

Summary of Amendments Submitted to the Rules Committee for

H.R. 1249 - America Invents Act

(summaries derived from information provided by sponsors)

Listed in Alphabetical Order

Jun 13, 2011 7:47PM

Click on sponsor for amendment text.

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| Baldwin (WI),
Sensenbrenner
(WI) | #5 | Would strike Section 5, the “prior user rights” language, and conform H.R. 1249 to H.R. 1908, as passed by the U.S. House of Representatives on September 7, 2007, and S. 23, as passed by the U.S. Senate on March 8, 2011. |
| Conyers (MI),
Sensenbrenner
(WI), Manzullo
(IL) | #20 | Would strike the entire bill except Section 2 (Definitions), Section 22 (Patent and Trademark Office Funding) and Section 31 (Budgetary Effects). |
| Conyers (MI),
Rohrabacher
(CA) | #21 | Would insert language to move the United States to a first to file system only upon a Presidential finding that other major patent authorities have adopted a similar one-year grace period. |
| Cuellar (TX) | #19 | Withdrawn Would require the Patent Ombudsman Program for Small Business Concerns to include “independent inventors” to receive support and services relating to patent filings. |
| Jackson Lee (TX) | #22 | Would strike "small businesses" and insert "small business concerns (as defined in section 3 of the Small Business Act (15 U.S.C. 632) including small business concerns that are minority-owned or woman-owned" on page 139. |
| Jackson Lee (TX) | #23 | Would extend the disclosure period for small business entities with assets less than \$2 million from 1 year to 18 months. |
| Jackson Lee (TX) | #24 | Would establish a transitional review program for business method patents that states, within 1 year of enactment, the USPTO shall determine whether this section creates a condition that could be considered the unlawful taking of property. |

- Jackson Lee (TX)** #25 Would establish a transitional review program for business method patents that will sunset years.
- Jackson Lee (TX)** #27 Would add a sense of Congress that it is important to protect the rights of small businesses and inventors from predatory behavior that could result in the cutting off innovation and may provide an undue advantage to large financial institutions and high-tech firms.
- Jackson Lee (TX)** #28 Would add a sense of Congress amendment expressing that these changes do not create an unconstitutional taking of property under the “takings clause” of the U.S. Constitution.
- Jackson Lee (TX)** #29 Would ensure that Historically Black Colleges and Universities and Hispanic serving institutions are included in the definition of “small entities”.
- Jackson (IL)** #26 Would provide the term 'small business concern' shall include minority-owned business and woman-owned business on page 99.
- Lofgren (CA)** #18 Would clarify the scope of the one-year grace period for filing a patent application after disclosures of an invention by the inventor.
- Luján (NM)** #12 Would add requirements to the satellite office location selection process to ensure that 1) the purposes, as described in the bill, of establishing satellite offices are achieved, 2) recruitment costs are minimized by considering the availability of knowledgeable personnel in the region, and 3) the economic impact to the region is considered. It would also require that the Director in the required report to Congress on the rationale in selecting the location of any satellite office include an explanation of how the selected location will achieve the purposes of satellite offices and how the required considerations were met.
- Luján (NM)** #13 Would establish a new section in the bill which requires the Director of the USPTO to work with local small business assistance and economic development organizations, including organizations affiliated with national laboratories and research universities, to provide patent application assistance to small businesses and independent inventors.
- Manzullo (IL)** #1 Would eliminate the ability of the Director of the U.S.

Patent and Trademark Office (USPTO) to set fees, retaining that authority for Congress.

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| Michaud (ME) | #17 | Would clarify the term “technological invention,” for the purposes of Section 18, to ensure that the business method patents review does not include legitimate manufacturing and software patents. |
| Moore, Gwen (WI) | #2 | Would direct the USPTO to develop methods for studying the diversity of patent applicants, including those applicants who are minorities, women, or veterans. Any results of the study shall not be used for preferential treatment in the patent process. |
| Moore, Gwen (WI) | #3 | Would specify that the USPTO will take into consideration small businesses, minority-owned businesses, and women-owned businesses when conducting outreach activities. |
| Peters (MI), Renacci (OH) | #4 | Would mandate a USPTO-led study on what USPTO, SBA, and other agencies can do to help small businesses obtain, maintain, and enforce foreign patents. This study is to be conducted using existing resources. |
| Polis (CO) | #10 | Would clarify that the new legislation would apply only to new tax planning patents, not already filed patents which would disclose patent information leaving the applicants vulnerable. |
| Rohrabacher (CA) | #11 | Would eliminate the burden of post-grant reviews and reexaminations on individual inventors and small businesses with 100 or fewer employees. |
| Schock (IL), Boren (OK) | #37 | Would strike section 18 of H.R. 1249, the Transitional program for covered business method patents. |
| Sensenbrenner (WI) | #14 | Would strike Section 3 of the legislation, which would convert the U.S patent system from “first-to-invent” to “first-to-file.” |
| Shuster (PA) | #35 | Would exempt all business method patents granted prior to the effective date of the legislation from the Business Method Patent Transitional Program. |
| Shuster (PA) | #36 | Would exempt patents for competitive pricing or procurement, supply chain management, or business process |

outsourcing from the Business Method Patent Transitional Program.

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| Smith, Lamar (TX) | #15 | Would make technical edits and a few necessary changes to more substantive issues, such as prior user rights and an additional oversight requirement for the PTO. |
| Speier (CA) | #16 | Would direct the PTO to prescribe a requirement that parties provide sufficient evidence to prove and rebut a claim of derivation. |
| Terry (NE) | #33 | Would strike first-to-file provisions while maintaining the bill's stated purpose, i.e. (1) reduce latency by making office self funding, and (2) improve quality by adding additional layers of review. |
| Terry (NE) | #34 | Would require that a Small Business Study and Report on Prior User Rights be completed and reported with positive results, stating that the bill will not harm the patent system and the country, before the bill goes into effect. |
| Wasserman Schultz (FL) | #38 | Late Would make certain corrections and clarifications to language found at section 27 of the Smith (R-TX) Manager's Amendment and permit independent second opinions in certain genetic diagnostic testing. |
| Waters (CA) | #6 | Would add a severability clause protecting the remainder of the bill if the Supreme Court determines that certain sections or provisions are unconstitutional. |
| Waters (CA) | #7 | Would strike Section 18. |
| Waters (CA) | #8 | Would require the USPTO Director to develop standards and procedures that provide for the inclusion of minority and women-owned businesses in the Office's procurement and business activities. It also would allow the USPTO to consider the extent to which potential USPTO contractors employ and include small, minority, and women-owned businesses in its workforce. It would not apply to, or place any requirements on the USPTO with respect to the examinations of applications for, or issuance of, patents or trademarks. |
| Waters (CA) | #9 | Would provide a preference (not a hard line criteria or quota – merely one or many activities the USPTO can consider) |

for potential USPTO contractors that carry out certain investment and philanthropic activities to bolster education, training, and employment in science, technology, engineering, and mathematics (STEM) disciplines. Rep. Waters' amendment is intended to promote enhanced public and private partnerships, civic, and investment activities to strengthen our nation's STEM pipeline and ensure that the United States continues to produce highly skilled STEM professionals that are both diverse and innovative.

- Wolf (VA)** #30 Would strike section 22 of the bill on Patent and Trademark Office Funding, and provide a corresponding offset.
- Wolf (VA)** #31 Would strike section 22 of the bill on Patent and Trademark Office Funding.
- Wolf (VA)** #32 Would strike section 22 of the bill regarding Patent and Trademark Office funding; provide a corresponding offset; and authorize the retention of excess fee collections subject to appropriations.