

112<sup>TH</sup> CONGRESS  
2<sup>D</sup> SESSION

# H. R. 6621

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IN THE SENATE OF THE UNITED STATES

DECEMBER 19, 2012

Received

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## AN ACT

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,*

1 **SECTION 1. TECHNICAL CORRECTIONS.**

2 (a) **ADVICE OF COUNSEL.**—Notwithstanding section  
3 35 of the Leahy-Smith America Invents Act (35 U.S.C.  
4 1 note), section 298 of title 35, United States Code, shall  
5 apply to any civil action commenced on or after the date  
6 of the enactment of this Act.

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

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

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

14 (c) **JOINDER OF PARTIES.**—Section 299(a) of title  
15 35, United States Code, is amended in the matter pre-  
16 ceding paragraph (1) by striking “or counterclaim defend-  
17 ants only if” and inserting “only if”.

18 (d) **DEAD ZONES.**—

19 (1) **INTER PARTES REVIEW.**—Section 311(e) of  
20 title 35, United States Code, shall not apply to a pe-  
21 tition to institute an inter partes review of a patent  
22 that is not a patent described in section 3(n)(1) of  
23 the Leahy-Smith America Invents Act (35 U.S.C.  
24 100 note).

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

4           (e) CORRECT INVENTOR.—

5           (1) IN GENERAL.—Section 135(e) of title 35,  
6           United States Code, as amended by section 3(i) of  
7           the Leahy-Smith America Invents Act, is amended  
8           by striking “correct inventors” and inserting “cor-  
9           rect inventor”.

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

14          (f) INVENTOR’S OATH OR DECLARATION.—Section  
15          115 of title 35, United States Code, as amended by section  
16          4 of the Leahy-Smith America Invents Act, is amended—

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

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

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

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

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

11           (1) in paragraph (1)—

12           (A) in subparagraph (A)(i)(II), by striking  
13           “on which an international application fulfilled  
14           the requirements of section 371 of this title”  
15           and inserting “of commencement of the na-  
16           tional stage under section 371 in an inter-  
17           national application”; and

18           (B) in subparagraph (B), in the matter  
19           preceding clause (i), by striking “the applica-  
20           tion in the United States” and inserting “the  
21           application under section 111(a) in the United  
22           States or, in the case of an international appli-  
23           cation, the date of commencement of the na-  
24           tional stage under section 371 in the inter-  
25           national application”;

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

5           (3) in paragraph (4)(A)—

6                   (A) by striking “a determination made by  
7                   the Director under paragraph (3) shall have  
8                   remedy” and inserting “the Director’s decision  
9                   on the applicant’s request for reconsideration  
10                  under paragraph (3)(B)(ii) shall have exclusive  
11                  remedy”; and

12                   (B) by striking “the grant of the patent”  
13                   and inserting “the date of the Director’s deci-  
14                   sion on the applicant’s request for reconsider-  
15                   ation”.

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

20           (j) FINANCIAL MANAGEMENT CLARIFICATIONS.—  
21           Section 42(c)(3) of title 35, United States Code, is amend-  
22           ed—

23                   (1) in subparagraph (A)—

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

1 (B) by striking “a share of the administra-  
2 tive costs of the Office relating to patents” and  
3 inserting “a proportionate share of the adminis-  
4 trative costs of the Office”; and

5 (2) in subparagraph (B), by striking “a share  
6 of the administrative costs of the Office relating to  
7 trademarks” and inserting “a proportionate share of  
8 the administrative costs of the Office”.

9 (k) DERIVATION PROCEEDINGS.—

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

14 “(a) INSTITUTION OF PROCEEDING.—

15 “(1) IN GENERAL.—An applicant for patent  
16 may file a petition with respect to an invention to  
17 institute a derivation proceeding in the Office. The  
18 petition shall set forth with particularity the basis  
19 for finding that an individual named in an earlier  
20 application as the inventor or a joint inventor de-  
21 rived such invention from an individual named in the  
22 petitioner’s application as the inventor or a joint in-  
23 ventor and, without authorization, the earlier appli-  
24 cation claiming such invention was filed. Whenever  
25 the Director determines that a petition filed under

1 this subsection demonstrates that the standards for  
2 instituting a derivation proceeding are met, the Di-  
3 rector may institute a derivation proceeding.

4 “(2) TIME FOR FILING.—A petition under this  
5 section with respect to an invention that is the same  
6 or substantially the same invention as a claim con-  
7 tained in a patent issued on an earlier application,  
8 or contained in an earlier application when published  
9 or deemed published under section 122(b), may not  
10 be filed unless such petition is filed during the 1-  
11 year period following the date on which the patent  
12 containing such claim was granted or the earlier ap-  
13 plication containing such claim was published,  
14 whichever is earlier.

15 “(3) EARLIER APPLICATION.—For purposes of  
16 this section, an application shall not be deemed to  
17 be an earlier application with respect to an inven-  
18 tion, relative to another application, unless a claim  
19 to the invention was or could have been made in  
20 such application having an effective filing date that  
21 is earlier than the effective filing date of any claim  
22 to the invention that was or could have been made  
23 in such other application.

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

1 under paragraph (1) shall be final and not appeal-  
2 able.”.

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 (3) REVIEW OF INTERFERENCE DECISIONS.—  
8 The provisions of sections 6 and 141 of title 35,  
9 United States Code, and section 1295(a)(4)(A) of  
10 title 28, United States Code, as in effect on Sep-  
11 tember 15, 2012, shall apply to interference pro-  
12 ceedings that are declared after September 15,  
13 2012, under section 135 of title 35, United States  
14 Code, as in effect before the effective date under sec-  
15 tion 3(n) of the Leahy-Smith America Invents Act.  
16 The Patent Trial and Appeal Board may be deemed  
17 to be the Board of Patent Appeals and Interferences  
18 for purposes of such interference proceedings.

19 (1) PATENT AND TRADEMARK PUBLIC ADVISORY  
20 COMMITTEES.—

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

23 (A) in paragraph (1), by striking “Mem-  
24 bers of” and all that follows through “such ap-  
25 pointments.” and inserting the following: “In



1 each year, 3 members shall be appointed to  
2 each Advisory Committee for 3-year terms that  
3 shall begin on December 1 of that year. Any va-  
4 cancy on an Advisory Committee shall be filled  
5 within 90 days after it occurs. A new member  
6 who is appointed to fill a vacancy shall be ap-  
7 pointed to serve for the remainder of the prede-  
8 cessor's term.”;

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

11 “(2) CHAIR.—The Secretary of Commerce, in  
12 consultation with the Director, shall designate a  
13 Chair and Vice Chair of each Advisory Committee  
14 from among the members appointed under para-  
15 graph (1). If the Chair resigns before the completion  
16 of his or her term, or is otherwise unable to exercise  
17 the functions of the Chair, the Vice Chair shall exer-  
18 cise the functions of the Chair.”; and

19 (C) by striking paragraph (3).

20 (2) TRANSITION.—

21 (A) IN GENERAL.—The Secretary of Com-  
22 merce shall, in the Secretary's discretion, deter-  
23 mine the time and manner in which the amend-  
24 ments made by paragraph (1) shall take effect,  
25 except that, in each year following the year in

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

8                   (B) DEEMED TERMINATION OF TERMS.—

9           In order to implement the amendments made  
10          by paragraph (1), the Secretary of Commerce  
11          may determine that the term of an existing  
12          member of an Advisory Committee under sec-  
13          tion 5 of title 35, United States Code, shall be  
14          deemed to terminate on December 1 of a year  
15          beginning after the date of the enactment of  
16          this Act, regardless of whether December 1 is  
17          before or after the date on which such mem-  
18          ber's term would terminate if this Act had not  
19          been enacted.

20                   (m) REPORT ON PRE-GATT APPLICATIONS.—Using

21 existing resources, not later than four months after the  
22 date of the enactment of this Act, the Director of the  
23 United States Patent and Trademark Office shall submit  
24 a report to the Committees on the Judiciary of the United

1 States House of Representatives and the Senate that de-  
2 scribes—

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

5 (A) are not subject to an order under sec-  
6 tion 181 of title 35, United States Code; and

7 (B) were filed before the effective date of  
8 the amendments made by section 532 of the  
9 Uruguay Round Agreements Act (Public Law  
10 103–465; 108 Stat. 4983);

11 (2) the filing date of each such application;

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

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

17 (5) the amount of time that examination of  
18 each such application has been delayed because of a  
19 proceeding under section 135(a) of title 35, United  
20 States Code, an appeal to the Patent Trial and Ap-  
21 peal Board under section 134(a) of such title, a civil  
22 action in a United States District Court under sec-  
23 tion 145 or 146 of such title, or an appeal to the  
24 United States Court of Appeals for the Federal Cir-  
25 cuit under section 141 of such title; and

1           (6) other information about such applications  
2           that the Director believes is relevant to their pend-  
3           ency.

4           (n) CLERICAL AMENDMENT.—Section 123(a) of title  
5 35, United States Code, is amended in the matter pre-  
6 ceding paragraph (1) by inserting “of this title” after  
7 “For purposes”.

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

          Passed the House of Representatives December 18,  
2012.

Attest:

KAREN L. HAAS,  
*Clerk.*