

114TH CONGRESS  
1ST SESSION

# S. 926

To amend the patent law to promote basic research, to stimulate publication of scientific documents, to encourage collaboration in scientific endeavors, to improve the transfer of technology to the private sector, and for other purposes.

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## IN THE SENATE OF THE UNITED STATES

APRIL 14, 2015

Ms. BALDWIN (for herself and Mr. VITTER) introduced the following bill; which was read twice and referred to the Committee on the Judiciary

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## A BILL

To amend the patent law to promote basic research, to stimulate publication of scientific documents, to encourage collaboration in scientific endeavors, to improve the transfer of technology to the private sector, 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 “Grace Period Restora-  
5 tion Act of 2015”.

6 **SEC. 2. FINDINGS; PURPOSES.**

7 (a) FINDINGS.—Congress finds the following:

1           (1) Language in the Leahy-Smith America In-  
2           vents Act (Public Law 112–29; 125 Stat. 284) and  
3           regulations and examination guidelines issued by the  
4           United States Patent and Trademark Office imple-  
5           menting provisions of that Act have created uncer-  
6           tainty regarding the scope of the 1-year grace period  
7           during which an inventor who discloses an invention  
8           to the public may decide whether to file a patent ap-  
9           plication for the invention (referred to in this Act as  
10          the “grace period”).

11          (2) The regulatory reading of the Leahy-Smith  
12          America Invents Act does not comport with the in-  
13          tent of the sponsors of that Act.

14          (3) In performing more than 50 percent of all  
15          basic research in the United States and pursuing the  
16          transfer of research results to the private sector for  
17          the benefit of the public under the auspices of chap-  
18          ter 18 of title 35, United States Code (commonly  
19          known as the “Bayh-Dole Act”), institutions of  
20          higher education and government laboratories face a  
21          difficult and expensive challenge in gaining and uti-  
22          lizing the full scope of patent rights.

23          (4) The uncertainty relating to the grace period  
24          created by the Leahy-Smith America Invents Act  
25          adds to the challenge faced by institutions of higher

1 education and government laboratories in gaining  
2 and utilizing the full scope of patent rights.

3 (5) Job growth and the creation of start-up  
4 companies and small businesses are thwarted by un-  
5 certainty as to the scope of the grace period and by  
6 the difficulty and expense of gaining and utilizing  
7 patent rights, which hinders the economy of the  
8 United States and the technological leadership of the  
9 United States in a competitive global economy.

10 (6) Ambiguity and uncertainty in statutory text  
11 and government regulations breed abusive and ex-  
12 pensive patent litigation.

13 (7) Discouragement of scientific research publi-  
14 cation—

15 (A) delays the disclosure of scientific ad-  
16 vances to the public;

17 (B) thwarts scientific advances;

18 (C) chills collaborative research activities;

19 and

20 (D) delays, if not denies, the opportunity  
21 for the public to realize the benefits of research  
22 results.

23 (8) Misappropriation by third parties of dis-  
24 closed inventions is likely to increase, especially in  
25 countries that take advantage of the technological

1       prowess of the United States without appropriately  
2       compensating inventors.

3           (9) Secrecy is anathema to—

4               (A) the maintenance of a viable United  
5       States patent system;

6               (B) the constitutional purpose of the  
7       United States patent system; and

8               (C) the goal of the United States patent  
9       system of promoting scientific progress.

10          (10) In the words of David J. Kappos, who  
11       served as the Under Secretary of Commerce for In-  
12       tellectual Property and Director of the United States  
13       Patent and Trademark Office during the enactment  
14       of the Leahy-Smith America Invents Act, the grace  
15       period before the enactment of the Leahy-Smith  
16       America Invents Act was “the gold standard of best  
17       practices”.

18          (b) PURPOSES.—The purposes of this Act are—

19               (1) to correct the drafting problem in the  
20       Leahy-Smith America Invents Act relating to the  
21       grace period; and

22               (2) to maintain the position of leadership of the  
23       United States in educational, technological, and sci-  
24       entific progress.

1 **SEC. 3. DISCLOSURES FOLLOWING A PUBLIC DISCLOSURE**  
2 **OF A CLAIMED INVENTION BY AN INVENTOR.**

3 Section 102(b) of title 35, United States Code, is  
4 amended by adding at the end the following:

5 “(3) DISCLOSURES BY ANY PERSON AFTER  
6 PUBLIC DISCLOSURE OF A CLAIMED INVENTION BY  
7 AN INVENTOR.—

8 “(A) DEFINITIONS.—In this paragraph—

9 “(i) the term ‘covered person’, with  
10 respect to a claimed invention, means—

11 “(I) the inventor;

12 “(II) a joint inventor; or

13 “(III) another who obtained the  
14 claimed invention directly or indirectly  
15 from the inventor or a joint inventor;  
16 and

17 “(ii) the term ‘relevant section 112(a)  
18 requirements’ means the requirements for  
19 a specification under section 112(a) other  
20 than the requirement to set forth the best  
21 mode of carrying out the invention.

22 “(B) PUBLIC DISCLOSURE.—A disclosure  
23 by any person shall not be prior art to a  
24 claimed invention under subsection (a) or sec-  
25 tion 103 if—

1           “(i) the disclosure is made under sub-  
2           section (a)(1) or effectively filed under  
3           subsection (a)(2) 1 year or less before the  
4           effective filing date of the claimed inven-  
5           tion; and

6           “(ii) before the disclosure described in  
7           clause (i) is made or filed, and 1 year or  
8           less before the effective filing date of the  
9           claimed invention, the claimed invention is  
10          publicly disclosed in a printed publication  
11          by a covered person in a manner that sat-  
12          isfies the relevant section 112(a) require-  
13          ments.

14          “(C) DETERMINATION THAT PUBLIC DIS-  
15          CLOSURE WOULD HAVE SATISFIED SPECIFICA-  
16          TION REQUIREMENTS.—In determining under  
17          subparagraph (B) whether a claimed invention  
18          was publicly disclosed in a printed publication  
19          by a covered person in a manner that satisfied  
20          the relevant section 112(a) requirements—

21                 “(i) only the state of the art known  
22                 on and before the date of the disclosure  
23                 may be considered; and

24                 “(ii) satisfaction of the relevant sec-  
25                 tion 112(a) requirements may be—

1                   “(I) established by 1 or more  
2                   public disclosures in printed publica-  
3                   tions made by a covered person during  
4                   the period of 1 year or less between—

5                               “(aa) the disclosure by the  
6                               covered person described in sub-  
7                               paragraph (B)(ii); and

8                               “(bb) the effective filing  
9                               date of the claimed invention;  
10                              and

11                   “(II) supported by statements  
12                   under declaration or oath relating to  
13                   the existence and content of the public  
14                   disclosure or disclosures in printed  
15                   publications described in subclause  
16                   (I).

17                   “(D) PRESUMPTION OF VALIDITY.—An ap-  
18                   plicant for a patent shall present to the Patent  
19                   and Trademark Office, before the Patent and  
20                   Trademark Office issues a notice of allowance  
21                   of the application for the patent, each disclo-  
22                   sure under subparagraph (C)(ii)(I) and any  
23                   statement under subparagraph (C)(ii)(II) in  
24                   order for the section 112(a) support provided  
25                   by each such disclosure or statement under sub-

1 paragraph (C)(ii) to be taken into account  
2 under the section 282(a) presumption of valid-  
3 ity of an issued patent.

4 “(E) CERTAIN DISCLOSURES NOT PRIOR  
5 ART.—A disclosure described in paragraph  
6 (1)(A), (2)(A), or (2)(C) shall not be prior art  
7 to a claimed invention under this paragraph.

8 “(F) PROCEDURES.—The Patent and  
9 Trademark Office may establish procedures to  
10 carry out this paragraph.”.

11 **SEC. 4. EFFECTIVE DATE.**

12 The amendments made by this Act shall take effect  
13 as if enacted as part of the Leahy-Smith America Invents  
14 Act (Public Law 112–29; 125 Stat. 284).

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