



Greenblum & Bernstein, P.L.C.
CLIENT ADVISORY
Recent Changes in Rules and Procedures

January 21, 2013

**TECHNICAL CORRECTIONS TO THE
AMERICA INVENTS ACT**

Dear Clients:

On January 14, 2013, President Obama signed into law modifications to the America Invents Act intended to correct and improve certain provisions of the Act. We summarize the pertinent modifications below.

Advice of Counsel: Effective one year after enactment, the AIA had barred using an accused infringer's failure to obtain advice of counsel to prove willful or induced infringement. The new modifications make that bar effective for any civil action commenced on or after enactment of the AIA.

"Dead Zones": Under the AIA, the remaining first-to-invent patents ("pre-AIA patents") to be issued prior to the effective date of the new first-to-file patent system had no avenue for review during the first nine months because they were required to wait nine months for *inter partes* review and are ineligible for post-grant review. The new modifications eliminate the "dead zone" by providing that the waiting provision for IPR filings does not apply to pre-AIA patents.

Applicant Requirements: Under the AIA, an applicant was required to comply with oath/declaration provisions in order to obtain a Notice of Allowance. The new modifications provide that an applicant must comply with the oath/declaration provision before paying the issue fee. The new modifications also repeal sections of Patent Act that provided that the PTO could not accept an international application designating the United States if it was filed by someone who was not qualified to file a U.S. patent application under section 111, i.e., someone other than an inventor.

Patent Term Adjustments: The new modifications change the "A" type (guarantee of timely action) from the date on which an international application *fulfilled* the requirements under 35 U.S.C. § 371 to the *commencement* date. This will avoid the problem of a PCT national stage not getting "A" type PTA until the declaration is filed. Moreover, this clarified that the statute for "B" type (three-year guarantee) is the national stage commencement date, which is how the PTO was interpreting the statute (but others were asserting that PCT filing date should be used).

The new modifications also allow the PTO to transmit the notice of determination of patent term adjustment no later than the issuance of the patent, rather than with

the Notice of Allowance. The new modifications also make an appeal to the U.S. District Court for the Eastern District of Virginia the exclusive remedy for challenging the USPTO's determination of PTA. The required timing for filing such appeal would now be within 180 days of the USPTO's decision, rather than 180 days after the patent issuance.

Derivation Proceedings and Interference: The new modifications change the timing for filing a derivation proceeding to one year from the date on which an earlier patent claiming a derived invention was granted, or an earlier application containing such claim was published, whichever is earlier. The new modifications specifically define what may be considered an "earlier application." The new modifications also clarify that interferences are subject to the pre-AIA provisions of the Patent Act governing the Board of Patent Appeals and Interferences and appeals to the Court of Appeals for the Federal Circuit.

Please feel free to contact us if there are any questions about any of these provisions.

Best regards,

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