

Union Calendar No. 405

103D CONGRESS
2D SESSION

H. R. 4307

[Report No. 103-728]

A BILL

To amend title 35, United States Code, with respect to applications for process patents.

SEPTEMBER 20, 1994

Reported with an amendment, committed to the Committee of the Whole House on the State of the Union, and ordered to be printed

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IN THE HOUSE OF REPRESENTATIVES

APRIL 28, 1994

Mr. HUGHES (for himself, Mr. MOORHEAD, Mr. FRANK of Massachusetts, Mr. BOUCHER, Mr. SENSENBRENNER, Mr. FISH, and Mr. COBLE) introduced the following bill; which was referred to the Committee on the Judiciary

SEPTEMBER 20, 1994

Additional sponsor: Mr. McCOLLUM

SEPTEMBER 20, 1994

Reported with an amendment, committed to the Committee of the Whole House on the State of the Union, and ordered to be printed

[Strike out all after the enacting clause and insert the part printed in italic]

[For text of introduced bill, see copy of bill as introduced on April 28, 1994]

A BILL

To amend title 35, United States Code, with respect to applications for process patents.

1 *Be it enacted by the Senate and House of Representa-*
2 *tives of the United States of America in Congress assembled,*

1 **SECTION 1. EXAMINATION OF PROCESS PATENT APPLICA-**
2 **TIONS FOR OBVIOUSNESS.**

3 *Section 103 of title 35, United States Code, is amend-*
4 *ed—*

5 *(1) by designating the first paragraph as sub-*
6 *section (a);*

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

9 *(3) by inserting after the first paragraph the fol-*
10 *lowing:*

11 *“(b)(1) Notwithstanding subsection (a), and upon*
12 *timely election by the applicant for patent to proceed under*
13 *this subsection, a process using or resulting in a composi-*
14 *tion of matter that is novel under section 102 and*
15 *nonobvious under subsection (a) of this section shall be con-*
16 *sidered nonobvious if—*

17 *“(A) claims to the process and the composition*
18 *of matter are contained in either the same applica-*
19 *tion for patent or in separate applications having the*
20 *same effective filing date; and*

21 *“(B) the composition of matter, and the process*
22 *at the time it was invented, were owned by the same*
23 *person or subject to an obligation of assignment to the*
24 *same person.*

25 *“(2) A patent issued on a process under paragraph*
26 *(1)—*

1 “(A) shall also contain the claims to the com-
2 position of matter used in or made by that process,
3 or

4 “(B) shall, if such composition of matter is
5 claimed in another patent, be set to expire on the
6 same date as such other patent, notwithstanding sec-
7 tion 154.”.

8 **SEC. 2. PRESUMPTION OF VALIDITY; DEFENSES.**

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

16 **SEC. 3. EFFECTIVE DATE.**

17 The amendments made by section 1 shall apply to any
18 application for patent filed on or after the date of the enact-
19 ment of this Act and to any application for patent pending
20 on such date of enactment, including (in either case) an
21 application for the reissue of a patent.