

PATENT WATCH:

who's on first?

BY KIRK TESKA

Being first is very important in a patent system. A patent, after all, recognizes a novel idea—something no one has designed before. In return for disclosing the idea to the public, the inventor gets exclusive rights to it for a number of years. There can only be one patent issued for one invention.

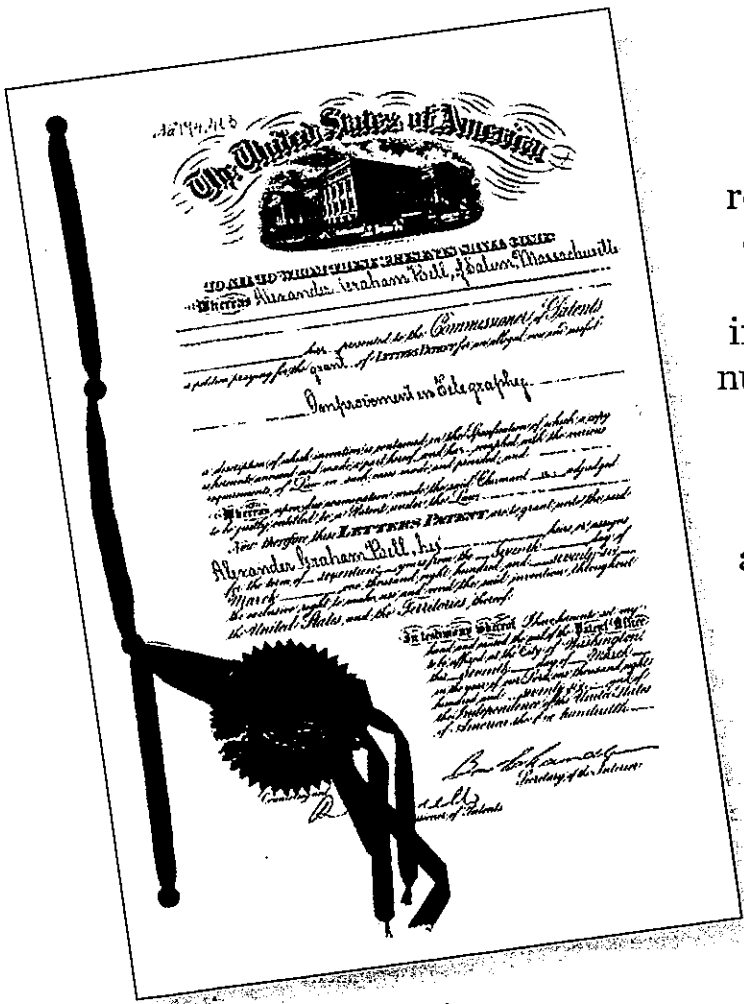
The question, then, is who is first?

The first person to file a patent application for the idea? Or the person who can prove she thought of it first?

In a first-to-file patent system, the inventor who files the first patent application wins the patent. All

countries except the United States, until now, have first-to-file systems.

The U.S. has been a first-to-invent country for, well, as long as it's been a country. That means, if two or more inventors apply



Kirk Teska is an adjunct law professor at Suffolk University Law School, and is the managing partner of landiorio Teska & Coleman, an intellectual property law firm in Waltham, Mass. His latest book Patent Project Management (ASME Press) is now available.

to patent a similar idea, the inventor who can establish that he worked out the idea first will win the patent even if another inventor has filed a patent application first.

How do we decide who was first to invent? By using a quasi-judicial procedure convened at the Patent Office called an "interference." During an interference, first to invent means looking at both inventors' invention conception dates and how and when they each reduced their inventions to practice. Lawyers are hired, invention notebooks are reviewed, and after a lot of time and money are spent, a winner is declared by a patent examiner.

Before that happens, though, two things have to occur. First, there have to be two inventors who, at about the same time, invent the same thing. Second, someone has to notice. One of the inventors could become aware of the other's patent and force an interference, or a Patent Office examiner could see two competing patent applications and declare an interference. Each of these contingencies (invention of the same thing at the same time or someone noticing) have low odds of occurrence. Together, the odds are even lower.

The overall result is that there haven't been very many interferences: there are fewer than a couple of hundred interferences each year from the half million patent applications filed. And, in the vast majority of cases, the first filer wins anyway. As a result, some commentators have quipped that we already have a de facto first-to-file system.

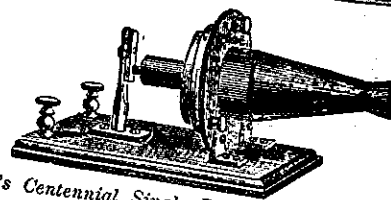
Still, first-to-file is simpler, what everyone else does, and sounds progressive. It will become effective in the U.S. on March 16, 2013. Independent inventors and small businesses who lobbied for keeping our first-to-invent system failed to convince Congress to retain the *status quo*.

Some legal experts are of the opinion that first-to-file violates the Constitution insofar as it states inventors are granted exclusive rights to their discoveries wherein "inventor" is read to be the "first" or "true" or "original" inventor. Others disagree: Suffolk University Law School's Andrew Beckerman-Rodau doesn't believe any court would seriously consider the issue. Time will tell if and how the courts react to constitutional challenges to the new first-to-file regime.

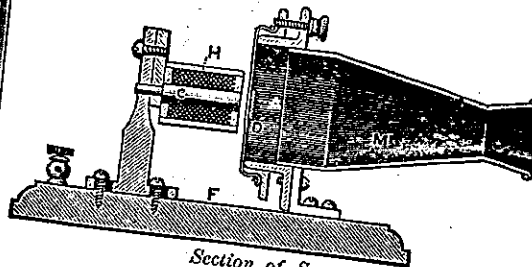
Perhaps more interesting is that, when a first-to-file system in the U.S. was first proposed years ago, the goal was harmonization with the rest of the world, since the U.S. stood alone with a first-to-invent system. Patent reform measures including the first-to-file change were in the news each year for the last six or so years but were never passed by Congress.

The 2011 version of a patent reform bill was called the "America Invents Act" and included, again, the first-to-file change. After being touted as a "jobs creation bill," the bill finally passed both houses of Congress and was signed by President Obama on Sept. 16, 2011. Harmonization was no longer the key driving force behind first-to-file; simplicity was.

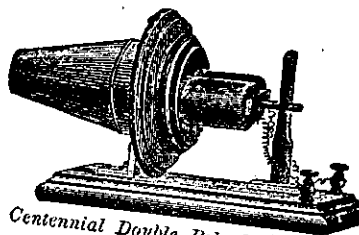
So that's how the sausage was made: harmonization gave way to simplicity and a problem that didn't exist was solved in a way that might be in violation of the Constitution. ■



Bell's Centennial Single Pole Magneto Telephone.



Section of Same.



Bell's Centennial Double Pole Magneto Telephone.

The U.S. policy in granting patents until now held that the person who was first to invent will receive the patent, regardless who is first to file the patent. There is a popular belief that it was Graham Bell's patent application, filed shortly before that of Elisha Gray's, and that made all the difference.

The order of filing, in fact, was the issue. The U.S. Patent Office suspended all patent applications and began an interference proceeding. The patent was issued to Bell, but he eventually convinced everyone that he had been the first to invent the telephone.

Most of the world followed the U.S. system for issuing patents. It was not until the patent reform of 1980 that the world adopted that system or, more accurately, the patent reform of 1980 that the world became effective.

Above, Single Pole Magneto Telephone design by Bell, as published in *Science* in 1906. Diagram of the telephone patent awarded to Graham Bell in 1876.