FRANKLIN PIERCE LAW CENTER
SUMMER 2002

LEGISLATIVE ASPECTS OF INTELLECTUAL PROPERY LAW

EXAM TAKE-HOME PROJECT

[To be turned in to the Register's Office by Close of Business, Monday, July 8, 2002]

Upon the strong recommendation of the adjunct faculty of PierceLaw, you have been hired as General Counsel and Chief of Staff of the Subcommittee on Courts, Intellectual Property and the Internet, House Committee on the Judiciary. The Subcommittee Chair, Congressman Coble of North Carolina, is concerned that U.S. patents are being granted by the U.S. Patent and Trademark Office ("USPTO") in cases in which industry and academia are aware of prior art that was not considered by the examiners.

Chairman Coble asks you to draft (1) a bill and (2) a section-by-section analysis of the draft bill. The purpose of the bill is to provide an effective form of post-grant review of issued patents. He hands you Exhibit A, a statement of goals defined by the USPTO and asks you to adopt as many of those features as you think would be appropriate.

In response to your question on whether to retain the present forms of reexamination under 35 U.S.C. sections 301-307 & 311-318, the Chairman tells you to do "what you think is right," but to be very clear about what you recommend in your drafts.

For the purpose of this take-home project, please draft (1) the bill and (2) the section-by-section analysis of it to respond to the Chairman's request. You may use as models for your draft legislation and sectional analysis anything that you have considered during this course, including materials included in the syllabus, plus anything else that you may find on the THOMAS website.

EXHIBIT A

Essential Elements of the Cancellation Proceeding

- Public May Petition for Cancellation of Patent within One Year of Issue Date
- Parties Threatened with Litigation May Petition for Cancellation at Any Time
- Petitioner Must Make Initial Showing to Avoid Harassment of Patentee
- Inter Partes Adjudication Not Reexamination
- Cases Heard by the Patent Board
- Discovery and Live Cross-Examination Allowed
- Individual Claims May Be Challenged without Reconsideration of Whole Patent
- Patentee May File One Narrowing Amendment
- Questions of Enforceability Are Not Considered
- Goal: Decision on the Merits Within One Year
- Appeal to the Federal Circuit Only From a Final Decision After Full Proceeding