

AMENDMENT NO. _____ Calendar No. _____

Purpose: To improve the bill.

IN THE SENATE OF THE UNITED STATES—112th Cong., 1st Sess.

S. 23

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

Referred to the Committee on _____ and
ordered to be printed

Ordered to lie on the table and to be printed

AMENDMENTS intended to be proposed by _____

Viz:

1 On page 7, between lines 2 and 3, insert the fol-
2 lowing:

3 (2) CONTINUITY OF INTENT UNDER THE CRE-
4 ATE ACT.—The enactment of section 102(c) of title
5 35, United States Code, under the preceding para-
6 graph is done with the same intent to promote joint
7 research activities that was expressed, including in
8 the legislative history, through the enactment of the
9 Cooperative Research and Technology Enhancement
10 Act of 2004 (Public Law 108–453; the “CREATE
11 Act”), the amendments of which are stricken by sub-
12 section (c). The United States Patent and Trade-
13 mark Office shall administer section 102(c) of title

1 35, United States Code, in a manner consistent with
2 the legislative history of the CREATE Act that was
3 relevant to its administration by the United States
4 Patent and Trademark Office.

5 On page 7, line 3, strike “(2)” and insert “(3)”.

6 On page 41, strike lines 11 through 16, and insert
7 the following:

8 “(b) PATENT OWNER’S ACTION.—An inter partes re-
9 view may not be instituted if the petition requesting the
10 proceeding is filed more than 6 months after the date on
11 which the petitioner, real party in interest, or his privy
12 is served with a complaint alleging infringement of the
13 patent. The time limitation set forth in the preceding sen-
14 tence shall not apply to a request for joinder under sub-
15 section (c).

16 On page 56, strike lines 3 through 8, and insert the
17 following:

18 “(b) PATENT OWNER’S ACTION.—A post-grant re-
19 view may not be instituted if the petition requesting the
20 proceeding is filed more than 6 months after the date on
21 which the petitioner, real party in interest, or his privy
22 is served with a complaint alleging infringement of the

1 patent. The time limitation set forth in the preceding sen-
2 tence shall not apply to a request for joinder under sub-
3 section (c).

4 On page 64, line 6, strike “1 year” and insert “18
5 months”.

6 On page 64, line 12, strike “1 year” and insert “18
7 months”.

8 On page 67, line 11, strike “1 year” and insert “18
9 months”.

10 On page 67, line 22, strike “1 year” and insert “18
11 months”.

12 On page 73, line 7, strike “1 year” and insert “18
13 months”.

14 On page 74, line 1, strike “1 year” and insert “18
15 months”.

16 On page 74, line 7, strike “1 year” and insert “18
17 months”.

1 On page 74, line 15, strike “1 year” and insert “18
2 months”.

3 On page 88, strike line 8 and all that follows through
4 page 89, line 10, and insert the following:

5 **SEC. 11. RESIDENCY OF FEDERAL CIRCUIT JUDGES.**

6 (a) IN GENERAL.—Section 44(c) of title 28, United
7 States Code, is amended—

8 (1) by repealing the second sentence; and

9 (2) in the third sentence, by striking “state”
10 and inserting “State”.

11 (b) EFFECTIVE DATE.—This section shall take effect
12 on the date of enactment of this Act.

13 On page 97, strike lines 4 through 6, and insert the
14 following:

15 (2) Section 202 of title 35, United States Code,
16 is amended—

17 (A) in subsection (b)(3), by striking “the
18 section 203(b)” and inserting “section 203(b)”;

19 and

20 (B) in subsection (c)(7)—

21 (i) in subparagraph (D), by striking
22 “except where it proves” and all that fol-
23 lows through “; and” and inserting: “ex-

1 cept where it is determined to be infeasible
2 following a reasonable inquiry, a preference
3 in the licensing of subject inventions shall
4 be given to small business firms; and”; and
5 (ii) in subparagraph (E)(i), by strik-
6 ing “as described above in this clause
7 (D);” and inserting “described above in
8 this clause;”.

9 On page 98, between lines 19 and 20, insert the fol-
10 lowing:

11 **SEC. 17. CLARIFICATION OF JURISDICTION.**

12 (a) **SHORT TITLE.**—This section may be cited as the
13 “Intellectual Property Jurisdiction Clarification Act of
14 2011”.

15 (b) **STATE COURT JURISDICTION.**—Section 1338(a)
16 of title 28, United States Code, is amended by striking
17 the second sentence and inserting the following: “No State
18 court shall have jurisdiction over any claim for relief aris-
19 ing under any Act of Congress relating to patents, plant
20 variety protection, or copyrights.”.

21 (c) **COURT OF APPEALS FOR THE FEDERAL CIR-**
22 **CUIT.**—Section 1295(a)(1) of title 28, United States Code,
23 is amended to read as follows:

1 “(1) the action may be removed by any party;
2 and

3 “(2) the time limitations contained in section
4 1446(b) may be extended at any time for cause
5 shown.

6 “(c) REMAND.—If a civil action is removed solely
7 under this section, the district court—

8 “(1) shall remand all claims that are neither a
9 basis for removal under subsection (a) nor within
10 the original or supplemental jurisdiction of the dis-
11 trict court under any Act of Congress; and

12 “(2) may, under the circumstances specified in
13 section 1367(c), remand any claims within the sup-
14 plemental jurisdiction of the district court under sec-
15 tion 1367.”.

16 (2) CONFORMING AMENDMENT.—The table of
17 sections for chapter 89 of title 28, United States
18 Code, is amended by adding at the end the following
19 new item:

“1454. Patent, plant variety protection, and copyright cases.”.

20 (e) TRANSFER BY COURT OF APPEALS FOR THE
21 FEDERAL CIRCUIT.—

22 (1) IN GENERAL.—Chapter 99 of title 28,
23 United States Code, is amended by adding at the
24 end the following new section:

1 **“§ 1632. Transfer by the Court of Appeals for the Fed-**
2 **eral Circuit**

3 “When a case is appealed to the Court of Appeals
4 for the Federal Circuit under section 1295(a)(1), and no
5 claim for relief arising under any Act of Congress relating
6 to patents or plant variety protection is the subject of the
7 appeal by any party, the Court of Appeals for the Federal
8 Circuit shall transfer the appeal to the court of appeals
9 for the regional circuit embracing the district from which
10 the appeal has been taken.”.

11 (2) CONFORMING AMENDMENT.—The table of
12 sections for chapter 99 of title 28, United States
13 Code, is amended by adding at the end the following
14 new item:

“1632. Transfer by the Court of Appeals for the Federal Circuit.”.

15 (f) EFFECTIVE DATE.—The amendments made by
16 this section shall apply to any civil action commenced on
17 or after the date of the enactment of this Act.

18 On page 98, line 20, strike “**SEC. 17.**” and insert
19 “**SEC. 18.**”.

20 On page 98, line 20, strike “**; RULE OF CONSTRUC-**
21 **TION**”.

1 On page 98, line 21, strike “(a) EFFECTIVE DATE.—
2 ”.

3 On page 99, strike lines 1 through 14.