

## RATNERPRESTIA UPDATE

### NEWLY PROPOSED PATENT REFORM LEGISLATION

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Economic turmoil aside, Congress seems poised to attempt a major revision of U.S. patent law again in the new Congress. Similar bills introduced concurrently in the House and Senate on March 3, bear striking resemblance to those which were considered in the last Congress, but on which agreement between the House and Senate was never reached. *[More...](#)*

The bills would convert the U.S. patent system from one in which invention priority is based on first-to-invent, to one in which priority is based on first-inventor-to-file, the latter being the rule in most of the world. The U.S. system would retain a one year grace period for disclosures by, or derived from, the inventor. *[More...](#)*

A proportional damages provision, one of the major stumbling blocks last year, remains in the new bill without modification, at least in comparing the bill approved by the Senate Judiciary Committee in the last Congress and that proposed in this Congress. *[More...](#)*

As seen in the Senate version of the proposed legislation, willful patent infringement could not be proven in the absence of express prior notification, actual copying or prior adjudication and could not even be pleaded until liability had been proven. *[More...](#)*

Modified reexamination and a new post grant review proceeding, controversial provisions in prior efforts at patent reform, are also part of the new bills, but post grant review, which may include 35 U.S.C. § 112 issues, must be requested within 12 months of patent issuance, i.e. there is no "second window" for post grant review. The bases for reexamination would be expanded to include public use and on sale allegations. *[More...](#)*

Other notable provisions of the bills include assignor filing, limitation on venue for patent infringement litigation and interlocutory consideration of patent claim interpretation by the Federal Circuit.

As presently proposed and unlike patent reform proposed in the last Congress, the newly proposed legislation would not require applicants to provide a prior art search report or an affirmative statement regarding prior art and patentability ("Applicant Quality Submissions"). Nor does it deal with inequitable conduct in any way, although in introducing the bill in the Senate, its sponsor, Senator Patrick Leahy, indicated provisions in these areas will likely be added as the bill is considered.