

## HR 6621

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

**Congress:** 112 (2011–2013, Ended)

**Chamber:** House

**Policy Area:** Commerce

**Introduced:** Nov 30, 2012

**Current Status:** Became Public Law No: 112-274.

**Latest Action:** Became Public Law No: 112-274. (Jan 14, 2013)

**Law:** 112-274 (Enacted Jan 14, 2013)

**Official Text:** <https://www.congress.gov/bill/112th-congress/house-bill/6621>

### Sponsor

**Name:** Rep. Smith, Lamar [R-TX-21]

**Party:** Republican • **State:** TX • **Chamber:** House

### Cosponsors

*No cosponsors are listed for this bill.*

### Committee Activity

| Committee           | Chamber | Activity    | Date         |
|---------------------|---------|-------------|--------------|
| Judiciary Committee | House   | Referred To | Nov 30, 2012 |

### Subjects & Policy Tags

#### Policy Area:

Commerce

### Related Bills

| Bill        | Relationship | Last Action                                 |
|-------------|--------------|---|
| 112 HR 1249 | Related bill | Sep 16, 2011: Became Public Law No: 112-29. |

**(This measure has not been amended since it was passed by the Senate on December 28, 2012. The summary of that version is repeated here.)**

Amends the Leahy-Smith America Invents Act (AIA) to make technical changes regarding the transitional program for covered business method patents and joinder of parties.

Applies, to any civil action commenced on or after enactment of this Act, the AIA's bar on using an accused infringer's failure to obtain the advice of counsel to prove that any infringement was willful or induced. (Currently, the bar would not take effect until one year after the AIA's enactment.)

Prohibits a nine-month waiting period for inter partes review from applying to issuances of first-to-invent patents ineligible for post-grant review. (Currently, the remaining first-to-invent patents to be issued prior to the effective date of the new first-to-file patent system have no avenue for review during the first nine months because they must wait nine months for inter partes review and are ineligible for post-grant review.)

Revises the filing deadline for inter partes review to be after the later of either: (1) nine months after the grant of a patent (currently, nine months after such grant or the issuance of a reissue patent), or (2) the termination date of any post-grant review.

Extends the time period for an applicant to file an inventor's oath or declaration, substitute statement, or recorded assignment until the date on which the issue fee for the patent is paid. (Current law permits a notice of allowance of a patent application only after such a filing.)

Makes provisions concerning travel expenses for employees of the U.S. Patent and Trademark Office (USPTO) and the payment of administrative judges effective as of September 16, 2011.

Modifies requirements and time periods for activities relating to patent term adjustments. Revises the patent extension period for certain international applications. Specifies that a civil action filed in the U.S. District Court for the Eastern District of Virginia is the exclusive remedy for challenging a USPTO decision on a request for reconsideration of a patent term adjustment determination.

Repeals a provision prohibiting the USPTO from accepting certain international applications designating the United States from anyone not qualified under specified application requirements.

Revises USPTO funding requirements to make all federal patent law fees available for expenses relating to patent processing and to permit patent and trademark fees to be used interchangeably to cover proportionate shares of the USPTO's administrative costs. (Currently, patent fees are used to cover administrative costs relating to patents while trademark fees are used to cover administrative costs relating to trademarks.)

Modifies requirements for applicants filing petitions to institute derivation proceedings and delineates the criteria applied to deem an application as an earlier application with respect to an invention relative to another application.

Sets forth authority for the Patent Trial and Appeal Board to conduct, and for courts to review appeals from, interference proceedings declared after enactment but before the effective date of certain AIA amendments replacing interference proceedings with derivation proceedings.

Modifies the original appointment terms for members of the Patent Public Advisory Committee and the Trademark Public

Advisory Committee. Directs the Secretary of Commerce to designate, from among the appointed members, a Chair and Vice Chair of each committee.

## Actions Timeline

---

- **Jan 14, 2013:** Signed by President.
- **Jan 14, 2013:** Became Public Law No: 112-274.
- **Jan 3, 2013:** Presented to President.
- **Jan 1, 2013:** Resolving differences -- House actions: On motion that the House suspend the rules and agree to the Senate amendment Agreed to by voice vote.(consideration: CR H7559; text as House agreed to Senate amendment: CR 12/30/2012 H7455-7456)
- **Jan 1, 2013:** On motion that the House suspend the rules and agree to the Senate amendment Agreed to by voice vote. (consideration: CR H7559; text as House agreed to Senate amendment: CR 12/30/2012 H7455-7456)
- **Jan 1, 2013:** Motion to reconsider laid on the table Agreed to without objection.
- **Dec 30, 2012:** Message on Senate action sent to the House.
- **Dec 30, 2012:** Mr. Smith (TX) moved that the House suspend the rules and agree to the Senate amendment. (consideration: CR H7455-7457)
- **Dec 30, 2012:** DEBATE - The House proceeded with forty minutes of debate on the motion to suspend the rules and agree to the Senate amendment to H.R. 6621.
- **Dec 30, 2012:** At the conclusion of debate, the chair put the question on the motion to suspend the rules. Mr. Scott (VA) objected to the vote on the grounds that a quorum was not present. Further proceedings on the motion were postponed. The point of no quorum was considered as withdrawn.
- **Dec 28, 2012:** Measure laid before Senate by unanimous consent. (consideration: CR S8517-8518)
- **Dec 28, 2012:** Passed/agreed to in Senate: Passed Senate with an amendment by Unanimous Consent.
- **Dec 28, 2012:** Passed Senate with an amendment by Unanimous Consent.
- **Dec 19, 2012:** Received in the Senate, read twice.
- **Dec 18, 2012:** Mr. Smith (TX) moved to suspend the rules and pass the bill, as amended.
- **Dec 18, 2012:** Considered under suspension of the rules. (consideration: CR H6842-6844)
- **Dec 18, 2012:** DEBATE - The House proceeded with forty minutes of debate on H.R. 6621.
- **Dec 18, 2012:** At the conclusion of debate, the Yeas and Nays were demanded and ordered. Pursuant to the provisions of clause 8, rule XX, the Chair announced that further proceedings on the motion would be postponed.
- **Dec 18, 2012:** Considered as unfinished business. (consideration: CR H6854)
- **Dec 18, 2012:** Passed/agreed to in House: On motion to suspend the rules and pass the bill, as amended Agreed to by the Yeas and Nays: (2/3 required): 308 - 89 (Roll no. 631).(text: CR H6842-6843)
- **Dec 18, 2012:** On motion to suspend the rules and pass the bill, as amended Agreed to by the Yeas and Nays: (2/3 required): 308 - 89 (Roll no. 631). (text: CR H6842-6843)
- **Dec 18, 2012:** Motion to reconsider laid on the table Agreed to without objection.
- **Nov 30, 2012:** Introduced in House
- **Nov 30, 2012:** Referred to the House Committee on the Judiciary.