

108TH CONGRESS
2D SESSION

S. 2192

AN ACT

To amend title 35, United States Code, to promote cooperative research involving universities, the public sector, and private enterprises.

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 “Cooperative Research
5 and Technology Enhancement (CREATE) Act of 2004”.

1 **SEC. 2. COLLABORATIVE EFFORTS ON CLAIMED INVEN-**
2 **TIONS.**

3 Section 103(c) of title 35, United States Code, is
4 amended to read as follows:

5 “(c)(1) Subject matter developed by another person,
6 which qualifies as prior art only under one or more of sub-
7 sections (e), (f), and (g) of section 102 of this title, shall
8 not preclude patentability under this section where the
9 subject matter and the claimed invention were, at the time
10 the claimed invention was made, owned by the same per-
11 son or subject to an obligation of assignment to the same
12 person.

13 “(2) For purposes of this subsection, subject matter
14 developed by another person and a claimed invention shall
15 be deemed to have been owned by the same person or sub-
16 ject to an obligation of assignment to the same person if—

17 “(A) the claimed invention was made by or on
18 behalf of parties to a joint research agreement that
19 was in effect on or before the date the claimed in-
20 vention was made;

21 “(B) the claimed invention was made as a re-
22 sult of activities undertaken within the scope of the
23 joint research agreement; and

24 “(C) the application for patent for the claimed
25 invention discloses or is amended to disclose the

1 names of the parties to the joint research agree-
2 ment.

3 “(3) For purposes of paragraph (2), the term ‘joint
4 research agreement’ means a written contract, grant, or
5 cooperative agreement entered into by two or more per-
6 sons or entities for the performance of experimental, devel-
7 opmental, or research work in the field of the claimed in-
8 vention.”.

9 **SEC. 3. EFFECTIVE DATE.**

10 (a) IN GENERAL.—The amendments made by this
11 Act shall apply to any patent granted on or after the date
12 of the enactment of this Act.

13 (b) SPECIAL RULE.—The amendments made by this
14 Act shall not affect any final decision of a court or the
15 United States Patent and Trademark Office rendered be-
16 fore the date of the enactment of this Act, and shall not
17 affect the right of any party in any action pending before
18 the United States Patent and Trademark Office or a court
19 on the date of the enactment of this Act to have that par-
20 ty’s rights determined on the basis of the provisions of

- 1 title 35, United States Code, in effect on the day before
- 2 the date of the enactment of this Act.

Passed the Senate June 25, 2004.

Attest:

Secretary.

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