

June 13, 2011

The Honorable Lamar Smith
Chairman
Committee on the Judiciary
U.S. House of Representatives
Washington, D.C.

Dear Sir:

This letter addresses a single issue: the claim that the first-inventor-to-file provisions in Section 3 of the America Invents Act, H.R. 1249, are unconstitutional in view of Article I, Section 8, Clause 8. The basis for this claim is that the only person who can constitutionally qualify as an “inventor” is the *first* person who invents something, such that Congress lacks the power to grant patent rights to others who independently invent, no matter how compelling the circumstances. The signatories to this letter, all professors of law, disagree with this claim of unconstitutionality. The claim cannot be squared with well-accepted and longstanding rules of current patent law.

Our reasons are as follows:

- **Article I, Section 8, Clause 8 of the Constitution empowers Congress to grant “exclusive Rights” to “Inventors”**
 - Congress’ power to create copyright and patent systems, respectively, originates from Article I, Section 8, clause 8: “The Congress shall have 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”
 - The clause refers to “Inventors,” not to “first inventors”; it does not dictate how Congress should define who an “inventor” may be; it does not limit Congress power to place conditions on true inventors to obtain these exclusive rights; it does not specify how Congress should distribute rights among multiple persons who invent the same thing; it does not even specify that the “exclusive right” granted to the “Inventor” must be in the form of a patent. See WILLIAM C. ROBINSON, I THE LAW OF PATENTS FOR USEFUL INVENTIONS § 46 (1890) (“The authority thus conferred on Congress is unrestricted as to the method of its exercise.”)

- **Congress has exercised its power under the Intellectual Property clause by enacting statutes that offer patent rights to persons who “invent or discover”**
 - Congress’ first patent statute, the 1790 Patent Act, provided that persons who “invented or discovered” inventions could petition for patent rights, subject to other specified conditions. *See also Bd. of Trustees of Leland Stanford Jr. University v. Roche Molecular Sys., Inc.*, 563 U.S. ____ (June 6, 2011) (confirming that “[s]ince 1790, the patent law has operated on the premise that rights in an invention belong to the inventor”).
 - The current statute, the 1952 Patent Act, provides that “[w]hoever invents or discovers” inventions can seek patent rights, subject to other specified conditions – 35 U.S.C. § 101

- **Under the current “first to invent” system, Congress and the courts have long recognized that a person who independently invents something is an “inventor,” and does not lose that status merely because someone else has also invented the same thing**
 - Even under our present “first-to-invent” system, U.S. law does not favor the first inventor over subsequent inventors in all circumstances. The most distinguished patent jurist of the twentieth century pointed out that the current first-to-invent system is better understood as a *qualified* first-to-invent system. *Young v. Dworkin*, 489 F.2d 1277, 1282-83 (C.C.P.A. 1974) (Rich, J., concurring) (“The United States patent system is a first-to-invent system, wherefore we have interferences to determine, in cases of conflict, who the first inventor is. But for at least a century it has been a qualified first-to-invent system. The de facto first inventor has not necessarily been adjudged to be the de jure first inventor.”)
 - Under the current “first to invent” system, the actual “first to invent” ultimately may not be awarded the patent if he “abandoned, suppressed, or concealed” the invention. In those circumstances, the second inventor can be awarded the patent. 35 U.S.C. 102(g). If the constitutional argument is correct – that the Constitution mandates that the patent be awarded only to the true “first to invent” – then the constitutionality of this long-standing patent rule would be in doubt. This rule, however, confirms that Congress has discretion to establish conditions on who, among competing inventors, has the right to the patent. The rule of awarding the patent to the second to invent in these circumstances has been an integral part of the patent system since the 19th century:
 - *Mason v. Hepburn*, 13 App. D.C. 86, 91 (App. D.C. 1898)(“[A] subsequent inventor of a new and useful manufacture or improvement who has diligently pursued his labors to the procurement of a patent in good faith and without any knowledge of the preceding discoveries of another, shall, as against that other,

who has deliberately concealed the knowledge of his invention from the public, be regarded as the real inventor and as such entitled to his reward")

- *Kendall v. Winsor*, 62 U.S. 322, 328 (1858) ("[T]he inventor who designedly, and with the view of applying it indefinitely and exclusively for his own profit, withholds his invention from the public, comes not within the policy or objects of the Constitution or acts of Congress. He does not promote, and, if aided in his design, would impede, the progress of science and the useful arts. . . . Hence, if, during such a concealment, an invention similar to or identical with his own should be made and patented, or brought into use without a patent, the latter could not be inhibited nor restricted, upon proof of its identity with a machine previously invented and withheld and concealed by the inventor from the public.")
- *Gayler v. Wilder*, 51 U.S. 477 (1850) (argument of Daniel Webster, endorsed by the Supreme Court: "The object of the patent law, and of the Constitution under which the law was passed, was the public benefit. If this be so, how does a man bring himself within its provisions who locks his secret in his own breast? And why is he less a benefactor to the public who invents a machine which had been before invented and afterwards forgotten, than he who invents something never before known?")

- Similarly, under the first-to-invent system as it existed from the late nineteenth century until 1996, a foreign inventor was unable to use evidence of his activities outside of the United States to prove that he was in fact the first to invent; therefore, the second to invent could be awarded the patent. 35 U.S.C. § 104 (repealed). The assertion that all subsequent inventors cannot constitutionally qualify as "Inventors" cannot be squared with this long-existing practice.

➤ **H.R. 1249 leaves in place the existing provision offering patent rights to persons who "invent or discover"**

- H.R. 1249 would make no change to current 35 U.S.C. § 101. Patents would still be awarded to those who "invent or discover."
- H.R. 1249's proposed "first inventor to file" provisions adopt the longstanding view that a person who independently invents is an "inventor" and does not lose that status merely because someone else has also invented the same thing.
- H.R. 1249's derivation provision confirms that Congress is extending patent protection only to a true inventor; a patent applicant or patent holder who took the idea, or derived it, from someone else cannot be considered a true inventor and is not entitled to the patent, even if he was the first to file an application on the invention. See H.R. 1249 §3(h) & (i).

- H.R. 1249 simply places a different condition on obtaining a patent: a true inventor must be the first to file an application to be awarded the patent. It is different only in degree from the present rule that the first inventor cannot abandon, suppress, or conceal the invention in order to obtain a patent.

In sum, the first-inventor-to-file provisions of H.R. 1249 raise no constitutional concerns under Art. I Sec. 8 Cl. 8. Congress has discretion in defining the term “inventor “ and is able to specify conditions that true inventors must satisfy in order to be awarded a patent. Art. I Sec. 8 Cl. 8 is silent about whether the condition is that the inventor not abandon, suppress, or conceal (as in the current system), that true inventor be the first among other true inventors to file a patent application, or that the true inventor satisfy some other set of conditions. The authority to create such conditions is well within Congress’s constitutional power. H.R. 1249’s first-inventor-to-file is “a rational exercise” of Congress’s legislative authority under the clause that “reflects judgments of a kind Congress typically makes” that cannot be “dismiss[ed] as outside the Legislature’s domain.” *Eldred v. Ashcroft*, 537 U.S. 186, 204-05 (2003).

Our patent laws are vital to American innovation. H.R. 1249 proposes to make many changes to existing American patent laws. H.R. 1249 is a complex bill; its provisions, and the policies that they seek to advance, deserve Congress’ attention and debate. Congress should not permit that debate to be sidetracked by the assertion that the first-inventor-to-file provisions violate Article I, Section 8, clause 8.

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*Cc: The Honorable John Conyers
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