

Changes Afoot for US Patent Law

By John Landells and Helen Palmer

A bill currently before the US congress proposes some sweeping changes to the US patent system that would bring US patent law more into line with other first world countries. US patent law has undergone regular amendments in recent times, however, Congressman Lamar Smith, who introduced the bill, has said that the changes proposed will be the most comprehensive seen in the last 50 years.

The Patent Reform Act of 2005 (bill HR 2795) was introduced on 8 June 2005 but has since undergone some significant modifications as it has moved through congress. Presently, some of the proposed changes are:

- Move from “first to invent” to “first to file”
- Introduction of post-grant opposition proceedings
- A revision of the provisions that presently provide for treble damages in cases of willful patent infringement
- Introduction of a system to allow third parties to challenge a patent application by introducing new information to the USPTO up to six months after the date of publication of the patent application
- A “duty of candor and good faith” imposed on persons associated with the filing and prosecution of a patent application and on third parties who are involved in proceedings against a patent or patent application before the USPTO
- Removal of the “best mode” or “best method” requirement in patent specifications

For some time the US has differed from other jurisdictions in that the winner of the race for patent rights is the party that can show it was the “first to invent” the subject matter of a patent application. Essentially the rest of the world has relied on the more pragmatic system of providing patent rights to the applicant who was “first to file” a patent application. In other words, the person who first applies for the patent will win the race for the patent rights. Although the present US system of “first to invent” may be considered fairer, it can be complex, difficult to administer and can result in expensive litigation over who

was the first applicant to invent. However, one of the most compelling reasons for the US to change from “first to invent” to “first to file” is simply to provide harmonization of global patent laws. This change would bring the US more into line with other countries. The move from the present US system of “first to invent” to a “first to file” system is certainly one of the most interesting changes that has been proposed.

Another area in which the Act would bring the US patent system closer to other countries is the proposed implementation of a post-grant opposition procedure. The post-grant opposition procedure is an internal procedure through the USPTO and would provide a cheaper and more expedient means for any member of the public to challenge the validity of a patent. The opposition period is proposed to run for nine months from the grant of a patent with an extension of a further six months possible if good cause exists.

Another amendment to the US patent law includes the removal of the “best mode” or “best method” requirement in patent specifications. Presently, one of the requirements for patent specifications in the US is to disclose the best method of performing the invention that is known to that applicant at the time of filing. One of the arguments in support for the omission of the “best method” requirement is that the subjectivity within this requirement can provide the basis for much litigation.

It will be very interesting to see the final shape of the Act once it has been passed. It is hoped that the recently proposed legislation will provide for not only better harmonization of global patent laws but also greater certainty for all parties involved in the prosecution, issuance and enforcement of US patents.

A reminder: if you have any queries regarding patents, or indeed any form of intellectual property, please direct them to:

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