

Comparison of the Technical Corrections to the AIA as Introduced November 30, 2012 and as Enacted as Public Law 112-274 on Jan. 14, 2013

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I. INTRODUCTION

My article "A review of HR 6621, dated November 30, 2012" specified changes to 35 USC that would result if the HR 6621 technical corrections (herein TC) bill to the America Invents Act (AIA) was passed. Since then, HR 6621 was amended and then enacted as PL 112-274. This article specifies the two changes to patent rights of the enacted version of the TC compared to the November 30, 2012 version. Other than these two changes (to the dead zones and the pre GATT applications), refer to my earlier article.

II. CHANGE TO THE PROPOSED CHANGE TO THE "DEAD ZONES"

Both the TC act of 11/20/13 and the TC act, as enacted, contain the same section 1(d)(1) dead zone provision, allowing inter partes review (IPR) of non AIA patents from their date of issue. However, they contain different section 1(d)(2)'s "dead zone" provisions.

The TC act of 11/30/12, section 1(d)(2) "dead zones" read: "(2) REPEAL- Section 325(f) of title 35, United States Code, as added by section 6 of the Leahy-Smith America Invents Act, is repealed." The TC act that is now PL 112-274, replaced the TC 11/30/12 section 1(d)(2) "dead zones" with the following section 1(d)(2): "2) REISSUE- Section 311(c)(1) of title 35, United States Code, is amended by striking 'or issuance of a reissue of a patent'."

Analysis:

325(f) as enacted by the AIA reads:

(f) REISSUE PATENTS.—A post-grant review may not be instituted under this chapter if the petition requests cancellation of a claim in a reissue patent that is identical to or narrower than a claim in the original patent from which the reissue patent was issued, and the time limitations in section 321(c) would bar filing a petition for a post-grant review for such original patent. (Added Sept. 16, 2011, Leahy-Smith America Invents Act, Public Law 112-29, sec. 6(d), 125

Stat. 284, effective Sept. 16, 2012.)

321(c) as enacted by the AIA reads:

(c) FILING DEADLINE.—A petition for a post-grant review may only be filed not later than the date that is 9 months after the date of the grant of the patent or of the issuance of a reissue patent (as the case may be).

311(c) as amended by the AIA reads:

(c) FILING DEADLINE.—A petition for inter partes review shall be filed after the later of either (1) the date that is 9 months after the grant of a patent or issuance of a reissue of a patent; or (2) if a post-grant review is instituted under chapter 32, the date of the termination of such post-grant review.

321(c) precludes a post grant review (PGR) if the PGR is filed more than 9 months after the issued date of a patent. 325(f) precludes a PGR of a reissued patent claim if the PGR is filed more than 9 months after the issued date of the original patent for any claim in the reissued patent that is "identical to or narrower than a claim in the original patent." In other words, 325(f) prevents an extension of the period for using a PGR to challenge a claim as a consequence of reissue of the patent resulting in a new issue date for a claim identical to or narrower than the claim in the original patent.

The TC act of 11/30/12 would have repealed 325(f). That would have allowed a PGR within 9 months from the issue date of a reissued patent, regardless of the relationship between claims in the original patent and the reissued patent. The TC, as enacted, however, dropped the repeal of 325(f). 325(f) remains law. Reissued patents normally issue much longer than 9 months after issue of the original patent. Therefore, PGR challenge of claims in reissued patents that were present in the original patents are generally barred.

The TC section 1(d)(2), as enacted, instead amended 35 USC 311(c)(1) by deleting "or issuance of a reissue of a patent," as shown below:

(c) FILING DEADLINE.—A petition for inter partes review shall be filed after the later of either (1) the date that is 9 months after

the grant of a patent ~~or issuance of a reissue of a patent~~; or (2) if a post-grant review is instituted under chapter 32, the date of the termination of such post-grant review.

First note that this change affects IPRs, not PGRs. Therefore, this amendment to 311(c)(1) does not affect the time limitation for a PGR attacking a claim in a reissued patent specified by 325(f).

Second, it is unclear whether this provision changes the law regarding when an IPR can be filed against a reissued patent. That is because it is unclear whether the "or issuance of a reissue of a patent", the language struck from 35 USC 311(c)(1), was redundant of the "grant of a patent" language in 311(c)(1). Note that 35 USC 251(d), as amended by the AIA, reads:

(d) REISSUE PATENT ENLARGING SCOPE OF CLAIMS.—No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent.

The language "No reissued patent shall be granted..." suggests that issue of a reissue patent is grant of a patent. If so, then the amendment to 311(c)(1) is merely clerical, making language more concise because "grant of a patent" may be construed to mean grant of either an original patent or a reissued patent. But if that was the intent, Congress could have amended 311(c)(1) to state "grant of an original or reissued patent". Thus, Congress may not have intended the 311(c)(1) "grant of a patent" to also mean issuance of a reissue patent. In that case, the issuance of a reissue patent does not start the 9 month period during which an IPR to challenge claims in the reissued patent cannot be filed, and the 9 month period instead would run from the date of grant of the original patent.

In summary, first, 325(f)'s limitations are still in effect. That is, there is a limitation on PGR attacks on certain claims in reissued patents under the conditions noted in this statutory section. Second, it is unclear whether an IPR for a reissued patent is barred within the first 9 months after the issuance of the reissued patent.

III. THE PROVISION TO KILL OFF PRE GATT PATENT APPLICATIONS, WAS KILLED OFF

The TC act of 11/30/2012, section 1(m), specified that:

(m) Effective Date of Uruguay Round Agreements Act-

(1) CERTAIN PATENT APPLICATIONS- Notwithstanding section 534(b)(1) of the Uruguay Round Agreements Act (35 U.S.C. 154 note), section 154(a) of title 35, United States Code, as amended by section 532 of the Uruguay Round Agreements Act (Public Law 103-465; 108 Stat. 4809), shall apply, and section 154(c)(1) of title 35, United States Code, shall not apply, to any application that is--

(A) filed before the date that is 6 months after the date of the enactment of the Uruguay Round Agreements Act; and

(B) pending on a date that is 1 year or more after the date of the enactment of this Act.

(2) EFFECTIVE DATE- This subsection shall take effect on the date that is 1 year after the date of the enactment of this Act and shall apply to any original plant or utility patent application that is pending on or after that effective date.

This provision was highly controversial because its effect would have been to deny rights to patent applicants whose applications had a filing date prior to June 8, 1995 (the pre GATT applications) unless those applications issued within a year of enactment of the TC act. This provision is not present in the TC as enacted.

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