

Patent Reform in the Deep Freeze

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Change doesn't happen over night and in the case of patent law in the United States—it doesn't even happen over the course of several years. As we enjoy the warmth of summer, the patent reform movement, both in terms of legislation and rule-making, appears to be frozen in its tracks. Here's a summary of what has happened over the past several months.

Tafas and GlaxoSmithKline v. Dudas

On April 1, 2008, Judge Cacheris of the Eastern District of Virginia permanently enjoined the United States Patent & Trademark Office (USPTO) from implementing the controversial final rules on claims and continuations package as published on August 21, 2007. The Court found that the USPTO does not have substantive rule-making authority and that the proposed final rules were substantive rule changes, not procedural rule changes as the USPTO had argued.

Speculation was abound regarding what the USPTO's next move would be. We found out on May 7, when the patent office filed a Notice of Appeal with the Court of Appeals for the Federal Circuit, challenging Judge Cacheris' ruling. Unless the Court of Appeals is incredibly speedy, it is unlikely that the matter will be resolved before the next Presidential administration is in place.

In addition to the final rule on claims and continuations, the USPTO has several other proposed rule changes "in the oven." The most anticipated of which relate to limits on the number of references cited in an Information Disclosure Statement. Other significant rule changes relate to appeals and how they are handled. Given the outcome of the claims and continuations final rules launch, it is likely that the USPTO will not attempt to promulgate further rule changes until after there is a change in administration.

Patent Reform Act

The Patent Reform Act debate has been simmering over the past few years, but is currently stalled over the Senate's inability to reach a compromise on apportioned damages. The White House has since continued to urge the Senate to keep working on the bill while noting that changes to the damages provisions are not favored by the administration.

The best guess is that if the Senate does return to patent reform, it would not do so until the lame duck session after the election. Otherwise, patent reform will probably be moved out at least another year.