

111TH CONGRESS
1ST SESSION

S. 515

To amend title 35, United States Code, to provide for patent reform.

IN THE SENATE OF THE UNITED STATES

MARCH 3, 2009

Mr. LEAHY (for himself, Mr. HATCH, Mr. SCHUMER, Mr. CRAPO, Mr. WHITEHOUSE, Mr. RISCH, and Mrs. GILLIBRAND) introduced the following bill; which was read twice and referred to the Committee on the Judiciary

A BILL

To amend title 35, United States Code, to provide for patent reform.

1 *Be it enacted by the Senate and House of Representa-*
2 *tives of the United States of America in Congress assembled,*

3 **SECTION 1. SHORT TITLE; TABLE OF CONTENTS.**

4 (a) **SHORT TITLE.**—This Act may be cited as the
5 “Patent Reform Act of 2009”.

6 (b) **TABLE OF CONTENTS.**—The table of contents for
7 this Act is as follows:

- Sec. 1. Short title; table of contents.
- Sec. 2. Right of the first inventor to file.
- Sec. 3. Inventor’s oath or declaration.
- Sec. 4. Right of the inventor to obtain damages.
- Sec. 5. Post-grant procedures and other quality enhancements.
- Sec. 6. Definitions; patent trial and appeal board.

- Sec. 7. Preissuance submissions by third parties.
 Sec. 8. Venue and jurisdiction.
 Sec. 9. Patent and Trademark Office regulatory authority.
 Sec. 10. Residency of Federal Circuit judges.
 Sec. 11. Micro-entity defined.
 Sec. 12. Technical amendments.
 Sec. 13. Effective date; rule of construction.
 Sec. 14. Severability.

1 SEC. 2. RIGHT OF THE FIRST INVENTOR TO FILE.

2 (a) DEFINITIONS.—Section 100 of title 35, United
 3 States Code, is amended by adding at the end the fol-
 4 lowing:

5 “(f) The term ‘inventor’ means the individual or, if
 6 a joint invention, the individuals collectively who invented
 7 or discovered the subject matter of the invention.

8 “(g) The terms ‘joint inventor’ and ‘coinventor’ mean
 9 any 1 of the individuals who invented or discovered the
 10 subject matter of a joint invention.

11 “(h) The ‘effective filing date of a claimed invention’
 12 is—

13 “(1) the filing date of the patent or the applica-
 14 tion for the patent containing the claim to the inven-
 15 tion; or

16 “(2) if the patent or application for patent is
 17 entitled to a right of priority of any other applica-
 18 tion under section 119, 365(a), or 365(b) or to the
 19 benefit of an earlier filing date in the United States
 20 under section 120, 121, or 365(c), the filing date of
 21 the earliest such application in which the claimed in-

1 vention is disclosed in the manner provided by the
2 first paragraph of section 112.

3 “(i) The term ‘claimed invention’ means the subject
4 matter defined by a claim in a patent or an application
5 for a patent.

6 “(j) The term ‘joint invention’ means an invention
7 resulting from the collaboration of inventive endeavors of
8 2 or more persons working toward the same end and pro-
9 ducing an invention by their collective efforts.”.

10 (b) CONDITIONS FOR PATENTABILITY.—

11 (1) IN GENERAL.—Section 102 of title 35,
12 United States Code, is amended to read as follows:

13 **“§ 102. Conditions for patentability; novelty**

14 “(a) NOVELTY; PRIOR ART.—A patent for a claimed
15 invention may not be obtained if—

16 “(1) the claimed invention was patented, de-
17 scribed in a printed publication, or in public use, on
18 sale, or otherwise available to the public—

19 “(A) more than 1 year before the effective
20 filing date of the claimed invention; or

21 “(B) 1 year or less before the effective fil-
22 ing date of the claimed invention, other than
23 through disclosures made by the inventor or a
24 joint inventor or by others who obtained the

1 subject matter disclosed directly or indirectly
2 from the inventor or a joint inventor; or

3 “(2) the claimed invention was described in a
4 patent issued under section 151, or in an application
5 for patent published or deemed published under sec-
6 tion 122(b), in which the patent or application, as
7 the case may be, names another inventor and was
8 effectively filed before the effective filing date of the
9 claimed invention.

10 “(b) EXCEPTIONS.—

11 “(1) PRIOR INVENTOR DISCLOSURE EXCEP-
12 TION.—Subject matter that would otherwise qualify
13 as prior art based upon a disclosure under subpara-
14 graph (B) of subsection (a)(1) shall not be prior art
15 to a claimed invention under that subparagraph if
16 the subject matter had, before such disclosure, been
17 publicly disclosed by the inventor or a joint inventor
18 or others who obtained the subject matter disclosed
19 directly or indirectly from the inventor or a joint in-
20 ventor.

21 “(2) DERIVATION, PRIOR DISCLOSURE, AND
22 COMMON ASSIGNMENT EXCEPTIONS.—Subject mat-
23 ter that would otherwise qualify as prior art only
24 under subsection (a)(2), after taking into account

1 the exception under paragraph (1), shall not be prior
2 art to a claimed invention if—

3 “(A) the subject matter was obtained di-
4 rectly or indirectly from the inventor or a joint
5 inventor;

6 “(B) the subject matter had been publicly
7 disclosed by the inventor or a joint inventor or
8 others who obtained the subject matter dis-
9 closed, directly or indirectly, from the inventor
10 or a joint inventor before the effective filing
11 date of the application or patent set forth under
12 subsection (a)(2); or

13 “(C) the subject matter and the claimed
14 invention, not later than the effective filing date
15 of the claimed invention, were owned by the
16 same person or subject to an obligation of as-
17 signment to the same person.

18 “(3) JOINT RESEARCH AGREEMENT EXCEP-
19 TION.—

20 “(A) IN GENERAL.—Subject matter and a
21 claimed invention shall be deemed to have been
22 owned by the same person or subject to an obli-
23 gation of assignment to the same person in ap-
24 plying the provisions of paragraph (2) if—

1 “(i) the claimed invention was made
2 by or on behalf of parties to a joint re-
3 search agreement that was in effect on or
4 before the effective filing date of the
5 claimed invention;

6 “(ii) the claimed invention was made
7 as a result of activities undertaken within
8 the scope of the joint research agreement;
9 and

10 “(iii) the application for patent for
11 the claimed invention discloses or is
12 amended to disclose the names of the par-
13 ties to the joint research agreement.

14 “(B) For purposes of subparagraph (A),
15 the term ‘joint research agreement’ means a
16 written contract, grant, or cooperative agree-
17 ment entered into by 2 or more persons or enti-
18 ties for the performance of experimental, devel-
19 opmental, or research work in the field of the
20 claimed invention.

21 “(4) PATENTS AND PUBLISHED APPLICATIONS
22 EFFECTIVELY FILED.—A patent or application for
23 patent is effectively filed under subsection (a)(2)
24 with respect to any subject matter described in the
25 patent or application—

1 tion to a person having ordinary skill in the art to which
2 the claimed invention pertains. Patentability shall not be
3 negated by the manner in which the invention was made.”.

4 (d) REPEAL OF REQUIREMENTS FOR INVENTIONS
5 MADE ABROAD.—Section 104 of title 35, United States
6 Code, and the item relating to that section in the table
7 of sections for chapter 10 of title 35, United States Code,
8 are repealed.

9 (e) REPEAL OF STATUTORY INVENTION REGISTRA-
10 TION.—

11 (1) IN GENERAL.—Section 157 of title 35,
12 United States Code, and the item relating to that
13 section in the table of sections for chapter 14 of title
14 35, United States Code, are repealed.

15 (2) REMOVAL OF CROSS REFERENCES.—Section
16 111(b)(8) of title 35, United States Code, is amend-
17 ed by striking “sections 115, 131, 135, and 157”
18 and inserting “sections 131 and 135”.

19 (f) EARLIER FILING DATE FOR INVENTOR AND
20 JOINT INVENTOR.—Section 120 of title 35, United States
21 Code, is amended by striking “which is filed by an inven-
22 tor or inventors named” and inserting “which names an
23 inventor or joint inventor”.

24 (g) CONFORMING AMENDMENTS.—

1 (1) RIGHT OF PRIORITY.—Section 172 of title
2 35, United States Code, is amended by striking
3 “and the time specified in section 102(d)”.

4 (2) LIMITATION ON REMEDIES.—Section
5 287(c)(4) of title 35, United States Code, is amend-
6 ed by striking “the earliest effective filing date of
7 which is prior to” and inserting “which has an effec-
8 tive filing date before”.

9 (3) INTERNATIONAL APPLICATION DESIG-
10 NATING THE UNITED STATES: EFFECT.—Section
11 363 of title 35, United States Code, is amended by
12 striking “except as otherwise provided in section
13 102(e) of this title”.

14 (4) PUBLICATION OF INTERNATIONAL APPLICA-
15 TION: EFFECT.—Section 374 of title 35, United
16 States Code, is amended by striking “sections 102(e)
17 and 154(d)” and inserting “section 154(d)”.

18 (5) PATENT ISSUED ON INTERNATIONAL APPLI-
19 CATION: EFFECT.—The second sentence of section
20 375(a) of title 35, United States Code, is amended
21 by striking “Subject to section 102(e) of this title,
22 such” and inserting “Such”.

23 (6) LIMIT ON RIGHT OF PRIORITY.—Section
24 119(a) of title 35, United States Code, is amended
25 by striking “; but no patent shall be granted” and

1 all that follows through “one year prior to such fil-
2 ing”.

3 (7) INVENTIONS MADE WITH FEDERAL ASSIST-
4 ANCE.—Section 202(c) of title 35, United States
5 Code, is amended—

6 (A) in paragraph (2)—

7 (i) by striking “publication, on sale,
8 or public use,” and all that follows through
9 “obtained in the United States” and in-
10 sserting “the 1-year period referred to in
11 section 102(a) would end before the end of
12 that 2-year period”; and

13 (ii) by striking “the statutory” and
14 inserting “that 1-year”; and

15 (B) in paragraph (3), by striking “any
16 statutory bar date that may occur under this
17 title due to publication, on sale, or public use”
18 and inserting “the expiration of the 1-year pe-
19 riod referred to in section 102(a)”.

20 (h) REPEAL OF INTERFERING PATENT REMEDIES.—
21 Section 291 of title 35, United States Code, and the item
22 relating to that section in the table of sections for chapter
23 29 of title 35, United States Code, are repealed.

1 (i) ACTION FOR CLAIM TO PATENT ON DERIVED IN-
2 VENTION.—Section 135 of title 35, United States Code,
3 is amended to read as follows:

4 “(a) DISPUTE OVER RIGHT TO PATENT.—

5 “(1) INSTITUTION OF DERIVATION PRO-
6 CEEDING.—An applicant may request initiation of a
7 derivation proceeding to determine the right of the
8 applicant to a patent by filing a request which sets
9 forth with particularity the basis for finding that an
10 earlier applicant derived the claimed invention from
11 the applicant requesting the proceeding and, without
12 authorization, filed an application claiming such in-
13 vention. Any such request may only be made within
14 12 months after the date of first publication of an
15 application containing a claim that is the same or is
16 substantially the same as the claimed invention,
17 must be made under oath, and must be supported
18 by substantial evidence. Whenever the Director de-
19 termines that patents or applications for patent
20 naming different individuals as the inventor interfere
21 with one another because of a dispute over the right
22 to patent under section 101, the Director shall insti-
23 tute a derivation proceeding for the purpose of de-
24 termining which applicant is entitled to a patent.

1 “(2) DETERMINATION BY PATENT TRIAL AND
2 APPEAL BOARD.—In any proceeding under this sub-
3 section, the Patent Trial and Appeal Board—

4 “(A) shall determine the question of the
5 right to patent;

6 “(B) in appropriate circumstances, may
7 correct the naming of the inventor in any appli-
8 cation or patent at issue; and

9 “(C) shall issue a final decision on the
10 right to patent.

11 “(3) DERIVATION PROCEEDING.—The Board
12 may defer action on a request to initiate a derivation
13 proceeding until 3 months after the date on which
14 the Director issues a patent to the applicant that
15 filed the earlier application.

16 “(4) EFFECT OF FINAL DECISION.—The final
17 decision of the Patent Trial and Appeal Board, if
18 adverse to the claim of an applicant, shall constitute
19 the final refusal by the United States Patent and
20 Trademark Office on the claims involved. The Direc-
21 tor may issue a patent to an applicant who is deter-
22 mined by the Patent Trial and Appeal Board to have
23 the right to patent. The final decision of the Board,
24 if adverse to a patentee, shall, if no appeal or other
25 review of the decision has been or can be taken or

1 had, constitute cancellation of the claims involved in
2 the patent, and notice of such cancellation shall be
3 endorsed on copies of the patent distributed after
4 such cancellation by the United States Patent and
5 Trademark Office.

6 “(b) SETTLEMENT.—Parties to a derivation pro-
7 ceeding may terminate the proceeding by filing a written
8 statement reflecting the agreement of the parties as to the
9 correct inventors of the claimed invention in dispute. Un-
10 less the Patent Trial and Appeal Board finds the agree-
11 ment to be inconsistent with the evidence of record, it shall
12 take action consistent with the agreement. Any written
13 settlement or understanding of the parties shall be filed
14 with the Director. At the request of a party to the pro-
15 ceeding, the agreement or understanding shall be treated
16 as business confidential information, shall be kept sepa-
17 rate from the file of the involved patents or applications,
18 and shall be made available only to Government agencies
19 on written request, or to any person on a showing of good
20 cause.

21 “(c) ARBITRATION.—Parties to a derivation pro-
22 ceeding, within such time as may be specified by the Di-
23 rector by regulation, may determine such contest or any
24 aspect thereof by arbitration. Such arbitration shall be
25 governed by the provisions of title 9 to the extent such

1 title is not inconsistent with this section. The parties shall
2 give notice of any arbitration award to the Director, and
3 such award shall, as between the parties to the arbitration,
4 be dispositive of the issues to which it relates. The arbitra-
5 tion award shall be unenforceable until such notice is
6 given. Nothing in this subsection shall preclude the Direc-
7 tor from determining patentability of the invention in-
8 volved in the derivation proceeding.”.

9 (j) ELIMINATION OF REFERENCES TO INTER-
10 FERENCES.—(1) Sections 6, 41, 134, 141, 145, 146, 154,
11 305, and 314 of title 35, United States Code, are each
12 amended by striking “Board of Patent Appeals and Inter-
13 ferences” each place it appears and inserting “Patent
14 Trial and Appeal Board”.

15 (2) Sections 141, 146, and 154 of title 35, United
16 States Code, are each amended—

17 (A) by striking “an interference” each place it
18 appears and inserting “a derivation proceeding”;
19 and

20 (B) by striking “interference” each additional
21 place it appears and inserting “derivation pro-
22 ceeding”.

23 (3) The section heading for section 134 of title 35,
24 United States Code, is amended to read as follows:

1 **“§ 134. Appeal to the Patent Trial and Appeal Board”.**

2 (4) The section heading for section 135 of title 35,
3 United States Code, is amended to read as follows:

4 **“§ 135. Derivation proceedings”.**

5 (5) The section heading for section 146 of title 35,
6 United States Code, is amended to read as follows:

7 **“§ 146. Civil action in case of derivation proceeding”.**

8 (6) Section 154(b)(1)(C) of title 35, United States
9 Code, is amended by striking “INTERFERENCES” and in-
10 serting “DERIVATION PROCEEDINGS”.

11 (7) The item relating to section 6 in the table of sec-
12 tions for chapter 1 of title 35, United States Code, is
13 amended to read as follows:

“6. Patent Trial and Appeal Board.”.

14 (8) The items relating to sections 134 and 135 in
15 the table of sections for chapter 12 of title 35, United
16 States Code, are amended to read as follows:

“134. Appeal to the Patent Trial and Appeal Board.

“135. Derivation proceedings.”.

17 (9) The item relating to section 146 in the table of
18 sections for chapter 13 of title 35, United States Code,
19 is amended to read as follows:

“146. Civil action in case of derivation proceeding.”.

20 (10) CERTAIN APPEALS.—Section 1295(a)(4)(A) of
21 title 28, United States Code, is amended to read as fol-
22 lows:

1 “(A) the Patent Trial and Appeal Board of
2 the United States Patent and Trademark Office
3 with respect to patent applications, interference
4 proceedings (commenced before the date of en-
5 actment of the Patent Reform Act of 2009),
6 derivation proceedings, and post-grant review
7 proceedings, at the instance of an applicant for
8 a patent or any party to a patent interference
9 (commenced before the effective date of the
10 Patent Reform Act of 2009), derivation pro-
11 ceeding, or post-grant review proceeding, and
12 any such appeal shall waive any right of such
13 applicant or party to proceed under section 145
14 or 146 of title 35;”.

15 (k) SEARCH AND EXAMINATION FUNCTIONS.—Sec-
16 tion 131 of title 35, United States Code, is amended by—

17 (1) by striking “The Director shall cause” and
18 inserting “(a) IN GENERAL.—The Director shall
19 cause”; and

20 (2) by adding at the end the following:

21 “(b) SEARCH AND EXAMINATION FUNCTIONS.—To
22 the extent consistent with United States obligations under
23 international agreements, examination and search duties
24 for the grant of a United States patent are sovereign func-
25 tions which shall be performed within the United States

1 by United States citizens who are employees of the United
2 States Government.”.

3 **SEC. 3. INVENTOR’S OATH OR DECLARATION.**

4 (a) INVENTOR’S OATH OR DECLARATION.—

5 (1) IN GENERAL.—Section 115 of title 35,
6 United States Code, is amended to read as follows:

7 **“§ 115. Inventor’s oath or declaration**

8 “(a) NAMING THE INVENTOR; INVENTOR’S OATH OR
9 DECLARATION.—An application for patent that is filed
10 under section 111(a), that commences the national stage
11 under section 363, or that is filed by an inventor for an
12 invention for which an application has previously been
13 filed under this title by that inventor shall include, or be
14 amended to include, the name of the inventor of any
15 claimed invention in the application. Except as otherwise
16 provided in this section, an individual who is the inventor
17 or a joint inventor of a claimed invention in an application
18 for patent shall execute an oath or declaration in connec-
19 tion with the application.

20 “(b) REQUIRED STATEMENTS.—An oath or declara-
21 tion under subsection (a) shall contain statements that—

22 “(1) the application was made or was author-
23 ized to be made by the affiant or declarant; and

1 “(2) such individual believes himself or herself
2 to be the original inventor or an original joint inven-
3 tor of a claimed invention in the application.

4 “(c) ADDITIONAL REQUIREMENTS.—The Director
5 may specify additional information relating to the inventor
6 and the invention that is required to be included in an
7 oath or declaration under subsection (a).

8 “(d) SUBSTITUTE STATEMENT.—

9 “(1) IN GENERAL.—In lieu of executing an oath
10 or declaration under subsection (a), the applicant for
11 patent may provide a substitute statement under the
12 circumstances described in paragraph (2) and such
13 additional circumstances that the Director may
14 specify by regulation.

15 “(2) PERMITTED CIRCUMSTANCES.—A sub-
16 stitute statement under paragraph (1) is permitted
17 with respect to any individual who—

18 “(A) is unable to file the oath or declara-
19 tion under subsection (a) because the indi-
20 vidual—

21 “(i) is deceased;

22 “(ii) is under legal incapacity; or

23 “(iii) cannot be found or reached after
24 diligent effort; or

1 “(B) is under an obligation to assign the
2 invention but has refused to make the oath or
3 declaration required under subsection (a).

4 “(3) CONTENTS.—A substitute statement under
5 this subsection shall—

6 “(A) identify the individual with respect to
7 whom the statement applies;

8 “(B) set forth the circumstances rep-
9 resenting the permitted basis for the filing of
10 the substitute statement in lieu of the oath or
11 declaration under subsection (a); and

12 “(C) contain any additional information,
13 including any showing, required by the Direc-
14 tor.

15 “(e) MAKING REQUIRED STATEMENTS IN ASSIGN-
16 MENT OF RECORD.—An individual who is under an obliga-
17 tion of assignment of an application for patent may in-
18 clude the required statements under subsections (b) and
19 (c) in the assignment executed by the individual, in lieu
20 of filing such statements separately.

21 “(f) TIME FOR FILING.—A notice of allowance under
22 section 151 may be provided to an applicant for patent
23 only if the applicant for patent has filed each required
24 oath or declaration under subsection (a) or has filed a sub-

1 stitute statement under subsection (d) or recorded an as-
2 signment meeting the requirements of subsection (e).

3 “(g) EARLIER-FILED APPLICATION CONTAINING RE-
4 QUIRED STATEMENTS OR SUBSTITUTE STATEMENT.—

5 The requirements under this section shall not apply to an
6 individual with respect to an application for patent in
7 which the individual is named as the inventor or a joint
8 inventor and that claims the benefit under section 120 or
9 365(c) of the filing of an earlier-filed application, if—

10 “(1) an oath or declaration meeting the require-
11 ments of subsection (a) was executed by the indi-
12 vidual and was filed in connection with the earlier-
13 filed application;

14 “(2) a substitute statement meeting the re-
15 quirements of subsection (d) was filed in the earlier
16 filed application with respect to the individual; or

17 “(3) an assignment meeting the requirements
18 of subsection (e) was executed with respect to the
19 earlier-filed application by the individual and was re-
20 corded in connection with the earlier-filed applica-
21 tion.

22 “(h) SUPPLEMENTAL AND CORRECTED STATE-
23 MENTS; FILING ADDITIONAL STATEMENTS.—

24 “(1) IN GENERAL.—Any person making a state-
25 ment required under this section may withdraw, re-

1 place, or otherwise correct the statement at any
2 time. If a change is made in the naming of the in-
3 ventor requiring the filing of 1 or more additional
4 statements under this section, the Director shall es-
5 tablish regulations under which such additional
6 statements may be filed.

7 “(2) SUPPLEMENTAL STATEMENTS NOT RE-
8 QUIRED.—If an individual has executed an oath or
9 declaration under subsection (a) or an assignment
10 meeting the requirements of subsection (e) with re-
11 spect to an application for patent, the Director may
12 not thereafter require that individual to make any
13 additional oath, declaration, or other statement
14 equivalent to those required by this section in con-
15 nection with the application for patent or any patent
16 issuing thereon.

17 “(3) SAVINGS CLAUSE.—No patent shall be in-
18 valid or unenforceable based upon the failure to
19 comply with a requirement under this section if the
20 failure is remedied as provided under paragraph (1).

21 “(i) ACKNOWLEDGMENT OF PENALTIES.—Any dec-
22 laration or statement filed pursuant to this section shall
23 contain an acknowledgment that any willful false state-
24 ment made in such declaration or statement is punishable

1 under section 1001 of title 18 by fine or imprisonment
2 of not more than 5 years, or both.”.

3 (2) RELATIONSHIP TO DIVISIONAL APPLICA-
4 TIONS.—Section 121 of title 35, United States Code,
5 is amended by striking “If a divisional application”
6 and all that follows through “inventor.”.

7 (3) REQUIREMENTS FOR NONPROVISIONAL AP-
8 PPLICATIONS.—Section 111(a) of title 35, United
9 States Code, is amended—

10 (A) in paragraph (2)(C), by striking “by
11 the applicant” and inserting “or declaration”;

12 (B) in the heading for paragraph (3), by
13 striking “AND OATH”; and

14 (C) by striking “and oath” each place it
15 appears.

16 (4) CONFORMING AMENDMENT.—The item re-
17 lating to section 115 in the table of sections for
18 chapter 11 of title 35, United States Code, is
19 amended to read as follows:

“115. Inventor’s oath or declaration.”.

20 (b) FILING BY OTHER THAN INVENTOR.—Section
21 118 of title 35, United States Code, is amended to read
22 as follows:

23 **“§ 118. Filing by other than inventor**

24 “A person to whom the inventor has assigned or is
25 under an obligation to assign the invention may make an

1 application for patent. A person who otherwise shows suf-
2 ficient proprietary interest in the matter may make an ap-
3 plication for patent on behalf of and as agent for the in-
4 ventor on proof of the pertinent facts and a showing that
5 such action is appropriate to preserve the rights of the
6 parties. If the Director grants a patent on an application
7 filed under this section by a person other than the inven-
8 tor, the patent shall be granted to the real party in inter-
9 est and upon such notice to the inventor as the Director
10 considers to be sufficient.”.

11 (c) SPECIFICATION.—Section 112 of title 35, United
12 States Code, is amended—

13 (1) in the first paragraph—

14 (A) by striking “The specification” and in-
15 serting “(a) IN GENERAL.—The specification”;
16 and

17 (B) by striking “of carrying out his inven-
18 tion” and inserting “or joint inventor of car-
19 rying out the invention”;

20 (2) in the second paragraph—

21 (A) by striking “The specifications” and
22 inserting “(b) CONCLUSION.—The specifica-
23 tions”; and

1 (B) by striking “applicant regards as his
2 invention” and inserting “inventor or a joint in-
3 ventor regards as the invention”;

4 (3) in the third paragraph, by striking “A
5 claim” and inserting “(c) FORM.—A claim”;

6 (4) in the fourth paragraph, by striking “Sub-
7 ject to the following paragraph,” and inserting “(d)
8 REFERENCE IN DEPENDENT FORMS.—Subject to
9 subsection (e),”;

10 (5) in the fifth paragraph, by striking “A
11 claim” and inserting “(e) REFERENCE IN MULTIPLE
12 DEPENDENT FORM.—A claim”; and

13 (6) in the last paragraph, by striking “An ele-
14 ment” and inserting “(f) ELEMENT IN CLAIM FOR
15 A COMBINATION.—An element”.

16 **SEC. 4. RIGHT OF THE INVENTOR TO OBTAIN DAMAGES.**

17 (a) DAMAGES.—Section 284 of title 35, United
18 States Code, is amended to read as follows:

19 **“§ 284. Damages**

20 “(a) IN GENERAL.—Upon finding for the claimant
21 the court shall award the claimant damages adequate to
22 compensate for the infringement but in no event less than
23 a reasonable royalty for the use made of the invention by
24 the infringer, together with interest and costs as fixed by
25 the court, subject to the provisions of this section.

1 “(b) DETERMINATION OF DAMAGES; EVIDENCE CON-
2 SIDERED; PROCEDURE.—The court may receive expert
3 testimony as an aid to the determination of damages or
4 of what royalty would be reasonable under the cir-
5 cumstances. The admissibility of such testimony shall be
6 governed by the rules of evidence governing expert testi-
7 mony. When the damages are not found by a jury, the
8 court shall assess them.

9 “(c) STANDARD FOR CALCULATING REASONABLE
10 ROYALTY.—

11 “(1) IN GENERAL.—The court shall determine,
12 based on the facts of the case and after adducing
13 any further evidence the court deems necessary,
14 which of the following methods shall be used by the
15 court or the jury in calculating a reasonable royalty
16 pursuant to subsection (a). The court shall also
17 identify the factors that are relevant to the deter-
18 mination of a reasonable royalty, and the court or
19 jury, as the case may be, shall consider only those
20 factors in making such determination.

21 “(A) ENTIRE MARKET VALUE.—Upon a
22 showing to the satisfaction of the court that the
23 claimed invention’s specific contribution over
24 the prior art is the predominant basis for mar-
25 ket demand for an infringing product or proc-

1 ess, damages may be based upon the entire
2 market value of that infringing product or pro-
3 cess.

4 “(B) ESTABLISHED ROYALTY BASED ON
5 MARKETPLACE LICENSING.—Upon a showing to
6 the satisfaction of the court that the claimed in-
7 vention has been the subject of a nonexclusive
8 license for the use made of the invention by the
9 infringer, to a number of persons sufficient to
10 indicate a general marketplace recognition of
11 the reasonableness of the licensing terms, if the
12 license was secured prior to the filing of the
13 case before the court, and the court determines
14 that the infringer’s use is of substantially the
15 same scope, volume, and benefit of the rights
16 granted under such license, damages may be
17 determined on the basis of the terms of such li-
18 cense. Upon a showing to the satisfaction of the
19 court that the claimed invention has sufficiently
20 similar noninfringing substitutes in the relevant
21 market, which have themselves been the subject
22 of such nonexclusive licenses, and the court de-
23 termines that the infringer’s use is of substan-
24 tially the same scope, volume, and benefit of the
25 rights granted under such licenses, damages

1 may be determined on the basis of the terms of
2 such licenses.

3 “(C) VALUATION CALCULATION.—Upon a
4 determination by the court that the showings
5 required under subparagraphs (A) and (B) have
6 not been made, the court shall conduct an anal-
7 ysis to ensure that a reasonable royalty is ap-
8 plied only to the portion of the economic value
9 of the infringing product or process properly at-
10 tributable to the claimed invention’s specific
11 contribution over the prior art. In the case of
12 a combination invention whose elements are
13 present individually in the prior art, the con-
14 tribution over the prior art may include the
15 value of the additional function resulting from
16 the combination, as well as the enhanced value,
17 if any, of some or all of the prior art elements
18 as part of the combination, if the patentee dem-
19 onstrates that value.

20 “(2) ADDITIONAL FACTORS.—Where the court
21 determines it to be appropriate in determining a rea-
22 sonable royalty under paragraph (1), the court may
23 also consider, or direct the jury to consider, any
24 other relevant factors under applicable law.

1 “(d) INAPPLICABILITY TO OTHER DAMAGES ANAL-
2 YSIS.—The methods for calculating a reasonable royalty
3 described in subsection (c) shall have no application to the
4 calculation of an award of damages that does not neces-
5 sitate the determination of a reasonable royalty as a basis
6 for monetary relief sought by the claimant.

7 “(e) WILLFUL INFRINGEMENT.—

8 “(1) INCREASED DAMAGES.—A court that has
9 determined that an infringer has willfully infringed
10 a patent or patents may increase damages up to 3
11 times the amount of the damages found or assessed
12 under subsection (a), except that increased damages
13 under this paragraph shall not apply to provisional
14 rights under section 154(d).

15 “(2) PERMITTED GROUNDS FOR WILLFUL-
16 NESS.—A court may find that an infringer has will-
17 fully infringed a patent only if the patent owner pre-
18 sents clear and convincing evidence that acting with
19 objective recklessness—

20 “(A) after receiving written notice from
21 the patentee—

22 “(i) alleging acts of infringement in a
23 manner sufficient to give the infringer an
24 objectively reasonable apprehension of suit
25 on such patent, and

1 “(ii) identifying with particularity
2 each claim of the patent, each product or
3 process that the patent owner alleges in-
4 fringes the patent, and the relationship of
5 such product or process to such claim,
6 the infringer, after a reasonable opportunity to
7 investigate, thereafter performed 1 or more of
8 the alleged acts of infringement;

9 “(B) the infringer intentionally copied the
10 patented invention with knowledge that it was
11 patented; or

12 “(C) after having been found by a court to
13 have infringed that patent, the infringer en-
14 gaged in conduct that was not colorably dif-
15 ferent from the conduct previously found to
16 have infringed the patent, and which resulted in
17 a separate finding of infringement of the same
18 patent.

19 “(3) LIMITATIONS ON WILLFULNESS.—

20 “(A) IN GENERAL.—A court may not find
21 that an infringer has willfully infringed a patent
22 under paragraph (2) for any period of time dur-
23 ing which the infringer had an informed good
24 faith belief that the patent was invalid or unen-
25 forceable, or would not be infringed by the con-

1 duct later shown to constitute infringement of
2 the patent.

3 “(B) GOOD FAITH ESTABLISHED.—An in-
4 formed good faith belief within the meaning of
5 subparagraph (A) may be established by—

6 “(i) reasonable reliance on advice of
7 counsel;

8 “(ii) evidence that the infringer
9 sought to modify its conduct to avoid in-
10 fringement once it had discovered the pat-
11 ent; or

12 “(iii) other evidence a court may find
13 sufficient to establish such good faith be-
14 lief.

15 “(C) RELEVANCE OF NOT PRESENTING
16 CERTAIN EVIDENCE.—The decision of the in-
17 fringer not to present evidence of advice of
18 counsel is not relevant to a determination of
19 willful infringement under paragraph (2).

20 “(4) LIMITATION ON PLEADING.—Before the
21 date on which a court determines that the patent in
22 suit is not invalid, is enforceable, and has been in-
23 fringed by the infringer, a patentee may not plead
24 and a court may not determine that an infringer has
25 willfully infringed a patent. The court’s determina-

1 tion of an infringer’s willfulness shall be made with-
2 out a jury.”.

3 (b) REPORT TO CONGRESSIONAL COMMITTEES.—

4 (1) IN GENERAL.—Not later than 2 years after
5 the date of enactment of this Act, the Director shall
6 report to the Committee on the Judiciary of the
7 Senate and the Committee on the Judiciary of the
8 House of Representatives, the findings and rec-
9 ommendations of the Director on the operation of
10 prior user rights in selected countries in the indus-
11 trialized world. The report shall include the fol-
12 lowing:

13 (A) A comparison between patent laws of
14 the United States and the laws of other indus-
15 trialized countries, including the European
16 Union, Japan, Canada, and Australia.

17 (B) An analysis of the effect of prior user
18 rights on innovation rates in the selected coun-
19 tries.

20 (C) An analysis of the correlation, if any,
21 between prior user rights and start-up enter-
22 prises and the ability to attract venture capital
23 to start new companies.

1 (D) An analysis of the effect of prior user
2 rights, if any, on small businesses, universities,
3 and individual inventors.

4 (E) An analysis of legal and constitutional
5 issues, if any, that arise from placing trade se-
6 cret law in patent law.

7 (2) CONSULTATION WITH OTHER AGENCIES.—
8 In preparing the report required under paragraph
9 (1), the Director shall consult with the Secretary of
10 State and the Attorney General.

11 (c) DEFENSE TO INFRINGEMENT BASED ON EAR-
12 LIER INVENTOR.—Section 273(b)(6) of title 35, United
13 States Code, is amended to read as follows:

14 “(6) PERSONAL DEFENSE.—The defense under
15 this section may be asserted only by the person who
16 performed or caused the performance of the acts
17 necessary to establish the defense as well as any
18 other entity that controls, is controlled by, or is
19 under common control with such person and, except
20 for any transfer to the patent owner, the right to as-
21 sert the defense shall not be licensed or assigned or
22 transferred to another person except as an ancillary
23 and subordinate part of a good faith assignment or
24 transfer for other reasons of the entire enterprise or
25 line of business to which the defense relates. Not-

1 owner takes a position on the scope of one or more
2 patent claims.

3 “(b) SUBMISSIONS PART OF OFFICIAL FILE.—If the
4 person citing prior art or written submissions under sub-
5 section (a) explains in writing the pertinence and manner
6 of applying the prior art or written submission to at least
7 one claim of the patent, the citation of the prior art or
8 documentary evidence (as the case may be) and the expla-
9 nation thereof shall become a part of the official file of
10 the patent.

11 “(c) PROCEDURES FOR WRITTEN STATEMENTS.—

12 “(1) SUBMISSION OF ADDITIONAL MATE-
13 RIALS.—A party that submits written statements
14 under subsection (a)(2) in a proceeding shall include
15 any other documents, pleadings, or evidence from
16 the proceeding that address the patent owner’s
17 statements or the claims addressed by the written
18 statements.

19 “(2) LIMITATION ON USE OF STATEMENTS.—

20 Written statements submitted under subsection
21 (a)(2) shall not be considered for any purpose other
22 than to determine the proper meaning of the claims
23 that are the subject of the request in a proceeding
24 ordered pursuant to section 304 or 313. Any such
25 written statements, and any materials submitted

1 under paragraph (1), that are subject to an applica-
2 ble protective order shall be redacted to exclude in-
3 formation subject to the order.

4 “(d) IDENTITY WITHHELD.—Upon the written re-
5 quest of the person making the citation under subsection
6 (a), the person’s identity shall be excluded from the patent
7 file and kept confidential.”.

8 (b) REQUEST FOR REEXAMINATION.—The first sen-
9 tence of section 302 of title 35, United States Code, is
10 amended to read as follows: “Any person at any time may
11 file a request for reexamination by the Office of any claim
12 on a patent on the basis of any prior art or documentary
13 evidence cited under paragraph (1) or (3) of subsection
14 (a) of section 301 of this title.”.

15 (c) REEXAMINATION.—Section 303(a) of title 35,
16 United States Code, is amended to read as follows:

17 “(a) Within three months following the filing of a re-
18 quest for reexamination under section 302, the Director
19 shall determine whether a substantial new question of pat-
20 entability affecting any claim of the patent concerned is
21 raised by the request, with or without consideration of
22 other patents or printed publications. On the Director’s
23 own initiative, and at any time, the Director may deter-
24 mine whether a substantial new question of patentability
25 is raised by patents, publications, or other evidence discov-

1 ered by the Director, is cited under section 301, or is cited
2 by any person other than the owner of the patent under
3 section 302 or section 311. The existence of a substantial
4 new question of patentability is not precluded by the fact
5 that a patent, printed publication, or other evidence was
6 previously considered by the Office.”.

7 (d) REQUEST FOR INTER PARTES REEXAMINA-
8 TION.—Section 311(a) of title 35, United States Code, is
9 amended to read as follows:

10 “(a) IN GENERAL.—Any third-party requester at any
11 time may file a request for inter partes reexamination by
12 the Office of a patent on the basis of any prior art or
13 documentary evidence cited under paragraph (1) or (3)
14 of subsection (a) of section 301 of this title.”.

15 (e) CONDUCT OF INTER PARTES PROCEEDINGS.—
16 Section 314 of title 35, United States Code, is amended—

17 (1) in the first sentence of subsection (a), by
18 striking “conducted according to the procedures es-
19 tablished for initial examination under the provisions
20 of sections 132 and 133” and inserting “heard by
21 an administrative patent judge in accordance with
22 procedures which the Director shall establish”;

23 (2) in subsection (b), by striking paragraph (2)
24 and inserting the following:

1 “(2) The third-party requester shall have the oppor-
2 tunity to file written comments on any action on the mer-
3 its by the Office in the inter partes reexamination pro-
4 ceeding, and on any response that the patent owner files
5 to such an action, if those written comments are received
6 by the Office within 60 days after the date of service on
7 the third-party requester of the Office action or patent
8 owner response, as the case may be.”; and

9 (3) by adding at the end the following:

10 “(d) ORAL HEARING.—At the request of a third-
11 party requestor or the patent owner, the administrative
12 patent judge shall conduct an oral hearing, unless the
13 judge finds cause lacking for such hearing.”.

14 (f) ESTOPPEL.—Section 315(c) of title 35, United
15 States Code, is amended by striking “or could have
16 raised”.

17 (g) REEXAMINATION PROHIBITED AFTER DISTRICT
18 COURT DECISION.—Section 317(b) of title 35, United
19 States Code, is amended—

20 (1) in the subsection heading, by striking
21 “FINAL DECISION” and inserting “DISTRICT COURT
22 DECISION”; and

23 (2) by striking “Once a final decision has been
24 entered” and inserting “Once the judgment of the
25 district court has been entered”.

1 (h) POST-GRANT OPPOSITION PROCEDURES.—

2 (1) IN GENERAL.—Part III of title 35, United
3 States Code, is amended by adding at the end the
4 following new chapter:

5 **“CHAPTER 32—POST-GRANT REVIEW**
6 **PROCEDURES**

“Sec.

“321. Petition for post-grant review.

“322. Timing and bases of petition.

“323. Requirements of petition.

“324. Prohibited filings.

“325. Submission of additional information; showing of sufficient grounds.

“326. Conduct of post-grant review proceedings.

“327. Patent owner response.

“328. Proof and evidentiary standards.

“329. Amendment of the patent.

“330. Decision of the Board.

“331. Effect of decision.

“332. Settlement.

“333. Relationship to other pending proceedings.

“334. Effect of decisions rendered in civil action on post-grant review proceedings.

“335. Effect of final decision on future proceedings.

“336. Appeal.

7 **“§ 321. Petition for post-grant review**

8 “Subject to sections 322, 324, 332, and 333, a per-
9 son who is not the patent owner may file with the Office
10 a petition for cancellation seeking to institute a post-grant
11 review proceeding to cancel as unpatentable any claim of
12 a patent on any ground that could be raised under para-
13 graph (2) or (3) of section 282(b) (relating to invalidity
14 of the patent or any claim). The Director shall establish,
15 by regulation, fees to be paid by the person requesting
16 the proceeding, in such amounts as the Director deter-
17 mines to be reasonable.

1 **“§ 322. Timing and bases of petition**

2 “A post-grant proceeding may be instituted under
3 this chapter pursuant to a cancellation petition filed under
4 section 321 only if—

5 “(1) the petition is filed not later than 12
6 months after the issuance of the patent or a reissue
7 patent, as the case may be; or

8 “(2) the patent owner consents in writing to the
9 proceeding.

10 **“§ 323. Requirements of petition**

11 “A cancellation petition filed under section 321 may
12 be considered only if—

13 “(1) the petition is accompanied by payment of
14 the fee established by the Director under section
15 321;

16 “(2) the petition identifies the cancellation peti-
17 tioner;

18 “(3) for each claim sought to be canceled, the
19 petition sets forth in writing the basis for cancella-
20 tion and provides the evidence in support thereof, in-
21 cluding copies of patents and printed publications,
22 or written testimony of a witness attested to under
23 oath or declaration by the witness, or any other in-
24 formation that the Director may require by regula-
25 tion; and

1 “(4) the petitioner provides copies of the peti-
2 tion, including any evidence submitted with the peti-
3 tion and any other information submitted under
4 paragraph (3), to the patent owner or, if applicable,
5 the designated representative of the patent owner.

6 **“§ 324. Prohibited filings**

7 “A post-grant review proceeding may not be insti-
8 tuted under section 322 if the petition for cancellation re-
9 questing the proceeding—

10 “(1) identifies the same cancellation petitioner
11 and the same patent as a previous petition for can-
12 cancellation filed under such section; or

13 “(2) is based on the best mode requirement
14 contained in section 112.

15 **“§ 325. Submission of additional information; show-
16 ing of sufficient grounds**

17 “(a) IN GENERAL.—The cancellation petitioner shall
18 file such additional information with respect to the peti-
19 tion as the Director may require. For each petition sub-
20 mitted under section 321, the Director shall determine if
21 the written statement, and any evidence submitted with
22 the request, establish that a substantial question of pat-
23 entability exists for at least one claim in the patent. The
24 Director may initiate a post-grant review proceeding if the
25 Director determines that the information presented pro-

1 vides sufficient grounds to believe that there is a substan-
2 tial question of patentability concerning one or more
3 claims of the patent at issue.

4 “(b) NOTIFICATION; DETERMINATIONS NOT RE-
5 VIEWABLE.—The Director shall notify the patent owner
6 and each petitioner in writing of the Director’s determina-
7 tion under subsection (a), including a determination to
8 deny the petition. The Director shall make that determina-
9 tion in writing not later than 60 days after receiving the
10 petition. Any determination made by the Director under
11 subsection (a), including whether or not to institute a
12 post-grant review proceeding or to deny the petition, shall
13 not be reviewable.

14 **“§ 326. Conduct of post-grant review proceedings**

15 “(a) IN GENERAL.—The Director shall prescribe reg-
16 ulations, in accordance with section 2(b)(2)—

17 “(1) establishing and governing post-grant re-
18 view proceedings under this chapter and their rela-
19 tionship to other proceedings under this title;

20 “(2) establishing procedures for the submission
21 of supplemental information after the petition for
22 cancellation is filed; and

23 “(3) setting forth procedures for discovery of
24 relevant evidence, including that such discovery shall
25 be limited to evidence directly related to factual as-

1 sertions advanced by either party in the proceeding,
2 and the procedures for obtaining such evidence shall
3 be consistent with the purpose and nature of the
4 proceeding.

5 In carrying out paragraph (3), the Director shall bear in
6 mind that discovery must be in the interests of justice.

7 “(b) POST-GRANT REGULATIONS.—Regulations
8 under subsection (a)(1)—

9 “(1) shall require that the final determination
10 in a post-grant proceeding issue not later than one
11 year after the date on which the post-grant review
12 proceeding is instituted under this chapter, except
13 that, for good cause shown, the Director may extend
14 the 1-year period by not more than six months;

15 “(2) shall provide for discovery upon order of
16 the Director;

17 “(3) shall provide for publication of notice in
18 the Federal Register of the filing of a petition for
19 post-grant review under this chapter, for publication
20 of the petition, and documents, orders, and decisions
21 relating to the petition, on the website of the Patent
22 and Trademark Office, and for filings under seal ex-
23 empt from publication requirements;

24 “(4) shall prescribe sanctions for abuse of dis-
25 covery, abuse of process, or any other improper use

1 of the proceeding, such as to harass or to cause un-
2 necessary delay or unnecessary increase in the cost
3 of the proceeding;

4 “(5) may provide for protective orders gov-
5 erning the exchange and submission of confidential
6 information; and

7 “(6) shall ensure that any information sub-
8 mitted by the patent owner in support of any
9 amendment entered under section 329 is made avail-
10 able to the public as part of the prosecution history
11 of the patent.

12 “(c) CONSIDERATIONS.—In prescribing regulations
13 under this section, the Director shall consider the effect
14 on the economy, the integrity of the patent system, and
15 the efficient administration of the Office.

16 “(d) CONDUCT OF PROCEEDING.—The Patent Trial
17 and Appeal Board shall, in accordance with section 6(b),
18 conduct each post-grant review proceeding authorized by
19 the Director.

20 **“§ 327. Patent owner response**

21 “After a post-grant proceeding under this chapter
22 has been instituted with respect to a patent, the patent
23 owner shall have the right to file, within a time period
24 set by the Director, a response to the cancellation petition.
25 The patent owner shall file with the response, through af-

1 fidavits or declarations, any additional factual evidence
2 and expert opinions on which the patent owner relies in
3 support of the response.

4 **“§ 328. Proof and evidentiary standards**

5 “(a) IN GENERAL.—The presumption of validity set
6 forth in section 282 shall not apply in a challenge to any
7 patent claim under this chapter.

8 “(b) BURDEN OF PROOF.—The party advancing a
9 proposition under this chapter shall have the burden of
10 proving that proposition by a preponderance of the evi-
11 dence.

12 **“§ 329. Amendment of the patent**

13 “(a) IN GENERAL.—In response to a challenge in a
14 petition for cancellation, the patent owner may file one
15 motion to amend the patent in one or more of the fol-
16 lowing ways:

17 “(1) Cancel any challenged patent claim.

18 “(2) For each challenged claim, propose a sub-
19 stitute claim.

20 “(3) Amend the patent drawings or otherwise
21 amend the patent other than the claims.

22 “(b) ADDITIONAL MOTIONS.—Additional motions to
23 amend may be permitted only for good cause shown.

1 “(c) SCOPE OF CLAIMS.—An amendment under this
2 section may not enlarge the scope of the claims of the pat-
3 ent or introduce new matter.

4 **“§ 330. Decision of the Board**

5 “If the post-grant review proceeding is instituted and
6 not dismissed under this chapter, the Patent Trial and
7 Appeal Board shall issue a final written decision address-
8 ing the patentability of any patent claim challenged and
9 any new claim added under section 329.

10 **“§ 331. Effect of decision**

11 “(a) IN GENERAL.—If the Patent Trial and Appeal
12 Board issues a final decision under section 330 and the
13 time for appeal has expired or any appeal proceeding has
14 terminated, the Director shall issue and publish a certifi-
15 cate canceling any claim of the patent finally determined
16 to be unpatentable and incorporating in the patent by op-
17 eration of the certificate any new claim determined to be
18 patentable.

19 “(b) NEW CLAIMS.—Any new claim held to be pat-
20 entable and incorporated into a patent in a post-grant re-
21 view proceeding shall have the same effect as that speci-
22 fied in section 252 for reissued patents on the right of
23 any person who made, purchased, offered to sell, or used
24 within the United States, or imported into the United
25 States, anything patented by such new claim, or who made

1 substantial preparations therefor, before a certificate
2 under subsection (a) of this section is issued.

3 **“§ 332. Settlement**

4 “(a) IN GENERAL.—A post-grant review proceeding
5 shall be terminated with respect to any petitioner upon
6 the joint request of the petitioner and the patent owner,
7 unless the Patent Trial and Appeal Board has issued a
8 written decision before the request for termination is filed.
9 If the post-grant review proceeding is terminated with re-
10 spect to a petitioner under this paragraph, no estoppel
11 shall apply to that petitioner. If no petitioner remains in
12 the proceeding, the panel of administrative patent judges
13 assigned to the proceeding shall terminate the proceeding.

14 “(b) AGREEMENT IN WRITING.—Any agreement or
15 understanding between the patent owner and a petitioner,
16 including any collateral agreements referred to in the
17 agreement or understanding, that is made in connection
18 with or in contemplation of the termination of a post-grant
19 review proceeding, must be in writing. A post-grant review
20 proceeding as between the parties to the agreement or un-
21 derstanding may not be terminated until a copy of the
22 agreement or understanding, including any such collateral
23 agreements, has been filed in the Office. If any party filing
24 such an agreement or understanding requests, the agree-
25 ment or understanding shall be kept separate from the

1 file of the post-grant review proceeding, and shall be made
2 available only to Government agencies on written request,
3 or to any person on a showing of good cause.

4 **“§ 333. Relationship to other proceedings**

5 “(a) IN GENERAL.—Notwithstanding subsection
6 135(a), sections 251 and 252, and chapter 30, the Direc-
7 tor may determine the manner in which any reexamination
8 proceeding, reissue proceeding, interference proceeding
9 (commenced with respect to an application for patent filed
10 before the effective date provided in section 3(k) of the
11 Patent Reform Act of 2009), derivation proceeding, or
12 post-grant review proceeding, that is pending during a
13 post-grant review proceeding, may proceed, including pro-
14 viding for stay, transfer, consolidation, or termination of
15 any such proceeding.

16 “(b) STAYS.—The Director may stay a post-grant re-
17 view proceeding if a pending civil action for infringement
18 of a patent addresses the same or substantially the same
19 questions of patentability raised against the patent in a
20 petition for the post-grant review proceeding.

21 “(c) EFFECT OF COMMENCEMENT OF PRO-
22 CEEDING.—The commencement of a post-grant review
23 proceeding—

1 “(1) shall not limit in any way the right of the
2 patent owner to commence an action for infringe-
3 ment of the patent; and

4 “(2) shall not be cited as evidence relating to
5 the validity of any claim of the patent in any pro-
6 ceeding before a court or the International Trade
7 Commission concerning the patent.

8 **“§ 334. Effect of decisions rendered in civil action on**
9 **post-grant review proceedings**

10 “If a final decision is entered against a party in a
11 civil action arising in whole or in part under section 1338
12 of title 28 establishing that the party has not sustained
13 its burden of proving the invalidity of any patent claim—

14 “(1) that party to the civil action and the
15 privies of that party may not thereafter request a
16 post-grant review proceeding on that patent claim on
17 the basis of any grounds, under the provisions of
18 section 321, which that party or the privies of that
19 party raised or could have raised; and

20 “(2) the Director may not thereafter maintain
21 a post-grant review proceeding that was requested,
22 before the final decision was so entered, by that
23 party or the privies of that party on the basis of
24 such grounds.

1 **“§ 335. Effect of final decision on future proceedings**

2 “If a final decision under section 330 is favorable to
3 the patentability of any original or new claim of the patent
4 challenged by the cancellation petitioner, the cancellation
5 petitioner may not thereafter, based on any ground that
6 the cancellation petitioner raised during the post-grant re-
7 view proceeding—

8 “(1) request or pursue a reexamination of such
9 claim under chapter 31;

10 “(2) request or pursue a derivation proceeding
11 with respect to such claim;

12 “(3) request or pursue a post-grant review pro-
13 ceeding under this chapter with respect to such
14 claim;

15 “(4) assert the invalidity of any such claim in
16 any civil action arising in whole or in part under sec-
17 tion 1338 of title 28; or

18 “(5) assert the invalidity of any such claim in
19 defense to an action brought under section 337 of
20 the Tariff Act of 1930 (19 U.S.C. 1337).

21 **“§ 336. Appeal**

22 “A party dissatisfied with the final determination of
23 the Patent Trial and Appeal Board in a post-grant pro-
24 ceeding under this chapter may appeal the determination
25 under sections 141 through 144. Any party to the post-

1 grant proceeding shall have the right to be a party to the
2 appeal.”.

3 (i) CONFORMING AMENDMENT.—The table of chap-
4 ters for part III of title 35, United States Code, is amend-
5 ed by adding at the end the following:

“32. Post-Grant Review Proceedings 321”.

6 (j) REPEAL.—Section 4607 of the Intellectual Prop-
7 erty and Communications Omnibus Reform Act of 1999,
8 as enacted by section 1000(a)(9) of Public Law 106–113,
9 is repealed.

10 (k) EFFECTIVE DATES.—

11 (1) IN GENERAL.—The amendments and repeal
12 made by this section shall take effect at the end of
13 the 1-year period beginning on the date of the enact-
14 ment of this Act.

15 (2) APPLICABILITY TO EX PARTE AND INTER
16 PARTES PROCEEDINGS.—Notwithstanding any other
17 provision of law, sections 301 and 311 through 318
18 of title 35, United States Code, as amended by this
19 section, shall apply to any patent that issues before,
20 on, or after the effective date under paragraph (1)
21 from an original application filed on any date.

22 (3) APPLICABILITY TO POST-GRANT PRO-
23 CEEDINGS.—The amendments made by subsections
24 (h) and (i) shall apply to patents issued on or after
25 the effective date under paragraph (1).

1 (l) REGULATIONS.—The Under Secretary of Com-
2 merce for Intellectual Property and Director of the United
3 States Patent and Trademark Office (in this subsection
4 referred to as the “Director”) shall, not later than the
5 date that is 1 year after the date of the enactment of this
6 Act, issue regulations to carry out chapter 32 of title 35,
7 United States Code, as added by subsection (h) of this
8 section.

9 **SEC. 6. DEFINITIONS; PATENT TRIAL AND APPEAL BOARD.**

10 (a) DEFINITIONS.—Section 100 of title 35, United
11 States Code, (as amended by section 2 of this Act) is fur-
12 ther amended—

13 (1) in subsection (e), by striking “or inter
14 partes reexamination under section 311”; and

15 (2) by adding at the end the following:

16 “(k) The term ‘cancellation petitioner’ means the real
17 party in interest requesting cancellation of any claim of
18 a patent under chapter 31 of this title and the privies of
19 the real party in interest.”.

20 (b) PATENT TRIAL AND APPEAL BOARD.—Section 6
21 of title 35, United States Code, is amended to read as
22 follows:

23 **“§ 6. Patent Trial and Appeal Board**

24 “(a) ESTABLISHMENT AND COMPOSITION.—There
25 shall be in the Office a Patent Trial and Appeal Board.

1 The Director, the Deputy Director, the Commissioner for
2 Patents, the Commissioner for Trademarks, and the ad-
3 ministrative patent judges shall constitute the Patent
4 Trial and Appeal Board. The administrative patent judges
5 shall be persons of competent legal knowledge and sci-
6 entific ability who are appointed by the Secretary of Com-
7 merce. Any reference in any Federal law, Executive order,
8 rule, regulation, or delegation of authority, or any docu-
9 ment of or pertaining to the Board of Patent Appeals and
10 Interferences is deemed to refer to the Patent Trial and
11 Appeal Board.

12 “(b) DUTIES.—The Patent Trial and Appeal Board
13 shall—

14 “(1) on written appeal of an applicant, review
15 adverse decisions of examiners upon application for
16 patents;

17 “(2) on written appeal of a patent owner, re-
18 view adverse decisions of examiners upon patents in
19 reexamination proceedings under chapter 30;

20 “(3) conduct derivation proceedings under sub-
21 section 135(a); and

22 “(4) conduct post-grant opposition proceedings
23 under chapter 32.

24 Each appeal and derivation proceeding shall be heard by
25 at least 3 members of the Patent Trial and Appeal Board,

1 who shall be designated by the Director. Only the Patent
2 Trial and Appeal Board may grant rehearings. The Direc-
3 tor shall assign each post-grant review proceeding to a
4 panel of 3 administrative patent judges. Once assigned,
5 each such panel of administrative patent judges shall have
6 the responsibilities under chapter 32 in connection with
7 post-grant review proceedings.”.

8 **SEC. 7. PREISSUANCE SUBMISSIONS BY THIRD PARTIES.**

9 Section 122 of title 35, United States Code, is
10 amended by adding at the end the following:

11 “(e) PREISSUANCE SUBMISSIONS BY THIRD PAR-
12 TIES.—

13 “(1) IN GENERAL.—Any person may submit for
14 consideration and inclusion in the record of a patent
15 application, any patent, published patent application,
16 or other publication of potential relevance to the ex-
17 amination of the application, if such submission is
18 made in writing before the earlier of—

19 “(A) the date a notice of allowance under
20 section 151 is mailed in the application for pat-
21 ent; or

22 “(B) either—

23 “(i) 6 months after the date on which
24 the application for patent is published
25 under section 122, or

1 “(ii) the date of the first rejection
2 under section 132 of any claim by the ex-
3 aminer during the examination of the ap-
4 plication for patent,
5 whichever occurs later.

6 “(2) OTHER REQUIREMENTS.—Any submission
7 under paragraph (1) shall—

8 “(A) set forth a concise description of the
9 asserted relevance of each submitted document;

10 “(B) be accompanied by such fee as the
11 Director may prescribe; and

12 “(C) include a statement by the person
13 making such submission affirming that the sub-
14 mission was made in compliance with this sec-
15 tion.”.

16 **SEC. 8. VENUE AND JURISDICTION.**

17 (a) VENUE FOR PATENT CASES.—Section 1400 of
18 title 28, United States Code, is amended by striking sub-
19 section (b) and inserting the following:

20 “(b) Notwithstanding section 1391 of this title, in
21 any civil action arising under any Act of Congress relating
22 to patents, a party shall not manufacture venue by assign-
23 ment, incorporation, or otherwise to invoke the venue of
24 a specific district court.

1 “(c) Notwithstanding section 1391 of this title, any
2 civil action for patent infringement or any action for de-
3 claratory judgment may be brought only in a judicial dis-
4 trict—

5 “(1) where the defendant has its principal place
6 of business or in the location or place in which the
7 defendant is incorporated or formed, or, for foreign
8 corporations with a United States subsidiary, where
9 the defendant’s primary United States subsidiary
10 has its principal place of business or is incorporated
11 or formed;

12 “(2) where the defendant has committed sub-
13 stantial acts of infringement and has a regular and
14 established physical facility that the defendant con-
15 trols and that constitutes a substantial portion of
16 the operations of the defendant;

17 “(3) where the primary plaintiff resides, if the
18 primary plaintiff in the action is—

19 “(A) an institution of higher education as
20 defined under section 101(a) of the Higher
21 Education Act of 1965 (20 U.S.C. 1001(a)); or

22 “(B) a nonprofit organization that—

23 “(i) qualifies for treatment under sec-
24 tion 501(c)(3) of the Internal Revenue
25 Code (26 U.S.C. 501(c)(3));

1 “(ii) is exempt from taxation under
2 section 501(a) of such Code; and

3 “(iii) serves as the patent and licens-
4 ing organization for an institution of high-
5 er education as defined under section
6 101(a) of the Higher Education Act of
7 1965 (20 U.S.C. 1001(a)); or

8 “(4) where the plaintiff resides, if the sole
9 plaintiff in the action is an individual inventor who
10 is a natural person and who qualifies at the time
11 such action is filed as a micro-entity pursuant to
12 section 123 of title 35.

13 “(d) If a plaintiff brings a civil action for patent in-
14 fringement or declaratory judgment relief under sub-
15 section (c), then the defendant may request the district
16 court to transfer that action to another district or division
17 where, in the court’s determination—

18 “(1) any of the parties has substantial evidence
19 or witnesses that otherwise would present consider-
20 able evidentiary burdens to the defendant if such
21 transfer were not granted;

22 “(2) such transfer would not cause undue hard-
23 ship to the plaintiff; and

24 “(3) venue would be otherwise appropriate
25 under section 1391 of this title.”.

1 (b) INTERLOCUTORY APPEALS.—Subsection (c)(2) of
2 section 1292 of title 28, United States Code, is amended
3 by adding at the end the following:

4 “(3) of an appeal from an interlocutory order
5 or decree determining construction of claims in a
6 civil action for patent infringement under section
7 271 of title 35.

8 Application for an appeal under paragraph (3) shall
9 be made to the court within 10 days after entry of
10 the order or decree. The district court shall have dis-
11 cretion whether to approve the application and, if so,
12 whether to stay proceedings in the district court dur-
13 ing the pendency of such appeal.”.

14 (c) TECHNICAL AMENDMENTS RELATING TO
15 VENUE.—Sections 32, 145, 146, 154(b)(4)(A), and 293
16 of title 35, United States Code, and section 21(b)(4) of
17 the Act entitled “An Act to provide for the registration
18 and protection of trademarks used in commerce, to carry
19 out the provisions of certain international conventions,
20 and for other purposes”, approved July 5, 1946 (com-
21 monly referred to as the “Trademark Act of 1946” or the
22 “Lanham Act”; 15 U.S.C. 1071(b)(4)), are each amended
23 by striking “United States District Court for the District
24 of Columbia” each place that term appears and inserting

1 “United States District Court for the Eastern District of
2 Virginia”.

3 **SEC. 9. PATENT AND TRADEMARK OFFICE REGULATORY**
4 **AUTHORITY.**

5 (a) FEE SETTING.—

6 (1) IN GENERAL.—The Director shall have au-
7 thority to set or adjust by rule any fee established
8 or charged by the Office under sections 41 and 376
9 of title 35, United States Code or under section 31
10 of the Trademark Act of 1946 (15 U.S.C. 1113) for
11 the filing or processing of any submission to, and for
12 all other services performed by or materials fur-
13 nished by, the Office, provided that such fee
14 amounts are set to reasonably compensate the Office
15 for the services performed.

16 (2) REDUCTION OF FEES IN CERTAIN FISCAL
17 YEARS.—In any fiscal year, the Director—

18 (A) shall consult with the Patent Public
19 Advisory Committee and the Trademark Public
20 Advisory Committee on the advisability of re-
21 ducing any fees described in paragraph (1); and

22 (B) after that consultation may reduce
23 such fees.

24 (3) ROLE OF THE PUBLIC ADVISORY COM-
25 MITTEE.—The Director shall—

1 (A) submit to the Patent or Trademark
2 Public Advisory Committee, or both, as appro-
3 priate, any proposed fee under paragraph (1)
4 not less than 45 days before publishing any
5 proposed fee in the Federal Register;

6 (B) provide the relevant advisory com-
7 mittee described in subparagraph (A) a 30-day
8 period following the submission of any proposed
9 fee, on which to deliberate, consider, and com-
10 ment on such proposal, and require that—

11 (i) during such 30-day period, the rel-
12 evant advisory committee hold a public
13 hearing related to such proposal; and

14 (ii) the Director shall assist the rel-
15 evant advisory committee in carrying out
16 such public hearing, including by offering
17 the use of Office resources to notify and
18 promote the hearing to the public and in-
19 terested stakeholders;

20 (C) require the relevant advisory com-
21 mittee to make available to the public a written
22 report detailing the comments, advice, and rec-
23 ommendations of the committee regarding any
24 proposed fee;

1 (D) consider and analyze any comments,
2 advice, or recommendations received from the
3 relevant advisory committee before setting or
4 adjusting any fee; and

5 (E) notify, through the Chair and Ranking
6 Member of the Senate and House Judiciary
7 Committees, the Congress of any final decision
8 regarding proposed fees.

9 (4) PUBLICATION IN THE FEDERAL REG-
10 ISTER.—

11 (A) IN GENERAL.—Any rules prescribed
12 under this subsection shall be published in the
13 Federal Register.

14 (B) RATIONALE.—Any proposal for a
15 change in fees under this section shall—

16 (i) be published in the Federal Reg-
17 ister; and

18 (ii) include, in such publication, the
19 specific rationale and purpose for the pro-
20 posal, including the possible expectations
21 or benefits resulting from the proposed
22 change.

23 (C) PUBLIC COMMENT PERIOD.—Following
24 the publication of any proposed fee in the Fed-
25 eral Register pursuant to subparagraph (A), the

1 Director shall seek public comment for a period
2 of not less than 45 days.

3 (5) CONGRESSIONAL COMMENT PERIOD.—Fol-
4 lowing the notification described in paragraph
5 (3)(E), Congress shall have not more than 45 days
6 to consider and comment on any proposed fee under
7 paragraph (1). No proposed fee shall be effective
8 prior to the end of such 45-day comment period.

9 (6) RULE OF CONSTRUCTION.—No rules pre-
10 scribed under this subsection may diminish—

11 (A) an applicant’s rights under this title or
12 the Trademark Act of 1946; or

13 (B) any rights under a ratified treaty.

14 (b) FEES FOR PATENT SERVICES.—Division B of
15 Public Law 108–447 is amended in title VIII of the De-
16 partments of Commerce, Justice and State, the Judiciary,
17 and Related Agencies Appropriations Act, 2005, in section
18 801(a) by striking “During fiscal years 2005, 2006 and
19 2007”, and inserting “Until such time as the Director sets
20 or adjusts the fees otherwise,”.

21 (c) ADJUSTMENT OF TRADEMARK FEES.—Division
22 B of Public Law 108–447 is amended in title VIII of the
23 Departments of Commerce, Justice and State, the Judici-
24 ary and Related Agencies Appropriations Act, 2005, in
25 section 802(a) by striking “During fiscal years 2005,

1 2006 and 2007”, and inserting “Until such time as the
2 Director sets or adjusts the fees otherwise,”.

3 (d) EFFECTIVE DATE, APPLICABILITY, AND TRANSI-
4 TIONAL PROVISION.—Division B of Public Law 108–447
5 is amended in title VIII of the Departments of Commerce,
6 Justice and State, the Judiciary and Related Agencies Ap-
7 propriations Act, 2005, in section 803(a) by striking “and
8 shall apply only with respect to the remaining portion of
9 fiscal year 2005, 2006 and 2007.”.

10 (e) RULE OF CONSTRUCTION.—Nothing in this sec-
11 tion shall be construed to affect any other provision of Di-
12 vision B of Public Law 108–447, including section 801(c)
13 of title VII of the Departments of Commerce, Justice and
14 State, the Judiciary and Related Agencies Appropriations
15 Act, 2005.

16 (f) DEFINITIONS.—In this section:

17 (1) DIRECTOR.—The term “Director” means
18 the Director of the United States Patent and Trade-
19 mark Office.

20 (2) OFFICE.—The term “Office” means the
21 United States Patent and Trademark Office.

22 (3) TRADEMARK ACT OF 1946.—The term
23 “Trademark Act of 1946” means an Act entitled
24 “Act to provide for the registration and protection
25 of trademarks used in commerce, to carry out the

1 provisions of certain international conventions, and
2 for other purposes”, approved July 5, 1946 (15
3 U.S.C. 1051 et seq.) (commonly referred to as the
4 Trademark Act of 1946 or the Lanham Act).

5 **SEC. 10. RESIDENCY OF FEDERAL CIRCUIT JUDGES.**

6 (a) RESIDENCY.—The second sentence of section
7 44(c) of title 28, United States Code, is repealed.

8 (b) FACILITIES.—Section 44 of title 28, United
9 States Code, is amended by adding at the end the fol-
10 lowing:

11 “(e)(1) The Director of the Administrative Office of
12 the United States Courts shall provide—

13 “(A) a judge of the Federal judicial circuit who
14 lives within 50 miles of the District of Columbia
15 with appropriate facilities and administrative sup-
16 port services in the District of the District of Colum-
17 bia; and

18 “(B) a judge of the Federal judicial circuit who
19 does not live within 50 miles of the District of Co-
20 lumbia with appropriate facilities and administrative
21 support services—

22 “(i) in the district and division in which
23 that judge resides; or

24 “(ii) if appropriate facilities are not avail-
25 able in the district and division in which that

1 judge resides, in the district and division closest
2 to the residence of that judge in which such fa-
3 cilities are available, as determined by the Di-
4 rector.

5 “(2) Nothing in this subsection may be construed to
6 authorize or require the construction of new facilities.”.

7 **SEC. 11. MICRO-ENTITY DEFINED.**

8 Chapter 11 of title 35, United States Code, is amend-
9 ed by adding at the end the following new section:

10 **“§ 123. Micro-entity defined**

11 “(a) IN GENERAL.—For purposes of this title, the
12 term ‘micro-entity’ means an applicant who makes a cer-
13 tification under either subsections (b) or (c).

14 “(b) UNASSIGNED APPLICATION.—For an unas-
15 signed application, each applicant shall certify that the ap-
16 plicant—

17 “(1) qualifies as a small entity, as defined in
18 regulations issued by the Director;

19 “(2) has not been named on 5 or more pre-
20 viously filed patent applications;

21 “(3) has not assigned, granted, or conveyed,
22 and is not under an obligation by contract or law to
23 assign, grant, or convey, a license or any other own-
24 ership interest in the particular application; and

1 “(4) does not have a gross income, as defined
2 in section 61(a) of the Internal Revenue Code (26
3 U.S.C. 61(a)), exceeding 2.5 times the average gross
4 income, as reported by the Department of Labor, in
5 the calendar year immediately preceding the cal-
6 endar year in which the examination fee is being
7 paid.

8 “(c) ASSIGNED APPLICATION.—For an assigned ap-
9 plication, each applicant shall certify that the applicant—

10 “(1) qualifies as a small entity, as defined in
11 regulations issued by the Director, and meets the re-
12 quirements of subsection (b)(4);

13 “(2) has not been named on 5 or more pre-
14 viously filed patent applications; and

15 “(3) has assigned, granted, conveyed, or is
16 under an obligation by contract or law to assign,
17 grant, or convey, a license or other ownership inter-
18 est in the particular application to an entity that has
19 5 or fewer employees and that such entity has a
20 gross income, as defined in section 61(a) of the In-
21 ternal Revenue Code (26 U.S.C. 61(a)), that does
22 not exceed 2.5 times the average gross income, as
23 reported by the Department of Labor, in the cal-
24 endar year immediately preceding the calendar year
25 in which the examination fee is being paid.

1 “(d) INCOME LEVEL ADJUSTMENT.—The gross in-
2 come levels established under subsections (b) and (c) shall
3 be adjusted by the Director on October 1, 2009, and every
4 year thereafter, to reflect any fluctuations occurring dur-
5 ing the previous 12 months in the Consumer Price Index,
6 as determined by the Secretary of Labor.”.

7 **SEC. 12. TECHNICAL AMENDMENTS.**

8 (a) JOINT INVENTIONS.—Section 116 of title 35,
9 United States Code, is amended—

10 (1) in the first paragraph, by striking
11 “When” and inserting “(a) JOINT INVEN-
12 TIONS.—When”;

13 (2) in the second paragraph, by striking
14 “If a joint inventor” and inserting “(b) OMIT-
15 TED INVENTOR.—If a joint inventor”; and

16 (3) in the third paragraph, by striking
17 “Whenever” and inserting “(c) CORRECTION OF
18 ERRORS IN APPLICATION.—Whenever”.

19 (b) FILING OF APPLICATION IN FOREIGN COUN-
20 TRY.—Section 184 of title 35, United States Code, is
21 amended—

22 (1) in the first paragraph, by striking “Except
23 when” and inserting “(a) FILING IN FOREIGN
24 COUNTRY.—Except when”;

1 (2) in the second paragraph, by striking “The
2 term” and inserting “(b) APPLICATION.—The
3 term”; and

4 (3) in the third paragraph, by striking “The
5 scope” and inserting “(c) SUBSEQUENT MODIFICA-
6 TIONS, AMENDMENTS, AND SUPPLEMENTS.—The
7 scope”.

8 (c) REISSUE OF DEFECTIVE PATENTS.—Section 251
9 of title 35, United States Code, is amended—

10 (1) in the first paragraph, by striking “When-
11 ever” and inserting “(a) IN GENERAL.—Whenever”;

12 (2) in the second paragraph, by striking “The
13 Director” and inserting “(b) MULTIPLE REISSUED
14 PATENTS.—The Director”;

15 (3) in the third paragraph, by striking “The
16 provision” and inserting “(c) APPLICABILITY OF
17 THIS TITLE.—The provisions”; and

18 (4) in the last paragraph, by striking “No re-
19 issued patent” and inserting “(d) REISSUE PATENT
20 ENLARGING SCOPE OF CLAIMS.—No reissued pat-
21 ent”.

22 (d) EFFECT OF REISSUE.—Section 253 of title 35,
23 United States Code, is amended—

1 (1) in the first paragraph, by striking “When-
2 ever” and inserting “(a) IN GENERAL.—Whenever”;
3 and

4 (2) in the second paragraph, by striking “in
5 like manner” and inserting “(b) ADDITIONAL DIS-
6 CLAIMER OR DEDICATION.—In the manner set forth
7 in subsection (a),”.

8 (e) CORRECTION OF NAMED INVENTOR.—Section
9 256 of title 35, United States Code, is amended—

10 (1) in the first paragraph, by striking “When-
11 ever” and inserting “(a) CORRECTION.—Whenever”;
12 and

13 (2) in the second paragraph, by striking “The
14 error” and inserting “(b) PATENT VALID IF ERROR
15 CORRECTED.—The error”.

16 (f) PRESUMPTION OF VALIDITY.—Section 282 of title
17 35, United States Code, is amended—

18 (1) in the first undesignated paragraph, by
19 striking “A patent” and inserting “(a) IN GEN-
20 ERAL.—A patent”;

21 (2) in the second undesignated paragraph, by
22 striking “The following” and inserting “(b) DE-
23 FENSES.—The following”; and

24 (3) in the third undesignated paragraph, by
25 striking “In actions” and inserting “(c) NOTICE OF

1 ACTIONS; ACTIONS DURING EXTENSION OF PATENT
2 TERM.—In actions”.

3 **SEC. 13. EFFECTIVE DATE; RULE OF CONSTRUCTION.**

4 (a) EFFECTIVE DATE.—Except as otherwise provided
5 in this Act, the provisions of this Act shall take effect 12
6 months after the date of the enactment of this Act and
7 shall apply to any patent issued on or after that effective
8 date.

9 (b) CONTINUITY OF INTENT UNDER THE CREATE
10 ACT.—The enactment of section 102(b)(3) of title 35,
11 United States Code, under section (2)(b) of this Act is
12 done with the same intent to promote joint research activi-
13 ties that was expressed, including in the legislative history,
14 through the enactment of the Cooperative Research and
15 Technology Enhancement Act of 2004 (Public Law 108–
16 453; the “CREATE Act”), the amendments of which are
17 stricken by section 2(c) of this Act. The United States
18 Patent and Trademark Office shall administer section
19 102(b)(3) of title 35, United States Code, in a manner
20 consistent with the legislative history of the CREATE Act
21 that was relevant to its administration by the United
22 States Patent and Trademark Office.

23 **SEC. 14. SEVERABILITY.**

24 If any provision of this Act or of any amendment or
25 repeals made by this Act, or the application of such a pro-

1 vision to any person or circumstance, is held to be invalid
2 or unenforceable, the remainder of this Act and the
3 amendments and repeals made by this Act, and the appli-
4 cation of this Act and such amendments and repeals to
5 any other person or circumstance, shall not be affected
6 by such holding.

○