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114TH CONGRESS
1ST SESSION

# H. R. 1791

To amend the patent law to promote basic research, to stimulate publication of scientific documents, to encourage collaboration in scientific endeavors, to improve the transfer of technology to the private sector, and for other purposes.

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IN THE HOUSE OF REPRESENTATIVES

APRIL 14, 2015

Mr. SENSENBRENNER (for himself and Mr. CONYERS) introduced the following bill; which was referred to the Committee on the Judiciary

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# A BILL

To amend the patent law to promote basic research, to stimulate publication of scientific documents, to encourage collaboration in scientific endeavors, to improve the transfer of technology to the private sector, and for other purposes.

*Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,*

**SECTION 1. SHORT TITLE.**

This Act may be cited as the ''Grace Period Restoration Act of 2015''.

**SEC. 2. FINDINGS; PURPOSES.**

(a) FINDINGS.—Congress finds the following:

(1) Language in the Leahy-Smith America Invents Act (Public Law 112–29; 125 Stat. 284) and regulations and examination guidelines issued by the United States Patent and Trademark Office implementing provisions of that Act have created uncertainty regarding the scope of the 1-year grace period during which an inventor who discloses an invention to the public may decide whether to file a patent application for the invention (referred to in this Act as the ''grace period'').

(2) The regulatory reading of the Leahy-Smith America Invents Act does not comport with the intent of the sponsors of that Act.

(3) In performing more than 50 percent of all basic research in the United States and pursuing the transfer of research results to the private sector for the benefit of the public under the auspices of chapter 18 of title 35, United States Code (commonly known as the ''Bayh-Dole Act''), institutions of higher education and government laboratories face a difficult and expensive challenge in gaining and utilizing the full scope of patent rights.

(4) The uncertainty relating to the grace period created by the Leahy-Smith America Invents Act adds to the challenge faced by institutions of higher

education and government laboratories in gaining and utilizing the full scope of patent rights.

(5) Job growth and the creation of start-up companies and small businesses are thwarted by uncertainty as to the scope of the grace period and by the difficulty and expense of gaining and utilizing patent rights, which hinders the economy of the United States and the technological leadership of the United States in a competitive global economy.

(6) Ambiguity and uncertainty in statutory text and government regulations breed abusive and expensive patent litigation.

(7) Discouragement of scientific research publication—

(A) delays the disclosure of scientific advances to the public;

(B) thwarts scientific advances;

(C) chills collaborative research activities; and

(D) delays, if not denies, the opportunity for the public to realize the benefits of research results.

(8) Misappropriation by third parties of disclosed inventions is likely to increase, especially in countries that take advantage of the technological

prowess of the United States without appropriately compensating inventors.

(9) Secrecy is anathema to—

(A) the maintenance of a viable United States patent system;

(B) the constitutional purpose of the United States patent system; and

(C) the goal of the United States patent system of promoting scientific progress.

(10) In the words of David J. Kappos, who served as the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office during the enactment of the Leahy-Smith America Invents Act, the grace period before the enactment of the Leahy-Smith America Invents Act was ''the gold standard of best practices''.

(b) PURPOSES.—The purposes of this Act are—

(1) to correct the drafting problem in the Leahy-Smith America Invents Act relating to the grace period; and

(2) to maintain the position of leadership of the United States in educational, technological, and scientific progress.

**SEC. 3. DISCLOSURES FOLLOWING A PUBLIC DISCLOSURE OF A CLAIMED INVENTION BY AN INVENTOR.**

Section 102(b) of title 35, United States Code, is amended by adding at the end the following:

''(3) DISCLOSURES BY ANY PERSON AFTER PUBLIC DISCLOSURE OF A CLAIMED INVENTION BY AN INVENTOR.—

''(A) DEFINITIONS.—In this paragraph—

''(i) the term 'covered person', with respect to a claimed invention, means—

''(I) the inventor;

''(II) a joint inventor; or

''(III) another who obtained the claimed invention directly or indirectly from the inventor or a joint inventor; and

''(ii) the term 'relevant section 112(a) requirements' means the requirements for a specification under section 112(a) other than the requirement to set forth the best mode of carrying out the invention.

''(B) PUBLIC DISCLOSURE.—A disclosure by any person shall not be prior art to a claimed invention under subsection (a) or section 103 if—

"(i) the disclosure is made under subsection (a)(1) or effectively filed under subsection (a)(2) 1 year or less before the effective filing date of the claimed invention; and

"(ii) before the disclosure described in clause (i) is made or filed, and 1 year or less before the effective filing date of the claimed invention, the claimed invention is publicly disclosed in a printed publication by a covered person in a manner that satisfies the relevant section 112(a) requirements.

"(C) DETERMINATION THAT PUBLIC DISCLOSURE WOULD HAVE SATISFIED SPECIFICATION REQUIREMENTS.—In determining under subparagraph (B) whether a claimed invention was publicly disclosed in a printed publication by a covered person in a manner that satisfied the relevant section 112(a) requirements—

"(i) only the state of the art known on and before the date of the disclosure may be considered; and

"(ii) satisfaction of the relevant section 112(a) requirements may be—

"(I) established by 1 or more public disclosures in printed publications made by a covered person during the period of 1 year or less between—

"(aa) the disclosure by the covered person described in subparagraph (B)(ii); and

"(bb) the effective filing date of the claimed invention; and

"(II) supported by statements under declaration or oath relating to the existence and content of the public disclosure or disclosures in printed publications described in subclause (I).

"(D) PRESUMPTION OF VALIDITY.—An applicant for a patent shall present to the Patent and Trademark Office, before the Patent and Trademark Office issues a notice of allowance of the application for the patent, each disclosure under subparagraph (C)(ii)(I) and any statement under subparagraph (C)(ii)(II) in order for the section 112(a) support provided by each such disclosure or statement under sub-

paragraph (C)(ii) to be taken into account under the section 282(a) presumption of validity of an issued patent.

''(E) CERTAIN DISCLOSURES NOT PRIOR ART.—A disclosure described in paragraph (1)(A), (2)(A), or (2)(C) shall not be prior art to a claimed invention under this paragraph.

''(F) PROCEDURES.—The Patent and Trademark Office may establish procedures to carry out this paragraph.''.

**SEC. 4. EFFECTIVE DATE.**

The amendments made by this Act shall take effect as if enacted as part of the Leahy-Smith America Invents Act (Public Law 112–29; 125 Stat. 284).

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