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112TH CONGRESS
2D SESSION

H. R. 6621

AN ACT

To correct and improve certain provisions of the Leahy-Smith America Invents Act and title 35, United States Code.

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,

SECTION 1. TECHNICAL CORRECTIONS.

(a) ADVICE OF COUNSEL.—Notwithstanding section 35 of the Leahy-Smith America Invents Act (35 U.S.C. 1 note), section 298 of title 35, United States Code, shall apply to any civil action commenced on or after the date of the enactment of this Act.

(b) TRANSITIONAL PROGRAM FOR COVERED BUSINESS METHOD PATENTS.—Section 18 of the Leahy-Smith America Invents Act (35 U.S.C. 321 note) is amended—

(1) in subsection (a)(1)(C)((i), by striking ''of such title'' the second place it appears; and

(2) in subsection (d)(2), by striking ''subsection'' and inserting ''section''.

(c) JOINDER OF PARTIES.—Section 299(a) of title 35, United States Code, is amended in the matter preceding paragraph (1) by striking ''or counterclaim defendants only if'' and inserting ''only if''.

(d) DEAD ZONES.—

(1) INTER PARTES REVIEW.—Section 311(c) of title 35, United States Code, shall not apply to a petition to institute an inter partes review of a patent that is not a patent described in section 3(n)(1) of the Leahy-Smith America Invents Act (35 U.S.C. 100 note).

(2) REISSUE.—Section 311(c)(1) of title 35, United States Code, is amended by striking ''or issuance of a reissue of a patent''.

(e) CORRECT INVENTOR.—

(1) IN GENERAL.—Section 135(e) of title 35, United States Code, as amended by section 3(i) of the Leahy-Smith America Invents Act, is amended by striking ''correct inventors'' and inserting ''correct inventor''.

(2) EFFECTIVE DATE.—The amendment made by paragraph (1) shall be effective as if included in the amendment made by section 3(i) of the Leahy-Smith America Invents Act.

(f) INVENTOR'S OATH OR DECLARATION.—Section 115 of title 35, United States Code, as amended by section 4 of the Leahy-Smith America Invents Act, is amended—

(1) by striking subsection (f) and inserting the following:

''(f) TIME FOR FILING.—The applicant for patent shall provide each required oath or declaration under subsection (a), substitute statement under subsection (d), or recorded assignment meeting the requirements of subsection (e) no later than the date on which the issue fee for the patent is paid.''; and

(2) in subsection (g)(1), by striking ''who claims'' and inserting ''that claims''.

(g) TRAVEL EXPENSES AND PAYMENT OF ADMINISTRATIVE JUDGES.—Notwithstanding section 35 of the Leahy-Smith America Invents Act (35 U.S.C. 1 note), the amendments made by section 21 of the Leahy-Smith America Invents Act (Public Law 112–29; 125 Stat. 335) shall be effective as of September 16, 2011.

(h) PATENT TERM ADJUSTMENTS.—Section 154(b) of title 35, United States Code, is amended—

(1) in paragraph (1)—

(A) in subparagraph (A)(i)(II), by striking ''on which an international application fulfilled the requirements of section 371 of this title'' and inserting ''of commencement of the national stage under section 371 in an international application''; and

(B) in subparagraph (B), in the matter preceding clause (i), by striking ''the application in the United States'' and inserting ''the application under section 111(a) in the United States or, in the case of an international application, the date of commencement of the national stage under section 371 in the international application'';

(2) in paragraph (3)(B)(i), by striking ''with the written notice of allowance of the application under section 151'' and inserting ''no later than the date of issuance of the patent''; and

(3) in paragraph (4)(A)—

(A) by striking ''a determination made by the Director under paragraph (3) shall have remedy'' and inserting ''the Director's decision on the applicant's request for reconsideration under paragraph (3)(B)(ii) shall have exclusive remedy''; and

(B) by striking ''the grant of the patent'' and inserting ''the date of the Director's decision on the applicant's request for reconsideration''.

(i) IMPROPER APPLICANT.—Section 373 of title 35, United States Code, and the item relating to that section in the table of sections for chapter 37 of such title, are repealed.

(j) FINANCIAL MANAGEMENT CLARIFICATIONS.—Section 42(c)(3) of title 35, United States Code, is amended—

(1) in subparagraph (A)—

(A) by striking ''sections 41, 42, and 376,'' and inserting ''this title,''; and

(B) by striking ''a share of the administrative costs of the Office relating to patents'' and inserting ''a proportionate share of the administrative costs of the Office''; and

(2) in subparagraph (B), by striking ''a share of the administrative costs of the Office relating to trademarks'' and inserting ''a proportionate share of the administrative costs of the Office''.

(k) DERIVATION PROCEEDINGS.—

(1) IN GENERAL.—Section 135(a) of title 35, United States Code, as amended by section 3(i) of the Leahy-Smith America Invents Act, is amended 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 derived such invention from an individual named in the petitioner's application as the inventor or a joint inventor and, without authorization, the earlier application 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 Director 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 contained 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 application 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 invention, 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 Director whether to institute a derivation proceeding

under paragraph (1) shall be final and not appealable.''.

(2) EFFECTIVE DATE.—The amendment made by paragraph (1) shall be effective as if included in the amendment made by section 3(i) of the Leahy-Smith America Invents Act.

(3) REVIEW OF INTERFERENCE DECISIONS.—The provisions of sections 6 and 141 of title 35, United States Code, and section 1295(a)(4)(A) of title 28, United States Code, as in effect on September 15, 2012, shall apply to interference proceedings that are declared after September 15, 2012, under section 135 of title 35, United States Code, as in effect before the effective date under section 3(n) of the Leahy-Smith America Invents Act. The Patent Trial and Appeal Board may be deemed to be the Board of Patent Appeals and Interferences for purposes of such interference proceedings.

(l) PATENT AND TRADEMARK PUBLIC ADVISORY COMMITTEES.—

(1) IN GENERAL.—Section 5(a) of title 35, United States Code, is amended—

(A) in paragraph (1), by striking ''Members of'' and all that follows through ''such appointments.'' and inserting the following: ''In

each year, 3 members shall be appointed to each Advisory Committee for 3-year terms that shall begin on December 1 of that year. Any vacancy on an Advisory Committee shall be filled within 90 days after it occurs. A new member who is appointed to fill a vacancy shall be appointed to serve for the remainder of the predecessor's term.'';

(B) by striking paragraph (2) and inserting the following:

''(2) CHAIR.—The Secretary of Commerce, in consultation with the Director, shall designate a Chair and Vice Chair of each Advisory Committee from among the members appointed under paragraph (1). If the Chair resigns before the completion of his or her term, or is otherwise unable to exercise the functions of the Chair, the Vice Chair shall exercise the functions of the Chair.''; and

(C) by striking paragraph (3).

(2) TRANSITION.—

(A) IN GENERAL.—The Secretary of Commerce shall, in the Secretary's discretion, determine the time and manner in which the amendments made by paragraph (1) shall take effect, except that, in each year following the year in

which this Act is enacted, 3 members shall be appointed to each Advisory Committee (to which such amendments apply) for 3-year terms that begin on December 1 of that year, in accordance with section 5(a) of title 35, United States Code, as amended by paragraph (1) of this subsection.

(B) DEEMED TERMINATION OF TERMS.—In order to implement the amendments made by paragraph (1), the Secretary of Commerce may determine that the term of an existing member of an Advisory Committee under section 5 of title 35, United States Code, shall be deemed to terminate on December 1 of a year beginning after the date of the enactment of this Act, regardless of whether December 1 is before or after the date on which such member's term would terminate if this Act had not been enacted.

(m) REPORT ON PRE-GATT APPLICATIONS.—Using existing resources, not later than four months after the date of the enactment of this Act, the Director of the United States Patent and Trademark Office shall submit a report to the Committees on the Judiciary of the United

States House of Representatives and the Senate that describes—

(1) the total number of pending United States applications for patent that—

(A) are not subject to an order under section 181 of title 35, United States Code; and

(B) were filed before the effective date of the amendments made by section 532 of the Uruguay Round Agreements Act (Public Law 103–465; 108 Stat. 4983);

(2) the filing date of each such application;

(3) the filing date of the earliest application for which each such application claims the benefit of or a right of priority to its filing date;

(4) the inventor and assignee named on each such application;

(5) the amount of time that examination of each such application has been delayed because of a proceeding under section 135(a) of title 35, United States Code, an appeal to the Patent Trial and Appeal Board under section 134(a) of such title, a civil action in a United States District Court under section 145 or 146 of such title, or an appeal to the United States Court of Appeals for the Federal Circuit under section 141 of such title; and

(6) other information about such applications that the Director believes is relevant to their pendency.

(n) CLERICAL AMENDMENT.—Section 123(a) of title 35, United States Code, is amended in the matter preceding paragraph (1) by inserting ''of this title'' after ''For purposes''.

(o) EFFECTIVE DATE.—Except as otherwise provided in this Act, the amendments made by this Act shall take effect on the date of the enactment of this Act and shall apply to proceedings commenced on or after such date of enactment.

Passed the House of Representatives December 18, 2012.

Attest:

Clerk.

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