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Priority of Invention in United States Patents:

From the Paris Convention to GATT

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I. Introduction

{1} Imagine the following:

It's New Year's Eve, 1994, and as twilight falls you start to clean off your desk and get ready to go home. On top of your "Out" tray is a copy of a patent application for American Corporation that you filed with the Patent and Trademark Office last week. A-Corp., one of your largest clients, is the nation's largest manufacturer of business office furniture. The patent application is for A-Corp's new "Security Cabinet," a device that protects sensitive computer disks and videotapes from electromagnetic contamination.

The Security Cabinet was unveiled at an office supply trade show in Las Vegas over the summer, and sales have been brisk ever since. Both the R & D and Sales departments at A-Corp. consider the success of the Security Cabinet to be a feather in their cap. As a result, the company would like to develop an entire Security Cabinet product line. However, before making such an investment, A-Corp. wanted to acquire patent protection for the device to secure its position at the top of the market.

The phone rings as you remember that drafting the claims and completing the application for the Security Cabinet were routine. On the other end of the line is the head of A-Corp.'s R & D department. "Have you filed the patent application for the Security Cabinet yet?" he asks, almost out of breath. You tell him that the application was delivered to the Patent and Trademark Office in Arlington just this week.

"Well," he says, "we may have a problem. My staff keeps tabs on the market to see what kind of office products are out there, and we've found two other companies that are selling rip-offs of our Security Cabinet! One is made here in the U.S. and the other is made in Canada. And they both say 'U.S. Patent Applied For' on them! What are we going to do?"

{2} The above account opens a Pandora's box of possibilities that may help or hinder the fictional A-Corp and its patent counsel in its pursuit of patent protection. Disputes often arise between parties who independently claim patent rights in an invention. The protectionistic laws by which these disputes traditionally have been resolved have changed dramatically in the past twelve months and, because of recently enacted legislation, will change dramatically again in the near future. This paper provides a context in which to examine inventorship disputes by surveying the fundamentals of United States patent law. In addition, this document analyzes the traditional manner in which inventorship disputes have been resolved, as well as the extraordinary impact recent changes in the law will have on the resolution of patent disputes in the United States.[\[1\]](#)

II. Sources of Statutory and Regulatory Patent Law

{3} "To promote the progress of useful arts, Chief Justice Marshall said, is the interest and policy of every enlightened government."[\[2\]](#) To this end, the United States Constitution has granted to Congress the right "[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"[\[3\]](#) The importance of this endowment in the lives of citizens cannot be overstated. As noted by Ralph Oman, a former Registrar of Copyrights of the United States, "[this] protection of intellectual property is the only right granted to individuals in the U.S. Constitution - the Bill of Rights would not come until four years later."[\[4\]](#) Congress has never hesitated in exercising its authority to protect intellectual property rights; the current enactment relating to patents was passed in 1952.[\[5\]](#)

{4} These laws provide a basic framework for the U.S. patent examination and registration system. The Code also allows the Commissioner of Patents and Trademarks, in conjunction with the Secretary of Commerce, to establish regulations with regard to the conduct of proceedings in the Patent and Trademark Office ("PTO").[\[6\]](#) In addition, the PTO has promulgated its Manual of Patent Examining Procedure ("MPEP"), which its employees apply when examining patent applications. The MPEP reflects the PTO's interpretation of the patent statutes and regulations together with interpretive case law.[\[7\]](#)

{5} These legislative and administrative statutes have been supplemented over the years with treaties and reciprocal national legislation to which the United States is a party. Important for the resolution of inventorship disputes is the Paris Convention for the Protection of Industrial Property of March 20, 1883 (revised and amended) ("[Paris Convention](#)"),[\[8\]](#) the North American Free Trade Agreement Implementation Act ("[NAFTA](#)"),[\[9\]](#) and the General Agreement on Tariffs and Trade ("[GATT](#)") as enacted by the Uruguay Round Agreements Act.[\[10\]](#) The changes to United States patent law as a result of both the Paris Convention and NAFTA have been codified in the statutes and regulations.[\[11\]](#) However, the PTO's interpretation of the statutory amendments brought about by the recent adoption of GATT is less certain because the changes,

although effective, have not yet been reflected in the regulations or the MPEP.

III. Overview of United States Patent Law

{6} For an individual to be awarded a patent by the United States Patent and Trademark Office, he must submit his application to the PTO for rigorous examination to ensure compliance with both formal and statutory requirements.^[12] There are three fundamental statutory requirements that an invention must embody before a patent will be granted:^[13] utility,^[14] novelty,^[15] and non-obviousness.^[16] The first two requirements, utility and novelty, have straightforward definitions and applications.

{7} Courts have been liberal in finding that inventions have utility. Utility exists if an invention is not "frivolous or injurious to the well-being, good policy, or sound morals of society"^[17] and so long as it has some "substantial utility [greater than merely being] an object of scientific research."^[18] Novel inventions are those which are new and do not replicate "prior art," *i.e.*, inventions that have previously been discovered. Patents will not be granted for inventions that lack novelty because to do so "would injure the public by removing existing knowledge from the public domain."^[19]

{8} In addition to the utility and novelty requirements, an invention must also be more than a mere obvious extension over previous inventions.^[20] For an inventor to be awarded a patent for an invention, his invention must be unlike anything ever created in that field, and it also must be *so unlike* other prior art that its creation would not have been obvious to someone skilled in that field. To allow a patent to be awarded for acts that are less than quantum improvements in an art would result in patent holders having little or no patent protection at all.^[21]

{9} In addition to the triad of utility, novelty and non-obviousness, a United States patent can only be granted to an applicant who is "the original and first inventor" of the subject matter of the application.^[22] Thus, one who does not *himself* invent the subject matter to be patented is precluded from obtaining a patent.^[23] Historically, the privilege of patenting was limited to United States citizens.^[24] However, by the mid-nineteenth century the Patent Code extended to "any person" the ability to acquire a United States patent.^[25] Since that time, "participation in the U.S. patent system, as patentees and as licensees, [has been] available to citizens and non-citizens alike."^[26]

{10} The patenting process begins by submitting an application that complies with the above statutory requirements to the PTO. Such an application, in combination with compliance with the formal requirements of the Code and the Rules, should result in the award of a patent. The formal requirements compel applicants to, *inter alia*, submit drawings on certain sizes and types of paper,^[27] respond to official communication by the PTO within a set amount of time^[28] and pay appropriate fees prior to the issuance of a patent.^[29]

{11} If an inventor is successful in obtaining a patent, he will be awarded the "right to exclude others from

making, using, or selling the invention throughout the United States . . . "[30] Additionally, the United States Code provides that "patents shall have the attributes of personal property." [31] Thus, "[these] exclusionary rights . . . are actually a large bundle of rights that the owner may break up into component parts and give away, sell, license or lease, individually, or as a composite whole." [32] The term for which a U.S. patent holder has these rights is currently seventeen years following the issuance of the patent; [33] however, under the new GATT, patent coverage will last twenty years from the date the inventor submits his patent application to the PTO. [34]

IV. Priority of Invention and United States Patents

{12} *"Both of the copycat cabinets say 'U.S. Patent Applied For' on them?" you ask. "Yes," responds the head of A-Corp.'s Research and Development department. "Did we file too late to get patent protection?"*

{13} When two or more inventors claim they have independently created an invention, who should receive the patent? Most countries have a very straight-forward method of answering this question. Other than the United States and the Philippines, every country in the world that offers patent protection has a "first-to-file" patent system. [35] A "first-to-file" patent system awards a patent to the first person to file an application for an invention. [36] "First-to-file" systems encourage inventors to file quickly because those who delay in obtaining a patent risk losing patent protection to a subsequent inventor who wins the race to file at the patent office. Society benefits from this type of system because an invention that is quickly patented will have its patent protection expire sooner than inventions that are not promptly patented. This allows ideas protected by a patent to be placed in the public domain as soon as possible.

{14} Instead of a "first-to-file" system, the United States has chosen to adopt a "first-to-invent" patenting system. Unlike the "first-to-file" system, a "first-to-invent" system is based on the principle that "a patent belongs to the first person who invented the claimed subject matter and not to the first person who filed a patent application for it." [37] This type of system is thought to place a premium on inventing without wasting resources on frequent races to the patent office. [38] Thus, in a pure "first-to-invent" patenting system the first, original inventor has priority in any contest between competing inventors, even if he files after other, later inventors. However, not all inventive acts have been equal in the eyes of United States patent law. This modified "first-to-invent" system has traditionally favored inventions made in the United States over those made abroad, even those made overseas by U.S. citizens.

A. Patent Priority in Domestic Inventions

{15} *You explain to A-Corp.'s head of R & D that all may not be lost even if the other companies have already filed for patent protection because the U.S. has a "first-to-invent" filing system. "Tell me about the process behind the development of A-Corp.'s Security Cabinet," you ask.*

"Well," he responds, "Walters in Electronics came up with the specifications for the hardware late in '93. After that, it was up to the Prototype Team to come up with a working model. Sales was putting a lot of pressure on us to get the Cabinet up and running, so we put two crews on it and had a working production model by March of '94. Everyone loved it, so Sales began planning the Las Vegas premier. Since then we haven't been able to make enough Cabinets to meet demand!"

"How about those copycat cabinets?" you ask. "You said one is made here in the U.S. Who makes it?"

"That's made by Business Corporation. Have you heard of them? They're out of St. Louis."

"I think so," you respond. "Any chance they're doing any of their inventing overseas?"

"No way," he says, "B-Corp. is strictly a mom-and-pop company."

{16} Contests between inventors who claim patent rights in domestically-made inventions are settled by extension of the principles discussed in the above overview of patent law. It is important to remember that in addition to other requirements, United States patents are granted to actual inventors.^[39] Thieves cannot rightfully patent stolen inventions. Additionally, a patent will not issue if the invention has previously been invented.^[40] These concepts are codified in Section 102 of Title 35 of the United States Code and are used to resolve priority contests.

{17} Section 102(g) of Title 35 provides the basic rule that a patent applicant will be prohibited from receiving a patent if someone else first invented the same invention in the United States. This rule is modified, however, if the previous inventor abandoned, suppressed, or concealed his invention. In such circumstances, a later inventor will be allowed to obtain patent protection for his invention.^[41] Abandonment, suppression and concealment is penalized to protect the public from inventors who keep their inventions secret, profit from their inventions and later acquire patent protection. Such abuse would allow inventors to obtain additional years of patent protection, effectively extending the term of their control over the patented idea beyond what was intended by Congress.

{18} In order to apply the fundamental rule of section 102(g), which rewards the first inventor with a patent, the date of invention must be determined. Under the Code, the date of invention is usually considered to be the date when an inventor actually produces a working model of his invention. This act is called "reduction to practice."^[42] The general rule regarding priority of invention can be restated as follows: the first person to *reduce an invention to practice* will be awarded a patent so long as he does not abandon, suppress, or conceal it. This general rule regarding priority, however, is subject to an exception.

{19} Section 102(g) provides an exception to the general priority rule for a conscientious inventor by allowing mere conception of an invention to be considered the actual date of that invention. An inventor who would otherwise lose a priority contest under the general priority rule will be granted a patent if (1) he was the first to *conceive* of an invention and (2) he was *diligent* in reducing the invention to practice.^[43] Therefore, a diligent inventor will win a priority contest even if his reduction to practice occurred after other inventors built working models. However, proof of diligence is burdensome. The applicant must be able to demonstrate diligence from a point prior to his opponent's conception up until the applicant's reduction to practice.^[44] Diligence, once begun, is a continuing duty. "In patent law, an inventor is either diligent at a given time or he is not diligent; there are not degrees of diligence."^[45]

{20} Therefore, in working out priority disputes between domestic inventors who may or may not be U.S. citizens but who are competing for priority in a patent, the following general rules apply: (1) only the true

inventor can receive the patent; thieves cannot; (2) the first inventor to reduce his invention to practice is awarded the patent so long as he does not abandon, suppress or conceal his invention; and (3) an inventor who later reduces his invention to practice will be awarded the patent if he can demonstrate that he was the first to conceive of the invention and he had the requisite diligence.

B. Patent Priority of Inventions Made Abroad

{21} *"Hmm," you say, as you process what you've been told. "We'll have to look into it, but it sounds like conception of the Security Cabinet occurred when Walters did his work. When did you say that was?"*

"I think it was October of '93," responds the head of A-Corp.'s R & D department. "I'd have to take a look at his Inventor's Notebook."

You take notes and continue speaking, "So if the Prototype Team was diligent in getting a working model built, and it sounds like they were, A-Corp might have priority of invention back to the date of conception. You said the Cabinet was spec'd out in October of '93, right?"

"Right," he responds.

"It would be tough to beat B-Corp. in a domestic priority dispute if they had a working model before October of 1993, our date of conception," you continue. "But even then, we could win if they had abandoned, suppressed or concealed their invention."

"Yeah, I guess you're assuming that they didn't steal it from us," he says.

"They can't rightfully get a patent for something they didn't invent," you respond.

"But what about the other cabinet we found?" he says.

"The one built in Canada? Tell me about it," you say.

"Well, that one's built by Commonwealth Corporation," he responds.

"They're Australian, right?" you ask.

"Yeah, but C-Corp. has offices all over the world. They're huge," he responds.

"Where have they done their R & D?" you ask.

"Pretty much in Australia and Canada," he answers.

"Let's hope it's Australia," you say.

{22} Because the United States has a "first-to-invent" patenting system, priority disputes are resolved by determining the party that can establish the first date of invention through either reduction to practice or conception plus diligence. This general rule has traditionally been modified if a party performed these inventive acts abroad. For most of this century, foreign inventive acts have been inadmissible to prove a date of invention.^[46] Prior to the adoption of NAFTA and GATT, the Code explicitly stated that a patent applicant "may not establish a date of invention by reference to knowledge or use thereof, or other activity . . . in a

foreign country . . . "[47] This exclusionary rule applied equally to inventive acts by foreign nationals working abroad as well as those performed by United States citizens overseas. Until very recently there were only two limited exceptions to this exclusionary rule.

1. Exception for Those Working for the Government

{23} Prior to NAFTA and GATT, there were only two exceptions to the rule that barred foreign inventive acts from being able to prove date of invention. The first exception to the exclusionary rule was very limited. It allowed evidence of foreign acts of invention to be admissible "if the invention was made by a person . . . serving in any other country in connection with operations by or on behalf of the United States. . . ." [48] Thus, acts of invention performed in Austria by a Vienna-stationed Captain in the United States Air Force would be admissible to prove date of invention. Likewise, a civilian employee of a defense contractor who installed radar sites in Seoul during the day and invented in his basement after work would be allowed to use his foreign acts to prove his date of invention. Without this exception to the exclusionary rule, the United States would be hindered from attracting people with inventive minds to work abroad for its national interests.

2. The Paris Convention Exception

{24} The second exception to the exclusionary rule was originally based on the Paris Convention for the Protection of Industrial Property [49] and has since been expanded to include other treaties and reciprocal legislation. The codified section allowed a very specific foreign act to be admissible to prove an inventor's date of invention: the filing of a foreign patent application. [50] Specifically, the date the foreign patent *application* was filed will be considered the date of invention if: (1) a patent application is then filed in this country by a person who has (2) within the past twelve months (3) filed (4) a patent application that meets certain disclosure requirements (5) for the same invention (6) in a foreign country that affords "similar privileges" to applications filed in the United States. [51]

{25} By following this process, "[a] person applying for a patent in the United States may be entitled to a right of priority based on the filing of an application for the same invention in a foreign country" [52] However, this earlier application can be relied upon only if the same invention "was adequately disclosed in the foreign application." [53] Consequently, foreign applications that do not meet American standards of disclosure as per 35 U.S.C. § 112 are inadmissible to provide a date of invention for a subsequently filed United States patent application. Furthermore, foreign applications cannot be filed more than one year before the subsequent United States application is made. "[T]he time period of 12 months runs . . . from the filing of the first foreign application in a reciprocating country [However,] [e]arlier filings in non-convention and non-reciprocating countries may be ignored" [54]

{26} Countries that adhere to the Paris Convention are considered reciprocating countries that afford similar privileges with regard to reliance on foreign applications for priority purposes. Almost all of the major industrial countries are members of the Paris Convention, [55] and a list of the countries that the PTO recognizes as adherents to the Paris Convention can be found in [Appendix A](#), *infra*. In addition, some Latin American countries have reciprocal priority rights with the United States only through the Inter-American Convention relating to Inventions, Patents, Designs and Industrial Models, signed at Buenos Aires, August

20, 1910 ("Inter-American Convention").^[56] A list of the adherents to the Inter-American Convention can also be found in [Appendix A](#), *infra*.

3. The NAFTA Exception

{27} *A-Corp.'s head of R & D pauses before he responds. "I'm pretty sure that C-Corp. shut down their Australian R & D back in 1990 . . ."*

Interrupting, you say, "Well, if they did all of their R & D in Australia we don't have much to worry about if we can beat their U.S. filing date. The PTO won't allow most foreign acts to prove a date of invention, so C-Corp. will probably be stuck with their U.S. filing date as their invention date, unless they filed for patent protection abroad. Can you see anywhere on that C-Corp. cabinet that C-Corp. has applied for any foreign patents?"

"No," he responds, "it just says 'U.S. Patent Applied For'."

"Well," you say, "if C-Corp's R & D was limited to Australia, about the only way C-Corp. would be able to establish an earlier date of invention than their U.S. filing date would be to file a foreign patent application under the Paris Convention. The earliest priority date they could get would be their U.S. application date. For us to win, our conception and diligence will have to pre-date their U.S. application date."

"But what about Canada?" he shoots back.

"Canada?" you ask. "What about it?"

"I was trying to tell you that C-Corp. shut down their R & D in Australia back in '90, but that was so they could open up their new R & D center in Toronto. If they didn't steal the Security Cabinet from us, I'm sure they invented their own in Canada."

{28} With the two limited exceptions previously noted, United States patent law did not allow inventive acts carried out abroad to prove a date of invention.^[57] However, as of December 8, 1993, the evidentiary privilege that domestic inventors (including domestic inventors of foreign citizenship) have enjoyed under this exclusionary rule was eroded by passage of NAFTA. The Code now explicitly exempts any inventive act in a NAFTA country from its exclusionary rule.^[58] As a result, inventive acts performed in any NAFTA country are equally admissible in proving conception, diligence and actual reduction to practice as similar acts performed in the United States. Currently, the United States considers Canada and Mexico to be NAFTA countries as defined by Section 2(4) of NAFTA.^[59]

{29} In addition, some inventive acts outside of NAFTA countries are admissible to prove the date of invention. The new language of the Code mirrors the old exception that allows United States domiciliaries working abroad on behalf of the government to prove their dates of invention by their foreign inventive acts. Now, as a result of amendments to the Code, a NAFTA domiciliary working abroad on behalf of a NAFTA country can establish a date of invention for United States patent priority purposes with inventive acts in any foreign country.^[60] For example, prior to the NAFTA amendments, a Mexican diplomat who conceived of a new method of processing grain while stationed in Madrid and later reduced the invention to practice in Mexico City would not be able to establish his date of invention until he either filed a patent application in

the United States or made an appropriate foreign filing under the Paris Convention. However, since NAFTA became effective, such conception and reduction to practice are admissible to prove date of invention.

4. The GATT Exception

{30} "Well," you say, "if C-Corp. invented their cabinet in Canada, NAFTA would allow Canadian acts of invention back to December 8, 1993 to help them prove their date of invention. But didn't you say that we were working on our Security Cabinet back in October of '93?"

"Yeah," he responds,

"We'll have to look into it," you say, "but if C-Corp. didn't file any patent applications here or abroad before our date of conception, it looks like we have priority over C-Corp. by a couple of months."

"I want you to look in to it. I'll send Walter's Inventor's Notebook over to you Monday," he says.

After a pause A-Corp.'s head of R & D says, "So, inventors working in the U.S., Canada or Mexico can use inventive acts to prove date of invention?"

"For the most part," you respond. "This is all very new, and you never really know what the courts will do."

"Well, I guess you should know about some of our plans. The president here at A-Corp. has got a deal in the works to build a R & D shop in Cyprus to service our clients in southern Europe. If you are saying that our inventive acts over there wouldn't be admissible to prove dates of invention for U.S. patents maybe we should build in North America."

{31} The exclusionary rule that has barred most foreign acts from being admissible to prove date of invention was a protectionistic dike that surrounded domestic inventors (including domestic inventors of foreign citizenship). NAFTA penetrated that wall by allowing inventive acts in Mexico and Canada to be admissible as domestic acts in proving inventorship. The recent passage of GATT has broken down that barrier and substantially done away with the exclusionary rule. Paralleling the language in NAFTA, the GATT amendments to the Patent Act exclude any act performed in any World Trade Organization ("WTO") member country from the ambit of the exclusionary rule.^[61] As a result, inventive acts done by anyone in any WTO country are as admissible in proving conception, diligence and actual reduction to practice as similar acts performed in the United States. WTO countries are defined by Section 2(10) of the Uruguay Round Agreements Act as those states or separate customs territories that accede to the Agreement Establishing the World Trade Organization.^[62] Countries signing the Agreement are listed in [Appendix B](#), *infra*.

{32} Additionally, the language provided by the GATT amendments to the Patent Act mirrors the NAFTA language that allows NAFTA domiciliaries working abroad on behalf of their respective NAFTA countries to be able to use foreign inventive acts to establish dates of invention for United States patent priority purposes.^[63] Consequently, any person working abroad on behalf of a GATT signatory will be able to use these acts to prove inventorship in order to obtain a United States patent.

{33} Checking your list, you say, "Did you say Cyprus or Crete?"

A-Corp.'s R & D chief says, "We want to build the R & D facility in Cyprus."

Finding "Cyprus" on the U.S. Trade Representative's list, you say, "Good. They signed onto the Final Act of the GATT, so they should be a member of the World Trade Organization when it enters into force. That means that Cyprus R & D work done after the WTO comes into force would be admissible to prove date of invention for United States patents."

"Look," he says, "would you mind coming over here next week and putting on a workshop for our R & D Unit Managers about all this?"

V. Conclusion

{34} Unlike most countries, the United States has a first-to-invent patenting system. In pure form, first-to-invent systems confer patent rights on the first inventor. Although American citizenship *per se* is not required to obtain a United States patent, the United States has for many years placed protectionist barriers around those who invent within the United States. This modified first-to-invent system excluded most foreign inventive acts from establishing a date of invention, even if they were performed by a United States citizen. As a result, substantial evidentiary privileges were given to domestic inventors involved in priority disputes.

{35} With the implementation of GATT, however, this barrier has been overcome. Most inventorship disputes between those who file proper United States patent applications will now be resolved by examining competing inventors' acts of conception, diligence, and reduction to practice, so long as these acts take place in WTO member countries. Applicants who invent outside the borders of WTO member countries can still establish date of invention equal to the *filing* date of a foreign patent application under the Paris Convention. However, the traditional Paris Convention restrictions apply, including the requirement that the foreign country in which the patent application is filed must be one that offers the United States reciprocal priority rights.

{36} If the acts used to prove date of invention under GATT occur in a country that is not a WTO member, or if there is no Paris Convention application filed abroad, priority based on foreign inventive acts can only be established for United States patenting purposes under a very narrow exception: the foreign inventive acts must be performed by a domiciliary of a WTO country who is serving in that foreign country on behalf of his WTO country. Any other foreign act continues to be inadmissible to prove date of invention in proceedings regarding United States patents. Date of invention in such a case will not be earlier than the filing date of the actual United States patent application or the actual date inventive acts are performed on American soil.

{37} Since most countries will be members of the World Trade Organization, application of any of these exclusionary rules should be infrequent. Consequently, this lowering of protectionist barriers makes the American patenting system more of a pure first-to-invent system, since the location of inventive acts is no longer determinative in establishing a date of invention for a United States patent applicant. By admitting such foreign acts to prove date of invention, the United States has revolutionized the protection of intellectual property rights. As demonstrated by the above hypothetical situation, this decline in protectionism exposes domestic inventors to greater foreign competition at home by protecting the United States property rights of first inventors without regard to their citizenship or the location of almost all of their inventive acts. Similarly, domestic inventors will be able to take advantage of opportunities in almost every corner of the world without negative impact on their ability to acquire patent protection from the United States Patent and Trademark Office.

Footnotes

[]NOTE:** All endnote citations in this article follow the conventions appropriate to the edition of THE BLUEBOOK: A UNIFORM SYSTEM OF CITATION that was in effect at the time of publication. When citing to this article, please use the format required by the Seventeenth Edition of THE BLUEBOOK, provided below for your convenience.

John F. Carroll, IV, Note, *Priority of Invention in United States Patents: From the Paris Convention to GATT*, 1 RICH. J.L. & TECH. 3 (1995) at <http://www.richmond.edu/jolt/v1i1/carroll.html>.

[1] This paper is limited to a discussion and analysis of priority disputes regarding utility patents. Priority contests regarding plant patents and patents for ornamental designs are not within the scope of this inquiry.

[2] ERNEST B. LIPSCOMB III, LIPSCOMB'S WALKER ON PATENTS § 2.2, at 89 (3d ed. 1984) (quoting *Grant v. Raymond*, 31 U.S. (6 Peters) 218, 218 (1832) (internal quotations ommitted)).

[3] U.S. CONST. art. I, § 8, cl. 8.

[4] Ralph Oman, *Intellectual Property-Our Once and Future Strength*, 27 GEO. WASH. J. INT'L L. & ECON. 301, 301 (1993).

[5] See generally [35 U.S.C. §§ 1-376](#) (1988).

[6] [35 U.S.C. § 6\(a\)](#).

[7] See generally PATENT & TRADEMARK OFFICE, MANUAL OF PATENT EXAMINING PROCEDURE (5th ed. 1993) [hereinafter MPEP].

[8] MPEP, *supra* [note 7](#), at P-1.

[9] Pub. L. No. 103-182, 107 Stat. 2057 (1993) (codified as amended in scattered titles of U.S.C.).

[10] Pub. L. No. 103-465, 108 Stat. 4809 (1994) (codified as amended in scattered titles of U.S.C.).

[11] See [35 U.S.C. § 104](#) (1994).

[12] See [35 U.S.C. §§ 111-115](#) (1988).

[13] *Graham v. John Deere Co.*, 383 U.S. 1, 6 (1966).

[14] [35 U.S.C. § 101](#).

[15] [35 U.S.C. § 102](#).

[16] [35 U.S.C. § 103](#).

[17] *Lowell v. Lewis*, 15 F. Cas. 1018, 1019 (C.C.C.D. Mass. 1817) (No. 8568).

[18] *Brenner v. Manson*, 383 U.S. 519, 534-35 (1966).

[19] PAUL GOLDSTEIN, COPYRIGHT, PATENT, TRADEMARK AND RELATED STATE DOCTRINES 387 (3d ed. 1993) (citing Note, *Novelty and reduction to Practice: Patent Confusion*, 75 YALE L.J. 1194, 1195 (1966)).

[20] [35 U.S.C. § 103](#).

[21] For example, suppose that Inventor A properly obtains a patent for a green, three-legged widget. If Inventor B paints one of A's widgets yellow, B could properly claim that his yellow widget is novel because no yellow widget has ever existed before. However, if painting the widget would have been obvious to someone skilled in the art, B would not be granted a patent on his yellow widget because merely painting the device another color would only be an obvious extension of the work A had already done.

[22] [35 U.S.C. § 115](#).

[23] [35 U.S.C. § 102\(f\)](#).

[24] 3 DONALD S. CHISUM, A TREATISE ON THE LAW OF PATENTABILITY, VALIDITY AND INFRINGEMENT § 10.03[3][a][i], at 10-36 (1994).

[25] 3 *Id.* § 10.03[3][a][ii], at 10-36.

[26] *Schenk v. Nortron Corp.*, 713 F.2d 782, 784 (Fed. Cir. 1983). However, even if an inventor is the first to create a useful, new, non-obvious device, he will not necessarily be able to obtain United States patent protection because not all inventions are patentable. "The subject matter of the invention or discovery must come within the boundaries set forth by [35 U.S.C. \[§\] 101](#), which permits patents to be granted only for 'any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof.'" MPEP, *supra* [note 7](#), § 706.03(a), at 700-13 to -14. Therefore, patents will not be granted for such things as the mere arrangement of printed matter, the discovery of a naturally occurring thing in nature, a method of doing business or a scientific principal. *Id.* at 700-14. In addition, a patent will not be granted unless the patent application contains an "enabling disclosure." [35 U.S.C. § 112](#). Such a disclosure describes the invention in enough detail so that someone skilled in the art could make and use the invention. *Id.* "The [enabling disclosure] requirement reflects the bargain struck by the patent system generally: society grants exclusive property rights in an invention in return for disclosure of information sufficient for practicing the invention upon the patent's expiration." GOLDSTEIN, *supra* [note 19](#), at 432. Additionally, the application must contain a description of the best mode contemplated by the inventor for carrying out his invention. [35 U.S.C. § 112](#). "The enablement requirement is distinct from the 'best mode' requirement [because] the enablement requirement is objective; the best mode requirement is subjective." GOLDSTEIN, *supra* [note 19](#), at 432. The policy behind the "best mode" requirement is to "restrain inventors from applying for patents while at the same time concealing from the public preferred embodiments of their inventions which they have in fact conceived." *In re Gray*, 309 F.2d 769, 772 (C.C.P.A. 1962).

[27] *See generally* 37 C.F.R. § 1.84 (1994).

[28] *See generally* 37 C.F.R. § 1.445 (1994).

[29] *Id.*

[30] [35 U.S.C. § 154](#).

[31] [35 U.S.C. § 261](#).

[32] IRVING KAYTON, *Introduction to Patents and Patent Practice*, in 1 PATENT PRACTICE 1-1, 1-24 (Irving Kayton ed., 5th ed. 1993).

- [33] [35 U.S.C. § 154](#).
- [34] Uruguay Round Agreements Act, Pub. L. No. 103-465, 108 Stat. 4809 (amending [35 U.S.C. § 154](#) (1994)).
- [35] GOLDSTEIN, *supra* [note 19](#), at 408.
- [36] *Id.*
- [37] *Id.*
- [38] *Id.* at 409.
- [39] [35 U.S.C. § 102\(f\)](#).
- [40] [35 U.S.C. § 102\(g\)](#).
- [41] *Id.*
- [42] *Id.* Note also that filing a patent application is considered constructive reduction to practice. MPEP, *supra* [note 7](#), § 715.07, at 700-82 (citing 37 C.F.R. § 1.13 (1994)).
- [43] [35 U.S.C. § 102\(g\)](#).
- [44] *Id.*
- [45] MPEP, *supra* [note 7](#), § 715.07(a), at 700-82.
- [46] MPEP, *supra* [note 7](#), § 715.07(c), at 700-83.
- [47] [35 U.S.C. § 104](#) (listing [35 U.S.C. §§ 119](#), [365](#) as exceptions).
- [48] [35 U.S.C. § 104\(a\)](#) (Supp. V 1993).
- [49] MPEP, *supra* [note 7](#), § 201.13, at 200-19; MPEP, *supra* [note 7](#), at P-1.
- [50] [35 U.S.C. § 119](#) (Note that this includes filing under the Patent Cooperation Treaty of an international application which designates at least one country other than the United States as per [35 U.S.C. § 365](#) (incorporating by reference [35 U.S.C. § 119](#))).
- [51] [35 U.S.C. § 119](#) says in pertinent part:
- An application for patent for an invention filed in this country by any person who has, or whose legal representatives or assigns have, previously regularly filed an application for a patent for the same invention in a foreign country which affords similar privileges in the case of applications filed in the United States or to citizens of the United States, shall have the same effect as the same application would have if filed in this country on the date on which the application for patent for the same invention was first filed in such foreign country, if the application in this country is filed within twelve months from the earliest date on which such foreign application was filed
- [52] 4 CHISUM, *supra* [note 24](#), § 14.01, at 14-2.

[53] 4 *Id.* § 14.03, at 14-30.

[54] Irving Kayton & Daniel R. Cherry, *Foreign Priority*, in 2 PATENT PRACTICE 7-6 (Irving Kayton & Karyl S. Kayton eds., 5th ed. 1993) (emphasis in the original).

[55] Richard L. Schwaab, *Rights and Procedures Under the Patent Cooperation Treaty*, in 6 PATENT PRACTICE 26-3 (Irving Kayton & Karyl S. Kayton eds., 5th ed. 1993).

[56] MPEP, *supra* [note 7](#), § 201.13, at 200-19. In order to obtain foreign priority from an Inter-American Convention signatory, the Code applies the same rules applied under the Paris Convention. [35 U.S.C. § 119](#).

[57] MPEP, *supra* [note 7](#), § 715.07(c), at 700-83.

[58] [35 U.S.C. § 104\(a\)](#) (Supp. V 1993) in pertinent part, reads as follows:

IN GENERAL.--In proceedings in the Patent and Trademark Office, in the courts, and before any other competent authority, an applicant for a patent, or a patentee, may not establish a date of invention by reference to knowledge of use thereof, or other activity with respect thereto, in a foreign country other than a NAFTA country, except as provided in sections 119 [foreign priority] and 365 [Patent Cooperation Treaty] of this title.

[59] North American Free Trade Agreement Implementation Act 1993 § 2(4), [35 U.S.C. § 104\(b\)](#) (Supp. V 1993).

[60] [35 U.S.C. § 104\(a\)](#) (Supp. V 1993) states, in pertinent part:

Where an invention was made by a person, civil or military, while domiciled in the United States or a NAFTA country and serving in any other country in connection with operations by or on behalf of the United States or a NAFTA country, the person shall be entitled to the same rights of priority in the United States with respect to such invention as if such invention had been made in the United States or a NAFTA country.

[61] Uruguay Round Agreements Act, Pub. L. No. 103-465, 108 Stat. 4809 (amending [35 U.S.C. § 104](#) (1994)).

[62] Final Texts of the GATT Uruguay Round Agreements Including the Agreement Establishing the World Trade Organization, Agreement Establishing the World Trade Organization, Office of the U.S. Trade Representative, Executive Office of the President, April 15, 1994. (On file with the author)

[63] [35 U.S.C. § 104\(a\)\(2\)](#), as amended on December 8, 1994, states:

Rights.--If an invention was made by a person, civil or military--

(A) while domiciled in the United States, and serving in any other country in connection with operations by or on behalf of the United States,

(B) while domiciled in a NAFTA country and serving in another country in connection with operations by or on behalf of that NAFTA country, or

(C) while domiciled in a WTO member country and serving in another country in connection with operations by or on behalf of that WTO member country,

that person shall be entitled to the same rights of priority in the United States with respect to such invention as if such invention had been made in the United States, that NAFTA country, or that WTO member country, as the case may be.

Pub. L. No. 103-465, §§ 531, 534, 108 Stat. 4982, 4990 (1994).

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