

116TH CONGRESS  
1ST SESSION

# H. R. 3199

To amend title 35, United States Code, to prevent double patenting, and  
for other purposes.

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## IN THE HOUSE OF REPRESENTATIVES

JUNE 11, 2019

Mr. JEFFRIES (for himself, Mr. COLLINS of Georgia, Ms. MUCARSEL-POWELL,  
and Mr. CLINE) introduced the following bill; which was referred to the  
Committee on the Judiciary

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## A BILL

To amend title 35, United States Code, to prevent double  
patenting, 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.**

4       This Act may be cited as the “Terminating the Ex-  
5       tension of Rights Misappropriated Act of 2019” or the  
6       “Term Act of 2019”.

7       **SEC. 2. PREVENTION OF DOUBLE PATENTING.**

8       (a) IN GENERAL.—Section 253 of title 35, United  
9       States Code, is amended by adding at the end the fol-  
10      lowing:

1 “(c) DISCLAIMERS OF DRUG PATENT TERM.—

2 “(1) IN GENERAL.—Except as provided in para-  
3 graph (2), in a proceeding challenging the validity of  
4 patents under section 505(c) of the Federal Food,  
5 Drug, and Cosmetic Act (21 U.S.C. 355(c)) with re-  
6 spect to a drug, under section 351(l) of the Public  
7 Health Service Act (42 U.S.C. 262(l)) with respect  
8 to a biological product, or a Federal district court  
9 proceeding involving patents that are the subject of  
10 an action under section 271(e)(2), the patentee shall  
11 be presumed to have disclaimed the patent term for  
12 each of the listed patents after the date on which the  
13 term of the first patent expires, subject to the excep-  
14 tions provided for in subsection (2).

15 “(2) DEMONSTRATION OF DISTINCT INVEN-  
16 TIONS.—If a patentee demonstrates by a preponder-  
17 ance of the evidence that certain patents described  
18 in paragraph (1) cover patentably distinct inventions  
19 from the invention claimed in the first such patent  
20 to expire, no part of the term of any such patent  
21 shall be presumed to have been disclaimed, and all  
22 patent term extensions granted by the United States  
23 Patent and Trademark Office shall be respected, un-  
24 less and to the extent the patentee expressly dis-

1 claims, in writing, the patent term for each such  
2 patent.”.

3 (b) USPTO REVIEW.—

4 (1) DEFINITIONS.—In this subsection—

5 (A) the term “Office” means the United  
6 States Patent and Trademark Office; and

7 (B) the term “Director” means the Under  
8 Secretary of Commerce for Intellectual Property  
9 and Director of the Office.

10 (2) REVIEW.—The Director shall conduct a  
11 comprehensive review of the patent examination pro-  
12 cedures of the Office to determine whether the Of-  
13 fice—

14 (A) is using best examination practices,  
15 guidance, and procedures to avoid the issuance  
16 of patents relating to the same drug, or biologi-  
17 cal product, that are not patentably distinct  
18 from one another, and not subject to an appro-  
19 priate disclaimer of patent term; and

20 (B) should develop and implement new  
21 practices, guidance, or procedures to—

22 (i) improve examination of patent ap-  
23 plications relating to the same drug or bio-  
24 logical product; and

1                   (ii) reduce the improper issuance of  
2                   patents that improperly extend the term of  
3                   exclusivity afforded a new drug or biological  
4                   product.

5           (3) REPORT.—Not later than 1 year after the  
6           date of enactment of this Act, the Director shall  
7           submit to the Committee on the Judiciary of the  
8           House of Representatives a report that contains—

9                   (A) the findings from the review conducted  
10                  under paragraph (2); and

11                  (B) any recommendations of the Director  
12                  with respect to the review conducted under  
13                  paragraph (2).

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