One Hundred Eighth Congress

of the

United States of America

AT THE SECOND SESSION

Begun and held at the City of Washington on Tuesday,
the twentieth day of January, two thousand and four

An Act

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

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.

Speaker of the House of Representatives.

Vice President of the United States and

President of the Senate.