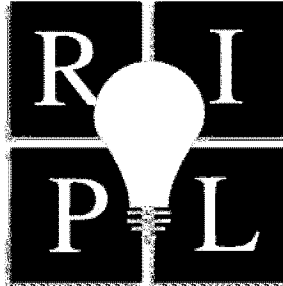


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THE PATENT REFORM ACT'S PROPOSED FIRST-TO-FILE STANDARD: NEEDED REFORM OR CONSTITUTIONAL BLUNDER?

KAREN E. SIMON

ABSTRACT

The proposed Patent Reform Act of 2005 would bring U.S. patent law into harmony with most other countries by adopting a first-to-file standard for determining patent rights. This comment questions whether overturning the first-to-invent standard and two hundred years of settled law is permissible under the Patent Clause of the U.S. Constitution. The comment concludes that the Patent Reform Act of 2005, as proposed, violates the Constitution, and supports its argument by placing into context of the founding fathers fear of extending government monopolies. The comment proposes that Congress focus on procedural reform, and not change the fundamental standard for awarding patent rights.

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REFORM OR CONSTITUTIONAL BLUNDER?

KAREN E. SIMON*

*Monopolies may be allowed to persons for their own productions in
literature, and their own inventions in the arts, for a term not
exceeding years, but for no longer term and for no other purpose.*

*Thomas Jefferson*¹

INTRODUCTION

The Patent Reform Act of 2005 (“PRA”) proposes a radical change to the existing standard for determining patent rights from first-to-invent to first-to-file.² Presently, only the original inventor is entitled to patent protection, regardless of who is first to apply for a patent.³ This allows a patent filed by someone who independently originated an idea to be challenged by someone claiming priority of invention.⁴ Under the proposed PRA, a party who is the first-to-file a patent application will be recognized as the inventor.⁵ The proposed PRA raises questions under the Patent Clause of the U.S. Constitution and reverses two hundred years of settled law.⁶

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¹ Letter from Thomas Jefferson to James Madison (Aug. 28, 1789), *available at* <http://www.constitution.org/tj/jeff07.txt>.

² Patent Reform Act of 2005, H.R. 2795, 109th Cong. § 3(b) (2005) (eliminating the first-to-invent standard in lieu of the first-to-file standard in the United States). While this comment will focus on the Patent Reform Act of 2005, it is important to note that the Patent Reform Act of 2006 was recently proposed in the Senate. *See* Patent Reform Act of 2006, S. 3818, 109th Cong. (2006). Senate Bill 3818, also proposes the elimination of the first-to-invent standard in favor of the first-to-file standard. *Id.*

³ 3A-10 DONALD S. CHISUM, CHISUM ON PATENTS, § 10.01 (2004). Generally, the inventor who first reduced the invention to practice has priority. *Id.* There are two exceptions to this rule. *Id.* The first to conceive, but second to reduce to practice will prevail only if he exercised reasonable diligence in reducing the invention to practice prior to the time the second person conceived the idea. *Id.* Also, the first to reduce to practice will lose right to the invention if he abandoned, suppressed, or concealed the invention. *Id.*

⁴ 1 DONALD S. CHISUM, CHISUM ON PATENTS, § 4 (2005) (“Section 15 of this Act introduced the diligence concept by providing that an inventor’s patent was invalid if it was for an invention ‘invented or discovered by another, who was using reasonable diligence in adapting and perfecting the same.’”).

⁵ *See* Patent Reform Act of 2005, H.R. 2795, 109th Cong. § 3 (2005).

⁶ U.S. CONST. art. I, § 8, cl. 8 (“To promote the Progress of . . . useful Arts, by securing for limited Times to . . . Inventors the exclusive Right to their respective . . . Discoveries.”). This Clause is also known and referred to as the Patent Clause of the Constitution. Paul A. Ballonoff, *Limits to Regulation Due to Interaction of the Patent and Commerce Clauses*, 20 CATO J. 401, 402 (2001), *available at* <http://www.cato.org/pubs/journal/cj20n3/cj20n3-5.pdf>. The battle between the first-to-

While the first-to-invent standard for patentability has been in place in the United States since the 1790s, it remains unique to the United States.⁷ Indeed, the first-to-invent standard has been subject to domestic and international criticism for many years.⁸ With increased globalization, the United States has received even stronger pressure from other commercial nations to convert to a first-to-file standard, because there are greater incentives to achieving harmonized global patent laws.⁹ Multinational corporations and others involved in patent litigation also favor the certainty that accompanies the first-to-file standard.¹⁰

Those who oppose the change to the first-to-file standard fear that, in practice, small businesses, universities, research organizations, and individual inventors would be unable to afford the expense of continuously filing applications.¹¹ Consequently, the original inventor may lose patent protection to a subsequent inventor who files first. The public may also suffer from a lack of adequate disclosure

file standard and first-to-invent standard is based on whether the term “Inventor,” as used in the Constitution, can mean something other than the first person to invent. Doug Harvey, Comment: *Reinventing the U.S. Patent System: A Discussion of Patent Reform Through an Analysis of the Proposed Patent Reform Act of 2005*, 38 TEX. TECH. L. REV. 1133, 1144 (2006). A related question is whether the definition of “Inventor” is mandated by the Constitution, or, alternatively, whether Congress has the authority to define and redefine the term “Inventor”? Timothy R. Holbrook, *The Treaty Power and the Patent Clause: Are There Limits on the United States’ Ability to Harmonize?*, 22 CARDOZO ARTS & ENT. L.J. 1, 6 (2004). Over the past two hundred years, the courts have awarded patent rights to the first inventor. *See, e.g.*, *Shaw v. Cooper*, 32 U.S. 292, 318–19 (1833).

⁷ CHISUM, *supra* note 4, § 4 (“The United States patent standard stands alone in the world in determining priority among competing inventors by reference to who was the ‘first to invent.’”). *Pennock v. Dialogue*, 27 U.S. 1, 17–18 (1829) (recognizing that while based on English common law, it is still a distinct standard, although this does not mean that the founders were unaware of the English law).

⁸ Kelber, *Bill Has Issues All Will Debate: Scope and Complexity of Patent Reform Act Reach All Industry Sectors*, 27 THE NATIONAL LAW JOURNAL 50 (2005); *see also* Edwin A. Suominen, *Re-Discovering Article I, § 8 – A Uniquely American Formula for a First-to-invent Patent Standard*, 66 FR 15409; Comment to Item 1, 1 (2001).

⁹ *See, e.g.*, Edward G. Fiorito, *The “Basic Proposal” for Harmonization of U.S. and Worldwide Patent Laws Submitted by WIPO*, 73 J. PAT. & TRADEMARK OFF. SOCIETY 83, 88–89 (1991) (discussing the WIPO draft treaty harmonizing patent laws, which would require the United States to adopt a first-to-file standard).

¹⁰ Brad Pedersen & Vadim Braginsky, *Recent Development: The Rush to a First-to-File Patent System in the United States: Is a Globally Standardized Patent Reward System Really Beneficial to Patent Quality and Administrative Efficiency?*, 7 MINN. J.L. SCI. & TECH. 757, 765 (2006). (noting that uncertainty and expenses are more of a concern for multinational corporations). The first-to-file standard also eliminates three other rules that add uncertainty to the standard including: “the ‘secret prior’ art rules governing commercial but nonpublic use, and that differ depending on whether the user is the patentee or not; the ‘experimental use’ exemption based on a totality of the circumstances analysis; and the perplexing definition of when an invention is on sale.” *Patent Law Revision Hearing Before the Subcomm. on Intellectual Prop. of the S. Comm. on the Judiciary*, 109th Cong. ¶ 9 (2005) (statement of Mark A. Lemley, Professor, Stanford Law School).

¹¹ Lawrence B. Ebert, *Patent Reform 2005: Sound and Fury Signifying What?*, THE NEW JERSEY LAW JOURNAL, July 18, 2005, ¶¶ 9–11 (recognizing that even large entities with limited resources, such as a university, would suffer because they would be unable to make multiple filings for each invention for each faculty member).

resulting from the race to file the application first if the haste causes the application to be incomplete and lacking necessary details.¹²

This Comment analyzes Section 3 of the proposed PRA and the impact of changing the United States patent law from the first-to-invent to the first-to-file standard. After reviewing the major decisions in the two hundred years using the first-to-invent standard, Section I considers the difficulties that have developed due to increasing international global trade and its effect on United States policy. Section II examines challenges to the first-to-file standard under the Patent Clause of the U.S. Constitution, which authorizes Congress to grant patents for “Discoveries” to “Inventors.”¹³ Section III proposes that it is better to maintain the fundamental policy of encouraging invention by rewarding the inventor who is first-to-invent and that Congress would be better advised to focus on making the current patent procedures more efficient. This Comment concludes that the proposal in Section 3 of the PRA is unconstitutional, and that a change in the constitutional standard will disturb the Framers’ preference for protecting against the abuses of government granted monopolies.

I. BACKGROUND

A patent holder’s right to a period of government-enforced exclusivity to use a new invention is well established under English common law.¹⁴ However, these patent rights have their origin in the dishonored practice of the British Crown rewarding favored subjects with monopolies in a variety of commercial areas, usually in exchange for payments to the Monarch.¹⁵ Opposition to this corrupt practice eventually led to its prohibition in the Statute of Monopolies of 1623.¹⁶ However, the granting of patent rights to inventors was deemed to be a valuable incentive for innovation and, as such, was exempted from this statute.¹⁷

¹² Cole A. Bloomberg, *In Defense of the First-to-Invent Rule*, 21 AIPLA Q.J. 255, 260 (1993) (recognizing that the public gains more from carefully prepared and full disclosures than it does from a rushed inadequate application).

¹³ U.S. CONST. art. I, § 8, cl. 8.

¹⁴ *Pennock v. Dialogue*, 27 U.S. 1, 16–18 (1829). English common law recognized various monopolies until 1623 when the Statute of Monopolies was enacted and all monopolies were abolished, except for the “exclusive privileges” of patents. *Id.* America differs from England in that America never recognized monopolies, except for those in the form of patent rights. *Id.*

¹⁵ PJO Taylor, *Spice of Life Letters Patent*, THE STATESMAN (India), Jan. 16, 2005, available at <http://www.thestatesman.net/page.arcview.php?clid=3&id=94098&usrsess=1>. The practice of selling monopolies led to many abuses by the English Crown, and resulted in the entire country’s trade being controlled by relatively few men. *Id.* Examples of these abuses include: the granting of exclusive rights to provide all Spanish wools to make felt hats and the exclusive right to print the Psalms of David, including all the songs. *Id.*

¹⁶ Statute of Monopolies ch. 3 Eng. Preamble (1623) (noting that all monopolies are void).

¹⁷ *Id.* § 6 (recognizing that existing patents are not subject to this limitation). Under the Statute of Monopolies, Parliament was authorized to grant inventors the exclusive right to their invention for fourteen years. *Id.*

The Framers of the U.S. Constitution strongly feared monopolies because of their history of abuse by the British Crown.¹⁸ The Framers, however, also viewed patents differently from other monopolies, and recognized that the protection of patent rights is necessary with appropriate limitations.¹⁹ Explaining the need for patents in Federalist No. 43, James Madison stated

The utility of this power will scarcely be questioned. The copyright of authors has been solemnly adjudged, in Great Britain, to be a right of common law. *The right to useful inventions seems with equal reason to belong to the inventors. The public good fully coincides in both cases with the claims of individuals.* The States cannot separately make effectual provisions for either of the cases, and most of them have anticipated the decision of this point, by laws passed at the instance of Congress.²⁰

The right exists in the inventor, and is recognized through a government-issued patent.²¹ Madison apparently believed that if invention is necessary for progress in society, then the inventor must be rewarded for his contribution as an incentive to continue to innovate.²² State-awarded monopolies, on the other hand, are not based on any inherent individual right.²³ Instead, a monopoly is a right created by the government.²⁴ The award of a monopoly was not designed to promote innovation for the public good, but rather to promote the private welfare of the monopolist.²⁵

¹⁸ *Great A. & Pac. Tea Co. v. Supermarket Equip. Corp.*, 340 U.S. 147, 154 (Douglas, J. concurring). “The Framers plainly did not want those monopolies freely granted.” *Id.*

¹⁹ *Id.*

²⁰ The FEDERALIST No. 43 (James Madison) (emphasis added).

²¹ See Ballonoff, *supra* note 6, at 402 (noting that the Framers, in not using the term “patent” in the so-called “Patent Clause,” declined to give the federal government the authority to grant economic rights). Today, the general understanding of the term “patent” differs from its general definition at the time the Constitution was written. *Id.* At the time the Constitution was drafted, a “patent” was understood to be a grant of an economic right by the government. *Id.* The Framers of the Constitution were aware of this general definition and intentionally did not include the word “patent” in the Patent Clause. *Id.* at 401–02. Therefore, the Framers did not intend to authorize Congress to grant economic rights. *Id.* at 402. Instead, in the Patent Clause, the Framers stated the specific right that the government must protect. *Id.* at 403. This right, as Justice Story recognized in his writings, is a “right to useful inventions . . . [that] belongs to inventors.” *Id.* at 406 (citing JOSEPH L. STORY, COMMENTARIES OF THE CONSTITUTION OF THE UNITED STATES § 1147 (vol. 3) (Hilliard, Gray and Co. 1833)). “The right to useful inventions seems . . . to belong to inventors; and accordingly, it was saved out of the Statute of Monopolies in the reign of King James the First.” *Id.*

²² See The FEDERALIST No. 43 (James Madison).

²³ Ballonoff, *supra* note 6, at 402–03. The present definition of a “monopoly” is the same as the definition of a patent at the time the Constitution was drafted: economic rights granted by the government. *Id.*

²⁴ *Id.* at 402.

²⁵ *Id.* (noting that the English Crown used to sell monopolies for its own benefit under the pretense of being for the public good).

Thomas Jefferson was not easily convinced that the benefits of protecting patent rights outweighed the harm caused by monopolies.²⁶ However, he also came to realize the distinction between patents and other monopolies, and eventually supported the Patent Clause.²⁷ Jefferson, like Madison, recognized that the interest of the inventor and public good coincide, in that both benefit by rewarding the inventor for his ingenuity.²⁸

The United States Constitution grants Congress the authority to distribute patents.²⁹ Article I, Section 8, Clause 8 of the Constitution provides Congress with the power “To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.”³⁰ In addition to giving Congress the right to issue patents, the Patent Clause³¹ prescribes the Constitutional standard of patentability.³² This Constitutional standard is specifically limited with respect to recipient (“Inventors”), to subject matter (“Discoveries”), purpose (“promote the Progress of Science”), and duration of rights granted (“for limited Times”).³³

²⁶ Letter from Thomas Jefferson to James Madison (July 31, 1788), *available at* <http://www.constitution.org/tj/jeff07.txt>. Jefferson wrote to Madison from France arguing that “the benefit of even limited monopolies is too doubtful, to be opposed to that of their general suppression.” *Id.* Jefferson opposed a Constitution that did not have a Bill of Rights, which would include an express restriction against monopolies. *Id.*

²⁷ Letter from Thomas Jefferson to James Madison (Aug. 28, 1789), *available at* <http://www.constitution.org/tj/jeff07.txt>. Jefferson, in an 1807 letter, stated that “Certainly an inventor ought to be allowed a right to the benefit of his invention for some certain time.” Letter from Thomas Jefferson to Oliver Evans (May 2, 1807), *available at* <http://www.constitution.org/tj/jeff11.txt>. Jefferson, however, did not believe that there was inherit property right belonging to an inventor, “It would be curious, then, if an idea, the fugitive fermentation of an individual brain, could, of natural right, be claimed in exclusive and stable property. . . . Inventions then cannot, in nature, be a subject of property.” Letter from Thomas Jefferson to Isaac McPherson (Aug. 13, 1813), *available at* <http://www.constitution.org/tj/jeff13.txt>.

²⁸ Compare THE FEDERALIST NO. 43 (James Madison) with Letter from Thomas Jefferson to Oliver Evans (May 2, 1807), *available at* <http://www.constitution.org/tj/jeff11.txt>.

²⁹ U.S. CONST. art. I, § 8, cl. 8; *Youngstown Sheet & Tube Co. v. Sawyer*, 343 U.S. 579, 588 (1952).

[T]hat “All legislative Powers herein granted shall be vested in a Congress of the United States. . . .” After granting many powers to the Congress, Article I goes on to provide that Congress may “make all Laws which shall be necessary and proper for carrying into Execution the foregoing Powers, and all other Powers vested by this Constitution in the Government of the United States, or in any Department or Officer thereof.”

Id.

³⁰ U.S. CONST. art. I, § 8, cl. 8.

³¹ U.S. CONST. art. I, § 8, cl. 8.

³² *Graham*, 383 U.S. at 5–6.

³³ *Great A. & Pac. Tea Co. v. Supermarket Equip. Corp.*, 340 U.S. 147, 154 (1950) (Douglas, J., concurring).

The Congress does not have free rein . . . to decide that patents should be easily or freely given. The Congress acts under the restraint imposed by the statement of purpose . . . “To promote the Progress of Science and useful Arts” The means for achievement of that end is the grant for a limited time to inventors of the exclusive right to their inventions.

Id.

Congress cannot exceed or vary this prescribed standard when enacting patent legislation.³⁴

On April 10, 1790, Congress enacted the first laws governing patents.³⁵ The Patent Act of 1790 recognized that patent rights are vested in the individual that has “invented or discovered any useful art, manufacture, engine, machine, or device, or any improvement therein not before known or used. . . .”³⁶ Furthermore, the Act recognized that a patent can be repealed if it is determined that the owner is not the “first and true inventor or discoverer.”³⁷ Finally, the patent serves as “*prima facie* evidence” that the patent holder is the first and true inventor of the patented subject.³⁸

The administration of the Patent Act of 1790 was conducted by the Department of State, but the power to grant patents was vested in three board members: the Secretary of State, the Secretary of War, and the Attorney General.³⁹ The members of the Patent Board soon realized that the Patent Act of 1790 failed to provide a standard for resolving disputes that arose when more than one person claimed the right to patent the same invention.⁴⁰ In one of the best known early patent cases, four individuals applied for a patent on a steamboat.⁴¹ A number of hearings were held in April of 1791, where it was proposed that the Patent Board award a patent to the first person to file an application.⁴² This proposal was rejected.⁴³ The Patent Board instead decided to grant all four patents, although for non-overlapping and differing aspects of the steamboat.⁴⁴ John Fitch, who was most likely the original

³⁴ *Graham*, 383 U.S. at 5–6.

³⁵ P.J. Federico, *Operation of the Patent Act of 1790*, 18 J. PAT. OFF. SOC'Y 237, 237 (1936); Patent Act of 1790 § 1, 1 Stat. 109, 109–10.

³⁶ Patent Act of 1790 § 1, at 109–10.

³⁷ Patent Act of 1790 § 5, at 111.

³⁸ Patent Act of 1790 § 6, at 111; *see also* *Allen v. Hunter*, 1 F. Cas. 476, 476 (D. Ohio 1855) (“[An] individual who disputes the right must produce evidence to counterbalance the legal presumption of the right in the plaintiff from his patent.”).

³⁹ Federico, *supra* note 35, at 237–38. The first Patent Board members were Thomas Jefferson, Henry Knox, and Edmund Randolph. *Id.* at 238. Thomas Jefferson played a large role in shaping the patent standard in the United States. *Id.* The first board referred to themselves as the “Commissioners for the Promotion of Useful Arts.” *Id.* They were also known interchangeably as the Patent Commission and the Patent Board. *Id.*

⁴⁰ *Id.* at 248.

⁴¹ *Id.*

⁴² *Id.*

⁴³ *Id.*

⁴⁴ *Id.* at 248–50. Nathan Read and John Stevens were given specific patents for specific parts that they had invented for the steamboat. *Id.* at 250. For instance, Read was awarded three patents: first, for improvements on the boiler of the steam engine; second, for improvements of the steam cylinder; and third, for the invention described as

[A] practical mode of driving or impelling boats or vessels of any kind in the water or against the current, by means of chain-wheel, or rowing machine, constructed and operating upon the general principles of the chain-pump, and moved by the force of steam or any other power in the same manner the chain-pump is moved.

Id. at 249–50. There was no conflict between the patents granted. *Id.* at 250. Fitch’s patent was broad, covering several types of propelling, while Read’s was limited to a particular manner of propulsion. *Id.*

inventor, was given a broad patent over the steamboat.⁴⁵ The Patent Act of 1793 not only affirmed the first-to-invent standard, but also implemented what is known as an “interference,” which is the process for resolving priority disputes between alleged inventors.⁴⁶

The Supreme Court found that the first-to-invent standard of awarding patent rights is a proper exercise of the Congressional authority.⁴⁷ The Supreme Court has continuously affirmed this first-to-invent standard since the Act was first passed in 1791.⁴⁸ All subsequent Patent Acts continued to use the first-to-invent standard without controversy.⁴⁹

The Patent Act of 1952 introduced the requirement that patents be non-obvious.⁵⁰ To qualify as non-obvious, the invention could not simply be an improvement that is obvious to a “person having ordinary skill in the art. . . .”⁵¹ This

⁴⁵ *Id.* Read and Stevens both admitted to the Patent Board that Fitch was the original inventor of the steamboat. *Id.* However, Read and Stevens both felt that they still deserved the exclusive rights the patent awards due to the improvements caused by their respective inventions. *Id.*

⁴⁶ Patent Act of 1793, §§. 3, 9, 1 Stat. 318, 321, 322–23. When more than one application is submitted for the same invention, the applications are submitted for arbitration, which consists of three persons, one chosen by each party, and the last by the Secretary of State. *Id.* If more than two parties exist, the Secretary of State appoints all three. *Id.* at 323.

⁴⁷ *Shaw v. Cooper*, 32 U.S. 292, 318–19 (1833). The policy behind granting exclusive rights for new inventions in the United States was determined to be of such importance that the power to do so was given to Congress through Article I, Section 8, Clause 8 of the Constitution. *Id.* at 318.

This power was exercised by congress, in the passage of [Patent] acts And from an examination of their various provisions, it clearly appears, that it was the intention of the legislature, by a compliance with the requisites of the law, to vest the exclusive right in the inventor only

Id. at 318–19.

⁴⁸ *See Seymour v. Osborn*, 78 U.S. 516, 533 (1870) (reasoning that the role of patents is to compensate “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.”); *see also Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 59 (1883) (finding that a major difference between patent rights and copyrights are that patents cannot be issued until the inventor can establish by proof “the novelty, the utility, and the actual discovery or invention”); *Pennock v. Dialogue*, 27 U.S. 1, 12 (1829) (reasoning that under the Constitution “the right is created by the invention, and not by the patent”). Additionally, lower courts have continued to follow this precedent. *See Allen v. Hunter*, 1 F. Cas. 476, 477 (D. Ohio 1855) (recognizing that “[n]o exclusive right can be granted for anything which the patentee has not invented or discovered . . .” and that the law gives him this right to compensate him for his effort); *Thompson v. Haight*, 23 F. Cas. 1040, 1045 (S.D.N.Y. 1826)

[The] “Essay on the Law of Patents . . .,” an American work, [states] that “there is a difference between our statute and that of Great Britain on this subject. In England, if the invention has been put in use before the patent is obtained, it is void. But our act does not, like the English statute, refer to the grant of letters patent, but to the time of the invention.”

Id. This is another difference between the United States standard and English standard, and again points out that the focus is on the time of the invention. *Id.*

⁴⁹ *See generally* Patent Act of 1836, 5 Stat. 117 (1836); Patent Act of 1870, 16 Stat. 198 (1870).

⁵⁰ Patent Act of 1952 § 103, 66 Stat. 797 (1952).

⁵¹ *Id.*

provision was challenged in *Graham v. John Deere Co.*⁵² The *Graham* Court agreed that a patentability standard is contained in the Patent Clause of the U.S. Constitution, but found that the non-obvious requirement is also included within this standard.⁵³ Therefore, the Patent Act of 1952 was found not to violate the Constitution.⁵⁴

Importantly, in *Graham v. John Deere Co.*, the Supreme Court reiterated that Article I, Section 8, Clause 8 is both a grant and a limitation on Congressional power.⁵⁵ Furthermore, the Supreme Court found that in the United States, “[i]nnovation, advancement, and things which add to the sum of useful knowledge are inherent requisites in a patent system which by constitutional command must ‘promote the Progress of . . . useful Arts.’”⁵⁶ Therefore, Congress cannot impose legislation that is contrary to the “inherent requisites” of the Constitution.⁵⁷

Undeniably, the first-to-invent standard has produced uncertainty.⁵⁸ Even where a person independently creates an invention, and obtains a patent, which recognizes his rights in that invention, the patent-holder still may lose those rights if another proves to be the first creator.⁵⁹ Moreover, there is significant complexity and expense in judicially determining who is the first-to-invent.⁶⁰

Changing the standard to first-to-file would, arguably, simplify the process as well as reduce legal cost for the inventor.⁶¹ Proponents also claim that changing to the first-to-file standard would improve fairness and enhance the progress toward a globally harmonized patent standard.⁶² It is argued that the first-to-invent standard

⁵² *Graham v. John Deere*, 383 U.S. 1, 3 (1966). In *Graham*, the Supreme Court considered whether Congress acted within its authority when it added a third requirement, utility, to the statutory test for granting patents. *Id.* The Court found that the 1952 Act merely codified the traditional test of patentability. *Id.* at 3–4.

⁵³ *Id.* at 5–6, 17.

⁵⁴ *Id.* at 3–4 (holding that the 1952 Act codifies the traditional standard, and that even though the Act emphasizes obviousness, “the general level of innovation necessary to sustain patentability remains the same.”).

⁵⁵ *Id.* at 5. The Supreme Court recognized that the intention of the limitation of Congressional authority over patents was an effort to distinguish the United States from the English practice in the sixteenth and seventeenth centuries of granting monopolies. *Id.* The Constitution limited Congress by only allowing patents to be awarded for inventions that promote the “useful arts.” *Id.* This Clause grants Congress the power to regulate the administration of distributing patents, but is limited in regards to purpose, duration, patent holders, and inventions. Due to these constitutional limitations, “Congress in the exercise of the patent power may not overreach the restraints imposed by the stated Constitutional purpose.” *Id.* at 5–6.

⁵⁶ *Id.* at 6.

⁵⁷ *Id.*

⁵⁸ Pedersen & Braginsky, *supra* note 10, at 765–66.

⁵⁹ *Dietz v. Wade*, 7 F. Cas. 684, 690 (D.C. Cir. 1859) (“He who invents first shall have the prior right if he is using reasonable diligence in adapting and perfecting the same, although the second inventor first perfects and reduces the same to practice in a positive form.”).

⁶⁰ Steven Ludwig, *U.S. Patent Reform and the Future of Nanotechnology*, 20 LEGAL BACKGROUNDER 37, ¶ 24 (2005).

⁶¹ See, e.g., Lemley, *supra* note 10, ¶ 1 (noting the current system needs to simplify the unnecessary complex rules); see also Kelber, *supra* note 8, ¶ 4 (noting that there is currently surprisingly little opposition to changing the patent standard to first-to-file and recognizing that the change will simplify the process).

⁶² Lemley, *supra* note 10, ¶ 10.

requires complex proof of invention, which some say creates an unfair advantage to those who can afford the costs.⁶³

The first-to-file standard, on the other hand, may lead to incomplete patent applications due to the pressure to file first.⁶⁴ When comparing patent applications from the United States and Japan, many Japanese applications are considered inadequate, as a result of rushing to obtain the priority date.⁶⁵ Consequently, United States applications are much more developed.⁶⁶ Those supporting the first-to-invent standard argue that the public gains more from a patent containing complete disclosure of a finished invention than it does from an incomplete disclosure of a newly developed idea.⁶⁷

In 1966, the President's Commission on the Patent System recommended that the United States depart from precedent and adopt a first-to-file standard.⁶⁸ Congress rejected the recommendation after industry and Bar Associations spoke out against it.⁶⁹ In the mid 1980s, the United Nations' World Intellectual Property Organization ("WIPO") proposed that member countries, including the United States, adopt a first-to-file standard.⁷⁰ At that time, United States leadership assured the G-7 nations that the United States would be a first-to-file country before the end of the decade.⁷¹ Those supporting the change tended to be multinational corporations who preferred the certainty and had the funds to file patent applications quickly and continuously.⁷²

Professional inventors, universities, and small businesses continued to defend the first-to-invent standard.⁷³ In 1990, international pressures continued as WIPO drafted a treaty, which would impose a first-to-file standard on all signatories.⁷⁴ Like previous attempts to change the U.S. patent standard, it was opposed and the treaty was never adopted.⁷⁵

While the United States did not implement the change before the end of the last century, Congress is now taking steps to enact sweeping reforms to U.S. patent

⁶³ *Id.* ¶ 11 (expressing that while in the past, small inventors have criticized the first-to-file standard, new evidence shows that it is large corporations who benefit most from the first-to-invent standard).

⁶⁴ Gabriel Katona, *First-to-File – Not in the United States*, 73 J. PAT. OFF. SOC'Y 399, 401 (1991).

⁶⁵ Charles R.B. Macedo, Note, *First-to-File: Is American Adoption of the International Standard in Patent Law Worth the Price?*, 1998 COLUM. BUS. L. REV. 543, 573 (1988).

⁶⁶ Katona, *supra* note 64, at 400.

⁶⁷ Bloomberg, *supra* note 12, at 260.

⁶⁸ Suominen, *supra* note 8, at 1.

⁶⁹ *Id.*

⁷⁰ Fiorito, *supra* note 9, at 84, 88. The United States is the last major country to use the first-to-invent standard. CHISUM, *supra* note 4, § 4. This has created problems for the harmonization of international patent laws, which has become important in an increasingly commercially interdependent world. Fiorito, *supra* note 9, at 84, 88.

⁷¹ Kelber, *supra* note 8, ¶ 3. The promise was made by United States trade representatives without "advance consultation with patent professionals." Katona, *supra* note 64, at 400.

⁷² Pedersen & Braginsky, *supra* note 9, 765–66.

⁷³ *Id.*

⁷⁴ Fiorito, *supra* note 9, at 84–85, 88.

⁷⁵ Suominen, *supra* note 8, at 1. In 2001, WIPO proposed another harmonization treaty. *Id.* As in 1990, this treaty would require that all signatories adopt a first-to-file standard for solving patent disputes. *Id.*

laws.⁷⁶ On June 8, 2005, the U.S. House of Representatives' Judiciary Committee's Subcommittee on Courts, the Internet, and Intellectual Property introduced H.R. 2795, The Patent Reform Act of 2005.⁷⁷ Among the many proposed reforms, H.R.

⁷⁶ See generally The Patent Reform Act of 2005, H.R. 2795, 109th Cong. § 3 (2005). The Patent Reform Act of 2005 has several provisions including changing the first-to-invent standard to first-to-file standard for resolving patent disputes. Ebert, *supra* note 11, ¶ 2. It also would allow someone other than the inventor to file an application. It would place duty of candor and inequitable conduct inquiries under the PTO's jurisdiction and create duty of candor for parties opposing patent or application. Kelber, *supra* note 8, ¶ 11. H.R. 2795 would also change provisions on reasonable royalty and willful infringements. *Id.* at ¶ 18–21. A losing party would also be allowed to obtain a stay of an injunction pending an appeal. *Id.* ¶ 15. The PTO Director will be able to limit circumstances under which priority can be claimed for a continuation. *Id.* ¶ 7. Finally, it would change post-grant activities to include publication application, as well as the creation of a post-grant opposition procedure. *Id.*

⁷⁷ The Patent Reform Act, 2005 H.R. 2795 109th Cong. § 3 (2005). In 2005, the U.S. Senate Judiciary Committee created a new subcommittee to handle intellectual property issues. Ludwig, *supra* note 60, ¶ 2. The goals of the Patent Reform Act are to allay concerns about the quality of patents, curb patent litigation abuse and take steps toward global harmonization. Pedersen & Braginsky, *supra* note 10, at 757. Both the Senate and House Committees want to create strong patent protection as an incentive for invention. Ludwig, *supra* note 60, ¶¶ 1–2. Multiple House and Senate hearings have been held to address these issues, which have attracted many organizations, industry groups, companies, and individual inventors, including the Intellectual Property Owners Association, Business Software Alliance, Financial Services Roundtable, American Bar Association, American Intellectual Property Law Association, the U.S. Patent and Trademark Office, National Research Council of the National Academy of Sciences, Genentech, Eli Lilly, Intel, Micron Technologies, and Intellectual Ventures. *Id.* ¶ 5. Because the patent system works differently in different industries, it will be difficult to obtain complete agreement. Lemley, *supra* note 10, ¶¶ 5–6. The people in favor of the change say that it simplifies the complex rules for determining the first inventor. *Id.* ¶ 9. Also, it is argued that the elimination of inferences will help small business and those with fewer resources. *Id.* ¶ 11. Inferences are costly, therefore, large inventors challenge the patents of small inventors more frequently. *Id.* Also, H.R. 2795 has a marked distinction from a typical first-to-file standard. *Id.* ¶ 12. H.R. 2795 allows inventors or discoverers “who sell, use, or publish their invention [within one] year to get a patent application on file.” *Id.* Therefore, those with fewer resources who are concerned about losing a race to the patent office can still publish their invention on a website. *Id.* This will help protect the inventor from someone else getting a patent, and allow the inventor time hire a patent attorney and file an application. *Id.* One speaker at the hearings said that the first-to-file standard in “the rest of the world is a disadvantage to universities and independent inventors.” *The Patent Act of 2005 Hearing of the Courts the Internet, and Intellectual Property Subcommittee of the House Judiciary Committee*, 109th Cong. ¶ 27. (2005) (testimony of Carl E. Gulbrandsen, Managing Director, Wisconsin Alumni Research Foundation). This speaker quoted ProTon, the pan European network of knowledge transfer offices, which expressed its belief of the weakness of the European patent standard. *Id.* ¶¶ 27–28. ProTon stated,

The patent system in Europe, with its complexity and cost, is much less appropriate to university-based inventions than the U.S. standard and acts as a barrier to innovation from public research. It lacks a grace period, a provisional patent standard, a continuation-in-part (CIP) system and is several times more expensive. ProTon Europe is convinced that these differences account in large part for the much lower number of patent inventions coming out of public research in Europe.

Id. ¶ 28. The speaker went on to say that the uniquely American standard gives an advantage to universities and is relied on by the universities. *Id.* Thus, he argued that the first-to-invent standard should remain. *Id.* ¶ 29.

2795 would finally change the United States by creating a first-to-file standard, consistent with the rest of the world.⁷⁸

II. ANALYSIS

House Bill 2795, Section 3 would change over two hundred years of settled law by implementing a first-to-file standard.⁷⁹ In effect, Congress would be redefining the term “Inventors” as used in the Patent Clause of the U.S. Constitution, as those who first file an application in the United States Patent and Trademark Office (“PTO”).⁸⁰ The constitutionality of such a change will be examined in this section.

Part A of this section analyzes the text of Article I, Section 8, Clause 8 and what the Framers intended it to mean.⁸¹ Part B studies the historical interpretation and application of the Patent Clause in the United States. After examining other considerations that might justify a reinterpretation of the Patent Clause, Part C concludes that the first-to-file standard as proposed in H.R. 2795 is unconstitutional.

A. *The Meaning of the Text*

Article I, Section 8, Clause 8 specifically authorizes Congress “[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.”⁸² The Congressional authority to regulate patents stems from this specific Constitutional provision, which is both a grant and a limitation of power.⁸³ This Clause grants Congress the power to regulate the administration of patent distribution, but limits Congress’s power in regards to purpose, duration, patent holders, and inventions. Due to these Constitutional limitations, “Congress in the exercise of the patent power may not overreach the restraints imposed by the stated Constitutional purpose.”⁸⁴

⁷⁸ 2005 H.R. 2795 § 3 (striking the language “at the time the invention was made” and inserting “before the effective filing date of the claimed invention,” this section also eliminates interferences as they are no longer necessary in a first-to-file standard).

⁷⁹ See generally Patent Reform Act of 2005, H.R. 2795, 109th Cong. § 3 (2005).

⁸⁰ Holbrook, *supra* note 6. The issue of whether or not Article I, Section 8, Clause 8 authorizes Congress to define and redefine the term “Inventors” in the Patent Clause is at the center of the debate over the constitutionality of the first-to-file standard. *Id.* The PRA attempts to redefine “Inventor” by granting the patent right to the individual who files the application first. See Patent Reform Act of 2005, H.R. 2795, 109th Cong. § 3 (2005).

⁸¹ U.S. CONST., art. I, § 8, cl. 8.

⁸² U.S. CONST. art. I, § 8, cl. 8. While Article I, Section 8, Clause 8 also refers to the rights of Authors for their writings, this comment only focuses on inventors and their discoveries. Although “Authors and Inventors” is used in the same constitutional clause, and deals with the same principles, “Authors and Inventors” are treated as separate and distinct. *Burrow-Giles Lithograph Co. v. Sarony*, 111 U.S. 53, 56 (1884). Congress, giving effect to Article I, Section 8, Clause 8 divided the persons who are to be benefited into two separate categories: authors and inventors. *Id.* Authors are given a monopoly right called a copyright, while inventors are given a patent right. *Id.*

⁸³ *Graham v. John Deere Co.*, 383 U.S. 1, 5 (1965).

⁸⁴ *Id.* at 5–6. Congress also may not “enlarge the patent monopoly without regard to the innovation, advancement or social benefit gained thereby.” *Id.* at 6.

Unlike many enumerated powers in Article I, Section 8, Congress's power is explicitly qualified, making the Patent Clause unique.⁸⁵

Because Congress is authorized to act only pursuant to the power it is given in the Constitution, the adoption of the first-to-file standard is only possible if the Patent Clause allows patent rights to be vested in someone other than the first inventor. The Constitutional limitations provided in the Patent Clause secure exclusive rights only to "Inventors" for their "Discoveries."⁸⁶ At the time the Constitution was written, an inventor was defined as "one who produces something new; a deviser of something not known before."⁸⁷ In 1787, "to discover" was defined as "to bring to light," "to find out" or "to make known."⁸⁸ These words have the same meaning today,⁸⁹ and on their face, still appear to refer to the *first* discovery.

However, for the PRA to be constitutional, Congress must be able to define "Inventors" in the Patent Clause.⁹⁰ Therefore, it is necessary to examine the historical context of the term "Inventor" to ascertain the Framers' intent. There was no recorded debate at the Constitutional Convention about the definition of the terms "Inventors" and "Discoveries."⁹¹ In Federalist No. 43, James Madison refers to "Inventors" as individuals and to the right of invention as a personal right that can be claimed only by an inventor: "The copyright of authors has been solemnly adjudged, in Great Britain, to be a right of common law. The right to useful inventions seems with equal reason to belong to the inventors."⁹²

⁸⁵ Great A. & Pac. Tea Co. v. Supermarket Equip. Corp., 340 U.S. 147, 168 (1950) (Douglas, J., concurring); *Figuera v. U.S.*, 66 Fed. Cl. 139, 149 (2005) ("The Intellectual Property Clause is unique in that it is the only one of the Enumerated Powers where the drafters mandated 'a specific mode of accomplishing the particular authority granted,' *i.e.*, 'by securing exclusive rights for limited times to authors and inventors in their respective writings and discoveries.'").

⁸⁶ See U.S. CONST. art. I, § 8, cl. 8.

⁸⁷ SAMUEL JOHNSON, A DICTIONARY OF THE ENGLISH LANGUAGE, vol. 1 (1787); THE MERRIAM-WEBSTER DICTIONARY, 5th ed., 222 (1997) (listing a relatively unchanged definition today). The Merriam-Webster Dictionary defines the term "invent" as "to think up" and alternatively "to create or produce for the first time." *Id.*

⁸⁸ JOHNSON, *supra* note 87. An alternative definition at the time was "to make known; not to disguise; to reveal." *Id.* While this definition could give rise to the argument that "discoveries" is a term the Framers intended to use to cover the act of disclosure, examining the context of the Clause and the historical interpretation of the Clause, "discoveries" has been established to mean the activity of the inventor. See A.H. Seidel, *The Constitution and a Standard of Patentability*, 48 J. PAT. OFF. SOC'Y 1, 15.

⁸⁹ MERRIAM-WEBSTER DICTIONARY, 5th ed., 222 (1997). The modern definition of "to discover" is "to obtain sight or knowledge of for the first time" or "to make known or visible." *Id.*

⁹⁰ U.S. CONST., art I, § 8, cl. 8. Holbrook, *supra* note 6, at 6.

If the language in the [Patent] clause means "the inventor," and not "an inventor," then the exclusive rights must be awarded to the first to invent. Consequently, Congress would not have the power under the Constitution to change the patent law to redefine the term "inventor" to mean the first to file a patent application.

Id.

⁹¹ Edward Walterscheid, *Priority of Invention: How the United States Came to Have a First-to-Invent Patent Standard*, 23 AIPLA Q.J. 263, 281 (1995).

⁹² THE FEDERALIST NO. 43 (James Madison). It is not necessary to agree with Madison that the right of invention is a "natural right" to understand the implications of Madison's view. See *supra* text accompanying note 27. If the inventor had a right recognized at common law, the use of "Inventors" in the Patent Clause would seem to point to a person rather than a concept open to interpretation by Congress.

Early English practices give little insight into the meaning of the term “Inventors,” or “Priority of Invention.”⁹³ Proponents of the first-to-file standard argue that the Framers could not have intended patent rights exclusively for the original inventor, because English common law extended patent rights to the “first importer.”⁹⁴ Despite the common law interpretation, the United States rejected this idea in 1790, after proposed legislation failed due to concerns that it conflicted with the Constitutional standard in the Patent Clause.⁹⁵

Proponents of implementing the first-to-file standard in the United States also may argue that the purpose of the Patent Clause would be better served by the first-to-file standard.⁹⁶ The Patent Clause is different from the other enumerated powers of the Constitution.⁹⁷ The language stating that Congress has the authority “to promote the Progress of Science and useful Arts . . .” arguably is a preamble, setting forth the purpose of the Patent Clause.⁹⁸ Arguably, the first-to-file standard is a better way to achieve this objective.⁹⁹

While Congress generally may choose the best ways to implement a Constitutional provision, Congress cannot exceed the limits of its granted authority.¹⁰⁰ Unlike the other enumerated powers, the Framers listed specific

⁹³ Walterscheid, *supra* note 91, at 266–67. While the exact number of patent cases in England prior to 1790 is unknown, of the sixteen recorded cases, none dealt with priority of invention. *Id.* at 267 n. 10. Instead, when there was debate over a patent, the most likely result was that neither party would receive the patent on the grounds that it was not new. *Id.* at 268.

⁹⁴ *Id.* at 266–67. England, until the middle of the nineteenth century, granted patents as long as the invention was new to England, regardless if it was known in other parts of the world. *Id.* This practice was known as granting patents to the “first importer,” who was not necessarily the innovator. *Id.*

⁹⁵ *Id.* at 282. In 1790 the House committee drafted H.R. 41, which eventually became the Patent Act of 1790. *Id.* H.R. 41 specifically authorized patents to be granted to the first importer. *Id.* Debate on the bill led to the removal of this section due to concerns that patents of importation were beyond the Constitutional authority of Congress. *Id.* Representative Thomas Fitzsimmons wrote “The 6th Section, allowing Importers, was left out, the Constitutional power being Questionable.” *Id.* Madison had also argued “that patents of importation were unconstitutional.” *Id.* Therefore, while English Common law recognized the rights of the first importer, this idea was never part of the American patent standard due to concerns over constitutional validity. *Id.*

⁹⁶ See generally Walterscheid, *supra* note 91.

⁹⁷ See *Great A. & Pac. Tea Co. v. Supermarket Equip. Corp.*, 340 U.S. 147, 168 (1950) (Douglas, J., concurring); see also *Graham v. John Deere Co.*, 383 U.S. 1, 5 (1966) (noting that the Patent Clause is both a grant and a limitation of power); *Figuera v. United States*, 66 Fed. Cl. 139, 149 (2005) (recognizing that the Patent Clause is unique in that it is the only Clause where the Framers directed a specific mode for accomplishing its stated purpose).

⁹⁸ U.S. CONST., art I, § 8, cl. 8; see *Figuera*, 66 Fed. Cl. at 149.

⁹⁹ Peter A. Jackman, *Essay, Adoption of a First-To-File Patent System: A Proposal*, 26 U. BALT. L. REV. 67, 86 (1997).

¹⁰⁰ *Graham*, 383 U.S. at 6.

Within the limits of the constitutional grant, the Congress may, of course, implement the stated purpose of the Framers by selecting the policy which in its judgment best effectuates the constitutional aim. This is but a corollary to the grant to Congress of any Article I power. Within the scope established by the Constitution, Congress may set out conditions and tests for patentability.

Id.

provisions for the implementation of the Patent Clause's purpose.¹⁰¹ The stated requirements for granting an exclusive right were most likely established due to the Framers' fear of monopolies.¹⁰² Even if the first-to-file standard is the best way to "promote the Progress of Science and useful Arts," in today's global society, the Constitutional commands cannot be ignored.¹⁰³ Therefore, proponents of the first-to-file standard still must satisfy the specific requirements expressed in the Patent Clause.

However, the Framers clearly believed that in order to "promote the Progress of Science and useful Arts," there must be an incentive for inventors to continue their work.¹⁰⁴ Therefore, one of the main purposes behind the Patent Clause is to give inventors "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.'"¹⁰⁵ The first-to-file standard does not necessarily compensate the original inventor, but the person who files the application first. Accordingly, there is not security in being the first inventor.

Proponents of the first-to-file standard may also argue that Congress has the authority to implement the first-to-file standard through its other expressed Constitutional powers.¹⁰⁶ Congress also has authority to pass patent legislation through its Commerce Clause power or its power to approve treaties.¹⁰⁷ Therefore, supporters of the first-to-file standard may argue that the standard is constitutional under these provisions.¹⁰⁸

However, Congress's general grant of power under other Constitutional provisions is not enough to implement a standard that would ignore the specifically defined limitations of the Patent Clause.¹⁰⁹ While Congress may be constitutionally

¹⁰¹ *Figuera v. United States*, 66 Fed. Cl. 139, 149 (2005). "[T]he drafters mandated 'a specific mode of accomplishing the particular authority granted [in the Patent Clause],' *i.e.*, 'by securing exclusive rights for limited times to authors and inventors in their respective writings and discoveries.'" *Id.*

¹⁰² *Graham*, 383 U.S. at 7.

¹⁰³ U.S. CONST., art I, § 8, cl. 8; *Graham*, 383 U.S. at 6.

¹⁰⁴ *Graham*, 383 U.S. at 8 (citing Writings of Thomas Jefferson, (vol. 5) at 47 (Ford ed., 1895)). Jefferson, in an 1807 letter, stated that "Certainly an inventor ought to be allowed a right to the benefit of his invention for some certain time. . . ." *Id.*

The economic philosophy behind the clause empowering Congress to grant patents and copyrights is the conviction that encouragement of individual effort by personal gain is the best way to advance public welfare through the talents of authors and inventors in "Science and useful Arts." Sacrificial days devoted to such creative activities deserve rewards commensurate with the services rendered.

Mazer v. Stein, 347 U.S. 201, 220 (1953).

¹⁰⁵ *Allen v. Hunter*, 1 F. Cas. 476, 477 (D. Ohio 1855).

¹⁰⁶ See generally Holbrook, *supra* note 6 (discussing patent harmonization and the relationship of the Patent Clause to other constitutional provisions).

¹⁰⁷ U.S. CONST., art. I, § 8, cl. 3 ("To regulate Commerce with foreign Nations, and among the several States, and with the Indian Tribes."); U.S. CONST., art. II, § 2, cl. 2 ("He shall have Power, by and with the Advice and Consent of the Senate, to make Treaties, provided two-thirds of the Senators present concur.").

¹⁰⁸ U.S. CONST., art. I, § 8, cl. 3; U.S. CONST., art. II, § 2, cl. 2; U.S. Const. art. I, § 8, cl. 8.

¹⁰⁹ *Miller v. Pasco*, 310 P.2d 863, 866 (Wash. 1957). "[E]ach and every section of a legislative enactment must be given meaning, and . . . where general powers are granted with specific powers

authorized to act under other provisions to enact a multi-national patent standard, the standard created still must be in accordance with the other Constitutional provisions.¹¹⁰ If the first-to-file standard exceeds the Constitutional requirements in the Patent Clause, such legislation could not be a proper exercise of authority under any other general Constitutional provision, either.¹¹¹

A plain reading of the Patent Clause indicates that an exclusive right to an invention can only be granted to the original inventor, not to the person who wins the race to the patent office. The use of the words “Inventors” and “Discoveries” seems to convey rather clearly that the Framers intended the Clause to refer to the first or original inventor as opposed to anyone who later develops the same invention independently. This is supported by the lack of debate from the Constitutional Convention,¹¹² the refusal to allow the first importer to obtain patent rights,¹¹³ and the goal of encouraging invention by compensating the inventor.¹¹⁴

The plain meaning interpretation is also consistent with the use of the word “securing” when describing the “exclusive right” of a patent. In Federalist 43, Madison drew an explicit correlation between the property right of the inventor and the public good.¹¹⁵ Indeed, redefining the “Inventors” to be the people anointed by the act of a government filing disregards the Framers’ concern that government patent monopolies should be strictly limited.¹¹⁶

B. Two Hundred Years of Settled Law

Congress has instituted patent legislation through various Patent Acts.¹¹⁷ There have been various issues litigated in response to this legislation.¹¹⁸ In dealing with

enumerated, the general powers are modified, limited, and restricted to the extent of the specific enumeration.” *Id.*

¹¹⁰ *See Id.* “[T]he general grant of power must yield in its scope to the specific powers enumerated.” *Id.*

¹¹¹ *See Id.*

¹¹² Walterscheid, *supra* note 91, at 281. “It is unfortunate that no delegate left any record as to what the Convention intended ‘inventors’ and ‘discoveries’ to mean.” *Id.*

¹¹³ *Id.* at 282 (rejecting first importer, even though it was the practice in England at the time, due to Constitutional concerns).

¹¹⁴ *Graham v. John Deere Co.*, 383 U.S. 1, 9 (1966). The Court noted that the patent right was designed as a “reward, an inducement, to bring forth new knowledge.” *Id.*

¹¹⁵ THE FEDERALIST NO. 43 (James Madison) (“The public good fully coincides in both cases with the claims of individuals.”).

¹¹⁶ *See Ballonoff*, *supra* note 6, at 402 (recognizing that the Framers intentionally left out the word “patent” from the Patent Clause because at that time it was understood to mean a grant of an economic right by the government).

¹¹⁷ Patent Act of 1790, 1 Stat. 109; Patent Act of 1793, 1 Stat. 318; Patent Act of 1836, 5 Stat. 117; Patent Act of 1870, 16 Stat. 198; Patent Act of 1874, 18 Stat. 78; Patent Act of 1952, 66 Stat. 797.

¹¹⁸ *Chisum*, *supra* note 4.

Landmarks [court decisions] included *Mergenthaler v. Scuder*, [11 App. D.C. 264] (1897), defining conception; *Mason v. Hepburn*, [13 App. D.C. 86] (1898), holding that a first inventor loses priority by abandoning, suppressing or concealing the invention after reduction to practice; *Automatic Weighing Machine v. Pneumatic Scale Corp.* [166 F. 288 (1st Cir.) 1909], holding that the filing of a patent

patent disputes, the Supreme Court has not only looked at what qualifies as an invention, but also who qualifies as an inventor.¹¹⁹

The early Patent Acts required elements of novelty and utility before an invention could be patented.¹²⁰ The Patent Act of 1952 added a third element: non-obviousness.¹²¹ In considering a challenge to Congress's authority to add this requirement, the Supreme Court found that the non-obvious requirement did not expand the Constitutional standard, but merely codified it.¹²² The Court has found that "innovation, advancement, and things which add to the sum of useful knowledge are inherent requisites in a patent system which by constitutional command must 'promote the Progress of . . . useful Arts.' This is the *standard* expressed in the Constitution and it may not be ignored."¹²³ The Court has warned against attempts to broaden the definition of patents beyond the Constitutional limitations.¹²⁴

While the first-to-file standard does not seek to change the requirements for invention, it does attempt to change the person who has the rights to the invention.¹²⁵ Courts have consistently held that exclusive rights are granted to the original inventor.¹²⁶ Just as some individuals have over the years attempted to expand what qualifies as an invention, some have also tried to expand the definition of an inventor.¹²⁷

Those in favor of the first-to-file standard would argue that this standard does not expand the meaning of the term "Inventors."¹²⁸ Instead, they argue that modern practicalities often result in two people developing the same invention independently.¹²⁹ In these cases, it could be argued, both are inventors who spent time and resources developing their idea. Therefore, the adoption of the first-to-file

specification adequately disclosing the invention is constructive reduction to practice; and *Sydean v. Thomas*, [32 App. D.C. 362] (1909) summarizing a long series of decisions on what constitutes an actual reduction to practice.

Id.

¹¹⁹ *See, e.g.*, *Dietz v. Wade*, 7 F. Cas. 684, 690 (D.C. Cir. 1859) (noting that the person who invents first is the inventor as long as he uses reasonable diligence to reduce it to practice). This is true regardless of whether a second person reduces the same to practice first. *Id.*

¹²⁰ Patent Act of 1790, § 1, 1 Stat. 109; Patent Act of 1793, § 1, 1 Stat. 318, 318; Patent Act of 1836, § 1, 5 Stat. 117, 118; Patent Act of 1870, § 24, 16 Stat. 198, 201.

¹²¹ Patent Act of 1952, § 103, 66 Stat. 797, 798.

¹²² *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966).

¹²³ *Id.* at 6.

¹²⁴ *E.g.*, *Great A. & Pac. Tea Co. v. Supermarket Equip. Corp.*, 340 U.S. 147, 169–70 (1950) (Douglas, J., concurring). Justice Douglas, in his concurrence, criticized attempts to depart from the Constitutional standard for patents. *Id.*

¹²⁵ *See* Patent Act of 2005, H.R. 2795, 109th Cong. § 3.

¹²⁶ *See, e.g.*, *Allen v. Hunter*, 1 F. Cas. 476, 477 (D. Ohio 1855). "No exclusive right can be granted for anything which the patentee has not invented or discovered." *Id.* "And the law gives [the inventor] 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.'" *Id.* "To sustain his patent, the plaintiff must show that he was the first and original inventor or discoverer." *Id.* at 479.

¹²⁷ *See* Patent Act of 2005, H.R. 2795, 109th Cong. § 3 (2005) (proposing a first-to-file standard). *See also* *Suominen*, *supra* note 8, at 1 (discussing various attempts to change the United States to a first-to-file standard).

¹²⁸ *Walterscheid*, *supra* note 91, at 281.

¹²⁹ *Jackman*, *supra* note 99.

standard would create a simple way for solving these disputes because the patent would be granted to the individual with the earliest patent filing date.¹³⁰

While this has a certain practical appeal, it runs contrary to the past two hundred years of interpretation and application of the Patent Clause. Until the PRA, the Patent Acts have continued to reject the first-to-file standard, and the courts have consistently held that awarding patent rights to the original inventor is in accordance with the Constitution.¹³¹ Therefore, interpretation and application have always understood the term “inventor” to mean the first person to invent.

C. Current Policy

In addition to considering the meaning of the Constitutional text and its subsequent interpretations through legislation and case law, it is also necessary to consider current policy in regard to the patent dispute resolution. Practical considerations exist both in favor of and against adopting a first-to-file standard in the United States. Debates regarding the first-to-file standard often focus only on the practical issues.

Proponents of the first-to-file standard mainly stress the need for international patent harmonization.¹³² The first-to-invent standard currently in place affects the United States both politically and economically.¹³³ The United States is often unable to join in international treaties due to its failure to implement a first-to-file standard.¹³⁴ Arguably, this also prevents the United States from effectively competing in the international patent market.

Additionally, proponents of the first-to-file standard argue that individual inventors with fewer resources will benefit.¹³⁵ It is argued that interferences, the legal mechanism for determining patent rights during a dispute, usually result in a loss for the independent inventor against the inventor with large funds due to the cost of the procedure.¹³⁶ Interferences are not necessary in a first-to-file standard.¹³⁷

¹³⁰ Kelber, *supra* note 8, at S1–2.

¹³¹ Patent Act of 1790, § 1, 1 Stat. 109, 109–10; Patent Act of 1793, §§ 3, 9, 1 Stat. 318, 321, 322–23; Patent Act of 1836, 5 Stat. 117; Patent Act of 1870, 16 Stat. 198; Patent Act of 1874, 18 Stat. 78; Patent Act of 1952, § 103, 66 Stat. 797. *See, e.g.*, *Shaw v. Cooper*, 32 U.S. 292, 318–19 (1833) (noting that the legislature, through the various Patent Acts, intended to vest the exclusive patent right in the inventor only); *Stamicarbon v. Sepracor, Inc.*, No. 97-8, 2001 U.S. Dist. LEXIS 9061, at *17, *24 (D. Delaware March 12, 2001) (continuing to uphold the patent dispute resolution standard awarding the patent to the first inventor, not the first-to-file).

¹³² Pedersen, *supra* note 10, at 764–65. Implementing a first-to-file standard in the United States, bringing the United States in line with Europe and Japan is important as part of the plan to create an international treaty, which would create mutual reciprocity for patents granted in any of these countries. *Id.* This would lead to not only recognition of the patents granted by different countries, but also would encourage enforcement of foreign patents within each country. *Id.*

¹³³ *See, e.g.*, Fiorito, *supra* note 9, at 83, 88–89.

¹³⁴ *Id.*

¹³⁵ Ebert, *supra* note 11, ¶ 9; Pedersen, *supra* note 10, at 765–66.

¹³⁶ Ebert, *supra* note 11, ¶ 9.

¹³⁷ Ludwig, *supra* note 60, ¶ 26.

Therefore, the first-to-file standard for patent dispute resolution provides individual inventors security without the cost of expensive litigation.¹³⁸

While there are mainly historical reasons for not adopting the first-to-file standard, there are also practical considerations. For instance, while small entities or individual inventors may worry about the cost associated with interferences, they would replace that cost with the expense of rushing to file an application.¹³⁹ Additionally, they will encounter the expense of continuously filing applications as the invention develops.¹⁴⁰ With continuous filing the inventor not only risks not having the funds to file updated applications, but also jeopardizes efforts to attract new sponsors and researchers.¹⁴¹ Also, examination costs and workload will increase at the PTO.¹⁴² If there is a rush to file applications, the quality of the applications will decrease, which will increase the cost of examination.¹⁴³ These practical considerations must be considered before implementing the first-to-file standard.

III. PROPOSAL

Given the constitutional uncertainty, Congressional alternatives are either to amend the Patent Clause, or reject the first-to-file standard, and look to alternative methods of patent reform.¹⁴⁴ Amending Article I, Section 8 of the U.S. Constitution is

¹³⁸ *Id.*; Ebert, *supra* note 11, ¶ 9; Lemley, *supra* note 10, ¶ 10.

¹³⁹ *Id.* ¶ 25.

¹⁴⁰ *Id.* In addition to the cost of filing more applications, the amount of pressure to file at the earliest possible point will also increase. Steve Seidenberg, *A Sea Change in Patent Law: Proposed Legislation Would Wean the United States From a 'First to Invent' Approval System*, 92 A.B.A. J. 49, ¶ 78 (2006). This added pressure and cost will have the greatest impact on individual inventors and small companies because larger companies already act as though the United States has a first-to-file standard, because that is how these companies are also filing applications in the rest of the world. *Id.* ¶ 78. Therefore, multi-national corporations are better prepared for a first-to-file standard because that is how they receive priority in foreign countries. *Id.*

¹⁴¹ Ludwig, *supra* note 60, ¶ 25.

¹⁴² Katona, *supra* note 64, at 402 (“[T]he hurried filing of erroneous and incomplete disclosures will increase the proportion of examining time required for adequacy of disclosure issues, thereby, requiring more total examining time per application if the same quality of examination on the merits is to be maintained.”).

¹⁴³ *Id.*

¹⁴⁴ See Federico, *supra* note 35, at 248 (noting that the original Patent Board rejected the first-to-file standard in favor of the first-to-invent standard); see also Walterscheid, *supra* note 91, at 281 (noting that Congress in 1790 rejected the first importer provision due to concerns that such legislation was beyond the Constitutional authority of Congress); *Allen v. Hunter*, 1 F. Cas. 476, 477 (D. Ohio 1855) (recognizing that “no exclusive right can be granted for anything which the patentee has not invented or discovered” and that the law gives him this right to compensate him for his effort). The court has also rejected attempts to broaden the scope of the Patent Clause by disregarding its limitations. *Great A. & Pac. Tea Co. v. Supermarket Equip. Corp.*, 340 U.S. 147, 168 (1950) (Douglas, J. concurring).

The attempts through the years to get a broader, looser conception of patents than the Constitution contemplates have been persistent. The Patent Office, like most administrative agencies, has looked with favor on the opportunity which the exercise of discretion affords to expand its own jurisdiction. And so it has placed a host of gadgets under the armour of patents -- gadgets that obviously have had no place in the constitutional scheme of advancing scientific knowledge.

both difficult and not necessarily beneficial to patent reform.¹⁴⁵ Congress should focus instead on reforming patent procedures implementing the first-to-invent standard.

When weighing the modern practical considerations against the historical foundation upon which the first-to-invent standard is based, it becomes evident that a Constitutional amendment would be unwise.¹⁴⁶ The first-to-invent standard is a uniquely American standard that has been in place for over two hundred years, and has proven itself to work.¹⁴⁷

The Framers were strongly opposed to monopolies and other abuses by the crown, and sought to prevent such abuses in the Constitution.¹⁴⁸ The Framers sought to prevent the federal government from gaining too much control by expressly limiting its powers. In the case of patents, the courts have upheld these limitations and have found that the right to patent exclusivity rests with the original inventor only.¹⁴⁹ To change the Constitutional standard at this point would result in patent

Id. at 169.

¹⁴⁵ See U.S. CONST., art. V. In order to bypass Constitutional provisions, the Constitution sets forth an amendment process. *Id.* Therefore, if Congress chooses to switch to the first-to-file standard, it can be added through a Constitutional amendment. *Id.* However, Congress cannot skip this process and implement legislation that is beyond its authority.

¹⁴⁶ Compare Lemley, *supra* note 10, at 3.

[F]irst inventor to file recognizes the international nature of today's markets . . . Because the rest of the world already uses filing rather than invention date to measure priority, first inventor to file will take an important step towards global harmonization, permitting U.S. inventors to more easily seek patent protection not just in the U.S. but [also] in other countries.

Id. with *Shaw v. Cooper*, 32 U.S. 292, 318–19 (1833) (finding that the Constitution authorized Congress to promote the useful arts by granting exclusive rights to the original inventor only), and *Allen v. Hunter*, 1 F. Cas. 476, 477 (D. Ohio 1855) (recognizing that “no exclusive right can be granted for anything which the patentee has not invented or discovered” and that the law gives him this right to compensate him for his effort).

¹⁴⁷ *Pennock v. Dialogue*, 27 U.S. 1, 17–18 (1829) (recognizing that while based on English common law, the United States patent standard is unique). While the first-to-invent standard is unique to America, so is the underlying philosophy upon which America is based. Compare U.S. CONST., with 1–2 *Doing Business in France* § 2.02 (Matthew Bender & Co. 2005) and 1–1 *Doing Business in the United Kingdom* § 1.04 (Matthew Bender & Co. 2005). The philosophy of the United States' trading partners is often based on a belief in the government and its efficiency. *E.g.*, 1–2 *Doing Business in France* § 2.02 (Matthew Bender & Co. 2005). French law is based primarily on statutory law, not common law. *Id.* The French government creates and updates the laws. *Id.* Accordingly, France does not depend on common law rights, but only government created rights. The rights in other countries exist because the government gave the people those rights. *E.g.*, 1–1 *Doing Business in the United Kingdom* § 1.04 (Matthew Bender & Co. 2005). Because there is no written British Constitution, no law is above any other law. *Id.* There is no Bill of Rights or other documenting protecting any individual rights. *Id.* Therefore, it is the government that defines and protects the people's rights. *Id.*

¹⁴⁸ Letter from Thomas Jefferson to James Madison (July 31, 1788), available at <http://www.constitution.org/tj/jeff07.txt> (“The benefit even of limited monopolies is too doubtful to be opposed to that of their general suppression.”).

¹⁴⁹ See *Stamcarbon v. Sepracor, Inc.*, No. 97–8, 2001 U.S. Dist. LEXIS 9061, *17, *24 (D. Delaware March 12, 2001) (continuing to uphold the patent dispute resolution standard awarding the patent to the first inventor, not the first-to-file); *Seymour v. Osborn*, 78 U.S. 516, 533–34 (1870) (reasoning that the role of patents are to compensate “inventors for their labor, toil, and expense in making the inventions, and reducing the same to practice for the public benefit, as contemplated by

rights running with the invention, not the inventor. If the incentives for an inventor are not adequately protected, then society will not receive the intended benefits. Madison and Jefferson knew that the Patent Clause is based upon this fundamental principle.¹⁵⁰

Changing the Constitutional limitations in the Patent Clause could result in the abuses the Framers intended to prevent.¹⁵¹ While it seems straightforward to talk about “filing,” the practical application of this term could involve great subjectivity. The issue of what constitutes a “filing,” (the forms, place, time, discretion of patent office personnel, and other issues typically raised by government regulation and enforcement), could lead to the type of uncertainty that first-to-file proponents seek to avoid.

More fundamentally, adopting a government filing as the ultimate standard of awarding patent rights amounts to a fundamental shifting in the limitations of the Patent Clause. Framers feared monopolies and other exercises of government power, and carefully restricted Congressional authority to grant patent rights to individuals who could demonstrate an action completely independent of the government: the first creation of a literary work or invention.¹⁵² The implementation of a first-to-file standard alters the basis for receiving a patent monopoly to an event involving the government, the consequences of which cannot be fully understood.

If Congress wants to reform the patent process, it should look to better implementation of the current standard, and not depart from the Framers’ intention and current Constitutional requirements. Improving the efficiency and certainty in the patent process might take three initial steps. First, require transparency in the standard. Currently, most patent applications are published within eighteen months of filing.¹⁵³ However, the publication excludes patents that are filed only domestically.¹⁵⁴ This broad exception prevents the United States from achieving its intended goals of preventing duplicate research and warning inventors of possible conflicts.¹⁵⁵

the Constitution and sanctioned by the laws of Congress”); *Shaw v. Cooper*, 32 U.S. 292, 318–19 (1833) (noting that the legislature, through the various Patent Acts, intended to vest the exclusive patent right in the inventor only).

¹⁵⁰ See THE FEDERALIST NO. 43 (James Madison); see also *Graham v. John Deere Co.*, 383 U.S. 1, 8 (citing V Writings of Thomas Jefferson at 47 (Ford ed., 1895)).

¹⁵¹ JOAN THIRSK, *ECONOMIC POLICY AND PROJECTS: THE DEVELOPMENT OF CONSUMER SOCIETY IN EARLY MODERN ENGLAND* 34 (Clarendon Press) (1978). In the Seventeenth Century, but before the Statute of Monopolies was enacted, patents were issued as a way of alternative taxation and rewarding loyal servants. *Id.* Patents involved the grant of a protected right in trade or industry in exchange for a cash payment to the Crown. *Id.* Elevating patent application filing to determinative status places the government in the position the framers feared.

¹⁵² THE FEDERALIST NO. 43 (James Madison).

¹⁵³ Symposium, *Ideas Into Action: Implementing Reform of the Patent Standard: The Proper Balance of Competition and Patent Law and Policy: Executive Summary*, 19 BERKELEY TECH. L.J. 861, 879 (2004) [hereinafter *Ideas Into Action*]. Patents used to be published only when they were issued, while patent applications were never published. *Id.*

¹⁵⁴ *Id.*

¹⁵⁵ Reiko Watase, *Note: The American Inventors Protection Act of 1999: An Analysis of the New Eighteen-Month Publication Provision*, 20 CARDOZO ARTS & ENT. L.J. 649, 679 (2002).

Therefore, all patent applications, including those filed domestically, should be published¹⁵⁶ in a free public database that is easily accessible to all. This would allow all inventors, corporations, or individuals to access patent applications. An inventor claiming priority can raise a claim at an earlier point before either party spends considerable effort and resources developing the invention.¹⁵⁷ Potentially, some disputes can be resolved before a patent is even issued. Also, the quality of any resulting patent will be heightened because publication allows for added scrutiny. Additionally, publishing patent applications improves certainty in patents that are eventually granted and lessens expense. Of course, it is necessary to protect the inventor from others copying the invention from the published application, which can be accomplished by awarding the inventor damages for such an infringement if the application results in a patent.¹⁵⁸ Immediate publication of patent applications also serves to further encourage inventors to file quickly, without eliminating the rights of the true inventor.

Second, once the application has been filed, steps should also be taken to further streamline the process by which the patent is challenged. Any priority challenges should be expedited through an administrative proceeding. These claims should be reviewed quickly using arbitrators that are experienced in the field. These administrative proceedings should, in an expedited and streamlined fashion, develop all factual matters. Appeals can be taken from these proceedings to an appellate court, with limited jurisdiction to only hear priority of patent appeals.¹⁵⁹

Third, Congress could limit the time to apply for a patent and to shorten the life of any patent not used to produce a product or service. For example, inventors might be required to file patent applications within a short time after the original invention date. Also, patents, once granted, might exist for only a few years from the date of invention, unless there is a showing that the patent holder had actually used the patent or licensed its use by others. Returning to the Constitutional standard of promoting innovations that actually promote the “Progress of Science and useful Arts” may lessen the uncertainty of the current system. This would encourage subsequent inventors to bring new products and services to the marketplace with less fear of unknown inventors or professional patent holders (commonly referred to as “trolls”) seeking advantage from inaction.

Taking advantage of technology and modern communication standards, streamlining the interference process, and returning to Constitutional standards to require patent usefulness may increase stability in the current standard. However,

¹⁵⁶ *Ideas Into Action*, *supra* note 153 (“Hearing participants advocated expanding the 18-month publication requirement to include patents filed only domestically, because such patents may well have competitive significance.”).

¹⁵⁷ *See* Watase, *supra* note 155.

¹⁵⁸ *Ideas Into Action*, *supra* note 153 (noting that when publication is required, “patent applicants are protected from copying [of] their inventions by statutory royalty rights, if the patent ultimately issues”).

¹⁵⁹ *General Instrument Corp. v. Scientific-Atlanta, Inc.*, 995 F.2d 209, 211 (Fed. Cir. 1993).

Section 146 of Title 35 provides that “any party to an interference dissatisfied with the decision of the Board . . . may have remedy by civil action.” Consequently, such a party may timely file a complaint in an amenable federal district court challenging the decision of the Board awarding priority to another.

Id.

it is not the focus here to exhaustively list possible improvements in patent procedures. Rather, it is suggested that Congress focus on procedural reform rather than attempt a fundamental shift in the Constitutionally based patent law.

IV. CONCLUSION

Section 3 of H.R. 2795, which departs from over two hundred years of settled patent law by adopting a first-to-file standard for patent dispute resolution, should not be enacted because it is unconstitutional under Article I, Section 8, Clause 8 and contrary to the fundamental concerns of the Framers in strictly limiting monopolies.¹⁶⁰ The Patent Clause is both a grant and a limitation of Congressional power, making this Clause unique from the other Article I, Section 8 powers.¹⁶¹ Therefore, Congress can only act in accordance with the power it has been granted.

Despite few insights into the intended meaning of the term “Inventors,” Congress and the courts have continued to interpret its meaning as the first inventor, not the first person to file an application.¹⁶² The Patent Clause not only expresses its purpose, but also the manner in which it should be implemented.¹⁶³ Therefore, the term “Inventors” cannot be altered to effect change in the patent standard.

For over two hundred years, Congress and the courts have consistently interpreted the principles required by the Patent Clause.¹⁶⁴ While there are current pressures to adopt the first-to-file standard due to the efforts toward international patent harmonization, this cannot be done at the expense of upholding the United States Constitution.¹⁶⁵ Such a change is not only contrary to the Constitutional requirements, but also invites the abuses the Framers sought to prevent. The first-to-file standard denies original inventors their property rights simply because someone else first filed a form in a government office. This is incompatible with the principle that patent monopolies should only be granted to compensate inventors for their innovation.

¹⁶⁰ U.S. CONST. art. I, § 8; Patent Reform Act 2005, H.R. 2795, 109th Cong. § 3 (2005).

¹⁶¹ *Graham v. John Deere Co.* 383 U.S. 1, 5 (1966).

¹⁶² *Shaw v. Cooper*, 32 U.S. 292, 318–19 (1833) (noting that the legislature, through the various Patent Acts, intended to vest the exclusive patent right in the inventor only).

¹⁶³ U.S. CONST., art. I, § 8, cl. 8.

¹⁶⁴ U.S. CONST., art. I, § 8, cl. 8; *Shaw*, 32 U.S. at 318–19 (noting that the legislature, through the various Patent Acts, intended to vest the exclusive patent right in the inventor only).

¹⁶⁵ Fiorito, *supra* note 9, at 83, 88–89.