

AMENDMENT NO. \_\_\_\_\_ Calendar No. \_\_\_\_\_

Purpose: To provide procedural improvements to the post-grant review proceedings, and for other purposes.

**IN THE SENATE OF THE UNITED STATES—111th Cong., 1st Sess.**

**S. 515**

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 Mr. KYL (for  
himself and Mr. COBURN)

Viz:

- 1 On page 37, strike lines 14 through 16.
- 2 On page 37, line 17, strike “(g)” and insert “(f)”.
- 3 On page 37, after line 25, insert the following:
- 4 (g) AMENDMENTS TO CHAPTER 31.—
- 5 (1) IN GENERAL.—Chapter 31 of title 35,
- 6 United States Code, is amended—

1 (A) in section 313, by striking “a substan-  
2 tial new question of patentability affecting a  
3 claim of a patent is raised” and inserting “the  
4 information presented in the request, if  
5 un rebutted, would provide a sufficient basis to  
6 conclude that at least 1 of the claims challenged  
7 in the request is unpatentable”; and

8 (B) in section 312, by striking “substantial  
9 new question of patentability” each place that  
10 term appears and inserting “showing required  
11 by section 313”.

12 (2) REGULATIONS.—Section 314(b) of title 35,  
13 United States Code, is amended to read as follows:

14 “(b) The Director shall implement regulations—

15 “(1) allowing the patent owner to file a re-  
16 sponse to a request for inter partes re-examination  
17 that results in an order under section 313; and

18 “(2) setting for standards and procedures al-  
19 lowing the deposition of witnesses submitting affida-  
20 vits or declarations, and other discovery that is nec-  
21 essary in the interest of justice; and

22 “(3) requiring that the final determination in  
23 an inter partes re-examination issue not later than  
24 1 year after the date on which the inter partes re-  
25 examination is ordered under section 313, except

1           that, for good cause shown, the Director may extend  
2           the 1-year period by not more than 6 months.”.

3           (3) MULTIPLE PROCEEDINGS.—Section 317 of  
4           title 35, United States Code, is amended by adding  
5           at the end the following:

6           “(c) The Director may not grant an additional re-  
7           quest for inter partes re-examination if a prior request for  
8           inter partes re-examination has been granted, unless the  
9           Director determines that—

10           “(1) the request satisfies the requirements  
11           under section 313; and

12           “(2) the additional request presents exceptional  
13           circumstances or such an additional inter partes re-  
14           examination is reasonably required by the interests  
15           of justice.

16           “(d)(1) An inter partes re-examination or a pro-  
17           ceeding under chapter 32 may not be ordered or instituted  
18           or maintained if the requester or petitioner or real party  
19           in interest has filed a civil action challenging the validity  
20           of a claim of the patent.

21           “(2) An inter partes re-examination may not be or-  
22           dered if the request for the re-examination is filed more  
23           than 3 months after the date on which the requester, real  
24           party in interest, or his privy is required to respond to  
25           a civil action alleging infringement of the patent.

1           “(3) The Director may stay or dismiss an inter partes  
2 re-examination if the requester or real party in interest  
3 challenges the validity of a claim of the patent in a civil  
4 action.”.

5           (4) CONFORMING AMENDMENT.—Chapter 30 of  
6 title 35, United States Code, is amended—

7           (A) in section 302 (as amended by sub-  
8 section (b) of this section)—

9           (i) by striking “Any person” and in-  
10           serting “The owner of the patent”; and

11           (ii) by striking the last sentence; and

12           (B) in section 304, by striking “If the pat-  
13           ent owner” and all that follows through “reply  
14           filed.”.

15           On page 40, lines 22 and 23, strike “substantial  
16           question of patentability” and insert “showing required by  
17           section 313 of this title”.

18           On page 40, line 25, strike “information” and all that  
19           follows through “patentability” on page 41, line 2, and  
20           insert “showing required by section 313 has been made”.

21           On page 41, between lines 19 and 20, insert the fol-  
22           lowing:

1           “(2) setting forth standards for the showing re-  
2           quired by section 313 of this title;”

3           On page 41, line 20, strike “(2)” and insert “(3)”.

4           On page 41, line 23, strike “(3)” and insert “(4)”.

5           On page 43, line 13, before the comma insert “and  
6 chapter 31”.

7           On page 44, strike lines 5 through 11, and insert the  
8 following: “In a proceeding under this chapter or chapter  
9 31, the petitioner shall bear the burden of proving a prop-  
10 osition of invalidity by a preponderance of the evidence.”.

11          On page 48, between lines 7 and 8, insert the fol-  
12 lowing:

13          “(d) EARLY ACTIONS.—A post-grant review pro-  
14 ceeding may not be instituted until after a civil action al-  
15 leging infringement of the patent is finally concluded if—

16           “(1) the infringement action is filed within 3  
17 months after the grant of the patent;

18           “(2) at the time of issuance, the patent is being  
19 commercially used, or is the subject of substantial

1       preparations for commercial use, by or under the au-  
2       thority of the patent owner or its affiliates;

3           “(3) a stay of the proceeding is requested by  
4       the patent owner;

5           “(4) the Director determines that the infringe-  
6       ment action is likely to address the same or substan-  
7       tially the same questions of patentability that would  
8       be addressed in the proceeding; and

9           “(5) the Director determines that a stay of the  
10      proceeding would not be contrary to the interests of  
11      justice.”.

12       On page 51, line 8, after “section.” insert the fol-  
13      lowing: “The Director may stay implementation of such  
14      regulations for up to 1 additional year upon certification  
15      by the Director that the Patent and Trademark Office  
16      lacks adequate resources to implement the regulations.”

17       On page 58, between lines 2 and 3, insert the fol-  
18      lowing:

19       (d) CONFORMING AMENDMENTS.—Title 35, United  
20      States Code, is amended—

21           (1) in section 116, by striking “and such error  
22      arose without any deceptive intent on his part,”;

1           (2) in section 184, by striking “and without de-  
2           ceptive intent”;

3           (3) in section 185, by striking “and without de-  
4           ceptive intent”;

5           (4) in section 251, by striking “without decep-  
6           tive intention”;

7           (5) in section 253, by striking “, without decep-  
8           tive intention,”;

9           (6) in section 256, by striking “and such error  
10          arose without any deceptive intention on his part”;  
11          and

12          (7) in section 288, by striking “, without decep-  
13          tive intention,”.

14          On page 3, lines 17 and 18, strike “or in public use,  
15          on sale, or otherwise available to the public—” and insert  
16          “or otherwise made available to the public (other than  
17          through testing undertaken to reduce an invention to prac-  
18          tice)—”.