



JONES DAY
COMMENTARY

U.S. HOUSE OF REPRESENTATIVES PROPOSES SWEEPING CHANGES IN THE PATENT REFORM ACT (H.R. 2795)

On June 8, 2005, U.S. Representative Lamar Smith (R.-TX) introduced H.R. 2795. The bill seeks to amend Title 35 of the United States Code relating to the procurement, enforcement, and validity of patents. If enacted, the U.S. patent system will undergo its most substantial overhaul since Congress passed the Patent Act in 1952.

The Reform Act aims to change the patent system fundamentally by shifting from a “first to invent” system to a “first to file” system. The stated objectives of this change are to reduce the subjectivity and costs of proving the date of invention and to bring the U.S. patent system in line with many other countries around the world. The Reform Act will also affect other major facets of the patent process, including who can file a patent application, ownership of patents, publication requirements, limitations on continuation practice, elimination of best mode requirement, “inventor rights contests,” new inequitable conduct and willfulness standards,

new injunction standards, post-grant opposition procedures, and more.

In the months leading up to the introduction of the bill, several industry groups, legal organizations, and other think tanks weighed in on the substance of the bill. As no clear consensus has yet been reached on the major changes proposed by the current version, the coming months will be filled with testimony and hearings from the various interests, and amendments to the bill will be likely.

Jones Day is actively tracking the developments as they occur and has created a Patent Law Reform—Updates web site (accessible at www.jonesday.com/PatentLawReformUpdates), where materials including the bill, a redlined version of the Patent Act, hearing testimony, witness statements, and interest group position papers are available. Upcoming hearing dates are posted as they are scheduled.

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