



Law360 Quotes Partner Richard Bone on Proposed Legislation to Update America Invents Act

“New Bill Would Fix 'Dead Zones' In America Invents Act”
Law360

December 5, 2012 - *Law360* quoted VLP Law Group’s Richard Bone, a partner in the firm’s Intellectual Property practice, on H.R. 6621 a new bill introduced by the U.S. House of Representatives to make corrections to the America Invents Act (AIA).

Law360 reports that the most substantive part of the bill is that it would eliminate so-called “dead zones” during which post-grant review is not available for some patents under the new AIA law, by permitting inter partes reviews to be filed immediately after a patent is granted, rather than only after nine months as is currently the case. Both inter partes review and post-grant review are new proceedings established by the AIA. The “dead zone” means that a patentee could file suit over a patent as soon as it is issued and a defendant would have no ability to challenge the patent at the U.S. Patent and Trademark Office except via an *ex parte* re-examination request. “Eliminating that loophole would not be good for certain patentees, but it would be good for people challenging patents,” said Dr. Bone.

H.R. 6621, referred to by lawmakers as a “technical corrections” bill, also includes a provision that would affect the small number of long-pending (pre-GATT) patent applications. Those patent applications are the last that could benefit from a patent term that is measured as 17 years from their date of issue. Under the provision, if a pre-GATT application is not granted within a year of the bill’s enactment, a patent granted on the application would be forced to have a term that is 20 years from its earliest effective filing date, meaning that many of the applications would effectively have pre-expired. As Dr. Bone noted, taking this action against those specific applications will be very controversial for the applicants whose rights will be affected.

Most of the other aspects of the bill would make small amendments to the America Invents Act and would give patent applicants greater procedural flexibility. The bill does propose a mingling of PTO fees currently accounted for separately by the patent and trademark sides of the office. If doing that would give the PTO an option to delay its latest proposed schedule of patent fees, then that would be welcomed in the patent applicant community.

The fate of H.R. 6621 will most likely be subsumed into the current “fiscal cliff” negotiations that are dominating the end of the Congressional session. If the bill has to be introduced in the next session, most of the technical corrections are not likely to be vigorously opposed.

Read the article at [Law360 website](#).

View [recording](#) of recent webinar on Highlights of the AIA by Dr. Bone.