

112TH CONGRESS
2D SESSION

H. R. 6621

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

IN THE HOUSE OF REPRESENTATIVES

NOVEMBER 30, 2012

Mr. SMITH of Texas introduced the following bill; which was referred to the Committee on the Judiciary

A BILL

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

1 *Be it enacted by the Senate and House of Representa-*
2 *tives of the United States of America in Congress assembled,*

3 **SECTION 1. TECHNICAL CORRECTIONS.**

4 (a) **ADVICE OF COUNSEL.**—Notwithstanding section
5 35 of the Leahy-Smith America Invents Act (35 U.S.C.
6 1 note), section 298 of title 35, United States Code, shall
7 apply to any civil action commenced on or after the date
8 of the enactment of this Act.

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

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

6 (2) in subsection (d)(2), by striking “sub-
7 section” and inserting “section”.

8 (c) JOINDER OF PARTIES.—Section 299(a) of title
9 35, United States Code, is amended in the matter pre-
10 ceding paragraph (1) by striking “or counterclaim defend-
11 ants only if” and inserting “only if”.

12 (d) DEAD ZONES.—

13 (1) INTER PARTES REVIEW.—Section 311(e) of
14 title 35, United States Code, shall not apply to a pe-
15 tition to institute an inter partes review of a patent
16 that is not a patent described in section 3(n)(1) of
17 the Leahy-Smith America Invents Act (35 U.S.C.
18 100 note).

19 (2) REPEAL.—Section 325(f) of title 35, United
20 States Code, as added by section 6 of the Leahy-
21 Smith America Invents Act, is repealed.

22 (e) CORRECT INVENTOR.—

23 (1) IN GENERAL.—Section 135(e) of title 35,
24 United States Code, as amended by section 3(i) of
25 the Leahy-Smith America Invents Act, is amended

1 by striking “correct inventors” and inserting “cor-
2 rect inventor”.

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

7 (f) INVENTOR’S OATH OR DECLARATION.—Section
8 115 of title 35, United States Code, as amended by section
9 4 of the Leahy-Smith America Invents Act, is amended—
10 (1) by striking subsection (f) and inserting the
11 following:

12 “(f) TIME FOR FILING.—The applicant for patent
13 shall provide each required oath or declaration under sub-
14 section (a), substitute statement under subsection (d), or
15 recorded assignment meeting the requirements of sub-
16 section (e) no later than the date on which the issue fee
17 for the patent is paid.”; and

18 (2) in subsection (g)(1), by striking “who
19 claims” and inserting “that claims”.

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

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

3 (1) in paragraph (1)—

4 (A) in subparagraph (A)(i)(II), by striking
5 “on which an international application fulfilled
6 the requirements of section 371 of this title”
7 and inserting “of commencement of the na-
8 tional stage under section 371 in an inter-
9 national application”; and

10 (B) in subparagraph (B), in the matter
11 preceding clause (i), by striking “the applica-
12 tion in the United States” and inserting “the
13 application under section 111(a) in the United
14 States or, in the case of an international appli-
15 cation, the date of commencement of the na-
16 tional stage under section 371 in the inter-
17 national application”;

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

22 (3) in paragraph (4)(A)—

23 (A) by striking “a determination made by
24 the Director under paragraph (3) shall have
25 remedy” and inserting “the Director’s decision

1 on the applicant’s request for reconsideration
2 under paragraph (3)(B)(ii) shall have exclusive
3 remedy’; and

4 (B) by striking “the grant of the patent”
5 and inserting “the date of the Director’s deci-
6 sion on the applicant’s request for reconsider-
7 ation”.

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

12 (j) FINANCIAL MANAGEMENT CLARIFICATIONS.—
13 Section 42(c)(3) of title 35, United States Code, is amend-
14 ed—

15 (1) in subparagraph (A)—

16 (A) by striking “sections 41, 42, and 376,”
17 and inserting “this title,”; and

18 (B) by striking “a share of the administra-
19 tive costs of the Office relating to patents” and
20 inserting “a proportionate share of the adminis-
21 trative costs of the Office”; and

22 (2) in subparagraph (B), by striking “a share
23 of the administrative costs of the Office relating to
24 trademarks” and inserting “a proportionate share of
25 the administrative costs of the Office”.

1 (k) DERIVATION PROCEEDINGS.—

2 (1) IN GENERAL.—Section 135(a) of title 35,
3 United States Code, as amended by section 3(i) of
4 the Leahy-Smith America Invents Act, is amended
5 to read as follows:

6 “(a) INSTITUTION OF PROCEEDING.—

7 “(1) IN GENERAL.—An applicant for patent
8 may file a petition with respect to an invention to
9 institute a derivation proceeding in the Office. The
10 petition shall set forth with particularity the basis
11 for finding that an individual named in an earlier
12 application as the inventor or a joint inventor de-
13 rived such invention from an individual named in the
14 petitioner’s application as the inventor or a joint in-
15 ventor and, without authorization, the earlier appli-
16 cation claiming such invention was filed. Whenever
17 the Director determines that a petition filed under
18 this subsection demonstrates that the standards for
19 instituting a derivation proceeding are met, the Di-
20 rector may institute a derivation proceeding.

21 “(2) TIME FOR FILING.—A petition under this
22 section with respect to an invention that is the same
23 or substantially the same invention as a claim con-
24 tained in a patent issued on an earlier application,
25 or contained in an earlier application when published

1 or deemed published under section 122(b), may not
2 be filed unless such petition is filed during the 1-
3 year period following the date on which the patent
4 containing such claim was granted or the earlier ap-
5 plication containing such claim was published,
6 whichever is earlier.

7 “(3) EARLIER APPLICATION.—For purposes of
8 this section, an application shall not be deemed to
9 be an earlier application with respect to an inven-
10 tion, relative to another application, unless a claim
11 to the invention was or could have been made in
12 such application having an effective filing date that
13 is earlier than the effective filing date of any claim
14 to the invention that was or could have been made
15 in such other application.

16 “(4) NO APPEAL.—A determination by the Di-
17 rector whether to institute a derivation proceeding
18 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.

11 (l) PATENT AND TRADEMARK PUBLIC ADVISORY
12 COMMITTEES.—

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

15 (A) in paragraph (1), by striking “Mem-
16 bers of” and all that follows through “such ap-
17 pointments.” and inserting the following: “In
18 each year, 3 members shall be appointed to
19 each Advisory Committee for 3-year terms that
20 shall begin on May 1 of that year. Any vacancy
21 on an Advisory Committee shall be filled within
22 90 days after it occurs. A new member who is
23 appointed to fill a vacancy shall be appointed to
24 serve for the remainder of the predecessor’s
25 term.”;

1 (B) by striking paragraph (2) and insert-
2 ing the following:

3 “(2) CHAIRMAN.—The Secretary of Commerce,
4 in consultation with the Director, shall designate a
5 Chair and Vice Chair of each Advisory Committee
6 from among the members appointed under para-
7 graph (1). Each Chair and Vice Chair shall serve for
8 a 1-year term beginning on May 1 of the year in
9 which he or she is so designated. If the Chair re-
10 signs before the completion of his or her term or is
11 otherwise unable to exercise the functions of the
12 Chair, the Vice Chair shall exercise the functions of
13 the Chair.”; and

14 (C) by striking paragraph (3).

15 (2) TRANSITION.—

16 (A) IN GENERAL.—The Secretary of Com-
17 merce shall, in the Secretary’s discretion, deter-
18 mine the time and manner in which the amend-
19 ments made by paragraph (1) shall take effect,
20 except that, in each year following the year in
21 which this Act is enacted, 3 members shall be
22 appointed to each Advisory Committee (to
23 which such amendments apply) for 3-year terms
24 that begin on May 1 of that year, in accordance
25 with section 5(a) of title 35, United States

1 Code, as amended by paragraph (1) of this sub-
2 section.

3 (B) DEEMED TERMINATION OF TERMS.—

4 In order to implement the amendments made
5 by paragraph (1), the Secretary of Commerce
6 may determine that the term of an existing
7 member of an Advisory Committee under sec-
8 tion 5 of title 35, United States Code, shall be
9 deemed to terminate on May 1 of a year begin-
10 ning after the date of the enactment of this
11 Act, regardless of whether May 1 is before or
12 after the date on which such member's term
13 would terminate if this Act had not been en-
14 acted.

15 (m) EFFECTIVE DATE OF URUGUAY ROUND AGREE-
16 MENTS ACT.—

17 (1) CERTAIN PATENT APPLICATIONS.—Notwith-
18 standing section 534(b)(1) of the Uruguay Round
19 Agreements Act (35 U.S.C. 154 note), section
20 154(a) of title 35, United States Code, as amended
21 by section 532 of the Uruguay Round Agreements
22 Act (Public Law 103-465; 108 Stat. 4809), shall
23 apply, and section 154(c)(1) of title 35, United
24 States Code, shall not apply, to any application that
25 is—

1 (A) filed before the date that is 6 months
2 after the date of the enactment of the Uruguay
3 Round Agreements Act; and

4 (B) pending on a date that is 1 year or
5 more after the date of the enactment of this
6 Act.

7 (2) EFFECTIVE DATE.—This subsection shall
8 take effect on the date that is 1 year after the date
9 of the enactment of this Act and shall apply to any
10 original plant or utility patent application that is
11 pending on or after that effective date.

12 (n) CLERICAL AMENDMENT.—Section 123(a) of title
13 35, United States Code, is amended in the matter pre-
14 ceding paragraph (1) by inserting “of this title” after
15 “For purposes”.

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

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