

Would First-Inventor-to-File Be Better for the Basement Inventors, the Universities, or the Corporations?^{1,2}

By

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Is First-to-Invent Better for the Basement Inventors, the Universities, or the Corporations?

Our best basis for predicting the future to answer the question posed by the title of this article is to consider the past.

The basis for my opinion is anecdotal evidence. I don't think that the available data allows meaningful conclusions to be drawn. I've been an interference practitioner for 30 years, and I've long been an active member of the Interference Committee of the American Intellectual Property Law Association. I've read several articles on this subject. However, other interference practitioners may well have had experiences that differ from mine. So, take what follows with an appropriate grain of salt.

In my opinion, small entity v. large entity status and corporate v. non-corporate status both obscure the real issue. Most university inventions are commercialized by corporations, and many basement inventors are incorporated.

So, what really made a difference under the present regime? Record keeping, corroboration, and promptness of filing! All three of these variables can be correlated (very loosely!) with the basement inventors, universities, (big) corporations trichotomy.

Inventors at big corporations are not necessarily good record keepers. University inventors are often lousy record keepers. I cannot generalize about basement inventors. (I've dealt with some who were excellent.)

When I gave this presentation at the Columbus School of Law conference, Hal Wegner

was one of the other panelists. He maintained (with his customary vigor) that “big pharma” companies uniformly keep excellent records. Well, maybe. I’ve had contrary experiences with what I might call “medium pharma.” I prefer to say that the good record keeping variable varies from company to company, laboratory to laboratory, and even individual to individual.

Where inventors at big corporations have really had an advantage is in corroboration. Collegiality is the rule. Contrary to myth, university inventors tend to be short on collegiality. Basement inventors often are loners, which can give them serious problems. However, those problems are somewhat alleviated by the surprising fact that the BPAI accepts the statements of spouses and other near relatives as constituting “independent” corroboration.

Some big corporations file quickly, and some do not. Some small corporations file quickly, and some do not. Almost all universities file painfully slowly. Some basement inventors file quickly, and some do not.

Would the Change from First-to-Invent to First-Inventor-to-File Have an Impact?

On patent practice: You bet! At present, the life of patent practitioners in first-inventor-to-file jurisdictions is very different than the life of patent practitioners in the United States. American prep-and-pros folks are definitely going to have to learn to hustle.

On who obtains a patent: probably—depending largely on how big U.S. corporations adapt. Patent-savvy U.S. corporations (big or small) and patent-savvy basement inventors already behave as if they lived in a first-inventor-to-file world. Patent-clueless U.S. corporations (big or small--but mostly small) and patent-clueless basement inventors will probably remain so.

Universities are and probably will remain patent-clueless. That is because they are gangs of individual prima donnas, not organized entities. (Apologies to my professor son.)

The change would greatly decrease the need for corroboration. However, litigants would

probably still need corroboration in derivation and inventorship cases.⁴

Note that the first-inventor-to-file jurisdictions all have rudimentary interference-type systems to determine what we call derivation cases. Apparently we will continue to have a full blown interference-type system to determine what are now derivation interferences (i.e., A v. B interferences) and inventorship interferences (i.e., A v. A and B interferences).⁵

Would the Probable Impact of the Proposed Change Raise Policy Questions?

Of course! Most legislation has real-world impact, which means that there are winners and losers. Congress should consider that inescapable fact, but that fact is no different with respect to this proposed change than it is with almost all changes that Congress considers.

Whether you think that the fact that the proposed legislation would have real world impact should bias Congress for or against making the change probably depends on the clients that you normally represent.

Does the Probable Impact of the Proposed Change Raise Ethical Questions for Patent Practitioners?

Of course, each of us has his or her own present clients and probable future clients, and whatever one of us says about the desirability of the change will probably be influenced by that fact. (I represent mostly corporations, large and small.)

However, I don't think that the proposed changes would have any impact on the ethical issues confronting patent practitioners. 35 CFR 1.56 will still govern our lives. Different things will constitute "bad facts." However, our obligation to disclose "bad facts" to the PTO will be the same.

Conclusion

La plus ça change, la plus ça reste la meme chose. At least in this case, and at least so far as my assigned topic is concerned.

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² Based on a presentation by the author on March 29, 2007 at a conference entitled “Ethical Issues in Patent Law” held at the Columbus School of Law of the Catholic University of America in Washington, D.C.

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⁴ Many such cases involve documents generated by one or more of the putative inventors. As to such documents, see Gholz and Wilcox, Do Documents Generated by an Inventor Have to Be Corroborated?, 14 Intellectual Property Today No. 4 at page 26 (2007).

⁵ The “Leahy-Hatch/Berman-Smith Patent Reform Act of 2007” would replace 35 USC 135(a) with a section entitled “DISPUTE OVER RIGHT TO PATENT” which would provide for such proceedings.