

| | H.R. 3309 - Goodlatte | H.R. 2024 - Deutch | H.R. 2639 - Jeffries | H.R. 2766 - Issa | S. 866 - Schumer | S. 1013 - Cornyn | President's Recommendations | IPO Position |
|--|---|--|--|------------------|------------------|--|---|--|
| 1. Cost Shifting Including Attorney Fees | <ul style="list-style-type: none"> Awards to prevailing party unless non-prevailing party position "substantially justified" or exceptional circumstances make unjust. If losing party unable to pay, court may make recoverable against joined "interested party." Party asserting claim, who later extends covenant not to sue, is deemed "non-prevailing party." | n/a | <ul style="list-style-type: none"> Requires court to make findings regarding compliance with Rule 11. Upon finding of violation, court may impose sanctions including attorney fees. | n/a | n/a | <ul style="list-style-type: none"> Awards to prevailing party unless non-prevailing party position and conduct "objectively reasonable and substantially justified" or exceptional circumstances make unjust. If losing party unable to pay, court may make recoverable against any interested party. | Provide district courts more discretion to award fees under 35 U.S.C. § 285. | <ul style="list-style-type: none"> Award to prevailing party unless position and conduct of non-prevailing party were objectively reasonable and substantially justified. Not required if exceptional circumstances make unjust. |
| 2. Disclosure of Real Party-in-Interest (RPI) | <ul style="list-style-type: none"> Disclosure to court, USPTO, and adverse parties in infringement suits except ANDA suits; encumbers patent with ongoing duty of disclosure to USPTO. Includes assignee, entity with right to sublicense or enforce patent, financial interest in patent or plaintiff, and ultimate parent. Financial interest defined as ownership/control of > 5% of plaintiff or right to receive proceeds from assertion of patent. Nondisclosing party may not recover fees/damages related to period of noncompliance, and court may award adverse party costs incurred as result of nondisclosure. Court may join "interested party" upon showing by defendant that plaintiff interest is primarily asserting the patent in litigation. | <ul style="list-style-type: none"> Disclosure to USPTO of RPI and owner upon patent grant, payment of maintenance fees, and within 90 days after transfer of ownership. Includes ultimate parent, others with direct financial interest, exclusive licensees and others with right to enforce patent. Nondisclosing party may only recover damages prospectively from date on which disclosure requirement met. | <ul style="list-style-type: none"> Requires disclosure in complaint alleging patent infringement along with description of plaintiff's business, identification of assignees and exclusive licensees, and identity of any person known to have a legal or financial right to enforce patent. Court can join "interested party." Defendant must file motion within 120 days and show that plaintiff's interest is primarily asserting the patent in litigation. | n/a | n/a | <ul style="list-style-type: none"> Requires disclosure in complaint alleging patent infringement, along with description of plaintiff's business, identification of assignees and exclusive licensees, any identify of any person known to have legal right to enforce patent or financial interest in outcome of proceeding. Court can join "interested party" upon showing by defendant that plaintiff's interest is primarily asserting the patent in litigation. | <ul style="list-style-type: none"> Disclosure to upon sending demand letters, filing infringement suit, or seeking USPTO review. Enable USPTO and district courts to impose sanctions for non-compliance. Directs USPTO to initiate rulemaking process to require disclosure of ultimate parent in proceedings before USPTO. | <ul style="list-style-type: none"> Expand current rules to include ultimate parent of owner. Oppose multiple mandatory disclosures at prescribed times and potential limitation of damages. Oppose requiring disclosure of non-ownership interests: direct financial interest, exclusive licensees and others with right to enforce patent. |
| 3. Stays of Litigation Against End Users | <ul style="list-style-type: none"> Requires stay as to customer where manufacturer is party to same or other action on same patent. Parties must consent to stay. Motion must be filed within 120 days. Customer must agree to be bound by judgment entered against manufacturer. May be lifted where manufacturer suit will not resolve major issue in customer suit or unjust to party seeking to lift. | n/a | <ul style="list-style-type: none"> Requires stay as to "secondary party" with respect to infringement related to a primary party in same or other action on same allegedly infringing product or process. Parties must consent to stay. Motion must be filed within 120 days. Secondary party must agree to be bound by judgment entered against primary party. | n/a | n/a | n/a | Stay suit against customer when suit has also been brought against manufacturer. | Support stay against customer while suit proceeds against manufacturer. Should be carefully tailored to avoid unintended adverse consequences to innovators, manufacturers and customers. |
| 4. Heightened Pleading Standard for Patent Infringement | <ul style="list-style-type: none"> Requires pleading each asserted claim, allegedly infringing product or process including names and model numbers if known, and theory of how each accused product or service infringes each asserted claim except in ANDA suits and where information not reasonably accessible. Requires description of all rights to assert patent. Requires description of any licensing commitments, e.g. through standard setting. Requires explanation if of inaccessibility and attempts to access where information not disclosed. Permits court to allow filing of confidential information under seal. Eliminates Form 18; Supreme Court may create new form. | n/a | <ul style="list-style-type: none"> Requires pleading with particularity each asserted claim, allegedly infringing product or service including names and model numbers if known, and theory of how each accused product or service infringes each asserted claim. Requires description of all rights to assert patent. Requires amendment of Form 18. | n/a | n/a | <ul style="list-style-type: none"> Requires pleading with particularity each asserted claim, allegedly infringing product or service including names and model numbers if known, and theory of how each accused product or service infringes each asserted claim. Requires description of all rights to assert patent. Requires amendment of Form 18. | n/a | Support modifying Form 18 to include identification of at least one claim alleged to infringe, statement explaining such infringement, and statement addressing any indirect infringement alleged. |

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| 5. Post Grant Review and Inter Partes Review | <ul style="list-style-type: none"> Eliminates provision barring PGR petitioner from later asserting in a civil action that a claim is invalid on any ground that the petitioner "reasonably could have raised" during PGR. Requires USPTO to change approach to claim construction in PGR and IPR. | n/a | n/a | n/a | n/a | n/a | Permit wider range of challengers to petition for review of issued patents before PTAB. | <ul style="list-style-type: none"> Support eliminating provision barring PGR petitioner from later asserting in civil or ITC action that a claim is invalid on any ground petitioner "reasonably could have raised" during PGR. Support requiring USPTO to change approach to claim construction in PGR and IPR. |
| 6. Expanding Transitional Program for Covered Business Method Patents | <ul style="list-style-type: none"> Eliminates 8-year sunset. Limits to pre-AIA patents. Allows USPTO Director to waive fee. | n/a | n/a | <ul style="list-style-type: none"> Eliminates 8-year sunset and deletes limitation to "a financial product." Requires USPTO to work with/support IP law associations with <i>pro bono</i> programs and assist "financially under-resourced" alleged infringers. | <ul style="list-style-type: none"> Eliminates 8-year sunset and deletes limitation to "a financial product." | n/a | Broaden definition of "covered business method patent." | Oppose |
| 7. Identification of Core Discovery and Discovery Fee Shifting | <ul style="list-style-type: none"> Limits discovery prior to claim construction ruling to information necessary to construe claims or resolve motions. Court may expand where resolution within specified period of time affects rights of a party with respect to patent(s). Instructs Judicial Conference to develop rules: identifying "core documentary evidence" that must be produced by both parties, requiring party seeking additional discovery to bear costs including attorney fees, and allowing court to deny request for additional discovery if excessive, irrelevant, or abusive. Requires Judicial Conference to study efficacy of rules and procedures for first four years after implementation, authorizes modification following this study. | n/a | <ul style="list-style-type: none"> Requires court to stay discovery until after court rules on any motion to dismiss, transfer venue, and Markman hearing, except where discovery required to rule on these issues. | n/a | n/a | <ul style="list-style-type: none"> Limits discovery prior to claim construction ruling to information necessary to construe claims or resolve motions. Court may expand where resolution within specified period of time affects rights of a party with respect to patent(s). Each party responsible for producing "core documentary evidence." Party seeking additional discovery bears costs including attorney fees. | n/a | n/a |
| 8. Bankruptcy Protection | Bars bankruptcy trustee from terminating certain licenses. | n/a | | | n/a | n/a | n/a | Support |
| 9. Double Patenting | Codifies doctrine of double patenting for first-inventor-to-file patents. | n/a | | | n/a | n/a | n/a | n/a |
| 10. Repeal of 35 U.S.C. §145 | Prevents patent applicant rejected by the USPTO from filing suit in district court. | n/a | | | n/a | n/a | n/a | Oppose |