

States operations on that continent. Under his command the first oceanographic study was conducted far into the ice-covered Weddell Sea. Furthermore, Palmer Station, which was successfully completed and opened by Rear Admiral Abbot on schedule in 1968, was the first permanent United States presence in the Antarctica Peninsula. The Abbot Ice Shelf in Antarctica was named in his honor.

His exemplary service, spanning nearly four decades, garnered him many medals commendations. In addition to the Legion of Merit with Gold Star, the Air Medal and the Navy Commendation Medal, Rear Admiral Abbot was awarded the American Defense Service Medal; American Campaign Medal; Asiatic-Pacific Campaign Medal; World War II Victory Medal; Navy Occupation Service Medal, Europe Clasp; the National Defense Service Medal with bronze star; and the Antarctica Service Medal.

After his retirement from the Navy in 1974, he returned to an active life in Mobile where he was a member of the USS Alabama Battleship Commission and Foundation and served on the Mobile Area Chamber of Commerce. In 2011, Rear Admiral Abbot was named Patriot of the Year by the Mobile Bay Area Veterans Day Commission. He was also the first inductee into the Murphy High School Hall of Fame.

On behalf of the people of Alabama, I wish to extend condolences to his sons, Retired U.S. Navy Captain J. Lloyd Abbot III, and retired U.S. Navy Admiral Steve Abbot, his five grandchildren, extended family and many friends. We will be forever indebted to his exemplary devotion to and service of our nation.

## CORRECTING AND IMPROVING THE LEAHY-SMITH AMERICA INVENTS ACT

SPEECH OF

**HON. LAMAR SMITH**

OF TEXAS

IN THE HOUSE OF REPRESENTATIVES

*Sunday, December 30, 2012*

Mr. SMITH of Texas. Mr. Speaker, I submit the following.

### SECTION-BY-SECTION SUMMARY

(a) Advice of Counsel. The AIA's section 17 created a new §298 of title 35 that bars the use of evidence of an accused infringer's failure to obtain advice of counsel, or his failure to waive privilege and introduce such opinion, to prove either willfulness or intent to induce infringement. Section 17, however, neglected to specify when this new authority became effective. As a result, §298 is subject to the default effective date at section 35 of the AIA, and applies only to patents issued one year or later after enactment of the AIA. This subsection makes §298 applicable to all civil actions commenced after the enactment of this Act.

(b) Transitional Program for CBMs. This subsection corrects two scrivener's errors in section 18 of the AIA. These changes have no substantive effect.

(c) Joinder of Parties. This subsection corrects a scrivener's error in the new §299 of title 35. This change has no substantive effect.

(d) Dead Zones. This subsection fixes two provisions that inadvertently make it impossible to seek either post-grant or inter partes review of a patent during certain time periods. Section 311(c) of title 35 bars anyone

from seeking inter partes review of a patent during the first nine months after the patent issues, or until a post-grant review of a patent is completed if such review is instituted. Section 311(c) was intended to preclude challengers from using IPR during the period when they can instead use PGR. The problem with the provision is that, during Senate floor consideration of the AIA in March 2011, another provision was added to the bill via the managers' amendment that allows only first-to-file patents to be challenged in PGR. This provision, at section 6(f)(2)(A) of the AIA, was intended to allow USPTO a longer period to prepare to conduct PGR proceedings, and to exclude patents that raise discovery-intensive invention-date and loss-of-right-to-patent issues from PGR. However, §311(c) takes effect and applies to all petitions for IPR that are filed on or after September 16, 2012. Yet for several years thereafter, almost all patents that are issued will still be first-to-invent patents. And under §311(c) of title 35, these patents cannot be challenged in IPR during the first 9 months after their issuance, while under section 6(f)(2) of the AIA, these patents cannot be challenged in PGR. Paragraph (1) eliminates this nine month "dead zone" by making §311(c) inapplicable to patents that are first-to-invent patents and are thus ineligible for PGR.

Paragraph (2) addresses another dead zone that is unique to reissue patents. Under §311(c) of title 35, IPR cannot be sought during the nine months after a patent is reissued. This limit was imposed in order to force challengers to bring a PGR challenge (rather than IPR) against what is, in effect, a new patent. However, §325(f) of title 35 then bars a challenge to any claim in a reissue patent that is "identical" to or "narrower" than the claims in the original patent. As a result, such "identical" or "narrower" claims could not be reviewed in either a PGR or an IPR during the nine months after a reissue. Paragraph (2) eliminates this dead zone by repealing section 311(c)(1)'s limit on filing a petition for inter partes review after a patent has been reissued.

(e) Correct Inventor. This subsection amends the authorization of settlement in derivation proceedings to refer to "correct inventor" in the singular, out of recognition of the fact that it is the entire inventive entity that must be named in the settlement agreement. This change has no substantive effect.

(f) Required Oath. Paragraph (1) liberalizes the time allowed for an applicant to file the required oath or alternative statement, allowing him to file as late as payment of the issue fee (rather than requiring filing prior to allowance). Paragraph (2) corrects §115(g)(1) by using "that claims" rather than "who claims," since the antecedent for these words is "application" rather than "inventor." Paragraph (2)'s change has no substantive effect. (USPTO requests.)

(g) Travel Expenses and Payment of Administrative Judges. Section 21 of the AIA, which makes minor changes to the law regarding the compensation of USPTO employees for travel and the payment of APJs, was not given its own effective date. This subsection makes these provisions effective upon enactment of the AIA.

(h) Patent Term Adjustments. This subsection clarifies and improves certain requirements for seeking patent-term adjustments. These changes allow USPTO to provide notice of its PTA determination at the same time as the grant of a patent, and effectively require an applicant who wishes to pursue a civil action under paragraph (4)(A) of §154(b) to exhaust remedies provided under paragraph 3(B)(ii). These changes are minor,

and only apply prospectively to PTAs that are determined and to §154(b)(4)(A) actions that are commenced after the enactment of this Act. (USPTO request.)

The Committee is aware that the district court for the Eastern District of Virginia, on November 1 of this year, issued a decision in the case of *Exelixis v. Kappos* that appears to have adopted a highly problematic interpretation of the patent term adjustment allowed by §154(b)(1)(B). For reasons that remain unclear, the court concluded that continuations and other events described in the "not including" clauses of that subparagraph should not be excluded from the subparagraph's calculation of patent term adjustment, but instead must be read only to toll the three-year clock that determines when patent term adjustment begins to accrue under subparagraph (B). The district court's interpretation of subparagraph (B) thus would allow patent term adjustment to accrue for any continued examination sought after the three-year clock has run. Such a result, of course, would allow applicants to postpone their patent's expiration date through dilatory prosecution, the very submarine-patenting tactic that Congress sought to preclude in 1994 when it adopted a 20-year patent term that runs from an application's effective filing date.

Despite the absurd and undesirable results that would appear to flow from the district court's interpretation, the Committee declines to address this matter at this time. This case was brought to the Committee's attention only very recently, precluding the thorough consideration and consultation that is appropriate before legislation is enacted. Moreover, Congress is not in the business of immediately amending the United States Code in response to every nonfinal legal error made by a trial court. The Committee, of course, reserves the right to address this matter in the future. In the meantime, the fact that the present bill does not amend §154(b) to address the *Exelixis* decision should not be construed as congressional acquiescence in or agreement with the reasoning of that decision.

(i) Improper Applicant. This subsection repeals an unnecessary limitation on who may file an international application designating the United States. (USPTO request.)

(j) Financial Management Clarifications. This subsection makes several technical changes to §42 of title 35, concerning USPTO funding. These changes: (1) ensure that the rule requiring that patent fees be spent for patent purposes also applies to RCE fees; and (2) ensure that all USPTO administrative costs will be covered by either patent fees or trademark fees. (USPTO request.)

(k) Derivation Proceedings. Currently, the third sentence of §135(a) will allow a derivation proceeding to be sought only within the year after the victim's claim that has been the target of derivation has published. It is possible, however, that a deriver could file first, but delay claiming the derived material until more than a year has elapsed after the victim's claims have published, in other words, until after the current deadline has lapsed. The changes made by this subsection preclude such a scenario by requiring the proceeding to be sought during the year after the publication of the deriver's claim to the invention. These changes also add a definition of "earlier application" to §135(a), correct inconsistencies in the AIA's version of §135(a), and authorize the PTAB to conduct, and the courts to hear appeals of, interferences commenced after the effective date of the AIA's amendments to §135(a). (USPTO request.)

(l) Terms of Public Advisory Committee Members. This subsection makes the terms of PPAC and TPAC members run for 3 years

from a fixed date (rather than from the date that they are appointed), and requires Chairmen and Vice Chairmen to be designated from among existing members. (Current law designates only a Chairman and gives him a 3-year term.) These changes will produce better coordination of members' terms, will allow experienced Chairmen to be appointed without requiring such individuals to serve two 3-year terms, and will provide for automatic replacement of a Chairman who does not complete his term of service. (AIPLA request.)

(m) Report on pre-GATT Applications. The URAA amendments took effect on June 8, 1995 but were made inapplicable to applications filed before that effective date. Unfortunately, a small number of applicants may have engaged in clearly dilatory behavior and continue to maintain pending applications with effective-filing dates that precede the URAA effective date.

It is highly unlikely that the 103d Congress ever conceived that its amendments to §154(a) would remain inapplicable to applications still pending in this Congress. The issuance of any such patent at this late date would be grossly prejudicial to the public. Many of these applications claim invention dates in the 1980s, and some even claim priority dates in the 1970s. To remove such technology from the public domain in 2012 would work a clear injustice on the public, and would bear no relation to the patent system's purpose of promoting the progress of science and the useful arts.

An earlier version of this Act included a provision that would have required these applicants to complete prosecution of these applications promptly after the enactment of the Act. To avoid controversy that might delay the enactment of this Act, the present Act substitutes the earlier proposal with a requirement that USPTO issue a report that will provide Congress and the public with relevant information about these applications. The Committee expects that the report will contribute to an understanding of whether these applications present special circumstances that require further legislative, executive, or judicial action in order to ensure transparency and protect the public's interests.

(n) Micro Entity Definition. This subsection corrects a scrivener's error in the AIA's definition of the "micro entities" that are entitled to a fee reduction. This change has no substantive effect.

(o) Default Effective Date. This subsection provides that the amendments made by this Act apply to proceedings commenced on or after the enactment of the Act, except where the provisions of the Act include their own effective date or modify an existing law's effective date.

#### OTHER ISSUES FOR FUTURE CONSIDERATION

Post-Grant Review Could-Have-Raised Estoppel. The version of post-grant review that was enacted by the Leahy-Smith America Invents Act bars a petitioner who completes such a review from challenging any of the claims of the patent that were reviewed in the proceeding on any ground that the petitioner "could have raised" in the post-grant review. Although this broad estoppel first appeared in the bill that was reported by the House Judiciary Committee in June 2011, no amendment adopted by the committee authorized such a change. The change appears to have been made by staff charged with making technical corrections to the bill, who apparently assumed that the omission of could-have-raised estoppel in §325(e)(2) was an oversight.

The application of a civil-litigation could-have-raised estoppel to PGR would cripple that proceeding if it is not corrected. All va-

lidity issues can be raised in PGR, and must be raised during the first nine months of the patent's life and without the benefit of discovery. Thus if could-have-raised estoppel were applied to PGR, a PGR challenger would effectively have to waive the possibility of raising any validity defense against the patent if he is later sued for infringement—and all without an opportunity to adequately investigate enablement and other discovery-intensive issues. In order to ensure that the post-grant review system that USPTO has recently implemented does not simply become a white elephant, it is important that this scrivener's error be corrected in the future. And, lest anyone suggest that the correction of this error is properly regarded as controversial, allow me to note that this correction would simply conform the PGR estoppel provisions to those of the bill that passed the Senate on March 8, 2011, by a vote of 95-5.

### DEPARTMENT OF STATE REWARDS PROGRAM UPDATE AND TECHNICAL CORRECTIONS ACT OF 2012

SPEECH OF

#### HON. CHRIS VAN HOLLEN

OF MARYLAND

IN THE HOUSE OF REPRESENTATIVES

*Sunday, December 30, 2012*

Mr. VAN HOLLEN. Mr. Speaker, I rise as a cosponsor of the State Department Rewards Program Update Act to thank my House colleagues Representatives BERMAN and ROSLEHTINEN for their collaboration on the bill and also to thank Senator KERRY for introducing and managing the Senate companion.

This measure expands on the authority of the State Department to issue rewards for information that leads to the arrest and conviction of people accused of the commission of armed terrorist attacks, drug trafficking, cybercrimes, animal poaching and transnational organized crimes. I added my name as a cosponsor to the bill because I hoped it would contribute to existing international efforts to capture Joseph Kony, the guerrilla leader of the Lord's Resistance Army who has abducted, tortured, abused and forced thousands of children into a life of brutal violence and sexual slavery. Though one of Kony's top lieutenants has been captured, Kony remains on the run.

With the passage of this measure, more resources will be made available to help bring him to justice. I encourage my colleagues to join me in support of the bill.

#### IN TRIBUTE TO MY STAFF

#### HON. ELTON GALLEGLY

OF CALIFORNIA

IN THE HOUSE OF REPRESENTATIVES

*Monday, December 31, 2012*

Mr. GALLEGLY. Mr. Speaker, I rise in tribute to the men and women who work day after day, and often on nights and weekends, that I may best serve the people of California's 24th Congressional District.

During my 26 years in Congress, I have hired the best self-starters I could find who have a proven track record of caring for the people for whom they serve. As a result, I

have one of the smallest staffs of any Member of Congress. As proof of their dedication and professionalism, I also have one of the lowest turnover rates of any Member of Congress.

My district director, Paula Sheil, started with me in 1972 in the private sector and has run my district office since I was first elected to Congress. In addition to running the day-to-day operations of my district office, Paula brings me back to earth and redirects my energies when I get off-kilter.

As my district chief of staff for 20 years, Brian Miller served as my surrogate in the district when I was in Washington, DC. He knows everyone, everyone knows him, and he has been instrumental in my knowledge of the needs and concerns of the county, cities, districts, organizations and individuals throughout the district.

Tina Cobb has been handling my casework for 20 years. If a constituent has a problem and Tina can not solve it, it cannot be solved. She knows the ins and outs of our Federal agencies and can cut through red tape like no one else.

Myrna Vafee joined my district staff 6 years ago. In addition to doing case work, Myrna does all the chores necessary to keep an office running, from sorting mail to greeting constituents. Her smile immediately puts people at ease.

Thomas Widroe has been my deputy district director for 2 years, working from my Solvang office and acting as my eyes and ears in the North County.

Joel Kassiday has been my chief of staff in Washington, DC, for 11 years. Joel is the epitome of efficiency. I have learned to be very careful before I ask Joel to undertake a task because he has it done before you have a chance to change your mind.

Marianne Brant, my executive assistant, has been with me for 6 years. Marianne's primary responsibility is to maintain my schedule and to make sure I am where I am supposed to be. There probably is no tougher job in a congressional office and Marianne does it with poise, efficiency, and an ever-present smile.

Richard Mereu, my chief counsel and administrative assistant, has been a trusted advisor for 18 years. He has served as my staff director on the subcommittees I've chaired on both the Foreign Affairs and Judiciary committees, in addition to advising me on a wide range of legislative issues.

Tom Pfeifer joined my staff 14 years ago after 15 years as a journalist in my district. Tom's knowledge of the media, the people, the issues, and the politics of the district has made him a valuable resource in my D.C. office.

Cecilia Daly has been my legislative counsel for 6 years. Cecilia is a master researcher who takes great pleasure in tutoring our interns on that skill.

Kenneth Steinhardt first came to my office as an intern and came to work for me full time 7 years ago. Kenny is a bulldog on legislation. He builds coalitions on and off the Hill to move a bill and does not let up.

RJ Hauman is my newest staff member. As staff assistant, he is often the first person a constituent interacts with in my D.C. office.

Mr. Speaker, this is just my current staff. I have had many other great staffers over the years, but to try to name them all would take too long. Suffice it to say that I am grateful for their service as well. These are the best of the