

AMENDMENT NO. _____ Calendar No. _____

Purpose: To include original inventors in the bill's exemptions.

IN THE SENATE OF THE UNITED STATES—114th Cong., 1st Sess.

S. 1137

To amend title 35, United States Code, and the Leahy-Smith America Invents Act to make improvements and technical corrections, and for other purposes.

Referred to the Committee on _____ and
ordered to be printed

Ordered to lie on the table and to be printed

AMENDMENTS intended to be proposed by Mr. DURBIN

Viz:

1 On page 5, strike lines 14 through 16 and insert the
2 following:

3 “(f) EXEMPTIONS.—Subsection (a) shall not apply
4 to—

5 “(1) a civil action that includes a claim for re-
6 lief arising under section 271(e); or

7 “(2) a party alleging infringement if the party
8 is the inventor, a joint inventor, or in the case of a
9 patent filed by and awarded to an assignee of the
10 original inventor or joint inventor, the original as-
11 signee of the patent.

1 On page 18, between lines 3 and 4, insert the fol-
2 lowing:

3 “(3) ORIGINAL INVENTORS.—This section shall
4 not apply to a party alleging infringement if the
5 party is the inventor, a joint inventor, or in the case
6 of a patent filed by and awarded to an assignee of
7 the original inventor or joint inventor, the original
8 assignee of the patent.

9 On page 31, strike lines 1 through 9 and insert the
10 following:

11 “(d) EXEMPTED CLAIMS.—

12 “(1) APPLICABILITY.—Subsections (a), (b), and
13 (c) shall not apply to—

14 “(A) a civil action that includes a claim for
15 relief arising under section 271(e); or

16 “(B) a party alleging infringement if the
17 party is the inventor, a joint inventor, or in the
18 case of a patent filed by and awarded to an as-
19 signee of the original inventor or joint inventor,
20 the original assignee of the patent.

21 “(2) AWARD IN EXEMPTED CLAIMS.—In a civil
22 action that includes a claim for relief arising under
23 section 271(e) or in which the party alleging in-
24 fringement is described in paragraph (1)(B) of this

1 subsection, the court may in exceptional cases award
2 reasonable attorney fees to the prevailing party.”.