

**AMENDMENT TO H.R. 1908, AS REPORTED
OFFERED BY MR. WAXMAN OF CALIFORNIA**

Page 63, strike line 19 and all that follows through
line 15 on page 65 and insert the following:

1 “(1) DEFENSE.—One or more claims of a pat-
2 ent may be held to be unenforceable, or other rem-
3 edy imposed under paragraph (4), for inequitable
4 conduct only if it is established, by clear and con-
5 vincing evidence that a person with a duty of disclo-
6 sure to the Office, with the intent to mislead or de-
7 ceive the patent examiner, misrepresented or failed
8 to disclose material information to the examiner dur-
9 ing examination of the patent.

10 “(2) MATERIALITY.—

11 “(A) IN GENERAL.—Information is mate-
12 rial under this section if—

13 “(i) a reasonable examiner would have
14 made a prima facie finding of
15 unpatentability, or maintained a finding of
16 unpatentability, of one or more of the pat-
17 ent claims based on the information; and

1 “(ii) the information is not cumulative
2 to information already of record or pre-
3 viously considered by the Office.

4 “(B) PRIMA FACIE FINDING.—A court
5 shall make a prima facie finding of
6 unpatentability under this section if a reason-
7 able examiner, based on a preponderance of the
8 evidence, would—

9 “(i) conclude that the claim is
10 unpatentable based on the information
11 misrepresented or not disclosed, when that
12 information is considered alone or in con-
13 junction with other information of record;
14 or

15 “(ii) the material information refutes
16 or is inconsistent with a position the appli-
17 cant takes in opposing a rejection of the
18 claim or in asserting an argument of pat-
19 entability.

20 In determining whether there is a prima facie
21 finding of unpatentability, each term in the
22 claim shall be given its broadest reasonable con-
23 struction consistent with the specification, and
24 rebuttal evidence shall not be considered.

1 “(3) INTENT.—To prove a person with a duty
2 of disclosure to the Office intended to mislead or de-
3 ceive the examiner under paragraph (1), specific
4 facts beyond materiality of the information misrepre-
5 sented or not disclosed must be proven that establish
6 the intent of the person to mislead or deceive the ex-
7 aminer by the actions of the person. Facts support
8 an intent to mislead or deceive if they show cir-
9 cumstances that indicate conscious or deliberate be-
10 havior on the part of the person to not disclose ma-
11 terial information or to submit false material infor-
12 mation in order to mislead or deceive the examiner.
13 Circumstantial evidence may be used to prove a per-
14 son had the intent to mislead or deceive the exam-
15 iner under paragraph (1).

16 “(4) REMEDY.—Upon a finding of inequitable
17 conduct, the court shall balance the equities to de-
18 termine which of the following remedies to impose:

19 “(A) Denying equitable relief to the patent
20 holder and limiting the remedy for infringement
21 to reasonable royalties.

22 “(B) Holding the claims-in-suit, or the
23 claims in which inequitable conduct occurred,
24 unenforceable.

25 “(C) Holding the patent unenforceable.

1 “(D) Holding the claims of a related pat-
2 ent unenforceable.

3 “(5) ATTORNEY MISCONDUCT.—Upon a finding
4 of inequitable conduct, if there is evidence that the
5 conduct is attributable to a person or persons au-
6 thorized to practice before the Office, the court shall
7 refer the matter to the Office for appropriate dis-
8 ciplinary action under section 32, and shall order the
9 parties to preserve and make available to the Office
10 any materials that may be relevant to the determina-
11 tion under section 32.”.