

EXAMINING THE CONSTITUTIONALITY OF THE SHIFT TO “FIRST INVENTOR TO FILE” IN THE *LEAHY–SMITH AMERICA INVENTS ACT*

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*It is the sense of the Congress that converting the United States patent system from “first to invent” to a system of “first inventor to file” will promote the progress of science and the useful arts by securing for limited times to inventors the exclusive rights to their discoveries and provide inventors with greater certainty regarding the scope of protection provided by the grant of exclusive rights to their discoveries.*¹

Introduction

The Leahy–Smith America Invents Act dramatically changed the standard for obtaining patent rights in the United States by shifting from a “first to invent” system to a “first inventor to file” system for attaining patent rights in the United States.² Prior to the changes made by the America Invents Act, patent rights in the United States were granted based on a “first to invent” system whereby a patent was granted to the first individual to conceive of a new invention and reduce it to practice.³ In other words, only the so-called original or first-in-time inventor could obtain a patent. This occurred regardless of whether this original inventor was actually the first individual to file an application for a patent covering the invention with the United States Patent and Trademark Office.⁴ In instances when a subsequent (later in time) inventor was the first individual to file an application for or receive a patent, the original inventor could engage in a process known as an “interference proceeding” to establish her rights as the first inventor.⁵ In contrast,

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1. Leahy–Smith America Invents Act, Pub. L. No. 112-29, § 3(o), 125 Stat. 284, 293 (2011) (to be codified at 35 U.S.C. § 100).

2. *See id.*

3. *See Paulik v. Rizkalla*, 760 F.2d 1270, 1272 (Fed. Cir. 1985) (“United States patent law embraces the principle that the patent right is granted to the first inventor rather than the first to file a patent application.”).

4. *See* 35 U.S.C. § 102(g)(1) (2006) (repealed 2011) (stating a person shall be entitled to a patent unless “before such person’s invention thereof the invention was made by such other inventor and not abandoned, suppressed, or concealed, or (2) before such person’s invention thereof, the invention was made in this country by another inventor who had not abandoned, suppressed, or concealed it”). In other words, a first-filer would not receive patent rights if an earlier, diligent inventor existed.

5. *See* 35 U.S.C. § 135(a) (2006) (repealed 2011) (“Whenever an application is made for a patent which, in the opinion of the Director [of the Patent and Trademark Office], would interfere with any pending application, or with any unexpired patent, an interference may be declared and. . . [t]he Board of Patent

almost every other country in the world awards patents to the first individual to file for a patent, without considering whether the potential patentee was actually the first to invent (or conceive of and reduce to practice) the particular subject matter for which the patent is sought.⁶ This discrepancy between the method of obtaining patent rights in the United States and other nations, combined with treaties⁷ whereby nations have agreed to honor one another's filing dates,⁸ created the potential for applicants filing in one country to obtain favorable treatment over the applicants filing in another.⁹

However, under provisions of the America Invents Act, starting on March 16, 2013, patent rights in the United States will generally be granted to the first inventor to file with the United States Patent and Trademark Office.¹⁰ Under this new system, a second-in-time inventor who independently conceives of an invention can obtain rights over the invention (rather than the original or first-in-time inventor) by being the first to file a patent application for the invention.¹¹ In making this change, Congress stated that it intended to uphold the mandate set forth for the patent system in the Constitution.¹² Despite this, allegations persist that the

Appeals and Interferences shall determine questions of priority of the inventions . . ."). Accordingly, through interference proceedings, any patent rights awarded over a particular invention will be given to the first-in-time inventor rather than the first inventor to file for a patent.

6. See, e.g., Vito J. DeBari, Note, *International Harmonization of Patent Law: A Proposed Solution to the United States' First-to-File Debate*, 16 *FORDHAM INT'L L.J.* 687, 687-88 (1993) ("Nearly every other country in the world utilizes a 'first-to-file' system, which establishes priority of invention on the basis of the earliest effective filing date of a patent application disclosing and claiming an invention."). Notably, after the Philippines switched to a "first to file" system in 1998, the United States was left as the last nation utilizing the "first to invent" approach to patent rights. Gerald J. Mossinghoff, *Small Entities and the "First To Invent" Patent System: An Empirical Analysis* (2005), 1 n.1, <http://www.wf.org/upload/0505WPMossinghoff.pdf>.

7. For example, the Patent Cooperation Treaty (PCT) is one such international treaty. See Patent Cooperation Treaty, art. 11(3), June 19, 1970, 28 U.S.T. 7645, 1160 U.N.T.S. 231, available at <http://www.wipo.int/pct/en/texts/pdf/pct.pdf>.

8. Filing dates, the dates on which patent applications are filed, are used to determine priority and thereby establish which of several inventors should be given a patent over a particular invention.

9. See, e.g., *Yasuko Kawai v. Metlesics*, 480 F.2d 880, 883 (C.C.P.A. 1973) ("[W]ith adoption of the Paris Convention, an applicant's rights in one country insofar as they are affected by the filing date of a patent application could be determined as of the filing date of an earlier filed application in another country if both countries adhered to the Paris Convention. This was a particular advantage for an applicant in those countries where, unlike in the United States, the first to file for a patent on an invention is entitled to it even though he might not have been first to make the invention."); see also 35 U.S.C. § 363 (2006) ("An international application designating the United States shall have the effect, from its international filing date under article 11 of the treaty, of a national application for patent regularly filed in the Patent and Trademark Office except as otherwise provided in section 102(e) of this title.").

10. Leahy-Smith America Invents Act § 3(c). However, some limited exceptions to this general rule exist. For example:

The owner of a patent may have relief by civil action against the owner of another patent that claims the same invention and has an earlier effective filing date, if the invention claimed in such other patent was *derived* from the inventor of the invention claimed in the patent owned by the person seeking relief under this section.

Id. § 3(h)(1) (emphasis added). In other words, only *actual*, independent inventors may obtain patent rights.

11. *Id.* § 2.

12. *Id.* § 3(o) ("It is the sense of the Congress that converting the United States patent system from 'first to invent' to a system of 'first inventor to file' will promote the progress of science and the useful arts by securing for limited times to inventors the exclusive rights to their discoveries and provide inventors with greater certainty regarding the scope of protection provided by the grant of exclusive rights to their

sweeping overhaul of the American patent system contained in the America Invents Act violates the Constitution.¹³ Contrary to these contentions, this paper argues that the “first inventor to file” provisions in the America Invents Act are consistent with the Constitution and uphold Congress’s constitutional mandate to “promote the Progress of Science and the useful Arts.”¹⁴

This paper analyzes the changes made by Section 3 of the *America Invents Act* relating to the switch from a “first to invent” system to a “first inventor to file” system.¹⁵ Section I of this paper provides a brief overview of the history of the patent system in America, including both significant legislative changes made to the patent laws in the United States and some of the significant “first to invent” decisions made over the past two hundred years. Section II examines several of the arguments raised against the constitutionality of switching to a “first inventor to file” system. This paper concludes by analyzing whether the change from “first to invent” to “first inventor to file” is constitutional and upholds the preferences of the Framers of not granting monopolies without obtaining significant public benefit.¹⁶ In so doing, this paper examines the breadth of discretion granted to Congress in determining the intellectual property laws for the United States.

I. Background

The framework of patent laws in the United States can only be understood by examining the historical context in which the laws developed.¹⁷ The roots of the patent system in America can be traced back to the practice during the sixteenth and seventeenth centuries in England of allowing the monarch to grant exclusive commercial monopolies.¹⁸ Originally, no particular grounds were necessary for

discoveries.”).

13. See, e.g., Adam Mossoff, *The First-to-File Provision in H.R. 1249 is Unconstitutional: A Textual and Historical Analysis*, at 6 (“[T]he Constitution authorized Congress only to secure *property rights* to *first inventors*, not commercial monopoly privileges obtained by supplicants of the federal government’s favor.”).

14. U.S. CONST. art. I, § 8, cl. 8.

15. Although critics of the America Invents Act have alleged it implements a “first to file” system, the new approach in the United States should properly be characterized as granting rights to the “first *inventor* to file.” This distinction is discussed in greater detail below.

16. See, e.g., *Great Atl. & Pac. Tea Co. v. Supermarket Equip. Corp.*, 340 U.S. 147, 154 (1950) (Douglas, J., concurring) (“Every patent is the grant of a privilege of exacting tolls from the public. The Framers plainly did not want those monopolies freely granted.”).

17. See *Eldred v. Ashcroft*, 537 U.S. 186, 200 (2003) (“To comprehend the scope of Congress’s Copyright Clause power, ‘a page of history is worth a volume of logic.’”) (citing *New York Trust Co. v. Eisner*, 256 U.S. 345, 349 (1921)); see also *Burrow–Giles Lithographic Co. v. Saroni*, 111 U.S. 53, 57 (1884) (“The construction placed upon the Constitution by [the drafters of] the first [copyright] act of 1790 and the act of 1802 . . . men who were contemporary with [the Constitution’s] formation, many of whom were members of the convention which framed it, is of itself entitled to very great weight. . .”).

18. *Graham v. John Deere Co. of Kan. City*, 383 U.S. 1, 5 (1966) (observing that the original Patent Act “was written against the backdrop of the practices—eventually curtailed by the Statute of Monopolies—of the Crown in granting monopolies to court favorites in goods or businesses which had long before been enjoyed by the public.”); see also Adam Mossoff, *Rethinking the Development of Patents: An Intellectual History, 1550–1800*, 52 HASTINGS L.J. 1255, 1255 (2001) (“The history of patents does not begin with inventions, but rather with royal grants by Queen Elizabeth (1558–1603) for monopoly privileges that advanced her economic and industrial policies.”).

bestowing these monopolies; as such, they were given at the complete discretion of the monarch, often in exchange for payment.¹⁹ Both citizens and members of Parliament strongly disfavored this practice²⁰ and in 1623 the passage of the Statute of Monopolies eliminated almost all government-bestowed monopolies in England.²¹ However, in recognition of the value imparted through innovation, the English Parliament specifically retained the power to grant limited monopolies that would last a predetermined length of time to inventors over their inventions.²²

This was the framework under which the Founders created America's patent system. Congress's power to grant patent rights, and thus the entire patent system in the United States, is founded in a single provision of the United States Constitution²³ often referred to as "the Patent Clause."²⁴ This provision states that Congress shall have the power "[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."²⁵ Congress's power to grant exclusive rights—monopolies—is inherently limited. In particular, these rights can be given only for a limited time. Additionally, unlike the English system, only *authors* and *inventors* may obtain monopolies, and these monopolies are restricted to their own creations.²⁶ These limitations appear to stem from the Framers' fears regarding the potential abuses of state-granted monopolies based on their experiences with the English system.²⁷ Despite these concerns, the Framers recognized the benefits conferred by limited monopolies when used to promote innovation.²⁸ As explained

19. See, e.g., *McKeever v. United States*, 14 Ct. Cl. 396, 418 (1878) ("During the reign of Elizabeth it was the policy of the Crown to raise as little revenue as possible by direct taxation, and as much as possible by the sale of monopolies.").

20. See, e.g., *id.* at 419 (observing that the abuse of monopolies for common items had unnecessarily and drastically increased prices; for example "where salt (before the patent) was wont to be sold for sixteen pence a bushel, it is now sold for fourteen or fifteen shillings a bushel.").

21. English Statute of Monopolies of 1623, 21 Jac. 1, c. 3, (1623) (eliminating all Crown-sanctioned monopolies except for prior existing patents); see also Karen E. Simon, *The Patent Reform Act's Proposed First-to-File Standard: Needed Reform or Constitutional Blunder?*, 6 J. MARSHALL REV. INTELL. PROP. L. 129, 131. Following the enactment of the Statute of Monopolies in 1623, all sanctioned monopolies were eliminated in England except for the "exclusive privileges" of patents. See, e.g., *Pennock v. Dialogue*, 27 U.S. (2 Pet.) 1, 16-18 (1829). It was this sort of specially granted monopoly that served as the basis for the patent system in the United States, although it was not adopted whole-cloth. *Id.*

22. *Pennock*, 27 U.S. (2 Pet.) at 18-20.

23. See *Graham v. John Deere Co. of Kan. City*, 383 U.S. 1, 5 (1966) (citing U.S. CONST. art. I, § 8, cl. 8) ("[I]t must be remembered 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.'").

24. Notably, this clause of the Constitution is also referred to both as "the Copyright Clause" (as it is also the foundation for copyright protection) or more generally as "the Intellectual Property (IP) Clause." The clause will be referenced throughout this Note as "the Patent Clause" when referring specifically to the language referring to patents.

25. U.S. CONST. art. I, § 8, cl. 8.

26. No perpetual monopolies are granted for intellectual property; instead, only limited monopolies (that is, monopolies of limited scope and duration) are authorized. See, e.g., Andrew Auchincloss Lundgren, *Perspectives on Patent Claim Construction: Re-Examining Markman v. Westview Instruments Through Linguistic and Cognitive Theories of Decisionmaking*, 12 U. BALT. INTELL. PROP. L.J. 173, 194 (2004) ("The key to the patent system's success lies in its limited grant of monopoly . . .").

27. See, e.g., *Great Atl. & Pac. Tea Co.*, 340 U.S. at 154-58 (Douglas, J., concurring).

28. THE FEDERALIST NO. 43 (James Madison).

by James Madison:

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.²⁹

The rights to such limited monopolies were thus clearly conferred upon *inventors* as a means to encourage such individuals to innovate. Under the American patent framework, patents were given as property rights. In effect, just as a builder could come to own a piece of physical property by creating it through physical labor, an inventor could come to own the intellectual property he created through his mental labor.³⁰ This property rights justification underlying the patent system was perhaps best stated by Chancellor James Kent as, “[i]t is just that [inventors] should enjoy the pecuniary profits resulting from mental as well as bodily labor.”³¹ Accordingly, although under the English system patents did not prevent the use of an invention by the Crown,³² under the American system, the “property in the mind-work of the inventor” was secured *solely* to the inventor (and not also to the government).³³

However, not all of the Framers were equally convinced of the benefits conferred by patents. In particular, Thomas Jefferson believed that “the benefit of even limited monopolies is too doubtful, to be opposed to that of their general suppression.”³⁴ Thomas Jefferson’s views are particularly relevant to an understanding of the early patent system in America because, as noted by the Supreme Court, he was the primary originator of that system.³⁵ Jefferson believed it was necessary to “draw[] a line between the things which are worth to the public

29. *Id.* at 1.

30. *See, e.g.*, 2 JAMES KENT, COMMENTS ON AM. L. 463, 474 (O.W. Holmes, Jr. ed., 12th ed. 1873) (1826) (referring to patents as being “of original acquisition by intellectual labor.”); 1 ST. GEORGE TUCKER, BLACKSTONE’S COMMENTARIES: WITH NOTES OF REFERENCE TO THE CONSTITUTION AND LAWS OF THE FEDERAL GOVERNMENT OF THE UNITED STATES AND OF THE COMMONWEALTH OF VIRGINIA 260, 266 (1803) (appendix to vol. 1).

31. KENT, *supra* note 30.

32. *See McKeever*, 14 Ct. Cl. at 420.

33. *Id.* at 417-18. Note that in some special cases, the government may retain the right to utilize the subject matter of a patent without cost. For example, this may occur if the research underlying the patent was conducted using government funds. *See, e.g.*, Bayh–Dole Act (Patent and Trademark Law Amendments Act), 35 U.S.C. § 200-212 (2006). In general, individuals may recover against infringing uses by the government, as sovereign immunity has been waived. *See* 28 U.S.C. § 1498(a) (2006) (modified 2011).

34. Letter from Thomas Jefferson to James Madison (July 31, 1788), *available at* <http://www.constitution.org/tj/jeff07.txt>.

35. *See Graham*, 383 U.S. at 7 (noting that Thomas Jefferson was the “moving spirit” of the original patent office “and might well be called the ‘first administrator of our patent system’”) (internal citations omitted).

the embarrassment of an exclusive patent, and those which are not.”³⁶ Jefferson explained that “[i]nventions then cannot, in nature, be a subject of property;” however, “[s]ociety may give an exclusive right to the profits arising from them, as an encouragement to men to pursue ideas which may produce utility”³⁷

Starting with the passage of the first statutes creating a patent system, patent law in the United States has stressed that patents should be granted to *original* inventors. Congress first enacted laws governing patents on April 10, 1790.³⁸ This first patent statute explicitly set forth that patent rights could be granted to *first* inventors only and further provided for the repeal of any patent not issued to a first or original inventor.³⁹ Additionally, the law made clear that patents served as *prima facie* evidence that the patent holder was in fact the original inventor of the patented invention.⁴⁰ Problems with this approach arose almost immediately, as it was difficult to determine which of multiple alleged inventors was the true first inventor.⁴¹ Although the idea of awarding patents to the first inventor to file an application was proposed at a hearing of the Patent Board in April of 1791, the proposal was ultimately rejected.⁴² Instead, when the second Patent Act was enacted in 1793,⁴³ a procedure termed an “interference” was created in order to resolve problems arising when the identity of the original inventor was in dispute.⁴⁴ After the first-in-time inventor was determined, she would ultimately be awarded the patent, regardless of whether her application was actually the first application filed. This change, combined with the consideration and rejection of a “first to file” system, seemingly reaffirmed the belief that patents could only be awarded to original inventors. Additionally, although the 1793 Act removed much of the language of the 1790 Act regarding original inventors, it stressed that patents “not originally discovered by the patentee” or “surreptitiously obtained” based on the discovery of another person shall be declared void.⁴⁵ The concept of patents only being awarded to the first-in-time inventor persisted through all subsequent patent acts until the passage of the America Invents Act of 2011.⁴⁶

The Supreme Court has consistently supported the idea that the “first to invent”

36. *Id.* at 9. Jefferson made this comment in light of his many years as member of the patent board.

37. *Id.* at 8, n.2 (emphasis added) (quoting VI Writings of Thomas Jefferson at 180-81 (Washington ed.) (1854)).

38. Patent Act of 1790, § 1, Ch. VII, 1 Stat. 109, 109-10 (1790).

39. *Id.* § 5 (“[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 . . .”).

40. *Id.* § 6 (“[T]he said patents or specifications shall be prima facie evidence, that the said patentee or patentees was or were the first and true inventor or inventors, discoverer or discoverers of the thing so specified . . .”).

41. Simon, *supra* note 21, at 134-35 (describing an early patent case in which “four individuals applied for a patent on a steamboat”).

42. *Id.* at 134 (citing P.J. Federico, *Operation of the Patent Act of 1790*, 18 J. PAT. OFF. SOC’Y 237, 237 (1936)).

43. Patent Act of 1793, Ch. 11, 1 Stat. 318 (1793).

44. *Id.* at §§ 3, 9, (describing how multiple patent applications for the same invention shall be sent to arbitration).

45. *Id.* § 6.

46. *See, e.g.*, Patent Act of 1836, Ch. 357, 5 Stat. 117 (1836); Patent Act of 1870, Ch. 230, 16 Stat. 198 (1870); Patent Act of 1952, Pub. L. No. 82-593, 66 Stat. 792 (1956).

system is constitutional.⁴⁷ Furthermore, the Court has observed that Congress’s powers to grant patents are narrow and strictly constrained by the limits imposed by the Constitution.⁴⁸ In particular, the Court has stated that patent laws must accord with the “inherent requisites” of the Constitution.⁴⁹ To this end, the Court has stated that the requirements for patentability are inherently set forth in the Patent Clause of the Constitution.⁵⁰

II. Analysis

Several arguments have been raised against the constitutionality of a “first to file” or “first inventor to file” system in the United States. Part A of this section examines the specific provisions of the “first inventor to file” system implemented by the America Invents Act. Part B of this section discusses several arguments against switching to a “first inventor to file” system in America based on the text of the Patent Clause of the Constitution. Part C addresses those arguments against a “first inventor to file” system based on the Framers’ intentions. Part D justifies the constitutionality of the “first to file” system implemented by the America Invents Act.

A. “First to File” Under the America Invents Act

The America Invents Act (“The Act”) provides that patent rights will, in general, be given to the first inventor or group of inventors to file for a patent on a particular invention.⁵¹ As such, it is no longer relevant which inventor conceived of the invention first; priority for patent rights can normally be determined merely by checking which application was filed first with the Patent and Trademark Office. To this end, interference proceedings—originally established to determine which of several inventors was the original inventor—will no longer be used.⁵² The Act, however, makes several important distinctions regarding the recipients of patent rights. Only inventors who *actually discovered* the subject matter contained in a

47. Although the “first to invent” system has never faced a direct constitutional challenge in the United States, the language used in Supreme Court decisions indicates the Court’s support of such a system. For example, the Court has stressed that only *original* or *actual* inventors could obtain patent rights. See *Shaw v. Cooper*, 32 U.S. (6 Pet.) 292, 292 (1833) (“[I]t 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*”) (emphasis added).

48. *Graham*, 383 U.S. at 5-6 (“The Congress in the exercise of the patent power may not overreach the restraints imposed by the stated constitutional purpose. Nor may it enlarge the patent monopoly without regard to the innovation, advancement or social benefit gained thereby. Moreover, Congress may not authorize the issuance of patents whose effects are to remove existent knowledge from the public domain, or to restrict free access to materials already available.”).

49. *Id.* at 6.

50. *Id.* at 3.

51. See generally Leahy-Smith America Invents Act § 3. Notably, under the Act, patent rights are still restricted to *inventors*. See 35 U.S.C. § 101 (“Whoever *invents or discovers* any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.”) (emphasis added).

52. See Leahy-Smith America Invents Act § 3(j).

patent application shall be granted a patent.⁵³ Accordingly, if the subject matter contained in a patent or patent application belonging to a second-in-time inventor who filed first was *derived* from the work of another (earlier) inventor who filed second, the first-in-time inventor may bring suit to acquire patent rights in her invention.⁵⁴ Additionally, if an inventor chooses to publish the details of his invention prior to filing a patent application, he is effectively granted priority as if he had filed a patent application on that date, so long as he actually does file such an application within one year of the publication date.⁵⁵

B. Interpreting the Patent Clause: Textual Arguments against First-to-File

As noted above, the Patent Clause states that Congress shall have power “[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.”⁵⁶ This provision contains several explicit limitations on Congress’s ability to enact patent laws. Specifically, the Patent Clause restricts Congress’s ability to enact legislation regarding the purpose and duration of patents, the identity of original patent holders, and the subject matter of inventions that may be patented. In this way, the enumerated powers bestowed by the Patent Clause are expressly limited in scope.⁵⁷ The Patent Clause prevents Congress from granting patent rights to anyone except *inventors*. Accordingly, the “first inventor to file” system for patentability implemented in the America Invents Act would arguably be unconstitutional if the Patent Clause does not allow for patents to be initially obtained by an individual other than the original (or first-in-time) inventor.

It is relevant to note that a “true” first to file system that did not require the filer to be an *inventor* would be clearly unconstitutional, as the Patent Clause explicitly specifies that only *inventors* may obtain patents. There is, however, no explicit limitation that only *original* inventors may obtain patents in the language of the provision.⁵⁸ Under this reading of the Clause, the actual first to file system implemented by the America Invents Act is constitutional, as it does limit who may obtain a patent to actual inventors in accordance with the text of the Patent

53. *Id.* § 3(a) (stating that the “term ‘inventor’ means the individual or, if a joint invention, the individuals collectively *who invented or discovered the subject matter of the invention.*”) (emphasis added).

54. *Id.* § 3(h)(1) (“The owner of a patent may have relief by civil action against the owner of another patent that claims the same invention and has an earlier effective filing date, if the invention claimed in such other patent was derived from the inventor of the invention claimed in the patent owned by the person seeking relief under this section.”).

55. *Id.* § 3(b)(1) (Indicating disclosures shall not constitute prior art if “the subject matter disclosed had, before such disclosure, been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor.”).

56. U.S. CONST. art. I, § 8, cl. 8.

57. *See* *Figueroa v. United States*, 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.’”). Notably, the “IP Clause” refers to the entirety of Section 8, Clause 8 and provides the foundation for both patent law and copyright law.

58. U.S. CONST. art. I, § 8, cl. 8 (stating simply that “inventors,” rather than “original inventors,” may secure patent rights over inventions).

Clause.⁵⁹

Despite this, some have argued that the term “inventors” as used in the Constitution should be interpreted to refer only to *original* or *first* inventors.⁶⁰ At the time when the Framers drafted the Constitution, at least one dictionary defined an inventor as “one who produces something new; a deviser of something not known before.”⁶¹ Arguably, one could not be an inventor unless the alleged invention was, in fact, new—and thus not previously produced or known by someone else before. Along the same lines, “to discover” was defined as “to bring to light,” “to find out” or “to make known.”⁶² Presumably, only a first or original inventor would be in position “to make known” a concept.⁶³

C. Looking to the Framers’ Intent: Further Arguments against “First to File”

This interpretation is supported through the understanding by early American courts that patents were property rights in an invention obtained through first discovery, much the same as property rights in land were obtained through first possession.⁶⁴ Under the common law approach to property, an individual could first take ownership of newly-discovered land through possession and subsequently perfect title through statutorily established procedures.⁶⁵ Justice Marshall stressed that rights to inventions were acquired in much the same way.⁶⁶ He noted “[t]he

59. Leahy-Smith America Invents Act § 3.

60. See, e.g., Mossoff, *supra* note 13, at 14 (“The Constitution and long-established historical practice in American patent law establish that...only the first inventor can obtain a patent.”); Joe Matal, *A Guide to the Legislative History of the America Invents Act: Part I of II*, 21 FED. CIR. B.J. 435, 462 n.173 (2012) (“[I]nventor means first inventor in the Constitution.”) (quoting 157 CONG. REC. H4421-22 (daily ed. June 22, 2011) (statement by Rep. Sensenbrenner)).

Further, some lower courts have indicated that the Constitution requires a first to invent system rather than a first inventor to file system. See, e.g., *Benedict v. Menninger*, 64 F.2d 1001, 1003 (C.C.P.A. 1933) (“A first inventor being the inventor whom the Constitution and the law contemplates shall receive award” of patent rights.). The United States Supreme Court has not directly held whether the use of “inventors” in the Patent Clause is restricted to “original inventors.”

61. Simon, *supra* note 21, at 140 (citing SAMUEL JOHNSON, A DICTIONARY OF THE ENGLISH LANGUAGE, vol. 1 (1787)); see also Edwin Suominen, *Re-Discovering Article I, Section 8 — The Formula for First-to-Invent*, 83 J. PAT. OFF. SOC’Y 641, 643 (2001) (“The plain language of the terms [“inventor” and “discoveries”] would thus seem to settle the issue, [by] clearly prohibiting any first-to-file system as unconstitutionally denying *actual inventors* the exclusive right to their discoveries.”) (emphasis added).

62. Simon, *supra* note 21, at 140; see also Suominen, *supra* note 61, at 643.

63. Of course, were the original inventor to suppress, conceal, or abandon the invention, a subsequent inventor would be able to “stand in the shoes” of the true original inventor and make the initial disclosure of the subject matter of the invention. This possibility is discussed further in Part C of this section.

64. Mossoff, *supra* note 13, at 11 (“The analogy between the intellectual labor of the first inventor and the physical labor of a first possessor of land was in fact explicitly drawn by American judges in innumerable patent cases in the early nineteenth century.”)

65. See, e.g., *Johnson v. McIntosh*, 21 U.S. (7 Wheat.) 543, 573 (1823) (where Justice Marshall explained “discovery gave title to the government by whose subjects, or by whose authority, it was made, against all other European governments, which title might be consummated by possession”).

66. *Evans v. Jordan*, 8 F. Cas. 872, 873 (C.C.D. Va. 1813) (No. 4,564) *aff’d*, 13 U.S. (9 Cranch) 199 (1815) (“The constitution and law, taken together, give to the inventor, from the moment of invention, an inchoate property therein, which is completed by suing out a patent.”) Furthermore, “this inchoate and

constitution and law, taken together, give to the inventor, *from the moment of invention*, an inchoate property therein, which is completed by suing out a patent.⁶⁷ Justice Marshall further explained, “this inchoate and indefeasible property in the thing discovered *commences with the discovery itself*, and is only perfected by the patent subjecting the future use of the machine constructed previous to a patent.”⁶⁸ Accordingly, if rights were secured at the moment of invention, only the first inventor in time would be able to validly obtain a patent on an invention. Further, as noted by Justice Joseph Story⁶⁹ in 1817, “[n]o person is entitled to a patent under the act of congress unless he has invented some new and useful art, machine, manufacture, or composition of matter, *not known or used before*.”⁷⁰

As discussed above,⁷¹ this same understanding that patents should only be awarded to original inventors was reflected in the wording of the original Patent Act, which provided that “if 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.”⁷² This understanding was further supported by Justice Story’s reasoning in *Pennock v. Dialogue*.⁷³ Story found that three separate sections in the 1793 Patent Act restricted patents to first or original inventors.⁷⁴ Specifically, Justice Story noted that the 1793 Act required (1) patents be granted for things “not known or used before the application;” (2) 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 improvement for which he solicits a patent;” and (3) that a defense to a suit for patent infringement include “that 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.”⁷⁵ Based on this, Justice Story concluded that only the *first* inventor should be able to obtain a patent.⁷⁶

indefeasible property in the thing discovered commences with the discovery itself, and is only perfected by the patent subjecting the future use of the machine constructed previous to a patent . . .”).

67. *Evans*, 8 F. Cas. at 873 (emphasis added).

68. *Id.* (emphasis added).

69. Justice Story is considered “one of the architects of American patent law.” Frank D. Prager, *The Influence of Mr. Justice Story on American Patent Law*, 5 AM. J. LEGAL HIST. 254, 254 (1961). Although Justice Story only authored about two-dozen decisions in patent cases, his views are considered highly relevant to a complete understanding of patent jurisprudence in the United States. *Id.*

70. *Bedford v. Hunt*, 3 F. Cas. 37, 37 (C.C.D. Mass. 1817) (No. 1,217) (emphasis added).

71. *See supra* Background (discussing the requirements in the Patent Act of 1790).

72. Patent Act of 1790 § 5.

73. *See* 27 U.S. (Pet. 2) at 1.

74. *Id.* at 17.

75. *Id.* (emphasis added).

76. *Id.* at 19 (“If it were necessary, as it well might be, to employ others to assist in the original structure or use by the inventor himself; or if before his application for a patent his invention should be pirated by another, or used without his consent; it can scarcely be supposed, that the legislature had within its contemplation such knowledge or use.”).

D. Justification for the Constitutionality of the “First Inventor to File” System: An Examination of the Policy Underlying the Patent Clause

Despite these seemingly strong arguments that the Framers provided only for a “first to invent” system when the Patent Clause was drafted, a “first inventor to file” system falls within the constitutional mandate governing patents. Most notably, language limiting patent rights to only first-in-time or original inventors is absent from the Patent Clause.⁷⁷ Had the Framers intended to limit patent rights to only original inventors, such language could easily have been included within the Patent Clause itself—especially considering the Statute of Monopolies, from which the American Patent system drew its roots, *did* include language limiting patents to “first and true inventors.”⁷⁸ Furthermore, although the first two patent acts passed by Congress implemented a “first to invent” system of patent rights,⁷⁹ this requirement was not proposed as a Constitutional amendment. This can be seen as indicating, that while the Framers preferred a “first to invent” system, they did not consider it the only correct way to bestow patent rights. For example, in noting that England allowed individuals to obtain patents over ideas at least partially conceived by others, Justice Story himself observed that although “[t]he law in this country has not gone quite so far [as England], but I do not mean to say, that there would be any difficulty in going to that extent.”⁸⁰ In other words, Justice Story necessarily considered the term “inventors” to be fluid enough to encompass individuals who relied upon the prior knowledge and experimentation of others in perfecting the invention. Supreme Court precedent also indicates that the Patent Clause allows patents to be awarded to *subsequent*—rather than *first-in-time*—inventors, so long as they have independently conceived their ideas.⁸¹

Additionally, the prohibition on obtaining inventions previously known was seen by some, including Justice Story, to refer to *the public* rather than to *other inventors*. As noted by Justice Story in reference to the limitations in the 1793 Patent Act, “[w]e think, then, the true meaning [of the phrase ‘not known or used before the application’] must be, not known or used *by the public*, before the application.”⁸² In other words, an applicant could not patent something that was not novel or was obvious. Similarly, as discussed above, Justice Story believed the

77. U.S. CONST. art. I, § 8, cl. 8.

78. See English Statute of Monopolies of 1623, 21 Jac. 1, c. 3, (1623) (granting monopolies over “new manufactures within this realm, to *the true and first inventor and inventors* of such manufactures”) (emphasis added). See also Rebecca C.E. McFadyen, Note, *The “First-to-File” Patent System: Why Adoption Is Not an Option!*, 14 RICH. J.L. & TECH. 3, 7-8 (2007).

79. See generally Patent Act of 1790; Patent Act of 1793.

80. Washburn v. Gould, 29 F. Cas. 312, 317 (C.C.D. Mass. 1844) (No. 17,214).

81. See Gayler v. Wilder, 51 U.S. (9 How.) 477, 497 (1850) (“Yet it would hardly be doubted, if any one now discovered an art thus lost, and it was a useful improvement, that, upon a fair construction of the act of Congress, he would be entitled to a patent. Yet he would not literally be the first and original inventor. But he would be the first to confer on the public the benefit of the invention. He would discover what is unknown, and communicate knowledge which the public had not the means of obtaining without his invention.”). See also Matal, *supra* note 60, at 462 (explaining *Gayler*).

82. *Pennock*, 27 U.S. (Pet. 2) at 19 (emphasis added).

1793 Act restricted an individual from patenting something he did not himself develop, but instead had copied from some other actual inventor. Justice Story stressed that an inventor should not be able to conceal his invention until others had developed and implemented similar approaches and then subsequently apply for a patent, asserting that he himself was the “first and true inventor.”⁸³ By implication, under Justice Story’s interpretation, where multiple individuals independently conceived of the same invention, neither the 1793 Act nor the Constitution would prohibit the second-in-time inventor from obtaining a patent.

The Supreme Court has held that even under the “first to invent” system, patent rights were not vested in the first individual to *conceive* of a new idea. Rather, the Court held that an individual “is the first inventor in the sense of the patent law, and entitled to a patent for his invention, who first *perfected* and *adapted* [the invention] to use.”⁸⁴ As such, patent rights could only be obtained in an invention by reducing the invention to practice and complying with the procedural requirements set forth by Congress.⁸⁵ Additionally, a second-in-time inventor could obtain patent rights where the first-in-time inventor had failed to fully reduce the idea to practice and obtain a patent.⁸⁶ In the same vein, where a first-in-time inventor chooses to abandon his invention, conceal it from the public, or suppress it, a second-in-time inventor could obtain patent rights over the invention.⁸⁷ Accordingly, an inventor who failed to either utilize his invention publicly or file a patent application upon it in a timely fashion might lose patent rights to any later “inventors,” although such later inventors were clearly not *original* inventors.⁸⁸ This was all done because

83. *See id.* (“If an inventor should be permitted to hold back from the knowledge of the public the secrets of his invention; if he should for a long period of years retain the monopoly, and make, and sell his invention publicly, and thus gather the whole profits of it, relying upon his superior skill and knowledge of the structure; and then, and then only, when the danger of competition should force him to secure the exclusive right, he should be allowed to take out a patent, and thus exclude the public from any further use than what should be derived under it during his fourteen years; it would materially retard the progress of science and the useful arts, and give a premium to those who should be least prompt to communicate their discoveries.”).

84. *Seymour v. Osborne*, 78 U.S. (10 Wall.) 516, 552 (1870) (emphasis added).

85. *Id.* (“Original and first inventors are entitled to the benefit of their inventions if they reduce the same to practice, and seasonably comply with the requirements of the patent law in procuring letters patent for the protection of their exclusive rights. Crude and imperfect experiments are not sufficient to confer a right to a patent; but in order to constitute an invention, the party must have proceeded so far as to have reduced his idea to practice, and embodied it in some distinct form.”).

See also *Washburn v. Gould*, 29 F. Cas. at 317 (“The law is, that whoever first perfects a machine, is entitled to the patent, and is the real inventor, although others may previously have had the idea, and made some experiments towards putting it in practice.”).

86. *See Seymour*, 78 U.S. (10 Wall.) at 552. (“Desertion of an invention consisting of a machine, never patented, may be proved by showing that the inventor, after he had constructed it, and before he had reduced it to practice, broke it up as something requiring more thought and experiment, and laid the parts aside as incomplete.”).

87. *See Int’l Glass Co. v. U.S.*, 408 F.2d 395, 403 (Ct. Cl. 1969). (“The courts have consistently held that an invention, though completed, is deemed abandoned, suppressed, or concealed if, within a reasonable time after completion, no steps are taken to make the invention publicly known.”). Such inventors are not entitled to patent protection over their suppressed, concealed, or abandoned inventions. *See id.* “Thus, failure to file a patent application . . . ; to describe the invention in a publicly disseminated document . . . ; or to use the invention publicly . . . have been held to constitute abandonment, suppression or concealment.” *Id.* (citations omitted).

88. *See, e.g., Kendall v. Winsor*, 62 U.S. (20 How.) 322, 328 (1858) (stating that if an inventor chooses to conceal his invention, and “if, during such a concealment, an invention similar to or identical with his own

patent rights are granted due to the benefit they bestow upon the *public*, rather than to *inventors*.⁸⁹

This requirement of reduction to practice has been misapprehended by some critics of a “first inventor to file” system as indicating that the Supreme Court required that patents go to original inventors.⁹⁰ While patents may indeed only be granted for novel and non-obvious subject matter, the patentability of a particular invention is not based on the knowledge of other private individuals. Instead, the determination is based on the knowledge available to the *public*. As such, the mere fact that an individual had conceived of a novel idea—but not shared it with the public at large—would not preclude another who conceived of the same novel idea *and decided to share it with the public first* from obtaining a patent.

The Supreme Court has explicitly declined to determine whether one may be an “inventor” without being a “first inventor.”⁹¹ However, the Court indicated that in determining if a patent may be obtained for a supposedly new discovery, the crucial distinction is whether an invention was known to the *public* prior to the alleged inventor’s conception of the idea, rather than if another individual had previously conceived of the idea in secret.⁹² In other words, an *actual inventor* who had conceived of an invention independently, without having gained knowledge from another, could be denied a patent if the subject matter of his invention were already known to the public.⁹³ The Court provided that inventions that were already known to the public could not be “invented” again—and thus later patented and removed from the public domain—regardless of whether an inventor had actual knowledge of the prior discovery.⁹⁴ Justice Story described the burden on inventors as being one of “reasonable diligence,” that is, “an inventor, who has first actually perfected

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”).

89. *See, e.g.,* *Blanchard v. Sprague*, 3 F. Cas. 648, 650 (C.C.D. Mass. 1839) (No. 1,518) (Justice Story stated “[p]atents for inventions are now treated as . . . highly beneficial to the public, . . . as ultimately securing to the whole community great advantages from the free communication of secrets, and processes, and machinery . . .”).

90. *See, e.g.,* *Suominen, supra* note 61, at 644 (“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.’”).

91. *See* *Evans v. Eaton*, 16 U.S. (3 Wheat.) 454, 513 (1818) (where the Court declined to carry out “a critical inquiry into the accuracy with which the term invention or discovery may be applied to any other than the first inventor,” considering such investigation irrelevant based on the wording of the original Patent Act). Prior to the passage of the America Invents Act, such a determination would not be necessary, as the patent statutes clearly required an original inventor. However, as noted above, the Court has indicated that the term “inventor” is not restricted to “first-in-time inventors.” *See, e.g.,* *Gayler*, 51 U.S. (9 How.) at 497.

92. *See* *Evans*, 16 U.S. (3 Wheat.) at 514 (“Admitting the words ‘originally discovered,’ to be explained or limited by the subsequent words, still if the thing had been in use, or had been described in a public work, anterior to the supposed discovery, the patent is void.”).

93. *Id.* (stating that when a previous public use or description of an alleged invention exists, “[i]t may be that the patentee had no knowledge of this previous use or previous description; still his patent is void: the law supposes he may have known it”).

94. *See* *Id.* at 454-55 (“[I]f the thing secured by patent had been in use, or had been described in a public work anterior to the supposed discovery, the patent is void, *whether the patentee had a knowledge of this previous use or description, or not.*”) (emphasis added).

his invention, will not be deemed to have surreptitiously or unjustly obtained a patent for that, which was in fact first invented by another, unless the latter was at the time using *reasonable diligence* in adapting and perfecting the same.”⁹⁵ To this end, the Court considers every inventor to constructively have knowledge of all prior public inventions.⁹⁶ In the words of Justice Marshall, if a prior use or description of an invention exists, “[i]t may be that the patentee had no knowledge of this previous use or previous description; still his patent is void: the law supposes he may have known it; and the charge of the judge, which must be taken as applicable to the testimony, goes no farther than the law.”⁹⁷

As expressed in the Patent Clause itself, the essential goal underlying all patent rights is “[t]o promote the Progress of Science and useful Arts.”⁹⁸ That is, patent rights are fundamentally different from other property rights. Patent rights are an incentive for the individual not merely to invent, to discover something new and useful, but rather to do so *and then share it with society at large*.⁹⁹ This *quid pro quo* arrangement, trading a description of an invention for the right to its exclusive use, is the foundation upon which patents draw their support.¹⁰⁰ To this end, patents are secured only for limited terms in exchange for disclosing one’s invention to society as a whole. At the conclusion of the patent term, the inventor ceases to own the invention and it becomes part of the public domain—free for all to use and benefit from. In contrast, an explorer who discovered and thereby came to possess new land would, upon obtaining proper title, own such property indefinitely.¹⁰¹

With this goal in mind, a “first to file” system is entirely consistent with the ideals of the Framers. The Framers were opposed to the granting of monopolies in general.¹⁰² A narrow exception was created to allow monopolies for a limited time over new discoveries and creations solely to encourage innovation and benefit society at large by causing new technologies and works to enter the public domain upon the conclusion of the patent term. In fact, if an individual suppressed her

95. *Reed v. Cutter*, 20 F. Cas. 435, 438 (C.C.D. Mass. 1841) (No. 11,645) (emphasis added).

96. *Evans*, 16 U.S. at 454-55 (1818).

97. *Id.* at 514.

98. U.S. CONST. art. I, § 8, cl. 8.

99. *See, e.g., Mazer v. Stein*, 347 U.S. 201, 219 (1954) (“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.’”); *see also Kendall*, 62 U.S. at 327-28 (“It is undeniably true, that the limited and temporary monopoly granted to inventors was never designed for their exclusive profit or advantage; *the benefit to the public or community at large* was another and doubtless the primary object in granting and securing that monopoly.”) (emphasis added).

100. *See, e.g., J.E.M. Ag Supply, Inc. v. Pioneer Hi-Bred Int’l, Inc.*, 534 U.S. 124, 142 (2001) (“The disclosure required by the Patent Act is ‘the quid pro quo of the right to exclude.’”) (citation omitted); *see also Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1345 (Fed. Cir. 2010) (“Every patent must describe an invention. It is part of the quid pro quo of a patent; one describes an invention, and, if the law’s other requirements are met, one obtains a patent.”).

101. *See, e.g., Johnson v. McIntosh*, 21 U.S. (8 Wheat.) 543, 567 (1823) (“Discovery is the foundation of title, in European nations . . .”).

102. *See, e.g., Letter from Thomas Jefferson to James Madison* (July 31, 1788) (“[T]he benefit of even limited monopolies is too doubtful, to be opposed to that of their general suppression.”), *available at* <http://www.constitution.org/tj/jeff07.txt>.

discovery or failed to seek patent protection in a timely fashion, she was held to have lost all rights to her invention.¹⁰³ In contrast, an individual does not lose rights in property she has discovered and continuously possessed simply because she did not seek title over the land quickly enough.¹⁰⁴

Accordingly, the emphasis placed upon granting patent rights to first inventors could be better understood as granting rights to first inventors *to disclose their completed inventions*. An invention is not "made known" merely through its discovery, but instead through its dissemination to society at large once it has been fully developed. In light of this, the early definition of an "inventor" is better understood to refer to the first individual to "bring to light" his invention through some sort of publication (such as a filing with the Patent Office). Should an inventor create something new, but keep it from society at large, he has not "made it known" or "brought it to light" in the manner necessary to warrant granting him an exclusive monopoly over it. As stressed by Justice Story, partial inventions are not sufficient; an invention must be complete and the disclosure must be such that another competent individual in the relevant field could duplicate the inventor's work.¹⁰⁵

Congress has full power to determine the means and manners in which patents will be granted, so long as the strict language of the Constitution is upheld.¹⁰⁶ Only the narrowest restriction has been placed upon Congress's use of this power. In the words of the Supreme Court:

The powers of Congress to legislate upon the subject of patents is *plenary* by the terms of the Constitution, and *as there are no restraints on its exercise*, there can be no limitation of their right to modify them at their pleasure, so that they do not take away the rights of property in existing patents.¹⁰⁷

That is to say, the only limitation not explicitly placed on Congress by the Constitution is that property rights of existing patentees may not be removed by an act of Congress following the grant of their patent. This ideal of Congress

103. *See, e.g., Kendall*, 62 U.S. at 328 ("[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.").

104. For example, rights in real property may be acquired through adverse possession; an adverse possessor does not lose these rights if title to the property is not obtained fast enough. *See, e.g., Ewing's Lessee v. Burnet*, 36 U.S. (11 Pet.) 41 (1837) (setting forth the basic requirements of gaining ownership through adverse possession).

105. *See Reed v. Cutter*, 20 F. Cas. at 438 ("[H]e is the first inventor in the sense of the act... who has first perfected and adapted the same to use... until the invention is so perfected and adapted to use, it is not patentable. An imperfect and incomplete invention... not actually reduced to practice, and embodied in some distinct machinery, apparatus, manufacture, or composition of matter, is not, and indeed cannot be, patentable under our patent acts.").

106. *See, e.g., Owen v. Heimann*, 12 F.2d 173, 174 (D.C. Cir. 1926) ("*The right to a patent is purely statutory* and Congress has full power to prescribe to whom and upon what terms and conditions a patent shall issue.") (emphasis added).

107. *McClurg v. Kingsland*, 42 U.S. (1 How.) 202, 206 (1843).

receiving a liberal grant of power over patents was extolled by Justice Story in the early nineteenth century.¹⁰⁸ Justice Story believed that Congress's power to grant patents was "clearly entitled to a liberal construction."¹⁰⁹ The Supreme Court affirmed this approach in the twentieth century by stating that Congress was entitled to use its best judgment in passing laws governing patents, limited only by the express provisions of the Constitution.¹¹⁰ Furthermore, Congress may choose to advance policy goals other than those explicitly stated in the Patent Clause.¹¹¹ As such, Congress could legitimately seek to switch to a "first inventor to file" system so as to standardize the American patent system with those used by other nations.

This liberal limitation on Congress's power is further exemplified in the treatment given to Copyright legislation by the Court.¹¹² In the words of the Court:

Although the constitution of the United States, in section 8 of article 1, provides that 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 writing and discoveries,' yet the means for securing such right to authors are to be prescribed by congress.¹¹³

The standard imposed by the Court when reviewing intellectual property legislation is simply whether "Congress rationally *could have concluded*" that the change in law upheld a rationale underlying the Intellectual Property Clause.¹¹⁴ Congress's authority under the Patent Clause is to pass laws that promote the

108. See *Blanchard*, 3 F. Cas. at 650 ("[Congress's] power is general, to grant to inventors; and it rests in the sound discretion of congress to say, when and for what length of time and under what circumstances the patent for an invention shall be granted. *There is no restriction, which limits the power of congress to enact, where the invention has not been known or used by the public.*") (emphasis added).

109. *Id.*

110. See *Graham v. John Deere Co. of Kan. City*, 383 U.S. 1, 6 (1966) ("Within the limits of the constitutional grant, the Congress may ... implement the stated purpose of the Framers by selecting the policy which in its judgment best effectuates the constitutional aim.")

111. *Figueroa v. United States*, 466 F.3d 1023, 1031 (Fed. Cir. 2006) ("Congress may legitimately seek to advance other public policy goals related to the objectives of the Patent Clause by enacting legislation pursuant to the Clause.")

112. As discussed above, the same clause of the Constitution controls both Patent and Copyright laws. Accordingly, the interpretation of the IP Clause given by the Court as applied to Copyright law is generally considered indicative of the Court's views regarding Patent law. See, e.g., *Lee v. Runge*, 404 U.S. 887, 890 (1971) (dissent from denial of cert) ("No distinction is made in the constitutional language between copyrights and patents."). However, the distinction has been made that while the IP Clause has been liberally construed, when it comes to patent law, the IP Clause will be more strictly construed. See, e.g., *United States v. Masonite Corp.*, 316 U.S. 265, 280 (1942) ("Since patents are privileges restrictive of a free economy, the rights which Congress has attached to them must be strictly construed so as not to derogate from the general law beyond the necessary requirements of the patent statute."). Despite this, the Supreme Court's treatment of Copyright law can be used to inform patent law, and vice versa. See, e.g., *Eldred v. Ashcroft*, 537 U.S. 186, 188 (2003) ("[B]ecause the Clause empowering Congress to confer copyrights also authorizes patents, the Court's inquiry is significantly informed by the fact that early Congresses extended the duration of numerous individual patents as well as copyrights.")

113. *Banks v. Manchester*, 128 U.S. 244, 251-52 (1888).

114. *Golan v. Holder*, 132 S. Ct. 873, 889 (2012).

progress of the “useful arts.”¹¹⁵ Accordingly, when evaluating patent laws that do not clearly conflict with the text of the Constitution, it is merely necessary to determine whether it is reasonable to believe the law promotes the progress of the useful arts.

In *Eldred v. Ashcroft*, a Supreme Court case involving review of Congressional authority under the Copyright Clause, the Supreme Court found that the phrase “limited Times” only restricted Congress’s authority such that copyright protections must expire at some point—Congress could freely choose to extend the length of copyright protection well beyond the life of the original copyright holder.¹¹⁶ In effect, Congress was only restricted in that the term granted for copyright protection must be finite, even allowing works that had previously “entered the public domain,” that is, works which had their copyright term expire, to regain protected status. The Court held that when reviewing Congressional exercise of authority under the Copyright Clause,¹¹⁷ substantial deference is afforded to Congress and its actions are reviewed only to determine if they are *rational*.¹¹⁸ The Court indicated that when a law founded in Congress’s IP Clause authority “reflects judgments of a kind Congress typically makes, judgments the Court cannot dismiss as outside the Legislature’s domain,” the Court should not substitute its own judgment in place of Congress’s.¹¹⁹ In the words of the Court, “we are not at liberty to second-guess congressional determinations and policy judgments of this order, however debatable or arguably unwise they may be.”¹²⁰

Applying this reasoning to the Patent Clause, Congress should have the discretion to do anything not explicitly prohibited by the IP Clause in implementing the Patent system. Selecting which of several independent inventors should be awarded a patent is a choice determined entirely by policy, which thereby falls within the ample discretion granted to Congress. As indicated by the Supreme Court in *Eldred*, the judiciary should be deferential in any review of the Patent laws, and barring a clear and obvious indication that Congress has exceeded its mandate, the judiciary should refrain from substituting its own judgment in place of Congress’s.

This conclusion is supported by the reasoning of the Supreme Court in a more recent decision that also dealt with Congress’s power under the IP Clause: *Golan v. Holder*.¹²¹ In *Golan*, the Supreme Court appears to find there are essentially no restrictions imposed as to either the steps Congress may take regarding intellectual property law or the justifications Congress may use in reaching its decisions about how to implement such laws. In particular, the Court held that Congress is permitted to decide to modify the intellectual property laws in order to bring the law

115. See, e.g., *id.* at 888 (“Perhaps counterintuitively for the contemporary reader, Congress’s copyright authority is tied to the progress of science; its patent authority, to the progress of the useful arts.”).

116. See *Eldred v. Ashcroft*, 537 U.S. 186 (2003).

117. The Copyright Clause, the Patent Clause, and the Intellectual Property Clause all refer to the same clause of the Constitution, article 1, section 8, clause 8. See *supra* note 24-25.

118. *Eldred v. Ashcroft*, 537 U.S. 186, 208 (2003).

119. *Id.* at 188.

120. *Id.* at 208.

121. 132 S. Ct. 873.

in the United States in line with the laws of other nations.¹²² Furthermore, Congress has historically not been constrained to merely promoting the creation or invention of new works or devices. Rather, Congress may promote other ends, such as the *dissemination* of new works. In the words of the Court, “[n]othing in the text of the Copyright Clause confines the ‘Progress of Science’ exclusively to ‘incentives for creation’ . . . [e]vidence from the founding, moreover, suggests that inducing dissemination—as opposed to creation—was viewed as an appropriate means to promote science.”¹²³

Accordingly, by examining the shift from first-to-invent to first-inventor-to-file using this logic, it is clear this change would be permitted even if Congress’s only justification was to standardize the law in the United States with the laws already in effect in other countries. Even if it is not clear what Congress’s reasoning in passing a particular intellectual property law was, the law will be found Constitutional where Congress reasonably could have found that harmonizing the law in the United States with other countries could promote progress in the useful arts.¹²⁴ The Court further reinforced that it would not utilize its own judgment in place of Congress’s political decisions in implementing the Patent laws.¹²⁵ In the words of the Court, the IP Clause “empowers Congress to determine the intellectual property regimes that, overall, in that body’s judgment, will serve the ends of the Clause.”¹²⁶

III. Conclusion

Read literally, the text of the Patent Clause restricts Congress’s ability to grant patents such that they may only be given to actual inventors. Although it could be argued that the Framers originally intended patents to be awarded only to first or original inventors, language imposing such additional limitations is conspicuously absent from the Patent Clause of the Constitution. In other words, because the Framers specifically refrained from explicitly restricting patent rights to original inventors in the text of the Constitution, such a limitation should not be read *post hoc* into the Patent Clause. Furthermore, the Supreme Court has repeatedly stated that Congress may use any manner not prohibited by the Constitution in implementing the goals for patent rights contained in the Patent Clause.¹²⁷ These

122. See *id.* at 875-876 (“In aligning the United States with other nations bound by the Berne Convention, and thereby according equitable treatment to once disfavored foreign authors, Congress can hardly be charged with a design to move stealthily toward a regime of perpetual copyrights.”).

123. *Id.* at 888.

124. See, e.g., *id.* at 889 (A law harmonizing United States law with an international convention (Berne) was appropriate where Congress “rationally could have concluded that adherence to Bern promotes the diffusion of knowledge” because “Congress had reason to believe [such adherence] would expand the foreign markets available to U.S. authors and invigorate protection against piracy of U.S. works abroad, thereby benefitting copyright-intensive industries stateside and inducing greater investment in the creative process.”) (internal quotations and citations omitted).

125. See *id.* at 887 (“Given the authority we hold Congress has, we will not second-guess the political choice Congress made.”).

126. *Id.* at 888.

127. See *Graham v. John Deere Co. of Kan. City*, 383 U.S. at 6 (“Within the limits of the constitutional

goals do not need to be directly achieved by intellectual property legislation; it is enough for Congress to rationally believe a law will indirectly result in progress for it to be considered Constitutional. It is particularly appropriate for Congress to attempt to harmonize the United States intellectual property laws with the laws of other countries, as such harmonization clearly has the potential to promote progress and the interests of American inventors and creators. The “first inventor to file” system implemented by the America Invents Act carries out these goals without violating any of the Constitutional limitations imposed on Congress.

