

108<sup>TH</sup> CONGRESS  
2<sup>D</sup> SESSION

# H. R. 2391

---

IN THE SENATE OF THE UNITED STATES

MARCH 11, 2004

Received; read twice and referred to the Committee on the Judiciary

---

## AN ACT

To amend title 35, United States Code, to promote cooperative research involving universities, the public sector, and private enterprises.

1        *Be it enacted by the Senate and House of Representa-*  
2        *tives of the United States of America in Congress assembled,*

1 **SECTION 1. SHORT TITLE.**

2 This Act may be cited as the “Cooperative Research  
3 and Technology Enhancement (CREATE) Act of 2004”.

4 **SEC. 2. COLLABORATIVE EFFORTS ON CLAIMED INVEN-**  
5 **TIONS.**

6 Section 103(e) of title 35, United States Code, is  
7 amended to read as follows:

8 “(c)(1) Subject matter developed by another person,  
9 which qualifies as prior art only under one or more of sub-  
10 sections (e), (f), and (g) of section 102 of this title, shall  
11 not preclude patentability under this section where the  
12 subject matter and the claimed invention were, at the time  
13 the claimed invention was made, owned by the same per-  
14 son or subject to an obligation of assignment to the same  
15 person.

16 “(2) For purposes of this subsection, subject matter  
17 developed by another person and a claimed invention shall  
18 be deemed to have been owned by the same person or sub-  
19 ject to an obligation of assignment to the same person if—

20 “(A) the claimed invention was made by or on  
21 behalf of parties to a joint research agreement that  
22 was in effect on or before the date the claimed in-  
23 vention was made;

24 “(B) the claimed invention was made as a re-  
25 sult of activities undertaken within the scope of the  
26 joint research agreement; and

1           “(C) the application for patent for the claimed  
2           invention discloses or is amended to disclose the  
3           names of the parties to the joint research agree-  
4           ment.

5           “(3) For purposes of paragraph (2), the term ‘joint  
6           research agreement’ means a written contract, grant, or  
7           cooperative agreement entered into by two or more per-  
8           sons or entities for the performance of experimental, devel-  
9           opmental, or research work in the field of the claimed in-  
10          vention.”.

11       **SEC. 3. EFFECTIVE DATE.**

12           (a) IN GENERAL.—The amendments made by this  
13           Act shall apply to any patent granted on or after the date  
14           of the enactment of this Act.

15           (b) SPECIAL RULE.—The amendments made by this  
16           Act shall not affect any final decision of a court or the  
17           United States Patent and Trademark Office rendered be-  
18           fore the date of the enactment of this Act, and shall not  
19           affect the right of any party in any action pending before  
20           the United States Patent and Trademark Office or a court  
21           on the date of the enactment of this Act to have that par-  
22           ty’s rights determined on the basis of the provisions of

1 title 35, United States Code, in effect on the day before  
2 the date of the enactment of this Act.

Passed the House of Representatives March 10,  
2004.

Attest:

JEFF TRANDAHL,

*Clerk.*