

Practice Exam Question #2

H.R. 2795 (“The Patent Reform Act of 2005”) is pending in congress. It would make several substantive changes to US patent law, some of which are reproduced below. Analyze these amendments for compatibility with Paris and TRIPs.¹ In what ways, if any, do these amendments harmonize US and international patent law?²

H.R. 2795

SECTION. 3.

(a) Definitions- Section 100 is amended by adding at the end the following:

- (h) The ‘effective filing date’ of a claimed invention is--
- (1) the filing date of the patent or the application for patent containing the claim to the invention; or
 - (2) if the patent or application for patent is entitled to a right of priority of any other application under section 119, 365(a), or 365(b) or to the benefit of an earlier filing date in the United States under section 120, 121, or 365(c), the filing date of the earliest such application in which the claimed invention is disclosed in the manner provided by the first paragraph of section 112 of this title.

(b) Conditions for Patentability-

(1) IN GENERAL- Section 102 is amended to read as follows:

Sec. 102. Conditions for patentability; novelty

(a) Novelty; Prior Art- 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 a patent issued under section 151, or in an application for patent published or deemed published under section 122(b), in which the patent or application, as the case may be, names another inventor and was effectively filed before the effective filing date of the claimed invention.

¹ Only excerpts of the Patent Reform Act are reproduced in this practice question. The complete text can be found at <http://thomas.loc.gov/cgi-bin/query/z?c109:H.R.2795>; or <http://classes.ils.edu/fall2006/iip-atik-manheim/docs/hr2795.pdf>. Existing US patent law (in a single document to facilitate comparison with the proposed amendments), can be found here: http://www.uspto.gov/web/offices/pac/mpep/consolidated_laws.pdf.

² [Capitalized “SECTION” refers to sections in the Bill; lower case “Section” refers to code sections in Title 35. New code language appears in Arial font]

(b) Limitation on Prior Art-

(1) COMMONLY ASSIGNED INVENTION EXCEPTION- Subject matter that would otherwise qualify as prior art only under subsection (a)(2) 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.

(i) Inventor's Rights Contests- Section 135(a) is amended to read as follows:

(a) Dispute Over Right to Patent-

(1) INSTITUTION OF INVENTOR'S RIGHTS CONTEST- Whenever patents or applications for patent naming different individuals as the inventor are deemed by the Director to interfere because of a dispute over the right to patent under section 101, the Director shall institute an inventor's rights contest for the purpose of determining the right to patent.

SECTION. 4

(d) Specification- Section 112 is amended--

(1) in the first paragraph--

(B) by striking ` , and shall set forth the best mode contemplated by the inventor of carrying out his invention';

SECTION. 9

(a) Publication- Section 122(b)(2) is amended--

(1) by striking subparagraph (B); and

(f) Post-Grant Opposition Procedures-

(1) IN GENERAL- Part III is amended by adding at the end the following new chapter:

CHAPTER 32--POST-GRANT OPPOSITION PROCEDURES

Sec. 321. Right to oppose patent; opposition request

(a) Filing of Opposition- A person may request that the grant or reissue of a patent be reconsidered by the Office by filing an opposition seeking to invalidate one or more claims in the patent. The Director shall establish, by regulation, fees to be paid by the opposer. Copies of patents and printed publications to be relied upon in support of the request must be filed with the request. If an opposer relies on other factual evidence or on expert opinions in support of the opposition, such evidence and opinions must be filed with the request through one or more accompanying affidavits or declarations.

(b) Copies Provided to Patent Owner- Copies of any documents filed under subsection (a) must be provided to the patent owner or, if applicable, the designated representative of the patent owner, at the time of filing under subsection (a), except that if a request is made under section 322(b) that the identity of a real party in interest be kept separate, then the identity of the real party in interest may be redacted from the copies provided.

(c) File Available to the Public- The file of any opposition proceeding shall be made available to the public except as provided in section 322.

SECTION. 11

(h) Effect of European Patent Convention and Patent Laws of Japan- Before the date, if ever, that the Director of the United States Patent and Trademark Office publishes a notice in the Official Gazette of the Office declaring that both the European Patent Convention and the patent laws of Japan afford inventors seeking patents a 1-year period prior to the effective filing date of a claimed invention during which disclosures made by the inventor or by others who obtained the subject matter disclosed directly or indirectly from the inventor do not constitute prior art, the term `effective filing date' as used in section 102(a)(1)(A) of title 35, United States Code, shall be construed by disregarding any right of priority except that provided under section 119(e) of title 35, United States Code.