

# Patent Reform: What's in the Bill(s)?

(highlighting major changes between drafts)



## HOUSE

### **H.R.5096 (PDQ Act)** –Berman/Boucher-**April 5, 2006**

- Post-Grant Opposition Proceeding (Sec. 2)
- Publication of Application after 18-Mos (Sec. 3)
- Submissions by 3rd Parties (Sec. 4)
- *Inter Partes* Reexamination (Sec. 5)
- Willful Infringement (Sec.6)
- Transfer of Venue (Sec. 7)
- Injunctions (Sec. 8)

### **Industry Coalition “Redline”** – **Sept. 1, 2005**

- First-Inventor-to-File (Sec.3)
- Definition of Prior Art Revisions (Sec.3)
- Assignee Filing (Sec.4)
- Best Mode Requirement Repeal (Sec.4)
- Duty of Candor in Front of the USPTO (Sec.5)
- Apportionment of Damages (Sec.6)
- Willful Infringement (Sec.6)
- Publication of Application after 18-Mos (Sec. 7)
- Prior User Rights (Sec. 7)
- *Inter Partes* Reexamination (Sec. 7)
- Post-Grant Opposition Proceeding (Sec. 7)
- Submissions by 3rd Parties (Sec. 8)
- Transfer of Venue (Sec. 9)

*Added: Repeal 271(f)*

### **Chairman’s Substitute Amendment** – **July 26, 2005**

- First-Inventor-to-File (Sec.3)
- Definition of Prior Art Revisions (Sec.3)
- Assignee Filing (Sec.4)
- Best Mode Requirement Repeal (Sec.4)
- Duty of Candor in Front of the USPTO (Sec.5)
- Apportionment of Damages (Sec.6)
- Willful Infringement (Sec.6)
- Publication of Application after 18 Mos (Sec. 7)
- Prior User Rights (Sec. 7)
- *Inter Partes* Reexamination (Sec. 7)
- Post-Grant Opposition Proceeding (Sec. 7)
- Submissions by 3rd Parties (Sec. 8)
- Venue (Sec. 9) – *new provision*

*Removed: Injunctions, Continuation Applications*

### **Original Bill** - **H.R. 2795, The Patent Reform Act of 2005 (as introduced, April 4, 2005)**

- First-Inventor-to-File (Sec.3)
- Definition of Prior Art Revisions (Sec.3)
- Assignee Filing (Sec.4)
- Best Mode Requirement Repeal (Sec.4)
- Duty of Candor in Front of the USPTO (Sec.5)
- Apportionment of Damages (Sec.6)
- Willful Infringement (Sec.6)
- Injunctions (Sec. 7)
- Limiting Continuation Applications (Sec. 8)
- Publication of Application after 18 Mos (Sec. 9)
- Prior User Rights (Sec. 9)
- *Inter Partes* Reexamination (Sec. 9)
- Post-Grant Opposition Proceeding (Sec. 9)
- Submissions by 3rd Parties (Sec. 10)

## SENATE

### **S.3818 – Hatch/Leahy Bill** – **Aug. 3, 2006**

- First-Inventor-to-File (Sec.3)
- Definition of Prior Art Revisions (Sec.3)
- Assignee Filing (Sec.4)
- Apportionment of Damages (Sec.5)
- Willful Infringement (Sec.5)
- **Attorneys Fees/ Loser Pays provision (Sec. 5)**
- Unenforcability (Sec.5)
- Prior User Rights (Sec. 5)
- Repeal of 271(f) (Sec. 5)
- Publication of Application after 18-Mos (Sec. 7)
- Post-Grant Review Proceeding (Sec. 6)
- Submissions by 3rd Parties (Sec. 7)
- Venue (Sec. 8)
- **Interlocutory Appeals for Claim Construction Cases (Sec. 8)**
- **Enhanced Rule Making Authority (Sec. 9)**
- *Inter Partes* Reexamination (Sec. 9)

**BOLD/BLUE = Provisions not seen in House Proposals**