

Fifty Ways To Leave Your Lover And Nine Ways To Attack Patents

Article By:

As a “quick guide” to the **Patent Reform Bill**, [H.R. 1249](#), that will soon become law, these are the **sections of the Act and of the present statute that will all be, or remain effective**, upon enactment, to facilitate blocking the issuance of applications or cancellation of objectionable claims. I will try to be brief, but it is not easy. **Section references are to section of the Bill; “s.” references are to sections of 35 U.S.C.**

1. Sec. 3: **Derivation proceedings** (This replaces s. 291 – **Interfering patents**)
2. Sec. 6: Citation of prior art and written statements (Modifies s. 301 – Citation of **prior art** in an issued patent).
3. S. 302-307 – “**Old**” **ex parte reexamination** is not affected by Bill. (But, remember, ex parte reexamination is essentially unused now.)
4. S. 251-253. Reissue section is unscathed.
5. Sec. 6: **Inter partes review** (Substantially modifies inter partes reexamination – must wait to file until after “opposition period” for post-grant review).
6. Sec. 6: s. 321: **Post-grant review** (This is the new “opposition” section – must be filed within 9 mos. of issuance.)
7. Sec. 8: Adds s. 122(e) to permit **preissuance submissions of art** by third parties.
8. Sec. 12: Adds s. 257: “**Supplemental examination to consider, reconsider, or correct information.**” Commentators have noted that these proceedings will permit patent owners to purge “fraud,” but there are exceptions.
9. Sec. 18: Transitional post-grant review proceeding for review of validity of **business method patents** – Can be initiated by defendant in civil suit.

Since reissue, ex parte reexamination, and supplemental examination are owner-initiated, perhaps I should have titled this post, “Nine Ways to Limit Patent Protection”, but then I would have had to list sections involving **limiting false marking suits** and the **ban on patenting human organisms**. I hope that this will help you locate specific parts of the Bill and of 35 USC as the commentary begins to pile up. As Prof. Hal Wegner summarizes this array:

“A major feature of the [Bill] is the creation of a variety of new post-grant review procedures. The difficulty with both the current and the new procedures results in part from the fact that essentially nothing is being taken away while time consuming procedures are added to the

burden of the upper end professionals at the Patent Office, all at a time when the Board is slowly sinking into an ever greater backlog.” (H.C. Wegner, The 2011 Patent Law: Law and Practice, Version 5.0, Sept. 8, 2011).

Hear! Hear! And, by the way, the Patent Office Board of Appeals and Interferences is now “The Patent Trial and Appeal Board.” Check out its duties at Section 6 of the Bill.

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