



## COMPARISON OF SELECTED SECTIONS OF PRE-AIA AND AIA U.S. PATENT LAW.

LEAHY-SMITH AMERICA INVENTS ACT (AIA), PUB. L. NO. 112-29, 125 STAT. 284 (SEPT. 16, 2011).  
LISTED IN ORDER OF SECTIONS OF THE AIA. NOT EVERY SECTION IS COVERED. A SUMMARY  
OF STUDIES AND REPORTS BEGINS ON PAGE 13. “SEC.” MEANS A SECTION OF THE AIA; “§”  
MEANS A SECTION OF TITLE 35 U.S.C.

The text of the AIA is at [www.ipo.org/aia](http://www.ipo.org/aia). Submit suggestions and corrections for the next edition of this chart to [info@ipo.org](mailto:info@ipo.org). Copyright © 2011 Intellectual Property Owners Association. Permission to reproduce in whole or part is granted provided IPO is credited as the source.

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# COMPARISON OF SELECTED SECTIONS OF PRE-AIA AND AIA U.S. PATENT LAW.

PRE-AIA	AIA
<b>FIRST INVENTOR TO FILE, PRIOR ART &amp; GRACE PERIOD</b>	
<p style="text-align: center;"><i>35 U.S.C. §§102-103</i></p> <p><b>FIRST TO INVENT</b></p> <ul style="list-style-type: none"> <li>• §§102(g), 135, and 291 provide for proceedings to determine the earlier inventor.</li> <li>• §103 precludes patenting of an invention if it would have been obvious “at the time the invention was made . . . .”</li> </ul> <p><b>PRIOR ART</b></p> <ul style="list-style-type: none"> <li>• §102(a) precludes a patent if, before invention by the applicant, the invention was known or used in the U.S. or patented or described in a printed publication anywhere. §102(b) precludes a patent if, more than 12 months before U.S. filing, the invention was patented or described in a printed publication anywhere or in public use or on sale in the U.S. “On sale” is defined in case law.</li> <li>• §102(e) precludes a patent if the invention was described in a patent or published patent application filed by another before the applicant’s filing date in the U.S.</li> <li>• §102(g) precludes a patent if before the applicant made the invention, it was made by another who had not abandoned, suppressed, or concealed it.</li> </ul>	<p style="text-align: center;"><i>Sec. 3, 125 Stat. at 285-87</i></p> <p><b>FIRST INVENTOR TO FILE</b></p> <ul style="list-style-type: none"> <li>• §102(a)(2) precludes a patent if the claimed invention was described in a patent or patent application naming another inventor and “effectively filed before the effective filing date of the claimed invention.”</li> <li>• §103 states that a patent may not be obtained if the claimed invention would have been obvious “before the effective filing of the claimed invention.”</li> </ul> <p><b>PRIOR ART</b></p> <ul style="list-style-type: none"> <li>• §102(a)(1) precludes a patent if the invention was patented, described in a printed publication or “in public use, on sale or otherwise available to the public” <i>anywhere</i> before the inventor’s effective filing date. “On sale” means publically on sale.</li> <li>• §102(a)(2) precludes a patent if the invention was described in a U.S. patent or published U.S. patent application effectively filed by another before the applicant’s effective filing date. Prior art date can be a foreign filing date; <i>In re Hilmer</i> is overruled.</li> <li>• No comparable provision.</li> </ul>

PRE-AIA	AIA
<p><b>GRACE PERIOD</b></p> <ul style="list-style-type: none"> <li>§102(b) provides that an invention is not prior art if it was patented or described in printed publication anywhere, or in public use or on sale in the U.S., one year or less before the U.S. filing date. “On sale” is defined in case law.</li> </ul>	<p><b>GRACE PERIOD</b></p> <ul style="list-style-type: none"> <li>§102(b)(1) provides that a disclosure is not prior art if the disclosure was made one year or less before the effective filing date of the claimed invention and: (A) the disclosure was made by the inventor or someone who obtained the subject matter from the inventor, or (B) before the disclosure, the subject matter was publicly disclosed (e.g., published) by the inventor or someone who obtained the subject matter from the inventor.</li> </ul> <p><b>EFFECTIVE:</b> March 16, 2013. Applies to patent applications and patents containing, or that at any time contained, a claim with an effective filing date on or after March 16, 2013.</p>
<b>DERIVATION PROCEEDINGS</b>	
<p style="text-align: center;"><i>35 U.S.C. §§135 &amp; 291</i></p> <ul style="list-style-type: none"> <li>Derivation is not referred to in §135, which governs interference proceedings in the USPTO, but can arise in interference proceedings.</li> <li>No comparable provision.</li> <li>No comparable provision.</li> <li>Derivation is not referred to in §291, which permits a civil action by a patent owner against the owner of an interfering patent, but can arise in such civil actions.</li> </ul>	<p style="text-align: center;"><i>Sec. 3, 125 Stat. at 288-90</i></p> <ul style="list-style-type: none"> <li>§135 permits a patent applicant to petition to institute a derivation proceeding in the USPTO, alleging that the inventor named in an earlier application derived the invention from the petitioner.</li> <li>A §135 petition must be filed within one year after the publication of a claim that is the same or substantially the same as the earlier application’s claim.</li> <li>The USPTO may correct the naming of the inventor in any application or patent at issue under §135.</li> <li>§291 gives the owner of a patent relief by civil action against the owner of another patent that claims the same invention and has an earlier effective filing date <i>if</i> the invention claimed in the other patent was derived from the inventor of the invention claimed by the patent owner seeking relief and the action is filed within one year after the issuance of the first patent.</li> </ul> <p><b>EFFECTIVE:</b> March 16, 2013. Applies to patent applications and issued patents containing, or that at any time contained, a claim with an effective filing date on or after March 16, 2013.</p>

PRE-AIA	AIA
<b>INVENTOR'S OATH/ASSIGNEE FILING</b>	
<p style="text-align: center;"><i>35 U.S.C. §§115, 116, 118, 256</i></p> <ul style="list-style-type: none"> <li>• §115 states that the oath must include a statement of belief that the applicant is original and first inventor. The inventor is deemed to be the applicant.</li> <li>• Assignee may file an application and oath on behalf of inventor who cannot be found or who refuses to cooperate.</li> <li>• §§116 &amp; 256 require the absence of deceptive intent to correct inventorship errors.</li> </ul>	<p style="text-align: center;"><i>Sec. 4, 125 Stat. at 293</i></p> <ul style="list-style-type: none"> <li>• §115 requires the name and an oath or declaration of the inventor to be filed prior to notice of allowance. The oath or declaration must include statement of belief that inventor is the original inventor.</li> <li>• §118 allows an assignee to file an application. The assignee is deemed to be the applicant.</li> <li>• Corrections may be made at any time, and failure to comply with requirements under §115 will not make a patent invalid or unenforceable if the failure is remedied.</li> </ul> <p><b>EFFECTIVE:</b> For applications filed on or after September 16, 2012.</p>
<b>PRIOR USER RIGHTS</b>	
<p style="text-align: center;"><i>35 U.S.C. §273</i></p> <ul style="list-style-type: none"> <li>• §273(b) allows a prior user rights defense against patents for methods of doing or conducting business if the prior user reduced the invention to practice one year before the filing date of the patent and commercially used the invention in the U.S. before the effective filing date of the patent.</li> <li>• No comparable provision.</li> <li>• No comparable provision.</li> </ul>	<p style="text-align: center;"><i>Sec. 5, 125 Stat. at 297-99</i></p> <ul style="list-style-type: none"> <li>• §273 extends prior user rights to all subject matter.</li> <li>• The defense applies to all internal commercial uses of inventions or arm's length sales of "a useful end result" of such uses made one year before either the effective filing date of the claimed invention or public disclosure date.</li> <li>• The defense is unavailable if a patented invention, when made, was owned or subject to obligation of assignment to an institution of higher education or a technology transfer organization whose primary purpose is commercialization of technologies developed by institutions of higher education.</li> </ul> <p><b>EFFECTIVE:</b> For any patent issued on or after September 16, 2011.</p>

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<b>POST-GRANT REVIEW</b>	
<ul style="list-style-type: none"> <li>• No comparable provisions.</li> </ul>	<p style="text-align: center;"><i>Sec. 6, 125 Stat. at 305</i></p> <ul style="list-style-type: none"> <li>• New §§321-329 add post-grant review (PGR) procedure in which a 3<sup>rd</sup> party may file a petition to institute PGR to cancel one or more patent claims within nine months of issue or reissue date.</li> <li>• §324 states PGR will be granted if it is more likely than not that at least one of the claims challenged in the petition is unpatentable OR if the petition raises a novel or unsettled legal question.</li> <li>• Petitioner may assert <u>any</u> basis for asserting invalidity (except failure to disclose best mode), and may rely on patents, printed publications, affidavits, or declarations of supporting evidence and opinions.</li> <li>• The patent owner may file one motion to amend the patent by canceling any challenged patent claim, and proposing a reasonable number of substitute claims.</li> <li>• §325 sets forth PGR’s relation to other proceedings:             <ul style="list-style-type: none"> <li>○ After the Patent Trial and Appeal Board (PTAB) issues a final decision, petitioner will be estopped from raising in a subsequent USPTO proceeding, a civil action, or an ITC proceeding that a patent claim is invalid on any ground that the petitioner raised or <i>reasonably</i> could have raised during PGR.</li> <li>○ PGR is not available if petitioner has first filed a civil action (not including counterclaims) challenging the validity of the patent.</li> <li>○ If petitioner files a civil action after filing petition for PGR, the civil action is automatically stayed until the patent owner moves to lift the stay or files a civil action or counterclaim that petitioner has infringed the patent.</li> <li>○ A patentee’s motion for a preliminary injunction in a civil</li> </ul> </li> </ul>

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	<p>action will not be stayed if the patent owner files the action within 3 months from the patent's issue date.</p> <ul style="list-style-type: none"> <li>• §327 permits parties to settle prior to a decision on the merits and no estoppel will attach to petitioner.</li> <li>• A final decision must be issued within one year from the notice of grant of PGR, with an extension of six months for good cause, and any party may appeal that decision to the Federal Circuit.</li> </ul> <p><b>EFFECTIVE:</b> On or after September 16, 2012 for patents issued/reissued less than nine months. Limited, however, to patents based on first-inventor-to-file applications under Sec. 3 (which may not be filed until March 16, 2013).</p>
INTER PARTES REVIEW	
<p><b>35 U.S.C. §§311-318</b></p> <ul style="list-style-type: none"> <li>• Any 3<sup>rd</sup> party may file a request for <i>inter partes</i> <u>reexamination</u> by an examiner at any time.</li> <li>• For requests filed before September 16, 2011, <i>inter partes</i> reexamination will be granted if there is a substantial new question of patentability. For requests filed after September 16, 2011, <i>inter partes</i> reexamination will be granted if there is a reasonable likelihood that the petitioner would prevail with respect to at least one of the challenged claims.</li> <li>• Substantially same per USPTO practice.</li> <li>• Permits the patent owner to propose amendments and add new claims.</li> </ul>	<p><b>Sec. 6, 125 Stat. at 299</b></p> <ul style="list-style-type: none"> <li>• Any 3<sup>rd</sup> party may file a petition to institute <i>inter partes</i> <u>review</u> (IPR) by the PTAB nine months or more after issue or reissue date or at the conclusion of PGR. IPR may not be filed, however, more than one year after petitioner is sued for infringing the patent.</li> <li>• §314 states IPR will be granted if there is a reasonable likelihood that the petitioner would prevail with respect to at least one of the challenged claims.</li> <li>• Petitioner may assert only §§102 and 103 as the basis for invalidity, and may rely on patents, printed publications, affidavits, or declarations of supporting evidence and opinions.</li> <li>• §316 provides that the patent owner may file one motion to amend the patent by canceling any challenged patent claim and proposing a reasonable number of substitute claims.</li> </ul>

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<ul style="list-style-type: none"> <li>• Petitioner is estopped from raising in a civil action that a patent claim is invalid on any ground that petitioner raised or could have raised during the reexamination proceedings. Estoppel does not take effect, however, until petitioner has exhausted all available appeals. A stay of pending litigation may be obtained unless it would not serve the interest of justice.</li>   <li>• No comparable provision.</li>   <li>• No comparable provision.</li>   <li>• Proceedings are to be conducted with “special dispatch.”</li> </ul>	<ul style="list-style-type: none"> <li>• §315 sets forth IPR's relation to other proceedings:               <ul style="list-style-type: none"> <li>○ IPR is not available if petitioner has first filed a civil action (not including counterclaims) challenging the validity of the patent.</li> <li>○ After PTAB issues final decision, petitioner will be estopped from raising in a subsequent USPTO proceeding, a civil action, or an ITC proceeding that a patent claim is invalid on any ground that petitioner raised or <i>reasonably</i> could have raised during IPR.</li> <li>○ If petitioner files a civil action after filing petition for IPR, the civil action is automatically stayed until the patent owner moves to lift the stay or files a civil action or counterclaim that petitioner has infringed the patent.</li> </ul> </li>   <li>• §316 permits limited discovery.</li>   <li>• §317 permits parties to settle prior to a decision on the merits and no estoppel will attach to petitioner.</li>   <li>• A final decision must be issued within one year from the notice of grant of IPR, with an extension of six months for good cause.</li> </ul> <p><b>EFFECTIVE:</b> September 16, 2012, for any patent issued before, on, or after that date.</p>
<b>SUBMISSION OF PRIOR IN ART IN APPLICATIONS BY THIRD PARTIES TO USPTO</b>	
	<p style="text-align: center;"><i>Sec. 8, 125 Stat. at 315</i></p> <ul style="list-style-type: none"> <li>• §122 allows third parties to submit for inclusion in the record of a patent application any patent, published patent application or other printed publication to the USPTO: before the date of notice of allowance, six months after the publication date, or the date of first rejection, whichever is earlier.</li> </ul> <p><b>EFFECTIVE:</b> September 16, 2012, for any application filed before, on, or</p>



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	after that date.
<b>VENUE FOR USPTO</b>	
<ul style="list-style-type: none"> <li>35 U.S.C. §§32, 145, 146, 154(b)(4)(A), 293 and 15 U.S.C. §1070(b)(4) list venue of the USPTO in the “United States District Court for the District of Columbia”.</li> </ul>	<p style="text-align: center;"><i>Sec. 9, 125 Stat. at 316</i></p> <ul style="list-style-type: none"> <li>35 U.S.C. §§32, 145, 146, 154(b)(4)(A), 293 and 15 U.S.C. §1070(b)(4), list venue of the USPTO in the “United States District Court for the Eastern District of Virginia.”</li> </ul> <p><b>EFFECTIVE:</b> September 16, 2011.</p>
<b>PATENT FEES</b>	
<ul style="list-style-type: none"> <li>Congress controls the general authority to set patent and trademark fees.</li> <li>Fees reduced by 50% for small entities.</li> </ul>	<p style="text-align: center;"><i>Sec. 10-11, 125 Stat. at 316</i></p> <ul style="list-style-type: none"> <li>The USPTO Director is given the authority to set and adjust the patent and trademark fees by rule to recover the estimated costs to the USPTO for processing, activities and services.</li> <li>Same for small entities and reduced by 75% for micro entities.             <ul style="list-style-type: none"> <li>A micro-entity is a small entity that has been an inventor in no more than three prior applications; has less than three times the median household income; and has not assigned ownership interest in an application to an entity with an income exceeding three times the median household income.</li> </ul> </li> <li>The Director is required to publish any proposed fee change in the Federal Register and allow 45 days for public comment. The Patent Public Advisory Committee and Congress may comment on the rule.</li> <li>Automatic 15% surcharge added to pre-AIA fees on September 26, 2011</li> </ul> <p><b>EFFECTIVE:</b> 15% Surcharge Effective September 26, 2011. September 16, 2011, sunsets on September 16, 2018 (Seven years from enactment date).</p>

PRE-AIA	AIA
<b>ELECTRONIC FILING INCENTIVE</b>	
<ul style="list-style-type: none"> <li>• §41 requires the USPTO to charge certain fees for different types of patent applications, but does not discriminate between electronic and paper filings.</li> </ul>	<p style="text-align: center;"><i>Sec. 10, 125 Stat. at 319</i></p> <ul style="list-style-type: none"> <li>• A \$400 fee shall be charged for each patent application not filed electronically.</li> </ul> <p><b>EFFECTIVE:</b> 60 days from September 16, 2011, which is November 15, 2011.</p>
<b>SUPPLEMENTAL EXAMINATION</b>	
<ul style="list-style-type: none"> <li>• No comparable provisions.</li> </ul>	<p style="text-align: center;"><i>Sec. 12, 125 Stat. at 325-27</i></p> <ul style="list-style-type: none"> <li>• Adds §257 allowing a patent owner to request supplemental examination of a patent in the USPTO to consider, reconsider, or correct information believed to be relevant to the patent.</li> <li>• Supplemental examination is ordered if a substantial new question of patentability is raised by one or more items of information in the request. If the requirements are met the USPTO Director must conduct supplemental examination within three months of the request date according to procedures for <i>ex parte</i> reexamination.</li> <li>• A patent shall not be held unenforceable if the information was considered, reconsidered, or corrected in supplemental examination. Supplemental examination must be concluded before an allegation is pled in a civil action. If the Director becomes aware that a material fraud on the USPTO may have been committed, the Director shall refer the matter to the Attorney General.</li> </ul> <p><b>EFFECTIVE:</b> September 16, 2012.</p>
<b>TAX STRATEGY PATENTS</b>	
<ul style="list-style-type: none"> <li>• No comparable provisions.</li> </ul>	<p style="text-align: center;"><i>Sec. 14, 125 Stat. at 327</i></p> <ul style="list-style-type: none"> <li>• Precludes patentability for inventions for reducing, avoiding, or deferring tax liability by deeming such inventions to be within the prior art.</li> </ul>

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	<ul style="list-style-type: none"> <li>Does not apply to the part of an invention that is used solely for preparing/filing tax return or for financial management that is severable from any tax strategy.</li> </ul> <p><b>EFFECTIVE:</b> For any patent application pending on or filed on or after September 16, 2011, as well as any patent that is issued on or after September 16, 2011.</p>
<b>BEST MODE REQUIREMENT</b>	
<p style="text-align: center;"><i>35 U.S.C. §§112 &amp; 282</i></p> <ul style="list-style-type: none"> <li>§112 requires inventor to disclose best mode of carrying out invention.</li> <li>§282 requires invalidation of claim for failure to comply with any requirement of §112.</li> </ul>	<p style="text-align: center;"><i>Sec. 15, 125 Stat. at 328</i></p> <ul style="list-style-type: none"> <li>Same.</li> <li>§282 states that failure to disclose best mode shall not be basis for invalidity or unenforceability.</li> </ul> <p><b>EFFECTIVE:</b> September 16, 2011.</p>
<b>VIRTUAL MARKING AND FALSE PATENT MARKING</b>	
<p style="text-align: center;"><i>35 U.S.C. §287</i></p> <ul style="list-style-type: none"> <li>§287 states that patentees may give notice to the public that an item is patented, either by fixing the word “patent” or “pat.” and the patent number to the article (or its packaging).</li> <li>Whoever falsely marks an unpatented article with a patent number for the purpose of deceiving the public shall be fined not more than \$500 for every such offense.</li> <li>Any person may sue for penalty, with one half to go the person suing and the other half to the U.S.</li> </ul>	<p style="text-align: center;"><i>Sec. 16, 125 Stat. at 328-29</i></p> <ul style="list-style-type: none"> <li>Amends §287(a) to allow patentees the option of fixing an Internet address that associates the patented article with the patent number as opposed to physical patent marking.</li> <li>Only the U.S. may sue for penalty.</li> <li>A person who has suffered competitive injury may sue for damages. Marking with the number of an expired patent number is not a violation.</li> </ul> <p><b>EFFECTIVE:</b> Amendment to apply to all cases without exception pending on or commenced on or after September 16, 2011.</p>

PRE-AIA	AIA
<b>ADVICE OF COUNSEL</b>	
<ul style="list-style-type: none"> <li>No comparable provision.</li> </ul>	<p style="text-align: center;"><i>Sec. 17, 125 Stat. at 329</i></p> <ul style="list-style-type: none"> <li>Adds a new section, §298 stating that failure to obtain advice of counsel may not be used to prove willful infringement.</li> </ul> <p><b>EFFECTIVE:</b> For patents issued on or after September 16, 2012.</p>
<b>REVIEW OF BUSINESS-METHOD PATENTS</b>	
<ul style="list-style-type: none"> <li>No comparable provision.</li> </ul>	<p style="text-align: center;"><i>Sec. 18, 125 Stat. at 329</i></p> <ul style="list-style-type: none"> <li>Regulations will be implemented for transitional post-grant review for patents claiming methods for performing data processing and other operations used in administration of financial products/services, except that patents for technological inventions are not included.</li> <li>Only a party who has been sued or charged with infringement by a patent owner may request review.</li> <li>If review results in a final written decision by PTAB, the same grounds may not be raised in a civil action or before the ITC.</li> <li>If a patent under review is also at issue in an infringement action, a party may seek a stay of that action, and the court’s decision is immediately appealable to the Federal Circuit.</li> </ul> <p><b>EFFECTIVE:</b> September 16, 2012; sunsets September 16, 2020.</p>
<b>JOINDER OF PARTIES</b>	
<ul style="list-style-type: none"> <li>No comparable provision.</li> </ul>	<p style="text-align: center;"><i>Sec. 19, 125 Stat. at 332</i></p> <ul style="list-style-type: none"> <li>Adds a new section, §299, allowing infringers in patent civil actions to be joined only if:             <ul style="list-style-type: none"> <li>the right to relief is asserted against the parties jointly, severally, or via same transaction or occurrence, relating to the making,</li> </ul> </li> </ul>

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	<p>using or importing into U.S., relating to the same accused product or process; and</p> <ul style="list-style-type: none"> <li>○ if questions of fact are common to all defendants. Parties are ineligible for joinder when there are mere allegations that they may have infringed.</li> </ul> <p><b>EFFECTIVE:</b> September 16, 2012.</p>
<b>USPTO FUNDING/ENDING FEE DIVERSION</b>	
<p style="text-align: center;"><i>35 U.S.C. §42</i></p> <ul style="list-style-type: none"> <li>• §42(b) provides that all fees are deposited in the USPTO appropriations account in the U.S. Treasury, but §42(c) makes fees available to the USPTO only when authorized “in advance in appropriations Acts”. Since 1991, the USPTO has collected <u>over</u> \$1 billion in user fees to which it has been unable to obtain access.</li> </ul>	<p style="text-align: center;"><i>Sec. 22, 125 Stat. at 336</i></p> <ul style="list-style-type: none"> <li>• Amends §42(c) to create a USPTO “Reserve Fund” in the U.S. Treasury to hold fee collections in excess of the USPTO’s annual appropriation, but still does not make the fee collections available without an appropriation.</li> </ul> <p><b>EFFECTIVE:</b> October 1, 2011.</p>
<b>SATELLITE OFFICES</b>	
<ul style="list-style-type: none"> <li>• No comparable provision.</li> </ul>	<p style="text-align: center;"><i>Sec. 23, 125 Stat. at 336</i></p> <ul style="list-style-type: none"> <li>• Requires USPTO to establish three or more satellite offices in the U.S., subject to available resources.</li> </ul> <p><b>EFFECTIVE:</b> Within three years after September 16, 2011, which is September 16, 2014.</p>
<b>PRIORITIZED EXAMINATION</b>	
<ul style="list-style-type: none"> <li>• The USPTO has developed certain prioritized examination programs via rulemaking.</li> </ul>	<p style="text-align: center;"><i>Section 25, 125 Stat. at 337</i></p> <ul style="list-style-type: none"> <li>• Amends §2(b)(2) to allow the USPTO, at the request of an applicant, to prioritize examination for products, processes, or technologies important to the U.S. economy or U.S. competitiveness.</li> </ul> <p><b>EFFECTIVE:</b> September 16, 2012.</p>

PRE-AIA	AIA
<b>PATENT CLAIMS DIRECTED TO OR ENCOMPASSING A HUMAN ORGANISM</b>	
<p style="text-align: center;"><i>Pub. L. 111-117</i></p> <ul style="list-style-type: none"> <li>• The Weldon Amendment has been included in annual appropriations bills since 2004. The amendment states: “None of the funds appropriated or otherwise made available by this [appropriations] act may be used to issue patents on claims directed to or encompassing a human organism.”</li> <li>• The Weldon Amendment was last included in Sec. 518, Title V, Division B, of FY2010 Consolidated Appropriations Act (<u>Pub. L. 111-117</u>) – an appropriations act that was extended by the 2011 Fiscal Year Omnibus Appropriations bill (Pub. L. 112-10). <i>See also letter</i> from the USPTO on examining procedures regarding the Weldon Amendment.</li> </ul>	<p style="text-align: center;"><i>Sec. 33, 125 Stat. at 340</i></p> <ul style="list-style-type: none"> <li>• Permanent legislation stating that “no patent may issue on a claim directed to or encompassing a human organism,” notwithstanding any other provision of law.</li> </ul> <p><b>EFFECTIVE:</b> On applications pending on or filed after September 16, 2011.</p>
<b>CALCULATION OF 60 DAY PERIOD FOR PATENT TERM ADJUSTMENTS</b>	
<ul style="list-style-type: none"> <li>• No comparable provision.</li> <li>• When the FDA receives requests for approval after hours (after 4:30p.m. ET), the FDA considers it received on the next business day. When communications are <i>sent</i> after 4:30p.m., the FDA considers it sent on the same business day, provided that the communication is sent prior to midnight. <i>The Medicines Company v. David Kappos, et al.</i>, 731 F.Supp.2d 470, 473 (E.D. Va. 2010).</li> </ul>	<p style="text-align: center;"><i>Sec. 37, 125 Stat. at 341</i></p> <ul style="list-style-type: none"> <li>• Amends §156(d)(1) such that if a grant of regulatory approval (such as FDA approval, etc.) is transmitted after 4:30p.m., ET on a business day, the product shall be deemed to receive permission on the next business day.</li> </ul> <p><b>EFFECTIVE:</b> Applies to applications pending on, filed after, or decisions subject to judicial review as of September 16, 2011.</p>

## STUDIES AND REPORTS

<b>REPORT ON MISCONDUCT BEFORE THE OFFICE</b>
<i>Sec. 3, 125 Stat. at 291</i>
<ul style="list-style-type: none"> <li>Requires the USPTO Director to report to the House and Senate Judiciary Committees <b>once every two years</b> on the impact that the new statute of limitations provision (Sec. 3, 125 Stat. at 291) has on the USPTO, including a short description of misconduct made known to the USPTO but where the USPTO was barred from commencing a proceeding due to the new provision.</li> </ul>
<b>SMALL BUSINESS STUDY</b>
<i>Sec. 3, 125 Stat. at 291</i>
<ul style="list-style-type: none"> <li>Requires the Small Business Administration and the USPTO to conduct a study for the Senate and House Small Business and Judiciary Committees <b>within 1 year of September 16, 2011</b>, on how eliminating the first-to-invent system affects the ability for small business to obtain patents.</li> </ul>
<b>REPORT ON PRIOR USER RIGHTS</b>
<i>Sec. 3, 125 Stat. at 292</i>
<ul style="list-style-type: none"> <li>Requires the USPTO Director to report to the House and Senate Judiciary Committees <b>not later than 4 months after September 16, 2011</b>, on the operation of prior user rights in other industrialized countries.</li> </ul>
<b>REPORT ON SATELLITE OFFICES</b>
<i>Sec. 23, 125 Stat. at 337</i>
<ul style="list-style-type: none"> <li>Requires the USPTO Director to report to Congress <b>every three years after September 16, 2011</b> on the rationale for selecting the location of satellite offices, progress in establishment of the offices, and whether the offices are achieving their identified purposes.</li> </ul>
<b>STUDY OF AMERICA INVENTS ACT</b>
<i>Sec. 26, 125 Stat. at 338</i>
<ul style="list-style-type: none"> <li>Requires the USPTO Director to conduct a study <b>within 4 years of September 16, 2011</b>, on the manner in which the Act is being implemented and its effects on innovation, competitiveness and small business access to capital.</li> </ul>
<b>STUDY ON GENETIC TESTING</b>
<i>Sec. 27, 125 Stat. at 338</i>
<ul style="list-style-type: none"> <li>Requires the USPTO Director to conduct a study <b>not later than 9 months after September 16, 2011</b>, on effective ways of promoting</li> </ul>

independent, confirming genetic diagnostic test activity where gene patents and exclusive licensing for primary genetic diagnostic tests exist.

**ESTABLISHING METHODS FOR STUDYING THE DIVERSITY OF APPLICANTS**

*Sec. 29, 125 Stat. at 339*

- Requires the USPTO Director to establish methods for studying the diversity of patent applicants, including minorities, women, or veterans and must report to Congress **not later than 6 months after September 16, 2011.**

**STUDY ON INTERNATIONAL PATENT PROTECTIONS FOR SMALL BUSINESSES**

*Sec. 31, 125 Stat. at 339*

- Requires the USPTO Director, in consultation with the Commerce Secretary and Small Business Administration, to study and report on how to help small business with international patent protection, including a revolving fund loan or grant program to defray costs.
- The USPTO must report to Congress **within 120 days from September 16, 2011, which is January 14, 2012.**

**STUDY OF PATENT LITIGATION**

*Sec. 34, 125 Stat. at 340*

- Requires the Government Accountability Office to conduct a study of the impact of patent infringement litigation by non-practicing entities or patent assertion entities.
- The study must be completed by **September 16, 2012.**



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