H.R. REP. 112-98(I), H.R. REP. 112-98, H.R. Rep. No. 98(I), 112TH Cong., 1ST Sess. 2011, 2011 WL 2150541, 2011 U.S.C.C.A.N. 67 (Leg.Hist.)
P.L. 112-29, **67 AMERICA INVENTS ACT

DATES OF CONSIDERATION AND PASSAGE

House: June 23, 2011
Senate: September 8, 2011
Cong. Record Vol. 157 (2011)

House Report (Judiciary Committee)
No. 112-98, June 1, 2011
[To accompany H.R. 1249]

HOUSE REPORT NO. 112–98(I)

June 1, 2011

***1** Mr. Smith of Texas, from the Committee on the Judiciary, submitted the following

REPORT

[To accompany H.R. 1249]

The Committee on the Judiciary, to whom was referred the bill (H.R. 1249) to amend title 35, United States Code, to provide for patent reform, having considered the same, reports favorably thereon with an amendment and recommends that the bill as amended do pass.

CONTENTS

***2 **0** THE AMENDMENT

The amendment is as follows:

Strike all after the enacting clause and insert the following:

SECTION 1. SHORT TITLE; TABLE OF CONTENTS.

(a) Short Title.–This Act may be cited as the “America Invents Act”.

(b) Table of Contents.–The table of contents for this Act is as follows:

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.

(3) Patent public advisory committee.–The term “Patent Public Advisory Committee” means the Patent Public Advisory Committee established under section 5(a)(1) of title 35, United States Code.

(4) Trademark act of 1946.–The term “Trademark Act of 1946” means the Act entitled “An Act to provide for the registration and protection of trademarks used in commerce, to carry out the provisions of certain international conventions,

and for other purposes", approved July 5, 1946 (15 U.S.C. 1051 et seq.) (commonly referred to as the "Trademark Act of 1946" or the "Lanham Act").

(5) Trademark public advisory committee.–The term "Trademark Public Advisory Committee" means the Trademark Public Advisory Committee established under section 5(a)(1) of title 35, United States Code.

SEC. 3. FIRST INVENTOR TO FILE.

(a) Definitions.–Section 100 of title 35, United States Code, is amended–

(1) in subsection (e), by striking "or inter partes reexamination under section 311"; and

(2) by adding at the end the following:

"(f) The term 'inventor' means the individual or, if a joint invention, the individuals collectively who invented or discovered the subject matter of the invention.

"(g) The terms 'joint inventor' and 'coinventor' mean any 1 of the individuals who invented or discovered the subject matter of a joint invention.

"(h) The term 'joint research agreement' means a written contract, grant, or cooperative agreement entered into by 2 or more persons or entities for the performance of experimental, developmental, or research work in the field of the claimed invention.

"(i)(1) The term 'effective filing date' for a claimed invention in a patent or application for patent means–

"(A) if subparagraph (B) does not apply, the actual filing date of the patent or the application for the patent containing a claim to the invention; or

***3** "(B) the filing date of the earliest application for which the patent or application is entitled, as to such invention, to a right of priority under section 119, 365(a), or 365(b) or to the benefit of an earlier filing date un

"(2) The effective filing date for a claimed invention in an application for reissue or reissued patent shall be determined by deeming the claim to the invention to have been contained in the patent for which reissue was sought.

"(j) The term 'claimed invention' means the subject matter defined by a claim in a patent or an application for a patent.".

(b) Conditions for Patentability.–

(1) In general.–Section 102 of title 35, United States Code, is amended to read as follows:

"S 102. Conditions for patentability; novelty

"(a) Novelty; Prior Art.–A person shall be entitled to a patent unless–

"(1) the claimed invention was patented, described in a printed publication, or in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention; or

"(2) the claimed invention was described in a patent issued under section 151, or in an application for patent published or deemed published under section 122(b), in which the patent or application, as the case may be, names another inventor and was effectively filed before the effective filing date of the claimed invention.

"(b) Exceptions.–

"(1) Disclosures made 1 year or less before the effective filing date of the claimed invention.–A disclosure made 1 year or less before the effective filing date of a claimed invention shall not be prior art to the claimed invention under subsection (a)(1) if–

"(A) the disclosure was made by the inventor or joint inventor or by another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor; or

"(B) the subject matter disclosed had, before such disclosure, been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor.

"(2) Disclosures appearing in applications and patents.–A disclosure shall not be prior art to a claimed invention under subsection (a)(2) if–

"(A) the subject matter disclosed was obtained directly or indirectly from the inventor or a joint inventor;

"(B) the subject matter disclosed had, before such subject matter was effectively filed under subsection (a)(2), been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor; or

"(C) the subject matter disclosed and the claimed invention, not later than the effective filing date of the claimed invention, were owned by the same person or subject to an obligation of assignment to the same person.

"(c) Common Ownership Under Joint Research Agreements.–Subject matter disclosed and a claimed invention shall be deemed to have been owned by the same person or subject to an obligation of assignment to the same person in applying the provisions of subsection (b)(2)(C) if–

"(1) the subject matter disclosed was developed and the claimed invention was made by, or on behalf of, 1 or more parties to a joint research agreement that was in effect on or before the effective filing date of the claimed invention;

"(2) the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement; and

"(3) the application for patent for the claimed invention discloses or is amended to disclose the names of the parties to the joint research agreement.

"(d) Patents and Published Applications Effective as Prior Art.–For purposes of determining whether a patent or application for patent is prior art to a claimed invention under subsection (a)(2), such patent or application shall be considered to have been effectively filed, with respect to any subject matter described in the patent or application–

"(1) if paragraph (2) does not apply, as of the actual filing date of the patent or the application for patent; or

"(2) if the patent or application for patent is entitled to claim a right of priority under section 119, 365(a), or 365(b), or to claim the benefit of an earlier filing date under section 120, 121, or 365(c), based upon 1 or more prior filed applications for patent, as of the filing date of the earliest such application that describes the subject matter.".

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