

[COMMITTEE PRINT]

109TH CONGRESS  
1ST SESSION

**H. R.** \_\_\_\_\_

To amend title 35, United States Code, relating to the procurement, enforcement, and validity of patents.

IN THE HOUSE OF REPRESENTATIVES

M\_\_\_\_. \_\_\_\_\_ introduced the following bill; which was referred to the Committee on \_\_\_\_\_

**A BILL**

To amend title 35, United States Code, relating to the procurement, enforcement, and validity of patents.

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

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

4 (a) SHORT TITLE.—This Act may be cited as the  
5 “Patent Act of 2005”.

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

- Sec. 1. Short title; table of contents.
- Sec. 2. Reference to title 35, United States Code.



- Sec. 3. Right of the first inventor to file.
- Sec. 4. Right to a patent.
- Sec. 5. Duty of candor.
- Sec. 6. Right of the inventor to obtain damages.
- Sec. 7. Injunctions.
- Sec. 8. Continuation applications.
- Sec. 9. Post-grant procedures and other quality enhancements.
- Sec. 10. Combinations; components.
- Sec. 11. Effect and effective date; transitional provisions.

**1 SEC. 2. REFERENCE TO TITLE 35, UNITED STATES CODE.**

2 Whenever in this Act a section or other provision is  
3 amended or repealed, that amendment or repeal shall be  
4 considered to be made to that section or other provision  
5 of title 35, United States Code.

**6 SEC. 3. RIGHT OF THE FIRST INVENTOR TO FILE.**

7 (a) DEFINITIONS.—Section 100 is amended by add-  
8 ing at the end the following:

9 “(f) The term ‘inventor’ means the person or persons  
10 who invented the subject matter of the invention.

11 “(g) The terms ‘joint inventor’ and ‘coinventor’ mean  
12 one of the persons who invented the subject matter of the  
13 invention.

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

16 “(1) the filing date of the patent or the applica-  
17 tion for patent containing the claim; or

18 “(2) if the patent or application for patent is  
19 entitled to a right of priority of any other applica-  
20 tion under section 119 or section 365(a) or to the  
21 benefit of an earlier filing date in the United States



1 under section 120, 121, or 365(c) based upon one  
2 or more prior filed applications for patent, the filing  
3 date of the earliest such application in which the  
4 claimed invention is disclosed in the manner pro-  
5 vided by section 112.”.

6 (b) CONDITIONS FOR PATENTABILITY.—

7 (1) IN GENERAL.—Section 102 is amended to  
8 read as follows:

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

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

12 “(1)(A) the claimed invention was patented, de-  
13 scribed in a printed publication, or otherwise known  
14 more than one year before the effective filing date  
15 of the claimed invention; or

16 “(B) the claimed invention was patented, de-  
17 scribed in a printed publication, or otherwise known  
18 before the effective filing date of the claimed inven-  
19 tion, other than through disclosures made by the in-  
20 ventor or by others who obtained the subject matter  
21 disclosed directly or indirectly from the inventor; or

22 “(2) the claimed invention was described in a  
23 patent issued under section 151, or in an application  
24 for patent published under section 122(b), in a case  
25 in which the application or the patent names an-



1 other inventor and the application was effectively  
2 filed before the effective filing date of the claimed  
3 invention.

4 “(b) COMMONLY ASSIGNED INVENTION EXCEP-  
5 TION.—Subject matter developed by a person other than  
6 the inventor that would have qualified as prior art under  
7 subsection (a)(2) but not under subsection (a)(1) shall not  
8 be prior art to a claimed invention if the subject matter  
9 and the claimed invention were, not later than the effective  
10 filing date of the claimed invention, owned by the same  
11 person or subject to an obligation of assignment to the  
12 same person.

13 “(c) REASONABLE AND EFFECTIVE ACCESSIBILITY  
14 REQUIREMENT.—

15 “(1) IN GENERAL.—For the purposes of sub-  
16 section (a)(1), subject matter is known when it be-  
17 comes reasonably and effectively accessible, either  
18 through its use or through its disclosure by other  
19 means, or when it has been made inherently known  
20 from subject matter that has become reasonably and  
21 effectively accessible.

22 “(2) REASONABLY AND EFFECTIVELY ACCES-  
23 SIBLE.—In this section, subject matter is ‘reason-  
24 ably and effectively accessible’ if the subject matter  
25 can be accessed and comprehended, without resort to



1 undue efforts, by persons of ordinary skill in the art  
2 to which the subject matter pertains.

3 “(d) PATENTS AND PUBLISHED APPLICATIONS EF-  
4 FECTIVELY FILED.—A patent or application for patent is  
5 effectively filed under subsection (a)(2) with respect to any  
6 subject matter described in the patent or application—

7 “(1) as of the filing date of the patent or the  
8 application for patent; or

9 “(2) if the patent or application for patent is  
10 entitled to a right of priority of any other applica-  
11 tion under section 119 or 365(a) or to the benefit  
12 of an earlier filing date in the United States under  
13 section 120, 121, or 365(c) based upon one or more  
14 prior filed applications for patent, as of the filing  
15 date of the earliest such application in which the  
16 claimed invention is disclosed in the manner pro-  
17 vided by section 112.”.

18 (2) CONFORMING AMENDMENT.—The item re-  
19 lating to section 102 in the table of sections for  
20 chapter 10 is amended to read as follows:

“102. Conditions of patentability; novelty.”.

21 (c) CONDITIONS FOR PATENTABILITY; NON-OBVIOUS  
22 SUBJECT MATTER.—Section 103 is amended—

23 (1) by striking subsections (b) and (c); and

24 (2) in subsection (a)—



1 (A) by striking “(a) A patent may not”  
2 and inserting “A patent may not”; and

3 (B) by striking “at the time the invention  
4 was made” and inserting “on the effective filing  
5 date of the claimed invention”.

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

10 (e) REPEAL OF STATUTORY INVENTION REGISTRA-  
11 TION.—Section 157, and the item relating to that section  
12 in the table of sections for chapter 14, are repealed.

13 (f) EARLIER FILING DATE FOR INVENTOR AND  
14 JOINT INVENTOR.—Section 120 is amended by striking  
15 “which is filed by an inventor or inventors named” and  
16 inserting “which names an inventor or joint inventor”.

17 (g) CONFORMING AMENDMENTS.—

18 (1) RIGHT OF PRIORITY.—Section 172 is  
19 amended by striking “and the time specified in sec-  
20 tion 102(d)”.

21 (2) LIMITATION ON REMEDIES.—Section  
22 287(c)(4) is amended by striking “the earliest effec-  
23 tive filing date of which is prior to” and inserting  
24 “which has an effective filing date before”



1           (3) INTERNATIONAL APPLICATION DESIG-  
2           NATING THE UNITED STATES: EFFECT.—Section  
3           363 is amended by striking “except as otherwise  
4           provided in section 102(e) of this title”.

5           (4) PUBLICATION OF INTERNATIONAL APPLICA-  
6           TION: EFFECT.—The first paragraph of section 374  
7           is amended by striking “sections 102(e) and 154(d)”  
8           and inserting “section 154(d)”.

9           (5) PATENT ISSUED ON INTERNATIONAL APPLI-  
10          CATION: EFFECT.—The second sentence of section  
11          375(a) is amended by striking “Subject to section  
12          102(e) of this title, such” and inserting “Such”.

13          (h) REPEAL OF INTERFERING PATENT REMEDIES.—  
14          Section 291, and the item relating to that section in the  
15          table of sections for chapter 29, are repealed.

16          (i) INTERFERENCES.—Section 135(a) is amended to  
17          read as follows:

18          “(a) DISPUTE OVER INVENTOR.—

19                 “(1) INSTITUTION OF INTERFERENCE.—When-  
20                 ever a patent or an application for a patent is  
21                 deemed by the Director to interfere with another  
22                 patent or application for patent because of a dispute  
23                 over who is the inventor under section 101, the Di-  
24                 rector shall institute an interference for the purpose  
25                 of determining the right to patent.



1           “(2) DETERMINATION BY BOARD OF PATENT  
2 APPEALS AND INTERFERENCES.—The Board of Pat-  
3 ent Appeals and Interferences—

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

6           “(B) in appropriate circumstances, may  
7 correct the naming of the inventor in any in-  
8 volved application or patent; and

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

11           “(3) EFFECT OF FINAL DECISION.—The final  
12 decision of the Board of Patent Appeals and Inter-  
13 ferences under paragraph (2), if adverse to the claim  
14 of an applicant, shall constitute the final refusal by  
15 the Patent and Trademark Office on the claims in-  
16 volved. The Director may issue a patent to an appli-  
17 cant who is adjudged to have the right to patent.  
18 The final decision of the Board, if adverse to a pat-  
19 entee, shall, if no appeal or other review of the deci-  
20 sion has been or can be taken or had, constitute can-  
21 cellation of the claims involved in the patent, and  
22 notice of such cancellation shall be endorsed on cop-  
23 ies of the patent distributed after such cancellation  
24 by the Patent and Trademark Office.”.





1 **SEC. 4. RIGHT TO A PATENT.**

2 (a) RIGHT TO PATENT.—

3 (1) IN GENERAL.—Section 101 is amended to  
4 read as follows:

5 **“§ 101. Right to patent; subject matter eligible for**  
6 **patenting**

7 “The inventor of any new and useful process, ma-  
8 chine, manufacture, or composition of matter, or any new  
9 and useful improvement thereof, has the right to apply  
10 for and to obtain a patent for the invention, subject to  
11 the conditions and requirements of this title.”.

12 (2) CONFORMING AMENDMENT.—The item re-  
13 lating to section 101 in the table of sections for  
14 chapter 10 is amended to read as follows:

“101. Right to patent; subject matter eligible for patenting.”.

15 (b) OATH OF APPLICANT.—Section 115 is amended  
16 to read as follows:

17 **“§ 115. Oath of applicant**

18 “The Director may require the applicant to make an  
19 oath setting forth particulars relating to the inventor and  
20 the invention.”.

21 (c) FILING BY OTHER THAN INVENTOR.—Section  
22 118 is amended to read as follows:

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

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



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

11 (d) SPECIFICATION.—Section 112 is amended—

12 (1) in the first paragraph, by striking “, and  
13 shall set forth the best mode contemplated by the in-  
14 ventor of carrying out his invention”; and

15 (2) in the second paragraph, by striking “appli-  
16 cant regards as his invention” and inserting “inven-  
17 tor or a joint inventor regards as the invention”.

18 **SEC. 5. DUTY OF CANDOR.**

19 (a) IN GENERAL.—Chapter 12 of title 35, United  
20 States Code, is amended by adding at the end the fol-  
21 lowing:

22 **“§ 136. Duty of candor: patents and applications for**  
23 **patent**

24 “(a) DUTY.—The Director shall by regulation impose  
25 a duty of candor and good faith on individuals associated



1 with the filing and prosecution of an application for patent  
2 and on individuals assisting a patent owner in proceedings  
3 before the Office involving a patent. The duty shall require  
4 each such individual to timely disclose information known  
5 to that individual to be material to any issue before the  
6 Office in connection with the application or patent, and  
7 to not materially misrepresent information. The duty may  
8 further address the types of information for which disclo-  
9 sure is required and the standards upon which a finding  
10 of misrepresentation or concealment on the part of such  
11 individuals could be based. Any allegation of any type of  
12 violation of the duty of candor and good faith under this  
13 subsection shall be governed exclusively by this chapter.

14 “(b) VIOLATION.—Any individual who is subject to  
15 the duty of candor and good faith under subsection (a)  
16 and who, with the intent to deceive or mislead, knowingly  
17 fails to disclose material information or knowingly and  
18 materially misrepresents information has engaged in mis-  
19 conduct under this section, if the Director finds, by clear  
20 and convincing evidence, that—

21 “(1) the individual failed to disclose information  
22 or misrepresented information;

23 “(2) the information not disclosed was material  
24 or, in the case of a misrepresentation, the misrepre-  
25 sentation was material;



1           “(3) the individual had knowledge of the mate-  
2           riality of the information not disclosed or, in the  
3           case of a misrepresentation, of the misrepresentation  
4           and materiality of the misrepresentation; and

5           “(4) the individual had the intent to deceive or  
6           mislead.

7           “(c) ADJUDICATION BY THE OFFICE.—

8           “(1) OTHER FORA PRECLUDED.—No court or  
9           Federal department or agency other than the Office,  
10          and no other Federal or State governmental entity,  
11          may investigate or make a determination or an adju-  
12          dication with respect to an alleged violation of the  
13          duty of candor and good faith under subsection (a)  
14          or with respect to an alleged fraud, inequitable con-  
15          duct, or other misconduct in any proceeding before  
16          the Office involving a patent or in connection with  
17          the filing or examination of an application for pat-  
18          ent, except as expressly permitted in this section.

19          “(2) EXCEPTION REGARDING PENDING APPLI-  
20          CATIONS.—Nothing in this subsection shall limit the  
21          authority of the Director to enforce regulations con-  
22          cerning pending applications for patent, including  
23          regulations relating to misconduct.

24          “(3) LIMITATION ON DEFENSES TO ENFORCE-  
25          MENT OF PATENT.— No defense of invalidity of a



1 patent or other defense to the enforcement of a pat-  
2 ent may be based in whole or in part upon a viola-  
3 tion of the duty of candor and good faith under sub-  
4 section (a) or on any fraud, inequitable conduct, or  
5 other misconduct, except as expressly permitted in  
6 this section.

7 “(4) REFERRAL BY COURT.—In any matter be-  
8 fore a court involving an issue of validity or infringe-  
9 ment of a patent, if the court determines that an  
10 issue of possible misconduct under subsection (b) ex-  
11 ists, the court shall refer the matter to the Office for  
12 investigation and sanctions under this section. If  
13 such referral is made, the matter shall be resolved  
14 as provided in this section.

15 “(d) UNENFORCEABILITY ACTION.—

16 “(1) IN GENERAL.—A patent may be held un-  
17 enforceable if a court determines, pursuant to a  
18 pleading permitted under paragraph (2), that—

19 “(A) misconduct under subsection (b) con-  
20 stitutes fraud by reason of reliance by the Of-  
21 fice on the misconduct which has resulted in the  
22 issuance of, or a certificate affirming patent-  
23 ability of, one or more invalid claims in a pat-  
24 ent; and



1           “(B) the fraud is attributable to the patent  
2           owner.

3           “(2) REQUIRED MOTION TO PLEAD UNEN-  
4           FORCEABILITY.—The defense of unenforceability de-  
5           scribed in paragraph (1) may be pled in an action  
6           before a court only upon a motion to amend the  
7           pleadings in the action. The court shall not grant  
8           the motion unless—

9           “(A) the validity of one or more claims in  
10          the patent is at issue in the action;

11          “(B) the court has previously entered a  
12          judgment in the action that a claim in the pat-  
13          ent is invalid;

14          “(C) the motion to amend the pleadings is  
15          brought by a party to the action adverse to the  
16          patent owner within 3 months after a judgment  
17          is entered by the court invalidating the claim;  
18          and

19          “(D) the motion sets out with particularity  
20          a substantial basis for findings that—

21                 “(i) because of the reliance of the Of-  
22                 fice on the misconduct, fraud took place in  
23                 a proceeding before the Office involving the  
24                 patent or in connection with the filing or  
25                 examination of the application for patent,



1 and as a result at least 1 claim in the pat-  
2 ent invalidated in the action was issued as  
3 a result of the reliance on the misconduct;  
4 and

5 “(ii) the alleged fraud is attributable  
6 to the patent owner.

7 “(3) REQUIRED FINDINGS FOR UNENFORCE-  
8 ABILITY.—

9 “(A) LIABILITY OF PATENT OWNER.—In  
10 determining the unenforceability of a patent, no  
11 misconduct under subsection (b) by an indi-  
12 vidual registered to practice before the Office  
13 and acting in a representative capacity before  
14 the Office in a proceeding before the Office in-  
15 volving the patent or in connection with the fil-  
16 ing or examination of the application for patent  
17 shall be attributable to the patent owner unless  
18 the patent owner, or another individual who—

19 “(i) is subject to the duty of candor  
20 and good faith with respect to the patent,

21 “(ii) is not registered to practice be-  
22 fore the Office, and

23 “(iii) was acting on the patent owner’s  
24 behalf,



1 is determined to have been participated in the  
2 misconduct constituting the fraud.

3 “(B) RELIANCE OF THE PATENT EXAM-  
4 INER.—No misconduct may be determined to  
5 constitute fraud sufficient to support a finding  
6 that a patent is unenforceable without clear and  
7 convincing evidence of reliance of the Office on  
8 the alleged misconduct, resulting in the  
9 issuance of a claim invalidated by the court be-  
10 cause a competent patent examiner either—

11 “(i) would not have issued the invali-  
12 dated claim, acting reasonably, in the ab-  
13 sence of the misconduct; or

14 “(ii) based upon the prosecution his-  
15 tory as a whole objectively considered,  
16 would have done so based upon in whole or  
17 in part on account of the misconduct.

18 “(e) REFERRAL OF MISCONDUCT ISSUES.—

19 “(1) IN GENERAL.—The Director shall establish  
20 a special office with authority to investigate possible  
21 violations of the duty of candor and good faith, in-  
22 cluding possible misconduct, in a proceeding before  
23 the Office involving a patent or in connection with  
24 the filing or examination of an application for pat-  
25 ent, in cases in which such matters are referred to



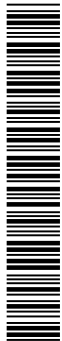


1 the Office for investigation under subsection (c)(4).  
2 The special office shall commence an investigation  
3 into possible violations of the duty following such re-  
4 ferral. After such an investigation is begun, any sub-  
5 sequent decision to maintain the investigation or  
6 abandon the investigation may be made only by the  
7 Director, and such decision may not be appealed or  
8 reviewed.

9 “(2) PROCEDURES.—

10 “(A) SUBPOENAS.—During the period in  
11 which a misconduct investigation is conducted  
12 under paragraph (1), the matter shall be a con-  
13 tested case in the Office and the Director may  
14 seek evidence or other information through sub-  
15 poenas under section 24.

16 “(B) NOTICE; SUBJECT PARTIES.—The  
17 Director shall provide written notice to the pat-  
18 ent owner of the commencement of the inves-  
19 tigation and may provide such written notice to  
20 persons who were owners of the patent or appli-  
21 cation for patent (or persons to whom the pat-  
22 ent or application for patent was subject to an  
23 obligation of assignment) at the time the con-  
24 duct that is the subject of the investigation oc-  
25 curred. Any person receiving written notice



1 under this subparagraph shall be designated as  
2 a ‘subject party.’ The Director shall provide  
3 written notice under this subparagraph of an  
4 investigation before seeking any evidence under  
5 section 24, but otherwise at such time as the  
6 Director shall determine. Upon providing such  
7 written notice to the subject parties, the Direc-  
8 tor shall publish a notice of the commencement  
9 of the investigation in the Federal Register.

10 “(C) OBTAINING EVIDENCE.—Upon re-  
11 quest of a subject party, the Director shall de-  
12 termine the manner in which to allow a subject  
13 party to obtain evidence of potential relevance,  
14 including by authorizing the subject party to  
15 seek subpoenas under section 24.

16 “(D) PRELIMINARY DETERMINATION.—  
17 The Director, at the earliest practicable time  
18 after the date on which notice of the investiga-  
19 tion is published under subparagraph (B), shall  
20 conclude the investigation and make a prelimi-  
21 nary determination on the issues under inves-  
22 tigation. The Director shall, within 45 days  
23 after an investigation is begun, establish a tar-  
24 get date for rendering a preliminary determina-  
25 tion.



1           “(E) CONSULTATION WITH OTHER DE-  
2 PARTMENTS AND AGENCIES.—During the  
3 course of each investigation under this section  
4 and section 137, the Director may consult with,  
5 seek advice and information from, and other-  
6 wise obtain assistance from the Attorney Gen-  
7 eral, the Federal Trade Commission, the Inter-  
8 national Trade Commission, the Securities and  
9 Exchange Commission, and the heads of such  
10 other departments and agencies as the Director  
11 considers appropriate.

12           “(3) NOTICE OF DETERMINATION.—

13           “(A) IF NO MISCONDUCT FOUND.—If the  
14 Director determines in an investigation under  
15 paragraph (2) that there is no basis for con-  
16 cluding that misconduct under subsection (b)  
17 has occurred, the Director shall provide written  
18 notice of such determination to each of the sub-  
19 ject parties not later than 1 month after the  
20 conclusion of the investigation. A determination  
21 of the Director under this subparagraph is final  
22 and may not be appealed.

23           “(B) IF MISCONDUCT MAY HAVE OC-  
24 CURRED.—If the Director makes a preliminary  
25 determination in an investigation under para-



1 graph (2) that misconduct under subsection (b)  
2 may have occurred, the Director shall provide  
3 written notice of the preliminary determination  
4 to each of the subject parties not later than 1  
5 month after the conclusion of the investigation.  
6 Such written notice shall provide a description  
7 with particularity of the separate acts alleged to  
8 constitute such possible misconduct. The Direc-  
9 tor shall afford the subject parties an oppor-  
10 tunity to respond to the preliminary determina-  
11 tion and a period of time within which to reach  
12 a settlement of the issue before taking any fur-  
13 ther action.

14 “(4) FINAL DETERMINATION; APPEAL TO  
15 BOARD.—

16 “(A) IN GENERAL.—If a matter relating to  
17 possible misconduct is not settled under para-  
18 graph (3), the preliminary determination shall  
19 become final and may not be appealed unless 1  
20 or more of the subject parties contests the pre-  
21 liminary determination by requesting a hearing  
22 on the matter, within 60 days after the end of  
23 the settlement period provided under paragraph  
24 (3)(B), before a panel of the Board of Patent  
25 Appeals and Interferences.



1           “(B) HEARING.—If a hearing is timely re-  
2           quested under subparagraph (A), the hearing  
3           shall provide the Director and the patent owner  
4           an opportunity to present evidence and argu-  
5           ments.

6           “(C) DETERMINATION OF PANEL.—The  
7           panel shall, not later than one year after the  
8           date of the request by 1 or more of the subject  
9           parties for a hearing under subparagraph (B),  
10          issue a written determination containing find-  
11          ings of facts and conclusions of law on the mat-  
12          ters before it. If the written determination by  
13          the panel concludes that one or more alleged  
14          violations of the duty of candor and good faith  
15          do not constitute acts of misconduct, then the  
16          determination is final with respect to such  
17          issues of possible misconduct and may not be  
18          appealed, and no penalty shall be imposed with  
19          respect to such issues. If the written determina-  
20          tion by the panel concludes that one or more al-  
21          leged violations of the duty of candor and good  
22          faith do constitute acts of misconduct, then the  
23          decision of the panel shall represent a final de-  
24          termination of the Office on the matters in-  
25          volved.



1           “(5) NOTICE OF FINAL DETERMINATION.—If a  
2 matter of possible misconduct is not settled or other-  
3 wise terminated following the opportunity for settle-  
4 ment and hearing under paragraphs (3) and (4), the  
5 Director shall notify the subject parties in writing of  
6 the final determination on the matter under para-  
7 graph (4), setting forth—

8           “(A) the factual findings of the investiga-  
9 tion;

10           “(B) the legal conclusions reached;

11           “(C) a description of each separate act of  
12 misconduct determined to have taken place;

13           “(D) the amount of any civil monetary  
14 penalty imposed against the subject parties  
15 under paragraph (6); and

16           “(E) a deadline for payment of any penalty  
17 imposed, which may not be earlier than 6  
18 months after the date on which the notice is  
19 provided to the patent owner under this para-  
20 graph of the final determination.


21           “(6) PENALTY AMOUNT.—

22           “(A) IN GENERAL.—Subject to the limita-  
23 tions of this paragraph, the Director may im-  
24 pose civil monetary penalties on each subject  
25 party for each act of misconduct of which notice



1 is given under paragraph (5), in amounts that  
2 the Director considers sufficient in the Direc-  
3 tor's discretion to act as a deterrent to future  
4 such violations of the duty of candor and good  
5 faith under this section, taking into account the  
6 totality of the circumstances in each individual  
7 case.

8 “(B) LIMITATION ON AMOUNT.—The  
9 amount of a civil penalty imposed under sub-  
10 paragraph (A) may not exceed \$1,000,000 for  
11 each separate act of misconduct, except that in  
12 a case in which the violation of the duty of can-  
13 dor and good faith is found to be the result of  
14 fraudulent or other particularly egregious mis-  
15 conduct, the penalty imposed may not exceed  
16 \$5,000,000 for such act of misconduct. In an  
17 exceptional case, the Director may impose an  
18 additional penalty in an amount equal to the  
19 costs incurred by the Director in conducting the  
20 investigation.



21 “(C) LIMITATION ON PARTIES ON WHICH  
22 PENALTIES MAY BE IMPOSED.—No penalty  
23 based upon an act of misconduct may be im-  
24 posed under subparagraph (A) on a subject  
25 party other than the patent owner unless the

1 subject party was the owner of a claimed inven-  
2 tion in the patent or application for patent (or  
3 entitled to an assignment thereof), at the time  
4 the act of misconduct giving rise to the penalty  
5 occurred. Unless otherwise specified in the final  
6 determination, subject parties shall be jointly  
7 and severally liable for any penalty imposed.

8 “(7) TOLLING OF PENALTY; FAILURE OF TIME-  
9 LY PAYMENT.—The deadline for payment of any  
10 penalty imposed shall be tolled during the pendency  
11 of an appeal brought by a subject party under para-  
12 graph (8). If the patent owner fails to make timely  
13 payment of any penalty imposed on the patent  
14 owner, including any penalty for which the patent  
15 owner is jointly liable, before the expiration of the  
16 deadline provided under paragraph (5)(E), the fail-  
17 ure to pay the penalty constitutes a disclaimer of all  
18 enforceable rights in each patent involved in the vio-  
19 lation of the duty of candor and good faith for which  
20 the penalty was imposed.

21 “(8) APPEAL.—A subject party dissatisfied with  
22 the final determination of the Director under this  
23 section may, unless the penalty has been paid pursu-  
24 ant to the final determination, appeal the determina-  
25 tion under sections 141 through 144.





1           “(f) OTHER ACTIONS NOT SUBJECT TO PREEMP-  
2 TION.—Nothing in this section shall in any manner oper-  
3 ate to—

4           “(1) prevent or otherwise obstruct a criminal  
5 investigation or supersede any criminal law, or any  
6 penalty imposed pursuant thereto, in connection  
7 with any matter involving a patent or application for  
8 patent;

9           “(2) limit the ability of the courts of any State  
10 or the District of Columbia to investigate and make  
11 determinations with respect to issues of attorney  
12 malpractice and impose sanctions on an attorney for  
13 malpractice; or

14           “(3) limit the ability of any entity before which  
15 an individual is registered or otherwise entitled to  
16 practice a profession to investigate and sanction  
17 such individual based upon professional misconduct.

18           “(g) ACTIONS BASED UPON PRIOR MISCONDUCT AD-  
19 JUDICATION.—If a final, nonappealable adjudication of  
20 misconduct has been made based upon an action not sub-  
21 ject to preemption under subsection (f)(1), a pleading de-  
22 scribed in subsection (d), or a proceeding instituted pursu-  
23 ant to a referral described in subsection (e)(1), such adju-  
24 dication of misconduct may be used as a basis for pur-  
25 suing further remedies under any Federal or State law,



1 including common law, except that nothing in this sub-  
2 section shall authorize any investigation or determination  
3 of misconduct that is otherwise preempted under this sec-  
4 tion.

5 **“§ 137. Duty of candor: parties adverse to a patent or**  
6 **application**

7 “(a) DUTY.—The Director shall prescribe by regula-  
8 tion a duty of candor and good faith applicable to individ-  
9 uals who are parties adverse to a patent or application  
10 for patent in contested cases before the Office. The duty  
11 shall apply to individuals associated with such a pro-  
12 ceeding on behalf of a party adverse to the patent or appli-  
13 cation. Each such individual shall timely disclose informa-  
14 tion known to that individual to be material to issues  
15 raised or responded to by the adverse party on whose be-  
16 half the individual is involved and shall not materially mis-  
17 represent information.

18 “(b) MISCONDUCT.—Misconduct under this section  
19 shall be defined with respect to individuals described in  
20 subsection (a) in the same manner as that provided in sec-  
21 tion 136(b) with respect to individuals under that section.  
22 The Director may conduct an investigation of possible  
23 misconduct by an individual based upon a violation of the  
24 duty described in subsection (a) in the manner provided  
25 in section 136(e), except that the written notice described



1 in section 136(e)(2)(B) shall be given by the Director to  
2 each party on whose behalf an individual is acting who  
3 is being investigated for possible violation of the duty of  
4 candor and good faith under this section. The persons re-  
5 ceiving such written notice shall be the subject parties of  
6 the investigation. If, on the basis of an investigation the  
7 Director determines that there is a basis for concluding  
8 that a violation of the duty that amounts to misconduct  
9 may have occurred, the Director shall provide written no-  
10 tice of the preliminary determination to each subject party  
11 and shall afford the subject party an opportunity to reach  
12 a settlement of the issue before taking any further action.

13       “(c) PENALTIES.—If an issue of misconduct arising  
14 from a possible violation of the duty of candor and good  
15 faith under this section is not settled or otherwise termi-  
16 nated following the opportunity for settlement and hearing  
17 described in subsection (b), the Director may impose a  
18 civil monetary penalty against the subject parties. The  
19 procedures described in section 136(e) shall be followed  
20 in imposing a civil penalty under this subsection, except  
21 that the maximum civil monetary penalty that may be im-  
22 posed on a subject party under this section may not exceed  
23 \$500,000.”.



1 (b) TABLE OF SECTIONS.—The table of sections for  
2 chapter 12 is amended by adding at the end the following  
3 new items:

“136. Duty of candor: patents and applications for patent.

“137. Duty of candor: parties adverse to a patent or application.”.

4 (c) REMOVAL OF DECEPTIVE INTENT RESTRIC-  
5 TION.—

6 (1) INVENTOR.—

7 (A) IN GENERAL.—The third paragraph of  
8 section 116 is amended by striking “, and such  
9 error arose without any deceptive intention on  
10 his part”.

11 (B) CORRECTION OF NAMED INVENTOR.—  
12 The first paragraph of section 256 of such title  
13 is amended by striking “and such error arose  
14 without any deceptive intention on his part”.

15 (2) FILING.—

16 (A) FILING OF APPLICATION IN FOREIGN  
17 COUNTRY.—The first paragraph of section 184  
18 is amended by striking “and without deceptive  
19 intent”.

20 (B) PATENT BARRED FOR FILING WITH-  
21 OUT LICENSE.—Section 185 is amended by  
22 striking “and without deceptive intent”.

23 (3) REISSUE OF DEFECTIVE PATENTS.—The  
24 first paragraph of section 251 is amended by strik-



1 ing “, through error without any deceptive inten-  
2 tion,”.

3 (4) **DISCLAIMER.**—The first paragraph of sec-  
4 tion 253 is amended by striking “, without any de-  
5 ceptive intention,”.

6 (5) **ACTION FOR INFRINGEMENT.**—Section 288  
7 is amended by striking “, without deceptive inten-  
8 tion,”.

9 **SEC. 6. RIGHT OF THE INVENTOR TO OBTAIN DAMAGES.**

10 Section 284 is amended—

11 (1) in the first paragraph, by striking “Upon”  
12 and inserting “(a) **AWARD OF DAMAGES.**—Upon”;

13 (2) in the second paragraph, by striking  
14 “When” and inserting “(b) **ROLE OF THE COURT;**  
15 **TREBLE DAMAGES.**—When”;

16 (3) in the third paragraph, by striking “The  
17 court” and inserting “(c) **EXPERT TESTIMONY.**—  
18 The court”; and

19 (4) by adding at the end the following:

20 “(d) **BASIS FOR INCREASED DAMAGES.**—

21 “(1) **WILLFULNESS.**—For purposes of deter-  
22 mining whether to increase damages under this sec-  
23 tion, the court may consider the willfulness of any  
24 infringement. The absence of an opinion of counsel  
25 shall not create an inference that the infringement



1 was willful. Increased damages may not be awarded  
2 based merely upon the knowledge of a patent or its  
3 contents by the defendant prior to suit.

4 “(2) OTHER FACTORS.—Increased damages  
5 may be awarded for any infringement—

6 “(A) occurring after the defendant receives  
7 from the plaintiff written notice that—

8 “(i) contains a charge of infringe-  
9 ment,

10 “(ii) identifies the specific patent,  
11 claims, and allegedly infringing products or  
12 processes infringed, and

13 “(iii) is sufficient to give the defend-  
14 ant an objectively reasonable apprehension  
15 of suit on such patent,

16 unless the defendant had an informed good  
17 faith belief that a court would reasonably hold  
18 that the patent is invalid, not infringed, or un-  
19 enforceable;

20 “(B) in which the defendant intentionally  
21 copied the patent subject matter with knowl-  
22 edge that it was patented, unless the defendant  
23 had an informed good faith belief that a court  
24 would reasonably hold the patent is invalid, not  
25 infringed, or unenforceable; or



1           “(C) if the patent was asserted against the  
2           defendant in a previous judicial proceeding in a  
3           Federal court, and the present infringement is  
4           not more than colorably different from the con-  
5           duct asserted to be infringing in the previous  
6           proceeding.

7           “(e) DETERMINATION OF ROYALTIES OR DAMAGES  
8           FOR COMPONENTS.—Whenever the invention is incor-  
9           porated into, or is made part of, a method or apparatus  
10          otherwise known in the art, or is an approved method or  
11          apparatus including within it elements otherwise known  
12          in the art, then any award of a reasonable royalty or other  
13          damages shall be based only upon such portion of the total  
14          value of the method or apparatus as is attributable to the  
15          invention alone and shall not include value attributable to  
16          the method, apparatus, or elements otherwise known in  
17          the art or contributed by the infringer or its licensors.”.

18          **SEC. 7. INJUNCTIONS.**

19          Section 283 is amended—

20                 (1) by striking “The several” and inserting “(a)  
21                 IN GENERAL.—The several”; and

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

23                 “(b) GROUNDS FOR GRANTING INJUNCTION.—A  
24                 court shall not grant an injunction under this section un-  
25                 less it finds that the patentee is likely to suffer irreparable



1 harm that cannot be remedied by the payment of money  
2 damages. In making such a finding, the court shall not  
3 presume the existence of irreparable harm, but shall con-  
4 sider and weigh evidence that establishes or negates any  
5 equitable factor relevant to a determination of the exist-  
6 ence of irreparable harm, including the extent to which  
7 the patentee makes use of the invention.”.

8 **SEC. 8. CONTINUATION APPLICATIONS.**

9 Chapter 11 is amended by adding at the end the fol-  
10 lowing:

11 **“§ 123. Limitation on enlargement of claim**

12 “(a) IN GENERAL.—No claim in a patent or applica-  
13 tion shall be patentable if it is broader in scope than the  
14 broadest claim that—

15 “(1) is first published under section 122(b) in  
16 an application or patent that shares a claim of pri-  
17 ority under section 119 or 120 with the pending ap-  
18 plication;

19 “(2) is first issued under section 131 in an ap-  
20 plication or patent that shares a claim of priority  
21 under section 119 or 120 with the pending applica-  
22 tion; or

23 “(3) if neither paragraph (1) or (2) applies, is  
24 made in an application within 12 months after the





1 earliest filing date for which priority is sought for  
2 the pending application.

3 “(b) **BROADEST CLAIM.**—For purposes of deter-  
4 mining what is the broadest claim under subsection (a),  
5 the Office and a court shall consider only claims that were  
6 considered by an examiner under sections 102 and 103  
7 of this title.”.

8 **SEC. 9. POST-GRANT PROCEDURES AND OTHER QUALITY**  
9 **ENHANCEMENTS.**

10 (a) **PUBLICATION.**—Section 122(b) is amended—

11 (1) in paragraph (1)—

12 (A) in subparagraph (A), by striking “ear-  
13 liest filing date for which a benefit is sought  
14 under this title” and inserting “effective filing  
15 date of the claimed invention”; and

16 (B) in subparagraph (B), by striking “de-  
17 termines” and inserting “determines, except  
18 that the Director shall at a minimum publish,  
19 either with the application, or separately there-  
20 from if the application was published earlier at  
21 the request of the applicant under the second  
22 sentence of subparagraph (A), all claims sub-  
23 mitted within 12 months after the effective fil-  
24 ing date of the claimed invention”; and

25 (2) in paragraph (2)—



1 (A) by striking subparagraph (B); and  
2 (B) in subparagraph (A)—  
3 (i) by striking “(A) An application”  
4 and inserting “An application”; and  
5 (ii) by redesignating clauses (i)  
6 through (iv) as subparagraphs (A) through  
7 (D), respectively.

8 (b) DEFENSE TO INFRINGEMENT BASED ON EAR-  
9 LIER INVENTOR.—Section 273 of title 35, United States  
10 Code, is amended—

11 (1) in subsection (a)—

12 (A) in paragraph (1)—

13 (i) by striking “of a method”; and

14 (ii) by striking “review period;” and  
15 inserting “review period; and”;

16 (B) in paragraph (2)(B), by striking the  
17 semicolon at the end and inserting a period;  
18 and

19 (C) by striking paragraphs (3) and (4);

20 (2) in subsection (b)—

21 (A) in paragraph (1)—

22 (i) by striking “for a method”; and

23 (ii) by striking “of such patent, and”  
24 and all that follows through the period and  
25 inserting “of the claimed invention com-



1                   mercially used, or made substantial prep-  
2                   arations for commercial use of, the subject  
3                   matter before the effective filing date of  
4                   the claimed invention.”; and

5                   (B) in paragraph (3)—

6                   (i) by striking subparagraph (A); and

7                   (ii) by redesignating subparagraphs

8                   (B) and (C) as subparagraphs (A) and

9                   (B), respectively;

10                  (3) in paragraph (7), by striking “of the pat-  
11                  ent” and inserting “of the claimed invention”; and

12                  (4) by amending the heading to read as follows:

13                  **“§ 273. Special defenses to and exemptions from in-  
14                  fringement”.**

15                  (c) TABLE OF SECTIONS.—The item related to sec-  
16                  tion 273 in the table of sections for chapter 28 is amended  
17                  to read as follows:

                  “273. Special defenses to and exemptions from infringement.”.

18                  (d) APPEAL.—Section 315(c) of such title is amended  
19                  by striking “or could have raised”.

20                  (e) EFFECTIVE DATES.—Notwithstanding any other  
21                  provision of law, sections 311 through 318 of title 35,  
22                  United States Code, as amended by this Act, shall apply  
23                  to any patent that issues from an original application filed  
24                  on any date.

25                  (f) POST-GRANT OPPOSITION PROCEDURES.—



1 (1) IN GENERAL.—Part III is amended by add-  
2 ing at the end the following new chapter:

3 **“CHAPTER 32—POST-GRANT OPPOSITION**  
4 **PROCEDURES**

“CHAPTER 32—POST-GRANT OPPOSITION PROCEDURES

- “ 321. Right to oppose patent; opposition request.
- “ 322. Real party in interest.
- “ 323. Timing of opposition request.
- “ 324. Limits on scope of validity issues raised.
- “ 325. Institution of the opposition proceeding.
- “ 326. Patent owner response.
- “ 327. Amendment of claims.
- “ 328. Discovery and sanctions.
- “ 329. Supplemental submissions.
- “ 330. Hearing and briefs.
- “ 331. Written decision.
- “ 332. Burden of proof and evidence.
- “ 333. Reconsideration.
- “ 334. Appeal.
- “ 335. Certificate.
- “ 336. Estoppel.
- “ 337. Duration of opposition.
- “ 338. Settlement.
- “ 339. Intervening rights.
- “ 340. Relationship with reexamination proceedings.

5 **“§ 321. Right to oppose patent; opposition request**

6 “(a) FILING OF OPPOSITION.—A person may request  
7 that the grant or reissue of a patent be reconsidered by  
8 the Office by filing an opposition seeking to invalidate one  
9 or more claims in the patent. The Director shall establish,  
10 by regulation, fees to be paid by the person filing the oppo-  
11 sition (in this chapter referred to as the ‘opposer’). Copies  
12 of patents and printed publications to be relied upon in  
13 support of the request must be filed with the request. If  
14 an opposer relies on other factual evidence or on expert  
15 opinions in support of the opposition, such evidence and



1 opinions must be filed with the request through one or  
2 more accompanying affidavits or declarations.

3 “(b) COPIES PROVIDED TO PATENT OWNER.—Copies  
4 of any documents filed under subsection (a) must be pro-  
5 vided to the patent owner or, if applicable, the designated  
6 representative of the patent owner, at the time of filing  
7 under subsection (a), except that if a request is made  
8 under section 322(b) that the identity of a real party in  
9 interest be kept separate, then the identity of the real  
10 party in interest may be redacted from the copies pro-  
11 vided.

12 “(c) FILE AVAILABLE TO THE PUBLIC.—The file of  
13 any opposition proceeding shall be made available to the  
14 public except as provided in section 322.

15 **“§ 322. Real party in interest**

16 “(a) IDENTIFICATION.—The person making the re-  
17 quest under section 321 shall identify in writing each real  
18 party in interest, and the opposition shall proceed in the  
19 name of the real party in interest.

20 “(b) IDENTITY KEPT SECRET UPON REQUEST.—

21 “(1) IN GENERAL.—Subject to paragraph (2),  
22 if requested by the person making the request under  
23 section 321, the identity of a real party in interest  
24 shall be kept separate from the file of the opposition  
25 and made available only to Government agencies



1 upon written request, or to any person upon a show-  
2 ing of good cause. If the identity of a real party in  
3 interest is kept separate from the file under this  
4 paragraph, then the opposition shall proceed in the  
5 name of the individual filing the request as rep-  
6 resentative of the real party in interest.

7 “(2) EXCEPTION.—No request under paragraph  
8 (1) to keep the identity of a real party in interest  
9 separate from the file of the opposition may be made  
10 or maintained if the opposer relies upon factual evi-  
11 dence or expert opinions in the form of affidavits or  
12 declarations during the opposition proceeding or if  
13 the opposer exercises the right to appeal under sec-  
14 tion 141.

15 **“§ 323. Timing of opposition request**

16 “A person may not make an opposition request under  
17 section 321 more than 9 months after the grant of the  
18 patent or issuance of a reissue patent, as the case may  
19 be, except that, if the patent owner consents in writing,  
20 an opposition request may be filed anytime during the pe-  
21 riod of enforceability of the patent. A court having juris-  
22 diction over an issue of validity of a patent may not re-  
23 quire the patent owner to consent to such a request.



1 **“§ 324. Limits on scope of validity issues raised**

2 “An opposition request under section 321 must iden-  
3 tify with particularity the claims that are alleged to be  
4 invalid and, as to each claim, 1 or more issues of invalidity  
5 on which the opposition is based. The issues of invalidity  
6 that may be considered during the opposition proceeding  
7 are double patenting and any of the requirements for pat-  
8 entability set forth in sections 101, 102, 103, and 112,  
9 and the fourth paragraph of section 251.

10 **“§ 325. Institution of the opposition proceeding**

11 “(a) DISMISSAL; INSTITUTION.—

12 “(1) DISMISSAL.—The Director may dismiss an  
13 opposition request that the Director determines  
14 lacks substantial merit. The determination by the  
15 Director to dismiss may not be appealed. The dis-  
16 missal of an opposition request shall not be admis-  
17 sible in any civil action related to the patent against  
18 which a dismissed request was filed.

19 “(2) INSTITUTION.—If 1 or more requests  
20 meeting the requirements of section 321 are received  
21 by the Director and are not dismissed under para-  
22 graph (1), an opposition proceeding shall be prompt-  
23 ly instituted pursuant to the request or requests, but  
24 not before a period of 9 months has elapsed since  
25 the date on which the patent was granted.



1           “(3) CONSOLIDATED PROCEEDING.—If an op-  
2           position proceeding is instituted based upon more  
3           than 1 opposition request, the opposition shall pro-  
4           ceed as a single consolidated proceeding, unless later  
5           divided under subsection (c).

6           “(b) PARTIES.—The parties to an opposition pro-  
7           ceeding under this section shall be the patent owner and  
8           each opposer whose request meets the requirements of sec-  
9           tion 321 and has not been dismissed under subsection  
10          (a)(1).

11          “(c) DECISION BY PANEL.—The Director shall as-  
12          sign the opposition proceeding to a panel of three adminis-  
13          trative patent judges (in this chapter referred to as the  
14          ‘panel’). The panel shall decide the questions of patent-  
15          ability raised in each opposition request for which an oppo-  
16          sition has been instituted. The decision shall be based  
17          upon the prosecution record that was the basis for the  
18          grant of the patent and the additional submissions by the  
19          parties to the opposition proceeding authorized under this  
20          chapter. The panel may, in appropriate cases, divide the  
21          opposition into separate proceedings if the opposition in-  
22          volves multiple opposition requests by different parties.

23          **“§ 326. Patent owner response**

24          “After the Director has instituted an opposition pro-  
25          ceeding under section 325, the patent owner shall have





1 the right to file, within a time period set by the panel,  
2 a response to each opposition request that is the subject  
3 of the proceeding. The patent owner, in responding to an  
4 opposition request, shall file with the response, through  
5 affidavits or declarations, any additional factual evidence  
6 and expert opinions on which the patent owner relies in  
7 support of the response.

8 **“§ 327. Amendment of claims**

9 “The patent owner is entitled to request amendment  
10 of any claims that are the subject of an opposition pro-  
11 ceeding under this chapter, including by the addition of  
12 new claims. The patent owner shall file any such request  
13 for amendment with the patent owner’s response to the  
14 opposition request under section 326. The panel may per-  
15 mit further requests for amendment of the claims only  
16 upon good cause shown by the patent owner. No amend-  
17 ment enlarging the scope of the claims of the patent shall  
18 be permitted in the opposition proceeding.

19 **“§ 328. Discovery and sanctions**

20 “(a) DISCOVERY.—After an opposition proceeding is  
21 instituted under this chapter, the patent owner shall have  
22 the right to depose each person submitting an affidavit  
23 or declaration on behalf of any opposer, and each opposer  
24 shall have the right to depose each person submitting an  
25 affidavit or declaration on behalf of the patent owner.



1 Such depositions shall be limited to cross-examination on  
2 matters relevant to the affidavit or declaration. No other  
3 discovery shall be permitted unless the panel determines  
4 that additional discovery is required in the interest of jus-  
5 tice. The panel shall determine the schedule for the taking  
6 of discovery under this subsection.

7 “(b) CONSEQUENCES FOR FAILURE TO RESPOND  
8 PROPERLY.—If any party to an opposition proceeding  
9 fails to properly respond to any discovery under subsection  
10 (a), the panel may draw appropriate adverse inferences  
11 and take other action permitted by statute, rule, or regula-  
12 tion.

13 **“§ 329. Supplemental submissions**

14 “The panel may permit one or more supplemental  
15 submissions to be made by any party to an opposition pro-  
16 ceeding under this chapter, subject to the rights and limi-  
17 tations on discovery under section 328.

18 **“§ 330. Hearing and briefs**

19 “Any party to an opposition proceeding under this  
20 chapter may request an oral hearing within the time set  
21 by the panel. If a hearing is requested or the panel deter-  
22 mines sua sponte that a hearing is needed, the panel shall  
23 set a time for the hearing. The panel may permit the par-  
24 ties to file briefs for the hearing, and shall permit cross-  
25 examination of all affiants and declarants in the hearing,



1 either before the panel or by deposition taken under sec-  
2 tion 328.

3 **“§ 331. Written decision**

4 “The panel shall issue a written decision on each  
5 issue of patentability with respect to each claim that is  
6 the subject of an opposition proceeding under this chapter.  
7 The written decision shall consist of findings of fact and  
8 conclusions of law. The written decision shall become a  
9 final determination of the Office on the issues raised in  
10 the opposition unless a party to the opposition files a re-  
11 quest for reconsideration and modification of the written  
12 decision within a period of time set by the panel. Such  
13 time period may not be less than 2 weeks after the date  
14 of the written decision.

15 **“§ 332. Burden of proof and evidence**

16 “(a) BURDEN OF PROOF.—The opposer in an opposi-  
17 tion proceeding under this chapter shall have the burden  
18 to prove the invalidity of a claim by a preponderance of  
19 the evidence. The determination of invalidity shall be  
20 based upon the broadest reasonable construction of the  
21 claim.

22 “(b) EVIDENCE.—The Federal Rules of Evidence  
23 shall apply to the opposition proceeding, except to the ex-  
24 tent inconsistent with any provision of this chapter.



1 **“§ 333. Reconsideration**

2 “If a request is filed for reconsideration of the written  
3 decision in an opposition proceeding under this chapter,  
4 the panel may authorize a party to the proceeding who  
5 did not file such a request to file a response to the request  
6 for reconsideration. Following any reconsideration, the  
7 panel shall either deny the request for modification of the  
8 written decision or grant the request and issue a modified  
9 written decision, which shall constitute the final deter-  
10 mination of the Office on the issues raised in the opposi-  
11 tion proceeding.

12 **“§ 334. Appeal**

13 “A party dissatisfied with the final determination of  
14 the panel in an opposition proceeding under this chapter  
15 may appeal the determination under sections 141 through  
16 144. Any party to the opposition proceeding shall have the  
17 right to be a party to the appeal.

18 **“§ 335. Certificate**

19 “When a decision of a panel in an opposition pro-  
20 ceeding under this chapter has become final under section  
21 331, 333, or 334, the Director shall issue and publish a  
22 certificate in accordance with the decision, canceling any  
23 claim of the patent determined to be unpatentable, and  
24 shall incorporate into the patent any new or amended  
25 claims determined to be patentable. The issuance of the  
26 certificate shall terminate the opposition proceeding.



1 **“§ 336. Estoppel**

2 “(a) ESTOPPEL.—

3 “(1) IN GENERAL.—Subject to paragraph (2),  
4 after a certificate has been issued under section 335  
5 in accordance with the decision of the panel in an  
6 opposition proceeding, the determination with re-  
7 spect to an issue of invalidity raised by an opposer  
8 shall bar the opposer from raising, in any subse-  
9 quent proceeding involving that opposer under this  
10 title, any issue of fact or law actually decided and  
11 necessary to the determination of that issue.

12 “(2) EXCEPTION.—If an opposer in an opposi-  
13 tion proceeding demonstrates, in a subsequent pro-  
14 ceeding referred to in paragraph (1), that there is  
15 additional factual evidence that is material to an  
16 issue of fact actually decided and necessary to the  
17 final determination in the opposition proceeding,  
18 that could not reasonably have been discovered or  
19 presented in the opposition proceeding by that op-  
20 poser, the opposer may raise, in that subsequent  
21 proceeding, that issue of fact and any determined  
22 issue of law for which the issue of fact was nec-  
23 essary.

24 “(b) EXPANDED DEFINITION OF OPPOSER.—For  
25 purposes of this section, the term ‘opposer’ includes the



1 person making the request under section 321, any real  
2 party in interest, and their successors in interest.

3 “(c) NEW PARTY IN INTEREST.—If a proceeding  
4 arising by reason of additional factual evidence raised  
5 under subsection (a)(2) involves a real party in interest  
6 not identified to the patent owner under section 322, the  
7 real party in interest shall notify the Director and the pat-  
8 ent owner of that fact and of the subsequent proceeding,  
9 within 30 days after receiving notice that the subsequent  
10 proceeding has been filed.

11 **“§ 337. Duration of opposition**

12 “The final determination of a panel described in sec-  
13 tion 333 shall be issued not later than 1 year after the  
14 date on which the opposition proceeding is instituted  
15 under section 325. Upon good cause shown, the Director  
16 may extend the 1-year period by not more than 6 months.

17 **“§ 338. Settlement**

18 “(a) IN GENERAL.—An opposition proceeding under  
19 this chapter shall be terminated with respect to any op-  
20 poser upon the joint request of the opposer and the patent  
21 owner, unless the panel has issued a written decision  
22 under section 331 before the request for termination is  
23 filed. If the opposition is terminated with respect to an  
24 opposer under this section, no estoppel under section 336  
25 shall apply to that opposer. The written decision under



1 section 331 shall thereafter be issued only with respect  
2 to issues of invalidity raised by opposers that remain in  
3 the opposition proceeding.

4 “(b) AGREEMENTS IN WRITING.—Any agreement or  
5 understanding between the patent owner and an opposer,  
6 including any collateral agreements referred to therein,  
7 that is made in connection with or in contemplation of  
8 the termination of an opposition proceeding, shall be in  
9 writing. The opposition with respect to the parties to the  
10 agreement or understanding shall not be terminated until  
11 a true copy of the agreement or understanding, including  
12 any such collateral agreements, has been filed in the Pat-  
13 ent and Trademark Office. If any party filing such an  
14 agreement or understanding requests, the agreement or  
15 understanding shall be kept separate from the file of the  
16 opposition, and shall be made available only to Govern-  
17 ment agencies on written request, or to any person on a  
18 showing of good cause.

19 “(c) DISCRETIONARY ACTIONS REVIEWABLE.—Any  
20 discretionary action of the Director under subsection (b)  
21 shall be reviewable under chapter 7 of title 5.

22 **“§ 339. Intervening rights**

23 “Any proposed amended or new claim determined to  
24 be patentable and incorporated into a patent following an  
25 opposition proceeding under this chapter shall have the



1 same effect as that specified in section 252 of this title  
2 for reissued patents on the right of any person who made,  
3 purchased, or used within the United States, or imported  
4 into the United States, anything patented by such pro-  
5 posed amended or new claim, or who made substantial  
6 preparation therefor, before the certificate is issued under  
7 section 335 with respect to that amended or new claim.

8 **“§ 340. Relationship with reexamination proceedings**

9 “A patent for which an opposition proceeding has  
10 been instituted under this chapter may not thereafter be  
11 made the subject of a request under section 302 or 311  
12 for reexamination by the same opposer or on behalf of the  
13 same real party in interest, on the same claim and on the  
14 same issue that was the basis of the opposition proceeding.  
15 An ex parte reexamination request made by a person other  
16 than the patent owner during the 9-month period specified  
17 in section 323, or an inter partes reexamination request  
18 made during the 9-month period specified in section 323,  
19 shall be treated as a request under section 321, and no  
20 ex parte reexamination or inter partes reexamination may  
21 be ordered based on such request. A request for ex parte  
22 reexamination or inter partes reexamination made after  
23 the 9-month period specified in section 323, and a request  
24 for ex parte reexamination made by the patent owner at





1 any time, shall be stayed during the pendency of any oppo-  
2 sition proceeding under this chapter.”.

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

“32. Post-Grant Opposition Procedures.....321.”.

6 **SEC. 10. COMBINATIONS; COMPONENTS.**

7 Section 271(f) of title 35, United States Code, is  
8 amended by adding at the end the following:

9 “(3) An item supplied in or from the United States  
10 is not a ‘component’ under this section unless the item  
11 is a tangible item that is itself combined physically with  
12 other components to create the combination that is alleged  
13 to infringe. ”.

14 **SEC. 11. APPLICABILITY; TRANSITIONAL PROVISIONS.**

15 (a) SECTIONS 3, 6, 7, 8, AND 10.—

16 (1) APPLICABILITY.—The amendments made  
17 by sections 3, 6, 7, 8, and 10—

18 (A) shall apply only with respect to a non-  
19 provisional application for patent, and any pat-  
20 ent issued thereon, that claims an invention  
21 with an effective filing date (as defined in sec-  
22 tion 100(h) of title 35, United States Code)  
23 that is more than 1 year after the date of the  
24 enactment of this Act; and



1 (B) shall not apply with respect to any ac-  
2 tion brought in any court before the date of the  
3 enactment of this Act.

4 (2) CIRCULATION.—No claimed invention in a  
5 patent or application for patent for which the  
6 amendments made by section 3 have effect shall be  
7 entitled to assert an effective filing date that is be-  
8 fore the date of the enactment of this Act.

9 (b) SECTIONS 4, 5, AND 9.—The amendments made  
10 by sections 4, 5, and 9 shall apply as of the date of the  
11 enactment of this Act to any patent or application for pat-  
12 ent, except that—

13 (1)(A) no request for institution of an opposi-  
14 tion proceeding under chapter 32 of title 35, United  
15 States Code, may be made until—

16 (i) the end of the 1-year period beginning  
17 on the date of the enactment of this Act, or

18 (ii) such later date that the Director may  
19 establish through notice published in the Fed-  
20 eral Register; and

21 (B) no such request may be made unless the  
22 amendments made by section 3 apply with respect to  
23 the patent that is the subject of the request; and

24 (2) the amendments made by sections 4, 5, and  
25 9 shall not apply with respect to any action brought



1 in any court before the date of the enactment of this  
2 Act.

3 (c) DETERMINING VALIDITY OF OTHER CLAIMS.—

4 For the purpose of determining the validity of a claim in  
5 any patent or application for patent that is not subject  
6 to the amendments made by section 3, other than in an  
7 action brought in a court before the date of the enactment  
8 of this Act—

9 (1) the provisions of sections 102(c), 102(d),  
10 and 102(f) of title 35, United States Code, shall be  
11 deemed to be repealed; and

12 (2) the term “in public use or on sale” as used  
13 in section 102(b) of title 35, United States Code,  
14 shall be deemed to exclude the use, sale, or offer for  
15 sale of any subject matter that had not become rea-  
16 sonably and effectively accessible to persons of ordi-  
17 nary skill in the art to which the subject matter per-  
18 tains as defined in the amendments made by section  
19 3 of this Act.

20 (d) EFFECT OF EUROPEAN PATENT CONVENTION

21 AND PATENT LAWS OF JAPAN.—Before the date, if ever,  
22 that the Director of the United States Patent and Trade-  
23 mark Office publishes a notice in the Official Gazette of  
24 the Office declaring that both the European Patent Con-  
25 vention and the patent laws of Japan afford inventors



1 seeking patents a 1-year period before the effective filing  
2 date (as defined in section 100(h) of title 35, United  
3 States Code) of a claimed invention during which disclo-  
4 sures that are made by the inventor or by others who ob-  
5 tained the subject matter disclosed directly or indirectly  
6 from the inventor do not constitute prior art, the term  
7 “effective filing date” in section 102(a)(1)(A) of title 35,  
8 United States Code, shall be construed to mean—

9 (1) the filing date in the United States of the  
10 patent or the application for patent containing the  
11 claim; or

12 (2) if the patent or application for patent con-  
13 taining the claim is entitled to the benefit of an ear-  
14 lier filing date in the United States under section  
15 120, 121, or 365(c) of title 35, United States Code,  
16 based upon one or more prior filed applications for  
17 patent, the filing date of the earliest such applica-  
18 tion that contains an adequate disclosure of the  
19 claimed invention under section 112 of title 35,  
20 United States Code.

