

Union Calendar No. 54

112TH CONGRESS
1ST SESSION

H. R. 1249

[Report No. 112–98, Part I]

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

JUNE 1, 2011

Additional sponsors: Mr. CHABOT, Mr. GALLEGLY, and Mr. DUNCAN of Tennessee

JUNE 1, 2011

Reported from the Committee on the Judiciary with an amendment

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

JUNE 1, 2011

The Committee on the Budget discharged; committed to the Committee of the Whole House on the State of the Union and ordered to be printed

[For text of introduced bill, see copy of bill as introduced on March 30, 2011]

Canfield Scientific, Inc. - Exhibit 1024 Canfield Scientific, Inc. v. Melanoscan, LLC IPR2017-02125

1 or privy of the petitioner filed a civil action chal-
2 lenging the validity of a claim of the patent.

3 “(2) *STAY OF CIVIL ACTION.*—If the petitioner,
4 real party in interest, or privy of the petitioner files
5 a civil action challenging the validity of a claim of
6 the patent on or after the date on which the petitioner
7 files a petition for inter partes review of the patent,
8 that civil action shall be automatically stayed until
9 either—

10 “(A) the patent owner moves the court to
11 lift the stay;

12 “(B) the patent owner files a civil action or
13 counterclaim alleging that the petitioner, real
14 party in interest, or privy of the petitioner has
15 infringed the patent; or

16 “(C) the petitioner, real party in interest,
17 or privy of the petitioner moves the court to dis-
18 miss the civil action.

19 “(3) *TREATMENT OF COUNTERCLAIM.*—A coun-
20 terclaim challenging the validity of a claim of a pat-
21 ent does not constitute a civil action challenging the
22 validity of a claim of a patent for purposes of this
23 subsection.

24 “(b) *PATENT OWNER’S ACTION.*—An inter partes re-
25 view may not be instituted if the petition requesting the

1 proceeding is filed more than 1 year after the date on which
 2 the petitioner, real party in interest, or privy of the peti-
 3 tioner is served with a complaint alleging infringement of
 4 the patent. The time limitation set forth in the preceding
 5 sentence shall not apply to a request for joinder under sub-
 6 section (c).

7 “(c) *JOINDER*.—If the Director institutes an inter
 8 partes review, the Director, in his or her discretion, may
 9 join as a party to that inter partes review any person who
 10 properly files a petition under section 311 that the Director,
 11 after receiving a preliminary response under section 313
 12 or the expiration of the time for filing such a response, de-
 13 termines warrants the institution of an inter partes review
 14 under section 314.

15 “(d) *MULTIPLE PROCEEDINGS*.—Notwithstanding sec-
 16 tions 135(a), 251, and 252, and chapter 30, during the
 17 pendency of an inter partes review, if another proceeding
 18 or matter involving the patent is before the Office, the Di-
 19 rector may determine the manner in which the inter partes
 20 review or other proceeding or matter may proceed, includ-
 21 ing providing for stay, transfer, consolidation, or termi-
 22 nation of any such matter or proceeding.

23 “(e) *ESTOPPEL*.—

24 “(1) *PROCEEDINGS BEFORE THE OFFICE*.—The
 25 petitioner in an inter partes review of a claim in a