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Patent Reform Act of 2009: Same song, different verse

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The 111th Congress has again decided to take up reform of the patent system, despite the fact that similar reform efforts have failed several times in the past five years. In 2008, a patent-reform bill that was passed by the U.S. House of Representatives died in the Senate. The Patent Reform Act of 2009, introduced on March 3, 2009, in both the House (H.R. 1260) and Senate (S. 515), aims to pick up where the 2008 legislation left off.

Many of the less controversial sections are almost identical to sections from the previous bills. For example, one of the most drastic changes, but possibly the least controversial, would change the U.S. from a first-to-invent to a first-to-file system that would be more in line with most other countries.

A limitation on damages, which is one of the most controversial provisions from the 2008 legislation, remains in the 2009 version. The bill proposes limiting damages for infringement to lost profits or a reasonable royalty, and only for the invention's specific contribution over the prior art. The new bill also limits the availability of treble damages.

Other proposed changes include:

- Granting Federal Circuit jurisdiction over interlocutory appeals
- Allowing assignees to file patent applications on behalf of inventors
- Creating a post-grant review process:
  - Within 12 months of issuance
  - Based on any invalidity grounds
- Replacing interference procedures with reexaminations and post-grant trials
- Allowing third parties to submit prior art during examination
- Changing venue requirements to stem forum shopping

Although many of the provisions are mirror images of those previously proposed, several proposals are noticeably absent from the current legislation. For example, sections changing the inequitable-conduct standard, adding an 18-month publication requirement and requiring a mandatory search report have all been removed from the Patent Reform Act of 2009.