

From: Mark Lemley
Sent: Friday, October 05, 2012 7:13 PM
To: Robert Merges
Cc: fitf_guidance; Till, Mary
Subject: Re: Comments on PTO 1st to File Guidelines

I write to provide public comments on "Examination Guidelines", Docket No.: PTO-P-2012-0024, 77 Fed. Reg. 43759 (July 26, 2012). Specifically, my comments concern the PTO's tentative conclusion that a secret commercial use by the patent applicant more than a year before filing will no longer bar that applicant from a patent. In so concluding, the proposed Guidelines take the position that the AIA has reversed an unbroken line of precedent of both the Federal Circuit and the regional circuits tracing back to Judge Learned Hand's decision in the Metallizing case. Those cases hold -- for impeccable policy reasons -- that the term "public use" in old section 102(b) should be interpreted to prevent an applicant from making a secret commercial use for more than a year while delaying the filing of a patent application. A contrary conclusion, as the PTO now proposes, will enable inventors to keep their process inventions secret for years or even decades, and then surface and file a patent application. That is directly contrary to the goals of first-inventor-to-file in the AIA, which encourage early filing of patent applications.

Concluding that Metallizing and the cases that follow it were abrogated will have another, even more pernicious effect. Metallizing, Gore v. Garlock, and other cases interpret the term "public use" in the old statute. One might reasonably conclude that those cases stretch the meaning of that term, but what the courts said they were doing was interpreting "public use." The term "public use" appears unchanged in new section 102 under the AIA. For the PTO to conclude that the new law opens the door to reinterpretation of the settled meaning of terms present in both the old and new statutes opens a dangerous door. Parties and courts might be expected to try to revisit the meaning of "on sale," "patented," "printed publication," and many other settled statutory provisions, creating enormous uncertainty. To take just one example, the inherency doctrine, like the Metallizing rule, is not articulated expressly in either the old or new statute. If the reenactment of the term "public use" opens the door to revisiting Metallizing, it also opens the door to revisiting inherency, the "ready for patenting" rule in on sale bar, and a host of other settled cases. The PTO, patent applicants, and litigants would be much better served by leaving existing precedent interpreting unchanged statutory terms in place.

The floor statement of two members of Congress articulating their personal intent, unexpressed in the statute, to overrule Metallizing should not change settled law. The PTO is not obligated to follow that personal intent, and it should not do so.

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