



THINK FORWARD

President Signs Patent Reform Technical Corrections Bill

January 15, 2013

On January 14, 2013, President Obama signed into law a “technical corrections” bill that amends provisions of the Leahy-Smith America Invents Act (AIA), the recently enacted patent reform legislation. While much of the technical corrections bill deals with typographical, grammatical and drafting errors in the original bill, there are several items to note. These include the elimination of 'dead zones' where certain patents could not be challenged via Post-Grant Review (PGR) or Inter Parties Review (IPR); the clarifying of when the derivation proceeding can be instituted; the clarifying of certain patent term adjustment (PTA) calculations; and the clarifying of deadline for submission of the Oath/Declaration.

Elimination of Dead Zones – The AIA introduced the concepts of PGR and IPR. However, under the original AIA language, patents issued on applications filed before March 16, 2013 are not subject to PGR, but are subject to IPR. Similarly a reissue patent having issue claims identical to or narrower than the original claims could also not be challenged under PGR. The end result of this is a nine-month period after the grant of the patent in which no challenge may be initiated against the validity of the patent. The technical corrections bill eliminates the nine-month waiting period and allows patents in both instances to be immediately challenged, under IPR, after issuance

Derivation Proceedings - Derivation proceedings were also introduced under the AIA, but did not indicate the time for filing petitions to institute these proceedings. The technical corrections legislation specifies that the petition to institute a derivation proceeding must be filed within one year of the patent application publication or the patent grant, whichever is earlier.

Submission of Inventor's Oath/Declaration - Under the AIA, a signed inventor's oath/declaration does not need to be submitted at the time of filing the patent application or shortly thereafter. Rather, such signed documents only needed to be submitted before a Notice of Allowance was mailed. That time of mailing, however, is unknown to an applicant. The technical corrections legislation specifies that the oath/declaration deadline is the date on which the issue fee is paid.

PTA Calculations - The technical corrections legislation clarifies that calculations of delay caused by the U.S. Patent and Trademark Office are only to be calculated from the commencement of the national stage of a PCT application. Under the original language of the AIA, such calculations could have been calculated from the initial filing of the PCT application.

If you have any questions or wish to discuss how the AIA legislation may impact you, please contact your attorney at Brinks Gilson & Lione or visit the Patent Reform section of our website at www.brinksgilson.com.

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