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## IP Update

### IP Update - Patent Law Reform 2011

April 6, 2011

Finnegan attorneys closely track patent law reform efforts, most recently the Patent Reform Act of 2011, which was passed by the U.S. Senate on March 8, 2011, with the updated title "America Invents Act." Through *IP Updates*, webinars, conferences, articles, and this resource page, Finnegan provides information on important legislative developments, public statements and testimony, and commentary from Finnegan attorneys on the impact of legislative and regulatory changes on U.S. and international businesses.

The Patent Reform Act of 2011 was introduced on January 25, 2011, by Senator Patrick Leahy. It addresses significant changes to the patent system, including first-to-file; post-grant review proceedings (oppositions); inter partes review; preissuance submission by third parties; USPTO fee-setting authority and USPTO funding; supplemental examination; micro entity fees; tax strategy patents; best mode; residency for Federal Circuit judges; creation of special post-grant review for business method patents; USPTO authority to establish satellite offices; creation of a USPTO ombudsman; and USPTO authority to prioritize inventions of national importance. The Senate Judiciary Committee amended the bill and unanimously approved it on February 3, 2011. After lively debate and a variety of amendments proposed, the Senate passed the legislation on March 8, 2011, by a wide 95-5 margin.

Congressman Lamar Smith introduced H.R. 1249 "America Invents Act" on March 30, 2010, to the House of Representatives, which has also held extensive hearings on patent law reform. The House version of the legislation is very similar in many ways to the legislation passed by the Senate. The House has made notable changes, however, and Congressman Smith has indicated one of his goals is to make inter partes reexamination more "user-friendly." In this respect, the House changes the threshold for inter partes review, automatically stays subsequent declaratory judgment litigation, and gives a longer time window for initiating a proceeding if litigation has commenced. The House version provides additional opportunities for post-grant review by lengthening the time period allowed for this procedure. It also adds restrictions on litigation for business method patents. Additionally, with respect to defense of infringement based on earlier inventor, the house bill eliminates the requirement that the defense is only available for business methods. But, the House adds the limitation that the defense is not available if the patent-at-issue was funded by an institution of higher education or its technology transfer organization, and if it did not receive funding from a private business enterprise.

Finnegan will continue to follow developing news on patent reform. If you would like to learn more about patent law reform, please subscribe to Finnegan's patent law reform *IP Updates* by clicking [here](#).

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## Legislation

### Senate

Passed Senate - March 8, 2011 ("America Invents Act") [\[PDF\]](#)

Reported in Senate - February 3, 2011 [\[PDF\]](#)

Introduced in Senate - January 25, 2011 [\[PDF\]](#)

### House

Introduced in House - March 30, 2011 [\[PDF\]](#)

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## Congressional Testimony on Patent Law Reform

### House

Committee on the Judiciary Hearing: "Promoting Investment and Protecting

Commerce Online: Legitimate Sites v. Parasites, Part II" - April 6, 2011 [\[Website\]](#)

Statement of The Honorable John Morton, Director, U.S  
Immigration and Customs Enforcement [\[PDF\]](#)

Floyd Abrams, Senior Partner, Cahill Gordon & Reindel LLP [\[PDF\]](#)

Kent Walker, Senior Vice President and General Counsel,  
Google Inc. [\[PDF\]](#)

Statement of Christine N. Jones, Executive Vice-President, General  
Counsel, & Corporate Secretary, The Go Daddy Group, Inc. [\[PDF\]](#)

Committee on the Judiciary Hearing: "America Invents Act" - March 30, 2011 [\[Website\]](#)

Statement of The Honorable David J. Kappos, Under Secretary of  
Commerce for Intellectual Property and Director of the United  
States Patent and Trademark Office [\[PDF\]](#)

Statement of The Honorable Steve Bartlett, President and Chief  
Executive Officer of the Financial Services Roundtable [\[PDF\]](#)

Statement of Steven W. Miller, Vice President and General Council  
for Intellectual Property, Proctor & Gamble Company [\[PDF\]](#)

Statement of Mark Chandler, Vice President, General Counsel and  
Secretary, Cisco Systems, Inc. [\[PDF\]](#)

Statement of John Vaughn, Executive Vice President, Association of  
American Universities, [\[PDF\]](#)

Committee on the Judiciary Hearing: Review of Recent Judicial Decisions on Patent  
Law - March 10, 2011 [\[Website\]](#)

Statement of Dan L. Burk, Chancellor's Professor of Law, University of  
California, Irvine [\[PDF\]](#)

Statement On Behalf of the Business Software Alliance by Andrew J. Pincus,  
Partner, Mayer Brown LLP [\[PDF\]](#)

Statement of Dennis D. Crouch, Associate Professor of Law, University of  
Missouri School of Law [\[PDF\]](#)

Committee on the Judiciary Hearing: Driving American Innovation: Creating Jobs and  
Boosting our Economy – March 9, 2011 [\[Website\]](#)

Statement of Anthony Atala, M.D., Director, Wake Forest Institute for Regenerative Medicine and W.H. Boyce Professor and Chair, Department of Urology, Wake Forest University School of Medicine [\[PDF\]](#)

Michael S. Fulkerson, Ph.D., Chief Technology Officer, Rosetta Stone, Inc. [\[PDF\]](#)

Scott Smith, Ph.D., Professor and Chair, Department of Mechanical Engineering and Engineering Science, University of North Carolina at Charlotte [\[PDF\]](#)

Committee on the Judiciary Hearing: Crossing the Finish Line on Patent Reform: What Can and Should Be Done? - February 11, 2011 [\[Website\]](#)

Testimony of David Simon, Associate General Counsel, Intellectual Property Policy, Intel Corporation [\[PDF\]](#)

Statement of Carl Horton, Chairman Coalition for 21st Century Patent Reform and Chief IP Counsel of General Electric [\[PDF\]](#)

Statement of Judge Paul R. Michel (Ret.) former Chief Judge U.S. Court of Appeals for the Federal Circuit [\[PDF\]](#)

Committee on the Judiciary Hearing: How an Improved U.S. Patent and Trademark Office Can Create Jobs - January 25, 2011 [\[Website\]](#)

Statement of David J. Kappos, Under Secretary of Commerce for Intellectual Property and Director of the U.S. Patent and Trademark Office [\[PDF\]](#)

Statement of Douglas K. Norman, President, Intellectual Property Owners Association and General Patent Counsel for Eli Lilly and Company, Inc. [\[PDF\]](#)

Statement of Robert J. Shapiro, Chairman, Sonecon, LLC; Senior Fellow of the Georgetown University McDonough School of Business; and Former Under Secretary of Commerce for Economic Affairs [\[PDF\]](#)

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### **Government Statements**

Statement of House Judiciary Chairman Lamar Smith

March 30, 2011 [\[Website\]](#)

March 8, 2011 [\[Website\]](#)

Statement of the Senate Judiciary Committee about the America Invents Act [\[Website\]](#)

White Board: Austan Goolsbee, Chairman of the Council of Economic Advisers, on Patent Reform [\[Video\]](#)

USPTO Press Release [\[Website\]](#)

Statement of Administration Policy [\[PDF\]](#)

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### **Industry Organization Statements**

#### **American Intellectual Property Law Association (AIPLA)**

Letter to Majority Leader Reid and Minority Leader McConnell re: Support for S. 23, The Patent Reform Act of 2011 [\[PDF\]](#)

Patent Reform Legislation Chart (itemizing AIPLA's position on each section of the bill) [\[PDF\]](#)

#### **Intellectual Property Owners Association (IPO)**

Letter to the Senate re: Full 2011 Funding for the U.S. Patent and Trademark Office - An Urgent Jobs Issue [\[PDF\]](#)

Letter to the House re: Full 2011 Funding for the U.S. Patent and Trademark Office - An Urgent Jobs Issue [\[PDF\]](#)

**Biotech Industry Organization (BIO)**

BIO Commends Launch of House Patent Reform Process [\[Website\]](#)

BIO Hails Senate Passage of America Invents Act [\[Website\]](#)

BIO Commends Senate Judiciary Committee Passage of Patent Reform Act of 2011 [\[Website\]](#)

BIO Supports Patent Reform Act of 2011 [\[Website\]](#)

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**Related Prior Bills**

**S. 515: Patent Reform Act of 2009**

Introduced in the Senate - March 3, 2009 [\[PDF\]](#)

Reported in the Senate - April 2, 2009 [\[PDF\]](#)

**H.R. 1260: Patent Reform Act of 2009**

Introduced in the House - March 3, 2009 [\[PDF\]](#)

**H.R. 1908: Patent Reform Act of 2007**

Introduced in the House - April 18, 2007 [\[PDF\]](#)

Reported in the House - September 4, 2007 [\[PDF\]](#)

Engrossed in House [Passed House] - September 7, 2007 [\[PDF\]](#)

Placed on Calendar Senate - September 11, 2007 [\[PDF\]](#)

**H.R. 2795: Patent Reform Act of 2005**

Introduced in the House - June 8, 2005 [\[PDF\]](#)

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**Finnegan Patent Law Reform Resources**

"Senate Passes Patent Reform Act of 2011," *IP Update* - March 9, 2011 [\[IP Update\]](#)

"A Familiar Start to the New Year in IP - The Community's Reaction to Patent Reform and Anti-Piracy Attack," *BNA Patent Trademark & Copyright Journal* - February 4, 2011 [\[Media Mention\]](#)

"Senate That Cried Wolf Readies Fifth Try at Patent Law Changes," *Bloomberg* - February 2, 2011 [\[Media Mention\]](#)

"Special Feature - Patent Legislation - Meeting the Challenges of Reform?" *Intellectual Property Today* - January 28, 2011 [\[Article\]](#)

"Patent Reform Continues to Focus on Post Grant Challenges," *Full Disclosure* - April 2010 [\[Article\]](#)

"USPTO News," *Full Disclosure* - February 2010 [\[Article\]](#)

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