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**PATENT REFORM AND  
THE CHANGES TO SECTIONS 102 AND 103 IN  
THE AMERICA INVENTS ACT (H.R. 1249, S. 23)**

Summary. The changes to patent law in the America Invents Act (H.R. 1249, S. 23) are being made largely in the name of changing from a “first-to-invent” system to a “first-to-file” system. Those simple phrases suggest that Congress is making a three simple changes to the requirements and conditions for a patent in sections 102 and 103. See sections (1) to (3) below. In fact, Congress is making ten and perhaps eleven additional important changes. See sections (4) to (15) below.

The title of these bills suggest they will provide incentives for increased inventing by America’s citizens and companies. It is entirely unclear to me that the changes to sections 102 and 103 Acts will improve conditions for inventing. Section (16) below. My view is that they will probably have the opposite effect.<sup>1</sup> See sections (4) to (15).

The America Invents Acts change laws that provided the background for the phenomenal technology-driven economic growth of the United States from 1830 to the present. Section (17) below. The economic problems that sections 102 and 103 of United States patent law addressed in the 19th and 20th centuries are the same problems that exist today and will exist tomorrow. The supreme irony of the America Invents Acts is that they change current United States patent law to the law that prevailed in the 1790s and early decades of the 1800s. Section (18) below. The patent reformers want to adapt to the needs of the 21st century by returning to the law of the 18th century. Congress and the courts worked for about 180 years to change those laws in response to actual experience. Congress now apparently wishes to turn back the clock and start the whole process over again.

(1) Award a Patent to the First to File. The first change is to eliminate patent interferences and assign patent rights to the first inventor to file an application rather than the first inventor to think of the invention and do the research needed to show the invention may actually be made and used. To do this, Congress need merely delete sections 135 and 291 and change section 102(g)(1) to read (using the language of these bills), “(g)(1) the claimed invention

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<sup>1</sup> The title is misleading in another respect. For the most part, United States patent law makes United States patents available to United States citizens and companies on the same basis as foreign citizens and companies. Hence, any change in the law that that would increase incentives for inventing by people in the United States will also increase incentives for inventing by people outside the United States.

was patented by another in this country based on a patent application having an effective filing date prior to the effective filing date of the application for the claimed invention.” One effect of this change is that patents will go to inventors who are most efficient at R&D and filing patent applications rather than inventors who are simply most efficient at R&D. Another effect is that inventors have increased incentives to file patent applications based on their best guesses about products and processes that it might possible to make and use and without having conducted the actual R&D needed to show that they may successfully be made and used in practice. An inventor who waits to file until the actual research is complete may lose the rights to another inventor who filed based merely on the concept and theory of the invention.

(2) Base Prior Art on Filing Dates, Not Invention Date. The second change has nothing to do with interferences. The second change is to make the patentability of some invention depend on patents, publications, applications that are published or issued, and uses by others that existed before some inventor files an application rather than before that inventor made the invention. To do this, Congress need simply replace the phrases “before the invention thereof by the applicant for patent” in sections 102(a) and “before the invention by the applicant for patent” in section 102(e) with the phrase (again using the language of these bills) “before the effective filing date of the applicant for patent.” The effect of this change is that fewer inventions will be patentable, because more publications, patents, applications, and uses by others will be prior art. While inventors will devote more resources to preparing patent applications earlier to minimize this effect, some inventions that could have been patented under current law will no longer be patentable.

These bills would prevent some of these additional documents and events from being prior art in two situations. One is when these patents, publications, and uses occurred within one year of the inventor’s filing date and were written or carried out by the inventor or people who learned the invention from the inventor. This is not a change in the law. The other is when these patents, publications, and uses occurred within one year of the inventor’s filing date and after the inventor in some undefined fashion “disclosed” the invention, presumably meaning after the inventor published or used it. This is a change in the law. The effect will be that inventors may sometimes publish or use before filing to cut off potential publication or uses by others from becoming prior art. Patents rights will now sometimes depend on who wins the race to publish or use rather than who wins the race to invent.

(3) Preserve, Eliminate or Modify the Rule that Prior Invention by One Inventor Prevents a Patent to A Second Inventor and Is Prior Art. If the second change is made, a third issue arises. Section 102(g) provides an additional source of prior art based on invention dates. For 200 years, inventor Jones could not obtain a United States patent if inventor Smith made the invention in the United States before inventor Jones so long as inventor Smith did not abandon the invention or suppress and conceal it. This was true even if inventor Smith did not seek a patent. Inventor Smith could always use the invention free of infringement claims by Jones. Since the public had Smith as a source for the invention, the public did not need Jones.

Congress apparently wants Jones’ right to a patent to depend only on his or her application filing date, not the earlier invention date. If Jones’ invention date no longer matters and Smith’s does, many Joneses will not receive patents because many Smith’s made the invention after they did, but before the Jones filed their applications. It is not possible to solve this problem by making Jones’ right to a patent depend on Smith’s filing date, because Smith

does not want a patent and has no filing date. This leaves Congress with several options. I will mention two now and others later. See section (15) below.

One, Congress could change section 102(g)(2) to read “or (2) prior to the effective filing date of the claimed invention, the invention was made in this country by another inventor who had not abandoned, suppressed, or concealed it.” Smith’s prior invention prevents a patent to Jones. The effect of this change would be that fewer inventions will be patentable, because more inventions by others will prevent a patent. However, the basic principle would be preserved that no patent is available if the invention had been made in the United States by someone else who had not abandoned it or suppressed and concealed it.

Two, Congress would delete section 102(g)(2), as these bills do. This eliminates the basic principle. This permits second inventor Jones (and other Jones) to obtain a patent even though inventor Smith (and other inventor Smiths) made the invention first though without seeking a patent. The effect of this change would be that more inventions will be patentable, because fewer inventions by others will prevent a patent. However, it is difficult to say whether there is a net gain, since in the absence of a patent to Jones, the benefits of the invention may have been available from Smith without a patent. The Smiths of the world will become patent infringers if they use their inventions, even though they were willing to provide products and use processes without obtaining patents.

The important point is that these are the only three established doctrines of patent law that Congress needs to address to change from first-to-invent to first-to-file. This would be the end of it. However, this is far from the end. For some reason, Congress has also decided to change many other time-honored doctrines of patent law. This is a list of ten of them and an eleventh the House proposes to make. I discussed most of these issue detail in my letters of April 10 and May 5 to certain members of Congress.

(4) Eliminating the Basic Standard that Defines the Prior Art. Under these bills, the basic standard for determining what activities constitute prior art under section 102(a), whether the invention was “known or used by others,” is eliminated, and with it all of the law developed since 1830 interpreting and applying that standard. The effect will be new uncertainty about what events involving actual products and processes give rise to prior art and possibly expand the types of events that are prior art, making fewer inventions patentable.

(5) Establishing a Different Standard to Define the Prior Art The new standard for determining what activities constitute prior art under section 102(a)(1) is whether the invention was “in the public use or on sale, or otherwise available to the public.” The first part of that standard is taken from current section 102(b), which disappears. The second part is new. The effect again is to create uncertainty about what events involving actual products and processes give rise to prior art and possibly expand the types of events that are prior art.

(6) Eliminating the Separate Doctrine of Loss of Rights Section 102(b) is eliminated. There is no reason to change section 102(b) that provides that rights may be lost based on patents, publications, and certain types of uses and sales more than one year before some inventor’s filing date. There is no need to change what has come to be called the one year “grace period” for filing after an inventor seeking a patent publishes or makes certain uses or sales of some invention. The same one year “grace period” applies to patents, publications, and other

types of uses and sales of other people. There is also no apparent reason why changing to a so-called first-to-file system requires changing those rules.

(7) Broadening the Prior Art to Activities Outside the United States. New section 102(a)(1) broadens the activities that prevent a patent from those taking place in the United States to those that take place anywhere in the world. The effect is to expand the types of events that are prior art, making fewer inventions patentable, and creating uncertainty about whether the same rules that have been applied to determine whether events in the United States are prior art apply to events outside the United States.

(8) Changing the Date for Determining Whether Public Use or Sale Prevents a Patent. Under current section 102(b), an invention may not be patented only if it was in public use or on sale more than one year “prior to the date of the application for patent in the United States.” Under new section 102(a)(1) and (b)(1), an invention may never be patented if the invention was “in public use or on sale” more than one year before the “effective filing date” of an application, and “effective filing date” has been defined to include an earlier foreign priority application. Under new section 102(a)(1), the one year so-called grace period will start to run from the earlier date of any foreign priority application. Today, anyone who wants a United States patent may use an invention for only one year before filing for that patent. Under this change, a person who files first outside the United States may use the invention in the United States for two years before filing in the United States, because uses within one year before foreign filing do not prevent the patent and the foreign application may be the basis for priority if the United States application is filed one year later.

(9) Section 102(c) Is Eliminated. Section 102(c) prevents a person who previously abandoned an invention from obtaining a patent. This section is eliminated. The effect is that a person may now obtain a patent even though he or she previously threw the invention away and it would never have been used by anyone, unless made again by someone else. This person may now obtain the patent even though the only reason that person filed an application was that he or she got wind of the fact that someone else made the invention and was going to use it and perhaps patent it.

(10) Section 102(d) Is Eliminated. Section 102(d) that prohibits a patent if an inventor patented the invention in a foreign country before filing an application in the United States and filed the foreign application more than one year before filing the United States application is eliminated. Today, a person seeking United States and foreign patents risks losing United States patent rights by not acting promptly to seek them. Under these bills, a person may apparently file foreign applications and obtain foreign patents before seeking a United States patent, so long as a foreign application is not published and a foreign patent is not issued more than one year before filing in the United States.

(11) Section 102(e) Is Changed. Section 102(e) is amended and appears as new section 102(a)(2). One change is that a patent application may apparently be “deemed” to have been published even if it was not. The effect is to expand the prior art to include information inventors and the public may never know about.

(12) The Date Section 102(e) Applications Become Prior Art Is Changed. Section 102(e) is also amended by new section 102(a)(2) so that instead of United States patents and published

United States patent applications qualifying as prior art only as of the filing dates of United States applications or Patent Cooperation Treaty applications published in English and designating the United States, those patents and published patent applications will qualify as prior art as of the filing dates of earlier foreign patent applications. The effect is to expand the prior art and render fewer inventions patentable.

(13) Section 102(f) Is Eliminated. Section 102(f) says a person who “did not himself invent the subject matter sought to be patented” may not obtain a patent. This section is eliminated. The effect is to create uncertainty about whether information an inventor learned for others constitutes prior art and perhaps even uncertainty about the fundamental policy that an inventor may only patent inventions he or she created, and not inventions learned for others.

(14) The Date For Determining Nonobviousness Under Section 103 Is Changed. The date used to determine whether an inventor made an invention that would not have been obvious to a person of ordinary skill under section 103 is no longer the date on which that inventor made the invention, but the later date when the inventor files a patent application. The likely effect is that fewer inventions will be patentable. Some people who made inventions that were new and nonobvious at the time they did their work (when the patent rights appeared to be available) may be deprived of a patent because later and better information and later and better general skill became available.

This change may also have a more far reaching effect. Perhaps the most difficult practical problem in applying the nonobviousness standard is an almost unavoidable tendency to judge nonobviousness with the benefit of hindsight. While the law today requires that hindsight not be employed, it is enormously difficult to tell someone about some invention and then expect them to judge the ease or difficulty of making that invention based only on what was known before the invention was made and only on the level of skill others possessed before the invention was made. If section 103 commands that nonobviousness be judged as of the effective filing date, not the earlier date on which the invention was made, the problem of hindsight will be compounded since the law will appear to require use of hindsight.

(15) Modify the Rule that Prior Invention by One Inventor Prevents a Patent to A Second Inventor and Is Prior Art; Prior User Rights. I mentioned in section (3) the options of preserving or eliminating the principle that only the first person to make an invention may receive a patent, unless the first abandons the invention or suppresses it. Congress could also modify the effects of a prior invention.

Congress could eliminate the basic principle, allow the second inventor to have a patent, and create an immunity from infringement liability for the first inventor. This would make more inventions patentable, while limiting the value of the patents on those inventions. A second inventor could now have a patent, but the patent would not control use of the invention by earlier inventors. The net effect in most situations will be that an inventor who obtains a patent and an inventor with an immunity will have incentives to agree to some arrangement that maximizes the value of the invention and provides for some sharing of the resulting gains, assuming that antitrust law does not intervene. Neither bill adopts this straightforward approach. One can only speculate about the reason. One supposition is that providing an immunity for earlier inventors would require deciding who was an earlier inventor and Congress does not want any aspect of patent law to be based on invention dates.

Instead, the Senate bill calls for a study of “prior user rights” and a report to Congress. The House bill contains one possible type of “prior user rights” by broadening existing section 273 so that it applies to all inventions. Section 273 is titled “Defense to infringement based on earlier inventor.” In fact, section 273 does not provide an immunity for people who made some invention before the person who obtained a patent. As amended by the House bill, section 273 would provide an immunity for any person who (1) actually reduced the invention to practice more than one year before a patent’s effective filing date, and (2) commercially used the invention in the United States before the effective filing date, provided that person did not derive the invention from the patentee or abandon use of the invention. As amended, the section 273 immunity would not apply to inventions made with federal government money or invention made in universities. People who risk their own money inventing are not so privileged.

Prior user rights of the section 273 variety will have little effect given another change in these bills. Under section 102(a)(1) of the Senate and the House bills, if anyone places an invention “in the public use or on sale” at any time before someone else files a patent application, the patent application may not properly issue as a patent. In other words, people are protected who use an invention prior to someone else filing a patent application. Commercial users prior to filing (and everyone else) have total immunity, unless one exception provided by the bills applies (a use that takes place within one year of filing and after the person seeking a patent disclosed the invention to the public in some fashion) and perhaps another exception provide by the law applies (for example, a prior secret commercial use of a process that is not a public use). Except in those situations, the section 273 immunity will never matter. There will be no patent.

If Congress wishes to preserve in some manner the general principle that has governed United States law since 1830 without basing some immunity on who invented first under current standards, Congress could base an immunity on whether some inventor reduced an invention to practice (that is, actually made and successfully tested some product or process) before the inventor who obtained a patent did so. While rule this would change the law, it would retain the incentives existing under current allocation of rights – the first person to reduce to practice (the presumptive first inventor under current law) may obtain rights enforceable against a second to reduce to practice (the presumptive second inventor under current law), making inventing more valuable. If the second to reduce to practice obtains a patent (something not possible under current law unless the first abandoned the invention or suppressed and concealed it), the first may obtain some immunity. This will set the stage for a bargain in which the value of the patent is shared.

If Congress bases an immunity on whether some inventor reduced an invention to practice before some other inventor filed an application or more than one year before some other filed an application (as under section 273), this rule changes the incentives existing under current allocation of rights. The first person to reduce to practice will not have rights enforceable against a second, third or fourth to reduce to practice (provided they do so before filing), making inventing less valuable. Assuming the patent has any value, the first inventor must share its value with everyone who reduces to practice before the first files. This reduces net incentives to invent. The value of being first to do the research is zero (because the law does not take reduction to practice by the inventor seeking a patent into account in defining the basic right to a patent or the existence of immunities) and the value of being second, third or fourth to reduce to

practice is positive (because the law does take reduction to practice into account for creating immunities).

An Alternative to Prior User Rights – Joint Ownership. There is an alternative solution to the dilemma caused by the granting the patent to the first person to file an application rather than the first person to make an invention. It is to grant a patent jointly to all inventors who file patent applications for some invention within some limited period of time, such as one year. A variation would be to grant the patent jointly to the first to file and to anyone who filed later and who shows that it made the invention and was making investments to commercially exploit it before the first application was filed. There are other alternatives. The basic concept is to make all inventors who did what the law seeks encourage joint owners of the patent. This rule would preserve incentives to make inventions because patent rights remain exclusive. The law would provide that no joint owner could use or license the invention without authority of the others. This rule would leave to the people who made the invention to decide how the value of that invention will be divided among them. This approach may be preferable to one in which patent rights are not granted to anyone if someone else made the invention previously and did not abandoned or suppressed or suppress it and also preferable to one in which the law grants a patent to the first person to file an application and either makes all other earlier independent inventors patent infringers or gives earlier independent inventors prior user rights.

(16) There Is Little Reason To Believe The Changes To Sections 102 And 103 Of The America Invents Acts Will Provide Conditions For Increased Inventing By America. These changes are being made in a bill entitled the “America Invents Act.” This title suggest that enactment of these bills will lead to more inventing by people and companies in the United States. There is little reason to believe that these changes to sections 102 and 103 will have that effect.

Awarding a patent to the inventor who files first rather than the inventor who invents first makes inventing less important to the ability of someone to obtain a patent. Being the best inventor is no longer enough. Most efficient inventors will sometimes lose out to most efficient filers. Resources spent on lawyers become more valuable; resources devoted to R&D less valuable. Expanding the prior art to include publications and uses that occur after some inventor makes an invention but before it is able to file an application makes the prospect of a patent less likely and the corresponding incentives to invent smaller. Expanding the prior art in the many other ways will have the same effect. The only change likely to increase incentives to make inventions is the elimination of section 102(g), because this will allow a second or third inventor to obtain a patent, when they could not today. However, it is difficult to say whether there is a net gain, since in the absence of a patent to the second or third, the benefits of the invention may have been available from the first without a patent to anyone. With this change, the first person to make some invention may now become a patent infringer (making inventing riskier) and the value of patents rights to second and third inventor may be reduced and perhaps destroyed by prior user rights to protect the first inventor.

(17) The America Invents Acts Changes Laws That Existed During The Phenomenal Economic Growth of the United States From 1830 To The Present. These changes are hailed by many as necessary to adapt patent law to the realities of the 21st century. In fact, the economic problems that United States patent law addressed in the 18th, 19th and 20th centuries are the same problems that exist today and will exist tomorrow. The three fundamental doctrines

mentioned earlier have been in place since the Patent Act of 1836. These laws were in place throughout the period during which the United States changed from a country of farmers and traders to a country whose scientists, engineers and assorted tinkerers devised new machines, products and processes that gave rise to entirely new industries and new companies whose industrial output made the United States the envy of the world. While I am aware of general talk about adapting to the 21st century, I have not seen an explanation of exactly what economic conditions have changed and why these amendments to several other fundamental features of patent law are necessary to meet the new situation.

My sense is that the main changes in these bills are intended simply to change United States patent law so that it resembles the patent laws of countries in Europe and Asia. The underlying assumption of these bills may be that, in the 21st century, the United States will lag behind the main industrial countries of Europe and Asia in the rate of technological change and technology-driven economic growth, because the patent laws of Europe and Asia provide greater aggregate economic benefits at lower costs than United States patent law. If that is the assumption, I am aware no reason to believe it is true. The United States government does many things to discourage profit-driven technological change and economic growth. However, United States patent law is not one of them.

(18) The America Invents Acts Return United States Patent Law To The Law Of The 1790s And Early 1800s. Even if economic conditions in the 21st century are different from those in the 18th, 19th and 20th centuries, the so-called 21st century reforms do not implement novel approaches to meet the new conditions. Instead, they simply take United States law back to where it was in the late 18th and early part of the 19th centuries.

Many of the changes to section 102 as well as certain procedural changes seem designed to emulate the patent laws of countries in Europe. One of those countries is the United Kingdom. The UK patent system is a “first-to-file” system and has been for centuries. The United States Patent Acts of 1790, 1793 and 1800 were based in large part on the patent law of England.<sup>2</sup> The laws of England determined whether an invention was new based on “the time of making letters patent,” presumably filing date of whatever document at the time was an application.<sup>3</sup> The laws of England may also have limited patents the first inventor.<sup>4</sup> However, I have no information about how the first inventor was identified, by filing date or invention date.

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<sup>2</sup> See *Pennock v. Dialogue*, 27 U.S. 1, 18 (1829)(“It is obvious to the careful inquirer, that many of the provisions of our patent act are derived from the principles and practice which have prevailed in the construction of that of England.”)(Story, J.); Joseph Story, *Notes on the Patent Laws*, 16 U.S. 454, 591 (Appendix)(1818)(“The patent laws of the United States are, in a great degree, founded on the principles and usages which have grown out of the English statute on the same subject.”).

<sup>3</sup> Joseph Story, *Notes on the Patent Laws*, 16 U.S. 454, 591 (Appendix)(1818)(“6. A patent must be of such manufacture or process, as no other did, at the time of making the letters-patent, use; for though it were newly invented, yet, if any other did use it, at the time of making the letters-patent, or grant of the privilege, it is declared void by the act.”).



The Patent Act of 1793 (and 1800) seemed to have two requirements for a patent to issue and two defenses that would prevent enforcement.<sup>5</sup> Section 1 said the secretary of state could issue a patent to a person or persons who “allege that he or they invented any new and useful art, machine [etc.], not known or used before the application.” An inventor’s application filing date, not the invention date, determined whether the invention was new, as in the America Invents Acts.

Section 3 provided that an inventor also swear that he was the “true inventor or discoverer of the art, machine, or improvement for which he solicits a patent.” The Act of 1790 had authorized the courts to repeal a patent “if it shall appear that the patentee was not the first and true inventor or discoverer.”<sup>6</sup> In 1793, Congress eliminated the courts’ authority to repeal a patent because the patentee was not “first.” After 1793, the only ground for repeal was that the patentee was not the “true inventor.”<sup>7</sup> The 1793 Act did not require that an inventor be the first inventor, as in the America Invents Acts.

Section 6 said it was a defense to an infringement action that “the thing 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.” Section 6 caused confusion, because it provided defenses based on events before “the supposed discovery of the patentee.” The courts quickly noted the apparent inconsistency between section 1 that referred to application dates and section 6 that referred to invention dates.<sup>8</sup>

By 1829, the courts had interpreted the Act to mean that:

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<sup>4</sup> Joseph Story, Notes on the Patent Laws, 16 U.S. 454, 591 (Appendix)(1818)(“8. A patent may legally be granted only to the first and true inventor; for such are the descriptive terms of the statute. 3 Inst 184. But if the original inventor has confined the invention to his closet, and the public be not acquainted with it, a second inventor, who makes it public, is entitled to the patent.” (citations omitted)).

<sup>5</sup> Act of 1793, §§ 1,3 and 6.

<sup>6</sup> Act of 1790, § 5.

<sup>7</sup> Act of 1793, § 10.

<sup>8</sup> Pennock v. Dialogue, 27 U.S. 1, 22-23 (1829)(“The only real doubt which has arisen upon this exposition of the statute, has been created by the words of the sixth section already quoted. That section admits the party sued to give in his defence as a bar, that ‘the thing thus secured by patent was not originally discovered by the patentee, but had been in use *anterior to the supposed discovery* of the patentee.’ It has been asked, if the legislature intended to bar the party from a patent in consequence of a mere prior use, although he was the inventor; why were not the words ‘*anterior to the application*’ substituted, instead of ‘*anterior to the supposed discovery*? If a mere use of the thing invented before the application were sufficient to bar the right, then, although the party may have been the first and true inventor, if another person, either innocently as a second inventor, or piratically, were to use it without the knowledge of the first inventor; his right would be gone.”).

(1) an inventor could not have a patent if it made an agreement with a manufacturer to make and sell a product embodying the invention, such as fire hoses, to users of the product and the manufacturer did so before the inventor filed an application (because “known or used” in section 1 meant known or used by the public and an invention was known or used by the public when an inventor made and sold the invention publicly and thereby allowed the public to use it)<sup>9</sup>;

(2) an inventor might not have a patent if another person (even a second inventor) put the invention into actual use before the inventor seeking a patent filed an application<sup>10</sup>;

(3) an inventor could not obtain a patent, if some other person put the invention into actual use, before the inventor made his or her discovery (because the inventor had not made a “new” art or machine under section 1<sup>11</sup> and was not the first inventor as section 6 required<sup>12</sup>), and the rule applied even when the other person did not seek a patent<sup>13</sup>;

(4) an inventor could not obtain a valid patent, if some other person reduced the same invention to practice (that is put the machine in operation and produced useful results), before the inventor discovered the invention, and the other person did not abandon the invention<sup>14</sup>;

(5) when two inventors seek a patent on the same invention, the first person to reduce the invention to practice is entitled to the patent, unless the first inventor abandons the invention.<sup>15</sup>

In short, the courts said the Patent Act meant that: (1) no patent was available if an inventor and probably someone else used the invention for its practical purpose before an application was filed; (2) no patent was available to some inventor if someone else put the invention into normal use before the inventor made the discovery; (3) no patent was available to some inventor if someone else discovered the same invention and successfully operated the invention before the inventor made the discovery; and (4) when two people seek a patent on the same invention, the first to make the discovery is entitled to the patent.

In 1836, Congress changed the language of the Patent Act to incorporate these rules. The Act of 1836 changed the requirement that the invention not be “known or used before the application.” The Act said a person could apply for a patent “having discovered or invented any

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<sup>9</sup> Pennock v. Dialogue, 27 U.S. 1, 19-23 (1829).

<sup>10</sup> Pennock v. Dialogue, 27 U.S. 1, 19-23 (1829).

<sup>11</sup> Bedford v. Hunt, 3 Fed. Cas. 37 (C.C.M. Mass. 1817).

<sup>12</sup> Pennock v. Dialogue, 27 U.S. 1, 19-23 (1829).

<sup>13</sup> Pennock v. Dialogue, 27 U.S. 1, 19-23 (1829).

<sup>14</sup> Woodcock v. Parker, 30 F.Cas. 491, 492 (C.C.Mass. 1813).

<sup>15</sup> Cf., Woodcock v. Parker, 30 F.Cas. 491, 492 (C.C.Mass. 1813); Joseph Story, Notes on the Patent Laws, 16 U.S. 454, 591 (Appendix)(1818)(“The original inventor of a machine, who has reduced his invention first into practice, is entitled to a priority of the patent right: and a subsequent inventor, although an original inventor, cannot sustain his claim although he has obtained the first patent; for *qui prior est in tempore, potior est in jure*.”).

new and useful art . . . not known or used by others before his . . . discovery or invention thereof, and not, at the time of his application for a patent, in public use or on sale, with his consent or allowance, as the inventor or the discoverer.”<sup>16</sup> The Act of 1836 required the Commissioner of Patents not to grant a patent if “the same had been invented or discovered by any other person in this country prior to the alleged invention . . . by the applicant, or . . . it had been patented or described in any printed publication in this or any foreign country or had been in public use or on sale with the applicant’s consent or allowance prior to the application.”<sup>17</sup> The Act of 1836 was amended to require the applicant to swear he was “the original and first inventor” - rather than merely “the true inventor” - and that he did not believe “the same was ever before known or used.”<sup>18</sup> The 1836 Act provided that a defendant would not be liable if he proved “that the patentee was not the original and first inventor or discoverer of the thing patented . . . or that it had been described in some public work anterior to the supposed discovery thereof by the patentee, or had been in public use or on sale with the consent and allowance of the patentee before his application.”<sup>19</sup> The defenses track the grounds for the Commissioner to refuse to grant the patent. Congress also provided for interferences to decide “priority of invention.”<sup>20</sup>

The America Invents Act reverses these changes. Use of an invention by others prevents a patent if before the application filing date, and even if after the invention date. A person other than the first inventor may obtain a patent. A second inventor may obtain a patent, even if the first inventor had not abandoned the invention. The first inventor may be a patent infringer if it uses that invention. When two people seek a patent, the first inventor does not necessarily receive it.

These changes probably make United States law the same in those respects as the law of England in 1776. United States patent law is about to be amended to meet conditions in the 21st century by returning the law to the Patent Act of 1793. The law that evolved in over the 220 years of America’s experience with patent law is being thrown out and replaced with the laws that prevailed prior to 1836. Congress and the courts worked for about 180 years to adapt the law to actual experience. Congress now apparently wishes to turn back the clock and start the whole process over again.

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<sup>16</sup> Act of 1836, § 6.

<sup>17</sup> Act of 1836, § 7.

<sup>18</sup> Act of 1836, § 6.

<sup>19</sup> Act of 1836, § 15.

<sup>20</sup> Act of 1836, § 8.