

**LEAHY-SMITH AMERICA INVENTS ACT**

**SECTION 6 – POST-GRANT DISPUTES**

**OBSERVATIONS CONCERNING PROBLEMS TO BE ADDRESSED**

I.

As a patent attorney representing university technology transfer and individual inventors, I am concerned that the one year time frame for the proceedings and availability of discovery under §§316 and 326 create a potential for overwhelming owners of licensable technologies with limited resources.

II.

Joinder and merger under §§315 and 325 and submissions by anonymous third parties under §301 have the potential to create never ending proceedings which creates uncertainty for patent owners and the public, and the potential for abuse (e.g., sidestepping petitioner time limits).

III.

Derivation proceedings and the increasing frequency with which patents change hands create the potential for questionable default judgments due to out-of-date PTO correspondence and assignment records. Absence of the patent owner in the proceedings may undermine the intended *res judicata* effect of the final decision.

IV.

Submitting and arguing amendments to the claims on a claim-by-claim basis has the potential for creating a diffuse record of the proceedings and difficulties managing the proceedings.

V.

A lack of ability to amend the patent in response to developments in the proceedings has the potential of putting patent owners in a procedural trap.