HR 1908

Patent Reform Act of 2007

Congress: 110 (2007–2009, Ended)
Chamber: House
Policy Area: Commerce
Introduced: Apr 18, 2007
Current Status: Read the second time. Placed on Senate Legislative Calendar under General Orders. Calendar No. 348.
Latest Action: Read the second time. Placed on Senate Legislative Calendar under General Orders. Calendar No. 348. (Sep 11, 2007)
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Sponsor

Name: Rep. Berman, Howard L. [D-CA-28]
Party: Democratic • **State:** CA • **Chamber:** House

Cosponsors (23 total)

Cosponsor	Party / State	Role	Date Joined
Rep. Boucher, Rick [D-VA-9]	D · VA		Apr 18, 2007
Rep. Cannon, Chris [R-UT-3]	R · UT		Apr 18, 2007
Rep. Coble, Howard [R-NC-6]	R · NC		Apr 18, 2007
Rep. Conyers, John, Jr. [D-MI-14]	D · MI		Apr 18, 2007
Rep. Goodlatte, Bob [R-VA-6]	R · VA		Apr 18, 2007
Rep. Issa, Darrell E. [R-CA-49]	R · CA		Apr 18, 2007
Rep. Jackson-Lee, Sheila [D-TX-18]	D · TX		Apr 18, 2007
Rep. Lofgren, Zoe [D-CA-16]	D · CA		Apr 18, 2007
Rep. Schiff, Adam B. [D-CA-29]	D · CA		Apr 18, 2007
Rep. Smith, Lamar [R-TX-21]	R · TX		Apr 18, 2007
Rep. Crowley, Joseph [D-NY-7]	D · NY		May 8, 2007
Rep. Emanuel, Rahm [D-IL-5]	D · IL		May 8, 2007
Rep. Eshoo, Anna G. [D-CA-14]	D · CA		May 8, 2007
Rep. Matheson, Jim [D-UT-2]	D · UT		May 8, 2007
Rep. Simpson, Michael K. [R-ID-2]	R · ID		May 8, 2007
Rep. Wasserman Schultz, Debbie [D-FL-20]	D · FL		May 8, 2007
Rep. Wexler, Robert [D-FL-19]	D · FL		May 8, 2007
Rep. Smith, Adam [D-WA-9]	D · WA		May 23, 2007
Rep. Bachus, Spencer [R-AL-6]	R · AL		Aug 2, 2007
Rep. Davis, Jo Ann [R-VA-1]	R · VA		Aug 2, 2007
Rep. Hooley, Darlene [D-OR-5]	D · OR		Aug 2, 2007
Rep. Moran, James P. [D-VA-8]	D · VA		Aug 2, 2007
Rep. Sali, Bill [R-ID-1]	R · ID		Aug 2, 2007

Committee Activity

Committee	Chamber	Activity	Date
Judiciary Committee	House	Reported by	May 16, 2007

Subjects & Policy Tags

Policy Area:

Commerce

Related Bills

Bill	Relationship	Last Action
110 S 1145	Identical bill	**Jan 24, 2008:** An errata sheet on written report No. 110-259 was printed.
110 HRES 636	Procedurally related	**Sep 7, 2007:** Motion to reconsider laid on the table Agreed to without objection.

Summary (as of Sep 7, 2007)

Patent Reform Act of 2007 - Amends federal patent law to establish a first-inventor-to file system and to add or revise provisions governing patent review proceedings and patent infringement litigation.

(Sec. 3) Adds and expands definitions relating to patents. Defines "inventor" as the individual or individuals collectively who invented or discovered the subject matter of the invention and "joint inventor" as any one of the individuals who invented or discovered the subject matter of an invention.

Defines "effective filing date of a claimed invention" as the filing date of the patent or the application for patent containing the claim to the invention (thus establishing a first-inventor-to-file system).

Revises the definition of "prior art" and conditions for patentability to accommodate a first-inventor-to-file system. Reaffirms, with certain exceptions, the denial of a patent for a claimed invention, if such invention was patented, described in a printed publication, in public use, or on sale more than a one-year grace period before the effective filing date of the claimed invention.

Revises provisions for determining claims of patent derivation (i.e., deriving an invention from another inventor and filing a patent application without authorization). Directs the Patent Trial and Appeal Board (formerly the Board of Patent Appeals) to: (1) determine the question of the right to patent; (2) correct the naming of the inventor in any patent application or patent at issue; and (3) issue a final decision on the right to patent. Makes a final decision of the Patent Trial and Appeal Board the final refusal of a patent by the U.S. Patent and Trademark Office (USPTO) in a derivation proceeding. Allows parties to a derivation proceeding to terminate a proceeding by filing a written settlement statement or by referring such proceeding to arbitration.

Requires certification to Congress by the President that major patenting authorities (i.e., at least the patenting authorities in Europe and Japan) have adopted similar grace period provisions as contained in U.S. patent law before first-inventor-to file provisions set forth by this Act become effective.

Requires the Under Secretary of Commerce for Intellectual Property and the Director of the USPTO to: (1) conduct a study every seven years of the effectiveness and efficiency of the first inventor-to-file system; and (2) report to the Judiciary Committees of Congress on such study.

(Sec. 4) Revises requirements for an inventor's oath or declaration to: (1) require each individual who is the inventor or joint inventor of a claimed invention to execute an oath or declaration in connection with a patent application stating that he or she is the original inventor or joint inventor; and (2) allow a substitute statement if the original inventor is dead, legally incapacitated, or cannot be found, or is required to assign the invention and has refused to make an oath or declaration. Sets forth requirements for making substitute statements and supplemental and corrected statements.

(Sec. 5) Expands criteria for determining damages for patent infringement. Sets forth guidelines for courts in determining an award based upon a reasonable royalty relating to the economic and market value of patents attributable to their contribution over prior art. Allows increased damages for willful patent infringement.

Requires the Under Secretary of Commerce for Intellectual Property and the Director of USPTO to: (1) report by June 30, 2009, to the Judiciary Committees of Congress on the operation of prior user rights in selected industrialized countries: and (2) conduct a study every seven years and report to the Judiciary Committees on the effectiveness and efficiency of changes made by this Act for calculating inventor damages.

(Sec. 6) Revises procedures for: (1) citing prior art to USPTO for purposes of determining the patentability of a claimed invention; and (2) reexaminations of patents by the Director of USPTO.

Reassigns inter partes reexamination proceedings to administrative patent judges (currently, conducted by patent examiners). Allows patent owners or third parties to an inter partes reexamination proceeding to request an oral hearing before a patent judge.

Establishes procedures for post-grant review to cancel as unpatentable any claim of a patent on specified grounds of invalidity. Sets forth requirements for a post-grant review petition and the conduct of post-grant review proceedings, including appeals from a final determination of the Patent Trial and Appeal Board.

Repeals provisions of the Intellectual Property and Communications Omnibus Reform Act of 1999 relating to the estoppel effect on subsequent civil actions of requesting an inter partes reexamination.

Requires the Under Secretary of Commerce for Intellectual Property and the Director to issue regulations for post-grant review proceedings within one year of the enactment of this Act.

(Sec. 7) Defines "cancellation petitioner" as the real party in interest requesting cancellation of any claim of a patent and the privies of the real party in interest. Renames the Board of Patent Appeals as the Patent Trial and Appeal Board. Revises provisions relating to the Board's membership, duties, and authorities.

(Sec. 8) Directs the Under Secretary of Commerce for Intellectual Property and the Director of USPTO to study and report to the Judiciary Committees on the effectiveness and efficiency of proceedings available for the reexamination of patents.

(Sec. 9) Imposes time restrictions on the publication of certain pending patent applications.

Allows any third person to submit for consideration and inclusion in the record of a patent application, any patent, published patent application, or other publication of potential relevance to the examination of a patent application. Requires such submission to be made in writing, with a concise description of its relevance, before the earlier of: (1) the mailing of a notice of allowance in the application for a patent; or (2) the date that is six months after publication of the application or that date of the first rejection of any claim in the application, whichever is later.

(Sec. 10) Renders any tax planning method unpatentable. Defines "tax planning method" as a plan, strategy, technique, or scheme that reduces, minimizes, or defers individual tax liability.

(Sec. 11) Amends the federal judicial code to prohibit patent litigants from manufacturing venue by assignment, incorporation, or otherwise to invoke the venue of a specific federal district court. Restricts venue in patent litigation to a judicial district where: (1) the defendant has its principal place of business or is incorporated; (2) the defendant has committed a substantial portion of the acts of infringement and has a regular and established physical facility; (3) the primary plaintiff resides, if the primary plaintiff is an institution of higher education or a nonprofit organization; (4) the primary plaintiff has a place of business engaged in substantial research and development, manufacturing, or the management of such activities;(5) the plaintiff resides, if the plaintiff is named as inventor or co-inventor and there has been no transfer of rights in the patent; or (6) any defendants have substantial evidence and witnesses. Allows venue in any district for cases involving foreign defendants with no U.S. subsidiary.

Allows an appeal to the Court of Appeals for the Federal Circuit from an interlocutory order or decree determining construction of claims in a patent infringement case.

Provides for the transfer of any case commenced in a U.S. district court on or after September 7, 2007, in which venue is improper, unless substantive rulings have been made in such case or the court finds that transfer would not serve the interests of justice.

(Sec. 12) Requires the Director of USPTO to require patent applicants (except for micro-entities as defined by this Act) to submit a search report and other information and analysis relevant to patentability.

Establishes inequitable conduct (i.e., intentionally misleading or deceiving the USPTO or failing to disclose material information) as a defense to a patent infringement claim . Requires a showing of inequitable conduct by clear and convincing evidence. Provides for sanctions against attorneys involved in inequitable conduct.

(Sec. 13) Eliminates as a defense to a patent infringement claim the failure of an inventor to comply with the best mode of carrying out an invention.

(Sec. 14) Grants specific regulatory authority to USPTO over the quality and timeliness of patent applications and their examination. Requires regulations promulgated by USPTO to be reviewed and approved by Congress.

(Sec. 16) Requires the Director of the Administrative Office of the U.S. Courts, in consultation with the Federal Judicial Center, to study and report to the Judiciary Committees on the use of special masters in patent litigation.

(Sec. 17) Directs the Comptroller General, within two years after the enactment of this Act, to conduct a study of workplace conditions for the examiner corps of USPTO and to submit the results of such study, with any other recommendations relating to patent reexamination proceedings, to the Judiciary Committees.

(Sec. 18) Reaffirms congressional intent to promote joint research activities as previously expressed, including in the legislative history, by the enactment of the Cooperative Research and Technology Enhancement Act (CREATE Act). Directs USPTO to administer the joint research provisions of this Act in a manner consistent with the legislative history of the CREATE Act.

(Sec. 19) Directs the Under Secretary of Commerce for Intellectual Property and the Director of USPTO to study and report to Congress on patent damage awards based on a reasonable royalty standard.

(Sec. 20) Provides for severability of provisions of this Act held to be invalid or unenforceable.

Actions Timeline

- **Sep 11, 2007:** Read the second time. Placed on Senate Legislative Calendar under General Orders. Calendar No. 348.
- **Sep 10, 2007:** Received in the Senate. Read the first time. Placed on Senate Legislative Calendar under Read the First Time.
- **Sep 7, 2007:** Rule H. Res. 636 passed House.
- **Sep 7, 2007:** Considered under the provisions of rule H. Res. 636. (consideration: CR H10270-10307; text of measure as reported in House: CR H10285-10292)
- **Sep 7, 2007:** Rule provides for consideration of H.R. 1908 with 1 hour of general debate. Previous question shall be considered as ordered without intervening motions except motion to recommit with or without instructions. Measure will be considered read. Specified amendments are in order. All points of order againist consideration of the bill are waived except those arising under clause 9 or 10 of rule XXI. The resolution provides that the amendment in the nature of a substitute recommended by the Committee on the Judiciary, now printed in the bill shall be considered as an original bill.
- **Sep 7, 2007:** House resolved itself into the Committee of the Whole House on the state of the Union pursuant to H. Res. 636 and Rule XVIII.
- **Sep 7, 2007:** The Speaker designated the Honorable Hilda L. Solis to act as Chairwoman of the Committee.
- **Sep 7, 2007:** GENERAL DEBATE - The Committee of the Whole proceeded with one hour of general debate on H.R. 1908.
- **Sep 7, 2007:** DEBATE - Pursuant to the provisions of H. Res. 636, the Committee of the Whole proceeded with 20 minutes of debate on the Conyers amendment.
- **Sep 7, 2007:** POSTPONED PROCEEDINGS - At the conclusion of debate on the Conyers amendment the Chair put the question on adoption of the amendment and by voice vote, announced that the noes had prevailed. Mr. Berman demanded a recorded vote and the Chair postponed further proceedings on the question of adoption of the amendment until later in the legislative day.
- **Sep 7, 2007:** DEBATE - Pursuant to the provisions of H. Res. 636, the Committee of the Whole proceeded with 10 minutes of debate on the Issa amendment.
- **Sep 7, 2007:** POSTPONED PROCEEDINGS - At the conclusion of debate on the Issa amendment the Chair put the question on adoption of the amendment and by voice vote, announced that the ayes had prevailed. Mr. Rohrabacher demanded a recorded vote and the Chair postponed further proceedings on the question of adoption of the amendment until later in the legislative day.
- **Sep 7, 2007:** DEBATE - Pursuant to the provisions of H. Res. 636, the Committee of the Whole proceeded with 10 minutes of debate on the Jackson-Lee amendment.
- **Sep 7, 2007:** POSTPONED PROCEEDINGS - At the conclusion of debate on the Jackson-Lee (TX) amendment the Chair put the question on adoption of the amendment and by voice vote, announced that the ayes had prevailed. Mr. Rohrabacher demanded a recorded vote and the Chair postponed further proceedings on the question of adoption of the amendment until later in the legislative day.
- **Sep 7, 2007:** DEBATE - Pursuant to the provisions of H. Res. 636, the Committee of the Whole proceeded with 10 minutes of debate on the Pence amendment.
- **Sep 7, 2007:** ORDER OF PROCEDURE - Mr. Rohrabacher asked unanimous consent that his requests for recorded votes on amendments numbered 2, 3 and 4 be withdrawn to the end that the amendments be considered as disposed of according to the voice votes taken in each instance. Agreed to without objection.
- **Sep 7, 2007:** The House rose from the Committee of the Whole House on the state of the Union to report H.R. 1908.
- **Sep 7, 2007:** The previous question was ordered pursuant to the rule. (consideration: CR H10307)
- **Sep 7, 2007:** The House adopted the amendment in the nature of a substitute as agreed to by the Committee of the Whole House on the state of the Union.
- **Sep 7, 2007:** Passed/agreed to in House: On passage Passed by recorded vote: 220 - 175 (Roll no. 863).
- **Sep 7, 2007:** On passage Passed by recorded vote: 220 - 175 (Roll no. 863).
- **Sep 7, 2007:** Motion to reconsider laid on the table Agreed to without objection.
- **Sep 7, 2007:** The Clerk was authorized to correct section numbers, punctuation, and cross references, and to make other necessary technical and conforming corrections in the engrossment of H.R. 1908.
- **Sep 6, 2007:** Rules Committee Resolution H. Res. 636 Reported to House. Rule provides for consideration of H.R. 1908 with 1 hour of general debate. Previous question shall be considered as ordered without intervening motions except motion to recommit with or without instructions. Measure will be considered read. Specified amendments are in order. All points of order againist consideration of the bill are waived except those arising under clause 9 or 10 of rule XXI.

The resolution provides that the amendment in the nature of a substitute recommended by the Committee on the Judiciary, now printed in the bill shall be considered as an original bill.

- **Sep 4, 2007:** Reported (Amended) by the Committee on Judiciary. H. Rept. 110-314.
- **Sep 4, 2007:** Placed on the Union Calendar, Calendar No. 200.
- **Jul 18, 2007:** Committee Consideration and Mark-up Session Held.
- **Jul 18, 2007:** Ordered to be Reported (Amended) by Voice Vote.
- **May 16, 2007:** Subcommittee Consideration and Mark-up Session Held.
- **May 16, 2007:** Forwarded by Subcommittee to Full Committee by Voice Vote .
- **Apr 26, 2007:** Subcommittee Hearings Held.
- **Apr 20, 2007:** Referred to the Subcommittee on Courts, the Internet, and Intellectual Property.
- **Apr 18, 2007:** Introduced in House
- **Apr 18, 2007:** Sponsor introductory remarks on measure. (CR E773-775)
- **Apr 18, 2007:** Referred to the House Committee on the Judiciary.

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