



NEWS RELEASE

ORRIN HATCH

United States Senator for Utah

March 12th, 2008

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SENATE PATENT REFORM LEADERS RELEASE AMENDMENTS IN ADVANCE OF PATENT REFORM DEBATE

WASHINGTON – Senate Judiciary Committee members today released more than a dozen possible amendments to important patent reform legislation awaiting consideration in the Senate.

Senate Judiciary Committee Chairman Patrick Leahy (D-Vt.), Committee Member Orrin Hatch (R-Utah), and Ranking Member Arlen Specter (R-Pa.), have been working for months with a bipartisan coalition of senators in preparation of floor consideration of the Patent Reform Act, which would make the first reforms to the country’s patent laws in more than 50 years. The Judiciary Committee passed the legislation last July, and Leahy, Hatch and Specter have held dozens of meetings and briefings in the months since, listening to concerns from stakeholders, and working to address the concerns of the wide cross-section of interested parties.

The Senators have been urging consideration of the legislation in the full Senate for months, and Majority Leader Harry Reid (D-Nev.) has signaled the chamber could take up the bill in April. The House of Representatives passed patent reform legislation last year.

“Senator Hatch and I have been working for years to address needed reforms to our patent system,” said Leahy. “Senator Specter’s support in this process has been both constructive and valuable. The time for patent reform is now. We have been working carefully to address many concerns with the country’s patent laws, and we are looking forward to a thorough debate in the Senate after recess. These amendments are the first step forward in perfecting our bill and ensuring it has the support needed to become law.”

“We’re encouraged to see this progress toward a compromise, one that will be functional for interested stakeholders,” Hatch said. “These amendments are yet another sign that we can work through the few remaining issues. With the nation’s economic troubles so prevalent in people’s minds nowadays, Congress must strive to help America keep its competitive edge. When finally enacted, our patent reform is going to play an important role in doing just that. After years of negotiations, we believe we are close to striking the right balance to modernize our nation’s outdated patent system, so innovators can receive high-quality patents more efficiently and avoid wheel-spinning and counterproductive litigation.”

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Further amendments to address issues including venue, post grant review, damages and inequitable conduct are expected to be released in the coming weeks. The amendments released Wednesday include:

- “Best Mode” – eliminates ‘best mode’ as a ground for invalidating a patent, but maintains it as a requirement to obtain a patent
- Ex Parte Provision – restores third party ex-parte reexamination
- Federal Circuit Judges – ensures that any Federal Circuit judge who does not reside within a 50-mile radius of Washington, DC, must use the chambers of an existing courthouse in the district where they reside
- Interference – technical amendment to allow for appeal to the Federal Circuit of USPTO board interference decisions commenced prior to the date of the Act
- Interference – amends the bill to delete interference-related provisions and replace with new derivation-related provisions
- Interlocutory Appeals – limits interlocutory appeals of claim construction orders to those for which the District Court determines there is a reasonable basis for disagreement and the appeal may advance the ultimate termination of the litigation
- Marking Provision – deletes the marking provision in the bill and maintains the current law
- “Objective Recklessness” – codifies the Federal Circuit court’s ruling in Seagate, holding that infringement is only willful if the infringer acts with objective recklessness of the patent
- Patent and Trademark Board Judges – ensures that the appointment of patent and trademark judges is consistent with the Appointments Clause
- Patent Board Judges – technical amendment to clarify that the Patent Board’s duties include the conduction of derivation proceedings
- Post-Grant Review – technical amendment to delete a redundancy in sec. 338 as created in S 1145
- Post-Grant Review – corrects an inconsistency between S 337 (1) and (2), to preclude requesting or maintaining a post-grant review proceeding after a final decision in litigation on the same patent, based on any issue that was raised or could have been raised, in the litigation
- Post-Grant Review – defines “final decision” in the estoppel provision
- Post-Grant Review – technical amendment to delete a redundancy
- Severability – establishes a severability clause in the bill

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