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SPECIAL
REPORT

U.S. CONGRESS CORRECTS ASPECTS OF THE AIA

January 2, 2013

Congress today passed a bill (H.R. 6621) making technical corrections to the America Invents Act. President Obama is expect to sign ("enact") the bill as soon as today. In addition to correcting a number of non-substantive typographical errors, the bill makes the following seven changes to the AIA that will affect prosecution at the United States Patent and Trademark Office (USPTO), post-issuance proceedings at the USPTO, and/or certain civil actions.

I. PGR And IPR "Dead Zone" Has Been Eliminated

The AIA's applicability provisions for Post-Grant Review (PGR) and *Inter Partes* Review (IPR) created a "dead zone" during which no challenge to claims of certain patents was possible.[1] Specifically, the AIA prevented both PGR and IPR challenges to certain patents within the first nine months after the patent issued. This dead zone resulted from the AIA (1) only allowing PGR for patents subject to post-AIA §§102 and 103,[2] and (2) preventing a petition for IPR from being filed within the first nine months after any patent has been granted.

As of the date of enactment, IPR will be available immediately after issue for patents that are not subject to post-AIA §§102 and 103. This means that recently issued patents will be immediately subject to petitions for IPR.

II. Inventor Declarations Can Now be Submitted Any Time Before Payment of The Issue Fee

The AIA required submission of an inventor Declaration (or Substitute Statement or dual-purpose Assignment) before the issuance of a Notice of Allowance. The bill amends this provision to permit the submission of a Declaration (or Substitute Statement or dual-purpose Assignment) any time prior to payment of the issue fee.

This change is effective "for any proceeding commenced on or after" the date of enactment. Presumably, this means that this change applies to any application filed on or after the date of enactment.

[1] See our August 27, 2012 Special Report entitled "The USPTO Issues Final Rules Implementing *Inter Partes* Review And Post-Grant Review," which is available in the "Resources" section of our website (www.oliff.com).

[2] PGR was and remains available for patents subject to pre-AIA §§102 and 103 for patents including one or more claims falling within the covered business method exception.

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III. District Court Review of USPTO Patent Term Adjustment is Unavailable Unless The Patentee Requests Reconsideration by the USPTO

Patentees could previously appeal either the USPTO's initial calculation of patent term adjustment or the USPTO's decision on a request for reconsideration of the calculation to the U.S. District Court for the Eastern District of Virginia. The bill changes the law such that a patentee can no longer directly appeal the USPTO's initial calculation of patent term adjustment. To be eligible for appeal to the District Court, the patentee must first request reconsideration of the calculation by the USPTO.

This change will take effect on the date of enactment and will apply to any proceeding commenced on or after that date.

Thus, patentees currently considering appealing a USPTO calculation of patent term adjustment to the District Court will apparently not be able to file such an appeal unless they have first requested reconsideration by the USPTO. If still within the two-month time period for requesting reconsideration of the calculation, patentees who are considering appeal must first request reconsideration. Otherwise appeal would appear to be unavailable.

IV. Certain Time Limits for Actions Relating to Patent Term Adjustments Have Been Extended or Clarified

The bill amends "A delay" and "B delay" calculations to change the trigger point for the calculation of a patent term adjustment for a national phase application from the date on which a national phase application satisfies the requirements of 35 U.S.C. §371 to "the date of commencement of the national stage under Section 371 in an international application."[3] This change begins the A delay and B delay calculations for national phase applications on the 30-month deadline for filing the national phase application if the requirements of §371 are met later.

This change has the effect of potentially increasing patent term extension for national phase applications in which requirements under §371 (e.g., the filing of a declaration, the filing of an English-language translation, etc.) are met after the 30-month deadline.

This change is effective "for any proceeding commenced on or after" the date of enactment. Presumably, this means that this change applies to any patent term adjustment challenge filed on or after the date of enactment.

V. A Petition to Institute a Derivation Proceeding Must be Filed Within One Year After Publication of The Deriver's Claim

The time limit for filing a petition to institute a derivation proceeding has been the source of much confusion since the enactment of the AIA.[4]

In an attempt to resolve the confusion, the bill clarifies that a derivation proceeding must be instituted within one year after the earlier of (1) the grant of the deriver's patent containing a claim to the victim's invention, or (2) the publication of the deriver's application containing a claim to the

[3] Patent term extension and the types of delay are discussed in our August 30, 2012 Special Report entitled "USPTO Revises Patent Term Adjustment Rules," which is available in the "Resources" section of our website (www.oliff.com).

[4] Derivation proceedings are discussed in our October 19, 2012 Special Report entitled "USPTO Publishes Final Rules For Derivation Proceedings Under America Invents Act," which is available in the "Resources" section of our website (www.oliff.com).

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victim's invention. This change will be effective on March 16, 2013 and apply to any application or patent subject to post-AIA §§102 and 103.

VI. Adverse Decisions in Interference Proceedings May be Appealed to The Federal Circuit

The AIA mistakenly eliminated the ability of a party to appeal an adverse decision in an interference proceeding declared after September 15, 2012. Decisions in those interference proceedings can now be appealed to the U.S. Court of Appeals for the Federal Circuit.

VII. The AIA's Advice of Counsel Provision is Applicable to All Civil Actions Commenced on or After Enactment

The AIA prevents reliance on an accused infringer's failure to obtain advice of counsel, or to reveal such advice at trial, as evidence of willful infringement or intent to induce infringement. However, the AIA did not include an effective date or applicability provision for this change. Thus, by virtue of the AIA's default applicability provision, it was only applicable for patents issued on or after September 16, 2012. This had the unintended effect of preventing the change from applying to lawsuits filed well after the enactment of the AIA when the lawsuit was based on a patent that issued before September 16, 2012.

The bill makes this change applicable to all civil actions commenced after the date on which the bill is enacted, regardless of the issue date of the involved patent(s).

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The USPTO must now amend its administrative regulations to incorporate the above changes to the law. We will keep you informed of any significant regulatory changes.

Please let us know if you desire any additional information regarding this bill.

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Oliff & Berridge, PLC is a full-service Intellectual Property law firm based in historic Alexandria, Virginia. The firm specializes in patent, copyright, trademark, and antitrust law and litigation, and represents a large and diverse group of domestic and international clients, including businesses ranging from large multinational corporations to small privately owned companies, major universities, and individual entrepreneurs.

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For further information, please contact us by telephone at (703) 836-6400, facsimile at (703) 836-2787, email at email@oliff.com or mail at 277 South Washington Street, Suite 500, Alexandria, Virginia 22314. Information about our firm can also be found on our web site, www.oliff.com.

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