

107TH CONGRESS  
1ST SESSION

# H. R. 2231

To amend title 35, United States Code, with respect to patent reexamination proceedings.

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IN THE HOUSE OF REPRESENTATIVES

JUNE 19, 2001

Ms. LOFGREN introduced the following bill; which was referred to the Committee on the Judiciary

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## A BILL

To amend title 35, United States Code, with respect to patent reexamination proceedings.

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 “Patent Reexamination  
5 Enhancement Act of 2001”.

6 **SEC. 2. REQUESTS FOR INTER PARTES REEXAMINATION.**

7 (a) SCOPE OF REEXAMINATION AUTHORITY.—Sec-  
8 tion 311 of title 35, United States Code, is amended—

9 (1) by amending subsection (a) to read as fol-

10 lows:

1 “(a) REQUESTS FOR REEXAMINATION.—

2 “(1) AT ANY TIME.—Any person may at any  
3 time file a request for inter partes reexamination by  
4 the Office of a patent on the basis of any prior art  
5 cited under the provisions of section 301.

6 “(2) WITHIN LIMITED PERIOD AFTER ISSUE OF  
7 A PATENT.—Any person, within 12 months after the  
8 date on which a patent is issued, may file a request  
9 for an inter partes reexamination by the Office of  
10 the patent on the basis of evidence of subject matter  
11 described in section 102(a) or (b), alone or in com-  
12 bination with prior art that may be cited under sec-  
13 tion 301, or on the basis of evidence showing that  
14 one or more claims of the patent do not comply with  
15 the first or second paragraph of section 112 (other  
16 than the best mode requirement).”;

17 (2) in subsection (b)—

18 (A) by striking “The request” and insert-  
19 ing “Any request under subsection (a)”;

20 (B) in paragraph (1), by striking “and”  
21 after the semicolon;

22 (C) in paragraph (2)—

23 (i) by inserting after “(2)” the fol-  
24 lowing: “in the case of a request made  
25 under subsection (a)(1),”; and

1 (ii) by striking the period and insert-  
2 ing “; and”; and

3 (D) by adding at the end the following new  
4 paragraph:

5 “(3) in the case of a request made under sub-  
6 section (a)(2), set forth reasons demonstrating that,  
7 in view of the evidence provided, a substantial new  
8 question of patentability exists in light of the re-  
9 quirements of section 102(a), (b), or (e), section  
10 103, or the first or second paragraph of section 112  
11 (other than the best mode requirement), as the case  
12 may be, for each claim of the patent for which reex-  
13 amination is requested.”.

14 (b) REEXAMINATIONS ORDERED BY THE DIREC-  
15 TOR.—Section 312(a) of title 35, United States Code, is  
16 amended in the first sentence by inserting after “patents  
17 or printed publications” the following: “, or, within 12  
18 months after the date of issue of the patent, on the  
19 grounds specified in section 311(a)(2)”.

20 (c) BASIS FOR APPEAL.—Section 315(c) of title 35,  
21 United States Code, is amended—

22 (1) in the first sentence, by striking “an order  
23 under section 313” and inserting “a final decision in  
24 an inter partes reexamination proceeding that is fa-

1 vorable to the patentability of any original or pro-  
2 posed amended or new claim of the patent”; and

3 (2) in the second sentence—

4 (A) by inserting “or information” after  
5 “prior art”; and

6 (B) by inserting after “Patent and Trade-  
7 mark Office” the following: “, or upon evidence  
8 and reasons set forth in section 311(a)(2) and  
9 311(b)(3), respectively, which were not known  
10 to the third party requester,”.

11 (d) REPEAL.—Section 4607 of the Intellectual Prop-  
12 erty and Communications Omnibus Reform Act of 1999,  
13 as enacted by section 1000(a)(9) of Public Law 106–113,  
14 is repealed.

15 **SEC. 3. EFFECTIVE DATE.**

16 (a) IN GENERAL.—Subject to subsections (b) and (c),  
17 the amendments made by this Act shall apply to any pat-  
18 ent in force on the date of the enactment of this Act, and  
19 to any patent issued on or after such date.

20 (b) SPECIAL RULE.—In the case of any patent cov-  
21 ered by subsection (a) which was issued before the date  
22 of the enactment of this Act and with respect to which  
23 the 12-month period provided in section 311(a)(2) of title  
24 35, United States Code, as added by section 2 of this Act,  
25 has expired as of such date of enactment, a request for

1 inter partes reexamination under such section 311(a)(2)  
2 shall be valid if it is filed not later than 6 months after  
3 such date of enactment.

4 (c) APPLICABILITY OF APPEAL PROVISIONS.—The  
5 amendments made by section 2(e) and the repeal made  
6 by section 2(d) shall apply only to inter partes reexamina-  
7 tion proceedings for which a request under section 311  
8 of title 35, United States Code, is made on or after the  
9 date of the enactment of this Act.

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