

98TH CONGRESS  
1ST SESSION

# S. 1535

To amend title 35, United States Code, to increase the effectiveness of the patent laws and for other purposes.

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## IN THE SENATE OF THE UNITED STATES

JUNE 23 (legislative day, JUNE 20), 1983

Mr. MATHIAS (for himself, Mr. DOLE, and Mr. DECONCINI) introduced the following bill; which was read twice and referred to the Committee on the Judiciary

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## A BILL

To amend title 35, United States Code, to increase the effectiveness of the patent laws 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       That section 271 of title 35, United States Code, is amended  
4       by adding at the end thereof the following new subsections:

5       “(e) Whoever without authority imports into or sells or  
6       uses within the United States a product made in another  
7       country by a process patented in the United States shall be  
8       liable as an infringer.

9       “(f) Whoever without authority supplies or causes to be  
10      supplied in the United States the material components of a

1 patented invention, where such components are uncombined  
2 in whole or in part, intending that such components will be  
3 combined outside of the United States, and knowing that if  
4 such components were combined within the United States the  
5 combination would be an infringement of the patent, shall be  
6 liable as an infringer.”.

7       SEC. 2. Section 184 of title 35, United States Code, is  
8 amended by—

9           (1) amending the third sentence thereof by strik-  
10       ing out “inadvertently” and inserting after “filed  
11       abroad” the words “through error and without decep-  
12       tive intent”;

13           (2) adding at the end thereof the following new  
14       paragraph:

15       “In the case of an application for which a license has  
16       been obtained or an application which has been filed in the  
17       United States Patent and Trademark Office for more than six  
18       months before the filing in a foreign country, and on which no  
19       secrecy order has been issued, a license shall not be required  
20       for any modifications, amendments, supplements, divisions, or  
21       other information filed in or transmitted to the foreign coun-  
22       try in connection with such application if such modifications,  
23       amendments, supplements, divisions, or information consist  
24       only of the illustration, exemplification, comparison, or expla-

1 nation of subject matter specifically or generally disclosed in  
2 such application.”.

3       SEC. 3. Section 185 of title 35, United States Code, is  
4 amended by adding before the period in the last sentence  
5 thereof the following: “, unless the failure to procure such  
6 license was through error and without deceptive intent, and  
7 the patent does not disclose subject matter within the scope  
8 of section 181 of this title”.

9       SEC. 4. Section 186 of title 35, United States Code, is  
10 amended by—

11             (1) striking out “whoever, in violation of the pro-  
12 visions of section 184 of this title,”; and

13             (2) inserting “such” after “in respect of any”.

14       SEC. 5. Section 103 of title 35, United States Code, is  
15 amended by adding at the end thereof the following:

16       “Prior art shall not include unpublished information  
17 which is developed by the applicant singly or jointly with  
18 others, or which is known to the applicant only by virtue of  
19 his or her employment.”.

20       SEC. 6. Section 116 of title 35, United States Code, is  
21 amended by amending the first paragraph to read as follows:

22       “When two or more persons have made inventive con-  
23 tributions to the subject matter claimed in an application,  
24 they shall apply for patent jointly and each shall sign the  
25 application and make the required oath, except as otherwise

1 provided in this title. Joint inventors need not have made an  
2 inventive contribution to each claim of the application.”.

3 SEC. 7. Section 135(a) of title 35, United States Code,  
4 is amended by adding at the end thereof the following: “Evi-  
5 dence to establish priority of invention in accordance with  
6 section 102(g) shall be provided by affidavit.”.

7 SEC. 8. Section 135(c) of title 35, United States Code,  
8 is amended by—

9 (1) inserting before “shall render” in the third  
10 sentence the following: “, unless such failure was  
11 through error and without deceptive intent,”; and

12 (2) striking out the words “during the six-month  
13 period” in the fourth sentence and “within the six-  
14 month period” in the sixth sentence.

15 SEC. 9. Section 135 of title 35, United States Code, is  
16 amended by adding at the end thereof the following new  
17 subsection:

18 “(d) Parties to a patent interference may determine such  
19 contest or any aspect thereof by arbitration. The parties shall  
20 give notice of any arbitration award to the Commissioner,  
21 and such award shall be dispositive of the issues to which it  
22 relates. The arbitration award shall be unenforceable until  
23 such notice is given.”.

24 SEC. 10. (a) Title 35, United States Code, is amended  
25 by adding after section 294 the following new section:

1 **“§ 295. Licensee estoppel**

2       “(a) A licensee shall not be estopped from asserting in  
3 judicial action the invalidity of any patent to which it is  
4 licensed. Any agreement between the parties to a patent  
5 license agreement which purports to bar the licensee from  
6 asserting the invalidity of any licensed patent shall be  
7 unenforceable as to that provision.

8       “(b) In the event of an assertion of invalidity by the  
9 licensee in a judicial action, licensee and licensor shall each  
10 have the right to terminate the license at any time after such  
11 assertion. Until so terminated by either party, the licensee  
12 shall pay and the licensor shall receive the consideration set  
13 in the license agreement.”.

14       **(b)** The table of sections for chapter 29 of title 35,  
15 United States Code, is amended by adding after the item  
16 relating to section 294 the following:

“295. Licensee estoppel.”.

17       **SEC. 11.** The amendments made by this Act shall apply  
18 to all unexpired United States patents granted before or after  
19 the date of enactment of this Act.

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