

**[DISCUSSION DRAFT]**

SEPTEMBER 6, 2013

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

M. \_\_\_\_\_ 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 **[“\_\_\_\_\_ Act of 2013”]**.

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 infringe-**  
15 **ment 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 reasonable accessible, the following:

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

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

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

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

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

19 “(B) the name of each accused method,  
20 system, process, function, act, or service, or the  
21 name or model number of each apparatus,  
22 product, feature, or device that, when used, al-  
23 legedly results in the practice of the claimed in-  
24 vention.

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

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

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

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

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

15          “(A) the direct infringement;

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

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

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

24          “(A) patent identified under paragraph  
25          (1); and

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

3           “(8) A description of the principal business of  
4           the party alleging infringement.

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

9           “(10) For each patent identified under para-  
10          graph (1), whether such patent is subject to any li-  
11          censing term or pricing commitments through any  
12          agency or standard-setting body.

13          “(b) EXEMPTION.—A claim for relief arising under  
14          section 271(e)(2) shall not be subject to the requirements  
15          of subsection (a).”.

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

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

20          (b) FEES AND OTHER EXPENSES.—

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

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

24                 “(a) AWARD.—The court shall award, to a prevailing  
25                 party, reasonable fees and other expenses incurred by that

1 party in connection with a civil action in which any party  
2 asserts a claim for relief arising under any Act of Con-  
3 gress relating to patents, unless the court finds that the  
4 position of the nonprevailing party or parties was substan-  
5 tially justified or that special circumstances make an  
6 award unjust.

7 “(b) RECOVERY.—If a nonprevailing party is unable  
8 to pay reasonable costs and other expenses awarded by  
9 the court pursuant to subsection (a), the court may make  
10 the reasonable costs and other expenses recoverable  
11 against any interested party joined pursuant to section  
12 299(d).”.

13 (2) TECHNICAL AND CONFORMING AMEND-  
14 MENTS.—

15 (A) TECHNICAL AND CONFORMING AMEND-  
16 MENT.—The item relating to section 285 of the  
17 table of sections for chapter 29 of title 35,  
18 United States Code, is amended to read as fol-  
19 lows:

“285. Fees and other expenses.”.

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

23 (3) EFFECTIVE DATE.—The amendments made  
24 by this subsection shall take effect on the date of the

1 enactment of this Act and shall apply to any action  
2 for which a complaint is filed on or after that date.

3 (c) JOINDER OF INTERESTED PARTIES.—Section  
4 299 of title 35, United States Code, is amended by adding  
5 at the end the following new subsection:

6 “(d) JOINDER OF INTERESTED PARTIES.—

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

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

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

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

23 “(3) INTERESTED PARTY DEFINED.—In this  
24 subsection, the term ‘interested party’ means a per-

1 son, other than the party alleging infringement,  
2 that—

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

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

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

13 “(i) an attorney or law firm providing  
14 legal representation in the civil action if  
15 the sole basis for the financial interest of  
16 the attorney or law firm in the outcome of  
17 the action arises from the attorney or law  
18 firm’s receipt of compensation reasonably  
19 related to the provision of the legal rep-  
20 resentation; or

21 “(ii) a person whose sole financial in-  
22 terest in the patent or patents at issue is  
23 ownership of an equity interest in the  
24 party alleging infringement, unless such



1 person also has the right or ability to influ-  
2 ence, direct, or control the civil action.”.

3 (d) DISCOVERY LIMITS.—

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

7 **“§ 299A. Discovery in patent infringement action**

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

18 “(b) DISCRETION TO EXPAND SCOPE OF DIS-  
19 COVERY.—

20 “(1) TIMELY RESOLUTION OF ACTIONS.—If,  
21 under any provision of Federal law (including the  
22 amendments made by the Drug Price Competition  
23 and Patent Term Restoration Act of 1984 (Public  
24 Law 98–417)), resolution within a specified period  
25 of time of a civil action arising under any Act of

1 Congress relating to patents will necessarily affect  
2 the rights of a party with respect to the patent, the  
3 court may permit discovery in addition to the dis-  
4 covery authorized under subsection (a) before the  
5 ruling described in subsection (a) is issued as nec-  
6 essary to ensure timely resolution of the action.

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

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

“299A. Discovery in patent infringement action”.

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

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

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

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

3 (2) by striking “The clerks” and inserting “(a)  
4 **Notice of patent suits.**—The clerks”; and

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

7 “(b) INITIAL DISCLOSURE.—

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

14 “(A) The assignee of the patent or patents  
15 at issue.

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

18 “(C) Any entity, other than the plaintiff,  
19 that the plaintiff knows to have a financial in-  
20 terest in—

21 “(i) the patent or patents at issue; or

22 “(ii) the plaintiff.

23 “(D) The ultimate parent entity of any as-  
24 signee identified under subparagraph (A) and

1 any entity identified under subparagraphs (B)  
2 and (C).

3 “(2) EXEMPTION.—The requirements of para-  
4 graph (1) shall not apply with respect to a civil ac-  
5 tion filed under subsection (a) that includes a cause  
6 of action described under section 271(e)(2).

7 “(c) DISCLOSURE COMPLIANCE.—

8 “(1) PUBLICLY TRADED.—For purposes of sub-  
9 section (b), if the financial interest is held by a cor-  
10 poration traded on a public stock exchange, an iden-  
11 tification of the name of the corporation and the  
12 public exchange listing shall satisfy the disclosure re-  
13 quirement.

14 “(2) NOT PUBLICLY TRADED.—For purposes of  
15 subsection (b), if the financial interest is not held by  
16 a publicly traded corporation, the disclosure shall  
17 satisfy the disclosure requirement if the information  
18 identifies—

19 “(A) in the case of a partnership, the  
20 name of the partnership and the name and cor-  
21 respondence address of each partner or other  
22 entity that holds more than a 5 percent share  
23 of that partnership;

24 “(B) in the case of a corporation, the  
25 name of the corporation, the location of incor-

1           poration, the address of the principal place of  
2           business, and the name of each officer of the  
3           corporation; and

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

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

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

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

20                   “(A) the plaintiff or subsequent owner  
21          shall not be entitled to recover fees and other  
22          expenses under section 285 or increased dam-  
23          ages under section 284 with respect to infring-  
24          ing activities taking place during any period of  
25          noncompliance with paragraph (1), unless the

1 denial of such damages or fees would be mani-  
2 festly unjust; and

3 “(B) the court shall award to a prevailing  
4 party accused of infringement reasonable attor-  
5 ney fees and expenses incurred to discover the  
6 updated assignee or entity described under  
7 paragraph (1), unless such sanctions would be  
8 unjust.

9 “(e) DEFINITIONS.—In this section:

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

12 “(A) means ownership of a legal or equi-  
13 table interest, such as—

14 “(i) any person who directly or indi-  
15 rectly owns or controls more than 5% of  
16 the party alleging infringement of the pat-  
17 ent; or

18 “(ii) any person with a right to re-  
19 ceive proceeds from the action, including a  
20 fixed or variable portion of such proceeds;  
21 and

22 “(B) does not mean—

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

1 participates in the management of such  
2 fund; or

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

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

13 “(3) ULTIMATE PARENT ENTITY.—

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

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

22 (b) TECHNICAL AND CONFORMING AMENDMENT.—  
23 The item relating to section 290 in the table of sections  
24 for chapter 29 of title 35, United States Code, is amended  
25 to read as follows:

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

1 (c) REGULATIONS.—The Director may promulgate  
2 such regulations as are necessary to establish a registra-  
3 tion fee in an amount sufficient to recover the estimated  
4 costs of administering subsections (b) through (e) of sec-  
5 tion 290 of title 35, United States Code, as added by sub-  
6 section (a), to facilitate the collection and maintenance of  
7 the information required by such subsections, and to en-  
8 sure the timely disclosure of such information to the pub-  
9 lic.

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

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

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

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

19 “(a) STAY OF ACTION AGAINST CUSTOMER.—In any  
20 civil action arising under any Act of Congress relating to  
21 patents, the court shall grant a motion to stay at least  
22 the portion of the action against a covered customer re-  
23 lated to infringement of a patent involving a covered prod-  
24 uct or process if the following requirements are met:



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

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

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

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

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

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

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

1 “(c) LIFT OF STAY.—

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

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

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

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

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

23 “(e) DEFINITIONS.—In this section:

24 “(1) COVERED CUSTOMER.—The term ‘covered  
25 customer’ means a party accused of infringing a pat-

1 ent or patents in dispute based on a covered product  
2 or process.

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

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

12 “(A) is alleged to infringe the patent or  
13 patents in dispute; or

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

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

“296. Stay of action against customer.”.

20 (c) EFFECTIVE DATE.—The amendments made by  
21 this section shall take effect on the date of the enactment  
22 of this Act and shall apply to any action for which a com-  
23 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 shall develop rules  
8 and procedures to implement the requirements de-  
9 scribed in paragraph (2) to address the asymmetries  
10 in discovery burdens and costs in any civil action  
11 arising under any Act of Congress relating to pat-  
12 ents. Such rules and procedures shall include how  
13 and when payment for discovery in addition to the  
14 discovery of core documentary evidence is to occur,  
15 and what information must be presented to dem-  
16 onstrate financial capacity before permitting dis-  
17 covery in addition to core documentary evidence.

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

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

1 core documentary evidence within the posses-  
2 sion or control of each such party.

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

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

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

21 (iii) A party may not submit more  
22 than 5 production requests to a custodian,  
23 unless the parties jointly agree to modify  
24 the number of production requests without  
25 leave of the court.

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

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

12 (C) ADDITIONAL DISCOVERY.—

13 (i) IN GENERAL.—Each party to the  
14 action may seek any additional discovery  
15 otherwise permitted under the Federal  
16 Rules of Civil Procedure, if such party  
17 bears the costs, including reasonable attor-  
18 ney's fees, of the additional discovery.

19 (ii) REQUIREMENTS FOR ADDITIONAL  
20 DISCOVERY.—Unless the parties mutually  
21 agree otherwise, no party shall be per-  
22 mitted additional discovery unless such  
23 party posts a bond, or provides other secu-  
24 rity, in an amount sufficient to cover the  
25 expected costs of such additional discovery,

1 or makes a showing to the court that such  
2 party has the financial capacity to pay the  
3 costs of the discovery.

4 (iii) LIMITS ON ADDITIONAL DIS-  
5 COVERY.—A court, upon motion, may de-  
6 termine that a request for additional dis-  
7 covery is excessive, irrelevant, or otherwise  
8 abusive and may set limits on such addi-  
9 tional discovery.

10 (iv) GOOD CAUSE MODIFICATION.—A  
11 court, upon motion and for good cause  
12 shown, may modify the requirements of  
13 subparagraphs (A) and (B) and any defini-  
14 tion under paragraph (3). Not later than  
15 30 days after the pretrial conference under  
16 Rule 16 of the Federal Rules of Civil Pro-  
17 cedure, the parties shall jointly submit any  
18 proposed modifications of the requirements  
19 of subparagraphs (A) and (B) and any def-  
20 inition under paragraph (3), unless the  
21 parties do not agree, in which case each  
22 party shall submit any proposed modifica-  
23 tion of such party and a summary of the  
24 disagreement over the modification.

1 (v) COMPUTER CODE.—A court, upon  
2 motion and for good cause shown, may de-  
3 termine that computer code should be in-  
4 cluded in the discovery of core documen-  
5 tary evidence. The discovery of computer  
6 code shall occur after the parties have ex-  
7 changed initial disclosures and core docu-  
8 mentary evidence.

9 (D) DISCOVERY SEQUENCE AND SCOPE.—  
10 The parties shall discuss and address in the  
11 written report filed pursuant to Rule 26(f) of  
12 the Federal Rules of Civil Procedure the views  
13 and proposals of each party on the following:

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

16 (ii) Whether additional discovery will  
17 be sought under subparagraph (C).

18 (iii) Any issues about infringement,  
19 invalidity, or damages that, if resolved be-  
20 fore the additional discovery described in  
21 subparagraph (C) commences, might sim-  
22 plify or streamline the case, including the  
23 identification of any terms or phrases re-  
24 lating to any patent claim at issue to be  
25 construed by the court and whether the



1 early construction of any of those terms or  
2 phrases would be helpful.

3 (3) DEFINITIONS.—In this subsection:

4 (A) CORE DOCUMENTARY EVIDENCE.—In  
5 this subsection, the term “core documentary  
6 evidence”—

7 (i) includes documents—

8 (I) relating to the conception of,  
9 reduction to practice of, and applica-  
10 tion for, the patent or patents at  
11 issue;

12 (II) sufficient to show the tech-  
13 nical operation of the product or proc-  
14 ess identified in the complaint as in-  
15 fringing the patent or patents at  
16 issue;

17 (III) relating to potentially invali-  
18 dating prior art;

19 (IV) relating to any licensing of  
20 the patent or patents at issue before  
21 the date on which the complaint is  
22 filed;

23 (V) sufficient to show profit at-  
24 tributable to the claimed invention of  
25 the patent or patents at issue;

1 (VI) relating to any knowledge by  
2 the accused infringer of the patent or  
3 patents at issue before the date on  
4 which the complaint is filed; and

5 (VII) sufficient to show any  
6 marking or other notice provided of  
7 the patent or patents at issue; and

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

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

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

22 (b) JUDICIAL CONFERENCE RECOMMENDATIONS ON  
23 CASE MANAGEMENT.—Not later than 6 months after the  
24 date of the enactment of this Act, the Judicial Conference  
25 of the United States shall recommend case management

1 procedures to be implemented by the district courts and  
2 the United States Court of Federal Claims for any civil  
3 action arising under any Act of Congress relating to pat-  
4 ents, including initial disclosure and early case manage-  
5 ment conference practices that—

6 (1) will identify any potential dispositive issues  
7 of the case; and

8 (2) focus on early summary judgment motions  
9 when resolution of issues may lead to expedited dis-  
10 position of the case.

11 (c) REVISION OF FORM FOR PATENT INFRINGE-  
12 MENT.—

13 (1) ELIMINATION OF FORM.—The Supreme  
14 Court shall eliminate Form 18 in the Appendix to  
15 the Federal Rules of Civil Procedure (relating to  
16 Complaint for Patent Infringement), effective on the  
17 date of the enactment of this Act.

18 (2) REVISED FORM.—The Supreme Court may  
19 prescribe a new form or forms setting out model al-  
20 legations of patent infringement that, at a minimum,  
21 notify accused infringers of the asserted claim or  
22 claims, the products or services accused of infringe-  
23 ment, and the plaintiff's theory for how each ac-  
24 cused product or service meets each limitation of  
25 each asserted claim. The Judicial Conference should

1 exercise the authority under section 2073 of title 28,  
2 United States Code, to make recommendations with  
3 respect to such new form or forms.

4 (d) PROTECTION OF INTELLECTUAL-PROPERTY LI-  
5 CENSES IN BANKRUPTCY.—

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

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

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

12 (C) by inserting at the end the following  
13 new paragraph:

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

17 (2) EFFECTIVE DATE.—The amendments made  
18 by this subsection shall take effect on the date of the  
19 enactment of this Act and shall apply to any action  
20 for which a complaint is pending on, or filed on or  
21 after, such date of enactment.

22 **SEC. 7. SMALL BUSINESS EDUCATION, OUTREACH, AND IN-**  
23 **FORMATION ACCESS.**

24 (a) SMALL BUSINESS EDUCATION AND OUT-  
25 REACH.—

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

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

13           (b) IMPROVING INFORMATION TRANSPARENCY FOR  
14 SMALL BUSINESS AND THE UNITED STATES PATENT AND  
15 TRADEMARK OFFICE USERS.—

16           (1) WEBSITE.—Using existing resources, the  
17 Director shall create a user-friendly section on the  
18 official website of the Office to notify the public  
19 when a patent case is brought in Federal court and  
20 with respect to each patent at issue in such case, the  
21 Director shall include—

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

1 (B) any other information the Director de-  
2 termines to be relevant.

3 (2) **FORMAT.**—The information described in  
4 paragraph (1) shall be searchable by patent number,  
5 patent art area, and entity to promote accessibility  
6 for the public.

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

9 (a) **STUDY ON SECONDARY MARKET OVERSIGHT FOR**  
10 **PATENT TRANSACTIONS TO PROMOTE TRANSPARENCY**  
11 **AND ETHICAL BUSINESS PRACTICES.**—

12 (1) **STUDY REQUIRED.**—The Director, in con-  
13 sultation with the Secretary of Commerce, the Sec-  
14 retary of the Treasury, the Chairman of the Securi-  
15 ties and Exchange Commission, the heads of other  
16 relevant agencies, and interested parties, shall, using  
17 existing resources of the Office, conduct a study—

18 (A) to develop legislative recommendations  
19 to ensure greater transparency and account-  
20 ability in patent transactions occurring on the  
21 secondary market;

22 (B) to examine the economic impact that  
23 the patent secondary market has on the United  
24 States;

1 (C) to examine licensing and other over-  
2 sight requirements that may be placed on the  
3 patent secondary market, including the partici-  
4 pants in such markets, to ensure that the mar-  
5 ket is a level playing field and that brokers in  
6 the market have the requisite expertise and ad-  
7 here to ethical business practices; and

8 (D) to examine the requirements placed on  
9 other markets.

10 (2) SUBMISSION OF STUDY.—Not later than  
11 seven months after the date of the enactment of this  
12 Act, the Director shall submit a report to the Com-  
13 mittee on the Judiciary of the House of Representa-  
14 tives and the Committee on the Judiciary of the  
15 Senate on the findings and recommendations of the  
16 Director from the study required under paragraph  
17 (1).

18 (b) STUDY ON PATENTS OWNED BY THE UNITED  
19 STATES GOVERNMENT.—

20 (1) STUDY REQUIRED.—The Director, in con-  
21 sultation with the heads of relevant agencies and in-  
22 terested parties, shall, using existing resources of the  
23 Office, conduct a study on patents owned by the  
24 United States Government that—

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

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

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

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

18 (2) REPORT ON STUDY.—Not later than six  
19 months after the date of the enactment of this Act,  
20 the Director shall submit to the Committee on the  
21 Judiciary of the House of Representatives and the  
22 Committee on the Judiciary of the Senate a report  
23 on the findings and recommendations of the Director  
24 from the study required under paragraph (1).



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

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

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

11 (A) An examination of patent quality at  
12 the Office.

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

19 (C) A description of how patents are clas-  
20 sified.

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

24 (E) An examination of the types of off-the-  
25 shelf prior art databases and search software

1           used by foreign patent offices and governments,  
2           particularly in Europe and Asia, and whether  
3           those databases and search tools could be used  
4           by the Office to improve patent examination.

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

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

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

19          (a) REPEAL OF CIVIL ACTION TO OBTAIN A PAT-  
20          ENT.—

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

23               (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 has been or would be in  
5 a civil action to invalidate a patent under sec-  
6 tion 282(b), including construing each claim of  
7 the patent in accordance with the ordinary and  
8 customary meaning of such claim as understood  
9 by one of ordinary skill in the art and the pros-  
10 ecution 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 non-obviousness 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) did not apply and, if applicable, if the  
3           claimed invention of the first patent had not  
4           been effectively filed under section 102(d) on  
5           (but was effectively filed before) the effective  
6           filing date of the claimed invention of the sec-  
7           ond patent; and

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

12           (2) REGULATIONS.—The Director shall promul-  
13          gate regulations setting forth the form and content  
14          of any disclaimer required for a patent to be issued  
15          in compliance with section 106 of title 35, United  
16          States Code, as added by paragraph (1).

17           (3) CONFORMING AMENDMENT.—The table of  
18          sections for chapter 10 of title 35, United States  
19          Code, is amended by adding at the end the following  
20          new item:

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

21           (4) EFFECTIVE DATE.—The amendments made  
22          by this subsection shall take effect on the date of the  
23          enactment of this Act and shall apply to a patent or  
24          patent application only if both the first and second  
25          patents described in section 106 of title 35, United



1 States Code, as added by paragraph (1), are patents  
2 or patent applications that are described in section  
3 3(n)(1) of the Leahy-Smith America Invents Act (35  
4 U.S.C. 100 note).

5 (e) COVERED BUSINESS METHOD PATENT RE-  
6 VIEWS.—

7 (1) LIMITATION; REPEAL.—

8 (A) LIMITATION TO FIRST-TO-INVENT PAT-  
9 ENTS.—Section 18(a)(2) of the Leahy-Smith  
10 America Invents Act is amended by striking  
11 “shall not apply to a patent described in section  
12 6(f)(2)(A) of this Act during the period in  
13 which a petition for post-grant review of that  
14 patent would satisfy the requirements of section  
15 321(c) of title 35, United States Code” and in-  
16 sserting “shall not apply to a patent that is de-  
17 scribed in section 3(n)(1) of this Act”.

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

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

1           (2) DEFINITION; LIMITATION; CLARIFICA-  
2           TION.—

3           (A) DEFINITION.—For purposes of section  
4           18(d) of the Leahy-Smith America Invents Act,  
5           the words “used in the practice, administration,  
6           or management of a financial product or serv-  
7           ice” shall be construed consistently with the in-  
8           stitution decision of the Patent Trial and Ap-  
9           peal Board of the United States Patent and  
10          Trademark Office in *SAP America, Inc. v.*  
11          *Versata Dev. Group, Inc.*, CBM2012-00001,  
12          Paper 36 (January 9, 2013).

13          (B) LIMITATION TO BUSINESS-METHOD  
14          CLAIMS.—Section 18(a)(1)(E) of the Leahy-  
15          Smith America Invents Act is amended by  
16          striking “only for a patent that is a covered  
17          business method patent” and inserting “only  
18          for those claims in a patent that qualify the  
19          patent as a covered business method patent”.

20          (C) CLARIFICATION OF TECHNOLOGICAL-  
21          INVENTION LIMITATION.—Section 18(d)(1) of  
22          the Leahy-Smith America Invents Act is  
23          amended by inserting “, such as inventions in  
24          the natural sciences or computer operations.  
25          Claimed subject matter’s recitation of a techno-

1           logical feature does not qualify a patent as a  
2           patent for a technological invention if it is read-  
3           ily apparent that the recited feature is antici-  
4           pated by or obvious in light of the prior art”  
5           after “does not include patents for technological  
6           inventions”.

7           (D) SCOPE OF PRIOR ART.—Section  
8           18(a)(1)(C)(i) of the Leahy-Smith America In-  
9           vents Act is amended by striking “section  
10          102(a)” and inserting “subsection (a), (d), or  
11          (e) of section 102”.

12          (E) EFFECTIVE DATE.—Subparagraph (A)  
13          and the amendments made by subparagraphs  
14          (B), (C), and (D) shall take effect on the date  
15          of the enactment of this Act and shall apply in  
16          any proceeding pending on, or filed on or after,  
17          such date of enactment.

18          (f) CLARIFICATION OF LIMITS ON PATENT TERM AD-  
19          JUSTMENT.—

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

22                 (A) in the matter preceding clause (i), by  
23                 striking “not including—” and inserting “the  
24                 term of the patent shall be extended 1 day for

1 each day after the end of that 3-year period  
2 until the patent is issued, not including—”;

3 (B) in clause (i), by striking “consumed by  
4 continued examination of the application re-  
5 quested by the applicant” and inserting “con-  
6 sumed after continued examination of the appli-  
7 cation is requested by the applicant”;

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

10 (D) by striking the matter following clause  
11 (iii).

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

16 (g) CLARIFICATION OF JURISDICTION.—Congress  
17 finds that the Federal interest in preventing inconsistent  
18 final judicial determinations as to the legal force or effect  
19 of the claims in a patent presents a substantial Federal  
20 issue that is important to the Federal system as a whole.

21 (h) TECHNICAL CORRECTIONS.—

22 (1) NOVELTY.—

23 (A) AMENDMENT.—Section 102(b)(1)(A)  
24 of title 35, United States Code, is amended by  
25 striking “the inventor or joint inventor or by

1 another” and inserting “the inventor or a joint  
2 inventor or another”.

3 (B) EFFECTIVE DATE.—The amendment  
4 made by subparagraph (A) shall be effective as  
5 if included in the amendment made by section  
6 3(b)(1) of the Leahy-Smith America Invents  
7 Act (Public Law No. 112–29).

8 (2) ASSIGNEE FILERS.—

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

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

21 (C) DERIVED PATENTS.—Section 291(b)  
22 of title 35, United States Code, is amended by  
23 striking “or joint inventor” and inserting “or a  
24 joint inventor”.

1 (D) EFFECTIVE DATE.—The amendments  
2 made by this paragraph shall take effect on the  
3 date of the enactment of this Act and shall  
4 apply to any patent application, and any patent  
5 issuing from such application, that is filed on or  
6 after September 16, 2012.

7 (3) SPECIFICATION.—Notwithstanding section  
8 4(e) of the Leahy-Smith America Invents Act (Pub-  
9 lic Law 112–29; 125 Stat. 297), the amendments  
10 made by subsections (c) and (d) of section 4 of such  
11 Act shall apply to any patent application or patent,  
12 and in any proceeding or matter, that is pending on,  
13 or filed on or after, the date of the enactment of this  
14 Act.

15 (4) PATENT OWNER RESPONSE.—

16 (A) CONDUCT OF INTER PARTES RE-  
17 VIEW.—Paragraph (8) of section 316(a) of title  
18 35, United States Code, is amended by striking  
19 “the petition under section 313” and inserting  
20 “the petition under section 311”.

21 (B) CONDUCT OF POST-GRANT REVIEW.—  
22 Paragraph (8) of section 326(a) of title 35,  
23 United States Code, is amended by striking  
24 “the petition under section 323” and inserting  
25 “the petition under section 321”.

1 (C) EFFECTIVE DATE.—The amendments  
2 made by this paragraph shall take effect on the  
3 date of the enactment of this Act.

4 (5) INTERNATIONAL APPLICATIONS.—

5 (A) AMENDMENTS.—Section 202(b) of the  
6 Patent Law Treaties Implementation Act of  
7 2012 (Public Law 112–211; 126 Stat. 1536) is  
8 amended—

9 (i) by striking paragraph (7); and

10 (ii) by redesignating paragraphs (8)

11 and (9) as paragraphs (7) and (8).

12 (B) EFFECTIVE DATE.—The amendments  
13 made by subparagraph (A) shall be effective as  
14 if included in title II of the Patent Law Trea-  
15 ties Implementation Act of 2012 (Public Law  
16 No. 112–21).

17 **SEC. 10. EFFECTIVE DATE.**

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