

January 15, 2013

AIA Technical Corrections Bill Signed Into Law



President Obama signed into law H.R. 6621 on January 14, 2013, enacting a number of technical corrections to the Leahy-Smith America Invents Act and title 35, United States Code. In addition to correcting a number of scrivener's errors, the new law revises various windows for *inter partes* review of first-to-invent patents and reissues, filing of an inventor's oath or declaration, patent term adjustment of U.S. national stage applications, and derivation proceedings.

"Dead Zones" Eliminated for First-to-Invent Patents and Reissue Patents

H.R. 6621 amends 35 U.S.C. § 311(c) to remove the so-called "dead zones" in which no review of first-to-invent patents and reissue patents was available under the AIA. H.R. 6621 § 1(d). Now, petitioners need not wait to file *inter partes* review of those first-to-invent patents issuing within nine months of, or after, September 16, 2012, as H.R. 6621 makes Section 311(c) inapplicable to first-to-invent patents. Similarly, H.R. 6621 makes the nine-month tolling provision of Section 311(c) inapplicable to reissue patents. H.R. 6621 § 1(d)(2).

Inventor's Oath or Declaration Must be Filed by Payment of Issue Fee

The AIA changed the time for filing an inventor's oath or declaration, tying it to some time prior to, and as a condition for, the Office mailing a Notice of Allowance. H.R. 6621, however, amends this requirement of 35 U.S.C. § 115(f) and changes the deadline to "no later than the date on which the issue fee for the patent is paid." H.R. 6621 § 1(f). Despite this extra time, patent applicants should obtain signed oaths or declarations as early as possible to avoid possible abandonment of an application if an oath or declaration, or substitute statement, cannot be executed by the issue fee deadline.

Patent Term Adjustment Starts for National Stage Applications upon Commencement of the National Stage

Section 1(h) of H.R. 6621 amends 35 U.S.C. § 154(b) to clarify that the trigger point for calculating patent term adjustment of international applications is as of "the date of commencement of the national stage under Section 371 in an international application," rather than upon completion of requirements under Section 371.

Derivation Provisions Under 35 U.S.C. 135(a) Clarified

H.R. 6621 provides two clarifications to the derivations provisions under 35 U.S.C. 135(a) enacted by the AIA. First, Section 1(k) of H.R. 6621 divides Section 135(a) into subsections to improve readability. Second, Section 1(k) clarifies that a petition to institute a derivation proceeding must be filed on the earlier of 1) within one year after grant of the derived claim or 2) within one year after publication of the earlier application containing such claim.

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