

118TH CONGRESS
1ST SESSION

S. 2220

To amend title 35, United States Code, to invest in inventors in the United States, maintain the United States as the leading innovation economy in the world, and protect the property rights of the inventors that grow the economy of the United States, and for other purposes.

IN THE SENATE OF THE UNITED STATES

JULY 10, 2023

Mr. COONS (for himself, Mr. TILLIS, Mr. DURBIN, and Ms. HIRONO) introduced the following bill; which was read twice and referred to the Committee on the Judiciary

A BILL

To amend title 35, United States Code, to invest in inventors in the United States, maintain the United States as the leading innovation economy in the world, and protect the property rights of the inventors that grow the economy of the United States, and for other purposes.

1 *Be it enacted by the Senate and House of Representa-*
2 *tives of the United States of America in Congress assembled,*

3 **SECTION 1. SHORT TITLE.**

4 This Act may be cited as the “Promoting and Re-
5 specting Economically Vital American Innovation Leader-
6 ship Act” or the “PREVAIL Act”.

1 **SEC. 2. FINDINGS.**

2 Congress finds the following:

3 (1) The patent property rights enshrined in the
4 Constitution of the United States provide the foun-
5 dation for the exceptional innovation environment in
6 the United States.

7 (2) Reliable and effective patent protection en-
8 courages United States inventors to invest their re-
9 sources in creating new inventions.

10 (3) United States inventors have made discov-
11 eries leading to patient cures, positive changes to the
12 standard of living for all people in the United
13 States, and improvements to the agricultural, tele-
14 communications, and electronics industries, among
15 others.

16 (4) The United States patent system is an es-
17 sential part of the economic success of the United
18 States.

19 (5) Reliable and effective patent protection im-
20 proves the chances of success for individual inven-
21 tors and small companies and increases the chances
22 of securing investments for those inventors and com-
23 panies.

24 (6) Intellectual property-intensive industries in
25 the United States—

1 (A) generate tens of millions of jobs for in-
2 dividuals in the United States; and

3 (B) account for more than $\frac{1}{3}$ of the gross
4 domestic product of the United States.

5 (7) The National Security Commission on Arti-
6 ficial Intelligence has emphasized that—

7 (A) the People’s Republic of China is
8 leveraging and exploiting intellectual property
9 as a critical tool within its national strategies
10 for emerging technologies; and

11 (B) the United States has failed to simi-
12 larly recognize the importance of intellectual
13 property in securing its own national security,
14 economic interests, and technological competi-
15 tiveness.

16 (8) In the highly competitive global economy,
17 the United States needs reliable and effective patent
18 protections to safeguard national security interests
19 and maintain its position as the most innovative
20 country in the world.

21 (9) Congress last enacted comprehensive re-
22 forms of the patent system in 2011.

23 (10) Unintended consequences of the com-
24 prehensive 2011 reform of patent laws have become
25 evident during the decade preceding the date of en-

1 actment of this Act, including the strategic filing of
2 post-grant review proceedings to depress stock prices
3 and extort settlements, the filing of repetitive peti-
4 tions for inter partes and post-grant reviews that
5 have the effect of harassing patent owners, and the
6 unnecessary duplication of work by the district
7 courts of the United States and the Patent Trial
8 and Appeal Board, all of which drive down invest-
9 ment in innovation and frustrate the purpose of
10 those patent reform laws.

11 (11) Efforts by Congress to reform the patent
12 system without careful scrutiny create a serious risk
13 of making it more costly and difficult for innovators
14 to protect their patents from infringement, there-
15 by—

16 (A) disincentivizing United States compa-
17 nies from innovating; and

18 (B) weakening the economy of the United
19 States.

20 **SEC. 3. PATENT TRIAL AND APPEAL BOARD.**

21 Section 6 of title 35, United States Code, is amend-
22 ed—

23 (1) by redesignating subsections (b), (c), and
24 (d) as subsections (c), (d), and (e), respectively;

1 (2) by inserting after subsection (a) the fol-
2 lowing:

3 “(b) CODE OF CONDUCT.—

4 “(1) IN GENERAL.—The Director shall pre-
5 scribe regulations establishing a code of conduct for
6 the members of the Patent Trial and Appeal Board.

7 “(2) CONSIDERATIONS.—In prescribing regula-
8 tions under paragraph (1), the Director shall con-
9 sider the Code of Conduct for United States Judges
10 and how the provisions of that Code of Conduct may
11 apply to the Patent Trial and Appeal Board.”;

12 (3) by striking subsection (d), as so redesign-
13 ated, and inserting the following:

14 “(d) 3-MEMBER PANELS.—

15 “(1) IN GENERAL.—Each appeal, derivation
16 proceeding, post-grant review, and inter partes re-
17 view shall be heard by at least 3 members of the
18 Patent Trial and Appeal Board, who shall be des-
19 ignated by the Director. The Patent Trial and Ap-
20 peal Board may grant rehearings.

21 “(2) CHANGES TO CONSTITUTION OF PANEL.—

22 After the constitution of a panel of the Patent Trial
23 and Appeal Board under this subsection has been
24 made public, any changes to the constitution of that
25 panel, including changes that were made before the

1 constitution of the panel was made public, shall be
2 noted in the record.

3 “(3) NO DIRECTION OR INFLUENCE.—An offi-
4 cer who has supervisory authority or disciplinary au-
5 thority with respect to an administrative patent
6 judge of the Patent Trial and Appeal Board (or a
7 delegate of such an officer), and who is not a mem-
8 ber of a panel described in this subsection, shall re-
9 frain from communications with the panel that di-
10 rect or otherwise influence any merits decision of the
11 panel.

12 “(4) INELIGIBILITY TO HEAR REVIEW.—A
13 member of the Patent Trial and Appeal Board who
14 participates in the decision to institute an inter-
15 partes review or a post-grant review of a patent shall
16 be ineligible to hear the review.”; and

17 (4) in subsection (e), as so redesignated—

18 (A) in the first sentence—

19 (i) by striking “this subsection” and
20 inserting “the date of enactment of the
21 Promoting and Respecting Economically
22 Vital American Innovation Leadership
23 Act”;

1 (ii) by striking “by the Director” and
 2 inserting “by the Director or the Sec-
 3 retary”; and

4 (iii) by inserting “or the Secretary, as
 5 applicable,” after “on which the Director”;
 6 and

7 (B) in the second sentence—

8 (i) by inserting after “by the Direc-
 9 tor” the following: “, or, before the date of
 10 enactment of the Promoting and Respect-
 11 ing Economically Vital American Innova-
 12 tion Leadership Act, having performed du-
 13 ties no longer performed by administrative
 14 patent judges,”; and

15 (ii) by striking “that the administra-
 16 tive patent judge so appointed” and insert-
 17 ing “that the applicable administrative pat-
 18 ent judge”.

19 **SEC. 4. INTER PARTES REVIEW.**

20 (a) **STANDING AND REAL PARTIES IN INTEREST.—**

21 Section 311 of title 35, United States Code, is amended
 22 by adding at the end the following:

23 “(d) **PERSONS THAT MAY PETITION.—**

24 “(1) **DEFINITION.—**In this subsection, the term
 25 ‘charged with infringement’ means a real and sub-

1 stantial controversy regarding infringement of a pat-
2 ent exists such that the person would have standing
3 to bring a declaratory judgment action in Federal
4 court.

5 “(2) NECESSARY CONDITIONS.—A person may
6 not file with the Office a petition to institute an
7 inter partes review of a patent unless the person, or
8 a real party in interest or a privy of the person, has
9 been—

10 “(A) sued for infringement of the patent;

11 or

12 “(B) charged with infringement of the pat-
13 ent.

14 “(e) REAL PARTY IN INTEREST.—For purposes of
15 this chapter, a person that, directly or through an affiliate,
16 subsidiary, or proxy, makes a financial contribution to the
17 preparation for, or conduct during, an inter partes review
18 on behalf of a petitioner shall be considered a real party
19 in interest of that petitioner.”.

20 (b) INSTITUTION DECISION REHEARING TIMING.—
21 Section 314 of title 35, United States Code, is amended
22 by adding at the end the following:

23 “(e) REHEARING.—Not later than 45 days after the
24 date on which a request for rehearing from a determina-
25 tion by the Director under subsection (b) is filed, the Di-

1 rector shall finally decide any request for reconsideration,
2 rehearing, or review with respect to the determination, ex-
3 cept that the Director may, for good cause shown, extend
4 that 45-day period by not more than 30 days.”.

5 (c) ELIMINATING REPETITIVE PROCEEDINGS.—

6 (1) IN GENERAL.—Section 315 of title 35,
7 United States Code, is amended—

8 (A) in subsection (b), by amending the sec-
9 ond sentence to read as follows: “The time limi-
10 tation set forth in the preceding sentence shall
11 not bar a request for joinder under subsection
12 (d), but shall establish a rebuttable presump-
13 tion against joinder for the requesting person.”;

14 (B) by redesignating subsections (c), (d),
15 and (e) as subsections (d), (e), and (f), respec-
16 tively;

17 (C) by inserting after subsection (b) the
18 following:

19 “(c) SINGLE FORUM.—

20 “(1) IN GENERAL.—If an inter partes review is
21 instituted challenging the validity of a patent, the
22 petitioner, a real party in interest, or a privy of the
23 petitioner may not file or maintain, in a civil action
24 arising in whole or in part under section 1338 of
25 title 28, or in a proceeding before the International

1 Trade Commission under section 337 of the Tariff
2 Act of 1930 (19 U.S.C. 1337), a claim, a counter-
3 claim, or an affirmative defense challenging the va-
4 lidity of any claim of the patent on any ground de-
5 scribed in section 311(b).

6 “(2) CONSIDERATIONS.—In determining wheth-
7 er to institute a proceeding under this chapter, sub-
8 ject to the provisions of subsections (a)(1) and (g),
9 the Director may not reject a petition requesting an
10 inter partes review on the basis of the petitioner, a
11 real party in interest, or a privy of the petitioner fil-
12 ing or maintaining a claim, a counterclaim, or an af-
13 firmative defense challenging the validity of the ap-
14 plicable patent in any civil action arising in whole or
15 in part under section 1338 of title 28, or in a pro-
16 ceeding before the International Trade Commission
17 under section 337 of the Tariff Act of 1930 (19
18 U.S.C. 1337).”;

19 (D) by amending subsection (d), as so re-
20 designated, to read as follows:

21 “(d) JOINDER.—

22 “(1) IN GENERAL.—If the Director institutes
23 an inter partes review, the Director, in the discretion
24 of the Director, may join as a party to that inter
25 partes review any person that properly files a re-

1 quest to join the inter partes review and a petition
2 under section 311 that the Director, after receiving
3 a preliminary response under section 313 or the ex-
4 piration of the time for filing such a response, deter-
5 mines warrants the institution of an inter partes re-
6 view under section 314.

7 “(2) TIME-BARRED PERSON.—Pursuant to
8 paragraph (1), the Director, in the discretion of the
9 Director, may join as a party to an inter partes re-
10 view a person that did not satisfy the time limitation
11 under subsection (b) that rebuts the presumption
12 against joinder, except that any such person shall
13 not be permitted to serve as the lead petitioner and
14 shall not be permitted to maintain the inter partes
15 review unless a petitioner that satisfied the time lim-
16 itation under subsection (b) remains in the inter
17 partes review.”;

18 (E) by amending subsection (e), as so re-

19 designated, to read as follows:

20 “(e) MULTIPLE PROCEEDINGS.—

21 “(1) IN GENERAL.—Notwithstanding sections
22 135(a), 251, and 252, and chapter 30, after a peti-
23 tion to institute an inter partes review is filed, if an-
24 other proceeding or matter involving the patent is
25 before the Office—

1 “(A) the parties shall notify the Director
2 of that other proceeding or matter—

3 “(i) not later than 30 days after the
4 date of entry of the notice of filing date ac-
5 corded to the petition; or

6 “(ii) if the other proceeding or matter
7 is filed after the date on which the petition
8 to institute an inter partes review is filed,
9 not later than 30 days after the date on
10 which the other proceeding or matter is
11 filed; and

12 “(B) the Director shall issue a decision de-
13 termining the manner in which the inter partes
14 review or other proceeding or matter may pro-
15 ceed, including providing for stay, transfer, con-
16 solidation, or termination of any such matter or
17 proceeding.

18 “(2) CONSIDERATIONS.—In determining wheth-
19 er to institute a proceeding under this chapter, the
20 Director shall, unless the Director determines that
21 the petitioner has demonstrated exceptional cir-
22 cumstances, reject any petition that presents prior
23 art or an argument that is the same or substantially
24 the same as prior art or an argument that previously
25 was presented to the Office.”;

1 (F) by amending subsection (f), as so re-
2 designated, to read as follows:

3 “(f) ESTOPPEL.—

4 “(1) IN GENERAL.—A petitioner that has pre-
5 viously requested an inter partes review of a claim
6 in a patent under this chapter, or a real party in in-
7 terest or a privy of such a petitioner, may not re-
8 quest or maintain another proceeding before the Of-
9 fice with respect to that patent on any ground that
10 the petitioner raised or reasonably could have raised
11 in the petition requesting or during the prior inter
12 partes review, unless—

13 “(A) after the filing of the initial petition,
14 the petitioner, or a real party in interest or a
15 privy of the petitioner, is charged with infringe-
16 ment of additional claims of the patent;

17 “(B) a subsequent petition requests an
18 inter partes review of only the additional claims
19 of the patent that the petitioner, or a real party
20 in interest or a privy of the petitioner, is later
21 charged with infringing; and

22 “(C) that subsequent petition is accom-
23 panied by a request for joinder to the prior
24 inter partes review, which overcomes the rebut-
25 table presumption against joinder set forth in

1 subsection (b), and which the Director shall
2 grant if the Director authorizes an inter partes
3 review to be instituted on the subsequent peti-
4 tion under section 314.

5 “(2) JOINED PARTY.—Any person joined as a
6 party to an inter partes review, and any real party
7 in interest or any privy of such person, shall be es-
8 topped under this subsection and subsections (e)(1)
9 and (e)(2) to the same extent as if that person, real
10 party in interest, or privy had been the first peti-
11 tioner in that inter partes review.”; and

12 (G) by adding at the end the following:

13 “(g) FEDERAL COURT AND INTERNATIONAL TRADE
14 COMMISSION VALIDITY DETERMINATIONS.—An inter
15 partes review of a patent claim may not be instituted or
16 maintained if, in a civil action arising in whole or in part
17 under section 1338 of title 28, or in a proceeding before
18 the International Trade Commission under section 337 of
19 the Tariff Act of 1930 (19 U.S.C. 1337), in which the
20 petitioner, a real party in interest, or a privy of the peti-
21 tioner is a party, the court, or the International Trade
22 Commission, as applicable, has entered a final judgment
23 that decides a challenge to the validity of the patent claim
24 with respect to any ground described in section 311(b).”.

1 (2) TECHNICAL AND CONFORMING AMEND-
2 MENTS.—Section 316(a) of title 35, United States
3 Code, is amended—

4 (A) in paragraph (11), by striking “section
5 315(c)” and inserting “section 315(d)”; and

6 (B) in paragraph (12), by striking “section
7 315(c)” and inserting “section 315(d)”.

8 (d) CONDUCT OF INTER PARTES REVIEW.—Section
9 316 of title 35, United States Code, is amended—

10 (1) in subsection (a)—

11 (A) by amending paragraph (5) to read as
12 follows:

13 “(5) setting forth standards and procedures for
14 discovery of relevant evidence, including that such
15 discovery shall be limited to—

16 “(A) the deposition of witnesses submitting
17 affidavits or declarations;

18 “(B) evidence identifying the real parties
19 in interest of the petitioner; and

20 “(C) what is otherwise necessary in the in-
21 terest of justice;”;

22 (B) by amending paragraph (9) to read as
23 follows:

24 “(9) setting forth standards and procedures
25 for—

1 “(A) allowing the patent owner to move to
2 amend the patent under subsection (d) to can-
3 cel a challenged claim or propose a reasonable
4 number of substitute claims;

5 “(B) allowing the Patent Trial and Appeal
6 Board to provide guidance on substitute claims
7 proposed by the patent owner;

8 “(C) allowing the patent owner to further
9 revise proposed substitute claims after the
10 issuance of guidance described in subparagraph
11 (B); and

12 “(D) ensuring that any information sub-
13 mitted by the patent owner in support of any
14 amendment entered under subsection (d), and
15 any guidance issued by the Patent Trial and
16 Appeal Board, is made available to the public
17 as part of the prosecution history of the pat-
18 ent;”;

19 (C) in paragraph (12), by striking “and”
20 at the end;

21 (D) in paragraph (13), by striking the pe-
22 riod at the end and inserting “; and”; and

23 (E) by adding at the end the following:

1 “(14) setting forth the standards for dem-
2 onstrating exceptional circumstances under sections
3 303(e)(1) and 315(e)(2).”;

4 (2) by amending subsection (e) to read as fol-
5 lows:

6 “(e) EVIDENTIARY STANDARDS.—

7 “(1) PRESUMPTION OF VALIDITY.—The pre-
8 sumption of validity under section 282(a) shall apply
9 to previously issued claims of a patent that is chal-
10 lenged in an inter partes review under this chapter.

11 “(2) BURDEN OF PROOF.—In an inter partes
12 review under this chapter—

13 “(A) the petitioner shall have the burden
14 of proving a proposition of unpatentability of a
15 previously issued claim of a patent by clear and
16 convincing evidence; and

17 “(B) the petitioner shall have the burden
18 of persuasion, by a preponderance of the evi-
19 dence, with respect to a proposition of
20 unpatentability for any substitute claim pro-
21 posed by the patent owner.”; and

22 (3) by adding at the end the following:

23 “(f) CLAIM CONSTRUCTION.—For the purposes of
24 this chapter—

1 “(1) each challenged claim of a patent, and
2 each substitute claim proposed in a motion to
3 amend, shall be construed as the claim would be
4 construed under section 282(b) in an action to inval-
5 idate a patent, including by construing each such
6 claim in accordance with—

7 “(A) the ordinary and customary meaning
8 of the claim as understood by a person having
9 ordinary skill in the art to which the claimed
10 invention pertains; and

11 “(B) the prosecution history pertaining to
12 the patent; and

13 “(2) if a court has previously construed a chal-
14 lenged claim of a patent or a challenged claim term
15 in a civil action to which the patent owner was a
16 party, the Office shall consider that claim construc-
17 tion.”.

18 (e) SETTLEMENT.—Section 317(a) of title 35, United
19 States Code, is amended by striking the second sentence.

20 (f) TIMING TO ISSUE TRIAL CERTIFICATE AND DE-
21 CISIONS ON REHEARING.—Section 318 of title 35, United
22 States Code, is amended—

23 (1) in subsection (b), by inserting “, not later
24 than 60 days after the date on which the parties to
25 the inter partes review have informed the Director

1 that the time for appeal has expired or any appeal
2 has terminated,” after “the Director shall”; and

3 (2) by adding at the end the following:

4 “(e) REHEARING.—Not later than 90 days after the
5 date on which a request for rehearing of a final written
6 decision issued by the Patent and Trial Appeal Board
7 under subsection (a) is filed, the Board or the Director
8 shall finally decide any request for reconsideration, rehear-
9 ing, or review that is submitted with respect to the deci-
10 sion, except that the Director may, for good cause shown,
11 extend that 90-day period by not more than 60 days.

12 “(f) REVIEW BY DIRECTOR.—

13 “(1) IN GENERAL.—The Director may grant re-
14 hearing, reconsideration, or review of a decision by
15 the Patent Trial and Appeal Board issued under this
16 chapter.

17 “(2) REQUIREMENTS.—Any reconsideration, re-
18 hearing, or review by the Director, as described in
19 paragraph (1), shall be issued in a separate written
20 opinion that—

21 “(A) is made part of the public record; and

22 “(B) sets forth the reasons for the recon-
23 sideration, rehearing, or review of the applicable
24 decision by the Patent Trial and Appeal Board.

1 “(g) **RULE OF CONSTRUCTION.**—For the purposes of
2 an appeal permitted under section 141, any decision on
3 rehearing, reconsideration, or review of a final written de-
4 cision of the Patent Trial and Appeal Board under sub-
5 section (a) of this section that is issued by the Director
6 shall be deemed to be a final written decision of the Patent
7 Trial and Appeal Board.”.

8 (g) **TIMING TO ISSUE DECISIONS ON REMAND.**—Sec-
9 tion 319 of title 35, United States Code, is amended—
10 (1) by striking “A party” and inserting the fol-
11 lowing:

12 “(a) **IN GENERAL.**—A party”; and

13 (2) by adding at the end the following:

14 “(b) **TIMING ON REMAND AFTER APPEAL.**—Not
15 later than 120 days after the date on which a mandate
16 issues from the court remanding to the Patent Trial and
17 Appeal Board after an appeal under subsection (a), the
18 Board or the Director shall finally decide any issue on re-
19 mand, except that the Director may, for good cause
20 shown, extend that 120-day period by not more than 60
21 days.”.

22 **SEC. 5. POST-GRANT REVIEW.**

23 (a) **REAL PARTIES IN INTEREST.**—Section 321 of
24 title 35, United States Code, is amended by adding at the
25 end the following:

1 “(d) REAL PARTY IN INTEREST.—For purposes of
2 this chapter, a person that, directly or through an affiliate,
3 subsidiary, or proxy, makes a financial contribution to the
4 preparation for, or conduct during, a post-grant review on
5 behalf of a petitioner shall be considered a real party in
6 interest of that petitioner.”.

7 (b) TIMING TO ISSUE DECISIONS ON REHEARING.—
8 Section 324 of title 35, United States Code, is amended
9 by adding at the end the following:

10 “(f) REHEARING.—Not later than 45 days after the
11 date on which a request for rehearing from a determina-
12 tion by the Director under subsection (c) is filed, the Di-
13 rector shall finally decide any request for reconsideration,
14 rehearing, or review with respect to the determination, ex-
15 cept that the Director may, for good cause shown, extend
16 that 45-day period by not more than 30 days.”.

17 (c) ELIMINATING REPETITIVE PROCEEDINGS.—Sec-
18 tion 325 of title 35, United States Code, is amended—

19 (1) by redesignating subsections (c) through (f)
20 as subsections (d) through (g), respectively;

21 (2) by inserting after subsection (b) the fol-
22 lowing:

23 “(c) SINGLE FORUM.—

24 “(1) IN GENERAL.—If a post-grant review is in-
25 stituted challenging the validity of a patent, the peti-

1 tioner, a real party in interest, or a privy of the peti-
2 tioner may not file or maintain, in a civil action aris-
3 ing in whole or in part under section 1338 of title
4 28, or in a proceeding before the International
5 Trade Commission under section 337 of the Tariff
6 Act of 1930 (19 U.S.C. 1337), a claim, a counter-
7 claim, or an affirmative defense challenging the va-
8 lidity of any claim of the patent.

9 “(2) CONSIDERATIONS.—In determining wheth-
10 er to institute a proceeding under this chapter, sub-
11 ject to the provisions of subsections (a)(1) and (h),
12 the Director may not reject a petition requesting a
13 post-grant review on the basis of the petitioner, a
14 real party in interest, or a privy of the petitioner fil-
15 ing or maintaining a claim, a counterclaim, or an af-
16 firmative defense challenging the validity of the pat-
17 ent in any civil action arising in whole or in part
18 under section 1338 of title 28, or in a proceeding be-
19 fore the International Trade Commission under sec-
20 tion 337 of the Tariff Act of 1930 (19 U.S.C.
21 1337).”;

22 (3) by amending subsection (e), as so redesign-
23 nated, to read as follows:

24 “(e) MULTIPLE PROCEEDINGS.—

1 “(1) IN GENERAL.—Notwithstanding sections
2 135(a), 251, and 252, and chapter 30, after a peti-
3 tion to institute a post-grant review is filed, if an-
4 other proceeding or matter involving the patent is
5 before the Office—

6 “(A) the parties shall notify the Director
7 of that other proceeding or matter—

8 “(i) not later than 30 days after the
9 date of entry of the notice of filing date ac-
10 corded to the petition; or

11 “(ii) if the other proceeding or matter
12 is filed after the date on which the petition
13 to institute an inter partes review is filed,
14 not later than 30 days after the date on
15 which the other proceeding or matter is
16 filed; and

17 “(B) the Director shall issue a decision de-
18 termining the manner in which the post-grant
19 review or other proceeding or matter may pro-
20 ceed, including providing for stay, transfer, con-
21 solidation, or termination of any such matter or
22 proceeding.

23 “(2) CONSIDERATIONS.—In determining wheth-
24 er to institute a proceeding under this chapter, the
25 Director shall, unless the Director determines that

1 the petitioner has demonstrated exceptional cir-
2 cumstances, reject any petition that presents prior
3 art or an argument that is the same or substantially
4 the same as prior art or an argument that previously
5 was presented to the Office.”;

6 (4) by amending subsection (f), as so redesign-
7 nated, to read as follows:

8 “(f) ESTOPPEL.—

9 “(1) IN GENERAL.—A petitioner that has pre-
10 viously requested a post-grant review of a claim in
11 a patent under this chapter, or a real party in inter-
12 est or a privy of a petitioner, may not request or
13 maintain another proceeding before the Office with
14 respect to that patent on any ground that the peti-
15 tioner raised or reasonably could have raised in the
16 petition requesting or during the prior post-grant re-
17 view, unless—

18 “(A) after the filing of the initial petition,
19 the petitioner, or a real party in interest or a
20 privy of the petitioner, is charged with infringe-
21 ment of additional claims of the patent;

22 “(B) a subsequent petition requests an
23 inter partes review of only the additional claims
24 of the patent that the petitioner, or a real party

1 in interest or a privy of the petitioner, is later
2 charged with infringing; and

3 “(C) that subsequent petition is accom-
4 panied by a request for joinder to the prior
5 post-grant review, which the Director shall
6 grant if the Director authorizes a post-grant re-
7 view to be instituted on the subsequent petition
8 under section 324.

9 “(2) JOINED PARTY.—Any person joined as a
10 party to a post-grant review, and any real party in
11 interest or any privy of such person, shall be es-
12 topped under this subsection and subsections (c)(1)
13 and (e)(2) to the same extent as if that person, real
14 party in interest, or privy had been the first peti-
15 tioner in that post-grant review.”; and

16 (5) by adding at the end the following:

17 “(h) FEDERAL COURT AND INTERNATIONAL TRADE
18 COMMISSION VALIDITY DETERMINATIONS.—A post-grant
19 review of a patent claim may not be instituted or main-
20 tained if, in a civil action arising in whole or in part under
21 section 1338 of title 28, or in a proceeding before the
22 International Trade Commission under section 337 of the
23 Tariff Act of 1930 (19 U.S.C. 1337), in which the peti-
24 tioner, a real party in interest, or a privy of the petitioner
25 is a party, the court, or the International Trade Commis-

1 sion, as applicable, has entered a final judgment that de-
2 cides a challenge to the validity of the patent claim.”.

3 (d) CONDUCT OF POST-GRANT REVIEW.—Section
4 326 of title 35, United States Code, is amended—

5 (1) in subsection (a)—

6 (A) by amending paragraph (5) to read as
7 follows:

8 “(5) setting forth standards and procedures for
9 discovery of relevant evidence, including that such
10 discovery shall be limited to—

11 “(A) the deposition of witnesses submitting
12 affidavits or declarations;

13 “(B) evidence identifying the real parties
14 in interest of the petitioner; and

15 “(C) what is otherwise necessary in the in-
16 terest of justice;”;

17 (B) by amending paragraph (9) to read as
18 follows:

19 “(9) setting forth standards and procedures
20 for—

21 “(A) allowing the patent owner to move to
22 amend the patent under subsection (d) to can-
23 cel a challenged claim or propose a reasonable
24 number of substitute claims;

1 “(B) allowing the Patent Trial and Appeal
2 Board to provide guidance on substitute claims
3 proposed by the patent owner;

4 “(C) allowing the patent owner to further
5 revise proposed substitute claims after the
6 issuance of guidance described in subparagraph
7 (B); and

8 “(D) ensuring that any information sub-
9 mitted by the patent owner in support of any
10 amendment entered under subsection (d), and
11 any guidance issued by the Patent Trial and
12 Appeal Board, is made available to the public
13 as part of the prosecution history of the pat-
14 ent;”;

15 (C) in paragraph (11), by striking “section
16 325(c)” and inserting “section 325(d)”;

17 (D) in paragraph (12), by striking the pe-
18 riod at the end and inserting “; and”; and

19 (E) by adding at the end the following:

20 “(13) setting forth the standards for dem-
21 onstrating exceptional circumstances under section
22 325(e)(2).”;

23 (2) by amending subsection (e) to read as fol-
24 lows:

25 “(e) EVIDENTIARY STANDARDS.—

1 “(1) PRESUMPTION OF VALIDITY.—The pre-
2 sumption of validity under section 282(a) shall apply
3 to previously issued claims of a patent that is chal-
4 lenged in a post-grant review under this chapter.

5 “(2) BURDEN OF PROOF.—In a post-grant re-
6 view under this chapter—

7 “(A) the petitioner shall have the burden
8 of proving a proposition of unpatentability of a
9 previously issued claim of a patent by clear and
10 convincing evidence; and

11 “(B) the petitioner shall have the burden
12 of persuasion, by a preponderance of the evi-
13 dence, with respect to a proposition of
14 unpatentability for any substitute claim pro-
15 posed by the patent owner.”; and

16 (3) by adding at the end the following:

17 “(f) CLAIM CONSTRUCTION.—For the purposes of
18 this chapter—

19 “(1) each challenged claim of a patent, and
20 each substitute claim proposed in a motion to
21 amend, shall be construed as the claim would be
22 construed under section 282(b) in an action to inval-
23 idate a patent, including by construing each such
24 claim in accordance with—

1 “(A) the ordinary and customary meaning
2 of the claim as understood by a person having
3 ordinary skill in the art to which the claimed
4 invention pertains; and

5 “(B) the prosecution history pertaining to
6 the patent; and

7 “(2) if a court has previously construed a chal-
8 lenged claim of a patent or a challenged claim term
9 in a civil action to which the patent owner was a
10 party, the Office shall consider that claim construc-
11 tion.”.

12 (e) SETTLEMENT.—Section 327(a) of title 35, United
13 States Code, is amended by striking the second sentence.

14 (f) TIMING TO ISSUE TRIAL CERTIFICATES AND DE-
15 CISIONS ON REHEARING.—Section 328 of title 35, United
16 States Code, is amended—

17 (1) in subsection (b), by inserting “, not later
18 than 60 days after the date on which the parties to
19 the post-grant review have informed the Director
20 that the time for appeal has expired or any appeal
21 has terminated,” after “the Director shall”; and

22 (2) by adding at the end the following:

23 “(e) REHEARING.—Not later than 90 days after the
24 date on which a request for rehearing of a final written
25 decision issued by the Patent and Trial Appeal Board

1 under subsection (a) is filed, the Board or the Director
2 shall finally decide any request for reconsideration, rehear-
3 ing, or review that is submitted with respect to the deci-
4 sion, except that the Director may, for good cause shown,
5 extend that 90-day period by not more than 60 days.

6 “(f) REVIEW BY DIRECTOR.—

7 “(1) IN GENERAL.—The Director may grant re-
8 hearing, reconsideration, or review of a decision by
9 the Patent Trial and Appeal Board issued under this
10 chapter.

11 “(2) REQUIREMENTS.—Any reconsideration, re-
12 hearing, or review by the Director, as described in
13 paragraph (1), shall be issued in a separate written
14 opinion that—

15 “(A) is made part of the public record; and

16 “(B) sets forth the reasons for the recon-
17 sideration, rehearing, or review of the decision
18 by the Patent Trial and Appeal Board.

19 “(g) RULE OF CONSTRUCTION.—For the purposes of
20 an appeal permitted under section 141, any decision on
21 rehearing, reconsideration, or review of a final written de-
22 cision of the Patent Trial and Appeal Board under sub-
23 section (a) of this section that is issued by the Director
24 shall be deemed to be a final written decision of the Patent
25 Trial and Appeal Board.”

1 (g) TIMING TO ISSUE DECISIONS ON REMAND.—Sec-
2 tion 329 of title 35, United States Code, is amended—

3 (1) by striking “A party” and inserting the fol-
4 lowing:

5 “(a) IN GENERAL.—A party”; and

6 (2) by adding at the end the following:

7 “(b) TIMING ON REMAND AFTER APPEAL.—Not
8 later than 120 days after the date on which a mandate
9 issues from the court remanding to the Patent Trial and
10 Appeal Board after an appeal under subsection (a), the
11 Board or the Director shall finally decide any issue on re-
12 mand, except that the Director may, for good cause
13 shown, extend that 120-day period by not more than 60
14 days.”.

15 **SEC. 6. REEXAMINATION OF PATENTS.**

16 (a) REQUEST FOR REEXAMINATION.—Section 302 of
17 title 35, United States Code, is amended by inserting after
18 the second sentence the following: “The request must
19 identify all real parties in interest and certify that reexam-
20 ination is not barred under section 303(d).”.

21 (b) REEXAMINATION BARRED.—Section 303 of title
22 35, United States Code, is amended—

23 (1) in subsection (a), by striking the third sen-
24 tence; and

25 (2) by adding at the end the following:

1 “(d) An ex parte reexamination may not be ordered
2 if the request for reexamination is filed more than 1 year
3 after the date on which the requester or a real party in
4 interest or a privy of the requester is served with a com-
5 plaint alleging infringement of the patent. For purposes
6 of this chapter, a person that directly or through an affil-
7 iate, subsidiary, or proxy makes a financial contribution
8 to the preparation for, or conduct during, an ex parte re-
9 examination on behalf of a requester shall be considered
10 a real party in interest of the requester.

11 “(e) In determining whether to order an ex parte re-
12 examination, the Director—

13 “(1) shall, unless the Director determines that
14 the requestor has demonstrated exceptional cir-
15 cumstances, reject any request that presents prior
16 art or an argument that is the same or substantially
17 the same as prior art or an argument that previously
18 was presented to the Office; and

19 “(2) may reject any request that the Director
20 determines has used a prior Office decision as a
21 guide to correct or bolster a previous deficient re-
22 quest filed under this chapter or a previous deficient
23 petition filed under chapter 31 or 32.”.

24 (c) REEXAMINATION ORDER BY DIRECTOR.—Section
25 304 of title 35, United States Code, is amended, in the

1 first sentence, by inserting after “resolution of the ques-
 2 tion” the following: “, unless the Director determines that
 3 the request for reexamination should be rejected under
 4 subsection (d) or (e) of section 303, in which case the Di-
 5 rector shall issue an order denying reexamination”.

6 **SEC. 7. ELIMINATION OF USPTO FEE DIVERSION.**

7 (a) FUNDING.—Section 42 of title 35, United States
 8 Code, is amended—

9 (1) in subsection (a), by striking “All fees” and
 10 inserting the following:

11 “(a) FEES FOR SERVICE BY PTO.—All fees”;

12 (2) in subsection (b)—

13 (A) by striking “All fees paid to the Direc-
 14 tor and all appropriations” and inserting the
 15 following:

16 “(b) INNOVATION PROMOTION FUND.—All fees paid
 17 to the Director”; and

18 (B) by striking “Patent and Trademark
 19 Office Appropriation Account” and inserting
 20 “United States Patent and Trademark Office
 21 Innovation Promotion Fund”;

22 (3) by striking subsection (c) and inserting the
 23 following:

24 “(c) COLLECTION OF FUNDS FOR PTO ACTIVI-
 25 TIES.—

1 “(1) IN GENERAL.—Fees authorized in this
2 title or any other Act to be charged or established
3 by the Director shall be collected by the Director
4 and shall be available to the Director until expended
5 to carry out the activities of the Patent and Trade-
6 mark Office.

7 “(2) USE OF FEES.—

8 “(A) PATENT FEES.—Any fees that are
9 collected under this title, and any surcharges on
10 such fees, may only be used for expenses of the
11 Office relating to the processing of patent appli-
12 cations and for other activities, services, and
13 materials relating to patents and to cover a pro-
14 portionate share of the administrative costs of
15 the Office.

16 “(B) TRADEMARK FEES.—Any fees that
17 are collected under section 31 of the Trademark
18 Act of 1946 (as defined in subsection (d)(1))
19 (15 U.S.C. 1113), and any surcharges on such
20 fees, may only be used for expenses of the Of-
21 fice relating to the processing of trademark reg-
22 istrations and for other activities, services, and
23 materials relating to trademarks and to cover a
24 proportionate share of the administrative costs
25 of the Office.”;

1 (4) by redesignating subsections (d) and (e) as
2 subsections (e) and (f), respectively;

3 (5) by inserting after subsection (c) the fol-
4 lowing:

5 “(d) REVOLVING FUND.—

6 “(1) DEFINITIONS.—In this subsection—

7 “(A) the term ‘Fund’ means the United
8 States Patent and Trademark Office Innovation
9 Promotion Fund established under paragraph
10 (2); and

11 “(B) the term ‘Trademark Act of 1946’
12 means the Act entitled ‘An Act to provide for
13 the registration and protection of trademarks
14 used in commerce, to carry out the provisions
15 of certain international conventions, and for
16 other purposes’, approved July 5, 1946 (15
17 U.S.C. 1051 et seq.) (commonly referred to as
18 the ‘Trademark Act of 1946’ or the ‘Lanham
19 Act’).

20 “(2) ESTABLISHMENT.—There is established in
21 the Treasury a revolving fund to be known as the
22 ‘United States Patent and Trademark Office Inno-
23 vation Promotion Fund’.

1 “(3) DERIVATION OF RESOURCES.—There shall
2 be deposited into the Fund any fees collected
3 under—

4 “(A) this title; or

5 “(B) the Trademark Act of 1946.

6 “(4) EXPENSES.—Amounts deposited into the
7 Fund under paragraph (3) shall be available, with-
8 out fiscal year limitation, to cover—

9 “(A) to the extent consistent with the limi-
10 tation on the use of fees under subsection (c),
11 all expenses, including all administrative and
12 operating expenses, determined by the Director
13 to be ordinary and reasonable, incurred by the
14 Director for the continued operation of all serv-
15 ices, programs, activities, and duties of the Of-
16 fice relating to patents and trademarks, as such
17 services, programs, activities, and duties are de-
18 scribed under—

19 “(i) this title; and

20 “(ii) the Trademark Act of 1946; and

21 “(B) all expenses incurred pursuant to any
22 obligation, representation, or other commitment
23 of the Office.”;

24 (6) in subsection (e), as so redesignated, by
25 striking “The Director” and inserting the following:

1 “(e) REFUNDS.—The Director”; and

2 (7) in subsection (f), as so redesignated, by
3 striking “The Secretary” and inserting the fol-
4 lowing:

5 “(f) REPORT.—The Secretary”.

6 (b) EFFECTIVE DATE; TRANSFER FROM AND TERMI-
7 NATION OF OBSOLETE FUNDS.—

8 (1) EFFECTIVE DATE.—The amendments made
9 by subsection (a) shall take effect on the first day
10 of the first fiscal year that begins on or after the
11 date of enactment of this Act.

12 (2) REMAINING BALANCES.—On the effective
13 date described in paragraph (1), there shall be de-
14 posited in the United States Patent and Trademark
15 Office Innovation Promotion Fund established under
16 section 42(d)(2) of title 35, United States Code (as
17 added by subsection (a)), any available unobligated
18 balances remaining in the Patent and Trademark
19 Office Appropriation Account, and in the Patent and
20 Trademark Fee Reserve Fund established under sec-
21 tion 42(c)(2) of title 35, United States Code, as in
22 effect on the day before that effective date.

23 (3) TERMINATION OF RESERVE FUND.—Upon
24 the payment of all obligated amounts in the Patent
25 and Trademark Fee Reserve Fund under paragraph

1 (2), the Patent and Trademark Fee Reserve Fund
2 shall be terminated.

3 **SEC. 8. INSTITUTIONS OF HIGHER EDUCATION.**

4 Section 123(d) of title 35, United States Code, is
5 amended to read as follows:

6 “(d) INSTITUTIONS OF HIGHER EDUCATION.—

7 “(1) DEFINITION.—In this subsection, the term
8 ‘institution of higher education’ has the meaning
9 given the term in section 101(a) of the Higher Edu-
10 cation Act of 1965 (20 U.S.C. 1001(a)).

11 “(2) INCLUSIONS.—For purposes of this sec-
12 tion, a micro entity shall include an applicant who
13 certifies that—

14 “(A) the applicant’s employer, from which
15 the applicant obtains the majority of the appli-
16 cant’s income, is an institution of higher edu-
17 cation;

18 “(B) the applicant has assigned, granted,
19 conveyed, or is under an obligation by contract
20 or law to assign, grant, or convey, a license or
21 other ownership interest in the particular appli-
22 cations to an institution of higher education;

23 “(C) the applicant is an institution of
24 higher education; or

1 “(D) the applicant is an organization de-
2 scribed in section 501(c)(3) of the Internal Rev-
3 enue Code of 1986 and exempt from taxation
4 under section 501(a) of such Code that holds
5 title to patents and patent applications on be-
6 half of an institution of higher education for the
7 purpose of facilitating commercialization of the
8 technologies of the patents and patent applica-
9 tions.”.

10 **SEC. 9. ASSISTING SMALL BUSINESSES IN THE UNITED**
11 **STATES PATENT SYSTEM.**

12 (a) DEFINITION.—In this section, the term “small
13 business concern” has the meaning given the term in sec-
14 tion 3 of the Small Business Act (15 U.S.C. 632).

15 (b) SMALL BUSINESS ADMINISTRATION REPORT.—
16 Not later than 1 year after the date of the enactment of
17 this Act, the Administrator of the Small Business Admin-
18 istration, using existing resources, shall submit to the
19 Committee on Small Business and Entrepreneurship of
20 the Senate and the Committee on Small Business of the
21 House of Representatives a report analyzing the impact
22 of—

23 (1) patent ownership by small business con-
24 cerns; and

1 (2) civil actions against small business concerns
2 arising under title 35, United States Code, relating
3 to patent infringement.

4 (c) FREE ONLINE AVAILABILITY OF PUBLIC SEARCH
5 FACILITY MATERIALS.—Section 41(i) of title 35, United
6 States Code, is amended by adding at the end the fol-
7 lowing:

8 “(5) FREE ONLINE AVAILABILITY OF PUBLIC
9 SEARCH FACILITY MATERIALS.—The Director shall
10 make available online and at no charge all patent
11 and trademark information that is available at the
12 Public Search Facility of the Office located in Alex-
13 andria, Virginia, including, except to the extent that
14 licenses with third-party contractors would make
15 such provision financially unviable—

16 “(A) search tools and databases;

17 “(B) informational materials; and

18 “(C) training classes and materials.”.

○