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Senate Passes Sweeping Patent Reform Legislation

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Practice Area: Patents & Intellectual Property

The U. S. Senate passed sweeping legislation on September 8, 2011, designed to significantly overhaul the U.S. patent system. The Leahy-Smith America Invents Act ("Act") (HR 1249) makes numerous changes to the U.S. patent laws, most notably conforming U.S. patent law to the laws of most other countries by granting patent protection to the first person to file for patent protection rather than the first to invent, as it is now. Portions of the Act will take effect immediately, while others will become effective in 12 to 18 months. President Obama is expected to sign the bill into law promptly.

Other notable changes to the patent laws include:

- Third parties are given the opportunity to challenge the Patent Office's decision to grant a patent.
- Third parties may cite prior art to the Patent Office during prosecution of a patent application.
- Strategies to reduce taxes are not patentable.
- Only the government and those suffering a competitive injury will be allowed to sue for false patent marking.
- Failure to obtain the advice of counsel cannot be used to prove willful infringement.
- Creates a mechanism by which the Patent Office will reevaluate and possibly invalidate previously issued business method patents.
- Eliminates the requirement that inventors describe the "best mode" of making and using the invention as a basis for challenging the validity of a patent.
- Allows individual inventors or very small companies to file patent applications at significantly lower fees, allowing those small companies and inventors to afford filing a patent application where they might not otherwise be able to afford such an application.

Companies and individuals who already have patents or pending patent applications should review their current practices and bring them in-line with the new patent laws in order to maintain their competitive edge. Inventors should also file an application as soon as possible, and must take additional steps to avoid disclosure or commercialization of their inventions prior to filing a patent application or risk losing the right to seek patent protection.

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