**AMERICAN BAR ASSOCIATION**

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Dear Senator:

This week the Senate will be considering S. 23, the "Patent Reform Act of 2011." I am writing to express the support of the Section of Intellectual Property Law of the American Bar Association for Senate approval of S. 23, and our opposition to any amendment that may be offered to strike the "first-inventor-to-file" provisions of the bill. These views have not been considered by the American Bar Association's House of Delegates or Board of Governors and should not be considered to be views of the American Bar Association.

S. 23 is a bi-partisan product of six years of study and development within the Judiciary Committee. By necessity, it contains a number of provisions that are the result of negotiation and compromise and it is unlikely that all of the Judiciary Committee co-sponsors favor each and every provision. We too would have addressed some issues differently. However, the perfect should not be the enemy of the good and we believe that this is a good bill. S. 23 and S.515, its close predecessor in the 111th Congress, are the only bills that we have endorsed in the six years that we have been following this legislation. The enactment of S. 23 would substantially improve the patent system of the United States and we support that enactment.

At the same time, we want to express our strong opposition to an amendment that may be offered to strike the provisions of S. 23 that would switch the U.S. patent system to one that awards a patent to the first inventor who discloses his invention and applies for a patent ("first-inventor-to-file"), rather than awarding a patent based on winning the contest to show the earliest date of conception or reduction to practice of the invention ("first-to-invent").

The United States is alone in the world in retaining the first-to-invent system. While a first-inventor-to-file system encourages inventors to file for a patent and disclose their inventions at an early date, the first-to-invent standard increases opportunity for competing claims to the same invention, and facilitates protracted legal battles in administrative and court proceedings, which are extremely costly, in both time and money.

Some have long thought that small and independent inventors would be disadvantaged in a first-inventor-to-file environment and that competitors with more resources might learn of their inventions and get to the U.S. Patent Office first with an application. This current legislation, however, makes it clear that the award goes to the first *inventor* to file and not merely to the first person to file.

Equally important, recent studies show that, under the present U.S. patent system, small and independent inventors who are second to file but who attempt in the U.S. Patent Office and court proceedings to establish that they were the first to invent, actually lose more patents than they would obtain had the United States simply awarded patents to the first inventor to file.

Moreover, since 1996, an inventor based in the United States faces a much more difficult task of ever obtaining a patent. For inventions made after 1996, the U.S. patent system has been open to proofs of inventions made outside the United States—creating for many U.S.-based inventors a new and potentially even more expensive obstacle to obtaining a patent under the current first-to-invent rule.

Finally, U.S. inventors more and more are facing the need to file patent applications both at home and abroad to remain competitive in our global economy. Requiring compliance with two fundamentally different systems places undue additional burdens on our U.S. inventors and puts them at a competitive disadvantage in this global economy.

We urge you to support enactment of S. 23 and to oppose any amendment to strike the "first-inventor-to-file" provisions.

Sincerely,

Marylee Jenkins
Chairperson
Section of Intellectual Property Law