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OPINION

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Scrap the patent reform bill

Congress should start all over, making sure that patent law continues to reward the first true inventor, not the first to file.

BY DALE L. CARLSON

On March 4, leaders of the Senate Judiciary Committee announced that they'd reached agreement on a modified version of a patent reform bill (S. 515) introduced into Congress last year. If enacted, the modified bill is sure to disrupt our nation's established patent policy and decrease our nation's competitive edge in technology-related matters.

A first provision purports to change our system from "first to invent" to "first to file." Unfortunately, this change does not comport with more than a century of judicial construction of Article 1, § 8, clause 8 of the Constitution. Nor does it comport with patent statutes dating as far back as the Patent Act of 1836. That act required an oath or affirmation that the patent applicant "does verily believe that he [or she] is the original and first inventor or discoverer" of the invention. An "inventor" is the first person who makes the invention, not the second-comer, unless the first party has "abandoned, concealed or suppressed" it.

Proponents for the change mask both the purpose and effect of a first-to-file system under the guise of a nonsensical phrase, "the right of the first inventor to file." Perhaps this expression was created by throwing eight words into a word blender and selecting the most incomprehensible combination spewing out of the blender.

A second provision purports to supplement existing inter partes re-examination protocols with "post-grant review" proceedings. In doing so, it frames a false line of demarcation since inter partes re-examination is simply one form of post-grant review. In other words, "post-grant review" is the genus, and "inter partes re-examination" is a species within it. The second species proposed is in reality a "patent opposition." It is generally modeled after an analogous opposition procedure in Europe. Fortunately, we have the chance to look to other countries before leaping into patent-opposition legislation. Specifically, China, Japan and South Korea implemented European-style patent oppositions more than a decade ago; within the decade they all failed and were abolished.

In Europe, there are no administrative alternatives to the opposition procedure. Hence, there's no risk of redundancy nor of confusion among users of the system. In contrast, China, Japan and South Korea have a separate administrative option, which still exists, called an "invalidation trial." This is analogous to the separate administrative option that the United States has, namely inter partes re-examination.

The object lesson to be learned from China's, Japan's and South Korea's negative experience with oppositions is that they might confuse users and/or introduce redundancy into our system. In short, we should ditch the opposition proposal and frame new legislation to enhance the inter partes re-examination procedure.

A third provision purports to render the best-mode requirement of § 112 of the patent statutes unusable as a defense against patent infringement. This effectively emasculates that provision, which requires inventors to disclose what they believe to be the best way to carry out their invention. Such emasculation, if implemented, would diminish the incentive force afforded by our patent system by reducing the motivation to inventors to make such a disclosure, or face consequences that can include the loss of their patent. It is human nature to want to conceal the best aspects of an invention from the patent disclosure in order to keep them as "patented trade secrets."

In sum, it's time to scrap the existing proposals and replace them with new proposals for reforming our patent system. Preferably, they should be proposals that haven't been tried, and shown to fail, elsewhere. Hopefully, they will serve as a platform to enhance, not diminish, our patent system's incentive force. Ideally, they will serve to streamline inter partes re-examination, while continuing to reward first, true inventors for letting the public know the "full scoop" about their invention.

Dale L. Carlson is a partner in the New Haven, Conn., office of Wiggin and Dana, and an adjunct professor of patent law at Quinnipiac University School of Law in Hamden, Conn.