



A SECTION WHITE PAPER: AGENDA FOR 21ST CENTURY PATENT REFORM

Adopt the First-Inventor-to File Principle
Define Prior Art Through “Best Practices”
Repeal the “Best Mode” Requirement
Encourage Meaningful Disclosure to the PTO by
Reforming Inequitable Conduct
Eliminate Intent-Based Determinations
Publish Applications at 18-Months
Improve Inter Partes Reexamination
Create a Patent Opposition Proceeding
Use Improved Reexamination as a “Second Window”
Expand Pre-Grant Prior Art Submissions
Simplify the Willful Infringement Issue
Reduce The Claim Construction Reversal Rate
Expand Rights for Prior Users
Permit Filing by the Assignee of the Inventor

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**THE VIEWS EXPRESSED HEREIN ARE ON BEHALF OF THE AMERICAN BAR ASSOCIATION
SECTION OF INTELLECTUAL PROPERTY LAW. EXCEPT AS EXPRESSLY NOTED,
THEY HAVE NOT BEEN APPROVED BY
THE HOUSE OF DELEGATES OR THE BOARD OF GOVERNORS OF
THE AMERICAN BAR ASSOCIATION AND SHOULD NOT BE CONSTRUED
AS REPRESENTING THE POLICY OF THE AMERICAN BAR ASSOCIATION.**

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A RENEWED CALL TO ACTION ON PATENT LAW REFORMS

In 2003, the Federal Trade Commission issued a report, “To Promote Innovation: The Proper Balance of Competition and Patent Law and Policy.” That report made a number of recommendations for changes to the U.S. patent laws. In its 2004 report on the U.S. patent system, “A Patent System for the 21st Century,” the National Research Council of the National Academies also called for major changes to U.S. patent law. The ABA IPL Section’s responses to these reports supported the major recommendations of the National Academies, and many of the recommendations of the Federal Trade Commission, for legislative changes to the patent law. This “white paper” is intended as a follow-up to the Section’s response and it provides the Section’s views on patent law reform issues in a more comprehensive and complete manner.

In April 2005, Chairman Smith of the Subcommittee on Courts, the Internet, and Intellectual Property of the House Judiciary Committee tabled a “committee print” containing a set of proposals for patent law reform. The Section testified on aspects of these proposals at a subcommittee hearing held on April 20, 2005. In addition, we have had discussions with representatives of the American Intellectual Property Law Association, the Intellectual Property Owners Association, the Business Software Alliance, and the Biotechnology Industry Association, and others, each of which has shared with us ideas and proposals that they had respectively developed for patent law reform. These discussions were to a large extent reflected in bills introduced, in 2005 and 2006, and more recently in a bicameral bill titled “Patent Reform Act of 2007” (H.R. 1908/S. 1145) introduced in both houses of Congress in April 2007.

As a result of these efforts and our own work on these issues, the ABA IPL Section supports the following recommendations for a patent reform legislative agenda for the 109th Congress. We believe these proposals can form the basis for a broad consensus on moving forward with major reforms to the U.S. patent laws:

1. Adopt the first-inventor-to-file principle as part of U.S. patent law. Do so by maintaining the traditional inventor-focused features of U.S. patent law. These include the inventor’s 1-year “grace period” and protections against so-called “self-collision.” A consensus now exists among U.S.-based NGOs on this once controversial issue. Moreover, it appears a compelling starting point from which to construct a coordinated set of patent reform proposals. It will result in increased productivity in the examination of applications for patent, which is urgently needed as pendency of applications for patent continues to rise given the constrained resources of the United States Patent and Trademark Office (“PTO”). It will facilitate opening a limited term post-grant window during which patent oppositions may be filed and help assure that a post-grant opposition can address all issues of patent validity. It also will reduce the costs of *and increase the number of patents awarded to independent inventors*. The most recent data available suggests they are experiencing an accelerating loss in patents as a result of treaty-mandated changes to U.S. patent law made in 1994. Thus, this change

will serve the patent system and its various constituencies well. It also will further efforts aimed at greater international patent harmonization.

2. Enact the consensus “best practices” for implementing a first-inventor-to-file system. These “best practices” – developed in the patent harmonization context – include eliminating certain “loss of right” conditions for patentability that will be rendered unnecessary. In this regard we refer to the 2001 statements of U.S.-based NGOs (National Association of Manufacturers, Biotechnology Industry Association, Intellectual Property Owners Association, and the American Intellectual Property Law Association) developed in the context of “best practices” for international patent harmonization. The ABA IPL Section endorses these same “best practices” in the context of a first-to-file system. Their enactment into domestic law should clarify through unmistakable statutory language and clear legislative history that all publicly accessible knowledge of an invention, whether express or inherent, would remain prior art and would continue to include use, sale, offers for sale or other disclosures resulting in public accessibility.
3. Repeal the “best mode” requirement, relying instead on the requirements for a complete written description and sufficient enabling details to permit the full scope of the claimed invention to be readily carried out. This represents a part of the aforementioned “best practices” on which a domestic consensus was developed in 2001 among a number of U.S.-based NGOs and which the ABA IPL Section has adopted as policy in the context of a first-inventor-to file system.
4. Encourage meaningful disclosure to the PTO by limiting spurious claims of inequitable conduct. The PTO’s tasks of thoroughly examining applications has become increasingly difficult. Under current law, the standard for what might constitute inequitable conduct is vague and indefinite in its application. Applicants disclose too much prior art for the PTO to meaningfully consider, and do not explain its significance, all out of fear that to do otherwise risks a claim of inequitable conduct. The Section supports limiting the application of the defense to cases where a fraud resulted in the PTO issuing one or more invalidated claims. That clearer standard will enable applicants to focus their disclosure of prior art and make that disclosure more helpful to the PTO.
5. Eliminate as unnecessary all the “deceptive intent” provisions in the patent laws relating to inventorship changes, foreign filing licenses reissue applications, and enforcement of partially valid patents which merit repeal in light of the complete codification of inequitable conduct issues. These changes further the recommendation of the National Research Council of the National Academies on elimination of “subjective elements” that can be part of patent litigation.
6. Publish all applications for patent at 18-months following the earliest filing or priority date for which an applicant seeks the benefit. The adoption of a first-inventor-to-file rule removes the last objection to the mandatory publication of

pending applications because a third party with access to the published application will no longer be able to “swear behind” the date of the application in order to seek a patent for the same or similar (obvious) subject matter. Indeed, as of the publication date, it cuts off the ability for any third party to seek a patent for the same or any obvious subject matter relative to any subject matter disclosed in the published application. Equally importantly, once all pending applications are routinely published at the 18-month date, it provides complete assurance and certainty to all inventors as to all potential prior art that might exist based upon any earlier filed applications for patent. Thus, because all earlier-filed applications will already have published by the time an inventor’s application reaches the 18-month publication date, the universal publication rule means that at the publication date no possibility will exist that any later-emerging prior art will prevent the patenting of a claimed invention.

7. Open a limited window for post-grant opposition of an issued patent. The Section supports balanced legislation to provide for post-grant review. Among the principle virtues of such legislation—particularly if coupled with first-inventor-to-file and best practices reforms – is that all invalid patents can be corrected in the proceeding. Key features of the Section’s position are a single limited window for seeking an opposition and the “preponderance of the evidence” standard to be used in the opposition. These two features of the system are needed to best serve the public interest that information about a possible issuance of an invalid patent be brought forth early and be corrected by canceling the patent in whole or in part at the earliest possible time. Moreover, it is fully consistent with the position that the burden of persuasion in the courts on the issue of patent validity should *not* be changed from the “clear and convincing” evidence standard – both because this higher standard that will apply in later litigation will serve as an incentive to use the post-grant opposition mechanism and because this higher judicial standard will further assure that inventors can enjoy “quiet title” to their inventions once the patent opposition period has concluded. Finally, a critical element of the proposal for opening a window for post-grant opposition is addressing the inequitable conduct issues that are created, both for the patent owner and for the opposer. In this regard, the Section supports proposals for addressing these issues by providing that *all* parties to an opposition are bound by the duty and all parties are subject to sanctions effective to deter misconduct.
8. Authorize pre-grant submissions of prior art by third parties. Under the proposed system of post-grant opposition, inventors have a particular incentive to obtain completely valid patents based upon the fullest possible consideration of prior art and other published information that could bear on the validity of a claim. Where pre-issuance examination is complete, the issued patent can avoid institution of a post-grant opposition. Where prior art has already been reviewed by the patent examiner – especially where the relevance has been fully investigated by the patent examiner – an opposer is unlikely to trigger the required threshold for instituting an opposition. By permitting third parties to make pre-grant

submissions of prior art (together with a concise description of the relevance of the prior art), inventors will be best able to avoid first confronting such prior art during an opposition when the time permitted for responding to the issues raised and the ability to amend claims will be more limited. In many situations, the post-grant opposition will be avoided altogether. The Section does not support removal of the prohibition on pre-grant oppositions or any proposal that would allow third-party submissions to interfere with ongoing patent examination.

9. Improve *inter partes* reexamination by removing the retroactivity restrictions and the estoppel provision as it applies to issues that “could have been raised.” Improved reexamination, will in effect, provide a “second window” for challenging invalid patents after the post-grant opposition window closes. The experience with *inter partes* reexamination has not confirmed the need to limit this proceeding only to patents first sought after 1999, but has confirmed that the estoppel provision has greatly diminished the effectiveness of the proceeding. Thus, the experience over the past 5 years strongly supports these remedial actions to make *inter partes* reexamination an effective mechanism for challenging invalid patents.
10. Limit the ability to obtain enhanced damages for willful infringement of a patent to cases that meet an appropriate standard for improper conduct. The Section has worked with several organizations to best define the precise reforms that would preserve the right for multiplied damages in appropriate cases, but remove the specter of such damages being routinely used by patent owners to chill the willingness of accused infringers to challenge patents of questionable validity or where the allegations of infringement are questionable. The Section supports determination of willful infringement only after a patent has been found to have been infringed, enforceable and not invalid. In order to prove willful infringement, a patentee should be required to point to evidence of reprehensible conduct, such as intentional copying of an invention known to be patented or failure to exercise due care after receiving a notice threatening suit for infringement that set out with particularity the manner in which each infringed claim related to the infringer’s activities.
11. Enact a balanced rule on apportionment of reasonable royalty damages to assure that the royalty does not exceed the value properly attributable to the use made of the invention.
12. Reduce the reversal rate of claim construction decisions by requiring appellate court deference to fact findings made by the trial court as predicates to its claim construction. The current case law in the Federal Circuit allows *de novo* review of claim construction decisions with no deference at all to the trial court decision. This has resulted in a very high reversal rate, which has frustrated trial courts and often has required a second trial after appeal. Raising the standard of review would decrease the reversal rate and further the goal of speedy and final resolution of patent cases.

13. Expand the rights of prior inventors as part of the move to a first-inventor-to-file system. Failing to make tandem changes to the “first inventor” defense can only encourage “off-shoring” of manufacturing. In this regard, the Section supports a limited expansion of so-called “first inventor rights” provisions put into the U.S. patent law in 1999, as part of the American Inventors Protection Act (35 U.S.C. § 273). These prior inventor rights protect an inventor against charges of patent infringement where the inventor has made commercial use of the invention before the patent was sought, but make this protection unavailable if the inventor cannot meet a 1-year requirement for a prior reduction to practice, has only completed substantial preparations for commercial use and not a commercial use itself, or has infringed a patent claim not directed to a method. By removing restrictions on establishing the defense, the Section-endorsed changes to the patent statute will encourage locating and maintaining manufacturing facilities in the United States. Moreover, expanding the “prior inventor rights” provisions of the patent statute becomes particularly desirable in a first-inventor-to-file world where the prior inventor no longer can assert any “prior invention” defense to the validity of a patent.
14. Permit the filing of applications for patent by the assignee of the inventor. This simple change to the patent law that can facilitate the filing of applications for patent appeared in the committee print and was coupled with a proposal to remove any required formalities in the oath of the applicant. This non-controversial change should prove a modest benefit for applicants, especially inventors using the Patent Cooperation Treaty.

Many of these reforms – first-inventor-to-file, “best practices” prior art reforms, and facilitating the increased applicant responsibility initiative – will make the work of the United States Patent and Trademark Office simpler, more efficient, and more accurate and complete. Less will be left to the courts to resolve.

Other reforms are aimed at driving down the costs of enforcing patents. These reforms remove almost all subjective factors from patent litigation – factors that complicate life and drive up costs for both the patent owners and accused infringers. As recommended by the National Research Council, the “best mode,” “inequitable conduct,” and “willful infringement” issues would disappear from most patent litigation.

While patents are inventors’ property rights that should and must command respect, still other reforms are aimed at preventing that respect from rising to the level of intimidation – forcing accused infringers to pay tribute to questionable patents rather than have a rational business case for taking a questionable patent back to the United States Patent and Trademark Office or into the courts to challenge its validity or infringement. The creation of a post-grant opposition proceeding and scaling back on willfulness allegations are targeted to work effectively to this end.

With so many areas where the patent system must perform better to meet the rising expectations for all the constituencies that it serves, a convincing case now exists for moving ahead in a coordinated fashion with all the reforms that are outlined above.

1. ADOPT FIRST-INVENTOR-TO-FILE REFORMS

Section Position:

The Section and the American Bar Association favor enactment of legislation providing that the right to a patent shall belong to the first inventor to file.

Resolution TF-1:

(Passed by House of Delegates 2005)

RESOLVED, that the Association supports enactment of legislation providing that the right to a patent shall belong to the inventor who first files an application for patent containing an adequate disclosure under 35 U.S.C. § 112 of the invention or, in the event of an assignment of rights, shall belong to the assignee thereof.

Resolution TF-A1

RESOLVED, that the Section of Intellectual Property Law supports the principle that any legislation repealing 35 U.S.C. § 102(f) (barring a patent to a person who “did not himself invent the subject matter sought to be patented”) contain an explicit provision that the right to seek and obtain a patent is the right of the inventor or, in the case of a joint invention, the right of the joint inventors; and,

NOW THEREFORE, the Section supports adding to S.3818, 109th Cong., 2d Sess. (2006) (Hatch-Leahy), or similar legislation, a provision, in substance, that the inventor, or the joint inventors, as the case may be, of any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, have the right to apply for and to obtain a patent therefore, subject to the conditions and requirements of title 35.

Resolution TF-A2

RESOLVED that the Section of Intellectual Property Law opposes, in principle, in any contested proceeding before the United States Patent and Trademark Office in which derivation of a claimed invention could be raised, barring an applicant for patent from raising the issue of derivation in such a proceeding against a rival applicant or patent owner on the grounds that the effective filing date of the rival applicant or patent owner is more than a specified time earlier than the filing date of the applicant raising the issue of derivations; and

NOW THEREFORE, the Section opposes the requirement in Section 3(i) of S.3818, 109th Cong., 2d Sess. (2006) (Hatch-Leahy), or similar legislation, that would impose such a bar if the effective filing date of the rival applicant of patent owner was more than 18 months earlier than the filing date of the applicant raising the issue of derivation.

Resolution TF-A3

RESOLVED, that the Section of Intellectual Property Law opposes, in principle, limiting the definition of joint inventorship to joint invention by collaboration of persons working towards the same end; and,

NOW THEREFORE, the Section opposes the definition appearing in Section 3(a) of S.3818, 109th Cong., 2d Sess. (2006) (Hatch-Leahy), or similar legislation, that might limit or qualify the existing provisions of 35 U.S.C. § 116, first paragraph, that now state that inventors may apply for a patent jointly even though (1) they did not physically work together or at the same time, (2) each did not make the same type or amount of contribution, or (3) each did not make a contribution to the subject matter of every claim of the patent.

Discussion:

The ABA position favoring a first-inventor-to-file system, adopted in February 2005, forms the core around which other proposed reforms to the patent system have been coordinated and assembled. This is the keystone reform for effectively pursuing implementation of post-grant opposition practice. It has been demonstrated through exhaustive empirical evidence to be a self-interested change for U.S.-based inventors, including independent inventors.

The fundamental features of U.S. patent law that have focused on the inventor will remain. It is proposed that section 101 of the patent law be specifically amended to indicate that the right to apply for and obtain patent is the right of the inventor. Similarly, the inventor would enjoy a 1-year “grace period” during which the inventor’s own disclosure could not defeat the right to patent the invention. Should there be a joint inventor, there should not be needed any collaboration of persons working toward the same end.

The inventor should have the ability of contesting the derivation of a previously filed invention even if the inventor files after publication of the rival application.

Given support to date from *every* constituency for this change to the patent laws, the ripeness of this change for congressional action is now far different from the pre-1994 era. At that time, when U.S.-based inventors were still able to gain advantage from the bar in the statute to presenting foreign-origin work as a basis for being declared the first to invent, opponents could cite this offsetting advantage to the inherent disadvantages of costs, delays, uncertainties, complexities, unfairness and unpredictability.

Lastly, the time has come to bolster the negotiating position of the United States by demonstrating that we are prepared to act in our self-interest to make this fundamental change to our patent laws. For two decades, the United States – in contrast to the Europeans – has been proposing a patent harmonization treaty that would create a patent system that today exists nowhere in the world. With the first-inventor-to-file changes enacted into our law, we will finally be able to demonstrate that we do have in operation the very patent system we are asking others to emulate in the name of greater international harmonization.

2. DEFINE PRIOR ART THROUGH “BEST PRACTICES”

Section Position:

The Section favors as part of first-inventor-to-file reforms, defining prior art rules and formulating related provisions on the right to patent an invention according to “best practices.”

Resolution TF-2:

RESOLVED, that the Section supports, in principle, in enacting first-inventor-to-file reforms, an objectively based definition of prior art and conditions for patentability, including provisions that continue to afford inventors a 1-year grace period in which to file an application for patent and that prevent certain prior-filed patent applications by the same or related persons from being used as patent-defeating prior art; and

SPECIFICALLY, the Section favors legislation in this context that would—

- (a) eliminate from U.S. patent law provisions relating to—
 - (1) abandonment as set forth in 35 U.S.C. § 102(c) as a basis for a loss of right to patent;
 - (2) premature foreign patenting as set forth in 35 U.S.C. § 102(d) as an element of prior art or a basis for a loss of right to patent;
 - (3) an inventor’s forfeiture of his or her right to patent an invention once placed “in public use or on sale” as set forth in 35 U.S.C. § 102(b) by providing that no such loss of right to patent an invention can arise unless the invention had become reasonably and effectively accessible to persons of ordinary skill in the art more than one year before the inventor sought a patent for the invention;
 - (4) prior art as set forth in 35 U.S.C. § 102(f), under which non-public knowledge of the inventor, not otherwise qualifying as prior art, can render an invention made by such inventor obvious, by:
 - (A) repealing section 102(f) and
 - (B) codifying elsewhere in Title 35, United States Code, that the right to seek and obtain a patent is solely the right of the individual or individuals who made the invention for which a patent is sought (or, where applicable, the assignee of such inventor);
 - (5) the provisions currently in 35 U.S.C. § 102(g) providing that “secret prior art” (and/or loss of right to patent) can exist as from the date an invention of another inventor was made;
 - (6) the provisions currently in 35 U.S.C. §§ 102(a), (e), and (g) that permit the inventor to rely upon proofs of dates of invention in order to eliminate as prior art to an invention subject matter that would otherwise represent prior art relative to the effective filing date for the invention;
 - (7) the geographic restrictions on prior art currently in 35 U.S.C. §§ 102(a) and (b) that require proofs of knowledge or use in the United States;

- (8) the English language requirement currently in 35 U.S.C. § 102(e), relating to published international applications for patent that can qualify as prior art as of their respective filing dates; and
- (b) provide a definition of prior art, to be used for both novelty and non-obviousness determinations, stating that a patent for a claimed invention may not be obtained if—
- (1) the claimed invention was patented, described in a printed publication, or otherwise publicly known—
- (A) more than one year before the effective filing date of the claimed invention or
- (B) before the effective filing date of the claimed invention other than through disclosures made by the inventor or a joint inventor or by others who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor, or
- (2) the claimed invention was described in an issued patent or in an application for patent published as provided in 35 U.S.C. § 122 or 35 U.S.C. § 374, in which the application or the patent names another inventor and was effectively filed before the effective filing date of the claimed invention; and
- (c) with respect to determining novelty and non-obviousness with respect to the prior art that state that—
- (1) subject matter that would otherwise qualify as prior art only because of the filing of a published patent application or patent shall not be prior art to a claimed invention if the subject matter and the claimed invention were, not later than the effective filing date of the claimed invention, owned by the same person or subject to an obligation of assignment to the same person;
- (2) subject matter that would otherwise qualify as prior art only because of the filing of a published patent application or patent shall not be prior art for purposes of determining non-obviousness of a claimed invention if—
- (A) such claimed invention was made by or on behalf of parties to a joint research agreement that was in effect on or before the effective filing date of the claimed invention;
- (B) such subject matter was developed and such 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; and
- (3) subject matter would be regarded as publicly known for the purposes qualifying as prior art only when it becomes reasonably and effectively accessible, either through its use or through its disclosure by other means where;
- (A) reasonable accessibility requires that the subject matter can be accessed by persons of ordinary skill in the art to which the subject matter pertains without resort to undue efforts and
- (B) effective accessibility requires that its content can be comprehended by persons of ordinary skill in the art to which the subject matter pertains without resort to undue efforts; and
- (d) until a twelve-month grace period becomes effective under the patent laws of the member states of the European Patent Convention and in the patent law of Japan, provide that

the grace period under which disclosures made directly or indirectly by the inventor would only apply to disclosures made up to twelve months preceding the effective filing date in the United States.

Resolution TF-2B:

RESOLVED, that the Section of Intellectual Property Law re-affirms its opposition, in principle, in the context of a first-inventor-to-file system, to permitting the inventor to rely upon proof of date of invention in order to eliminate as prior art subject matter that would otherwise represent prior art relative to the effective filing date for the invention; and

SPECIFICALLY, the Section opposes legislation, in the context of a first-inventor-to-file system, providing that a patent for a claimed invention is not precluded by the claimed invention having been patented, described in a printed publication, or otherwise publicly known no more than one year before the effective filing date, but after the invention thereof by the applicant.

Resolution TF-2C-1:

RESOLVED, that the Section of Intellectual Property Law supports, in principle, in the context of a first inventor to file system, that a one year grace period for filing an application after an inventor's direct or indirect public disclosure of the invention contain an exclusion as prior art for any intervening public disclosures made by and/or intervening applications for patent filed by others, including disclosures or filings based upon derivation from the inventor, and

SPECIFICALLY, the Section supports amending § 102(b), as proposed in HR 2795 (June 6, 2005) to provide for the following exemptions from prior art:

(1) **Prior Inventor Public Disclosure Exception.**—Subject matter that would otherwise qualify as prior art based upon its public disclosure not more than one year prior to the effective filing date for a claimed invention shall not be prior art to the claimed invention under such circumstances if such subject matter had previously been made publicly known by the inventor or a joint inventor or others who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor.

(2) **Prior Filing Exceptions.**—Subject matter that would otherwise qualify as prior art as of the filing date of a patent or published application for patent only by virtue of its disclosure in such patent or published application shall not be prior art to a claimed invention if the subject matter had previously been made publicly known by the inventor or a joint inventor or others who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor.

Resolution TF-2C-2:

RESOLVED, that the Section of Intellectual Property Law supports, in principle, in the context of a first inventor to file system, the doctrine of *In re Facius*, 408 F.2d 1396 (C.C.P.A. 1969), and

SPECIFICALLY, the Section supports amending § 102(b), as proposed in HR 2795 (June 6, 2005) to provide that subject matter that would otherwise qualify as prior art as of the filing date of a patent or published application for patent only by virtue of its disclosure in such patent or published application shall not be prior art to a claimed invention if the subject matter was obtained directly or indirectly from the inventor or a joint inventor.

Resolution TF-A4

RESOLVED, that the Section of Intellectual Property Law opposes, in principle, treating the filing of a Paris Convention priority application any differently than the filing of a U.S. provisional application for patent in determining the effective filing date of a patent or a published application for patent as prior art under section 102 and 103 of title 35, United States Code; and,

NOW THEREFORE, the Section opposes the introduction of any discriminatory treatment in legislation creating a first-inventor-to-file system.

Discussion:

The Section, the American Intellectual Property Law Association, the Intellectual Property Owners Association, the National Association of Manufacturers, and the Biotechnology Industry Association all have taken common positions on the issue of implementation of a first-inventor-to-file system. This was done in response to the request by the PTO to address the issue of “best practices” in the harmonization context. The ABA IPL Section supports this common set of positions, both in a harmonization context, and as best practices for the U.S.

This is the correct set of policy choices for implementing first-inventor-to-file for several reasons. First, in changing our patent laws there would need to be some significant justification for not selecting the reforms that would best address the rationale for reform. Second, holding back on “best practices” and substituting less desirable reforms cannot be a credible “negotiating chip” in patent harmonization negotiations; withholding action in our domestic self-interest is nothing that would be cognizable as a concession by any foreign government. Third, moving directly to “best practices” avoids a triple set of applicable patentability rules – before reforms, after reforms but before completing “best practices,” and after completing “best practices.”

Key considerations, however, are the retention of all key features of U.S. patent law that focus on fairness to the inventor: prior art defined in terms of public accessibility (not the European “divulgation” principle), a 1-year “grace period” (not the European “absolute novelty”), no “self-collision” among copending unpublished applications of the same inventor or a common owner (not the European rule to the contrary on both counts), no ability to patent trivial variations of a first-filing inventor’s patent disclosure (not the European “novelty-only” restriction on such patenting), and no discrimination between Paris Convention priority or U.S. provisional filing with respect to determining the effective filing date of a patent or published application for use as prior art.

Moreover, in the first-inventor-to-file system, the applicant should not be permitted to eliminate what would otherwise be prior art by “swearing back” based upon the applicant’s date of invention. Instead, the “grace period” should be enhanced by assuring that prior art public disclosures or patent applications by another effective during the first publishing inventor’s “grace period” could not defeat the opportunity of the first publishing inventor to obtain a valid patent.