

113TH CONGRESS  
1ST SESSION

# H. R. 845

To amend chapter 29 of title 35, United States Code, to provide for the recovery of patent litigation costs, and for other purposes.

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## IN THE HOUSE OF REPRESENTATIVES

FEBRUARY 27, 2013

Mr. DEFAZIO (for himself and Mr. CHAFFETZ) introduced the following bill; which was referred to the Committee on the Judiciary

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## A BILL

To amend chapter 29 of title 35, United States Code, to provide for the recovery of patent litigation costs, and for other purposes.

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 “Saving High-Tech  
5 Innovators from Egregious Legal Disputes Act of 2013”.

6 **SEC. 2. RECOVERY OF LITIGATION COSTS.**

7 (a) AMENDMENT.—Chapter 29 of title 35, United  
8 States Code, is amended by inserting after section 285 the  
9 following new section:

1 **“§ 285A. Recovery of litigation costs**

2 “(a) IN GENERAL.—In an action involving the valid-  
3 ity or infringement of a patent—

4 “(1) a party asserting invalidity or noninfringe-  
5 ment may move for judgment that the adverse party  
6 does not meet at least one of the conditions de-  
7 scribed in subsection (d);

8 “(2) not later than 90 days after a party has  
9 moved for the judgment described in paragraph (1),  
10 the adverse party shall be provided an opportunity  
11 to prove such party meets at least one of the condi-  
12 tions described in subsection (d);

13 “(3) as soon as practicable after the adverse  
14 party has been provided an opportunity to respond  
15 under paragraph (2), but not later than 120 days  
16 after a party has moved for the judgment described  
17 in paragraph (1), the court shall make a determina-  
18 tion whether the adverse party meets at least one of  
19 the conditions described in subsection (d); and

20 “(4) notwithstanding section 285, the Court  
21 shall award the recovery of full costs to any pre-  
22 vailing party asserting invalidity or noninfringement,  
23 including reasonable attorney’s fees, other than the  
24 United States, upon the entry of a final judgment if  
25 the court determines that the adverse party did not  
26 meet at least one of the conditions described in sub-

1 section (d), unless the court finds that exceptional  
2 circumstances make an award unjust.

3 “(b) BOND REQUIRED.—Any party that fails to meet  
4 a condition under subsection (a)(3) shall be required to  
5 post a bond in an amount determined by the court to cover  
6 the recovery of full costs described in subsection (a)(4).

7 “(c) TIMING AND EFFECT OF PENDING MOTION.—  
8 With respect to any motion made pursuant to subsection  
9 (a)(1) the following applies:

10 “(1) In the case of a motion that is filed before  
11 the moving party’s initial disclosure are due—

12 “(A) the court shall limit any discovery to  
13 discovery that is necessary for the disposition of  
14 the motion; and

15 “(B) the court may delay issuing any  
16 scheduling order until after ruling on the mo-  
17 tion.

18 “(2) In the case of a motion that is filed after  
19 the moving party’s initial disclosures are due the  
20 court may delay ruling on the motion until after the  
21 entry of final judgment.

22 “(3) In the case of a motion that is filed after  
23 the entry of final judgment, any such motion must  
24 be combined with a motion for fees to the prevailing  
25 party.

1       “(d) CONDITION DEFINED.—For purposes of this  
2 section, a ‘condition’ means, with respect to the party al-  
3 leging infringement, any of the following:

4           “(1) ORIGINAL INVENTOR.—Such party is the  
5 inventor, a joint inventor, or in the case of a patent  
6 filed by and awarded to an assignee of the original  
7 inventor or joint inventor, the original assignee of  
8 the patent.

9           “(2) EXPLOITATION OF THE PATENT.—Such  
10 party can provide documentation to the court of sub-  
11 stantial investment made by such party in the ex-  
12 ploitation of the patent through production or sale  
13 of an item covered by the patent.

14           “(3) UNIVERSITY OR TECHNOLOGY TRANSFER  
15 ORGANIZATION.—Such party is—

16           “(A) an institution of higher education (as  
17 that term is defined in section 101 of the High-  
18 er Education Act of 1965 (20 U.S.C. 1001); or

19           “(B) a technology transfer organization  
20 whose primary purpose is to facilitate the com-  
21 mercialization of technology developed by one or  
22 more institutions of higher education.”.

23       (b) TECHNICAL AND CONFORMING AMENDMENT.—  
24 The table of sections for chapter 29 of title 35, United

1 States Code, is amended by inserting after the item relat-  
2 ing to section 285 the following new item:

“285A. Recovery of litigation costs for patent.”.

3 (c) **EFFECTIVE DATE.**—The amendment made by  
4 subsection (a) shall take effect on the date of the enact-  
5 ment of this Act and shall apply to any action involving  
6 the validity or infringement of a patent for which a com-  
7 plaint is filed on or after the date of the enactment of  
8 this Act.

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