

106TH CONGRESS
2D SESSION

H. R. 5364

To amend title 35, United States Code, to provide for improvements in the quality of patents on certain inventions.

IN THE HOUSE OF REPRESENTATIVES

OCTOBER 3, 2000

Mr. BERMAN (for himself and Mr. BOUCHER) introduced the following bill; which was referred to the Committee on the Judiciary

A BILL

To amend title 35, United States Code, to provide for improvements in the quality of patents on certain inventions.

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.**

4 This Act may be cited as the “Business Method Pat-
5 ent Improvement Act of 2000”.

6 **SEC. 2. DEFINITIONS.**

7 Section 100 of title 35, United States Code, is
8 amended by adding at the end the following:

9 “(f) The term ‘business method’ means—

10 “(1) a method of—

1 “(A) administering, managing, or other-
 2 wise operating an enterprise or organization, in-
 3 cluding a technique used in doing or conducting
 4 business; or

5 “(B) processing financial data;

6 “(2) any technique used in athletics, instruc-
 7 tion, or personal skills; and

8 “(3) any computer-assisted implementation of a
 9 method described in paragraph (1) or a technique
 10 described in paragraph (2).

11 “(g) The term ‘business method invention’ means—

12 “(1) any invention which is a business method
 13 (including any software or other apparatus); and

14 “(2) any invention which is comprised of any
 15 claim that is a business method.”.

16 **SEC. 3. PATENTS ON BUSINESS METHOD INVENTIONS.**

17 (a) IN GENERAL.—Title 35, United States Code, is
 18 amended by inserting after chapter 31 the following new
 19 chapter:

20 **“CHAPTER 32—PATENTS ON BUSINESS**
 21 **METHOD INVENTIONS**

“Sec.

“321. Business method invention determinations.

“322. Opposition procedures.

“323. Effect on other proceedings.

“324. Burden of proof.

1 **“§ 321. Business method invention determinations**

2 “(a) CONFIDENTIALITY.—Except as provided in sub-
3 section (b), an application for a patent on a business
4 method invention shall be kept in confidence by the Patent
5 and Trademark Office and no information concerning the
6 application may be given without authority of the appli-
7 cant or owner unless necessary to carry out the provisions
8 of an Act of Congress or in such special circumstances
9 as may be determined by the Director.

10 “(b) PUBLICATION.—

11 “(1) IN GENERAL.—(A) Subject to subpara-
12 graph (E) and paragraph (2), each application for a
13 patent on a business method invention shall be pub-
14 lished, in accordance with procedures determined by
15 the Director, promptly after the expiration of a pe-
16 riod of 18 months after the earliest filing date for
17 which a benefit is sought under this title. At the re-
18 quest of the applicant, an application may be pub-
19 lished earlier than the end of that 18-month period.

20 “(B) Within 12 months after the earliest filing
21 date of an application for a patent under this title,
22 the Director shall make a determination of whether
23 any invention claimed in the application is a busi-
24 ness method invention.

25 “(C) After making a determination under sub-
26 paragraph (B) that an invention is a business meth-

1 od invention, the Director shall notify the applicant
2 of the determination and shall provide the applicant
3 with a period of 60 days within which to respond to
4 the determination by amending the application, with-
5 drawing the application, or otherwise.

6 “(D) No information concerning patent applica-
7 tions published under this subsection shall be made
8 available to the public, except as the Director deter-
9 mines.

10 “(E)(i) The Director shall establish procedures
11 for making determinations under subparagraph (B),
12 and for addressing amendments to any application
13 that may affect the Director’s determination of
14 whether the invention claimed in the application is
15 a business method invention.

16 “(ii) In no case shall an application that would
17 be subject to section 122 but for this section be pub-
18 lished later than the date that would otherwise apply
19 to the application under section 122.

20 “(2) EXCEPTIONS.—(A) An application shall
21 not be published under paragraph (1) if that appli-
22 cation is—

23 “(i) no longer pending;

24 “(ii) subject to a secrecy order under sec-
25 tion 181 of this title;

1 “(iii) a provisional application filed under
2 section 111(b) of this title; or

3 “(iv) an application for a design patent
4 filed under chapter 16 of this title.

5 “(B) No application for a patent shall be pub-
6 lished under paragraph (1) if the publication or dis-
7 closure of such invention would be detrimental to the
8 national security. The Director shall establish appro-
9 priate procedures to ensure that such applications
10 are promptly identified and the secrecy of such in-
11 ventions is maintained in accordance with chapter
12 17 of this title.

13 “(3) PUBLIC PARTICIPATION.—Any party shall
14 have the opportunity to submit to the Director for
15 the record prior art (including, but not limited to,
16 evidence of knowledge or use, or public use or sale,
17 under section 102), file a protest, or petition the Di-
18 rector to conduct a proceeding to determine whether
19 the invention was known or used, or was in public
20 use, or on sale, under section 102 or is obvious
21 under section 103. The Director shall conduct such
22 a proceeding if the petition—

23 “(i) is in writing;

24 “(ii) is accompanied by payment of the fee
25 set forth in section 41(a) of this title; and

1 “(iii) sets forth in detail the basis on which
2 the proceeding is requested.

3 “(4) AVAILABILITY OF INFORMATION.—Infor-
4 mation submitted pursuant to paragraph (3) shall be
5 considered during the examination of the patent ap-
6 plication.

7 “(5) PROVISIONAL RIGHTS.—During the period
8 of pendency of an application after publication, an
9 applicant shall have provisional rights pursuant to
10 section 154 of this title.

11 **“§ 322. Opposition procedures**

12 “(a) ADMINISTRATIVE OPPOSITION PANEL.—

13 “(1) ESTABLISHMENT.—The Director shall, not
14 later than 1 year after the date of enactment of the
15 Business Method Patent Improvement Act of 2000,
16 establish an Administrative Opposition Panel. The
17 Administrative Opposition Panel shall be comprised
18 of not less than 18 administrative opposition judges,
19 each of whom shall be an individual of competent
20 legal knowledge and scientific ability. Upon estab-
21 lishment of the Administrative Opposition Panel, the
22 Director shall publish notice of the establishment of
23 the Panel in the Federal Register.

24 “(2) ASSIGNMENT OF PATENT EXAMINERS TO
25 PANEL.—Patent examiners may be assigned on de-

1 tail to assist the Administrative Opposition Panel in
2 carrying out opposition proceedings under this sec-
3 tion, except that a patent examiner may not be as-
4 signed to assist in review of a patent application ex-
5 amined by that patent examiner. The Director shall
6 establish procedures by which an opposition is heard
7 under subsection (b).

8 “(b) OPPOSITION PROCEDURES.—

9 “(1) REQUEST FOR OPPOSITION.—(A) Any per-
10 son may file a request for an opposition to a patent
11 on a business method invention on the basis of sec-
12 tion 101, 102, 103, or 112 of this title. Such a re-
13 quest is valid only if the request—

14 “(i) is made not later than 9 months after
15 the date of issuance of the patent;

16 “(ii) is in writing;

17 “(iii) is accompanied by payment of the
18 opposition fee set forth in section 41(a) of this
19 title; and

20 “(iv) sets forth in detail the basis on which
21 the opposition is requested.

22 “(B) Not later than 60 days after receiving a
23 valid request under subparagraph (A), the Director
24 shall issue an order for an opposition proceeding to
25 be held on the record after opportunity for a hear-

1 ing, and shall promptly send a copy of the request
2 to the owner of record of the patent. The patent
3 owner shall be provided a reasonable period, but in
4 no case less than 60 days after the date on which
5 a copy of the request is given or mailed to the pat-
6 ent owner, within which the owner may file a state-
7 ment in reply to the grounds for the request for op-
8 position, including any amendment to the patent and
9 new claim or claims, for consideration in the opposi-
10 tion proceeding. If the patent owner files such a
11 statement, the patent owner promptly shall serve a
12 copy of the statement on the third-party requester.
13 Not later than 2 months after the date of such serv-
14 ice, the third-party requester may file and have con-
15 sidered in the opposition proceeding a reply to the
16 statement filed by the patent owner.

17 “(2) CONDUCT OF OPPOSITION PRO-
18 CEEDINGS.—Each opposition shall be heard by one
19 administrative opposition judge, and no party shall
20 be permitted ex parte communication with the ad-
21 ministrative opposition judge. In addition to the
22 statements and replies set forth in paragraph (1),
23 the administrative opposition judge may consider
24 evidence that the judge considers relevant, including
25 evidence that is presented in any oral testimony (in-

1 including exhibits and expert testimony) in direct or
2 cross examination, or in any deposition, affidavit, or
3 other documentary form, whether voluntary or com-
4 pelled. In any opposition proceeding, the Federal
5 Rules of Evidence shall apply.

6 “(3) AMENDMENTS TO PATENT CLAIMS.—A
7 patent applicant may propose to amend a patent
8 claim or propose a new claim at any time during the
9 opposition proceeding, except that no proposed
10 amended or new claim enlarging the scope of a claim
11 of the patent may be permitted at any time during
12 an opposition proceeding under this section.

13 “(4) DETERMINATION.—Not later than 18
14 months after the filing of a request for an opposition
15 under this section, the administrative opposition
16 judge in the opposition proceeding shall determine
17 the patentability of the subject matter of the patent,
18 a record of the administrative opposition judge’s de-
19 termination under this section shall be placed in the
20 official file of the patent, and a copy promptly shall
21 be given or mailed to the owner of record of the pat-
22 ent and to the third-party requester.

23 “(5) APPEALS.—Any party to the opposition
24 may appeal a decision of the Administrative Opposi-
25 tion Panel under the provisions of section 134 of

1 this title, and may seek court review under the pro-
2 visions of section 141 to 145 of this title, with re-
3 spect to any decision in regard to the patentability
4 of any original or proposed amended or new claim
5 of the patent. A patent owner may be a party to an
6 appeal taken by a third-party requester. Any third-
7 party requester may be a party to an appeal taken
8 by a patent owner.

9 “(6) CERTIFICATION OF PATENTABILITY.—In
10 an opposition proceeding under this chapter, when
11 the time for appeal has expired or any appeal pro-
12 ceeding has terminated, the Director shall issue and
13 publish a certificate canceling any claim of the pat-
14 ent finally determined to be unpatentable, con-
15 firming any claim of the patent determined to be
16 patentable, and incorporating in the patent any pro-
17 posed amended or new claim determined to be pat-
18 entable.

19 “(7) EFFECT OF DETERMINATION.—Any pro-
20 posed, amended, or new claim determined to be pat-
21 entable and incorporated into a patent following an
22 opposition proceeding shall have the same effect as
23 that specified in section 252 of this title for reissued
24 patents on the right of any person who made, pur-
25 chased, or used within the United States, or im-

1 ported into the United States, anything patented by
2 such proposed amended or new claim, or who made
3 substantial preparations therefor, prior to issuance
4 of a certificate under paragraph (6) of this sub-
5 section.

6 **“§ 323. Effect on other proceedings**

7 “(a) RIGHT TO LITIGATION.—Subject to subsections
8 (b), (c), and (d), proceedings under section 322 shall not
9 alter or prejudice any party’s right to pursue remedies
10 under provisions of law other than this section. In the case
11 of court proceedings, other than an appeal of a decision
12 in an opposition proceeding under this section, the court
13 may consider any matter independently of any opposition
14 proceeding under this section.

15 “(b) EFFECT OF FINAL DECISION.—

16 “(1) IN GENERAL.—If a final decision has been
17 entered against a party in a civil action arising in
18 whole or in part under section 1338 of title 28, es-
19 tablishing that the party has not sustained its bur-
20 den of proving the invalidity of any patent claim, or
21 if a final decision in an inter partes reexamination
22 proceeding or an opposition proceeding instituted by
23 a third-party requester is favorable to the patent-
24 ability of any original or proposed amended or new
25 claim of the patent—

1 “(A) neither that party to the civil action,
2 the third-party requester, nor the privies of that
3 party or third-party requester may thereafter
4 bring a civil action under section 1338 of title
5 28, or request an inter partes reexamination of,
6 or an opposition to, such patent claim on the
7 basis of issues which that party, third-party re-
8 quester, or the privies of that party or third-
9 party requester raised or could have raised in
10 such civil action, inter partes reexamination
11 proceeding, or opposition proceeding (as the
12 case may be); and

13 “(B) an inter partes reexamination or op-
14 position requested by that party, third-party re-
15 quester, or the privies of that party or third-
16 party requester on the basis of such issues may
17 not thereafter be maintained by the Office.

18 “(2) NEW EVIDENCE.—Paragraph (1) does not
19 prevent the assertion by a party to a civil action or
20 a third-party requester of invalidity based on newly
21 discovered prior art, or other evidence, unavailable
22 to that party or third-party requester, as the case
23 may be, and the Patent and Trademark Office, at
24 the time of the civil action, inter partes reexamina-
25 tion, or opposition proceeding (as the case may be).

1 “(c) STAY OF LITIGATION.—Once an order for an op-
2 position proceeding with respect to a patent has been
3 issued under section 322(b)(1), any party to the pro-
4 ceeding may obtain a stay of any pending court proceeding
5 (other than an appeal to the Court of Appeals for the Fed-
6 eral Circuit) which involves an issue of patentability of any
7 claims of the patent which are the subject of the opposi-
8 tion proceeding, unless the court before which such litiga-
9 tion is pending determines that a stay would not serve the
10 interests of justice.

11 **“§ 324. Burden of proof**

12 “(a) BURDEN OF PROOF.—In the case of reexamina-
13 tion, interference, opposition, or other legal challenge (in-
14 cluding a civil action brought in whole or in part under
15 section 1338 of title 28) to a patent (or an application
16 for a patent) on a business method invention, the party
17 producing evidence of invalidity or ineligibility shall have
18 the burden of showing by a preponderance of the evidence
19 the invalidity of the patent or ineligibility of the subject
20 matter of the application.”.

21 (b) FEES.—Section 41(a) of title 35, United States
22 Code, is amended—

23 (1) by redesignating paragraphs (7) through
24 (15) as paragraphs (9) through (17), respectively;
25 and

1 (2) by inserting after paragraph (6) the fol-
2 lowing:

3 “(7)(A) On filing an opposition under chapter
4 32 to a patent on a business method invention based
5 on prior art citations or obviousness, a fee of \$200.

6 “(B) On filing an opposition under chapter 32
7 to a patent on a business method invention on any
8 other basis, a fee of \$5,000.

9 “(C) The Director may waive the payment by
10 an individual of fees under this paragraph if such
11 waiver is in the public interest.

12 “(8) On filing a request for a proceeding to de-
13 termine whether an invention claimed in an applica-
14 tion was known or used, or has been in public use
15 or on sale, under section 102, a fee of \$35.”.

16 (b) CLERICAL AMENDMENT.—The table of chapters
17 for part III of title 35, United States Code, is amended
18 by adding at the end the following:

“32. Patents on Business Method Inventions 321.”.

19 **SEC. 4. NONOBVIOUSNESS.**

20 Section 103 of title 35, United States Code, is
21 amended by adding at the end the following:

22 “(d)(1) If—

23 “(A) subject matter within the scope of a claim
24 addressed to a business method invention would be

1 obtained by combining or modifying one or more
2 prior art references, and

3 “(B) any of those prior art references discloses
4 a business method which differs from what is
5 claimed only in that the claim requires a computer
6 technology to implement the practice of the business
7 method invention,

8 the invention shall be presumed obvious to a person of
9 ordinary skill in the art at the time of the invention.

10 “(2)(A) An applicant or patentee may rebut the pre-
11 sumption under paragraph (1) upon a showing by a pre-
12 ponderance of the evidence that the invention is not obvi-
13 ous to persons of ordinary skill in all relevant arts.

14 “(B) Those areas of art which are relevant for pur-
15 poses of subparagraph (A) include the field of the business
16 method and the field of the computer implementation.”.

17 **SEC. 5. REQUIREMENT TO DISCLOSE SEARCH.**

18 The Director of the Patent and Trademark Office
19 shall, within 30 days after the date of enactment of this
20 Act, publish notice of rulemaking proceedings to amend
21 the rules of the Patent and Trademark Office to require
22 an applicant for a patent for a business method invention
23 to disclose in the application the extent to which the appli-
24 cant searched for prior art to meet the requirements of
25 title 35, United States Code. Such amendment shall in-

1 clude appropriate penalties for failure to comply with such
2 requirement. The Director shall ensure that the amend-
3 ment is implemented as promptly as possible.

4 **SEC. 6. CONFORMING AMENDMENTS.**

5 (a) DEFINITIONS.—Section 100(e) of title 35, United
6 States Code, is amended by striking “or inter partes reex-
7 amination under section 311” and inserting “, inter partes
8 reexamination under section 311, or an opposition under
9 section 322,”.

10 (b) BOARD OF PATENT APPEALS AND INTER-
11 FERENCES.—Section 134 of title 35, United States Code,
12 is amended—

13 (1) in subsection (b)—

14 (A) by inserting “or opposition” after “re-
15 examination”; and

16 (B) by inserting “or the Administrative
17 Opposition Panel (as the case may be)” after
18 “administrative patent judge”; and

19 (2) in subsection (c)—

20 (A) by striking “proceeding” and inserting
21 “reexamination proceeding or an opposition
22 proceeding”;

23 (B) by inserting “or the Administrative
24 Opposition Panel (as the case may be)” after
25 “administrative patent judge”; and

1 (C) in the last sentence, by inserting “in
2 an inter partes reexamination proceeding” after
3 “requester”.

4 (c) APPEAL TO COURT OF APPEALS.—(1) Section
5 141 of title 35, United States Code, is amended in the
6 second sentence by inserting after “reexamination pro-
7 ceeding” the following: “, and any party in an opposition
8 proceeding, who is”.

9 (2) Section 143 of title 35, United States Code, is
10 amended by inserting after the third sentence the fol-
11 lowing: “In any opposition proceeding, the Administrative
12 Opposition Panel shall submit to the court in writing the
13 grounds for the decision of the Panel, addressing all the
14 issues involved in the appeal.”.

15 (d) DEFENSE TO INFRINGEMENT.—Section 273 of
16 title 35, United States Code, is amended—

17 (1) in subsection (a)—

18 (A) by striking paragraph (3) and redesignig-
19 nating paragraph (4) as paragraph (3); and

20 (B) in paragraphs (1) and (2) by striking
21 “method” and inserting “business method”;
22 and

23 (2) in subsection (b), by striking “method”
24 each place it appears and inserting “business meth-
25 od”.

1 (e) OTHER PUBLICATION OF PATENT APPLICA-
2 TIONS.—Section 122 of title 35, United States Code, is
3 amended by adding at the end the following:

4 “(e) BUSINESS METHOD INVENTIONS.—In the case
5 of applications for business method inventions, section 321
6 of this title applies in lieu of this section.”.

7 **SEC. 7. EFFECTIVE DATE.**

8 (a) IN GENERAL.—Subject to subsections (b), (c),
9 and (d), this Act and the amendments made by this Act
10 apply to—

11 (1) any application for patent that is pending
12 on, or that is filed on or after, the date of enactment
13 of this Act; and

14 (2) any patent issued on or after the date of en-
15 actment of this Act.

16 (b) PENDING APPLICATIONS.—In applying section
17 321 of title 35, United States Code, as added by section
18 3 of this Act, to an application for patent that is pending
19 on the date of enactment of this Act—

20 (1) the Director of the Patent and Trademark
21 Office shall make the determination required by sub-
22 section (b)(1)(B) of such section 321 within 12
23 months after the date of enactment of this Act, or
24 on the date specified in such section 321, whichever
25 occurs later;

1 (2) subject to paragraph (3), such an applica-
2 tion shall be published—

3 (A) on the date specified in section 321 of
4 title 35, United States Code, or

5 (B) the date on which the determination is
6 made pursuant to paragraph (1),

7 whichever occurs later; and

8 (3) in no case shall an application that would
9 be published under section 122 of title 35, United
10 States Code, but for the enactment of this Act, be
11 published later than the date specified in such sec-
12 tion 122, regardless of when the Director makes the
13 determination under paragraph (1).

14 (c) PATENTS ISSUED BEFORE ESTABLISHMENT OF
15 ADMINISTRATIVE OPPOSITION PANEL.—In the case of a
16 patent issued after the enactment of this Act but before
17 the date on which notice of the establishment of the Ad-
18 ministrative Opposition Panel is published under section
19 322(a)(1) of title 35, United States Code (as added by
20 this Act), a request for an opposition to the patent may
21 be filed under section 322(b)(1)(A) of title 35, United
22 States Code (as added by this Act), notwithstanding the
23 9-month requirement set forth in clause (i) of that section,

- 1 if the request is filed not later than 9 months after the
- 2 date on which such notice is so published.

○