

## Articles

January 2013

### **An Overview of the Key Substantive Changes Implemented by the Recently Enacted Amendments to the Leahy-Smith America Invents Act and Title 35**

On January 14, 2013, H.R. 6621, entitled “An Act to correct and improve certain provisions of the **Leahy-Smith America Invents Act** and title 35, United States Code,” was signed into law. H.R. 6621 not only corrects clerical errors but also contains substantive changes to patent law, which may be of interest to patent applicants or patentees. A brief summary of the key substantive changes is outlined below.

#### **Elimination of “Dead Zones” for First-to-Invent and Reissue Patents**

H.R. 6621 eliminates the 9-month “dead zones” from the issue/reissue date during which one was precluded from petitioning for inter partes review of first-to-invent and reissue patents. Accordingly, any first-to-invent or reissue patent can now be challenged via inter partes review upon issuance.

#### **Revised deadline for submission of oath or declaration**

Furthermore, H.R. 6621 amends 35 U.S.C. § 115(f) to extend the deadline for submission of the oath or declaration to “no later than the date on which the issue fee for the patent is paid” rather than requiring submission of these materials as prerequisite for issuing the notice of allowance. Despite this extended deadline, applicants may want to consider submitting the oath or declaration well in advance of issue fee payment to avoid potential problems.

#### **Failure to obtain advice of counsel as evidence for willful infringement or inducement**

H.R. 6621 changes the effective date of 35 U.S.C. § 298, which precludes use of failure to obtain advice of counsel as evidence of willful infringement or inducement. As a result of H.R. 6621, 35 U.S.C. § 298 is now applicable to any civil action commenced on or after January 14, 2013.

#### **Clarification of Provision Dealing with Institution of Derivation Proceedings**

H.R. 6621 also amends 35 U.S.C. § 135(a), which pertains to the institution of derivation proceedings. Specifically, Section 1(k) of H.R. 6621 clarifies the timing of when a derivation proceeding must be filed. A petition for derivation proceeding must be “filed during the 1 year period following the date on which the patent containing such [a derived] claim was granted or the earlier application containing such [a derived] claim was published, whichever is earlier.”

#### **Changes to Patent Term Adjustment Provisions**

##### *Patent Term Adjustment for National Stage Applications:*

Furthermore, H.R. 6621 amends 35 U.S.C. § 154(b) to provide that patent term adjustment (“PTA”) for a national stage application for all purposes is calculated from the date “of commencement of the national stage under Section 371.” The date of commencement of national stage under 371 is the earlier of (a) the date that is 30 months from the earliest filing date, or (b) the date on which a request for early processing was made along with submission of the materials required by Section 371.

##### *Revised deadline for when Patent Office has to provide PTA calculations:*

H.R. 6621 amends 35 U.S.C. § 154(b)(1) to no longer require the PTO to provide a determination of PTA with the notice of allowance. Rather, the law now simply requires a determination of that PTA be provided “no later than issuance of the patent.”

##### *Revised procedures to appeal the Director’s PTA calculations:*

As a result of H.R. 6621, an applicant seeking to appeal the Director’s decision of a request for reconsideration of a PTA calculation has the “exclusive” remedy to pursue a civil action in the Eastern

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District of Virginia within **180 days** of “the date of the Director’s decision on applicant’s request for reconsideration.” Thus, patentees dissatisfied with the PTO’s PTA calculation must request reconsideration in order to preserve the right to challenge the PTA calculation via a civil action.

If you have any questions regarding these changes or patent law, do not hesitate to contact our patent practitioners.