

CQ MARKUP & VOTE COVERAGE

House Judiciary Committee Markup

April 14, 2011 - Updated to include links to amendment text

Panel Approves Patent Overhaul Measure

By Joanna Anderson, CQ Staff

The House Judiciary Committee advanced a patent measure on Thursday with broad bipartisan support, furthering an effort to overhaul the nation's patent law for the first time in decades.

By a 32-3 vote, the panel approved the bill (HR 1249) to shift the basis for issuing patents to a "first inventor to file" standard, allow the U.S. Patent and Trademark Office (PTO) to keep all the fees it collects and alter mechanisms to challenge the validity of issued patents. The Senate passed similar legislation (S 23) last month.

During Thursday's markup, the House panel turned back proposals to strip core provisions of the bill and instead opted to make more modest changes.

The committee rejected, by voice vote, an amendment by F. James Sensenbrenner Jr., R-Wis., to strike the bill's "first inventor to file" language. Supporters of the provision argue that it will provide greater certainty about patent ownership and put the United States in line with other nations. Currently, U.S. patents are awarded based on a "first to invent" standard.

Sensenbrenner withdrew a proposal to strike language that would create a "prior use" defense against patent infringement claims for alleged violators found using an invention before it was patented. However, a manager's amendment by panel Chairman Lamar Smith, R-Texas, adopted 29-2, narrowed the scope of the "prior use" defense by limiting it to "process" patents and by restricting its application to the United States.

Among the bill's key elements are provisions to allow the beleaguered PTO to set fees for patent applicants and to keep all revenue it generates in fees. Supporters of that proposal argue it would help the patent office as it struggles with a backlog of patent applications, a shortage of examiners and outdated computer systems. On Thursday, the House panel agreed to include a six-year sunset of the PTO fee-setting authority.

Panel members also altered the bill's language to establish new rules for a "inter partes" review of the validity of patents after they are granted. The committee voted to extend the review timeline from nine months after service of a complaint to 12 months and to raise the threshold for challenges to a "reasonable likelihood that the petitioner would prevail."

Also on Thursday, the committee rejected, 11-24, a proposal by ranking Democrat John Conyers Jr., of Michigan to limit the use of a transitional post-grant review process for business method patents to claims that have not already undergone review or have not been reissued as valid claims. Proponents of the underlying provision argue the additional process would allow business method patents to be re-examined using "prior art" -- previously disclosed information about an invention -- as an alternative to litigation and would help invalidate poor-quality patents.

The panel rejected, 8-21, a Zoe Lofgren, D-Calif., amendment to strike a provision that would allow patent owners to request a supplemental review of a patent in order to make corrections. But the committee did adopt, 21-9, a Robert W. Goodlatte, R-Va., amendment to prohibit the use of the supplemental review for cases revealed to involve fraud against the Patent office.

Committee Votes

HR 1249

Patent Overhaul/Prior User Rights

Sensenbrenner, R-Wis. – Amendment to the Smith manager's amendment that would strike language to create a "prior use" defense against patent infringement claims for alleged infringers who were using an invention before it was patented.

Withdrawn; April 14, 2011.

HR 1249

Patent Overhaul/Fee-Setting Sunset

Watt, D-N.C. – Amendment to the Smith manager's amendment that would provide for a six-year sunset of the U.S. Patent and Trademark Office fee-setting authority.

Adopted by voice vote; April 14, 2011.

HR 1249

Patent Overhaul/First-to-File

Sensenbrenner, R-Wis. – Amendment to the Smith manager's amendment that would strike language to shift the basis for issuing patents to a "first inventor to file" standard.

Rejected by voice vote; April 14, 2011.

HR 1249

Patent Overhaul/Litigation Study

Watt, D-N.C. – Amendment to the Smith manager's amendment that would revise language related to a Government Accountability Office report to Congress on patent litigation. It would require recommendations for changes to laws and regulations that would minimize "any negative impact" of litigation -- as opposed to the underlying "the negative impact" of litigation -- so as to avoid presuming a negative finding.

Adopted by voice vote; April 14, 2011.

HR 1249

Patent Overhaul/Inter Partes Threshold

Chu, D-Calif. – Amendment to the Smith manager's amendment that would maintain the lower threshold for inter partes review of "a substantial new question of patentability."

Rejected 7-21: R 0-18; D 7-3; I 0-0; April 14, 2011.

[Vote Key](#)

YEAS (7)

Democrats (7)

Berman (Calif.)

Lofgren (Calif.)

Watt (N.C.)

Chu (Calif.)

Nadler (N.Y.)

Conyers (Mich.)

Waters (Calif.)

NAYS (21)

Republicans (18)

Adams (Fla.)

Coble (N.C.)

Gallegly (Calif.)

Issa (Calif.)

Marino (Pa.)

Ross, D. (Fla.)

Chabot (Ohio)

Forbes (Va.)

Goodlatte (Va.)

King, S. (Iowa)

Pence (Ind.)

Sensenbrenner (Wis.)

Chaffetz (Utah)

Franks, T. (Ariz.)

Gowdy (S.C.)

Lungren (Calif.)

Quayle (Ariz.)

Smith, Lamar (Texas)

Johnson, H. (Ga.)

Scott, R. (Va.)

Lofgren (Calif.)

Waters (Calif.)

Nadler (N.Y.)

Watt (N.C.)

NAYS (17)

Republicans (16)

Chabot (Ohio)

Franks, T. (Ariz.)

Goodlatte (Va.)

Issa (Calif.)

Pence (Ind.)

Smith, Lamar (Texas)

Chaffetz (Utah)

Gallegly (Calif.)

Gowdy (S.C.)

King, S. (Iowa)

Quayle (Ariz.)

Forbes (Va.)

Gohmert (Texas)

Griffin (Ark.)

Marino (Pa.)

Ross, D. (Fla.)

Democrats (1)

Pierluisi (P.R.)

NOT VOTING (7)

Republicans (4)

Adams (Fla.) ?

Poe (Texas) ?

Coble (N.C.) ?

Jordan (Ohio) ?

Democrats (3)

Quigley (Ill.) ?

HR 1249

Sanchez, Linda (Calif.) ?

Wasserman Schultz (Fla.) ?

Patent Overhaul/Public Disclosure for Prior-User Rights

R. Goodlatte, R-Va. – Amendment to the Smith manager's amendment that would clarify public disclosure language related to prior-user rights.

Adopted by voice vote; April 14, 2011.

HR 1249

Patent Overhaul/Public Disclosure for First-to-File

Lofgren, D-Calif. – Amendment to the Smith manager's amendment that would revise public disclosure language related to the first-to-file provision.

Adopted by voice vote; April 14, 2011.

HR 1249

Patent Overhaul/Manager's Amendment

Lamar Smith, R-Texas – Manager's amendment that would narrow the "prior-use" defense against patent infringement claims for alleged infringers who were using an invention before it was patented. Specifically, it would limit it to "process" patents, restrict its application to the United States and alter language on a related grace period.

The amendment also would extend the timeline for "inter partes" reviews of the validity of issued patents from nine months after service of a complaint to 12 months, as well as raise the threshold for challenges to a "reasonable likelihood that the petitioner would prevail."

It would include a six-year sunset for the Patent and Trademark Office fee-setting authority.

Adopted (as amended) 29-2: R 17-1; D 12-1; I 0-0; April 14, 2011.

[Vote Key](#)

YEAS (29)

Republicans (17)

Adams (Fla.)	Chabot (Ohio)	Chaffetz (Utah)
Coble (N.C.)	Forbes (Va.)	Franks, T. (Ariz.)
Gallegly (Calif.)	Goodlatte (Va.)	Gowdy (S.C.)
King, S. (Iowa)	Lungren (Calif.)	Marino (Pa.)
Pence (Ind.)	Poe (Texas)	Quayle (Ariz.)
Ross, D. (Fla.)	Smith, Lamar (Texas)	

Democrats (12)

Berman (Calif.)	Chu (Calif.)	Cohen (Tenn.)
Deutch (Fla.)	Johnson, H. (Ga.)	Lofgren (Calif.)
Nadler (N.Y.)	Pierluisi (P.R.)	Quigley (Ill.)
Sanchez, Linda (Calif.)	Waters (Calif.)	Watt (N.C.)

NAYS (2)

Republicans (1)

Sensenbrenner (Wis.)

Democrats (1)

Conyers (Mich.)

NOT VOTING (7)

Republicans (4)

Gohmert (Texas) ?

Griffin (Ark.) ?

Issa (Calif.) ?

Jordan (Ohio) ?

Democrats (3)

Jackson Lee (Texas) ?

Scott, R. (Va.) ?

Wasserman Schultz (Fla.) ?

HR 1249

Patent Overhaul/Business Methods

Conyers, D-Mich. – Amendment that would limit the use of a transitional post-grant review process for business method patents to claims that have not already undergone review or have not been reissued as valid claims.

Withdrawn; April 14, 2011.

Note: This amendment was later rejected in an 11-24 roll-call vote.

HR 1249

Patent Overhaul/Confidential Information

R. Goodlatte, R-Va. – Amendment that would apply the business confidential information provision to inter partes and post-grant proceedings.

Adopted by voice vote; April 14, 2011.

HR 1249

Patent Overhaul/False Marking

Conyers, D-Mich. – Amendment that would revise language to ensure the bill would not apply to pending false marking cases.

Withdrawn; April 14, 2011.

HR 1249

Patent Overhaul/Term Extension

Conyers, D-Mich. – Amendment that would add language on the calculation of a 60-day period for application of patent term extension.

Adopted by voice vote; April 14, 2011.

HR 1249

Patent Overhaul/Fraud Cases

R. Goodlatte, R-Va. – Amendment that would prohibit the use of a supplemental review for corrections in cases revealed to involve fraud against the U.S. Patent and Trademark Office.

Adopted 21-9: R 13-5; D 8-4; I 0-0; April 14, 2011.

[Vote Key](#)

YEAS (21)

Republicans (13)

Adams (Fla.)

Chaffetz (Utah)

Forbes (Va.)

Franks, T. (Ariz.)

Goodlatte (Va.)

Gowdy (S.C.)

Griffin (Ark.)

Issa (Calif.)

King, S. (Iowa)

Lungren (Calif.)

Marino (Pa.)

Quayle (Ariz.)

Ross, D. (Fla.)

Democrats (8)

Berman (Calif.)

Conyers (Mich.)

Deutch (Fla.)

Lofgren (Calif.)

Nadler (N.Y.)

Scott, R. (Va.)

Waters (Calif.)

Watt (N.C.)

NAYS (9)

Republicans (5)

Chabot (Ohio)

Coble (N.C.)

Gallegly (Calif.)

Pence (Ind.)

Sensenbrenner (Wis.)

Democrats (4)

Chu (Calif.)

Jackson Lee (Texas)

Johnson, H. (Ga.)

Pierluisi (P.R.)

NOT VOTING (8)

Republicans (4)

Gohmert (Texas) ?

Jordan (Ohio) ?

Poe (Texas) ?

Smith, Lamar (Texas) P

Democrats (4)

Cohen (Tenn.) A

Quigley (Ill.) ?

Sanchez, Linda (Calif.) ?

Wasserman Schultz (Fla.) ?

HR 1249

Patent Overhaul/Required Study

Waters, D-Calif. – Amendment that would require the U.S. Patent and Trademark Office to conduct a study on the bill's implementation within four years of enactment.

Adopted by voice vote; April 14, 2011.

HR 1249

Patent Overhaul/Supplemental Review

Lofgren, D-Calif. – Amendment that would strike a provision to allow patent owners to request a supplemental review of a patent in order to make corrections.

Rejected 8-21: R 0-14; D 8-7; I 0-0; April 14, 2011.

[Vote Key](#)

YEAS (8)

Democrats (8)

Berman (Calif.)

Cohen (Tenn.)

Conyers (Mich.)

Lofgren (Calif.)

Nadler (N.Y.)

Scott, R. (Va.)

Wasserman Schultz (Fla.)

Watt (N.C.)

NAYS (21)

Republicans (14)

Adams (Fla.)	Chabot (Ohio)	Chaffetz (Utah)
Coble (N.C.)	Franks, T. (Ariz.)	Gallegly (Calif.)
Goodlatte (Va.)	Gowdy (S.C.)	Griffin (Ark.)
Issa (Calif.)	Lungren (Calif.)	Marino (Pa.)
Quayle (Ariz.)	Smith, Lamar (Texas)	

Democrats (7)

Chu (Calif.)	Deutch (Fla.)	Jackson Lee (Texas)
Johnson, H. (Ga.)	Pierluisi (P.R.)	Quigley (Ill.)
Sanchez, Linda (Calif.)		

NOT VOTING (9)

Republicans (8)

Forbes (Va.) ?	Gohmert (Texas) ?	Jordan (Ohio) ?
King, S. (Iowa) ?	Pence (Ind.) ?	Poe (Texas) ?
Ross, D. (Fla.) ?	Sensenbrenner (Wis.) ?	

Democrats (1)

Waters (Calif.) ?
HR 1249

En Bloc Amendments/Sense of Congress

S. Jackson Lee, D-Texas - En bloc amendments that would express the sense of Congress that converting to a "first to file" system will promote the progress of science and provide inventors with greater certainty, as well as harmonize the U.S. patent system with those commonly used in other countries.

Adopted by voice vote; April 14, 2011.

HR 1249

Patent Overhaul/Genetic Diagnostics

Wasserman Schultz, D-Fla. - Amendment that would provide safe harbor for certain genetic diagnostic testers in patent infringement cases.

Withdrawn; April 14, 2011.

HR 1249

Patent Overhaul/Business Methods

Conyers, D-Mich. – Amendment that would limit the use of a transitional post-grant review process for business method patents to claims that have not already undergone review or have not been reissued as valid claims.

Rejected 11-24: R 3-19; D 8-5; I 0-0; April 14, 2011.

Note: This amendment was previously offered and withdrawn.

[Vote Key](#)

YEAS (11)

Republicans (3)

Franks, T. (Ariz.)

Lungren (Calif.)

Sensenbrenner (Wis.)

Democrats (8)

Berman (Calif.)

Chu (Calif.)

Cohen (Tenn.)

Conyers (Mich.)

Jackson Lee (Texas)

Lofgren (Calif.)

Quigley (Ill.)

Sanchez, Linda (Calif.)

NAYS (24)

Republicans (19)

Adams (Fla.)

Chabot (Ohio)

Chaffetz (Utah)

Coble (N.C.)

Forbes (Va.)

Gallegly (Calif.)

Gohmert (Texas)

Goodlatte (Va.)

Gowdy (S.C.)

Griffin (Ark.)

Issa (Calif.)

Jordan (Ohio)

King, S. (Iowa)

Marino (Pa.)

Pence (Ind.)

Poe (Texas)

Quayle (Ariz.)

Ross, D. (Fla.)

Smith, Lamar (Texas)

Democrats (5)

Deutch (Fla.)

Nadler (N.Y.)

Pierluisi (P.R.)

Scott, R. (Va.)

Watt (N.C.)

NOT VOTING (3)

Democrats (3)

Johnson, H. (Ga.) ? Wasserman Schultz (Fla.) ? Waters (Calif.) ?
HR 1249

Patent Overhaul/Pro Bono Program

Chu, D-Calif. – Amendment that would direct the U.S. Patent and Trademark Office director to work toward establishing a pro bono program to help financially under-resourced independent inventors and small businesses.

Adopted by voice vote; April 14, 2011.

HR 1249

Patent Overhaul/State Court

Pierluisi, D-P.R. – Amendment that would include the District of Columbia, the Commonwealth of Puerto Rico, the U.S. Virgin Islands, American Samoa, Guam and the Northern Mariana Islands in language relating to state court jurisdiction.

Adopted by voice vote; April 14, 2011.

HR 1249

Patent Overhaul/Vote to Report

Overhaul U.S. patent law.

The bill would shift the basis for issuing patents to a "first inventor to file" standard. It would provide for a limited "prior-use" defense against patent infringement claims for alleged infringers who were using an invention before it was patented.

It would allow the U.S. Patent and Trademark Office (PTO) to set, and keep revenue from, all the fees it collects. The fee-setting authority would sunset after six years.

It would establish new rules for a so-called "inter partes" review of the validity of patents after they are granted, as well as establish a "post-grant" review to allow disputes involving patent quality and scope to be settled.

It also would authorize a special reexamination of business-method patents and would allow third parties to submit information regarding a patent application that may be relevant for the patent examiner to review.

Ordered reported favorably to the full House (as amended) 32-3: R 20-2; D 12-1; I 0-0;
April 14, 2011.

[Vote Key](#)

YEAS (32)

Republicans (20)

Adams (Fla.)	Chabot (Ohio)	Chaffetz (Utah)
Coble (N.C.)	Forbes (Va.)	Franks, T. (Ariz.)
Gallegly (Calif.)	Gohmert (Texas)	Goodlatte (Va.)
Gowdy (S.C.)	Griffin (Ark.)	Issa (Calif.)
Jordan (Ohio)	Lungren (Calif.)	Marino (Pa.)
Pence (Ind.)	Poe (Texas)	Quayle (Ariz.)
Ross, D. (Fla.)	Smith, Lamar (Texas)	

Democrats (12)

Berman (Calif.)	Chu (Calif.)	Cohen (Tenn.)
Deutch (Fla.)	Jackson Lee (Texas)	Lofgren (Calif.)
Nadler (N.Y.)	Pierluisi (P.R.)	Quigley (Ill.)
Sanchez, Linda (Calif.)	Scott, R. (Va.)	Watt (N.C.)

NAYS (3)

Republicans (2)

King, S. (Iowa)	Sensenbrenner (Wis.)
-----------------	----------------------

Democrats (1)

Conyers (Mich.)

NOT VOTING (3)

Democrats (3)

Johnson, H. (Ga.) ?	Wasserman Schultz (Fla.) ?	Waters (Calif.) ?
---------------------	----------------------------	-------------------

Committee Vote Position Key

* Proxy Vote
P Voted Present
A Abstained
? Did not vote

Paired for
X Paired against
+ Announced for
- Announced against