

AMENDMENT NO. _____ Calendar No. _____

Purpose: In the nature of a substitute.

IN THE SENATE OF THE UNITED STATES—112th Cong., 2d Sess.

H. R. 6621

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

Referred to the Committee on _____ and
ordered to be printed

Ordered to lie on the table and to be printed

AMENDMENT IN THE NATURE OF A SUBSTITUTE intended
to be proposed by Mr. LEAHY

Viz:

1 Strike all after the enacting clause and insert the fol-
2 lowing:

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.

9 (b) TRANSITIONAL PROGRAM FOR COVERED BUSI-
10 NESS METHOD PATENTS.—Section 18 of the Leahy-Smith
11 America 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 “sub-
4 section” and inserting “section”.

5 (c) JOINDER OF PARTIES.—Section 299(a) of title
6 35, United States Code, is amended in the matter pre-
7 ceding paragraph (1) by striking “or counterclaim defend-
8 ants only 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 pe-
12 tition to institute an inter partes review of a patent
13 that is not a patent described in section 3(n)(1) of
14 the Leahy-Smith America Invents Act (35 U.S.C.
15 100 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
22 the Leahy-Smith America Invents Act, is amended
23 by striking “correct inventors” and inserting “cor-
24 rect inventor”.

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

5 (f) INVENTOR’S OATH OR DECLARATION.—Section
6 115 of title 35, United States Code, as amended by section
7 4 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
11 shall provide each required oath or declaration under sub-
12 section (a), substitute statement under subsection (d), or
13 recorded assignment meeting the requirements of sub-
14 section (e) no later than the date on which the issue fee
15 for the patent 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 ADMINIS-
19 TRATIVE JUDGES.—Notwithstanding section 35 of the
20 Leahy-Smith America Invents Act (35 U.S.C. 1 note), the
21 amendments made by section 21 of the Leahy-Smith
22 America Invents Act (Public Law 112–29; 125 Stat. 335)
23 shall be effective as of September 16, 2011.

24 (h) PATENT TERM ADJUSTMENTS.—Section 154(b)
25 of 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”
5 and inserting “of commencement of the na-
6 tional stage under section 371 in an inter-
7 national application”; and

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

16 (2) in paragraph (3)(B)(i), by striking “with
17 the written notice of allowance of the application
18 under section 151” and inserting “no later than the
19 date of 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 deci-
5 sion on the applicant’s request for reconsider-
6 ation”.

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

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

14 (1) in subparagraph (A)—

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

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

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

25 (k) DERIVATION PROCEEDINGS.—

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

5 “(a) INSTITUTION OF PROCEEDING.—

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

20 “(2) TIME FOR FILING.—A petition under this
21 section with respect to an invention that is the same
22 or substantially the same invention as a claim con-
23 tained in a patent issued on an earlier application,
24 or contained in an earlier application when published
25 or deemed published under section 122(b), may not

1 be filed unless such petition is filed during the 1-
2 year period following the date on which the patent
3 containing such claim was granted or the earlier ap-
4 plication containing such claim was published,
5 whichever is earlier.

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

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

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

23 (3) REVIEW OF INTERFERENCE DECISIONS.—
24 The provisions of sections 6 and 141 of title 35,
25 United States Code, and section 1295(a)(4)(A) of

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

10 (l) PATENT AND TRADEMARK PUBLIC ADVISORY
11 COMMITTEES.—

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

14 (A) in paragraph (1), by striking “Mem-
15 bers of” and all that follows through “such ap-
16 pointments.” and inserting the following: “In
17 each year, 3 members shall be appointed to
18 each Advisory Committee for 3-year terms that
19 shall begin on December 1 of that year. Any va-
20 cancy on an Advisory Committee shall be filled
21 within 90 days after it occurs. A new member
22 who is appointed to fill a vacancy shall be ap-
23 pointed to serve for the remainder of the prede-
24 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) CLERICAL AMENDMENT.—Section 123(a) of title
14 35, United States Code, is amended in the matter pre-
15 ceding paragraph (1) by inserting “of this title” after
16 “For purposes”.

17 (n) EFFECTIVE DATE.—Except as otherwise pro-
18 vided in this Act, the amendments made by this Act shall
19 take effect on the date of enactment of this Act, and shall
20 apply to proceedings commenced on or after such date of
21 enactment.