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REMARKS:
Introduced by Mr. Kastenmeier

THE PATENT AND TRADEMARK OFFICE PROCEDURES IMPROVEMENT ACT OF 1983

HON. ROBERT W. KASTENMEIER
OF WISCONSIN
IN THE HOUSE OF REPRESENTATIVES

Thursday, November 17, 1983

● Mr. KASTENMEIER. Mr. Speaker, today, I—having been joined by the ranking minority Member of my subcommittee (Mr. MOORHEAD)—am introducing the Patent and Trademark Office Procedures Improvement Act of 1983.

The bill is derived from an executive communication dated July 18, 1983 sent to you, Mr. Speaker, from the Secretary of Commerce, Malcolm Baldrige. Although I take no position on the bill at this time, I find the proposal to be a serious one, deserving of our scrutiny.

The general purpose of the bill is to amend the patent laws to improve administrative proceedings in the Patent

and Trademark Office of the Department of Commerce for determining who is the first inventor of a given patentable invention. At present, these proceedings are known as interference proceedings. They are conducted in the Patent and Trademark Office between two or more adverse patent applicants or between one or more patent applicants and a patentee, all of whom are claiming the same patentable invention. Under existing law, the tribunal responsible for determining who is the first inventor, a Board of Patent Interferences, is not authorized to address all questions of patentability of the invention. This restriction on the Board's jurisdiction unduly complicates the procedures for obtaining patents for applicants involved in interference proceedings. By combining the Board of Patent Interferences with an existing board having patentability jurisdiction—the Board of Appeals of the Patent and Trademark Office, procedures for patent applicants and patentees involved in interferences will be simpler, more expeditious, and less costly. The merger of the Board of Patent Interferences with the Board of Appeals will also provide a uniform standard of patentability for the Patent and Trademark Office.

The proposed legislation is desinged to secure the just, speedy, and inexpensive determination of every interference action. See, for example, rule 1, Federal rules of civil procedure. Hearings will have to inquire whether this important standard is met.

A brief sectional analysis of the proposed legislation follows:

SECTION 1

This section provides a short title for the act.

SECTION 2

This section changes the name of the Board of Appeals to the Board of Appeals and Interferences. The Board of Appeals and Interferences, in addition to performing the tasks by the Board of Appeals of reviewing adverse decisions of examiners on patent applications and of a board of patent interferences of determining priority of invention, will also determine patentability of invention in interferences.

SECTION 3

This section changes the name of the Board of Appeals to the Board of Appeals and Interferences. The $100 fee for requesting an oral hearing for appeals is not extended to requests for oral hearings in interference proceedings.

SECTION 4

This section changes the name of the Board of Appeals to the Board of Appeals and Interferences.

SECTION 5

This section authorizes the Board of Appeals and Interferences to resolve questions of both priority and patentability of invention in interferences. Consideration of both questions in an interference will permit the Board to resolve all issues arising in the interference and will more promptly settle the rights of the parties in the interference. The change to section 135(b) is intended to make clear that a patent applicant is barred from obtaining a claim copied from a patent unless the applicant presents the claim within 1 year from the date the patent issued.

SECTION 6

This section replaces the references to the Board of Appeals and the Board of Patent Interferences with references to the Board of Appeals and Interferences, and makes the necessary conforming changes with respect to appeals of decisions under sections 134 and 135. As the Board of Appeals and Interferences will be addressing questions of priority and patent ability of invention in interferences, appeals may be taken from final decisions of the Board on both questions.

SECTION 7

This section replaces references to the Board of Appeals with references to the Board of Appeals and Interferences. A conforming change continues to limit review under this section to decision on ex parte matters arising under 35 U.S.C. 134.

SECTION 8

This section replaces the reference to the Board of Patent Interferences with a reference to the Board of Appeals and Interferences. As the Board of Appeals and Interferences will be addressing questions of priority and patentability of invention in interferences, remedy by civil action may be had with respect to final decisions of the Board on both questions.

SECTION 9

This section replaces the reference to the Board of Appeals with a reference to the Board of Appeals and Interferences.

SECTION 10

This section replaces the reference to the Board of Appeals and the Board of Patent Interferences with a reference to the Board of Appeals and Interferences.

SECTION 11

This section replaces the references to the Board of Patent Interferences with references to the Board of Appeals and Interferences.

SECTION 12

This section replaces the references to the Board of Patent Interferences with references to the Board of Appeals and Interferences.

SECTION 13

This section provides that the individuals serving as examiners-in-chief of the Board of Appeals and the examiners of interference of the Board of Patent Interferences on the effective date of the act shall continue in office as members of the Board of Appeals and Interferences.

SECTION 14

This section provides that the act shall take effect 90 days after enactment.

In conclusion, I commend a reading of this bill to my colleagues.●