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May 12, 2011

The Honorable Lamar Smith
Chairman, Committee on the Judiciary
U.S. House of Representatives
Washington, D.C. 20515

Dear Mr. Chairman:

On behalf of the Section of Intellectual Property Law ("Section") of the American Bar Association, I write as Chairperson to express the Section's views on H.R. 1249, the America Invents Act, which was ordered favorably reported by the Committee on the Judiciary on April 14th. I note, however, that the views expressed in this letter have not been submitted to or approved by the American Bar Association House of Delegates or Board of Governors, and should not be considered to be views of the American Bar Association.

Six years ago when you launched the patent law reform effort, our Section was honored to be asked by you to join with other groups in identifying areas of patent reform for your consideration. We are pleased to see that many of the reforms to the U.S. patent system, long supported by the Section, are included in H.R. 1249.

We accordingly wish to take this opportunity to comment specifically on provisions of H.R. 1249 that may be the subject of further proposals for change when the bill is taken up in the House of Representatives, or in reconciliation of the bill with S. 23, of which we see no need for change.

- The Section together with the American Bar Association supports the much-needed improvement in the U.S. patent system represented by the first-inventor-to-file provisions in H.R. 1249. For many years leading up to the end of the 20th century, the American Bar Association's support was conditioned on its inclusion in an international patent harmonization package. However, a decade ago the American Bar Association House of Delegates reviewed the matter anew and determined that transition of the United States to a first-inventor-to-file system was needed as a best practice, and need not be tied to harmonization.

  We understand that some are still expressing concern that this transition may not be in the interests of the United States, especially our independent inventor community. We believe that these concerns have been exhaustively addressed in the development of H.R. 1249, and that no further changes in the first-inventor-to-file provisions are needed.

- Since 2005, with the introduction of H.R. 2795, each of the patent reform bills in Congress has provided for an inventor's grace period, distinguishing our efforts at patent reform from the laws of most countries outside the United States that provide

no comparable degree of protection for an inventor who makes a public disclosure of an invention during the year before seeking a patent. We believe that the "grace period" language currently in H.R. 1249 maintains this protection and that no changes in the provisions of the bill relating to Section 102 are needed. Any remaining questions should be able to be clarified in the legislative history, such as was provided in the Senate to clarify Section 102 provisions in S. 23 that are identical to those in H.R. 1249.

- Recent suggestions have been made that H.R. 1249 should be amended to add further provisions on "prior art," creating new grounds on which to defeat an inventor's ability to obtain a valid U.S. patent. Particularly, proposals have emerged that secret uses and secret offers for sale of an invention be made patent-defeating. In developing our comprehensive *White Paper on Patent Law Reform*, the Section considered and rejected these types of "secret prior art" as inappropriate once a first-inventor-to-file principle is incorporated into U.S. patent law. We therefore believe that you were correct in not including these provisions in H.R. 1249 and urge you to oppose any efforts to include them in further consideration of the bill.

We greatly appreciate the opportunity to offer these further comments on H.R. 1249 and would be pleased to discuss any of these issues with you or your staff at any time.

Very truly yours,

Marylee Jenkins
Chairperson
Section of Intellectual Property Law
American Bar Association