

103<sup>RD</sup> CONGRESS  
2<sup>D</sup> SESSION

**H. R. 4307**

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**AMENDMENT**

***In the Senate of the United States,***

*October 6 (legislative day, September 12), 1994.*

*Resolved*, That the bill from the House of Representatives (H.R. 4307) entitled “An Act to amend title 35, United States Code, with respect to applications for process patents, and for certain other purposes”, do pass with the following

**AMENDMENT:**

Strike out all after the enacting clause and insert:

1       ***TITLE I—PROCESS PATENT***  
2                               ***APPLICATIONS***

3       ***SEC. 101. EXAMINATION OF PROCESS PATENT APPLICA-***  
4                               ***TIONS FOR OBVIOUSNESS.***

5       *Section 103 of title 35, United States Code, is amend-*  
6 *ed—*

7               (1) *by designating the first paragraph as sub-*  
8 *section (a);*

9               (2) *by designating the second paragraph as sub-*  
10 *section (c); and*

11              (3) *by inserting after the first paragraph the fol-*  
12 *lowing:*

13       “(b)(1) *Notwithstanding subsection (a), and upon*  
14 *timely election by the applicant for patent to proceed under*  
15 *this subsection, a “biotechnological process” using or result-*  
16 *ing in a composition of matter that is novel under section*

1 *102 and nonobvious under subsection (a) of this section*  
2 *shall be considered nonobvious if—*

3 *“(A) claims to the process and the composition*  
4 *of matter are contained in either the same applica-*  
5 *tion for patent or in separate applications having the*  
6 *same effective filing date; and*

7 *“(B) the composition of matter, and the process*  
8 *at the time it was invented, were owned by the same*  
9 *person or subject to an obligation of assignment to the*  
10 *same person.*

11 *“(2) A patent issued on a process under paragraph*  
12 *(1)—*

13 *“(A) shall also contain the claims to the com-*  
14 *position of matter used in or made by that process,*  
15 *or*

16 *“(B) shall, if such composition of matter is*  
17 *claimed in another patent, be set to expire on the*  
18 *same date as such other patent, notwithstanding sec-*  
19 *tion 154.”.*

20 *For purposes of subsection (b), the term biotechnological*  
21 *process” means a process of genetically altering or otherwise*  
22 *inducing a cell or a living organism to express an exogenous*  
23 *nucleotide sequence or to express specific physiological char-*  
24 *acteristics. Such processes include genetic alteration of a*  
25 *cell to express an exogenous nucleotide sequence, cell fusion*

1 *procedures yielding a cell line that expresses a specific pro-*  
2 *tein, including a monoclonal antibody, and genetic alter-*  
3 *ation of a multicellular organism to induce said organism*  
4 *to express an exogenous nucleotide sequence or to express*  
5 *predefined physiological characteristics.*

6 **SEC. 102. PRESUMPTION OF VALIDITY; DEFENSES.**

7 *Section 282 of title 35, United States Code, is amended*  
8 *by inserting after the second sentence of the first paragraph*  
9 *the following: “Notwithstanding the preceding sentence, if*  
10 *a claim to a composition of matter is held invalid and that*  
11 *claim was the basis of a determination of nonobviousness*  
12 *under section 103(b)(1), the process shall no longer be con-*  
13 *sidered nonobvious solely on the basis of section 103(b)(1).”.*

14 **SEC. 103. EFFECTIVE DATE.**

15 *The amendments made by section 101 shall apply to*  
16 *any application for patent filed on or after the date of the*  
17 *enactment of this Act and to any application for patent*  
18 *pending on such date of enactment, including (in either*  
19 *case) as application for the reissue of a patent.*

20 **SEC. 104. JURISDICTION OF UNITED STATES COURT OF**  
21 **FEDERAL CLAIMS RELATING TO CERTAIN**  
22 **SOFTWARE AND SERVICE CLAIMS.**

23 *(a) JURISDICTION.—Jurisdiction is conferred upon the*  
24 *United States Court of Federal Claims to hear, determine,*  
25 *and render conclusions that are sufficient to inform the*

1 *Congress of the amount, if any, legally or equitably due*  
2 *upon the claims of Inslaw, Inc., a Delaware Corporation*  
3 *(hereinafter referred to as “Inslaw”) and William A. Ham-*  
4 *ilton and Nancy Burke Hamilton, individually against the*  
5 *United States which claims arise out of the furnishing of*  
6 *computer software and services to the United States Depart-*  
7 *ment of Justice. The hearings and proceedings conducted,*  
8 *determinations and conclusions made, and report submitted*  
9 *to the Congress under this subsection shall be conducted in*  
10 *accordance with the provisions of section 2509 of title 28,*  
11 *United States Code.*

12       **(b) WAIVER OF SOVEREIGN IMMUNITY AND DE-**  
13 *FENSE.—For purposes of the report submitted under sub-*  
14 *section (a), any available defense relating to statute of limi-*  
15 *tations, any form of estoppel, laches, res judicata, failure*  
16 *to exhaust all remedies, and any available defense of sov-*  
17 *ereign immunity of the United States, the Department of*  
18 *Justice, or any other United States Government agency is*  
19 *specifically waived as to the respective claims of Inslaw,*  
20 *William A. Hamilton, and Nancy Burke Hamilton.*

Attest:

*Secretary.*