

**Suspend the Rules and Pass the Bill, H.R. 6621, With an Amendment**

**(The amendment strikes all after the enacting clause and inserts a new text)**

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

# H. R. 6621

To correct and improve certain provisions of the Leahy-Smith America Invents Act and title 35, United States Code.

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IN THE HOUSE OF REPRESENTATIVES

NOVEMBER 30, 2012

Mr. SMITH of Texas introduced the following bill; which was referred to the Committee on the Judiciary

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## A BILL

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,*

3 **SECTION 1. TECHNICAL CORRECTIONS.**

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

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

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

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

8 (c) JOINDER OF PARTIES.—Section 299(a) of title  
9 35, United States Code, is amended in the matter pre-  
10 ceding paragraph (1) by striking “or counterclaim defend-  
11 ants only if” and inserting “only if”.

12 (d) DEAD ZONES.—

13 (1) INTER PARTES REVIEW.—Section 311(c) of  
14 title 35, United States Code, shall not apply to a pe-  
15 tition to institute an inter partes review of a patent  
16 that is not a patent described in section 3(n)(1) of  
17 the Leahy-Smith America Invents Act (35 U.S.C.  
18 100 note).

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

22 (e) CORRECT INVENTOR.—

23 (1) IN GENERAL.—Section 135(e) of title 35,  
24 United States Code, as amended by section 3(i) of  
25 the Leahy-Smith America Invents Act, is amended

1 by striking “correct inventors” and inserting “cor-  
2 rect inventor”.

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 (f) INVENTOR’S OATH OR DECLARATION.—Section  
8 115 of title 35, United States Code, as amended by section  
9 4 of the Leahy-Smith America Invents Act, is amended—  
10 (1) by striking subsection (f) and inserting the  
11 following:

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

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

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

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

3 (1) in paragraph (1)—

4 (A) in subparagraph (A)(i)(II), by striking  
5 “on which an international application fulfilled  
6 the requirements of section 371 of this title”  
7 and inserting “of commencement of the na-  
8 tional stage under section 371 in an inter-  
9 national application”; and

10 (B) in subparagraph (B), in the matter  
11 preceding clause (i), by striking “the applica-  
12 tion in the United States” and inserting “the  
13 application under section 111(a) in the United  
14 States or, in the case of an international appli-  
15 cation, the date of commencement of the na-  
16 tional stage under section 371 in the inter-  
17 national application”;

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

22 (3) in paragraph (4)(A)—

23 (A) by striking “a determination made by  
24 the Director under paragraph (3) shall have  
25 remedy” and inserting “the Director’s decision

1 on the applicant's request for reconsideration  
2 under paragraph (3)(B)(ii) shall have exclusive  
3 remedy"; and

4 (B) by striking "the grant of the patent"  
5 and inserting "the date of the Director's deci-  
6 sion on the applicant's request for reconsider-  
7 ation".

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

12 (j) FINANCIAL MANAGEMENT CLARIFICATIONS.—  
13 Section 42(c)(3) of title 35, United States Code, is amend-  
14 ed—

15 (1) in subparagraph (A)—

16 (A) by striking "sections 41, 42, and 376,"  
17 and inserting "this title,"; and

18 (B) by striking "a share of the administra-  
19 tive costs of the Office relating to patents" and  
20 inserting "a proportionate share of the adminis-  
21 trative costs of the Office"; and

22 (2) in subparagraph (B), by striking "a share  
23 of the administrative costs of the Office relating to  
24 trademarks" and inserting "a proportionate share of  
25 the administrative costs of the Office".

1 (k) DERIVATION PROCEEDINGS.—

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

6 “(a) INSTITUTION OF PROCEEDING.—

7 “(1) IN GENERAL.—An applicant for patent  
8 may file a petition with respect to an invention to  
9 institute a derivation proceeding in the Office. The  
10 petition shall set forth with particularity the basis  
11 for finding that an individual named in an earlier  
12 application as the inventor or a joint inventor de-  
13 rived such invention from an individual named in the  
14 petitioner’s application as the inventor or a joint in-  
15 ventor and, without authorization, the earlier appli-  
16 cation claiming such invention was filed. Whenever  
17 the Director determines that a petition filed under  
18 this subsection demonstrates that the standards for  
19 instituting a derivation proceeding are met, the Di-  
20 rector may institute a derivation proceeding.

21 “(2) TIME FOR FILING.—A petition under this  
22 section with respect to an invention that is the same  
23 or substantially the same invention as a claim con-  
24 tained in a patent issued on an earlier application,  
25 or contained in an earlier application when published

1 or deemed published under section 122(b), may not  
2 be filed unless such petition is filed during the 1-  
3 year period following the date on which the patent  
4 containing such claim was granted or the earlier ap-  
5 plication containing such claim was published,  
6 whichever is earlier.

7 “(3) EARLIER APPLICATION.—For purposes of  
8 this section, an application shall not be deemed to  
9 be an earlier application with respect to an inven-  
10 tion, relative to another application, unless a claim  
11 to the invention was or could have been made in  
12 such application having an effective filing date that  
13 is earlier than the effective filing date of any claim  
14 to the invention that was or could have been made  
15 in such other application.

16 “(4) NO APPEAL.—A determination by the Di-  
17 rector whether to institute a derivation proceeding  
18 under paragraph (1) shall be final and not appeal-  
19 able.”.

20 (2) EFFECTIVE DATE.—The amendment made  
21 by paragraph (1) shall be effective as if included in  
22 the amendment made by section 3(i) of the Leahy-  
23 Smith America Invents Act.

24 (3) REVIEW OF INTERFERENCE DECISIONS.—  
25 The provisions of sections 6 and 141 of title 35,

1 United States Code, and section 1295(a)(4)(A) of  
2 title 28, United States Code, as in effect on Sep-  
3 tember 15, 2012, shall apply to interference pro-  
4 ceedings that are declared after September 15,  
5 2012, under section 135 of title 35, United States  
6 Code, as in effect before the effective date under sec-  
7 tion 3(n) of the Leahy-Smith America Invents Act.  
8 The Patent Trial and Appeal Board may be deemed  
9 to be the Board of Patent Appeals and Interferences  
10 for purposes of such interference proceedings.

11 (I) PATENT AND TRADEMARK PUBLIC ADVISORY  
12 COMMITTEES.—

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

15 (A) in paragraph (1), by striking “Mem-  
16 bers of” and all that follows through “such ap-  
17 pointments.” and inserting the following: “In  
18 each year, 3 members shall be appointed to  
19 each Advisory Committee for 3-year terms that  
20 shall begin on December 1 of that year. Any va-  
21 cancy on an Advisory Committee shall be filled  
22 within 90 days after it occurs. A new member  
23 who is appointed to fill a vacancy shall be ap-  
24 pointed to serve for the remainder of the prede-  
25 cessor’s term.”;



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

3 “(2) CHAIR.—The Secretary of Commerce, in  
4 consultation with the Director, shall designate a  
5 Chair and Vice Chair of each Advisory Committee  
6 from among the members appointed under para-  
7 graph (1). If the Chair resigns before the completion  
8 of his or her term, or is otherwise unable to exercise  
9 the functions of the Chair, the Vice Chair shall exer-  
10 cise the functions of the Chair.”; and

11 (C) by striking paragraph (3).

12 (2) TRANSITION.—

13 (A) IN GENERAL.—The Secretary of Com-  
14 merce shall, in the Secretary’s discretion, deter-  
15 mine the time and manner in which the amend-  
16 ments made by paragraph (1) shall take effect,  
17 except that, in each year following the year in  
18 which this Act is enacted, 3 members shall be  
19 appointed to each Advisory Committee (to  
20 which such amendments apply) for 3-year terms  
21 that begin on December 1 of that year, in ac-  
22 cordance with section 5(a) of title 35, United  
23 States Code, as amended by paragraph (1) of  
24 this subsection.

1 (B) DEEMED TERMINATION OF TERMS.—

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

13 (m) REPORT ON PRE-GATT APPLICATIONS.—Using  
14 existing resources, not later than four months after the  
15 date of the enactment of this Act, the Director of the  
16 United States Patent and Trademark Office shall submit  
17 a report to the Committees on the Judiciary of the United  
18 States House of Representatives and the Senate that de-  
19 scribes—

20 (1) the total number of pending United States  
21 applications for patent that—

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

24 (B) were filed before the effective date of  
25 the amendments made by section 532 of the

1 Uruguay Round Agreements Act (Public Law  
2 103–465; 108 Stat. 4983);

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

4 (3) the filing date of the earliest application for  
5 which each such application claims the benefit of or  
6 a right of priority to its filing date;

7 (4) the inventor and assignee named on each  
8 such application;

9 (5) the amount of time that examination of  
10 each such application has been delayed because of a  
11 proceeding under section 135(a) of title 35, United  
12 States Code, an appeal to the Patent Trial and Ap-  
13 peal Board under section 134(a) of such title, a civil  
14 action in a United States District Court under sec-  
15 tion 145 or 146 of such title, or an appeal to the  
16 United States Court of Appeals for the Federal Cir-  
17 cuit under section 141 of such title; and

18 (6) other information about such applications  
19 that the Director believes is relevant to their pend-  
20 ency.

21 (n) CLERICAL AMENDMENT.—Section 123(a) of title  
22 35, United States Code, is amended in the matter pre-  
23 ceding paragraph (1) by inserting “of this title” after  
24 “For purposes”.

1           (o) EFFECTIVE DATE.—Except as otherwise provided  
2 in this Act, the amendments made by this Act shall take  
3 effect on the date of the enactment of this Act and shall  
4 apply to proceedings commenced on or after such date of  
5 enactment.