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Senniger Powers' Associate Michael Vander Molen Comments on Patent Reform

Senniger Powers' Associate Michael Vander Molen provides an update on the status of proposed patent reform legislation including provisions relating to a first inventor to file system, post-grant opposition procedure and a new standard for willful infringement determinations.

Both the House and Senate Judiciary Committees have recently approved legislation that could significantly change the practice of patent law in the United States. Perhaps the most noteworthy provision is a proposal to change the patent system from a first inventor system to a first inventor to file system. Under this system, an invention is anticipated if the invention was patented, published, in public use, on sale or otherwise publicly known (1) one year prior to the filing date of the patent application, (2) less than one year prior to the filing date of the application through disclosures other than the inventor's or (3) described in a patent or published patent publication naming another inventor and effectively filed before the claimed invention.

The House and Senate bills also provide for a post-grant opportunity to oppose the issuance of a patent. Under the House Bill, a patent may be opposed without consent of the owner for a period of 12 months from issuance of the patent for any reason related to patentability. Under the provisions of the Senate Bill, the patent may also be opposed at any time prior to 12 months after issuance and may also be opposed after a period of 12 months from issuance if there is an allegation of infringement and (1) the claim is likely to cause "significant economic harm" and (2) the petition is filed within 12 months of notice of alleged infringement of the patent.

A further reform provision relates to the elements of proof which must be established for a court to find willful infringement and potentially award treble damages. Under both the House and Senate Bills, a patent owner must establish by clear and convincing evidence that the patentee gave written notice of infringement that identified each claim of the patent alleged to be infringed and that put the alleged infringer in reasonable apprehension of suit. The patentee must further show that the alleged infringer either (1) intentionally copied the invention knowing it was patented or (2) was previously found to have infringed the patent and later engaged in conduct that was not colorably different from the conduct previously found to have infringed the patent. There can be no finding of willfulness for periods of time the alleged infringer had a good faith belief that the patent was invalid, unenforceable or would not be infringed by the conduct that is the basis for the finding of infringement.

The House and Senate bills contain many additional reform provisions including provision for assignee filing of applications, interlocutory appeals for claim construction rulings, a requirement that applicants file mandatory search reports and provisions setting forth the standard for inequitable conduct determinations. The bills will now be presented to the House and Senate for debate and amendments.

If you would like more information about the proposed reform bills, contact
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