

*M. Friedman*84TH CONGRESS
1ST SESSION**S. 116**

IN THE SENATE OF THE UNITED STATES

JANUARY 6, 1955

Mr. DIRKSEN introduced the following bill; which was read twice and referred to the Committee on the Judiciary

A BILL

To authorize the extension of patents covering inventions whose practice was prevented or curtailed during certain emergency periods by service of the patent owner in the Armed Forces or by production controls.

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

3 That (a) if at any time during any of the periods specified
4 in subsection (d) of this section—

5 (1) the term of any patent of the United States
6 including time during which any individual or individ-
7 uals, owning solely or jointly with his spouse or their
8 spouses the entire interest in such patent, was or were
9 performing honorable service on active duty in the

1 Army, Navy Air Force, Marine Corps, or Coast Guard,
2 which service prevented or substantially curtailed the
3 normal use, exploitation, promotion, or development of
4 the patent; or

5 (2) the normal use, exploitation, promotion, or de-
6 velopment of the inventions described and claimed in
7 any patent of the United States was prevented or sub-
8 stantially curtailed by any order of an agency of the
9 Government prohibiting or limiting the production or
10 use of any class of machines, articles, or materials, or the
11 use of any class of processes or formulas; or

12 (3) to further the interests of the United States of
13 America, the owner of such patent has heretofore granted
14 a license thereunder to the United States, or to manu-
15 facturers, producers, or contractors authorizing them to
16 produce or furnish goods or services for or to the United
17 States, without payment of royalty, or at a nominal
18 royalty, such license having been granted by such owner
19 to promote any war effort, or any program of rearma-
20 ment or preparation for the national defense, in which
21 the United States has been engaged since the invasion
22 of Poland by Germany on September 1, 1939; and
23 since September 1, 1939, under the authority of such
24 license, the United States, or manufacturers, producers,
25 or contractors furnishing goods or services to the United

1 States, have made substantial use of the invention em-
2 bodied in such patent in the production or furnishing of
3 goods or services for or to the United States, such use
4 of said invention having been of material assistance and
5 benefit to the United States in connection with any war
6 effort, or any program of rearmament or preparation
7 for the national defense, which granting of a license
8 prevented or substantially curtailed the normal use, ex-
9 ploitation, promotion, or development of the patent;
10 then the term of such patent may be extended in accordance
11 with the provisions of this Act.

12 (b) The period of extension of a patent under this Act
13 shall be a further term from the expiration of the original
14 term as follows:

15 (1) In cases where the only grounds for extension
16 are those described in subsection (a) (1) of this sec-
17 tion, the further term shall equal twice the length of
18 the active service during the applicable period or periods
19 specified in subsection (d).

20 (2) In cases where the only grounds for extension
21 are those described in subsection (a) (2) the further
22 term shall equal the time for which (during the appli-
23 cable period or periods specified in subsection (d)) the
24 practice of the inventions described and claimed in the

1 patent was prevented or substantially curtailed as set
2 forth in subsection (a).

3 (3) In cases where the only grounds for extension
4 are those described in subsection (a) (3), the further
5 term shall equal the period during which the initial li-
6 cense granted by the owner of such patent, without pay-
7 ment of royalty, or at a nominal royalty, was in effect
8 after September 1, 1939: *Provided, however,* That in
9 no event shall the period of extension hereunder be
10 greater than the period during which the normal use,
11 exploitation, or development of the patent was prevented
12 or substantially curtailed.

13 (4) In cases where grounds for extension exist
14 under more than one paragraph of subsection (a), the
15 further terms designated in this subsection (b) shall not
16 be cumulative but shall be determined under the appli-
17 cable paragraph of this subsection (b) which results in
18 the longest extension.

19 (c) If the ownership of the patent at the time the cir-
20 cumstances, described in subsection (a), which qualify the
21 patent for extension, first arose, is different from the owner-
22 ship at the time of the filing of the application for extension
23 under this Act, such application shall be acted upon only if
24 the owner or owners at the time such circumstances first

1 arose (or their legal representatives) have joined in such
2 application.

3 (d) The periods during which one or more of the cir-
4 cumstances described in subsection (a) (1) or subsection
5 (a) (2) must have occurred in order to qualify a patent for
6 extension under this Act are as follows:

7 (1) The period beginning December 7, 1941, and
8 ending September 2, 1945.

9 (2) The period beginning June 26, 1950, and end-
10 ing July 26, 1953.

11 (e) For the purposes of this section, a reissue patent
12 shall be considered to be the same patent as that which it
13 supersedes.

14 SEC. 2. On the filing of an application for extension of
15 the term of a patent hereunder, together with such informa-
16 tion as may be required by the Commissioner, and upon
17 payment of such initial fees as the Commissioner may from
18 time to time prescribe, the Commissioner shall publish a
19 notice thereof in the Official Gazette of the Patent Office.
20 Within sixty days from such publication any person may
21 oppose an application for extension by filing with the Com-
22 missioner a notice of opposition thereto stating the grounds
23 therefor, which shall not include any charge that the patent

1 is invalid. If a proper notice of opposition is filed and pay-
2 ment is made by the opponent of such initial fees as the Com-
3 missioner may from time to time prescribe, the Commissioner
4 shall set a day for hearing which shall be within forty-five
5 days of the date of the filing of such notice of opposition, and
6 shall give not less than thirty days' notice of such hearing to
7 the parties in interest. Upon the hearing the parties in
8 interest shall present such evidence as they believe is relevant
9 and such other pertinent evidence as may be required by the
10 Commissioner. If, from all the evidence presented before
11 him, the Commissioner is satisfied that a patent should be
12 extended in accordance with this Act, he shall grant such
13 extension. The Commissioner shall take action granting or
14 denying an extension within six months after the filing of an
15 application for extension. The Commissioner shall fix the
16 total fees (not exceeding \$150) to be paid by each applicant
17 for extension of the term of a patent hereunder and the total
18 fees (not exceeding \$50) to be paid by each opponent to an
19 application, the specific amount of all such fees to be deter-
20 mined according to the work of the Patent Office required in
21 processing the application or in hearing an opponent thereto,
22 as the case may be, and the estimated cost thereof to the
23 Patent Office.

24 SEC. 3. If any applicant for an extension is dissatisfied
25 with the decision of the Commissioner or of any board

1 established by the Commissioner for the determination of
2 applications for extensions, he shall have the same remedy
3 by appeal to the United States Court of Customs and Patent
4 Appeals, or suit in the District Court for the District of
5 Columbia, as provided, in the case of applications for patent.

6 SEC. 4. The Commissioner shall issue a certificate evi-
7 dencing the granting of an extension hereunder. A notice of
8 the granting of an extension shall appear in the Official
9 Gazette of the Patent Office.

10 SEC. 5. Upon the issuance of the certificate of extension,
11 said patent shall have the same force and effect in law as
12 though it had been originally granted for seventeen years
13 plus the term of such extension, except as otherwise provided
14 herein.

15 SEC. 6. Except where the owner of a patent extended
16 hereunder was entitled to royalties under said patent
17 (whether or not such royalties were received or waived) for
18 any class of machines, articles or materials, or for the use
19 of any class of processes or formulas, produced or furnished
20 exclusively to or for the benefit of the United States, or used
21 exclusively by or for the benefit of the United States, no
22 patent extended under the provisions of this Act shall serve
23 as a basis for any claim by reason of manufacture, use, or
24 sale by or for the United States during the period of exten-

1 sion, and the rights of the United States shall remain in all
2 respects as if such patent had not been extended.

3 SEC. 7. In the event that an extension is not issued until
4 after the date of expiration of the original term of a patent
5 or reissue thereof, the extension order shall provide that any
6 vested rights arising out of the actual manufacture, use, or
7 sale of the invention covered by the patent so extended,
8 which took place after the said expiration and before the
9 issuance of the extension order may continue during the
10 remainder, if any, of the period of the extension upon such
11 terms and conditions as the Commissioner may prescribe,
12 including the payment of reasonable royalties, providing the
13 person or persons claiming such vested rights establish such
14 rights to the satisfaction of the Commissioner upon a
15 hearing.

16 SEC. 8. In any action for infringement after the expira-
17 tion of seventeen years from the grant of the patent and
18 during the period of such extension, the defendant may
19 plead and prove that any material statement of the applica-
20 tion for extension required by this Act is not true in fact;
21 and if any one or more of such statements shall be found un-
22 true in fact, judgment shall be rendered for the defendant,
23 with costs.

24 SEC. 9. Any application for the extension of the term
25 of a patent hereunder shall be filed within one year from the

1 effective date of this Act except for applications which are
2 filed under subsection (a) (1) of section 1, which applica-
3 tions shall be filed within one year from the effective date of
4 this Act or within one year from the date of the applicant's
5 honorable discharge from service.