

“As Time Goes By - A Long and Winding Road to Patent Reform” by Dale Carlson¹

I'm pleased to continue as NYIPLA Historian at the behest of our new President, Marylee Jenkins. Our previous five columns have focused on patent reform, and our Association's role through the years in molding reform. This column will continue in that vein.

As the 2005-2006 legislative session draws to a close, we can be confident that the road to patent reform is marked more by twists and turns than it is by straight paths. Perhaps things have always been that way.

A prime example of a long-winding legislative path, with starts and stops along the way, can be found in the proposals behind the creation of the Court of Appeals for the Federal Circuit.

A full half-century prior to the Federal Circuit's creation in 1982, our Association voiced its opinion on the proposal to form a single court for patent appeals. A 1932 article appearing in the American Bar Association Journal begins with this opening salvo “The proposal for a Single Court of Patent Appeals has again been recently agitated and widely circulated by its sponsors. It has frequently been urged since first brought to the attention of the American Bar Association in 1898.”

The 1932 ABA article (appearing at 18 A.B.A.J. 902 (1932)) documents the position of our Association on the patent court concept back then. Specifically the article notes that on “September 14, 1931, the Board of Governors of the New York Patent Law Association adopted the unanimous report of its sub-committee,

which stated that it ‘is convinced that the proposed bill is unsound in principle and

for this reason recommends that it be not approved.’” The article goes on to say that the Board adopted this report, and was officially represented at a “Patent Section” meeting of the ABA by Richard Eyre of New York for the purpose of opposing the bill.

Back in 1932, our Association did not stand alone in its opposition to the patent appeals court concept. It was joined by the ABA, the Cleveland Patent Law Association, and the Committee on Patents of the Association of the Bar of the City of New York in such opposition.

Perhaps in the face of such opposition, the enactment of the Federal Circuit was a long time in materializing. Needless to say, a half-century is an unusually long time period for any proposed legislation to percolate. Nevertheless, legislative change doesn't often happen quickly, particularly when it pertains to sweeping patent reform legislation.

During 2005, sweeping reform legislation was introduced by Representative Lamar Smith in the House in the form of a “Coalition Print” dubbed “Substitute bill H.R. 2795”. That bill called for, among other things, elimination of best mode. It also included a post-grant opposition procedure with a “single window” of opportunity for bringing an opposition not later than nine months after grant of a patent.

On April 5, 2006, Representative Howard Berman introduced the “Patents Depend on Quality Act of 2006” (H.R. 5096 - the “PDQ Act”) into the House. The proposed PDQ Act focuses on post-grant opposition, and includes a so-called “second window” for bringing an opposition, namely within six months of an alleged infringer's receiving notice of suit.

On August 3, 2006, Senator Orrin Hatch introduced the “Patent Reform Act of 2006” (S. 3818) into the Senate. This bill also includes a second window for bringing a post-grant review proceeding. The second window is open when an opponent “establishes a substantial reason to believe that the continued existence of the challenged claim causes or is likely to cause the petitioner substantial economic harm.” ■



Dale Carlson, a partner at Wiggin & Dana, serves as the NYIPLA Historian, and as a member of the Board of Directors.

¹ Editor's Note: Following the author's submission of his previous Historian's Column (published in the July/August Issue), the committee chairs referenced in that column have changed. Allan Fanucci has been appointed as chair of the License to Practice Requirements, and Susan McHale McGahan has been appointed as chair of the Committee on Public and Judicial Personnel and International Relations.