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(Original Signature of Member)

113TH CONGRESS  
1ST SESSION

**H. R.**

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

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IN THE HOUSE OF REPRESENTATIVES

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

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**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

1 cross-claim for patent infringement, unless the informa-  
2 tion is not reasonably accessible to such party, the fol-  
3 lowing:

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

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

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

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

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

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

24           “(5) For each accused instrumentality identi-  
25 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% of such plaintiff;  
19 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           initiation 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) WEBSITE.—Using existing resources, the  
23 Director shall create a user-friendly section on the  
24 official website 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.