curb the term of pending pre-GATT patent applications, and modify aspects of patent term adjustment (“PTA”).

Eliminating the *Inter Partes* Proceeding “Dead Zone”

The AIA provides two new *inter partes* proceedings: post-grant review (“PGR”) and *inter partes* review (“IPR”). To prevent copending PGR and IPR proceedings, the AIA includes a provision that precludes IPR requests before the expiration of the nine-month post-grant period in which PGR requests are permitted. That provision, however, created a nine-month “dead zone” in which a challenger of a pre-AIA patent cannot file either a PGR request or an IPR request. (A pre-AIA patent is not subject to the “first-inventor-to-file” provisions that take effect on March 16, 2013.) In fact, in its current form, the AIA prevents PGR proceedings on pre-AIA patents, yet still

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after grant of the pre-AIA patent. Section 1(d) of H.R. 6621 would eliminate the “dead zone” by providing that the AIA provision setting the waiting period for IPR filing (35 U.S.C. § 311(c)) does not apply to pre-AIA patents.

The AIA also currently includes a provision that bars PGRs for claims in a reissue patent that are identical to or narrower than a claim in the original patent if the PGR request is filed greater than nine months after issuance of the original patent. 35 U.S.C. § 325(f). Section 1(d) of H.R. 6621 would make those claims subject to PGR proceedings by eliminating that provision.

Reducing the Term of Pending Pre-GATT Applications

H.R. 6621 would severely curb the term of pre-GATT applications still pending with the U.S. Patent and Trademark Office (“PTO”) one year after enactment of H.R. 6621. In 1994, the United States enacted the Uruguay Round Agreements Act, implementing the GATT twenty-year patent term for any patent filed on or after June 8, 1995. Pre-GATT patents and patent applications currently are entitled to a term that is the greater of twenty years from the earliest filing date (the GATT rule) or seventeen years from issuance (the old U.S. rule). Under section 1(m) of H.R. 6621, applications that remain pending on the one-year anniversary of the enactment of H.R. 6621 would have a term of twenty years from the earliest filing date.

Changing Certain Patent Term Adjustment (“PTA”) Provisions

Currently, 35 U.S.C. § 154(b)(1)(B) provides extension of patent term in certain instances when a patent application is pending more than three years after “the actual filing date of the application in the United States.” Section 1(h)(1) of H.R. 6621 would change that starting date to the actual U.S. filing date for applications filed under 35 U.S.C. § 111(a), or to the commencement of the U.S. national stage under section 371 for international applications.

Section 1(h)(2) of H.R. 6621 would also change the timing of the PTO’s transmission of the notice of determination of PTA. Specifically, the PTO would transmit the notice no later than issuance of the patent rather than with the

Finally, under section 1(h)(3) of H.R. 6621, an appeal to the U.S. District Court for the Eastern District of Virginia would be the exclusive remedy for challenging an unsatisfactory Director's decision on a request for reconsideration of PTA. H.R. 6621 would also move the period for such an appeal to within 180 days of the Director's decision rather than the current 180 days after the grant of the patent.

Addressing the Effective Date of the AIA Provisions Concerning Advice of Counsel

Under a provision of the AIA, a party's failure to obtain the advice of counsel regarding alleged patent infringement cannot be used in court to prove willful infringement or intent to induce infringement. 35 U.S.C. § 298. Section 1(a) of H.R. 6612 would apply that provision to any civil action commenced on or after the date of enactment of the AIA, and would not limit its application to patents issued on or after the enactment date.

Changing Certain Provisions Directed to Derivation Proceedings and Interferences

Section 1(k) of H.R. 6621 changes the time for filing a petition to institute a derivation proceeding and adds a definition of the term "earlier application." In addition, section 1(k) of H.R. 6621 would clarify the PTO's jurisdiction and appeal process for interferences declared after September 15, 2012. Specifically, such interferences would be subject to the pre-AIA provisions of the Patent Act governing the Board of Patent Appeals and Interferences and appeals to the Court of Appeals for the Federal Circuit, namely, 35 U.S.C. §§ 6 and 141, and 28 U.S.C. § 1295(a)(4)(A).

Changing Certain Provisions Concerning the Applicant

Section 1(f) of H.R. 6621 provides that an applicant must comply with the oath or declaration provision of the Patent Act before paying the issue fee rather than conditioning the issuance of a Notice of Allowance on prior compliance, as the current law states. Section 1(i) of H.R. 6621 also proposes repealing

that the PTO cannot accept an international application designating the United States if it was filed by someone who was not qualified to file a U.S. patent application under section 111, i.e., someone other than an inventor.

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