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Comments by
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TO: Mr. Jon P. Santamauro

Please disregard the PDF file we sent you in an earlier e-mail and accept instead our comments in the PDF file attached to this e-mail. The previous PDF file contained a number of errors, which are corrected in this submission.

Thank you for the indication that we could submit our comments by midnight local time. (It is now about 11:40 PM, 4/30/01.) This uniform time standard allowed the opportunity to identify and remove errors that might otherwise have caused confusion.

Again, please let us know if you have any problems opening this file so we can arrange an alternative. My telephone number is (480) 948-3295 if you would rather call than e-mail in that event.

Ed Suominen

**Comments on International Effort to Harmonize
the Substantive Requirements of Patent Laws**

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from Louis J. Hoffman and Edwin A. Suominen

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Mr. Suominen is an agent at Mr. Hoffman's law firm. He is an electrical engineer and an independent inventor with several patents and pending applications who became a patent agent several years ago as a result of observing the patent system in connection with his engineering work. Mr. Suominen graduated from the University of Washington with a B.S.E.E. in 1995.

Messrs. Suominen and Hoffman submit the following response to the request for comments on particular items related to international harmonization. These are not necessarily the positions of any particular client.

Issue #1: First to file vs. first to invent

The present first-to-invent rule is the "best practice" for the U.S. for a harmonized, global patent system, for at least the following reasons:

The Quality of Applications Will Suffer

We represent a variety of inventors and small businesses who often do not have the resources to file many applications. Our clients sometimes select when to file based on how close they are to concluding development of their products. When application filing occurs late in the product development cycle, the resulting patent application is more fully fleshed out, and hence more useful for public use later. Clients forced to operate under a first-to-file regime would likely react by filing more applications earlier in the cycle. Many such applications would contain only near-worthless disclosures of "dead ends," and others would omit substantial "best mode" information (developed after the early filing). This reaction would result in the following policy disadvantages:

(1) Higher cost to applicants. Applicants under a "first-to-file" system would file at many points in a product development cycle, leading to multiple applications at higher cost. Costs would increase as well because of faster filing.

(2) Increased risk. An applicant would not be able to feel secure until an application is on file.

(3) Less valuable quality of disclosure. From the point of view of the public, such hastily filed applications have less value when published and would likely be less useful to researchers using the patent system as a tool.

(4) Increased workload for the Patent Office. Already clogged examination pipelines would bog down further if applications are filed indiscriminately and hastily. Once having paid the filing fee, an applicant would have every reason to leave the application pending for examination through the first office action, at least, even if the applicant has changed the product to use a technology different from that in the application. In many instances when this happens, the applicant will allow “dead end” applications to go abandoned, but not until after seeing the first office action. The Office would become burdened with examining a higher percentage of applications that go abandoned for reasons other than the merits of the rejection. The consequent waste of resources would surely outweigh any savings from interference elimination touted by proponents of “first-to-file.”

Published articles have noted these disadvantages of the first-to-file system:

“A first-to-file system would force everyone to file abbreviated and hurried applications, some of which are bound to include incomplete and erroneous information.” Gabriel P. Katona, *First-to-File – Not in the United States*, 73 JPTOS 399, 401 (1991).

“The scientific community stands to gain much more from a patent based on a carefully prepared disclosure of a complete invention as [opposed] to a hastily written disclosure of a concept that is still in its infancy.” Coe A. Bloomberg, *In Defense of the First-to-Invent Rule*, 21 AIPLA Q.J. 255, 260 (1993).

“Many of the 600,000 Japanese applications [filed annually] are scraps of paper written by the inventors and submitted for a priority date. By contrast, current American practice has provisions which provide applicants with ample time to adequately prepare an application and more thoroughly develop the inventions through the collection of experimental data.” Note, *First-To-File: Is American Adoption of the International Standard in Patent Law Worth the Price?*, 2 Colum. Bus. L. Rev. 543, 573 n.155 (1988).

The Proportion of Applications in Which the First-to-Invent Rule Makes a Difference Has Been Understated

Under the first-to-file system, it may be possible to eliminate the costly and difficult interference process, applicable only to a few cases. However, some

commentators have suggested that interferences will still be required even under first-to-file system.

In addition, interference is only the tip of the iceberg. In approximately 3-5% of applications, the inventors establish priority by filing a Rule 131 affidavit or declaration. *Supra*, 2 Colum. Bus. L. Rev. at 580. In many other cases, inventors who cannot afford to file interferences conduct informal negotiations that eliminate the need for a formal interference proceeding. How Rule 131 could survive a first-to-file regime remains unclear, yet that rule is quite valuable to inventors in modern prosecution. Indeed, Mr. Suominen has received a patent after an extensive Rule 131 showing of his work over many late nights and weekends perfecting a radio receiver prototype in a university laboratory.

First-to-File Would Burden the Relationship Between Patent Practitioners and Clients

We practice in a small patent firm. In a first-to-file world, the client's opportunity to obtain protection might evaporate on any (unknown) day between conception and application filing. Under the present system, small patent firms with backlogs of work can (and of necessity must) work on new applications as time allows. Under first-to-file, every new application entrusted to a firm becomes an urgency that pits the client's interest in early filing against the interests of other clients, the interest of the PTO and the public in prompt responses to Office Actions, and the interests of all clients (and the public) in the filing of quality disclosures.

Why should clients' rights depend on their attorneys' calendars? Why should a patent agent or attorney be forced into a choice between rushing an application, thereby potentially missing important disclosure details that can be critical under U.S. law, and deferring the application to get it right, thereby potentially losing a client's priority date? Why should a client be forced to choose between a quality agent or attorney who has a backlog and a less-skilled practitioner who can handle the job immediately?

A first-to-file system would impose such unfortunate choices, while the first-to-invent system does not.

U.S. Constitutional Law Requires Maintaining the First-to-Invent System

As the attached paper by Mr. Suominen proves, the United States simply does not have the option of trading away its first-to-invent system, even if Congress and the Administration so desired. Our established system is mandated by the Constitutional command that Congress grant patent protection to "inventors" of "discoveries."

Issue #2: Patentable Subject Matter

We support the current law on “useful Arts.” The present patent system’s rules on non-obviousness make the “technical contribution” standard redundant.

To the extent that countries advocate for eliminating patenting in certain classes, whatever those may be, it would be useful to recall that an applicant can, by clever claim drafting, “design around” any such limitations. For example, before *State Street*, software methods could not be patented, but programmed computers could. It was *always* possible to rewrite a software program patent claim into a claim directed to a computer (machine) programmed to perform certain steps. Such “cosmetic claim drafting” makes any efforts to restrict patentable subject matter essentially futile. Such bars can have pernicious effects, too, such as hiding the “point of novelty.”

Issue #3: Disclosure Requirements

The usefulness of a patent system depends on what the interested public learns from its publication. Indeed, the very word “patent” means “open” or “public.” The present requirements, while often subject to undue post hoc second guessing, facilitate a prime goal of any patent system: Allowing any inventor to “stand on the shoulders” of another.

The U.S. forms of disclosure should parallel the decision on first-to-file vs. first-to-invent. In any first-to-file regime, these strict forms of disclosure would hinder the system.

Issue #4: Technical Fields in Claims

No comment.

Issue #5: Unity of Invention

The U.S. should adopt the “unity of invention” standard for examination. The present U.S. standards allow for nearly complete examiner discretion. It is too easy for an examiner who wishes to do so to satisfy the “independent and distinct” standard, and no effective and practical review procedure exists to challenge such decisions. The standard of “patentable distinction” leads to similar subjectivity and similarly lacks an effective review process.

By contrast, the “unity of invention” standards have been relatively well developed, and the process under the PCT works somewhat more smoothly in practice. A practitioner can better judge in advance, and predict with more accuracy than in U.S. practice, whether a division will be required.

Issue #6: Utility

No comment.

Issue #7: Global Priority Date

Negotiations to achieve common ground with respect to this subject would seem a better use of effort than switching to an unproductive and incompatible first-to-file system.

However, any global rules concerning priority dates must consider the collateral issue of the “on sale bar” for commercial exploitation of inventions, including the “one year grace period,” the “experimental use exception,” and the difference between commercial exploitation in the country in which a patent is sought and such activity outside that country.

Also, any negotiation should make a sharp distinction between filings made by the patent applicant (or an assignee) and filings made by a third party. The circumstances under which an applicant’s own work can be used against applicant must rightly remain limited. *See, e.g., In re Costello*, 212 U.S.P.Q. 389 (Fed. Cir. 1983); 35 USC 103(c) (amended by AIPA to exclude from prior art prior-filed applications of inventor’s assignee).

Issue #8: Multiple Patents

The rules on “secret prior art” lead to traps for the unwary, which make inventors suspicious of the patent system. The practice of other countries in allowing obvious variation patents filed at roughly the same time would likely promote inventiveness and improve the U.S. patent system.

Issue #9: One Year Grace Period

The U.S. rule on the “grace period” is wise and prudent. Good policy encourages commercial implementation before patent filing. Also, patent applicants who lack funds to make an application can often secure protection after limited commercialization or test marketing, to the benefit of the applicant and the system as a whole.

Also important to consider is whether activity in a foreign country can defeat a patent, where “foreign” means outside the country examining the patent application. Foreign law is widely dispersed on that issue.

Foreign countries having “absolute novelty” requirements often specify that *non-public* disclosures do not defeat a patent. The best system would blend this rule with the U.S. one-year grace period.

Issue #10: Geographic Restrictions on Prior Art

Logic might seem to support an even-handed view of *where* an invention is practiced before a patent invention or filing. However, a fair system should require some modicum of public disclosure and indexing before something qualifies as prior art. It is not fair to an applicant to have a patent defeated by action allegedly taken in a remote locale, when the applicant has limited ability to locate information about the specifics of the action taken, both in advance, when deciding whether to spend the money on filing, and afterwards, when an infringer without knowledge of the action proffers it as a defense.

Issue #11: Non-Public Exploitation

Foreign law is superior to U.S. law in stipulating that non-public commercial activity does not defeat a patent. Moving to the foreign system in this respect, in exchange for implementation of a one-year grace period, would encourage the use of the patent system to put into the public domain products and especially processes previously kept secret. If Coca-Cola decided to publish its famous formula, for example, such would benefit the public interested in using that information to improve cola beverages and would amply justify granting Coca-Cola a 17-year patent even after a protracted delay.

Issue #12: Multiple References

No comment.

Issue #13: Obviousness

No comment.

Issue #14: Multiple Dependent Claims

No comment.

Issue #15: Perimeter Claiming

Peripheral claiming should be maintained. However, Section 112(6) should be eliminated, or there should be another way to specify in a claim “any structure that performs the function of”

Issue #16: Doctrine of Equivalents

The doctrine should be preserved and restored to its former scope. The much-criticized rules imposed by *Festo* will not work, especially because identical claim language may now have different meanings depending on how it was reached.

Issue #17: Assignee Filing

Direct filing by assignees should be permitted, provided that the patent document identifies and acknowledges the inventors and provided that the assignee proves ownership.

RE-DISCOVERING ARTICLE 1, SECTION 8 - A UNIQUELY AMERICAN FORMULA FOR A FIRST-TO-INVENT PATENT SYSTEM

by Edwin A. Suominen¹

INTRODUCTION

In 1791, the earliest predecessor to the U.S. Patent Office considered adopting a first-to-file system to settle disputes between interfering patent applicants and chose not to do so.² In 1966, a President's Commission on the Patent System recommended adoption of a first-to-file system, and Congress rejected it after a negative reception by industry and bar associations.³ In 1990, the World Intellectual Property Organization (WIPO) published a "basic proposal" draft treaty that would have imposed a first-to-file system on all signatories, including the United States.⁴ This proposed "fundamental change" in U.S. patent law was met with active opposition, and no interested associations took a position in favor of it.⁵

Now, in 2001, the question arises yet again, as the U.S. continues to consider becoming a signatory to the latest edition of WIPO's harmonization treaty.⁶ The U.S. Patent Office requests comments on whether the U.S. should adopt a first-to-file system, which the treaty in its present form would require all signatories to do.

The U.S. should not, and must not, abandon the uniquely American, and uniquely successful, first-to-invent system of patent protection prescribed by Article 1, Section 8 of the U.S. Constitution and maintained for two centuries.

¹ Mr. Suominen is a registered patent agent and an independent inventor with several patents and pending applications. The author is indebted to Louis J. Hoffman, Esq. for editorial assistance, guidance, and support in writing of this paper.

² P. J. Federico, *Operation of the Patent Act of 1790*, 18 J. Pat. Off. Soc'y 237, 248 (1936).

³ Note, *First-To-File: Is American Adoption of the International Standard in Patent Law Worth the Price?*, 1988 Colum. Bus. L. Rev. 543, 544.

⁴ Edward G. Fiorito, *The "Basic Proposal" for Harmonization of U.S. and Worldwide Patent Laws Submitted by WIPO*, 73 JPTOS 83, 88 (1991).

⁵ *Id.* at 89.

⁶ Draft Substantive Patent Law Treaty, WIPO Doc. SCP/5/2 Prov. (Feb. 2001), available on the Internet at [www. http://www.wipo.int/scp/en](http://www.wipo.int/scp/en).

Several commentators have written many practical arguments against switching to a first-to-file system,⁷ and others will no doubt provide many more in response to the Office's Request for Comments. Although those arguments are certainly supportive of the Constitution's wisdom in establishing a clear mandate for a first-to-invent patent system, it is the constitutional mandate on which we focus here.

CONSTITUTIONAL TERMS OF RESTRICTION: "INVENTORS" AND "DISCOVERIES"

"At the outset it must be remembered," began the Supreme Court in its seminal patent case of *Graham v. John Deere Co.*⁸, "that the federal patent power stems from a specific constitutional provision which authorizes the Congress 'To promote the Progress of . . . useful Arts, by securing for limited Times to . . . Inventors the exclusive Right to their . . . Discoveries.'" In deciding the fate of three patents before it that day, the Court held that Article 1, Section 8, the Constitution's patent clause, "is both a grant of power and a limitation."⁹ Thus the Court observed that the patent clause is not merely an open-ended invitation for Congress to grant whatever patents it wishes to whomever it wishes.¹⁰

The Constitution thus authorizes Congress to secure exclusive rights for limited times only to "inventors," and only for their "discoveries."¹¹ This restricted authorization was recognized by the judiciary 24 years after ratification of the Constitution. In one of the "Steamboat Cases," the New York Court of Chancery observed that "the power given to Congress to promote the progress of science and useful Arts is restricted to the rights of authors and inventors."¹² Subsequent decisions

⁷ See Gabriel P. Katona, *First-to-File - Not in the United States*, 73 JPTOS 399 (1991); Coe A. Bloomberg, *In Defense of the First-to-Invent Rule*, 21 AIPLA Q.J. 255 (1993); *supra* note 3.

⁸ 383 U.S. 1 (1966).

⁹ *Id.* at 5.

¹⁰ See Edward C. Walterscheid, *Disparity Between the Patent Term and the Copyright Term*, 83 JPTOS 233, 249 (2001).

¹¹ See WILLIAM C. ROBINSON, *THE LAW OF PATENTS FOR USEFUL INVENTIONS* 69-70 (1890) ("The subject of the exclusive right must be a writing or discovery of the person to whom the right is granted . . . as to all other matters, Congress is supreme").

¹² *Livingston v. Van Ingen*, 9 Johns. 505, 564 (1812).

by the U.S. Supreme Court¹³ and other federal courts¹⁴ in the early nineteenth century affirmed this view.

Who then are the “inventors” contemplated by the constitutional language as being the only recipients of exclusivity? As Samuel Johnson defined the term in the framers’ era with his authoritative dictionary, and as the term is still understood today, an inventor is “one who produces something new; a devisor of something not known before.”¹⁵ Similarly, Johnson defined “To discover” as “to find things or places not known before.”¹⁶

The plain language of the terms would thus seem to settle the issue, clearly prohibiting any first-to-file system as unconstitutionally denying actual inventors the exclusive right to their discoveries. That is not the conclusion Edward C. Walterscheid has drawn.¹⁷ Walterscheid asserts that the constitutional language “does not preclude the granting of patent rights to one who is not the literal first inventor.”¹⁸ He bases this conclusion largely on (1) contemporaneous interpretation of the words, (2) the founders’ omission of the terms “true and first” from contemporaneous English law, and (3) spotty implementation of first-to-invent statutes in the early nineteenth century.

¹³ *Shaw v. Cooper*, 32 U.S. 292, 318-19 (1833) (“This [constitutional] power was exercised by congress . . . and from an examination of their various provisions, it clearly appears, that it was the intention of the legislature, by compliance with the requisites of the [constitutional] law, to vest the exclusive right in the inventor only”).

¹⁴ *Blanchard v. Sprague*, 3 Fed. Cas. 648, 650 (D. Mass. 1839) (Story, J.); *In re Kemper*, 14 Fed. Cas. 286, 287 (D.D.C. 1841) (citing Article 1, Section 8: “There it is evident that the ‘discoveries,’ the use of which is to be secured, are the discoveries of inventors only”).

¹⁵ SAMUEL JOHNSON, A DICTIONARY OF THE ENGLISH LANGUAGE (1787) as quoted by A. H. Seidel, *The Constitution and a Standard of Patentability*, 48 J. Pat. Off. Soc’y 1, 13 (1966). Seidel commented, “The present day meaning . . . can be considered the same, that is to bring into being something *new* as a product of one’s own contrivance” (emphasis in original).

¹⁶ *Id.* An alternate definition provided by Johnson (there are several) is “to make known; not to disguise; to reveal.” It could be argued, albeit somewhat implausibly, that the framers understood this archaic definition of the term to cover the act of disclosure associated with filing an application. However, *see* Seidel *supra*: “[I]t is firmly established in the patent law that “discoveries” has a more restricted meaning, as being the activity of an inventor.”

¹⁷ Edward C. Walterscheid, *Priority of Invention: How the United States Came to Have a “First-To-Invent” Patent System*, 23 AIPLA Q.J. 263, 281 (1995).

¹⁸ *Id.* at 283.

These views cannot withstand careful examination of Supreme Court precedent and ordinary methods of constitutional interpretation.

SUPREME COURT PRECEDENT ON “INVENTORS” AND “DISCOVERIES”

In 1870 the Court discussed how the term “inventors” in the patent clause should be interpreted. The Court sustained validity of several patents by emphasizing the role of patents as “public franchises,”

as a matter of compensation to the inventors for their labor, toil, and expense in making the inventions, and *reducing the same to practice* for the public benefit, as contemplated by the Constitution and sanctioned by the laws of Congress.¹⁹

It seems unlikely that the Court would have used language so tilted toward the activities of actual reduction to practice if it had considered the Constitution to contemplate “inventors” as including first filers who reduced to practice after late-filing first inventors had already undergone the “labor, toil, and expense in making the inventions.”

In an 1884 copyright case, the Supreme Court offered the following dicta interpreting the patent clause in *Burrow-Giles Lithographic Co. v. Sarony*.²⁰

In regard, however, to the kindred subject of patents for invention, they cannot, by law, be issued to the inventor until the novelty, the utility, and the actual discovery or invention by the claimant have been established.

The Supreme Court recognized in that case that early statutes, passed by the constitutional framers, established “almost conclusive” interpretation entitled to at least “very great weight.” Thus, what the first patent act of 1790 and its immediate successor of 1793 say about “inventors” and “discoveries” is critical to the analysis.

The Act of 1790 could not be more clear in its grant of exclusive protection to the first inventor. The Act begins as follows:

Be it enacted . . . that upon the petition of any person or persons . . . setting forth, that he, she, or they, *have or have invented or discovered any useful art, manufacture, engine, machine, or device, or any improvements therein not*

¹⁹ *Seymour v. Osborne*, 78 U.S. 516, 533 (1870) (emphasis added).

²⁰ 111 U.S. 53.

*before known or used . . . it shall be lawful to . . . cause letters patent to be made out . . .*²¹

It continues with language authorizing repeal of patents not granted in accordance with the requirements of the petition:

[I]f it shall appear that the patentee was not the *first and true inventor or discoverer*, judgment shall be rendered by such Court for the repeal of such patent or patents . . .²²

Finally, the Act contains language that deems issued patents or specifications as

prima facie evidence, that the said patentee or patentees was or were the *first and true inventor or inventors, discover or discovers* of the thing so specified. . .²³

The Act of 1793 begins with language similar to that in the introduction of the 1790 Act:

Be it enacted . . . that when any person or persons . . . shall allege that he or they have invented any *new and useful art, machine, manufacture or composition of matter, or any new and useful improvement on any art, machine, manufacture or composition of matter, not known or used before the application*, and shall present a petition . . . it shall and may be lawful . . . to cause letters patent to be made out . . .²⁴

It also added a requirement that

every inventor, before he can receive a patent, shall swear or affirm, that he does verily believe, *that he is the true inventor or discoverer of the art, machine or, or improvement*, for which he solicits a patent . . .²⁵

The 1793 Act contained an updated version of the 1790 Act's repeal provisions, authorizing repeal "if it shall appear, that the patentee was not the true inventor or discoverer."²⁶ In addition, it permitted a defendant to plead for a declaration of invalidity if, *inter alia*,

the thing, thus secured by patent, *was not originally discovered by the patentee*, but had been in use, or had been described in some public work *anterior to the supposed discovery of the patentee . . .*²⁷

²¹ Patent Act of 1790, § 1, 1 Stat. 109, 109-110 (emphasis added).

²² *Id.* at § 5, 111 (emphasis added).

²³ *Id.* at § 6, 111 (emphasis added).

²⁴ Patent Act of 1793, § 1, 1 Stat. 318, 318-19 (emphasis added).

²⁵ *Id.* at § 3, 321 (emphasis added).

²⁶ *Id.* at § 10, 323.

²⁷ *Id.* at § 6, 322 (emphasis added).

Finally, the 1793 Act added the first interference provision in U.S. patent law.²⁸

What language could better convey the desire of the First Congress to jealously guard the exclusive right for first inventors than its repeated use of the phrase “first and true inventor”? How could the Second Congress have better affirmed that same desire than by instituting an interference system²⁹ and protecting the patent rights of the “original discoverer” against use or public work that occurred *after* his own discovery, regardless of his filing date?³⁰ Can there thus be any doubt about the “construction placed upon the constitution” by the “men who were contemporary with its formation” in the Patent Acts of 1790 and 1793? Under the interpretation directed by the Supreme Court’s holding in *Burrow-Giles* and its required reference to the Patent Acts of 1790 and 1793, the Constitution authorizes granting of exclusive rights only to first and true inventors.

THE ORIGINALIST VIEW OF “INVENTORS” AND “DISCOVERIES”

With the literal text and binding precedent so firmly on the side of first-to-invent, it is difficult to sustain an argument for the constitutionality of first-to-file under any theory of interpretation. The founders’ “original intent” provides no consistent basis for an argument either way.

In the originalist view, the Constitution should be interpreted according to understandings made public at the time of its drafting and ratification.³¹ Walterscheid’s analysis appears to use this technique. An originalist analysis, however, does not

²⁸ *Id.* at § 9, 322-23 (emphasis added).

²⁹ Walterscheid states that was nothing in the language of Section 9 that obligated the arbitrators to award the patent to the first inventor. *See supra* note 19 at 306. But later he seems to contract this statement. *See Id.* at 318 (“Priority seems to have been generally viewed as requiring a determination as to who had invented first”). In any event, it is implausible that this omission was intended to give the arbitrators *carte blanche*. Section 9 does not recite *any* standards for the arbitrators, instead relying on the requirements set forth in the other portions of the Act for their guidance. One could just as well conclude that the arbitrators were free to award patents for inoperative or well-known devices, and such award would “be final, as far as respects the granting of the patent.” 1 Stat. 318, 323. This was surely not Congress’ intent, and the failure of the arbitrators to abide by it, which Walterscheid describes at length, does not lessen the precedential value of that intent under *Burrow-Giles*.

³⁰ *See Thompson v. Haight infra* note 46.

provide a clear answer to the question of who are “inventors” of “discoveries,” because there was no debate in the Constitutional Convention with reference to the patent clause, and no committee minutes reference it.³² Walterscheid himself acknowledges that “no delegate left any record as to what the Convention intended ‘inventors’ and ‘discoveries’ to mean.”³³

Much of Walterscheid’s analysis of the framers’ understandings thus cannot help but be highly speculative. For example, he states that the constitutional language “seemed to suggest” that the exclusive right could be granted to other than the literal true and first inventor because there “is no reason to believe that the framers were not conversant with the English common law interpretation ‘true and first inventor’ to include a first importer.³⁴ But an equally plausible explanation, in view of Samuel Johnson’s clear dictionary definition of the word “inventor,”³⁵ is that the framers simply chose to avoid redundancy.

As another example, Walterscheid attributes the Patent Board’s decision to reject a first-to-file interference system alternately to discomfort with deciding the actual filing date of petitions that were originally filed with Congress and to political pressure from the steamboat rivals Rumsey and Fitch.³⁶ However, Walterscheid admits that “that the board may have interpreted ‘inventor’ to mean the true and first, *i.e.* original, inventor in a literal sense.”³⁷

Speculation could easily support an opposite view, in the form of Madison’s apparent proposal for constitutional language securing “to inventors of useful machines

³¹ KEITH E. WHITTINGTON, CONSTITUTIONAL INTERPRETATION 35 (1999).

³² Karl Fenning, *The Origin of the Patent and Copyright Clause of the Constitution*, 17 Geo. L. J. 109, 112 (1929).

³³ Walterscheid *supra* note 17 at 281.

³⁴ *Id.*

³⁵ JOHNSON *supra* note 15.

³⁶ *Supra* note 17 at 291-92.

³⁷ *Id.* at 293.

and implements, the benefits therefore, for a limited time.”³⁸ The thoughtful originalist might thus discern, in that framer’s mind at least, an emphasis on actual reductions to practice rather than mere application filings. If Madison’s proposed language had been incorporated into the ratified Constitution, the result under an originalist interpretation may well have been the restriction of patent protection only to tangible “machines and implements” that had been shown to be useful, *i.e.*, actually reduced to practice. Clearly, only a first-to-invent system would be realistic where an application filing, without more, would be insufficient to obtain a patent.

THE MODERNIST VIEW OF “INVENTORS” AND “DISCOVERIES”

Some who would argue against a textualist or “original intent” interpretation of the constitutional term “Discoveries,” may advocate instead that the Constitution is a “living document adaptable to new situations”³⁹ and thus would not prohibit a first-to-file system. Clearly, however, no interpretation can be so expansive as to entirely vitiate a significant term in a constitutional requirement.⁴⁰ Patents simply cannot be granted to any but “inventors” for anything but “discoveries.”⁴¹

Even modernists, however, rely on “deeply embedded traditional ways of conducting government” to give meaning to the words of a text or even supply them.⁴²

What then, have been the “deeply embedded traditional ways” in which the U.S. government has granted exclusive rights to inventors for their discoveries? Perhaps the most enduring and consistently followed principle of American patent law has been to grant such rights to first and original inventors. The statutes and published decisions

³⁸ Fenning *supra* note 32 at 114. In attributing this language to Madison, Fenning cites a five volume *Documentary History of the Constitution of the United States Of America* published by the U.S. State Department between 1894 and 1900, and FERRAND, RECORDS OF THE CONSTITUTIONAL CONVENTION (1911).

³⁹ *Youngstown Sheet & Tube Co. et al. v. Sawyer*, 343 U.S. 579, 682 (1952) (Vinson, C.J., dissenting). Also, see WHITTINGTON *supra* note 31 at 196.

⁴⁰ GREGORY BASSHAM, ORIGINAL INTENT AND THE CONSTITUTION 93 (1992). Bassham, though generally eschewing the originalist view, quotes Thomas Jefferson as expressing concern about elected officials rendering the Constitution “a blank paper by construction.”

⁴¹ See *supra* notes 11-14.

⁴² *Youngstown*, 343 U.S. at 682.

found throughout the nearly two centuries of legal history since ratification of the Constitution are an important consideration.⁴³ In view of that “gloss which life has written upon” its words, the patent clause overwhelmingly favors a first-to-invent interpretation of its mandate.

We begin with the decision of the 1791 patent board to reject a first-to-file proposal, which is appropriate for two reasons. First, it was arguably the first administrative decision regarding such a proposal under the Constitution, which had been in effect only three years. Nothing could be considered more “deeply embedded,” or the start of a more “traditional way of conducting government” than that early decision.⁴⁴ Second, one of the three board members was Thomas Jefferson, whose influence on framing of the patent clause is well established.⁴⁵ (Indeed, his part in the decision could well reflect “original intent.”)

In 1826, the Circuit Court for the Southern District of New York observed that the whole law relating to patents, which remained essentially under the Act of 1793, could still be regarded as novel in the United States.⁴⁶ That state of affairs did not prevent the court from pointing out that

[i]t is very true that “the right to a patent belongs to him who was the first inventor, even before the patent is granted.” [No citation given.] That is, none but the first inventor can have a patent.⁴⁷

Shortly after the Act of 1839 (and less pertinent Acts of 1842, ‘46, ‘48, and ‘52)⁴⁸, another federal district court observed that

[n]o exclusive right can be granted for anything which the patentee has not invented or discovered. . . . the right of the patentee entirely rests on his invention or discovery of that which is useful, and *which was not known*

⁴³ Kenneth Burchfiel, *Revising the “Original” Patent Clause: Pseudohistory in Constitutional Construction*, 2 Harv. J. Law & Tech. 155, 209 (1989) (“In the effort to determine the original meaning of a constitutional term, as in any legal history, a *sine qua non* is consideration of the most coherent and persuasive available data, contained in statutes and published decisions”).

⁴⁴ Federico considered it “very unlikely that duplicate patents were granted [by the board] to the four steamboat claimants without deciding the question of priority.” *See supra* note 2 at 249.

⁴⁵ *Graham*, 383 U.S. at 7.

⁴⁶ *Thompson v. Haight*, 23 Fed. Cas. 1040, 1041.

⁴⁷ *Id.* at 1048.

⁴⁸ *See* ROBINSON *supra* note 11 at 78-79.

*before. And the law gives him the exclusive use of the thing invented or discovered, for a few years, as a compensation for 'his ingenuity, labor, and expense in producing it.'*⁴⁹

The court, in instructing the jury, addressed the question of whether the plaintiff, who had been issued a patent for his invention, had protection against issuance of a rival patent to the defendant under the early caveat system then still in effect:

[The plaintiff] is protected by the law [against issuance of a rival patent], unless the defendant's invention entitled him to a patent before the plaintiff applied for his patent.⁵⁰

Interestingly, the jury found for the defendant, evidently heeding the court's instruction that "the one who perfected his invention first" would be entitled to protection if both the plaintiff and defendant could properly be considered rival inventors. This case, then, is an example of a first applicant losing out to a first inventor under legislation enacted some 60 years after ratification of the Constitution.

First-to-invent maintained its steady hand on the course of American patent law through the remainder of the nineteenth century and into the twentieth. In 1920, the D.C. Court of Appeals affirmed an award of priority to an interference party who was first to conceive and first to reduce to practice.⁵¹ The court observed that the award was grounded on what had been the rule in the Patent Office since 1872, a rule that had received the approval of the court in earlier cases.⁵² Since then, it has never become the law that one who "invented" later but filed first would receive a patent against a first inventor who had not forfeited his rights.⁵³

⁴⁹ *Allen v. Hunter*, 1 Fed. Cas. 476, 477 (D. Ohio 1855) (emphasis added).

⁵⁰ *Id.* at 482.

⁵¹ *Erben v. Yardley*, 267 F. 345.

⁵² *Hubbard v. Berg*, 40 App. D.C. 577; *Thompson v. Storrie*, 46 App. D.C. 324.

⁵³ The first inventor can forfeit his constitutional rights by his action or inaction, just as the citizen can forfeit his constitutional rights (*e.g.*, to vote) by his actions (*e.g.*, felonious crimes). The statutory and common law has long cautioned the first inventor to act diligently lest he lose his rights. See 35 U.S.C. 102(b),(c),(d)(g); *Howe v. Shumaway*, 12 Fed. Cas. 678 (D. Mass. 1854) (First inventor "gave nothing to the public." Court held he "only an idea, never carried out in a machine [*i.e.*, actually reduced to practice] that could anticipate one subsequently invented").

RETAINING FIRST-TO-INVENT: CONTINUED PROMOTION OF THE PROGRESS OF USEFUL ARTS

The Supreme Court has found a standard expressed in the Constitution, “inherent requisites” of “innovation, advancement, and things which add to the sum of useful knowledge.” It is a standard that “may not be ignored.”⁵⁴ To conclude our analysis of how the Constitution may prevent adoption of any first-to-file system, it is appropriate to consider which system better promotes “the progress of useful Arts” and fulfills the Court’s inherent requisites. The answer is clear, and is consistent with the rest of the Constitution’s patent clause. The first inventor, unlike another person who “invents” later but files earlier, is the one who brings an innovation or advancement into being. It is that person who fulfills the constitutional objective and is entitled to its prescribed reward. Thus the Constitution shows its wisdom; it expressly prohibits what would hinder the results it requires.

In consonance with this view, the Supreme Court observed that the patent laws promote the constitutional goal of progress

by offering a right of exclusion for a limited period as an incentive to inventors to risk the *often enormous costs in terms of time, research, and development*. The *productive effort thereby fostered* will have a positive effect on society through the introduction of new products and processes of manufacture into the economy, and the emanations by way of increased employment and better lives for citizens.⁵⁵

The Court did not speak of incentives to “win a race to the Patent Office.” It spoke, instead, in the traditional American terms of invention, of research and development, of productive effort.

How fitting it is that the United States, which progressed from a small band of colonists to being the single largest source of worldwide patent filings,⁵⁶ continues to

⁵⁴ *Graham*, 383 U.S. 1.

⁵⁵ *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470 (1974) (emphasis added).

⁵⁶ United States residents originated about 40% of all PCT applications during 1998 and 1999, more than twice the percentage filed by residents of any other single country. WIPO, *The Patent Cooperation Treaty (PCT) in 1999*, available on the Internet at www.wipo.int/pct/en/activity/1999/pctin99.htm#P22_952.

stand apart in rewarding “compensation for [the] ingenuity, labor, and expense”⁵⁷ of first inventors in producing their discoveries.

⁵⁷ *Allen v. Hunter supra* note 49.