

113TH CONGRESS
1ST SESSION

H. R. 3309

To amend title 35, United States Code, and the Leahy-Smith America Invents Act to make improvements and technical corrections, and for other purposes.

IN THE HOUSE OF REPRESENTATIVES

OCTOBER 23, 2013

Mr. GOODLATTE (for himself, Mr. DEFAZIO, Mr. COBLE, Ms. LOFGREN, Mr. SMITH of Texas, Ms. ESHOO, Mr. CHAFFETZ, Mr. BACHUS, Mr. MARINO, Mr. FARENTHOLD, and Mr. HOLDING) introduced the following bill; which was referred to the Committee on the Judiciary

A BILL

To amend title 35, United States Code, and the Leahy-Smith America Invents Act to make improvements and technical corrections, and for other purposes.

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 “Innovation Act”.

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. Definitions.
- Sec. 3. Patent infringement actions.

- Sec. 4. Transparency of patent ownership.
 Sec. 5. Customer-suit exception.
 Sec. 6. Procedures and practices to implement and recommendations to the Judicial Conference.
 Sec. 7. Small business education, outreach, and information access.
 Sec. 8. Studies on patent transactions, quality, and examination.
 Sec. 9. Improvements and technical corrections to the Leahy-Smith America Invents Act.
 Sec. 10. Effective date.

1 **SEC. 2. DEFINITIONS.**

2 In this Act:

3 (1) **DIRECTOR.**—The term “Director” means
 4 the Under Secretary of Commerce for Intellectual
 5 Property and Director of the United States Patent
 6 and Trademark Office.

7 (2) **OFFICE.**—The term “Office” means the
 8 United States Patent and Trademark Office.

9 **SEC. 3. PATENT INFRINGEMENT ACTIONS.**

10 (a) **PLEADING REQUIREMENTS.**—

11 (1) **AMENDMENT.**—Chapter 29 of title 35,
 12 United States Code, is amended by inserting after
 13 section 281 the following:

14 **“§ 281A. Pleading requirements for patent infringement**
 15 **actions**

16 “(a) **PLEADING REQUIREMENTS.**—Except as pro-
 17 vided in subsection (b), in a civil action in which a party
 18 asserts a claim for relief arising under any Act of Con-
 19 gress relating to patents, a party alleging infringement
 20 shall include in the initial complaint, counterclaim, or
 21 cross-claim for patent infringement, unless the informa-

1 tion is not reasonably accessible to such party, the fol-
2 lowing:

3 “(1) An identification of each patent allegedly
4 infringed.

5 “(2) An identification of each claim of each pat-
6 ent identified under paragraph (1) that is allegedly
7 infringed.

8 “(3) For each claim identified under paragraph
9 (2), an identification of each accused apparatus,
10 product, feature, device, method, system, process,
11 function, act, service, or other instrumentality (re-
12 ferred to in this section as an ‘accused instrumen-
13 tality’) alleged to infringe the claim.

14 “(4) For each accused instrumentality identi-
15 fied under paragraph (3), an identification with par-
16 ticularity, if known, of—

17 “(A) the name or model number of each
18 accused instrumentality; or

19 “(B) if there is no name or model number,
20 a description of each accused instrumentality
21 that, when used, allegedly results in the prac-
22 tice of the claimed invention.

23 “(5) For each accused instrumentality identi-
24 fied under paragraph (3), an explanation of—

1 “(A) where each element of each claim
2 identified under paragraph (2) is found within
3 the accused instrumentality;

4 “(B) whether each such element is in-
5 fringed literally or under the doctrine of equiva-
6 lents; and

7 “(C) with detailed specificity, how the
8 terms in each claim identified under paragraph
9 (2) correspond to the functionality of the ac-
10 cused instrumentality.

11 “(6) For each claim that is alleged to have been
12 infringed indirectly, a description of—

13 “(A) the direct infringement;

14 “(B) any person alleged to be a direct in-
15 fringer known to the party alleging infringe-
16 ment; and

17 “(C) the acts of the alleged indirect in-
18 fringer that contribute to or are inducing the
19 direct infringement.

20 “(7) A description of the right of the party al-
21 leging infringement to assert each—

22 “(A) patent identified under paragraph
23 (1); and

24 “(B) patent claim identified under para-
25 graph (2).

1 “(8) A description of the principal business of
2 the party alleging infringement.

3 “(9) A list of each complaint filed, of which the
4 party alleging infringement has knowledge, that as-
5 serts or asserted any of the patents identified under
6 paragraph (1).

7 “(10) For each patent identified under para-
8 graph (1), whether such patent has been specifically
9 declared as essential, potentially essential, or having
10 potential to become essential to any standard-setting
11 body, and whether the United States Government or
12 a foreign government has imposed specific licensing
13 requirements with respect to such patent.

14 “(b) INFORMATION NOT READILY ACCESSIBLE.—A
15 party required to disclose the information described under
16 subsection (a) shall include with such disclosure a descrip-
17 tion of any information described under subsection (a)
18 that is not disclosed, why such undisclosed information
19 was not readily accessible, and the efforts made by such
20 party to access such undisclosed information.

21 “(c) CONFIDENTIAL INFORMATION.—For good cause
22 shown by a party required to disclose the information de-
23 scribed under subsection (a), the court may allow certain
24 information that the court determines to be confidential
25 to be filed under seal.

1 “(d) EXEMPTION.—A civil action that includes a
2 claim for relief arising under section 271(e)(2) shall not
3 be subject to the requirements of subsection (a).”.

4 (2) CONFORMING AMENDMENT.—The table of
5 sections for chapter 29 of title 35, United States
6 Code, is amended by inserting after the item relating
7 to section 281 the following new item:

“281A. Pleading requirements for patent infringement actions.”.

8 (b) FEES AND OTHER EXPENSES.—

9 (1) AMENDMENT.—Section 285 of title 35,
10 United States Code, is amended to read as follows:

11 **“§ 285. Fees and other expenses**

12 “(a) AWARD.—The court shall award, to a prevailing
13 party, reasonable fees and other expenses incurred by that
14 party in connection with a civil action in which any party
15 asserts a claim for relief arising under any Act of Con-
16 gress relating to patents, unless the court finds that the
17 position of the nonprevailing party or parties was substan-
18 tially justified or that special circumstances make an
19 award unjust.

20 “(b) RECOVERY.—If a nonprevailing party is unable
21 to pay reasonable fees and other expenses awarded by the
22 court pursuant to subsection (a), the court may make the
23 reasonable fees and other expenses recoverable against any
24 interested party joined pursuant to section 299(d).

1 “(c) COVENANT NOT TO SUE.—A party to a civil ac-
2 tion that asserts a claim for relief arising under any Act
3 of Congress relating to patents against another party, and
4 that subsequently unilaterally extends to such other party
5 a covenant not to sue for infringement with respect to the
6 patent or patents at issue, shall be deemed to be a nonpre-
7 vailing party (and the other party the prevailing party)
8 for purposes of this section, unless the party asserting
9 such claim would have been entitled, at the time that such
10 covenant was extended, to voluntarily dismiss the action
11 or claim without a court order under Rule 41 of the Fed-
12 eral Rules of Civil Procedure.”.

13 (2) CONFORMING AMENDMENT AND AMEND-
14 MENT.—

15 (A) CONFORMING AMENDMENT.—The item
16 relating to section 285 of the table of sections
17 for chapter 29 of title 35, United States Code,
18 is amended to read as follows:

“285. Fees and other expenses.”.

19 (B) AMENDMENT.—Section 273 of title
20 35, United States Code, is amended by striking
21 subsections (f) and (g).

22 (3) EFFECTIVE DATE.—The amendments made
23 by this subsection shall take effect on the date of the
24 enactment of this Act and shall apply to any action
25 for which a complaint is filed on or after that date.

1 (c) JOINDER OF INTERESTED PARTIES.—Section
2 299 of title 35, United States Code, is amended by adding
3 at the end the following new subsection:

4 “(d) JOINDER OF INTERESTED PARTIES.—

5 “(1) JOINDER.—In a civil action arising under
6 any Act of Congress relating to patents, the court
7 shall grant a motion by a party defending against an
8 allegation of infringement of a patent claim to join
9 an interested party if such defending party shows
10 that the party alleging infringement has no substan-
11 tial interest in the patent or patents at issue other
12 than asserting such patent claim in litigation.

13 “(2) LIMITATION ON JOINDER.—The court may
14 deny a motion to join an interested party under
15 paragraph (1) if—

16 “(A) the interested party is not subject to
17 service of process; or

18 “(B) joinder under paragraph (1) would
19 deprive the court of subject matter jurisdiction
20 or make venue improper.

21 “(3) INTERESTED PARTY DEFINED.—In this
22 subsection, the term ‘interested party’ means a per-
23 son, other than the party alleging infringement,
24 that—

1 “(A) is an assignee of the patent or pat-
2 ents at issue;

3 “(B) has a right, including a contingent
4 right, to enforce or sublicense the patent or pat-
5 ents at issue; or

6 “(C) has a direct financial interest in the
7 patent or patents at issue, including the right
8 to any part of an award of damages or any part
9 of licensing revenue, except that a person with
10 a direct financial interest does not include—

11 “(i) an attorney or law firm providing
12 legal representation in the civil action de-
13 scribed in paragraph (1) if the sole basis
14 for the financial interest of the attorney or
15 law firm in the patent or patents at issue
16 arises from the attorney or law firm’s re-
17 ceipt of compensation reasonably related to
18 the provision of the legal representation; or

19 “(ii) a person whose sole financial in-
20 terest in the patent or patents at issue is
21 ownership of an equity interest in the
22 party alleging infringement, unless such
23 person also has the right or ability to influ-
24 ence, direct, or control the civil action.”.

25 (d) DISCOVERY LIMITS.—

1 (1) AMENDMENT.—Chapter 29 of title 35,
2 United States Code, is amended by adding at the
3 end the following new section:

4 **“§ 299A. Discovery in patent infringement action**

5 “(a) DISCOVERY IN PATENT INFRINGEMENT AC-
6 TION.—Except as provided in subsection (b), in a civil ac-
7 tion arising under any Act of Congress relating to patents,
8 if the court determines that a ruling relating to the con-
9 struction of terms used in a patent claim asserted in the
10 complaint is required, discovery shall be limited, until such
11 ruling is issued, to information necessary for the court to
12 determine the meaning of the terms used in the patent
13 claim, including any interpretation of those terms used to
14 support the claim of infringement.

15 “(b) DISCRETION TO EXPAND SCOPE OF DIS-
16 COVERY.—

17 “(1) TIMELY RESOLUTION OF ACTIONS.—If,
18 under any provision of Federal law (including the
19 amendments made by the Drug Price Competition
20 and Patent Term Restoration Act of 1984 (Public
21 Law 98–417)), resolution within a specified period
22 of time of a civil action arising under any Act of
23 Congress relating to patents will necessarily affect
24 the rights of a party with respect to the patent, the
25 court may permit discovery, in addition to the dis-

1 covery authorized under subsection (a), before the
2 ruling described in subsection (a) is issued as nec-
3 essary to ensure timely resolution of the action.

4 “(2) RESOLUTION OF MOTIONS.—When nec-
5 essary to resolve a motion properly raised by a party
6 before a ruling relating to the construction of terms
7 described in subsection (a), the court may allow lim-
8 ited discovery in addition to the discovery authorized
9 under subsection (a) as necessary to resolve the mo-
10 tion.”.

11 (2) CONFORMING AMENDMENT.—The table of
12 sections for chapter 29 of title 35, United States
13 Code, is amended by adding at the end the following
14 new item:

“299A. Discovery in patent infringement action.”.

15 (e) EFFECTIVE DATE.—Except as otherwise provided
16 in this section, the amendments made by this section shall
17 take effect on the date of the enactment of this Act and
18 shall apply to any action for which a complaint is filed
19 on or after that date.

20 **SEC. 4. TRANSPARENCY OF PATENT OWNERSHIP.**

21 (a) AMENDMENTS.—Section 290 of title 35, United
22 States Code, is amended—

23 (1) in the heading, by striking “**suits**” and in-
24 serting “**suits; disclosure of interests**”;

1 (2) by striking “The clerks” and inserting “(a)
2 NOTICE OF PATENT SUITS.—The clerks”; and

3 (3) by adding at the end the following new sub-
4 sections:

5 “(b) INITIAL DISCLOSURE.—

6 “(1) IN GENERAL.—Except as provided in para-
7 graph (2), upon the filing of an initial complaint for
8 patent infringement, the plaintiff shall disclose to
9 the Patent and Trademark Office, the court, and
10 each adverse party the identity of each of the fol-
11 lowing:

12 “(A) The assignee of the patent or patents
13 at issue.

14 “(B) Any entity with a right to sublicense
15 or enforce the patent or patents at issue.

16 “(C) Any entity, other than the plaintiff,
17 that the plaintiff knows to have a financial in-
18 terest in the patent or patents at issue or the
19 plaintiff.

20 “(D) The ultimate parent entity of any as-
21 signee identified under subparagraph (A) and
22 any entity identified under subparagraphs (B)
23 and (C).

24 “(2) EXEMPTION.—The requirements of para-
25 graph (1) shall not apply with respect to a civil ac-

1 tion filed under subsection (a) that includes a cause
2 of action described under section 271(e)(2).

3 “(c) DISCLOSURE COMPLIANCE.—

4 “(1) PUBLICLY TRADED.—For purposes of sub-
5 section (b)(1)(C), if the financial interest is held by
6 a corporation traded on a public stock exchange, an
7 identification of the name of the corporation and the
8 public exchange listing shall satisfy the disclosure re-
9 quirement.

10 “(2) NOT PUBLICLY TRADED.—For purposes of
11 subsection (b)(1)(C), if the financial interest is not
12 held by a publicly traded corporation, the disclosure
13 shall satisfy the disclosure requirement if the infor-
14 mation identifies—

15 “(A) in the case of a partnership, the
16 name of the partnership and the name and cor-
17 respondence address of each partner or other
18 entity that holds more than a 5-percent share
19 of that partnership;

20 “(B) in the case of a corporation, the
21 name of the corporation, the location of incor-
22 poration, the address of the principal place of
23 business, and the name of each officer of the
24 corporation; and

1 “(C) for each individual, the name and
2 correspondence address of that individual.

3 “(d) ONGOING DUTY OF DISCLOSURE TO THE PAT-
4 ENT AND TRADEMARK OFFICE.—

5 “(1) IN GENERAL.—A plaintiff required to sub-
6 mit information under subsection (b) or a subse-
7 quent owner of the patent or patents at issue shall,
8 not later than 90 days after any change in the as-
9 signee of the patent or patents at issue or an entity
10 described under subparagraphs (B) and (D) of sub-
11 section (b)(1), submit to the Patent and Trademark
12 Office the updated identification of such assignee or
13 entity.

14 “(2) FAILURE TO COMPLY.—With respect to a
15 patent for which the requirement of paragraph (1)
16 has not been met—

17 “(A) the plaintiff or subsequent owner
18 shall not be entitled to recover reasonable fees
19 and other expenses under section 285 or in-
20 creased damages under section 284 with respect
21 to infringing activities taking place during any
22 period of noncompliance with paragraph (1),
23 unless the denial of such damages or fees would
24 be manifestly unjust; and

1 “(B) the court shall award to a prevailing
2 party accused of infringement reasonable fees
3 and other expenses incurred to discover the up-
4 dated assignee or entity described under para-
5 graph (1), unless such sanctions would be un-
6 just.

7 “(e) DEFINITIONS.—In this section:

8 “(1) FINANCIAL INTEREST.—The term ‘finan-
9 cial interest’—

10 “(A) means—

11 “(i) with regard to a patent or pat-
12 ents, the right of a person to receive pro-
13 ceeds related to the assertion of the patent
14 or patents, including a fixed or variable
15 portion of such proceeds; and

16 “(ii) with regard to the plaintiff, di-
17 rect or indirect ownership or control by a
18 person of more than 5 percent of such
19 plaintiff; and

20 “(B) does not mean—

21 “(i) ownership of shares or other in-
22 terests in a mutual or common investment
23 fund, unless the owner of such interest
24 participates in the management of such
25 fund; or

1 “(ii) the proprietary interest of a pol-
2 icyholder in a mutual insurance company,
3 of a depositor in a mutual savings associa-
4 tion, or a similar proprietary interest, un-
5 less the outcome of the proceeding could
6 substantially affect the value of such inter-
7 est.

8 “(2) PROCEEDING.—The term ‘proceeding’
9 means all stages of a civil action, including pretrial
10 and trial proceedings and appellate review.

11 “(3) ULTIMATE PARENT ENTITY.—

12 “(A) IN GENERAL.—Except as provided in
13 subparagraph (B), the term ‘ultimate parent
14 entity’ has the meaning given such term in sec-
15 tion 801.1(a)(3) of title 16, Code of Federal
16 Regulations, or any successor regulation.

17 “(B) MODIFICATION OF DEFINITION.—The
18 Director may modify the definition of ‘ultimate
19 parent entity’ by regulation.”.

20 (b) TECHNICAL AND CONFORMING AMENDMENT.—

21 The item relating to section 290 in the table of sections
22 for chapter 29 of title 35, United States Code, is amended
23 to read as follows:

 “290. Notice of patent suits; disclosure of interests.”.

24 (c) REGULATIONS.—The Director may promulgate
25 such regulations as are necessary to establish a registra-

1 tion fee in an amount sufficient to recover the estimated
2 costs of administering subsections (b) through (e) of sec-
3 tion 290 of title 35, United States Code, as added by sub-
4 section (a), to facilitate the collection and maintenance of
5 the information required by such subsections, and to en-
6 sure the timely disclosure of such information to the pub-
7 lic.

8 (d) **EFFECTIVE DATE.**—The amendments made by
9 this section shall take effect upon the expiration of the
10 6-month period beginning on the date of the enactment
11 of this Act and shall apply to any action for which a com-
12 plaint is filed on or after such effective date.

13 **SEC. 5. CUSTOMER-SUIT EXCEPTION.**

14 (a) **AMENDMENT.**—Section 296 of title 35, United
15 States Code, is amended to read as follows:

16 **“§ 296. Stay of action against customer**

17 “(a) **STAY OF ACTION AGAINST CUSTOMER.**—Except
18 as provided in subsection (d), in any civil action arising
19 under any Act of Congress relating to patents, the court
20 shall grant a motion to stay at least the portion of the
21 action against a covered customer related to infringement
22 of a patent involving a covered product or process if the
23 following requirements are met:

24 “(1) The covered manufacturer and the covered
25 customer consent in writing to the stay.

1 “(2) The covered manufacturer is a party to
2 the action or to a separate action involving the same
3 patent or patents related to the same covered prod-
4 uct or process.

5 “(3) The covered customer agrees to be bound
6 by any judgment entered against the covered manu-
7 facturer to the same extent that the covered manu-
8 facturer may be bound with respect to issues that
9 the covered manufacturer and the covered customer
10 have in common.

11 “(4) The motion is filed after the first pleading
12 in the action and not later than 120 days after serv-
13 ice of the first pleading in the action that specifically
14 identifies—

15 “(A) the covered product or process as a
16 basis for the alleged infringement of the patent
17 by the covered customer; and

18 “(B) how the covered product or process is
19 alleged to infringe the patent.

20 “(b) APPLICABILITY OF STAY.—A stay issued pursu-
21 ant to subsection (a) shall apply only to the patents, prod-
22 ucts, systems, or components accused of infringement in
23 the action.

24 “(c) LIFT OF STAY.—

1 “(1) IN GENERAL.—A stay entered pursuant to
2 this section may be lifted upon grant of a motion
3 based on a showing that—

4 “(A) the action involving the covered man-
5 ufacturer will not resolve a major issue in suit
6 against the covered customer; or

7 “(B) the stay unreasonably prejudices and
8 would be manifestly unjust to the party seeking
9 to lift the stay.

10 “(2) SEPARATE MANUFACTURER ACTION IN-
11 VOLVED.—In the case of a stay entered based on the
12 participation of the covered manufacturer in a sepa-
13 rate action involving the same patent or patents re-
14 lated to the same covered product or process, a mo-
15 tion under this subsection may only be made if the
16 court in such separate action determines the show-
17 ing required under paragraph (1) has been met.

18 “(d) EXEMPTION.—This section shall not apply to an
19 action that includes a cause of action described under sec-
20 tion 271(e).

21 “(e) RULE OF CONSTRUCTION.—Nothing in this sec-
22 tion shall be construed to limit the ability of a court to
23 grant any stay, or expand any stay granted pursuant to
24 this section, if otherwise permitted by law.

25 “(f) DEFINITIONS.—In this section:

1 “(1) COVERED CUSTOMER.—The term ‘covered
2 customer’ means a party accused of infringing a pat-
3 ent or patents in dispute based on a covered product
4 or process.

5 “(2) COVERED MANUFACTURER.—The term
6 ‘covered manufacturer’ means a person that manu-
7 factures or supplies, or causes the manufacture or
8 supply of, a covered product or process or a relevant
9 part of such product or process.

10 “(3) COVERED PRODUCT OR PROCESS.—The
11 term ‘covered product or process’ means a product,
12 process, system, service, component, material, or ap-
13 paratus, or relevant part thereof, that—

14 “(A) is alleged to infringe the patent or
15 patents in dispute; or

16 “(B) implements a process alleged to in-
17 fringe the patent or patents in dispute.”.

18 (b) CONFORMING AMENDMENT.—The table of sec-
19 tions for chapter 29 of title 35, United States Code, is
20 amended by striking the item relating to section 296 and
21 inserting the following:

 “296. Stay of action against customer.”.

22 (c) EFFECTIVE DATE.—The amendments made by
23 this section shall take effect on the date of the enactment
24 of this Act and shall apply to any action for which a com-
25 plaint is filed on or after that date.

1 **SEC. 6. PROCEDURES AND PRACTICES TO IMPLEMENT AND**
2 **RECOMMENDATIONS TO THE JUDICIAL CON-**
3 **FERENCE.**

4 (a) **JUDICIAL CONFERENCE RULES AND PROCE-**
5 **DURES ON DISCOVERY BURDENS AND COSTS.—**

6 (1) **RULES AND PROCEDURES.—**The Judicial
7 Conference of the United States, using existing re-
8 sources, shall develop rules and procedures to imple-
9 ment the requirements described in paragraph (2) to
10 address the asymmetries in discovery burdens and
11 costs in any civil action arising under any Act of
12 Congress relating to patents. Such rules and proce-
13 dures shall include how and when payment for docu-
14 ment discovery in addition to the discovery of core
15 documentary evidence is to occur, and what informa-
16 tion must be presented to demonstrate financial ca-
17 pacity before permitting document discovery in addi-
18 tion to the discovery of core documentary evidence.

19 (2) **RULES AND PROCEDURES TO BE CONSID-**
20 **ERED.—**The rules and procedures required under
21 paragraph (1) shall include each of the following re-
22 quirements:

23 (A) **DISCOVERY OF CORE DOCUMENTARY**
24 **EVIDENCE.—**Each party to the action is enti-
25 tled to receive core documentary evidence and
26 shall be responsible for the costs of producing

1 core documentary evidence within the posses-
2 sion or control of each such party. Each party
3 to the action may seek nondocumentary dis-
4 covery as otherwise provided in the Federal
5 Rules of Civil Procedure.

6 (B) ELECTRONIC COMMUNICATION.—If the
7 parties determine that the discovery of elec-
8 tronic communication is necessary, such dis-
9 covery shall occur after the parties have ex-
10 changed initial disclosures and core documen-
11 tary evidence and shall be in accordance with
12 the following:

13 (i) Any request for the production of
14 electronic communication shall be specific
15 and may not be a general request for the
16 production of information relating to a
17 product or business.

18 (ii) Each request shall identify the
19 custodian of the information requested, the
20 search terms, and a time frame. The par-
21 ties shall cooperate to identify the proper
22 custodians, the proper search terms, and
23 the proper time frame.

24 (iii) A party may not submit produc-
25 tion requests to more than 5 custodians,

1 unless the parties jointly agree to modify
2 the number of production requests without
3 leave of the court.

4 (iv) The court may consider contested
5 requests for up to 5 additional custodians
6 per producing party, upon a showing of a
7 distinct need based on the size, complexity,
8 and issues of the case.

9 (v) If a party requests the discovery
10 of electronic communication for additional
11 custodians beyond the limits agreed to by
12 the parties or granted by the court, the re-
13 questing party shall bear all reasonable
14 costs caused by such additional discovery.

15 (C) ADDITIONAL DOCUMENT DISCOVERY.—

16 (i) IN GENERAL.—Each party to the
17 action may seek any additional document
18 discovery otherwise permitted under the
19 Federal Rules of Civil Procedure, if such
20 party bears the reasonable costs, including
21 reasonable attorney's fees, of the additional
22 document discovery.

23 (ii) REQUIREMENTS FOR ADDITIONAL
24 DOCUMENT DISCOVERY.—Unless the par-
25 ties mutually agree otherwise, no party

1 may be permitted additional document dis-
2 covery unless such a party posts a bond, or
3 provides other security, in an amount suffi-
4 cient to cover the expected costs of such
5 additional document discovery, or makes a
6 showing to the court that such party has
7 the financial capacity to pay the costs of
8 such additional document discovery.

9 (iii) LIMITS ON ADDITIONAL DOCU-
10 MENT DISCOVERY.—A court, upon motion,
11 may determine that a request for addi-
12 tional document discovery is excessive, ir-
13 relevant, or otherwise abusive and may set
14 limits on such additional document dis-
15 covery.

16 (iv) GOOD CAUSE MODIFICATION.—A
17 court, upon motion and for good cause
18 shown, may modify the requirements of
19 subparagraphs (A) and (B) and any defini-
20 tion under paragraph (3). Not later than
21 30 days after the pretrial conference under
22 Rule 16 of the Federal Rules of Civil Pro-
23 cedure, the parties shall jointly submit any
24 proposed modifications of the requirements
25 of subparagraphs (A) and (B) and any def-

1 inception under paragraph (3), unless the
2 parties do not agree, in which case each
3 party shall submit any proposed modifica-
4 tion of such party and a summary of the
5 disagreement over the modification.

6 (v) COMPUTER CODE.—A court, upon
7 motion and for good cause shown, may de-
8 termine that computer code should be in-
9 cluded in the discovery of core documen-
10 tary evidence. The discovery of computer
11 code shall occur after the parties have ex-
12 changed initial disclosures and other core
13 documentary evidence.

14 (D) DISCOVERY SEQUENCE AND SCOPE.—
15 The parties shall discuss and address in the
16 written report filed pursuant to Rule 26(f) of
17 the Federal Rules of Civil Procedure the views
18 and proposals of each party on the following:

19 (i) When the discovery of core docu-
20 mentary evidence should be completed.

21 (ii) Whether additional document dis-
22 covery will be sought under subparagraph
23 (C).

24 (iii) Any issues about infringement,
25 invalidity, or damages that, if resolved be-

1 fore the additional discovery described in
2 subparagraph (C) commences, might sim-
3 plify or streamline the case, including the
4 identification of any terms or phrases re-
5 lating to any patent claim at issue to be
6 construed by the court and whether the
7 early construction of any of those terms or
8 phrases would be helpful.

9 (3) DEFINITIONS.—In this subsection:

10 (A) CORE DOCUMENTARY EVIDENCE.—In
11 this subsection, the term “core documentary
12 evidence”—

13 (i) includes—

14 (I) documents relating to the
15 conception of, reduction to practice of,
16 and application for, the patent or pat-
17 ents at issue;

18 (II) documents sufficient to show
19 the technical operation of the product
20 or process identified in the complaint
21 as infringing the patent or patents at
22 issue;

23 (III) documents relating to po-
24 tentially invalidating prior art;

1 (IV) documents relating to any
2 licensing of, or other transfer of rights
3 to, the patent or patents at issue be-
4 fore the date on which the complaint
5 is filed;

6 (V) documents sufficient to show
7 profit attributable to the claimed in-
8 vention of the patent or patents at
9 issue;

10 (VI) documents relating to any
11 knowledge by the accused infringer of
12 the patent or patents at issue before
13 the date on which the complaint is
14 filed;

15 (VII) documents relating to any
16 knowledge by the patentee of infringe-
17 ment of the patent or patents at issue
18 before the date on which the com-
19 plaint is filed;

20 (VIII) documents relating to any
21 licensing term or pricing commitment
22 to which the patent or patents may be
23 subject through any agency or stand-
24 ard-setting body; and

1 (IX) documents sufficient to
2 show any marking or other notice pro-
3 vided of the patent or patents at
4 issue; and

5 (ii) does not include computer code,
6 except as specified in paragraph (2)(C)(v).

7 (B) ELECTRONIC COMMUNICATION.—The
8 term “electronic communication” means any
9 form of electronic communication, including
10 email, text message, or instant message.

11 (4) IMPLEMENTATION BY THE DISTRICT
12 COURTS.—Not later than 6 months after the date on
13 which the Judicial Conference has developed the
14 rules and procedures required by this subsection,
15 each United States district court and the United
16 States Court of Federal Claims shall revise the ap-
17 plicable local rules for such court to implement such
18 rules and procedures.

19 (5) AUTHORITY FOR JUDICIAL CONFERENCE TO
20 REVIEW AND MODIFY.—The Judicial Conference
21 shall study the efficacy of the rules and procedures
22 required by this subsection during the first 4 years
23 following the implementation of such rules and pro-
24 cedures by the district courts and the United States
25 Court of Federal Claims. The Judicial Conference

1 may modify such rules and procedures following
2 such 4-year period.

3 (b) JUDICIAL CONFERENCE PATENT CASE MANAGE-
4 MENT.—The Judicial Conference of the United States,
5 using existing resources, shall develop case management
6 procedures to be implemented by the United States dis-
7 trict courts and the United States Court of Federal Claims
8 for any civil action arising under any Act of Congress re-
9 lating to patents, including initial disclosure and early case
10 management conference practices that—

11 (1) will identify any potential dispositive issues
12 of the case; and

13 (2) focus on early summary judgment motions
14 when resolution of issues may lead to expedited dis-
15 position of the case.

16 (c) REVISION OF FORM FOR PATENT INFRINGE-
17 MENT.—

18 (1) ELIMINATION OF FORM.—The Supreme
19 Court, using existing resources, shall eliminate Form
20 18 in the Appendix to the Federal Rules of Civil
21 Procedure (relating to Complaint for Patent In-
22 fringement), effective on the date of the enactment
23 of this Act.

24 (2) REVISED FORM.—The Supreme Court may
25 prescribe a new form or forms setting out model al-

1 legations of patent infringement that, at a minimum,
2 notify accused infringers of the asserted claim or
3 claims, the products or services accused of infringe-
4 ment, and the plaintiff's theory for how each ac-
5 cused product or service meets each limitation of
6 each asserted claim. The Judicial Conference should
7 exercise the authority under section 2073 of title 28,
8 United States Code, to make recommendations with
9 respect to such new form or forms.

10 (d) PROTECTION OF INTELLECTUAL-PROPERTY LI-
11 CENSES IN BANKRUPTCY.—

12 (1) IN GENERAL.—Section 1520(a) of title 11,
13 United States Code, is amended—

14 (A) in paragraph (3), by striking “; and”
15 and inserting a semicolon;

16 (B) in paragraph (4), by striking the pe-
17 riod at the end and inserting “; and”; and

18 (C) by inserting at the end the following
19 new paragraph:

20 “(5) section 365(n) applies to intellectual prop-
21 erty of which the debtor is a licensor or which the
22 debtor has transferred.”.

23 (2) EFFECTIVE DATE.—The amendments made
24 by this subsection shall take effect on the date of the
25 enactment of this Act and shall apply to any action

1 for which a complaint is pending on, or filed on or
2 after, such date of enactment.

3 **SEC. 7. SMALL BUSINESS EDUCATION, OUTREACH, AND IN-**
4 **FORMATION ACCESS.**

5 (a) SMALL BUSINESS EDUCATION AND OUT-
6 REACH.—

7 (1) RESOURCES FOR SMALL BUSINESS.—Using
8 existing resources, the Director shall develop edu-
9 cational resources for small businesses to address
10 concerns arising from patent infringement.

11 (2) SMALL BUSINESS PATENT OMBUDSMAN.—
12 The Patent Ombudsman Program established under
13 section 28 of the Leahy-Smith America Invents Act
14 (Public Law 112–29; 125 Stat. 339; 35 U.S.C. 2
15 note) shall coordinate with the existing small busi-
16 ness outreach programs of the Office to provide edu-
17 cation and awareness on abusive patent litigation
18 practices.

19 (b) IMPROVING INFORMATION TRANSPARENCY FOR
20 SMALL BUSINESS AND THE UNITED STATES PATENT AND
21 TRADEMARK OFFICE USERS.—

22 (1) WEB SITE.—Using existing resources, the
23 Director shall create a user-friendly section on the
24 official Web site of the Office to notify the public
25 when a patent case is brought in Federal court and

1 with respect to each patent at issue in such case, the
2 Director shall include—

3 (A) information disclosed pursuant to sub-
4 sections (b) and (d) of section 290 of title 35,
5 United States Code, as added by section 4(a) of
6 this Act; and

7 (B) any other information the Director de-
8 termines to be relevant.

9 (2) **FORMAT.**—In order to promote accessibility
10 for the public, the information described in para-
11 graph (1) shall be searchable by patent number, pat-
12 ent art area, and entity.

13 **SEC. 8. STUDIES ON PATENT TRANSACTIONS, QUALITY,**
14 **AND EXAMINATION.**

15 (a) **STUDY ON SECONDARY MARKET OVERSIGHT FOR**
16 **PATENT TRANSACTIONS TO PROMOTE TRANSPARENCY**
17 **AND ETHICAL BUSINESS PRACTICES.**—

18 (1) **STUDY REQUIRED.**—The Director, in con-
19 sultation with the Secretary of Commerce, the Sec-
20 retary of the Treasury, the Chairman of the Securi-
21 ties and Exchange Commission, the heads of other
22 relevant agencies, and interested parties, shall, using
23 existing resources of the Office, conduct a study—

24 (A) to develop legislative recommendations
25 to ensure greater transparency and account-

1 ability in patent transactions occurring on the
2 secondary market;

3 (B) to examine the economic impact that
4 the patent secondary market has on the United
5 States;

6 (C) to examine licensing and other over-
7 sight requirements that may be placed on the
8 patent secondary market, including on the par-
9 ticipants in such markets, to ensure that the
10 market is a level playing field and that brokers
11 in the market have the requisite expertise and
12 adhere to ethical business practices; and

13 (D) to examine the requirements placed on
14 other markets.

15 (2) SUBMISSION OF STUDY.—Not later than 1
16 year after the date of the enactment of this Act, the
17 Director shall submit a report to the Committee on
18 the Judiciary of the House of Representatives and
19 the Committee on the Judiciary of the Senate on the
20 findings and recommendations of the Director from
21 the study required under paragraph (1).

22 (b) STUDY ON PATENTS OWNED BY THE UNITED
23 STATES GOVERNMENT.—

24 (1) STUDY REQUIRED.—The Director, in con-
25 sultation with the heads of relevant agencies and in-

1 terested parties, shall, using existing resources of the
2 Office, conduct a study on patents owned by the
3 United States Government that—

4 (A) examines how such patents are li-
5 censed and sold, and any litigation relating to
6 the licensing or sale of such patents;

7 (B) provides legislative and administrative
8 recommendations on whether there should be
9 restrictions placed on patents acquired from the
10 United States Government;

11 (C) examines whether or not each relevant
12 agency maintains adequate records on the pat-
13 ents owned by such agency, specifically whether
14 such agency addresses licensing, assignment,
15 and Government grants for technology related
16 to such patents; and

17 (D) provides recommendations to ensure
18 that each relevant agency has an adequate
19 point of contact that is responsible for man-
20 aging the patent portfolio of the agency.

21 (2) REPORT ON STUDY.—Not later than 6
22 months after the date of the enactment of this Act,
23 the Director shall submit to the Committee on the
24 Judiciary of the House of Representatives and the
25 Committee on the Judiciary of the Senate a report

1 on the findings and recommendations of the Director
2 from the study required under paragraph (1).

3 (c) STUDY ON PATENT QUALITY AND ACCESS TO
4 THE BEST INFORMATION DURING EXAMINATION.—

5 (1) GAO STUDY.—The Comptroller General of
6 the United States shall conduct a study on patent
7 examination at the Office and the technologies avail-
8 able to improve examination and improve patent
9 quality.

10 (2) CONTENTS OF THE STUDY.—The study re-
11 quired under paragraph (1) shall include the fol-
12 lowing:

13 (A) An examination of patent quality at
14 the Office.

15 (B) An examination of ways to improve
16 quality, specifically through technology, that
17 shall include examining best practices at foreign
18 patent offices and the use of existing off-the-
19 shelf technologies to improve patent examina-
20 tion.

21 (C) A description of how patents are clas-
22 sified.

23 (D) An examination of procedures in place
24 to prevent double patenting through filing by
25 applicants in multiple art areas.

1 (E) An examination of the types of off-the-
2 shelf prior art databases and search software
3 used by foreign patent offices and governments,
4 particularly in Europe and Asia, and whether
5 those databases and search tools could be used
6 by the Office to improve patent examination.

7 (F) An examination of any other areas the
8 Comptroller General determines to be relevant.

9 (3) REPORT TO CONGRESS.—Not later than 6
10 months after the date of the enactment of this Act,
11 the Comptroller General shall submit to the Com-
12 mittee on the Judiciary of the House of Representa-
13 tives and the Committee on the Judiciary of the
14 Senate a report on the findings and recommenda-
15 tions from the study required by this subsection, in-
16 cluding recommendations for any changes to laws
17 and regulations that will improve the examination of
18 patent applications and patent quality.

19 **SEC. 9. IMPROVEMENTS AND TECHNICAL CORRECTIONS TO**
20 **THE LEAHY-SMITH AMERICA INVENTS ACT.**

21 (a) REPEAL OF CIVIL ACTION TO OBTAIN A PAT-
22 ENT.—

23 (1) REPEAL.—Section 145 of title 35, United
24 States Code, is repealed.

25 (2) CONFORMING AMENDMENTS.—

1 (A) FEDERAL CIRCUIT JURISDICTION.—
2 Section 1295(a)(4) of title 28, United States
3 Code, is amended—

4 (i) in subparagraph (A), by striking
5 “except that an applicant or a party” and
6 all that follows through the end of the sub-
7 paragraph and inserting the following: “ex-
8 cept that a party to a derivation pro-
9 ceeding may also have remedy by civil ac-
10 tion pursuant to section 146 of title 35; an
11 appeal under this subparagraph of a deci-
12 sion of the Board with respect to a deriva-
13 tion proceeding shall waive the right of
14 such party to proceed under section 146 of
15 title 35;”; and

16 (ii) in subparagraph (C), by striking
17 “section 145, 146, or” and inserting “sec-
18 tion 146 or”.

19 (B) FEDERAL CIRCUIT APPEAL.—Section
20 141(a) of title 35, United States Code, is
21 amended—

22 (i) by striking “may appeal the
23 Board’s decision to” and inserting “may
24 appeal the Board’s decision only to”; and

25 (ii) by striking the second sentence.

1 (C) ADJUSTMENT OF PATENT TERM.—Sec-
2 tion 154(b)(1)(A)(iii) of title 35, United States
3 Code, is amended by striking “section 141, 145,
4 or 146” and inserting “section 141 or 146”.

5 (D) CLERICAL AMENDMENT.—The table of
6 sections for chapter 13 of title 35, United
7 States Code, is amended by repealing the item
8 relating to section 145.

9 (3) EFFECTIVE DATE.—The amendments made
10 by this subsection shall apply to any proceeding in
11 which a decision is made by the Patent Trial and
12 Appeal Board on or after the date of the enactment
13 of this Act.

14 (b) POST-GRANT REVIEW AMENDMENT.—Section
15 325(e)(2) of title 35, United States Code is amended by
16 striking “or reasonably could have raised”.

17 (c) USE OF DISTRICT-COURT CLAIM CONSTRUCTION
18 IN POST-GRANT AND INTER PARTES REVIEWS.—

19 (1) INTER PARTES REVIEW.—Section 316(a) of
20 title 35, United States Code, is amended—

21 (A) in paragraph (12), by striking “; and”
22 and inserting a semicolon;

23 (B) in paragraph (13), by striking the pe-
24 riod at the end and inserting “; and”; and

1 (C) by adding at the end the following new
2 paragraph:

3 “(14) providing that for all purposes under this
4 chapter—

5 “(A) each claim of a patent shall be con-
6 strued as such claim would be in a civil action
7 to invalidate a patent under section 282(b), in-
8 cluding construing each claim of the patent in
9 accordance with the ordinary and customary
10 meaning of such claim as understood by one of
11 ordinary skill in the art and the prosecution
12 history pertaining to the patent; and

13 “(B) if a court has previously construed
14 the claim or a claim term in a civil action in
15 which the patent owner was a party, the Office
16 shall consider such claim construction.”.

17 (2) POST-GRANT REVIEW.—Section 326(a) of
18 title 35, United States Code, is amended—

19 (A) in paragraph (11), by striking “; and”
20 and inserting a semicolon;

21 (B) in paragraph (12), by striking the pe-
22 riod at the end and inserting “; and”; and

23 (C) by adding at the end the following new
24 paragraph:

1 “(13) providing that for all purposes under this
2 chapter—

3 “(A) each claim of a patent shall be con-
4 strued as such claim would be in a civil action
5 to invalidate a patent under section 282(b), in-
6 cluding construing each claim of the patent in
7 accordance with the ordinary and customary
8 meaning of such claim as understood by one of
9 ordinary skill in the art and the prosecution
10 history pertaining to the patent; and

11 “(B) if a court has previously construed
12 the claim or a claim term in a civil action in
13 which the patent owner was a party, the Office
14 shall consider such claim construction.”.

15 (3) TECHNICAL AND CONFORMING AMEND-
16 MENT.—Section 18(a)(1)(A) of the Leahy-Smith
17 America Invents Act (Public Law 112–29; 126 Stat.
18 329) is amended by striking “Section 321(c)” and
19 inserting “Sections 321(c) and 326(a)(13)”.

20 (4) EFFECTIVE DATE.—The amendments made
21 by this subsection shall take effect upon the expira-
22 tion of the 90-day period beginning on the date of
23 the enactment of this Act, and shall apply to any
24 proceeding under chapter 31 or 32 of title 35,

1 United States Code, for which the petition for review
2 is filed on or after such effective date.

3 (d) CODIFICATION OF THE DOUBLE-PATENTING
4 DOCTRINE FOR FIRST-INVENTOR-TO-FILE PATENTS.—

5 (1) AMENDMENT.—Chapter 10 of title 35,
6 United States Code, is amended by adding at the
7 end the following new section:

8 **“§ 106. Prior art in cases of double patenting**

9 “A claimed invention of a patent issued under section
10 151 (referred to as the ‘first patent’) that is not prior art
11 to a claimed invention of another patent (referred to as
12 the ‘second patent’) shall be considered prior art to the
13 claimed invention of the second patent for the purpose of
14 determining the nonobviousness of the claimed invention
15 of the second patent under section 103 if—

16 “(1) the claimed invention of the first patent
17 was effectively filed under section 102(d) on or be-
18 fore the effective filing date of the claimed invention
19 of the second patent;

20 “(2) either—

21 “(A) the first patent and second patent
22 name the same inventor; or

23 “(B) the claimed invention of the first pat-
24 ent would constitute prior art to the claimed in-
25 vention of the second patent under section

1 102(a)(2) if an exception under section
2 102(b)(2) were deemed to be inapplicable and
3 the claimed invention of the first patent was, or
4 were deemed to be, effectively filed under sec-
5 tion 102(d) before the effective filing date of
6 the claimed invention of the second patent; and

7 “(3) the patentee of the second patent has not
8 disclaimed the rights to enforce the second patent
9 independently from, and beyond the statutory term
10 of, the first patent.”.

11 (2) REGULATIONS.—The Director shall promul-
12 gate regulations setting forth the form and content
13 of any disclaimer required for a patent to be issued
14 in compliance with section 106 of title 35, United
15 States Code, as added by paragraph (1). Such regu-
16 lations shall apply to any disclaimer filed after a
17 patent has issued. A disclaimer, when filed, shall be
18 considered for the purpose of determining the valid-
19 ity of the patent under section 106 of title 35,
20 United States Code.

21 (3) CONFORMING AMENDMENT.—The table of
22 sections for chapter 10 of title 35, United States
23 Code, is amended by adding at the end the following
24 new item:

“106. Prior art in cases of double patenting.”.

1 (4) EXCLUSIVE RULE.—A patent subject to sec-
2 tion 106 of title 35, United States Code, as added
3 by paragraph (1), shall not be held invalid on any
4 nonstatutory, double-patenting ground.

5 (5) EFFECTIVE DATE.—The amendments made
6 by this subsection shall take effect on the date of the
7 enactment of this Act and shall apply to a patent or
8 patent application only if both the first and second
9 patents described in section 106 of title 35, United
10 States Code, as added by paragraph (1), are patents
11 or patent applications that are described in section
12 3(n)(1) of the Leahy-Smith America Invents Act (35
13 U.S.C. 100 note).

14 (e) COVERED BUSINESS METHOD PATENT RE-
15 VIEWS.—

16 (1) LIMITATION; REPEAL.—

17 (A) LIMITATION TO FIRST-TO-INVENT PAT-
18 ENTS.—Section 18(a)(2) of the Leahy-Smith
19 America Invents Act is amended by striking
20 “shall not apply to a patent described in section
21 6(f)(2)(A) of this Act during the period in
22 which a petition for post-grant review of that
23 patent would satisfy the requirements of section
24 321(c) of title 35, United States Code” and in-
25 serting “shall not apply to a patent that is de-

1 scribed in section 3(n)(1) of this Act (but is not
2 described in section 3(n)(2) of this Act)”.

3 (B) REPEAL OF SUNSET.—Section 18(a)
4 of the Leahy-Smith America Invents Act (35
5 U.S.C. 321 note) is amended by striking para-
6 graph (3).

7 (C) EFFECTIVE DATE.—The amendments
8 made by subparagraphs (A) and (B) shall take
9 effect on the date of the enactment of this Act.

10 (2) DEFINITION; CLARIFICATION.—

11 (A) DEFINITION.—For purposes of section
12 18(d) of the Leahy-Smith America Invents Act,
13 the words “used in the practice, administration,
14 or management of a financial product or serv-
15 ice” shall be construed consistently with the in-
16 stitution decision of the Patent Trial and Ap-
17 peal Board of the United States Patent and
18 Trademark Office in *SAP America, Inc. v.*
19 *Versata Dev. Group, Inc.*, CBM2012–00001,
20 Paper 36 (January 9, 2013).

21 (B) SCOPE OF PRIOR ART.—Section
22 18(a)(1)(C)(i) of the Leahy-Smith America In-
23 vents Act is amended by striking “section
24 102(a)” and inserting “subsection (a), (d), or
25 (e) of section 102”.

1 (C) EFFECTIVE DATE.—Subparagraph (A)
2 and the amendment made by subparagraph (B)
3 shall take effect on the date of the enactment
4 of this Act and shall apply to any proceeding
5 pending on, or filed on or after, such date of
6 enactment.

7 (3) AUTHORITY TO WAIVE FEE.—Subject to
8 available resources, the Director may waive payment
9 of a filing fee for a transitional proceeding described
10 under section 18(a) of the Leahy-Smith America In-
11 vents Act (35 U.S.C. 321 note).

12 (f) CLARIFICATION OF LIMITS ON PATENT TERM AD-
13 JUSTMENT.—

14 (1) AMENDMENTS.—Section 154(b)(1)(B) of
15 title 35, United States Code, is amended—

16 (A) in the matter preceding clause (i), by
17 striking “not including—” and inserting “the
18 term of the patent shall be extended 1 day for
19 each day after the end of that 3-year period
20 until the patent is issued, not including—”;

21 (B) in clause (i), by striking “consumed by
22 continued examination of the application re-
23 quested by the applicant” and inserting “con-
24 sumed after continued examination of the appli-
25 cation is requested by the applicant”;

1 (C) in clause (iii), by striking the comma
2 at the end and inserting a period; and

3 (D) by striking the matter following clause
4 (iii).

5 (2) EFFECTIVE DATE.—The amendments made
6 by this subsection shall apply to any patent applica-
7 tion or patent that is pending on, or filed on or
8 after, the date of the enactment of this Act.

9 (g) CLARIFICATION OF JURISDICTION.—

10 (1) IN GENERAL.—The Federal interest in pre-
11 venting inconsistent final judicial determinations as
12 to the legal force or effect of the claims in a patent
13 presents a substantial Federal issue that is impor-
14 tant to the Federal system as a whole.

15 (2) APPLICABILITY.—Paragraph (1)—

16 (A) shall apply to all cases filed on, after,
17 or pending on, the date of the enactment of this
18 Act; and

19 (B) shall not apply to a case in which a
20 Federal court has issued a ruling on whether
21 the case or a claim arises under any Act of
22 Congress relating to patents or plant variety
23 protection before the date of the enactment of
24 this Act.

25 (h) TECHNICAL CORRECTIONS.—

1 (1) NOVELTY.—

2 (A) AMENDMENT.—Section 102(b)(1)(A)
3 of title 35, United States Code, is amended by
4 striking “the inventor or joint inventor or by
5 another” and inserting “the inventor or a joint
6 inventor or another”.

7 (B) EFFECTIVE DATE.—The amendment
8 made by subparagraph (A) shall be effective as
9 if included in the amendment made by section
10 3(b)(1) of the Leahy-Smith America Invents
11 Act (Public Law No. 112–29).

12 (2) INVENTOR’S OATH OR DECLARATION.—

13 (A) AMENDMENT.—Subsection (g)(1) of
14 section 115 of title 35, United States Code, is
15 amended—

16 (i) by striking “claims the benefit”
17 and inserting “is entitled, as to each inven-
18 tion claimed in the application, to the ben-
19 efit”; and

20 (ii) in subparagraph (A), by striking
21 “meeting the requirements of subsection
22 (a) was executed by the individual and was
23 filed in connection with the earlier-filed ap-
24 plication” and inserting the following: “ex-
25 ecuted by or on behalf of the individual

1 was filed in connection with the earlier-
2 filed application and meets the require-
3 ments of this section as effective on the
4 date such oath or declaration was filed”.

5 (B) EFFECTIVE DATE.—The amendment
6 made by subparagraph (A) shall be effective as
7 if included in the amendment made by section
8 4(a)(1) of the Leahy-Smith America Invents
9 Act (Public Law No. 112–29).

10 (3) ASSIGNEE FILERS.—

11 (A) BENEFIT OF EARLIER FILING DATE;
12 RIGHT OF PRIORITY.—Section 119(e)(1) of title
13 35, United States Code, is amended, in the first
14 sentence, by striking “by an inventor or inven-
15 tors named” and inserting “that names the in-
16 ventor or a joint inventor”.

17 (B) BENEFIT OF EARLIER FILING DATE IN
18 THE UNITED STATES.—Section 120 of title 35,
19 United States Code, is amended, in the first
20 sentence, by striking “names an inventor or
21 joint inventor” and inserting “names the inven-
22 tor or a joint inventor”.

23 (C) EFFECTIVE DATE.—The amendments
24 made by this paragraph shall take effect on the
25 date of the enactment of this Act and shall

1 apply to any patent application, and any patent
2 issuing from such application, that is filed on or
3 after September 16, 2012.

4 (4) DERIVED PATENTS.—

5 (A) AMENDMENT.—Section 291(b) of title
6 35, United States Code, is amended by striking
7 “or joint inventor” and inserting “or a joint in-
8 ventor”.

9 (B) EFFECTIVE DATE.—The amendment
10 made by subparagraph (A) shall be effective as
11 if included in the amendment made by section
12 3(h)(1) of the Leahy-Smith America Invents
13 Act (Public Law No. 112–29).

14 (5) SPECIFICATION.—Notwithstanding section
15 4(e) of the Leahy-Smith America Invents Act (Pub-
16 lic Law 112–29; 125 Stat. 297), the amendments
17 made by subsections (c) and (d) of section 4 of such
18 Act shall apply to any proceeding or matter, that is
19 pending on, or filed on or after, the date of the en-
20 actment of this Act.

21 (6) PATENT OWNER RESPONSE.—

22 (A) CONDUCT OF INTER PARTES RE-
23 VIEW.—Paragraph (8) of section 316(a) of title
24 35, United States Code, is amended by striking

1 “the petition under section 313” and inserting
2 “the petition under section 311”.

3 (B) CONDUCT OF POST-GRANT REVIEW.—
4 Paragraph (8) of section 326(a) of title 35,
5 United States Code, is amended by striking
6 “the petition under section 323” and inserting
7 “the petition under section 321”.

8 (C) EFFECTIVE DATE.—The amendments
9 made by this paragraph shall take effect on the
10 date of the enactment of this Act.

11 (7) INTERNATIONAL APPLICATIONS.—

12 (A) AMENDMENTS.—Section 202(b) of the
13 Patent Law Treaties Implementation Act of
14 2012 (Public Law 112–211; 126 Stat. 1536) is
15 amended—

16 (i) by striking paragraph (7); and
17 (ii) by redesignating paragraphs (8)
18 and (9) as paragraphs (7) and (8).

19 (B) EFFECTIVE DATE.—The amendments
20 made by subparagraph (A) shall be effective as
21 if included in title II of the Patent Law Trea-
22 ties Implementation Act of 2012 (Public Law
23 112–21).

1 **SEC. 10. EFFECTIVE DATE.**

2 Except as otherwise provided in this Act, the provi-
3 sions of this Act shall take effect on the date of the enact-
4 ment of this Act, and shall apply to any patent issued,
5 or any action filed, on or after that date.

○