

In the Senate of the United States,

December 28, 2012.

Resolved, That the bill from the House of Representatives (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.”, do pass with the following

AMENDMENT:

Strike all after the enacting clause and insert the following:

1 ***SECTION 1. TECHNICAL CORRECTIONS.***

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

7 (b) *TRANSITIONAL PROGRAM FOR COVERED BUSINESS*
8 *METHOD PATENTS.*—*Section 18 of the Leahy-Smith Amer-*
9 *ica Invents Act (35 U.S.C. 321 note) is amended—*

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

3 (2) *in subsection (d)(2), by striking “subsection”*
4 *and inserting “section”.*

5 (c) *JOINDER OF PARTIES.—Section 299(a) of title 35,*
6 *United States Code, is amended in the matter preceding*
7 *paragraph (1) by striking “or counterclaim defendants only*
8 *if” and inserting “only if”.*

9 (d) *DEAD ZONES.—*

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

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

19 (e) *CORRECT INVENTOR.—*

20 (1) *IN GENERAL.—Section 135(e) of title 35,*
21 *United States Code, as amended by section 3(i) of the*
22 *Leahy-Smith America Invents Act, is amended by*
23 *striking “correct inventors” and inserting “correct in-*
24 *ventor”.*

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

5 (f) *INVENTOR’S OATH OR DECLARATION.*—*Section 115*
6 *of title 35, United States Code, as amended by section 4*
7 *of the Leahy-Smith America Invents Act, is amended—*

8 (1) *by striking subsection (f) and inserting the*
9 *following:*

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

16 (2) *in subsection (g)(1), by striking “who*
17 *claims” and inserting “that claims”.*

18 (g) *TRAVEL EXPENSES AND PAYMENT OF ADMINISTRA-*
19 *TIVE JUDGES.*—*Notwithstanding section 35 of the Leahy-*
20 *Smith America Invents Act (35 U.S.C. 1 note), the amend-*
21 *ments made by section 21 of the Leahy-Smith America In-*
22 *vents Act (Public Law 112–29; 125 Stat. 335) shall be effec-*
23 *tive as of September 16, 2011.*

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

1 (1) in paragraph (1)—

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

8 (B) in subparagraph (B), in the matter pre-
9 ceding clause (i), by striking “the application in
10 the United States” and inserting “the applica-
11 tion under section 111(a) in the United States
12 or, in the case of an international application,
13 the date of commencement of the national stage
14 under section 371 in the international applica-
15 tion”;

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

20 (3) in paragraph (4)(A)—

21 (A) by striking “a determination made by
22 the Director under paragraph (3) shall have
23 remedy” and inserting “the Director’s decision
24 on the applicant’s request for reconsideration

1 under paragraph (3)(B)(ii) shall have exclusive
2 remedy”; and

3 (B) by striking “the grant of the patent”
4 and inserting “the date of the Director’s decision
5 on the applicant’s request for reconsideration”.

6 (i) *IMPROPER APPLICANT*.—Section 373 of title 35,
7 United States Code, and the item relating to that section
8 in the table of sections for chapter 37 of such title, are re-
9 pealed.

10 (j) *FINANCIAL MANAGEMENT CLARIFICATIONS*.—Sec-
11 tion 42(c)(3) of title 35, United States Code, is amended—

12 (1) in subparagraph (A)—

13 (A) by striking “sections 41, 42, and 376,”
14 and inserting “this title,”; and

15 (B) by striking “a share of the administra-
16 tive costs of the Office relating to patents” and
17 inserting “a proportionate share of the adminis-
18 trative costs of the Office”; and

19 (2) in subparagraph (B), by striking “a share of
20 the administrative costs of the Office relating to
21 trademarks” and inserting “a proportionate share of
22 the administrative costs of the Office”.

23 (k) *DERIVATION PROCEEDINGS*.—

24 (1) *IN GENERAL*.—Section 135(a) of title 35,
25 United States Code, as amended by section 3(i) of the

1 *Leahy-Smith America Invents Act, is amended to*
2 *read as follows:*

3 “(a) *INSTITUTION OF PROCEEDING.*—

4 “(1) *IN GENERAL.*—*An applicant for patent may*
5 *file a petition with respect to an invention to insti-*
6 *tute a derivation proceeding in the Office. The peti-*
7 *tion shall set forth with particularity the basis for*
8 *finding that an individual named in an earlier ap-*
9 *plication as the inventor or a joint inventor derived*
10 *such invention from an individual named in the peti-*
11 *tioner’s application as the inventor or a joint inven-*
12 *tor and, without authorization, the earlier applica-*
13 *tion claiming such invention was filed. Whenever the*
14 *Director determines that a petition filed under this*
15 *subsection demonstrates that the standards for insti-*
16 *tuting a derivation proceeding are met, the Director*
17 *may institute a derivation proceeding.*

18 “(2) *TIME FOR FILING.*—*A petition under this*
19 *section with respect to an invention that is the same*
20 *or substantially the same invention as a claim con-*
21 *tained in a patent issued on an earlier application,*
22 *or contained in an earlier application when published*
23 *or deemed published under section 122(b), may not be*
24 *filed unless such petition is filed during the 1-year*
25 *period following the date on which the patent con-*

1 *taining such claim was granted or the earlier appli-*
2 *cation containing such claim was published, which-*
3 *ever is earlier.*

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

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

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

21 “(3) *REVIEW OF INTERFERENCE DECISIONS.*—*The*
22 *provisions of sections 6 and 141 of title 35, United*
23 *States Code, and section 1295(a)(4)(A) of title 28,*
24 *United States Code, as in effect on September 15,*
25 *2012, shall apply to interference proceedings that are*

1 *declared after September 15, 2012, under section 135*
2 *of title 35, United States Code, as in effect before the*
3 *effective date under section 3(n) of the Leahy-Smith*
4 *America Invents Act. The Patent Trial and Appeal*
5 *Board may be deemed to be the Board of Patent Ap-*
6 *peals and Interferences for purposes of such inter-*
7 *ference proceedings.*

8 *(l) PATENT AND TRADEMARK PUBLIC ADVISORY COM-*
9 *MITTEES.—*

10 *(1) IN GENERAL.—Section 5(a) of title 35,*
11 *United States Code, is amended—*

12 *(A) in paragraph (1), by striking “Members*
13 *of” and all that follows through “such appoint-*
14 *ments.” and inserting the following: “In each*
15 *year, 3 members shall be appointed to each Advi-*
16 *sory Committee for 3-year terms that shall begin*
17 *on December 1 of that year. Any vacancy on an*
18 *Advisory Committee shall be filled within 90*
19 *days after it occurs. A new member who is ap-*
20 *pointed to fill a vacancy shall be appointed to*
21 *serve for the remainder of the predecessor’s*
22 *term.”;*

23 *(B) by striking paragraph (2) and inserting*
24 *the following:*

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

9 (C) by striking paragraph (3).

10 (2) TRANSITION.—

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

22 (B) DEEMED TERMINATION OF TERMS.—In
23 order to implement the amendments made by
24 paragraph (1), the Secretary of Commerce may
25 determine that the term of an existing member of

1 *an Advisory Committee under section 5 of title*
2 *35, United States Code, shall be deemed to termi-*
3 *nate on December 1 of a year beginning after the*
4 *date of the enactment of this Act, regardless of*
5 *whether December 1 is before or after the date on*
6 *which such member's term would terminate if*
7 *this Act had not been enacted.*

8 *(m) CLERICAL AMENDMENT.—Section 123(a) of title*
9 *35, United States Code, is amended in the matter preceding*
10 *paragraph (1) by inserting “of this title” after “For pur-*
11 *poses”.*

12 *(n) EFFECTIVE DATE.—Except as otherwise provided*
13 *in this Act, the amendments made by this Act shall take*
14 *effect on the date of enactment of this Act, and shall apply*
15 *to proceedings commenced on or after such date of enact-*
16 *ment.*

Attest:

Secretary.

112TH CONGRESS
2^D SESSION

H.R. 6621

AMENDMENT