

# Patent Reform and the 110<sup>th</sup> Congress: Who Favored What?

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Issue	House Bill H.R. 1908	Senate Bill S. 1145	Bush Administration	Coalition for Patent Fairness (IT, software, financial industry)	21st Century Patent Coalition (pharma, biotech, medical devices, manufacturers)	Intellectual Property Owners Association	Labor	Others – The Innovation Alliance, Universities, Venture Capital
<b>First Inventor to File</b>	Changes the U.S. to a first-inventor-to-file system	Similar to House	Supports conversion with grace period recognized by trading partners	Supports	Supports global harmonization	Supports	Neutral	Similar to Administration position
<b>Apportionment of Damages</b>	Provides various royalty models for courts: a) entire market value; b) economic value attributable to patent; or, c) relevant factors such as nonexclusive licensing arrangements.	Provides various royalty models for courts: a) entire market value; b) established royalty from licensing; or, c) economic value of invention over prior art	Opposed to every re-formulation of damages that has been on the table thus far. Does not support dramatic change that “limits the courts’ discretion.” Concerned about de-valuing patents	Supports	Opposes House and Senate language	Supports codification of damages, but proposed alternative language	Opposed House and Senate language	Opposed House and Senate language
<b>Post grant opposition</b>	Creates 1 <sup>st</sup> window for post-grant review	Creates a 1 <sup>st</sup> window and 2 <sup>nd</sup> window for filing post-grant opposition within 12 months of infringement - must show challenged claim causes “significant” economic harm	Supports a one-year window and limited 6-month second window based on notice of infringement and showing of substantial economic impact	Supports wide open second window	Supports “open review” process promptly after grant	Supports House language	Neutral	Does not support a new post-grant review regime. Prefers to perfect the reexamination process

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<b>Inequitable Conduct</b>	Codifies the current PTO “important to a reasonable examiner” standard	Same as House	Supports reform to discourage its use as a litigation tactic while preserving sanctions for true fraud	Resistant to change. Likes having IC as negotiation leverage when defending infringement lawsuits.	Supports ending the unenforceability defense based upon “inequitable conduct”	Opposes	Neutral	Supports reasonable reform. Hasn’t made it a top priority.
<b>Best Mode Requirement</b>	Prohibits using best mode as basis for an invalidity action in either litigation or as part of a post-grant opposition proceeding	Not addressed	Do not recommend any changes to available defenses or the underlying best mode requirement	Supports eliminating best mode requirement	Supports eliminating best mode requirement	Supports eliminating best mode requirement	Neutral	Supports eliminating best mode requirement
<b>Tax Method Patentability</b>	Bans tax patents, but provides exception for tax planning software patents	Not addressed	Should be handled within current confines of patentability requirements	Supports	Has concerns	Opposes	Neutral	Has concerns
<b>Willful Infringement</b>	Higher standards for finding willfulness	Same as House	Supports, but views as unnecessary due to <i>Seagate decision</i>	Supports higher standards and diminishing the likelihood of enhanced damages	Supports	Supports	Opposed	Opposed
<b>Applicant Quality Submissions</b>	Director of USPTO is required to issue regulations that require patent applicants to submit search reports and other information and analysis relevant to patentability	Director may issue such regulations	Strongly supports more applicant participation in the examination process. Believes AQS should be required	Opposed	Opposed	Opposed	Opposed	Opposed

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<b>Venue</b>	Prohibits patent litigants from manufacturing venue by assignment, incorporation, or otherwise to invoke the venue of a specific federal district court	Similar to H.R. 1908	Supports limitations to forum-shopping	Standards should preclude forum-shopping	Has concerns with venue provisions	Supports limiting forum-shopping	Neutral	Supports limitations to forum-shopping