



FOLEY & LARDNER LLP

Real or Hype? Business and Litigation Impact of Patent Reform

A Web Conference
Presented by
Foley & Lardner LLP
May 15, 2007

Presenters

- **Sharon Barner, Moderator**
Chair, IP Department



- **George Best**
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Of Counsel, IP Litigation Practice Group



- **Hal Wegner**
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Patent Reform Legislation— An Overview

George C. Best



The Proposed Legislation Has 13 Sections

- Six sections—1, 2, 7, 8, 11, and 12—have little substance
- Remaining 7 sections address several areas, including
 - First to file
 - Provision of a second window for PTO review of patents
 - Damages for Infringement

Section 3

- Changes U.S. to first to file system with a limited absolute novelty standard
- Makes the date of invention irrelevant
 - Key date is now the “effective filing date”

Section 3

- “Limited Absolute Novelty”
 - Prior art includes art on sale or in public use anywhere in the world before the effective filing date
 - Contains 1 year grace period for disclosures by
 - The inventor
 - Others who have to assign to the inventor or the inventor’s assignee,
 - Parties collaborating with the inventor pursuant to a Joint Research Agreement
 - Parties who derived their information from the inventor

Section 3

- In the event of interfering claims, first to file wins
- Only contest is a Derivation Proceeding
- Derivation not defined in statute, so assumption is that current legal standard applies

Section 4

- Amends Inventor's Oath Requirement
 - Statutory basis for allowing filing of substitute documents for dead/missing/uncooperative inventors
 - Oath can be combined with assignment
 - No need to file new oath for continuations

Section 5

- Substantial changes to damages law
- David Melton will discuss in more detail

Section 6

- Creates process for post-grant review of patents in PTO
- Hal Wegner will discuss

Section 9

- Statutory basis for allowing submission of art by third parties

Section 10

- Revisions to venue statute and appeals process

- David Melton to discuss

Section 13

■ Effective Date

- New statute applies to “any patent issued on or after” a date 12 months from enactment
- Keys laws to patent *issuance* rather than *application date*
 - Possible discrepancy for applications allowed under old laws and issued later
 - Possible that some applications already on file will be subject to new laws unless this provision is changed