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Patent Reform Clears the Senate: Debate over First-to-File Patent System Moves to the House

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The America Invents Act, formerly the [Patent Reform Act of 2011](#), cleared an important legislative hurdle on March 8, 2011, when the U.S. Senate passed the bill with a bipartisan vote of 95 to 5. Although certain provisions were amended before passage, the Senate retained a key provision that would move the United States to a first-to-file patent system. The bill now heads to the House for consideration.

This first-to-file system would grant priority of invention to the first inventor who files a patent application with the U.S. Patent and Trademark Office. While most countries have already adopted the first-to-file system, the United States is an exception in that it currently uses the first-to-invent system.

In contrast to the proposed reform, the current U.S. system grants priority to an inventor who first conceives of the invention, instead of an inventor who first files the patent application. This priority is contingent, however, on the first inventor's reasonable diligence in reducing the invention to practice. Under the current system, priority disputes arise between parties regarding alleged dates of conception and adherence to the diligence rule.

Supporters of the bill argue that U.S. innovation is falling behind other countries in part because of the first-to-invent system. Urging reform, Senator Patrick Leahy (D-VT) stated that a dispute to resolve priority of invention "typically costs at least \$400,000 in legal fees and even more if the case is appealed. By comparison, establishing a filing date through provisional application to establish priority of invention costs just \$110."

While the bill received strong bipartisan support, not everyone is on board with reforming the patent-filing system. Senator Dianne Feinstein (D-CA), for example, proposed an amendment to strip the bill of the first-to-file reform. In support of the amendment, Senator Reid (D-NV) argued that the current system "comports with the reality of small entity financing through friends, family, possible patent licensees, and venture capitalists. The [current system] allows small inventors to have conversations about their invention and to line up funding before going to the considerable expense of filing a patent application." The Feinstein amendment failed by a vote of 87 to 13, and the patent-filing reform remains a part of the bill that the House will consider.

The [summary](#), [full text](#), and [present status](#), of the bill can be found on the Library of Congress's legislative information website, THOMAS.

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