

112TH CONGRESS
1ST SESSION

H. R. 1249

To amend title 35, United States Code, to provide for patent reform.

IN THE HOUSE OF REPRESENTATIVES

MARCH 30, 2011

Mr. SMITH of Texas (for himself, Mr. GOODLATTE, and Mr. ISSA) introduced the following bill; which was referred to the Committee on the Judiciary, and in addition to the Committee on the Budget, for a period to be subsequently determined by the Speaker, in each case for consideration of such provisions as fall within the jurisdiction of the committee concerned

A BILL

To amend title 35, United States Code, to provide for patent reform.

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; TABLE OF CONTENTS.**

4 (a) SHORT TITLE.—This Act may be cited as the
5 “America Invents Act”.

6 (b) TABLE OF CONTENTS.—The table of contents for
7 this Act is as follows:

- Sec. 1. Short title; table of contents.
- Sec. 2. First inventor to file.
- Sec. 3. Inventor’s oath or declaration.
- Sec. 4. Defense to infringement based on earlier inventor.
- Sec. 5. Post-grant review proceedings.

Canfield Scientific, Inc. - Exhibit 1023 Canfield Scientific, Inc. v. Melanoscan, LLC IPR2017-02125

1 tioner files a petition for inter partes review of the
2 patent, that civil action shall be automatically stayed
3 until either—

4 “(A) the patent owner requests to lift the
5 stay;

6 “(B) the patent owner files a civil action or
7 counterclaim alleging that the petitioner, real
8 party in interest, or privy of the petitioner has
9 infringed the patent; or

10 “(C) the petitioner, real party in interest,
11 or privy of the petitioner requests to dismiss the
12 civil action.

13 “(3) TREATMENT OF COUNTERCLAIM.—A coun-
14 terclaim challenging the validity of a claim of a pat-
15 ent does not constitute a civil action challenging the
16 validity of a claim of a patent for purposes of this
17 subsection.

18 “(b) PATENT OWNER’S ACTION.—An inter partes re-
19 view may not be instituted if the petition requesting the
20 proceeding is filed more than 9 months after the date on
21 which the petitioner, real party in interest, or privy of the
22 petitioner is served with a complaint alleging infringement
23 of the patent. The time limitation set forth in the pre-
24 ceding sentence shall not apply to a request for joinder
25 under subsection (c).