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Citation: 2 An Act to Amend Title 35 United States Code with
to Patents on Biotechnological Processes Pub. L.
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Calendar No. 421

102D CONGRESS
2D SESSION**S. 654****[Report No. 102-260]**

To amend title 35, United States Code, with respect to patents on certain processes.

IN THE SENATE OF THE UNITED STATES

MARCH 13 (legislative day, FEBRUARY 6), 1991

Mr. DECONCINI (for himself, Mr. HATCH, Mr. KOHL, Mr. LAUTENBERG, Mr. SPECTER, Mr. GRASSLEY, Mr. BROWN, Mr. CRANSTON, and Mr. DOMENICI) introduced the following bill; which was read twice and referred to the Committee on the Judiciary

MARCH 11 (legislative day, JANUARY 30), 1992

Reported by Mr. BIDEN, with an amendment

[Strike out all after the enacting clause and insert the part printed in italic]

A BILL

To amend title 35, United States Code, with respect to patents on certain processes.

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 “Biotechnology Patent**
5 **Protection Act of 1991”.**

1 **SEC. 2. PATENTABILITY OF CERTAIN PROCESSES.**

2 Section 103 of title 35, United States Code, is
3 amended by adding at the end the following new para-
4 graph:

5 “When a process of making or using a machine, man-
6 ufacture, or composition of matter is sought to be pat-
7 ented in the same application as such machine, manufac-
8 ture, or composition of matter, such process shall not be
9 considered as obvious under this section if such machine,
10 manufacture, or composition of matter is novel under sec-
11 tion 102 and nonobvious under this section. If the patent-
12 ability of such process depends upon such machine, manu-
13 facture, or composition of matter, then a single patent
14 shall issue on the application.”

15 **SEC. 3. EFFECTIVE DATE.**

16 The amendment made by section 2 shall apply to all
17 United States patents granted on or after the date of the
18 enactment of this Act and to all applications for United
19 States patents pending on or filed after such date of enact-
20 ment, including any application for the reissuance of a
21 patent.

22 **SECTION 1. CONDITIONS FOR PATENTABILITY; NON-OBVI-**
23 **OUS SUBJECT MATTER.**

24 Section 103 of title 35, United States Code, is
25 amended—

1 (1) *in the first unnumbered paragraph by insert-*
2 *ing “(a)” before “A patent”;*

3 (2) *in the second unnumbered paragraph by in-*
4 *serting “(b)” before “Subject matter”; and*

5 (3) *by adding at the end thereof the following*
6 *new subsection:*

7 *“(c) Notwithstanding any other provision of this sec-*
8 *tion, a claimed process of making or using a machine, man-*
9 *ufacture, or composition of matter is not obvious under this*
10 *section if—*

11 *“(1) the machine, manufacture, or composition*
12 *of matter is novel under section 102 of this title and*
13 *nonobvious under this section; and*

14 *“(2)(A) the machine, manufacture, or com-*
15 *position of matter, and the claimed process invention*
16 *at the time it was made, were owned by the same per-*
17 *son or subject to an obligation of assignment to the*
18 *same person; and*

19 *“(B) claims to the process and to the machine,*
20 *manufacture, or composition of matter, are entitled to*
21 *the same effective filing date, and appear in the same*
22 *patent or in different patents which are owned by the*
23 *same person and are set to expire on the same date.”.*

1 **SEC. 2. PRESUMPTION OF VALIDITY.**

2 *The first unnumbered paragraph of section 282 of title*
3 *35, United States Code, is amended by inserting after the*
4 *second sentence “A claim issued under the provisions of sec-*
5 *tion 103(c) of this title on a process of making or using*
6 *a machine, manufacture, or composition of matter shall not*
7 *be held invalid under section 103 of this title solely because*
8 *the machine, manufacture, or composition of matter is de-*
9 *termined to lack novelty under section 102 of this title or*
10 *to be obvious under section 103 of this title.”.*

11 **SEC. 3. EFFECTIVE DATE.**

12 *The amendments made by this Act shall apply to all*
13 *United States patents granted on or after the date of the*
14 *enactment of this Act and to all applications for United*
15 *States patents pending on or filed after such date of enact-*
16 *ment, including any application for the reissuance of a pat-*
17 *ent.*

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