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Technical Amendments To The America Invents Act Could Mean More Patent Term For U.S. National Phase Applications

Courtenay C. Brinckerhoff (Foley&Lardner LLP) · Monday, August 5th, 2013

The first set of “technical corrections” to the Leahy-Smith America Invents Act (AIA) was enacted on January 14, 2013. While this legislation did make “technical” corrections to some of the new AIA provisions, it also made substantive changes to both the AIA and other provisions of U.S. patent law, including the Patent Term Adjustment (PTA) statute. This article provides an overview of the substantive changes to the AIA embodied in this law.

Technical Corrections To The AIA

The law at issue stemmed from HR 6621, is titled “To correct and improve certain provisions of the Leahy-Smith America Invents Act,” and also is referred to as the “Technical Corrections Act.”

Changes Relating To Patent Prosecution

- **Inventor’s Oath/Declaration** HR 6621 pushes the deadline for submitting an executed Inventor’s Oath/Declaration (or Substitute Statement) to “no later than the date on which the issue fee for the patent is paid.” This change is effective as of the date of enactment (January 14, 2013).
- **U.S. National Stage Applications** HR 6621 repeals 35 USC § 373 and thus eliminates the requirement that a PCT application have been filed in the name of the inventors in order to be accepted at the U.S. national stage. This change is effective as of the date of enactment (January 14, 2013).

Changes Relating To Patent Trials

- **Inter Partes Review** HR 6621 eliminates the Request for Inter Partes Review “dead zone” for patents that are not subject to Post-Grant Review. In particular, the law provides that the timing requirements of 35 USC § 311(c) (including the 9 month waiting period) do not apply to patents that do not fall under the first-to-file effective date provisions of Section 3(n)(1) of the AIA. The law also eliminates the 9 month waiting period for all reissue patents. These changes are effective as of the date of enactment (January 14, 2013).
- **Derivation Proceedings** HR 6621 rewrites 35 USC § 135(a)(1)-(4) in an attempt to clarify the timing requirements and other provisions. These changes are made retroactively, “as if included in the [AIA],” but derivation proceedings only are available to applications subject to the first-to-file provisions that do not take effect until March 16, 2013.

- **Interference Proceedings** HR 6621 clarifies that the versions of 35 USC § 6, 35 USC § 141, and 28 USC § 1295(a)(4)(A) in effect as of September 15, 2012 shall apply to interference proceedings commenced after September 15, 2012, with the Patent Trial and Appeal Board deemed to be the Board of Patent Appeals and Interferences. This means that the Federal Circuit still will have jurisdiction over appeals of decisions in interference proceedings.

Litigation Changes

- **Advice of Counsel** HR 6621 adjusts the effective date of the changes to 35 USC § 298 to make them applicable to any *civil action* commenced on or after the date of enactment (January 14, 2013). Under the original effective date, the amended version of this statute only applied to *patents* issued on or after September 16, 2012.

Patent Term Adjustment

Most of the other substantive changes in HR 6621 relate to Patent Term Adjustment. The most significant change in the *calculation* of PTA pertains to U.S. national stage applications, and the fourteen month time period that the USPTO has to issue a first Office Action or Notice of Allowance before it must award PTA. HR 6621 makes that clock start running upon “commencement of the national stage.” Previously, this time period did not start until “the date on which an international application fulfilled the requirements of section 371,” including the submission of an executed Inventor Oath/Declaration. Because an executed Inventor Oath/Declaration might not be submitted until many months after the commencement date, this change in the PTA calculation can mean significant amounts of additional PTA for U.S. national stage applications.

The most significant *procedural* changes to the PTA statute relate to when and how PTA awards can be challenged. Under the new law, the USPTO need only provide its PTA calculation when the patent issues (instead of with the Notice of Allowance), and the patentee has two months from the issue date to file a Request for Reconsideration with the USPTO. Under the USPTO’s new rules, this two-month time period is *extendable* for up to five months under normal extension of time practice.

The new law also changes the procedures for challenging the USPTO’s PTA award in a court proceeding. Instead of requiring any such action to be commenced within 180 days of the patent’s *issue date*, the new law provides that any such action must be commenced within 180 days of the USPTO’s *decision* on a Request for Reconsideration. While this will generally give patent holders more time to bring a court proceeding, it requires the filing of a Request for Reconsideration at the USPTO in the first instance.

According to the USPTO, all of these PTA changes apply to patents issued on or after January 14, 2013. However, it does not appear that the USPTO has updated its own PTA calculator to reflect the new 14-month period for U.S. national stage applications. Patent holders with the earliest eligible patents (those granted on January 15, 2013) may have until August 15, 2013 to request additional PTA under these statutory and regulatory changes.

Further Changes Ahead

A number of other changes to the AIA and other areas of U.S. patent law have been proposed and introduced in both Houses of Congress, with the most attention devoted to “patent trolls” and

efforts to rein in “abusive” patent litigation. It will be interesting to see whether U.S. legislators can reach any consensus on these issues.

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This entry was posted on Monday, August 5th, 2013 at 6:00 am and is filed under [United States of America](#)

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