

AMENDMENT NO. \_\_\_\_\_ Calendar No. \_\_\_\_\_

Purpose: To ensure fairness in post-grant proceedings with respect to standing.

**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

AMENDMENT intended to be proposed by Mr. COONS (for himself, Mr. VITTER, and Mr. DURBIN)

Viz:

1 At the appropriate place, insert the following:

2 **SEC. \_\_\_\_ . STANDING IN POST-GRANT PROCEEDINGS.**

3 (a) INTER PARTES REVIEW.—Section 311 of title 35,  
4 United States Code, is amended by adding at the end the  
5 following:

6 “(d) PERSONS THAT MAY PETITION.—

7 “(1) DEFINITION.—In this subsection, the term  
8 ‘charged with infringement’ means a real and sub-  
9 stantial controversy regarding infringement of a pat-  
10 ent exists such that the petitioner would have stand-

1 ing to bring a declaratory judgment action in Fed-  
2 eral court.

3 “(2) NECESSARY CONDITIONS.—A person may  
4 not file with the Office a petition to institute a post-  
5 grant review of the patent unless the person, or a  
6 real party in interest or privy of the person, dem-  
7 onstrates—

8 “(A) a reasonable possibility of being—

9 “(i) sued for infringement of the pat-  
10 ent; or

11 “(ii) charged with infringement under  
12 the patent;

13 “(B) a competitive harm related to the va-  
14 lidity of the patent; or

15 “(C) that the patent at issue has been the  
16 subject of widespread demand letters sent to  
17 small business concerns, as defined in section 3  
18 of the Small Business Act (15 U.S.C. 632).”.

19 (b) POST-GRANT REVIEW.—Section 321 of title 35,  
20 United States Code, is amended by adding at the end the  
21 following:

22 “(d) PERSONS THAT MAY PETITION.—

23 “(1) DEFINITION.—In this subsection, the term  
24 ‘charged with infringement’ means a real and sub-  
25 stantial controversy regarding infringement of a pat-

1 ent exists such that the petitioner would have stand-  
2 ing to bring a declaratory judgment action in Fed-  
3 eral court.

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6 grant review of the patent unless the person, or a  
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9 “(A) a reasonable possibility of being—

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12 “(ii) charged with infringement under  
13 the patent;

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15 lidity of the patent; or

16 “(C) that the patent at issue has been the  
17 subject of widespread demand letters sent to  
18 small business concerns, as defined in section 3  
19 of the Small Business Act (15 U.S.C. 632).”.