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## The America Invents Act Makes U.S. One Step Closer to First-to-File System

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**Keywords**  
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by Aaron Gleaton

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After the House of Representatives failed to pass patent reform legislation in 2007, the Senate has finally passed the America Invents Act. This new bill will effectively revamp current patent law and move toward harmonizing U.S. patent law with the patent laws of other countries. Most notably, the Act will shift the focus of §102 from the date of invention to the filing date, thereby transforming the U.S. first-to-invent system to the widely adopted first-to-file system, used by nearly every other country in the world. Therefore, a patent will no longer be issued if “the claimed invention was patented, described in a printed publication, or in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention.”

This amendment is huge for U.S. patent law. By amending §102, Congress is effectively harmonizing U.S. patent law with that of other nations. The implications of a first-to-file system will be beneficial in limiting the contentious determinations of competing inventors' invention dates and will simplify this determination by awarding the patent to the first inventor to file.

Opposing this legislation, some argue that a U.S. first-to-file system would hinder rather than further patent law and result in bias against small businesses, meanwhile favoring larger corporations who have the resources to draft patent applications and proceed to the patent office first. Anticipating this concern, however, a part of the new bill mandates congressional studies be conducted to measure the effect the bill will have on small business. Specifically, S.23 seeks to determine “how the change would affect the ability of small business[es] to obtain patents and their costs of obtaining patents; whether the change would create, mitigate, or exacerbate any disadvantage for applicants for patents that are small business[es]... and whether the change would create any advantages

for [small business] applicants. . . .” Interestingly such an effect was not felt in other conversions, and it will be interesting to see if the U.S. will be any different.

Further, this move toward patent reform is another example of how the U.S. seeks to remain competitive in the IP field at a time when other economies seem to threaten the once U.S. dominated IP market. The Obama Administration's creation of the Intellectual Property Enforcement Advisory Committees and now Congress's move toward patent reform has furthered Obama's continued promise to keep the U.S. competitive in IP markets, and harmonizing our patent laws with that of other countries is important to Obama's mission.

Among the supporters of the new legislation are some major corporations such as Microsoft, GE, Exxon Mobile, and IBM. On the other side of the table sits Apple, Dell, Verizon, and Cisco, so it is safe to say that the House will likely be heavily pressured on each side of the debate. However, with a 95-5 vote in the Senate, this legislation is likely to pass, in one form or another. David Kappos, Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office (USPTO), is hopeful and states that the USPTO “look[s] forward to further action in the House, which will help deliver a 21st Century patent system that better equips the USPTO to move innovative ideas with sound patent protection to the marketplace. We urge the House of Representatives to act on this legislation quickly, so that America's innovators can benefit from these reforms as they work to turn their ideas into new businesses and new jobs.”

