

AIA Technical Amendment Eliminates the "Dead Zone"

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President Obama has signed the America Invents Act Technical Corrections Bill. The bill eliminates the “dead zone” for filing an *inter partes* review with the Patent and Trademark Office, extends the time for filing an inventor's oath or declaration up to the payment of the issue fee, and provides changes to patent term adjustment calculation and notice thereof.

President Signs AIA Technical Corrections Bill Into Law

On January 14, 2013, President Obama signed H.R. 6621, also known as the America Invents Act Technical Corrections Bill. The bill provides a number of technical and substantive changes to the America Invents Act (AIA), including an important elimination of a restriction for filing an *inter partes* review (IPR) with the Patent and Trademark Office (PTO)—frequently referred to as the “dead zone,” a liberalization of the timing for filing an inventor's oath or declaration and changes to patent term adjustment calculation.

Eliminates the IPR “Dead Zone”

First, and perhaps most significantly, the bill fixes provisions that inadvertently made it impossible to seek either *inter partes* review or post-grant review (PGR) of a patent during certain time periods. As originally intended, the PGR process would be available for patents up to nine months after issue and the IPR process would be available after nine months. “The problem with the provision is that, during Senate floor consideration of the AIA in March 2011, another provision was added . . . that allows only first-to-file patents to be challenged in PGR.” Representative Smith (TX). “Correcting and Improving the Leahy-Smith America Invents Act.” Congressional Record 158:171 (December 30, 2012), p. E2016. However, for several years to come, the majority of newly issued patents will have been filed under the first-to-invent system. The bill eliminates the nine-month “dead zone” for patents which were filed under the first-to-invent system.

In practice, the waiting period forced a nine-month delay after a patent issued for a challenger to file a proceeding at the PTO in which the challenger could meaningfully participate. With the bill passed, potential challengers will have IPR proceedings for first-to-invent patents available to them the day the patent issues.

Liberalizes the Timing for Oaths

Second, the bill provides that an inventor's oath or declaration, or a substitute statement, must be filed on or before the date the issue fee is paid, as opposed to on or before the issuance of a notice of allowance. This provision provides applicants with up to three months of additional time to file the inventor's oath or declaration.

Clarifies Patent Term Adjustment

Third, the bill clarifies and improves the requirements for patent term adjustment (PTA) calculation in PCT applications that entered the United States as national stage applications under Section 371, by providing that the PTO is to begin the PTA calculation as of "the date of commencement of the national stage under Section 371 in an international application." The bill also requires the PTO to provide notice of its PTA determination no later than the date of the issuance of the patent as opposed to with the notice of allowance.

Potential Future AIA Activity

A number of provisions were considered for inclusion in the Technical Corrections Bill, but not included in the final legislation. For example, the bill does not provide a provision to limit the patent term of long-pending "pre-GATT" applications filed before 1995 that have a patent term of the longer of 20 years from filing or 17 years from issuance. The estoppel effects of the post-grant review proceedings is another area that some thought would be modified by the bill.

Over the course of the next few months in which the AIA is fully implemented, WilmerHale will be providing updates to educate and guide our clients through these changes in the patent system.

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