AMENDMENT IN THE NATURE OF A SUBSTITUTE
TO H.R. 3309
OFFERED BY MR. GOODLATTE OF VIRGINIA

Strike all after the enacting clause and insert the following:

1 SECTION 1. SHORT TITLE; TABLE OF CONTENTS.

(a) Short Title.—This Act may be cited as the “Innovation Act”.

(b) Table of Contents.—The table of contents for 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.

2 SEC. 2. DEFINITIONS.

In this Act:

(1) Director.—The term “Director” means the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office.
(2) OFFICE.—The term “Office” means the United States Patent and Trademark Office.

SEC. 3. PATENT INFRINGEMENT ACTIONS.

(a) PLEADING REQUIREMENTS.—

(1) AMENDMENT.—Chapter 29 of title 35, United States Code, is amended by inserting after section 281 the following:

“§ 281A. Pleading requirements for patent infringement actions

“(a) PLEADING REQUIREMENTS.—Except as provided in subsection (b), in a civil action in which a party asserts a claim for relief arising under any Act of Congress relating to patents, a party alleging infringement shall include in the initial complaint, counterclaim, or cross-claim for patent infringement, unless the information is not reasonably accessible to such party, the following:

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

“(2) An identification of each claim of each patent identified under paragraph (1) that is allegedly infringed.

“(3) For each claim identified under paragraph (2), an identification of each accused process, machine, manufacture, or composition of matter (re-
ferred to in this section as an ‘accused instrumentality’) alleged to infringe the claim.

“(4) For each accused instrumentality identified under paragraph (3), an identification with particularity, if known, of—

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

“(B) if there is no name or model number, a description of each accused instrumentality.

“(5) For each accused instrumentality identified under paragraph (3), a clear and concise statement of—

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

“(B) with detailed specificity, how each limitation of each claim identified under paragraph (2) is met by the accused instrumentality.

“(6) For each claim of indirect infringement, a description of the acts of the alleged indirect infringer that contribute to or are inducing the direct infringement.

“(7) A description of the authority of the party alleging infringement to assert each patent identified
under paragraph (1) and of the grounds for the
court’s jurisdiction.

“(8) A clear and concise description of the prin-
cipal business, if any, of the party alleging infringe-
ment.

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

“(10) For each patent identified under para-
graph (1), whether a standard-setting body has spe-
cifically declared such patent to be essential, poten-
tially essential, or having potential to become essen-
tial to that standard-setting body, and whether the
United States Government or a foreign government
has imposed specific licensing requirements with re-
spect to such patent.

“(b) INFORMATION NOT READILY ACCESSIBLE.—If
information required to be disclosed under subsection (a)
is not readily accessible to a party, that information may
instead be generally described along with an explanation
why such undisclosed information was not readily acces-
sible, and any efforts made by such party to access such
information.
“(c) CONFIDENTIAL INFORMATION.—A party required to disclose information described under subsection (a) may file, under seal, information believed to be confidential, with a motion setting forth good cause for such sealing. If such motion is denied by the court, the party may seek to file an amended complaint.

“(d) EXEMPTION.—A civil action that includes a claim for relief arising under section 271(e)(2) shall not be subject to the requirements of subsection (a).”.

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

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

(b) FEES AND OTHER EXPENSES.—

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

“§ 285. Fees and other expenses

“(a) AWARD.—The court shall award, to a prevailing party, reasonable fees and other expenses incurred by that party in connection with a civil action in which any party asserts a claim for relief arising under any Act of Congress relating to patents, unless the court finds that the position and conduct of the nonprevailing party or parties were substantially justified or that special circumstances make an award unjust.
“(b) CERTIFICATION AND RECOVERY.—Upon motion of any party to the action, the court shall require another party to the action to certify whether or not the other party will be able to pay an award of fees and expenses if such an award is made under subsection (a). If a non-prevailing party is unable to pay an award that is made against it under subsection (a), the court may make a party that has been joined under section 299(d) with respect to such party liable for the unsatisfied portion of the award.

“(c) COVENANT NOT TO SUE.—A party to a civil action that asserts a claim for relief arising under any Act of Congress relating to patents against another party, and that subsequently unilaterally extends to such other party a covenant not to sue for infringement with respect to the patent or patents at issue, shall be deemed to be a non-prevailing party (and the other party the prevailing party) for purposes of this section, unless the party asserting such claim would have been entitled, at the time that such covenant was extended, to voluntarily dismiss the action or claim without a court order under Rule 41 of the Federal Rules of Civil Procedure.”.

(2) CONFORMING AMENDMENT AND AMENDMENT.—
(A) CONFORMING AMENDMENT.—The item relating to section 285 of the table of sections for chapter 29 of title 35, United States Code, is amended to read as follows:

“285. Fees and other expenses.”.

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

(3) EFFECTIVE DATE.—The amendments made by this subsection shall take effect on the date of the enactment of this Act and shall apply to any action for which a complaint is filed on or after the first day of the 6-month period ending on that effective date.

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

“(d) JOINDER OF INTERESTED PARTIES.—

“(1) JOINDER.—In a civil action arising under any Act of Congress relating to patents in which fees and other expenses have been awarded under section 285 to a prevailing party defending against an allegation of infringement of a patent claim, and in which the nonprevailing party alleging infringement is unable to pay the award of fees and expenses, the court shall grant a motion by the pre-
vailing party to join an interested party if such pre-
vailing party shows that the nonprevailing party has
no substantial interest in the subject matter at issue
other than asserting such patent claim in litigation.

“(2) LIMITATION ON JOINDER.—

“(A) DISCRETIONARY DENIAL OF MO-
tion.—The court may deny a motion to join an
interested party under paragraph (1) if—

“(i) the interested party is not subject
to service of process; or

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

“(B) REQUIRED DENIAL OF MOTION.—The
court shall deny a motion to join an interested
party under paragraph (1) if—

“(i) the interested party did not time-
ly receive the notice required by paragraph
(3); or

“(ii) within 30 days after receiving
the notice required by paragraph (3), the
interested party renounces, in writing and
with notice to the court and the parties to
the action, any ownership, right, or direct
financial interest (as described in para-
graph (4)) that the interested party has in
the patent or patents at issue.

“(3) NOTICE REQUIREMENT.—An interested
party may not be joined under paragraph (1) unless
it has been provided actual notice, within 30 days
after the date on which it has been identified in the
initial disclosure provided under section 290(b), that
it has been so identified and that such party may
therefore be an interested party subject to joinder
under this subsection. Such notice shall be provided
by the party who subsequently moves to join the in-
terested party under paragraph (1), and shall in-
clude language that—

“(A) identifies the action, the parties
thereto, the patent or patents at issue, and the
pleading or other paper that identified the
party under section 290(b); and

“(B) informs the party that it may be
joined in the action and made subject to paying
an award of fees and other expenses under sec-
tion 285(b) if—

“(i) fees and other expenses are
awarded in the action against the party al-
leging infringement of the patent or pat-
ents at issue under section 285(a);
“(ii) the party alleging infringement is unable to pay the award of fees and expenses;

“(iii) the party receiving notice under this paragraph is determined by the court to be an interested party; and

“(iv) the party receiving notice under this paragraph has not, within 30 days after receiving such notice, renounced in writing, and with notice to the court and the parties to the action, any ownership, right, or direct financial interest (as described in paragraph (4)) that the interested party has in the patent or patents at issue.

“(4) INTERESTED PARTY DEFINED.—In this subsection, the term ‘interested party’ means a person, other than the party alleging infringement, that—

“(A) is an assignee of the patent or patents at issue;

“(B) has a right, including a contingent right, to enforce or sublicense the patent or patents at issue; or
“(C) has a direct financial interest in the patent or patents at issue, including the right to any part of an award of damages or any part of licensing revenue, except that a person with a direct financial interest does not include—

“(i) an attorney or law firm providing legal representation in the civil action described in paragraph (1) if the sole basis for the financial interest of the attorney or law firm in the patent or patents at issue arises from the attorney or law firm’s receipt of compensation reasonably related to the provision of the legal representation; or

“(ii) a person whose sole financial interest in the patent or patents at issue is ownership of an equity interest in the party alleging infringement, unless such person also has the right or ability to influence, direct, or control the civil action.”.

(d) DISCOVERY LIMITS.—

(1) AMENDMENT.—Chapter 29 of title 35, United States Code, is amended by adding at the end the following new section:
§ 299A. Discovery in patent infringement action

(a) Discovery in Patent Infringement Action.—Except as provided in subsection (b), in a civil action arising under any Act of Congress relating to patents, if the court determines that a ruling relating to the construction of terms used in a patent claim asserted in the complaint is required, discovery shall be limited, until such ruling is issued, to information necessary for the court to determine the meaning of the terms used in the patent claim, including any interpretation of those terms used to support the claim of infringement.

(b) Discretion to Expand Scope of Discovery.—

(1) Timely Resolution of Actions.—If, under any provision of Federal law (including the amendments made by the Drug Price Competition and Patent Term Restoration Act of 1984 (Public Law 98–417)), resolution within a specified period of time of a civil action arising under any Act of Congress relating to patents will necessarily affect the rights of a party with respect to the patent, the court shall permit discovery, in addition to the discovery authorized under subsection (a), before the ruling described in subsection (a) is issued as necessary to ensure timely resolution of the action.
“(2) Resolution of motions.—When necessary to resolve a motion properly raised by a party before a ruling relating to the construction of terms described in subsection (a) is issued, the court may allow limited discovery in addition to the discovery authorized under subsection (a) as necessary to resolve the motion.

“(3) Special circumstances.—In special circumstances that would make denial of discovery a manifest injustice, the court may permit discovery, in addition to the discovery authorized under subsection (a), as necessary to prevent the manifest injustice.”.

(2) Conforming amendment.—The table of sections for chapter 29 of title 35, United States Code, is amended by adding at the end the following new item:

“299A. Discovery in patent infringement action.”.

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

SEC. 4. TRANSPARENCY OF PATENT OWNERSHIP.

(a) Amendments.—Section 290 of title 35, United States Code, is amended—
(1) in the heading, by striking “suits” and inserting “suits; disclosure of interests”;

(2) by striking “The clerks” and inserting “(a) NOTICE OF PATENT SUITS.—The clerks”; and

(3) by adding at the end the following new subsections:

“(b) INITIAL DISCLOSURE.—

“(1) IN GENERAL.—Except as provided in paragraph (2), upon the filing of an initial complaint for patent infringement, the plaintiff shall disclose to the Patent and Trademark Office, the court, and each adverse party the identity of each of the following:

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

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

“(C) Any entity, other than the plaintiff, that the plaintiff knows to have a financial interest in the patent or patents at issue or the plaintiff.

“(D) The ultimate parent entity of any assignee identified under subparagraph (A) and any entity identified under subparagraphs (B) and (C).
“(2) EXEMPTION.—The requirements of paragraph (1) shall not apply with respect to a civil action filed under subsection (a) that includes a cause of action described under section 271(e)(2).

“(c) DISCLOSURE COMPLIANCE.—

“(1) PUBLICLY TRADED.—For purposes of subsection (b)(1)(C), if the financial interest is held by a corporation traded on a public stock exchange, an identification of the name of the corporation and the public exchange listing shall satisfy the disclosure requirement.

“(2) NOT PUBLICLY TRADED.—For purposes of subsection (b)(1)(C), if the financial interest is not held by a publicly traded corporation, the disclosure shall satisfy the disclosure requirement if the information identifies—

“(A) in the case of a partnership, the name of the partnership and the name and correspondence address of each partner or other entity that holds more than a 5-percent share of that partnership;

“(B) in the case of a corporation, the name of the corporation, the location of incorporation, the address of the principal place of
business, and the name of each officer of the

corporation; and

“(C) for each individual, the name and

correspondence address of that individual.

“(d) ONGOING DUTY OF DISCLOSURE TO THE PAT-

ENT AND TRADEMARK OFFICE.—

“(1) IN GENERAL.—A plaintiff required to sub-

mit information under subsection (b) or a subse-

quent owner of the patent or patents at issue shall,

not later than 90 days after any change in the as-

signee of the patent or patents at issue or an entity
described under subparagraphs (B) and (D) of sub-

section (b)(1), submit to the Patent and Trademark

Office the updated identification of such assignee or

entity.

“(2) FAILURE TO COMPLY.—With respect to a

patent for which the requirement of paragraph (1)

has not been met—

“(A) the plaintiff or subsequent owner

shall not be entitled to recover reasonable fees

and other expenses under section 285 or in-

creased damages under section 284 with respect
to infringing activities taking place during any

period of noncompliance with paragraph (1),
unless the denial of such damages or fees would be manifestly unjust; and

“(B) the court shall award to a prevailing party accused of infringement reasonable fees and other expenses incurred to discover the updated assignee or entity described under paragraph (1), unless such sanctions would be unjust.

“(e) DEFINITIONS.—In this section:

“(1) FINANCIAL INTEREST.—The term ‘financial interest’—

“(A) means—

“(i) with regard to a patent or patents, the right of a person to receive proceeds related to the assertion of the patent or patents, including a fixed or variable portion of such proceeds; and

“(ii) with regard to the plaintiff, direct or indirect ownership or control by a person of more than 5 percent of such plaintiff; and

“(B) does not mean—

“(i) ownership of shares or other interests in a mutual or common investment fund, unless the owner of such interest
participates in the management of such fund; or

“(ii) the proprietary interest of a policyholder in a mutual insurance company, of a depositor in a mutual savings association, or a similar proprietary interest, unless the outcome of the proceeding could substantially affect the value of such interest.

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

“(3) ULTIMATE PARENT ENTITY.—

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

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

(b) TECHNICAL AND CONFORMING AMENDMENT.—

The item relating to section 290 in the table of sections for chapter 29 of title 35, United States Code, is amended to read as follows:

“290. Notice of patent suits; disclosure of interests.”.
(c) REGULATIONS.—The Director may promulgate such regulations as are necessary to establish a registration fee in an amount sufficient to recover the estimated costs of administering subsections (b) through (e) of section 290 of title 35, United States Code, as added by subsection (a), to facilitate the collection and maintenance of the information required by such subsections, and to ensure the timely disclosure of such information to the public.

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

SEC. 5. CUSTOMER-SUIT EXCEPTION.

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

"§ 296. Stay of action against customer

"(a) STAY OF ACTION AGAINST CUSTOMER.—Except as provided in subsection (d), in any civil action arising under any Act of Congress relating to patents, the court shall grant a motion to stay at least the portion of the action against a covered customer related to infringement of a patent involving a covered product or process if the following requirements are met:
“(1) The covered manufacturer and the covered customer consent in writing to the stay.

“(2) The covered manufacturer is a party to the action or to a separate action involving the same patent or patents related to the same covered product or process.

“(3) The covered customer agrees to be bound by any issues that the covered customer has in common with the covered manufacturer and are finally decided as to the covered manufacturer in an action described in paragraph (2).

“(4) The motion is filed after the first pleading in the action but not later than the later of—

“(A) the 120th day after the date on which the first pleading in the action is served that specifically identifies the covered product or process as a basis for the covered customer’s alleged infringement of the patent and that specifically identifies how the covered product or process is alleged to infringe the patent; or

“(B) the date on which the first scheduling order in the case is entered.

“(b) APPLICABILITY OF STAY.—A stay issued under subsection (a) shall apply only to the patents, products,
systems, or components accused of infringement in the action.

“(c) Lift of Stay.—

“(1) In General.—A stay entered under this section may be lifted upon grant of a motion based on a showing that—

“(A) the action involving the covered manufacturer will not resolve a major issue in suit against the covered customer; or

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

“(2) Separate Manufacturer Action Involved.—In the case of a stay entered based on the participation of the covered manufacturer in a separate action involving the same patent or patents related to the same covered product or process, a motion under this subsection may only be made if the court in such separate action determines the showing required under paragraph (1) has been met.

“(d) Exemption.—This section shall not apply to an action that includes a cause of action described under section 271(e).

“(e) Consent Judgment.—If, following the grant of a motion to stay under this section, the covered manu-
facturer seeks or consents to entry of a consent judgment relating to one or more of the common issues that gave rise to the stay, or declines to prosecute through appeal a final decision as to one or more of the common issues that gave rise to the stay, the court may, upon grant of a motion, determine that such consent judgment or unappealed final decision shall not be binding on the covered customer with respect to one or more of such common issues based on a showing that such an outcome would unreasonably prejudice and be manifestly unjust to the covered customer in light of the circumstances of the case.

“(f) RULE OF CONSTRUCTION.—Nothing in this section shall be construed to limit the ability of a court to grant any stay, expand any stay granted under this section, or grant any motion to intervene, if otherwise permitted by law.

“(g) DEFINITIONS.—In this section:

“(1) COVERED CUSTOMER.—The term ‘covered customer’ means a party accused of infringing a patent or patents in dispute based on a covered product or process.

“(2) COVERED MANUFACTURER.—The term ‘covered manufacturer’ means a person that manufactures or supplies, or causes the manufacture or
supply of, a covered product or process or a relevant part thereof.

“(3) COVERED PRODUCT OR PROCESS.—The term ‘covered product or process’ means a product, process, system, service, component, material, or apparatus, or relevant part thereof, that—

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

“(B) implements a process alleged to infringe the patent or patents in dispute.”.

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

“296. Stay of action against customer.”.

(c) EFFECTIVE DATE.—The amendments made by this section shall take effect on the date of the enactment of this Act and shall apply to any action for which a complaint is filed on or after the first day of the 30-day period that ends on that date.

SEC. 6. PROCEDURES AND PRACTICES TO IMPLEMENT AND RECOMMENDATIONS TO THE JUDICIAL CONFERENCE.

(a) JUDICIAL CONFERENCE RULES AND PROCEDURES ON DISCOVERY BURDENS AND COSTS.—
(1) RULES AND PROCEDURES.—The Judicial Conference of the United States, using existing resources, shall develop rules and procedures to implement the issues and proposals described in paragraph (2) to address the asymmetries in discovery burdens and costs in any civil action arising under any Act of Congress relating to patents. Such rules and procedures shall include how and when payment for document discovery in addition to the discovery of core documentary evidence is to occur, and what information must be presented to demonstrate financial capacity before permitting document discovery in addition to the discovery of core documentary evidence.

(2) RULES AND PROCEDURES TO BE CONSIDERED.—The rules and procedures required under paragraph (1) should address each of the following issues and proposals:

(A) DISCOVERY OF CORE DOCUMENTARY EVIDENCE.—Whether and to what extent each party to the action is entitled to receive core documentary evidence and shall be responsible for the costs of producing core documentary evidence within the possession or control of each such party, and whether and to what ex-
tent each party to the action may seek non-
documentary discovery as otherwise provided in

(B) ELECTRONIC COMMUNICATION.—If the
parties determine that the discovery of elec-
tronic communication is appropriate, whether
such discovery shall occur after the parties have
exchanged initial disclosures and core documen-
tary evidence and whether such discovery shall
be in accordance with the following:

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

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

(iii) A party may not submit produc-
tion requests to more than 5 custodians,
unless the parties jointly agree to modify
the number of production requests without
leave of the court.

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

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

(C) ADDITIONAL DOCUMENT DISCOVERY.—

Whether the following should apply:

(i) IN GENERAL.—Each party to the
action may seek any additional document
discovery otherwise permitted under the
Federal Rules of Civil Procedure, if such
party bears the reasonable costs, including
reasonable attorney’s fees, of the additional
document discovery.

(ii) REQUIREMENTS FOR ADDITIONAL
DOCUMENT DISCOVERY.—Unless the par-
ties mutually agree otherwise, no party
may be permitted additional document discovery unless such a party posts a bond, or provides other security, in an amount sufficient to cover the expected costs of such additional document discovery, or makes a showing to the court that such party has the financial capacity to pay the costs of such additional document discovery.

(iii) LIMITS ON ADDITIONAL DOCUMENT DISCOVERY.—A court, upon motion, may determine that a request for additional document discovery is excessive, irrelevant, or otherwise abusive and may set limits on such additional document discovery.

(iv) GOOD CAUSE MODIFICATION.—A court, upon motion and for good cause shown, may modify the requirements of subparagraphs (A) and (B) and any definition under paragraph (3). Not later than 30 days after the pretrial conference under Rule 16 of the Federal Rules of Civil Procedure, the parties shall jointly submit any proposed modifications of the requirements of subparagraphs (A) and (B) and any def-
inition under paragraph (3), unless the parties do not agree, in which case each party shall submit any proposed modification of such party and a summary of the disagreement over the modification.

(v) **Computer Code.**—A court, upon motion and for good cause shown, may determine that computer code should be included in the discovery of core documentary evidence. The discovery of computer code shall occur after the parties have exchanged initial disclosures and other core documentary evidence.

**(D) Discovery Sequence and Scope.**—Whether the parties shall discuss and address in the written report filed pursuant to Rule 26(f) of the Federal Rules of Civil Procedure the views and proposals of each party on the following:

(i) When the discovery of core documentary evidence should be completed.

(ii) Whether additional document discovery will be sought under subparagraph (C).
(iii) Any issues about infringement, invalidity, or damages that, if resolved before the additional discovery described in subparagraph (C) commences, might simplify or streamline the case, including the identification of any terms or phrases relating to any patent claim at issue to be construed by the court and whether the early construction of any of those terms or phrases would be helpful.

(3) DEFINITIONS.—In this subsection:

(A) CORE DOCUMENTARY EVIDENCE.—The term “core documentary evidence”—

(i) includes—

(I) documents relating to the conception of, reduction to practice of, and application for, the patent or patents at issue;

(II) documents sufficient to show the technical operation of the product or process identified in the complaint as infringing the patent or patents at issue;

(III) documents relating to potentially invalidating prior art;
(IV) documents relating to any licensing of, or other transfer of rights to, the patent or patents at issue before the date on which the complaint is filed;

(V) documents sufficient to show profit attributable to the claimed invention of the patent or patents at issue;

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

(VII) documents relating to any knowledge by the patentee of infringement of the patent or patents at issue before the date on which the complaint is filed;

(VIII) documents relating to any licensing term or pricing commitment to which the patent or patents may be subject through any agency or standard-setting body; and
(IX) documents sufficient to show any marking or other notice provided of the patent or patents at issue; and

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

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

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

(5) AUTHORITY FOR JUDICIAL CONFERENCE TO REVIEW AND MODIFY.—

(A) STUDY OF EFFICACY OF RULES AND PROCEDURES.—The Judicial Conference shall study the efficacy of the rules and procedures required by this subsection during the 4-year period beginning on the date on which such
rules and procedures by the district courts and the United States Court of Federal Claims are first implemented. The Judicial Conference may modify such rules and procedures following such 4-year period.

(B) INITIAL MODIFICATIONS.—Before the expiration of the 4-year period described in sub-paragraph (A), the Judicial Conference may modify the requirements under this sub-section—

(i) by designating categories of “core documentary evidence”, in addition to those designated under paragraph (3)(A), as the Judicial Conference determines to be appropriate and necessary; and

(ii) as otherwise necessary to prevent a manifest injustice, the imposition of a requirement the costs of which clearly outweigh its benefits, or a result that could not reasonably have been intended by the Congress.

(b) JUDICIAL CONFERENCE PATENT CASE MANAGEMENT.—The Judicial Conference of the United States, using existing resources, shall develop case management procedures to be implemented by the United States dis-
strict courts and the United States Court of Federal Claims for any civil action arising under any Act of Congress relating to patents, including initial disclosure and early case management conference practices that—

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

(2) focus on early summary judgment motions when resolution of issues may lead to expedited disposition of the case.

c) Revision of Form for Patent Infringement.—

(1) Elimination of Form.—The Supreme Court, using existing resources, shall eliminate Form 18 in the Appendix to the Federal Rules of Civil Procedure (relating to Complaint for Patent Infringement), effective on the date of the enactment of this Act.

(2) Revised Form.—The Supreme Court may prescribe a new form or forms setting out model allegations of patent infringement that, at a minimum, notify accused infringers of the asserted claim or claims, the products or services accused of infringement, and the plaintiff’s theory for how each accused product or service meets each limitation of each asserted claim. The Judicial Conference should
exercise the authority under section 2073 of title 28, United States Code, to make recommendations with respect to such new form or forms.

(d) PROTECTION OF INTELLECTUAL-PROPERTY LICENSES IN BANKRUPTCY.—

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

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

(B) in paragraph (4), by striking the period at the end and inserting “; and”; and

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

“(5) section 365(n) applies to intellectual property of which the debtor is a licensor or which the debtor has transferred.”.

(2) TRADEMARKS.—

(A) IN GENERAL.—Section 101(35A) of title 11, United States Code, is amended—

(i) in subparagraph (E), by striking “or”;

(ii) in subparagraph (F), by striking “title 17;” and inserting “title 17; or”; and

(iii) by adding after subparagraph (F) the following new subparagraph:
“(G) a trademark, service mark, or trade name, as those terms are defined in section 45 of the Act of July 5, 1946 (commonly referred to as the ‘Trademark Act of 1946’) (15 U.S.C. 1127);”.

(B) Conforming Amendment.—Section 365(n)(2) of title 11, United States Code, is amended—

(i) in subparagraph (B)—

(I) by striking “royalty payments” and inserting “royalty or other payments”; and

(II) by striking “and” after the semicolon;

(ii) in subparagraph (C), by striking the period at the end of clause (ii) and inserting “; and”; and

(iii) by adding at the end the following new subparagraph:

“(D) in the case of a trademark, service mark, or trade name, the trustee shall not be relieved of a contractual obligation to monitor and control the quality of a licensed product or service.”.
(3) Effective Date.—The amendments made by this subsection shall take effect on the date of the enactment of this Act and shall apply to any case that is pending on, or for which a petition or complaint is filed on or after, such date of enactment.

SEC. 7. SMALL BUSINESS EDUCATION, OUTREACH, AND INFORMATION ACCESS.

(a) Small Business Education and Outreach.—

(1) Resources for small business.—Using existing resources, the Director shall develop educational resources for small businesses to address concerns arising from patent infringement.

(2) Small business patent ombudsman.—The Patent Ombudsman Program established under section 28 of the Leahy-Smith America Invents Act (Public Law 112–29; 125 Stat. 339; 35 U.S.C. 2 note) shall coordinate with the existing small business outreach programs of the Office to provide education and awareness on abusive patent litigation practices.

(b) Improving Information Transparency for Small Business and the United States Patent and Trademark Office Users.—
(1) Web site.—Using existing resources, the Director shall create a user-friendly section on the official Web site of the Office to notify the public when a patent case is brought in Federal court and, with respect to each patent at issue in such case, the Director shall include—

(A) information disclosed under subsections (b) and (d) of section 290 of title 35, United States Code, as added by section 4(a) of this Act; and

(B) any other information the Director determines to be relevant.

(2) Format.—In order to promote accessibility for the public, the information described in paragraph (1) shall be searchable by patent number, patent art area, and entity.

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

(a) Study on Secondary Market Oversight for Patent Transactions To Promote Transparency and Ethical Business Practices.—

(1) Study required.—The Director, in consultation with the Secretary of Commerce, the Secretary of the Treasury, the Chairman of the Securities and Exchange Commission, the heads of other
relevant agencies, and interested parties, shall, using
existing resources of the Office, conduct a study—

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

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

(C) to examine licensing and other over-
sight requirements that may be placed on the
patent secondary market, including on the par-
ticipants in such markets, to ensure that the
market is a level playing field and that brokers
in the market have the requisite expertise and
adhere to ethical business practices; and

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

(2) Submission of study.—Not later than 1
year after the date of the enactment of this Act, the
Director shall submit a report to the Committee on
the Judiciary of the House of Representatives and
the Committee on the Judiciary of the Senate on the
findings and recommendations of the Director from
the study required under paragraph (1).
(b) **Study on Patents Owned by the United States Government.**—

(1) **Study Required.**—The Director, in consultation with the heads of relevant agencies and interested parties, shall, using existing resources of the Office, conduct a study on patents owned by the United States Government that—

(A) examines how such patents are licensed and sold, and any litigation relating to the licensing or sale of such patents;

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

(C) examines whether or not each relevant agency maintains adequate records on the patents owned by such agency, specifically whether such agency addresses licensing, assignment, and Government grants for technology related to such patents; and

(D) provides recommendations to ensure that each relevant agency has an adequate point of contact that is responsible for managing the patent portfolio of the agency.
(2) **REPORT ON STUDY.**—Not later than 6 months after the date of the enactment of this Act, the Director shall submit to the Committee on the Judiciary of the House of Representatives and the Committee on the Judiciary of the Senate a report on the findings and recommendations of the Director from the study required under paragraph (1).

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

(1) **GAO STUDY.**—The Comptroller General of the United States shall conduct a study on patent examination at the Office and the technologies available to improve examination and improve patent quality.

(2) **CONTENTS OF THE STUDY.**—The study required under paragraph (1) shall include the following:

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

(B) An examination of ways to improve quality, specifically through technology, that shall include examining best practices at foreign patent offices and the use of existing off-the-shelf technologies to improve patent examination.
(C) A description of how patents are classified.

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

(E) An examination of the types of off-the-shelf prior art databases and search software used by foreign patent offices and governments, particularly in Europe and Asia, and whether those databases and search tools could be used by the Office to improve patent examination.

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

(3) REPORT TO CONGRESS.—Not later than 6 months after the date of the enactment of this Act, the Comptroller General shall submit to the Committee on the Judiciary of the House of Representatives and the Committee on the Judiciary of the Senate a report on the findings and recommendations from the study required by this subsection, including recommendations for any changes to laws and regulations that will improve the examination of patent applications and patent quality.

(d) STUDY ON PATENT SMALL CLAIMS COURT.—

(1) STUDY REQUIRED.—
(A) IN GENERAL.—The Director of the Administrative Office of the United States Courts, in consultation with the Director of the Federal Judicial Center and the United States Patent and Trademark Office, shall, using existing resources, conduct a study to examine the idea of developing a pilot program for patent small claims courts in certain judicial districts within the existing patent pilot program mandated by Public Law 111–349.

(B) CONTENTS OF STUDY.—The study under subparagraph (A) shall examine—

(i) the number of and qualifications for judges that could serve on such small claims courts;

(ii) how such small claims courts would be designated and the necessary criteria for such designation;

(iii) the costs that would be incurred for establishing, maintaining, and operating such a pilot program; and

(iv) the steps that would be taken to ensure that the courts in the pilot program are not misused for abusive patent litigation.
(2) Submission of study.—Not later than 1 year after the date of the enactment of this Act, the Director of the Administrative Office of the United States Courts shall submit a report to the Committee on the Judiciary of the House of Representatives and the Committee on the Judiciary of the Senate on the findings and recommendations of the Director of the Administrative Office from the study required under paragraph (1).

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

(a) Repeal of Civil Action To Obtain a Patent.—

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

(2) Conforming Amendments.—

(A) Federal Circuit Jurisdiction.—

Section 1295(a)(4) of title 28, United States Code, is amended—

(i) in subparagraph (A), by striking “except that an applicant or a party” and all that follows through the end of the subparagraph and inserting the following: “except that a party to a derivation proceeding may also have remedy by civil ac-
tion under section 146 of title 35; an appeal under this subparagraph of a decision of the Board with respect to a derivation proceeding shall waive the right of such party to proceed under section 146 of title 35;”; and

(ii) in subparagraph (C), by striking “section 145, 146, or” and inserting “section 146 or”.

(B) FEDERAL CIRCUIT APPEAL.—Section 141(a) of title 35, United States Code, is amended—

(i) by striking “may appeal the Board’s decision to” and inserting “may appeal the Board’s decision only to”; and

(ii) by striking the second sentence.

(C) ADJUSTMENT OF PATENT TERM.—Section 154(b)(1)(A)(iii) of title 35, United States Code, is amended by striking “section 141, 145, or 146” and inserting “section 141 or 146”.

(D) CLERICAL AMENDMENT.—The table of sections for chapter 13 of title 35, United States Code, is amended by repealing the item relating to section 145.
(3) EFFECTIVE DATE.—The amendments made by this subsection shall apply to any proceeding in which a decision is made by the Patent Trial and Appeal Board on or after the date of the enactment of this Act.

(b) POST-GRANT REVIEW AMENDMENT.—Section 325(e)(2) of title 35, United States Code is amended by striking “or reasonably could have raised”.

(c) USE OF DISTRICT-COURT CLAIM CONSTRUCTION IN POST-GRANT AND INTER PARTES REVIEWS.—

(1) INTER PARTES REVIEW.—Section 316(a) of title 35, United States Code, is amended—

(A) in paragraph (12), by striking “; and” and inserting a semicolon;

(B) in paragraph (13), by striking the period at the end and inserting “; and”; and

(C) by adding at the end the following new paragraph:

“(14) providing that for all purposes under this chapter—

“(A) each claim of a patent shall be construed as such claim would be in a civil action to invalidate a patent under section 282(b), including construing each claim of the patent in accordance with the ordinary and customary
meaning of such claim as understood by one of
ordinary skill in the art and the prosecution
history pertaining to the patent; and

“(B) if a court has previously construed
the claim or a claim term in a civil action in
which the patent owner was a party, the Office
shall consider such claim construction.”.

(2) POST-GRANT REVIEW.—Section 326(a) of
title 35, United States Code, is amended—

(A) in paragraph (11), by striking “; and”
and inserting a semicolon;

(B) in paragraph (12), by striking the pe-
period at the end and inserting “; and”; and

(C) by adding at the end the following new
paragraph:

“(13) providing that for all purposes under this
chapter—

“(A) each claim of a patent shall be con-
strued as such claim would be in a civil action
to invalidate a patent under section 282(b), in-
cluding construing each claim of the patent in
accordance with the ordinary and customary
meaning of such claim as understood by one of
ordinary skill in the art and the prosecution
history pertaining to the patent; and
“(B) if a court has previously construed the claim or a claim term in a civil action in which the patent owner was a party, the Office shall consider such claim construction.”.

(3) TECHNICAL AND CONFORMING AMENDMENT.—Section 18(a)(1)(A) of the Leahy-Smith America Invents Act (Public Law 112–29; 126 Stat. 329; 35 U.S.C. 321 note) is amended by striking “Section 321(e)” and inserting “Sections 321(e) and 326(a)(13))”.

(4) EFFECTIVE DATE.—The amendments made by this subsection shall take effect upon the expiration of the 90-day period beginning on the date of the enactment of this Act, and shall apply to any proceeding under chapter 31 or 32 of title 35, United States Code, as the case may be, for which the petition for review is filed on or after such effective date.

(d) CODIFICATION OF THE DOUBLE-PATENTING DOCTRINE FOR FIRST-INVENTOR-TO-FILE PATENTS.—

(1) AMENDMENT.—Chapter 10 of title 35, United States Code, is amended by adding at the end the following new section:
§ 106. Prior art in cases of double patenting

“A claimed invention of a patent issued under section 151 (referred to as the ‘first patent’) that is not prior art to a claimed invention of another patent (referred to as the ‘second patent’) shall be considered prior art to the claimed invention of the second patent for the purpose of determining the nonobviousness of the claimed invention of the second patent under section 103 if—

“(1) the claimed invention of the first patent was effectively filed under section 102(d) on or before the effective filing date of the claimed invention of the second patent;

“(2) either—

“(A) the first patent and second patent name the same inventor; or

“(B) the claimed invention of the first patent would constitute prior art to the claimed invention of the second patent under section 102(a)(2) if an exception under section 102(b)(2) were deemed to be inapplicable and the claimed invention of the first patent was, or were deemed to be, effectively filed under section 102(d) before the effective filing date of the claimed invention of the second patent; and

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

(2) REGULATIONS.—The Director shall promulgate regulations setting forth the form and content of any disclaimer required for a patent to be issued in compliance with section 106 of title 35, United States Code, as added by paragraph (1). Such regulations shall apply to any disclaimer filed after a patent has issued. A disclaimer, when filed, shall be considered for the purpose of determining the validity of the patent under section 106 of title 35, United States Code.

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

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

(4) EXCLUSIVE RULE.—A patent subject to section 106 of title 35, United States Code, as added by paragraph (1), shall not be held invalid on any nonstatutory, double-patenting ground.

(5) EFFECTIVE DATE.—The amendments made by this subsection shall take effect on the date of the enactment of this Act and shall apply to a patent or patent application only if both the first and second patents described in section 106 of title 35, United States Code, are issued before the enactment date.
States Code, as added by paragraph (1), are patents or patent applications that are described in section 3(n)(1) of the Leahy-Smith America Invents Act (35 U.S.C. 100 note).

(e) PTO PATENT REVIEWS.—

(1) CLARIFICATION.—

(A) Scope of prior art.—Section 18(a)(1)(C)(i) of the Leahy-Smith America Invents Act (35 U.S.C. 321 note) is amended by striking “section 102(a)” and inserting “subsection (a) or (e) of section 102”.

(B) Effective date.—The amendment made by subparagraph (A) shall take effect on the date of the enactment of this Act and shall apply to any proceeding pending on, or filed on or after, such date of enactment.

(2) Authority to waive fee.—Subject to available resources, the Director may waive payment of a filing fee for a transitional proceeding described under section 18(a) of the Leahy-Smith America Invents Act (35 U.S.C. 321 note).

(f) Clarification of limits on Patent Term Adjustment.—

(1) Amendments.—Section 154(b)(1)(B) of title 35, United States Code, is amended—
51

(A) in the matter preceding clause (i), by striking “not including—” and inserting “the term of the patent shall be extended 1 day for each day after the end of that 3-year period until the patent is issued, not including—”;

(B) in clause (i), by striking “consumed by continued examination of the application requested by the applicant” and inserting “consumed after continued examination of the application is requested by the applicant”;

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

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

(2) EFFECTIVE DATE.—The amendments made by this subsection shall apply to any patent application or patent that is pending on, or filed on or after, the date of the enactment of this Act.

(g) CLARIFICATION OF JURISDICTION.—

(1) IN GENERAL.—The Federal interest in preventing inconsistent final judicial determinations as to the legal force or effect of the claims in a patent presents a substantial Federal issue that is important to the Federal system as a whole.

(2) APPLICABILITY.—Paragraph (1)—
(A) shall apply to all cases filed on or after, or pending on, the date of the enactment of this Act; and

(B) shall not apply to a case in which a Federal court has issued a ruling on whether the case or a claim arises under any Act of Congress relating to patents or plant variety protection before the date of the enactment of this Act.

(h) PATENT PILOT PROGRAM IN CERTAIN DISTRICT COURTS DURATION.—Section 1(c) of Public Law 111–349 is amended to read as follows:

“(c) The program established under subsection (a) shall be maintained using existing resources, and shall terminate 20 years after the end of the 6-month period described in subsection (b).”.

(i) TECHNICAL CORRECTIONS.—

(1) NOVELTY.—

(A) AMENDMENT.—Section 102(b)(1)(A) of title 35, United States Code, is amended by striking “the inventor or joint inventor or by another” and inserting “the inventor or a joint inventor or another”.

(B) EFFECTIVE DATE.—The amendment made by subparagraph (A) shall be effective as
if included in the amendment made by section 3(b)(1) of the Leahy-Smith America Invents Act (Public Law 112–29).

(2) Inventor’s Oath or Declaration.—

(A) Amendment.—The second sentence of section 115(a) of title 35, United States Code, is amended—

(i) by striking “Except as otherwise provided” and inserting “Except for an application filed under section 118 or as otherwise provided”; and

(ii) by striking “shall execute” and inserting “may be required by the Director to execute”.

(B) Effective Date.—The amendment made by subparagraph (A) shall be effective as if included in the amendment made by section 4(a)(1) of the Leahy-Smith America Invents Act (Public Law 112–29).

(3) Assignee Filers.—

(A) Benefit of Earlier Filing Date; Right of Priority.—Section 119(e)(1) of title 35, United States Code, is amended, in the first sentence, by striking “by an inventor or inven-
tors named” and inserting “that names the inven-
tor or a joint inventor”.

(B) Benefit of earlier filing date in the United States.—Section 120 of title 35, United States Code, is amended, in the first sentence, by striking “names an inventor or joint inventor” and inserting “names the inventor or a joint inventor”.

(C) Effective date.—The amendments made by this paragraph shall take effect on the date of the enactment of this Act and shall apply to any patent application, and any patent issuing from such application, that is filed on or after September 16, 2012.

(4) Derived patents.—

(A) Amendment.—Section 291(b) of title 35, United States Code, is amended by striking “or joint inventor” and inserting “or a joint inventor”.

(B) Effective date.—The amendment made by subparagraph (A) shall be effective as if included in the amendment made by section 3(h)(1) of the Leahy-Smith America Invents Act (Public Law No. 112–29).
(5) Specification.—Notwithstanding section 4(e) of the Leahy-Smith America Invents Act (Public Law 112–29; 125 Stat. 297), the amendments made by subsections (c) and (d) of section 4 of such Act shall apply to any proceeding or matter that is pending on, or filed on or after, the date of the enactment of this Act.

(6) Time Limit for Commencing Misconduct Proceedings.—

(A) Amendment.—The fourth sentence of section 32 of title 35, United States Code, is amended by striking “1 year” and inserting “2 years”.

(B) Effective Date.—The amendment made by this paragraph shall apply to any action in which the Office files a complaint on or after the date of the enactment of this Act.

(7) Patent Owner Response.—

(A) Conduct of Inter Partes Review.—Paragraph (8) of section 316(a) of title 35, United States Code, is amended by striking “the petition under section 313” and inserting “the petition under section 311”.

(B) Conduct of Post-Grant Review.—

Paragraph (8) of section 326(a) of title 35,
United States Code, is amended by striking “the petition under section 323” and inserting “the petition under section 321”.

(C) **Effective date.**—The amendments made by this paragraph shall take effect on the date of the enactment of this Act.

(8) **International applications.**—

(A) **Amendments.**—Section 202(b) of the Patent Law Treaties Implementation Act of 2012 (Public Law 112–211; 126 Stat. 1536) is amended—

(i) by striking paragraph (7); and

(ii) by redesignating paragraphs (8) and (9) as paragraphs (7) and (8), respectively.

(B) **Effective date.**—The amendments made by subparagraph (A) shall be effective as if included in title II of the Patent Law Treaties Implementation Act of 2012 (Public Law 112–21).

**SEC. 10. Effective date.**

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