

S. 515 Retains and Strengthens the “Grace Period” of American Law

A letter has recently been circulating that alleges that pending patent reform legislation, S. 515, effectively eliminates the American one year “grace period.” To the contrary, S. 515 would enhance our “grace period” and make it more secure than under existing U.S. patent law.

The “grace period” to which the letter refers is an element of US law under which an inventor who publicly discloses his or her invention has a one year period in which to file a patent application before that disclosure becomes a bar to obtaining a patent, hence the term “grace period” – the disclosure is “graced” for one year.

S. 515 not only preserves the “grace period,” it actually enhances it. Today, an inventor who relies on the “grace period” could find that his or her early public disclosure is the subject of a patent application filed by another after the disclosure. Under the existing law, the person who is the first to file a patent application is presumed to be the “first to invent,” a presumption that is very difficult to overcome in a legal proceeding (referred to as an “interference”) to determine which of the two competing patent applicants was actually first to invent. These proceedings can last for years and require the investment of millions of dollars in patent attorney fees. In fact, studies have shown that independent inventors lose rights to patents under the existing first-to-invent system of priority that they would have won in a first-inventor-to-file system of priority. S.515 cuts off the right to file or maintain a patent application on subject matter first disclosed by another before the filing of an application.

S. 515 does not change any of the imperatives that already exist under current U.S. patent law for inventors to promptly seek patents once an invention has been made. Today, except in the rarest of situations, only inventors who are the first to file ever obtain a U.S. patent. Moreover, every day that a patent filing is delayed under current law creates another day’s worth of new prior art that can serve to bar a patent for lack of novelty or obviousness. S. 515, thus, does not add to the existing “pressure” for filings. Instead, it provides inventors a more secure “grace period” by cutting off patent filings by another following an inventor’s “grace period” disclosure.

S. 515 strengthens the U.S “grace period” by protecting an inventor who publicly discloses his or her invention before seeking a patent by precluding another from using that public disclosure to file for a patent on that invention or on some obvious variation of that invention. The other person, even if the first to file for a patent, will have its patent denied and its earlier filing will be disregarded on the basis of the information disclosed by the publishing inventor.

S. 515 will strengthen and improve US patent law and is deserving of your strong support.