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American Chemical Society

OFFICE OF THE
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February 8, 1980

The Honorable Birch Bayh
Chairman
Subcommittee on Constitution
Committee on the Judiciary
United States Senate
Washington, D.C. 20510

Dear Senator Bayh:

I have been authorized by the Board of Directors of the American Chemical Society to bring to your attention the views of the Society on S.1679, the "Patent Law Amendments of 1979."

For many years, the American Chemical Society has closely followed the proposals in the Congress for modification of the patent laws. The Society has repeatedly expressed the view that in order to strengthen issued patents, an inter partes proceeding within the Patent and Trademark Office would be highly desirable. Our position is based on the conviction that if opposing parties were given the opportunity to participate in the examination process, the integrity of issued patents would be restored, and the presumption of validity, which has been so severely weakened as a result of ex parte examination of applications, would be strengthened.

Therefore, the ACS supports the principle of reexamination embodied in S.1679. The Society strongly believes that there is a need for enlightened examination of presumptively valid patents which would take into consideration all available evidence. In this way, the ends of justice and the need for a strong patent system would simultaneously be served.

The Society is aware that since our last statement on the issue of reexamination, June 2, 1975, to the Honorable John L. McClellan, then Chairman of the Senate Subcommittee on Patents, Trademarks and Copyrights, the Patent and Trademark Office has revised its internal rules to provide for protests and prior art citations by the public (37 CFR §1.292), as well as to modify reissue practice (37 CFR §1.171-1.179). These changes have helped to "open up" the examination process to participation by those most interested in challenging a particular patent. As a result, the examiner is now more likely to have all relevant prior art and bars presented in an original protest or a reissue application.