

GENERAL LEAVE

Mr. SENSENBRENNER. Mr. Speaker, I ask unanimous consent that all Members may have 5 legislative days within which to revise and extend their remarks and include extraneous material on H.R. 2655.

The SPEAKER pro tempore. Is there objection to the request of the gentleman from Wisconsin?

There was no objection.

COOPERATIVE RESEARCH AND
TECHNOLOGY ENHANCEMENT
(CREATE) ACT OF 2004

Mr. SENSENBRENNER. Mr. Speaker, I ask unanimous consent to take from the Speaker's table the Senate bill (S. 2192) to amend title 35, United States Code, to promote cooperative research involving universities, the public sector, and private enterprises, and ask for its immediate consideration in the House.

The Clerk read the title of the Senate bill.

The SPEAKER pro tempore. Is there objection to the request of the gentleman from Wisconsin?

There was no objection.

The Clerk read the Senate bill, as follows:

S. 2192

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,

SECTION 1. SHORT TITLE.

This Act may be cited as the "Cooperative Research and Technology Enhancement (CREATE) Act of 2004".

SEC. 2. COLLABORATIVE EFFORTS ON CLAIMED INVENTIONS.

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

"(c)(1) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

"(2) For purposes of this subsection, subject matter developed by another person and a claimed invention shall be deemed to have been owned by the same person or subject to an obligation of assignment to the same person if—

"(A) the claimed invention was made by or on behalf of parties to a joint research agreement that was in effect on or before the date the claimed invention was made;

"(B) the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement; and

"(C) the application for patent for the claimed invention discloses or is amended to disclose the names of the parties to the joint research agreement.

"(3) For purposes of paragraph (2), the term 'joint research agreement' means a written contract, grant, or cooperative agreement entered into by two or more persons or entities for the performance of experimental, developmental, or research work in the field of the claimed invention."

SEC. 3. EFFECTIVE DATE.

(a) IN GENERAL.—The amendments made by this Act shall apply to any patent granted on

or after the date of the enactment of this Act.

(b) SPECIAL RULE.—The amendments made by this Act shall not affect any final decision of a court or the United States Patent and Trademark Office rendered before the date of the enactment of this Act, and shall not affect the right of any party in any action pending before the United States Patent and Trademark Office or a court on the date of the enactment of this Act to have that party's rights determined on the basis of the provisions of title 35, United States Code, in effect on the day before the date of the enactment of this Act.

Mr. SENSENBRENNER. Mr. Speaker, S. 2192 will help to spur the development of new technologies by making it easier for collaborative inventors who represent more than one organization to obtain the protection of the U.S. patent system for their inventions.

Members should note that the text of S. 2192 is identical to that of H.R. 2391, which received approximately 2 years of process. The House passed H.R. 2391 by voice vote on March 10 of this year.

The bill achieves this goal by limiting the circumstances in which confidential information, which is voluntarily exchanged by individual research team members, may be asserted to bar the patenting of the team's new inventions.

Today, industries that rely on intellectual property, like pharmaceuticals, biotechnology, and nano-technology serve as key catalysts to the U.S. economy, employing tens of thousands of Americans. More often than not, the innovations they develop are not done solely by researchers "in-house" but rather, in concert with other researchers who may be located at universities, non-profit institutions, or other private enterprises.

Carl E. Gulbrandsen, the managing director of the Wisconsin Alumni Research Foundation, provided an assessment of the value of university research contributions when he testified before the Intellectual Property Subcommittee last Congress that:

In 2000, non-profits and universities spent a record \$28.1 billion on research and development much of which involved collaborations among private, public, and non-profit entities.

Sales of products developed from inventions transferred from these research centers resulted in revenues that approached \$42 billion that year, a portion of which was then reinvested in additional research.

As significant as this research activity is, the tangible benefits of its application are also worth noting. Innovations like magnetic resonance imaging and the sequencing of the human genome through a process known as automated polymerase chain reaction technology were both made possible through collaborative research.

Mr. Speaker, in 1984, Congress acted to provide incentives for innovation by encouraging researchers within organizations to share information. That year, we amended the Patent Act to restrict the use of background scientific or technical information shared among researchers in an effort to deny a patent in instances where the subject matter and the claimed invention were under common ownership or control.

S. 2192 will provide a similar statutory "safe harbor" for inventions that result from the collaborative activities of private, public, and non-profit entities. In so doing, the bill responds to

the 1997 OddzON Products, Inc. V. Just Toys, Inc. decision of the Federal Circuit Court of Appeals by clarifying that prior inventions of team members will not serve as an absolute bar to the patenting of the team's new invention when the parties conduct themselves in accordance with the terms of the bill.

In the future, research collaborations between academia and industry will be even more critical to the efforts of U.S. industry to maintain our technological preeminence. By enacting S. 2192, Congress will help to foster improved communication among researchers, provide additional certainty and structure for those who engage in collaborative research, reduce patent litigation incentives, and facilitate innovation and investment.

S. 2192 is the product of the collaborative efforts of a number of individuals and leading professional patent and research organizations. Among those who contributed substantially to the development of the bill are the USPTO, the Wisconsin Alumni Research Foundation, the American Council on Education, the American University Technology Managers, the Biotechnology Industry Organization, and the American Intellectual Property Law Association.

Mr. Speaker, S. 2192 will ensure that tomorrow's collaborative researchers can enjoy the full measure of the benefits of the patent law. I urge the Members to support the bill.

The Senate bill was ordered to be read a third time, was read the third time, and passed, and a motion to reconsider was laid on the table.

GENERAL LEAVE

Mr. SENSENBRENNER. Mr. Speaker, I ask unanimous consent that all Members may have 5 legislative days within which to revise and extend their remarks and include extraneous material on S. 2192.

The SPEAKER pro tempore. Is there objection to the request of the gentleman from Wisconsin?

There was no objection.

ENSURING NEEDED HELP ARRIVES
NEAR CALLERS EMPLOYING 911
ACT OF 2004

Mr. PICKERING. Mr. Speaker, I ask unanimous consent that the Committee on Energy and Commerce be discharged from further consideration of the bill (H.R. 5419) to amend the National Telecommunications and Information Administration Organization Act to facilitate the reallocation of spectrum from governmental to commercial users; to improve, enhance, and promote the Nation's homeland security, public safety, and citizen activated emergency response capabilities through the use of enhanced 911 services, to further upgrade Public Safety Answering Point capabilities and related functions in receiving E-911 calls, and to support in the construction and operation of a ubiquitous and reliable citizen activated system; and to provide that funds received as universal service contributions under section 254 of the Communications Act of 1934 and the universal service support programs