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The America Invents Act Redefines Jurisdiction Over Patent Term Adjustment Civil Actions

IP LAW CLIENT ALERT

This Alert provides only general information and should not be relied upon as legal advice. For more information, contact your Patton Boggs LLP attorney or the authors listed below.

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When the America Invents Act (AIA) was enacted on September 16, 2011, it effectively preempted the Administrative Procedures Act (APA) regarding jurisdiction over civil actions brought by patentees challenging patent term adjustment calculations by Directors of the U.S. Patent and Trademark Office (USPTO). Previously, pursuant to Section 154(b)(4) of the patent statute and the APA, jurisdiction over civil actions relating to patent term adjustment calculations was in the U.S. District Court for the District of Columbia. Under Section 9 of the AIA, jurisdiction now lies in the U.S. District Court for the Eastern District of Virginia.

Ironically, this very issue was recently before the Eastern District of Virginia in *Janssen Pharmaceutica N.V. v. Kappos*, No. 1:11-cv-969 (E.D. Va. Feb. 10, 2012). The patentee in the *Janssen* case filed suit in the Eastern District of Virginia just days before the enactment of the AIA. The district court denied jurisdiction and transferred the case to the District of Columbia pursuant to the APA and the old Section 154(b)(4). Had the patentee filed suit on or after September 16, then the transferring court, the Eastern District of Virginia, would have been given the proper jurisdiction under Section 9 of the AIA. The *Janssen* case illustrates yet another example of the changes imparted by enactment of the AIA and the adjustments to be made by counsel.

Patentees should be properly counseled regarding jurisdiction under the AIA when filing civil suits challenging certain Director decisions, including patent term calculations.

Patton Boggs will continue to monitor changes in the world of intellectual property and their impact on business. If you have questions about this alert or any other patent-related issues, please contact one of the attorneys listed above.