The Corporate Patent - Reform or Retrogression

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THE CURRENT UNITED STATES PATENT STATUTE imposes upon inventors generally a personal obligation to participate in the patent acquisition process, whether or not the patent right has been assigned. In practice, conscientious discharge of this obligation provides insurance that the inventor's patent application includes the complete and accurate description of his invention, which is minimally prerequisite under United States law to the grant of an exclusive patent privilege. Hence, the obligation effectively guarantees that the public will receive the full value bargained for if a patent is granted on the application. Over the past decade,

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INTRODUCTION

1. A.B., Cornell University, 1950; J.D., George Washington University, 1960; Member, Virginia and District of Columbia Bars.

1. 35 U.S.C. §111 (1970). Section 111 of the current statute, the Patent Act of 1952 (1952 Act), requires that "[a]pplication for patent shall be made by the inventor, except as otherwise provided in this title, in writing to the Commissioner" and further requires that the application as filed must include "an oath by the applicant as prescribed by section 115 of this title" and "must be signed by the applicant . . . ." Id. Section 115 of the 1952 Act describes the requisites of the oath, an integral part of the application, which must indicate, inter alia, that the inventor believes himself to be the original and first inventor of the subject matter covered. Id. §115. Section 116 specifies that when two or more persons jointly make an invention, they shall jointly apply for the patent, each sign the application, and each make the required oath. Id. §116. Under current practice, the "oath" may be a declaration or affirmation on penalty of perjury. 37 C.F.R. §1.65 (1977).

The limited exceptions to the foregoing provisions are available where 1) a joint inventor refuses to sign the application, 35 U.S.C. §116 (1970); 2) an inventor is deceased or legally incapacitated, id. §117; or 3) an inventor of an assigned application cannot be located or refuses to sign the application, id. §118.

2. 35 U.S.C. §112 (Supp. V 1975). The language of this provision emphasizes the inventor’s personal responsibility to insure the correctness and completeness of the application. Thus, §112 specifically requires a description of the invention and of "the best mode contemplated by the inventor of carrying out his invention." Id. (emphasis added). In the same vein, the second paragraph requires "one or more claims particularly pointing out . . . the subject matter which the applicant [i.e., the inventor as required by §111] regards as his invention." Id.

Before the 1952 Act, the requirement for signature of the application by the inventor appeared in the same statutory section as these foregoing requirements. See, e.g., Act of July 8, 1870, ch. 230, §26, 16 Stat. 198 (1870).

3. It has been settled since at least as early as Pennock v. Dialogue, 27 U.S. (2 Pet.) 1 (1829), that:

While one great object [of our patent laws] was, by holding out a reasonable reward to inventors and giving them an exclusive right to their inventions for a limited period, to stimulate the efforts of genius; the main object was "to promote the progress of science and the useful arts".

Id. at 19, quoting U.S. Const. art. 1, §8, cl. 8 (emphasis added). The primary public purpose of the patent system has been repeatedly emphasized by the Supreme Court (1085)
Congress has entertained various proposals for patent reform legislation which have included provisions for assignee filing of patent applications, whereby inventors would be effectively diminished to virtual figureheads vis-à-vis assigned patent applications and the resulting patents. The term "corporate patent" as used in this article, encompasses the proposed provisions in their various versions.

The proponents of the "corporate patent" concept have to date justified these proposals primarily on the ground of convenience to corporate assignees, and on the popular, but ephemeral and doubtful, premise that inventorship is a "technicality," at least in the context of corporate research and development. So far, Congress and the public have apparently assumed that adoption of some form of a corporate patent would have little, if any, effect upon the substantive aspects of patent availability and validity, despite the


4. See notes 7-19 and accompanying text infra. These proposed provisions stem largely from Recommendation V of the Report of the President's Commission on the Patent System (Commission Report), issued in 1966. Subcomm. on Patents, Trademarks, and Copyrights of the Senate Comm. on the Judiciary, To Promote the Progress of Useful Arts, Report of the President's Commission on the Patent System, S. Doc. No. 5, 90th Cong., 1st Sess. (1967) [hereinafter cited as Commission Report]. While the proposed provisions have differed in some respects, all have provided for the filing of assigned patent applications by assignees to the exclusion of inventors, and all have dispensed with the requirement of inventor participation in the actual application for an assigned patent. See notes 13-19 and accompanying text infra.


Some groups have shown little enthusiasm for the "corporate patent" proposal, but even they have failed to appreciate the substantive, including constitutional, objections to its adoption. See note 22 infra.
clear inconsistency between the proposals and the literal wording of the patent clause of the United States Constitution.6

This article explores the constitutional implications of legislative implementation of the corporate patent concept, and examines the extent to which the various proposals might permit sharp departures from established patent law precepts.

II. THE CORPORATE PATENT CONCEPT

The corporate patent concept is based upon Recommendation V of the 1966 Report of the President’s Commission on the Patent System (Commission Report).7 The Commission’s patent reform proposal was “one interrelated and coherent plan,” composed of thirty-five specific recommendations to be implemented as a single legislative package.8 Far from manifesting an intention that the corporate patent concept could or should be implemented separately, the President’s Commission on the Patent System (Commission) specifically warned against a piecemeal approach to any of its recommendations.9

Congress has not heeded this warning. The Commission Report’s “coherent plan” for patent reform legislation was only briefly considered and shelved.10 Nevertheless, the specific corporate

6. U.S. CONST. art. I, §8, cl. 8. The constitutional patent clause authorizes Congress “To promote the Progress of Science and useful Arts by securing for limited Times to... Inventors the exclusive Right to their respective... Discoveries.” Id. In Graham v. John Deere Co., 383 U.S. 1 (1966), the Supreme Court held that the prerogative afforded to Congress by this language is qualified in that only “discoveries” which “promote progress of science and useful arts” may constitutionally be rewarded. Id. at 5–6. By analogy, it is questionable whether Congress may constitutionally authorize patents that do not have the effect of “securing to... Inventors” as distinguished from others, the exclusive patent right.
7. COMMISSION REPORT, supra note 4, at 22. Recommendation V of the Commission Report in its entirety states:
1. Either the inventor or assignee may file and sign both the preliminary and complete applications. Any application filed by the assignee shall include a declaration of ownership at the time of filing and, prior to publication of the application, shall include a declaration of originality by the inventor and evidence of a recorded specific assignment.
2. Every application shall include, at the time of filing, the name of each person believed to have made an inventive contribution.
3. Omission of an inventor’s name or inclusion of the name of a person not an inventor, without deceptive intent, shall not affect validity, and can be corrected at any time.
Id.
8. Id. at 12.
9. Id. The Commission Report cautioned that: “[A]n attempt to solve or reduce a problem at one point of the system can expose or create a dislocation at another. Separate and uncoordinated solutions to individual problems would yield a gerrymandered patent system full of internal contradictions and less efficient than the one we now have.” Id.
patent proposal lingers on. Though considerably watered down in the only patent reform bill passed by either house, the proposal will again be entertained by the 95th Congress in a form similar to that contemplated by Recommendation V of the Commission Report.\footnote{12}

The essence of the corporate patent concept was embodied first in sections 111, 115, 116, and 256 of the initial bills that were based on the Commission Report and introduced in both houses of Congress in February, 1967.\footnote{13} In sum, these proposed provisions contemplated three changes in the law, \textit{viz.}, they: 1) permitted an assignee to file a patent application without either the signature or oath of the inventor and afforded time up to the publication of the application to identify each of the inventors and supply an oath of each; 2) permitted an application naming two or more persons as joint inventors to include claims to subject matter invented by less than all of the group; and 3) restricted the patent invalidity consequence of incorrectly designating inventors to cases in which the error was made with deceptive intent.\footnote{14}

With only minor changes,\footnote{15} at least two of the essential features of these proposed sections have appeared in almost every patent

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\textit{Reform: A Legislative Perspective of an Extended Gestation}, 16 WM. & MARY L. REV. 937 (1975). As the authors point out, some of the Commission's recommendations were opposed by significant segments of the bar and industry as representing unduly radical alterations of existing law. \textit{Id.} at 938-40.

\footnote{11} This bill was passed by the Senate on February 26, 1976. S. 2255, 94th Cong., 2d Sess., 122 CONG. REC. 2383 (daily ed. Feb. 26, 1976). This bill's "corporate patent" provisions include §§ 111, 115, 116, and 256. \textit{Id.} §§ 111, 115, 116, 256, 122 CONG. REC. 2383 (daily ed. Feb. 26, 1976). This bill has not been acted upon by the House of Representatives.


\footnote{13} S. 1042, 90th Cong., 1st Sess. (1967); H.R. 5924, 90th Cong., 1st Sess. (1967). These identical bills were transmitted by President Lyndon B. Johnson to the Honorable Hubert H. Humphrey, President \textit{pro tem} of the United States Senate, and the Honorable John McCormack, Speaker of the House of Representatives, via identical letters dated February 21, 1967, with the request that they be introduced as administration-sponsored legislation. \textit{See Patent Reform Act of 1967, 47 J. PAT. OFF. SOC'Y} 149 (1967) [hereinafter cited as \textit{Act of 1967}]. The bills included as attachments to the letters explanatory commentary relating each of the proposed sections to the Commission Report. \textit{See id.} For the entire, identical text of both bills, the associated commentary, and the text of the accompanying presidential transmittal letter, \textit{see id.}

\footnote{14} \textit{See Act of 1967, supra note 13, at 171-75, 201.}

\footnote{15} These changes were in part aimed at permitting piecemeal implementation of the corporate patent proposal outside of the framework of the Commission's overall
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reform bill that the Senate has since considered. In 1976 the Senate passed a bill that incorporated the first and third of the statutory changes identified above, but in a modified form, more in keeping with the intent of present law. This bill omitted the second of the changes identified above. The House of Representatives permitted the bill to expire upon the adjournment of the 94th Congress, without hearings or further action. Thus the way is clear for the House of Representatives, which has not yet engaged in deliberations on patent reform, to plunge into the topic afresh.

reform plan. Id. at 171-75. Some other examples of these minor changes are that: 1) Recommendation VII of the Commission Report contemplated publication of each patent application within 18 to 24 months of filing. COMMISSION REPORT, supra note 4, at 24-25. Some versions of the legislation considered by the Senate have excluded this early publication provision and have tailored the corporate patent proposal to permit the assignee who files a patent application in its own name to identify the inventors and supply the oath of each at any time prior to the issuance of the patent, or within six months of filing, or at some other specific point after filing and prior to issuance. See note 16 infra. 2) Similarly, Recommendation V included a proposal to limit patent invalidity for incorrect inventorship to those instances involving a deliberate intent to mislead. COMMISSION REPORT, supra note 4, at 22. However, this was modified in some proposed bills to place on the patent applicant who erroneously identified the inventor the burden of correcting the mistake either before or after issuance, with correction being permitted freely unless a deliberate intention to mislead appears. See note 16 infra.


17. S. 2255, 94th Cong., 2d Sess., 122 CONG. REC. 2383 (daily ed. Feb. 26, 1976). The 1976 Senate-passed bill requires an assignee applicant to identify all inventors at the time he files the patent application and to obtain their ratification of the application's content plus the requisite inventors' oaths pursuant to §115 within two months of the filing date. Id. §§111, 115, 122 CONG. REC. 2383 (daily ed. Feb. 26, 1976). Senate bill 2255 authorizes the correction of erroneous designations of inventors in applications and patents provided the facts show there was no "willful default or intent to defraud, mislead or deceive the public on the part of any of the individuals . . . named as inventors" or their assignees. Id. §111(g), 122 CONG. REC. 2383 (daily ed. Feb. 26, 1976).

18. The Ford Administration recognized three undesirable consequences of adopting the second feature, viz., it would "(1) lower the standard of invention; (2) confuse the prosecution of the application and litigation of the patent; and (3) create a bias against individual inventors." Letter from Walter D. Scott, Ass't Director for Economics and Government, Office of Management and Budget, to A. R. Whale, President, Am. Patent Law Ass'n (Apr. 8, 1975), reprinted in PATENT, TRADEMARK AND COPYRIGHT J. (BNA), Mar. 4, 1976, at 40 (Special Supp.).

19. The continuing viability of the corporate patent concept, including the feature which the Senate rejected, is reflected by a September 14, 1976 letter of then Secretary of Commerce, Elliot W. Richardson, to Peter W. Rodino, Jr., Chairman of the Committee on the Judiciary of the House of Representatives (Committee). Formal
III. The Questionable Premises for the Corporate Patent

The Commission Report is markedly inadequate in its revelation of the premises for any of its recommendations, including Recommendation V. While the Commission "held thirteen meetings . . . lasting from one to four days, for a total of thirty-one days,"20 these meetings were not open to the public. A promised supplement to the Commission Report, to contain "[b]ackground material prepared by the staff and the Commission, reflecting more extensively the considerations taken into account in the development of these recommendations,"21 was never supplied. There is, accordingly, no available basis on which to evaluate the reliability or completeness of the information that prompted any of the recommendations, including Recommendation V.22

The premises for Recommendation V, as expressed in the Commission Report, at least partially reveal the limited nature of the notification was made to the Committee of the Commerce Department's specific espousal of this rejected feature:

The complexities of modern science and technology, coupled with the specialization of today's engineers and scientists, have resulted in the extensive use of organized research teams funded by government, industry and the universities.

Cooperative effort of this sort should be encouraged and not penalized by unnecessary technical requirements with respect to patents for inventions made jointly by two or more inventors. We urge amendment of section 116 to permit filing by several inventors where they have jointly contributed to at least one claim in the application.

Letter from Elliot W. Richardson to Peter W. Rodino, Jr. (Sept. 14, 1976), reprinted in PATENT, TRADEMARK AND COPYRIGHT J. (BNA), Sept. 23, 1976, at A-8 to -9 [hereinafter cited as Richardson letter].


22. Subsequent to the Commission Report, investigators of the Patent, Trademark, and Copyright Research Institute (Institute) found a lack of enthusiasm for the corporate patent proposal among many interested groups. One investigator noted that the few firms that have experienced difficulty in locating inventors express disinterest [in the corporate patent proposal] and a large number of respondents [to the ongoing investigation] don't see it as an important problem. A few inventors were suspicious, feeling it might lead to loss of their inventions. However, most seemed to accept the idea without much concern.

Green, Early Information on the Institutes Study of the President's Commission Report, 11 IDEA 459, 468 (1968). Subsequently, John C. Green and Gideon Schmuckler remarked that of 33 universities and 11 research foundations surveyed, "only three of the universities and none of the foundations, admitted to having had any difficulty in obtaining an inventor's signature despite the relatively frequent absence of academic personnel at conferences, on sabbatical leave, et cetera." Green & Schmuckler, The Presidential Commission's Recommendations: Public Interest Agencies' View, 12 IDEA 764, 773 (1968). Robert B. Bangs, another of the Institute's investigators, found that

the opinion of inventors was about equally divided as to whether this recommendation [Commission Recommendation V] was desirable or not. . . .

The opposition expressed was largely directed to the point that the assignee
study undertaken. The subsequent attention of commentators to the ramifications of the corporate patent has been at least equally superficial. The suggestion for assignee filing of patent applications seems to have been motivated in large part by the Commission Report’s recommendation that patents be awarded to the “first to file” rather than the “first to invent,” as the present statute requires. A vague impression that inventor filing somehow promotes delay also appears to have been formed. Thus, the Commission explained:

Occasionally, inventors are unavailable or unwilling to sign an application immediately after it is prepared. Moreover, it is sometimes difficult to determine the identity of an inventor at the time the application is prepared. Delay in complying with the requirements has resulted in loss of rights to the application.

might file without the inventor. . . . [T]here was a strong feeling that inventors might lose some status, or claim to special treatment, if this route were followed. Bangs, Competent Inventors and the President’s Commission, 12 IDEA 998, 1008-09 (1969). This author further commented that some inventors thought the proposal would be helpful primarily to the Patent Bar rather than to them. Others thought it was primarily the large corporations rather than the inventors who would benefit.

Running through the responses was a feeling of uncertainty as to how the simplification was to be achieved; also evident was a residual suspicion that any simplification might be, at least in part, at the inventor’s expense.

Id. at 1009.

Another investigator reported at a June 20, 1968 conference that among the company executives which he canvassed, it was agreed that “most of the companies have had no difficulty in persuading inventors to sign patent applications, and a similar high proportion had experienced no difficulty in locating inventors. Furthermore, few (17 out of 50) reported difficulty in determining the actual inventor.” Siegel, Toward the Modernization of Industrial Property in the United States, Part I - Patent Outlook, 12 IDEA 20, 22-23 (1968).

In sum, one may reasonably infer from these reports that the Commission formulated its Conclusion V without adequate evidence.

23. For the reasons cited by the Commission, see COMMISSION REPORT, supra note 4, at 22-23.

24. See, e.g., note 5 and accompanying text supra. Despite the less than wholehearted enthusiasm for the corporate patent shown by the users of the patent system, including inventors, many corporate executives, universities, and research foundations, there has been virtually no in-depth consideration of its impact upon substantive patent law. See note 22 supra.

25. COMMISSION REPORT, supra note 4, at 13. Under Recommendation I of the Commission Report “the patent would issue to the one who is FIRST TO FILE his application . . . .” Id. (capitalization in original).

26. 35 U.S.C. § 102 (1970 & Supp. V 1975). Section 102 provides in pertinent part: A person shall be entitled to a patent unless — (g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

Id. § 102(g). See also id. § 135.
owner. Such delay would be more serious when the effective filing date is treated as the date of invention.

The intent of this recommendation [for assignee filing] is to simplify the formalities for filing an application by allowing the owner of the patent rights to sign and file the necessary papers. Many detrimental delays thus would be avoided.27

The Commission only paid lip service to a need for "retaining safeguards to protect the rights of the inventor"28 and opined that the requirement that "[b]efore publication of the application . . . the assignee must provide both a declaration of originality and a specific assignment from the inventor"29 would effectively be such a safeguard not only for the interests of the inventor, but also for "the interests . . . of the public."30

While it is exceedingly difficult to speak authoritatively absent concrete information as to the basis for the Commission's avowed concern with alleged problems of loss of rights due to filing delays under present law, that concern seems misplaced. The published case law and commentary contain no significant evidence that the present requirement for initial identification of inventors, and for their participation in the patent application process, has caused any general loss of patent rights. No doubt specific instances can be found in which inventor cooperation was sought too close to a statutory deadline to prevent the loss of rights.31 And there are surely instances of loss of patent rights occasioned by mail delays, unduly postponed attorney action in initial patent application preparation, human error, and other specific circumstances that

27. Commission Report, supra note 4, at 22. For the full text of this recommendation, see note 7 supra.
29. Id. at 23.
30. Id.
31. Pursuant to the 1952 Act, such deadlines may arise under at least §§ 102(b), (d), and 119. See 35 U.S.C. §§ 102(b), (d), 119 (1970). Section 102(b) specifies that a patent may not issue on an application filed more than one year after publication anywhere in the world, or public use or placing on sale in the United States, of the alleged invention. Id. § 102(b). Under § 102(d), if the inventor or his assigns have first received a foreign patent for the same invention on an application filed more than one year before the United States application, the United States patent is barred. Id. § 102(d). Under § 119, the United States counterpart of a duly and legally filed foreign application is treated, in general, as if filed in the United States on the date of the foreign application, provided the United States application is filed within one year of the original foreign filing. Id. § 119.

Viewed in the light of these generous one-year grace periods, the Commission's attribution of loss of rights to "delay" occasioned by the requirement of inventor filing seems illogical. Certainly there would be few, if any, instances in which a grace period of one year does not afford sufficient time to permit a diligent attorney, who plans in advance, to coordinate with the inventor the filing of the application before the statutory deadline expires.
delayed the inventor's execution of the application and its transmission to the United States Patent Office until after a statutory deadline. However, there is no suggestion in the case law or commentary of any general "delay" phenomenon per se which could justify such a drastic change as eliminating inventor participation in the application.\(^{32}\)

Nor is there any evidence to support a suggestion that legitimatizing assignee filing could prevent delay. It appears far more likely that those who are unable to file their patent applications within the relevant statutory grace periods established in the present inventor filing system would be inclined to cut corners even more closely on deadlines and have precisely the same difficulties if assignee filing were permissible.

It seems probable that the word "delay," as utilized in the Commission Report, was a euphemism for "inconvenience."\(^{33}\) It has long been argued by patent practitioners, particularly those employed in corporate patent departments, that the obligation to identify inventors is burdensome and difficult.\(^{34}\) Patent practitioners predominantly engaged in filing United States patent applications

\(^{32}\) But see In re Sarett, 327 F.2d 1005, 1010 n.7 (C.C.P.A. 1964). There, in an unexplained and unelaborated comment, Judge Giles S. Rich, speaking for the court, asserted that the inventorship provisions of United States patent law create "complexities and delays which could be avoided under a less rigid statute." Id., citing 35 U.S.C. §§ 111, 116, 256 (1970).

\(^{33}\) One businessman suggested that Recommendation V "recognizes the true economic interests in patents and the way in which such values are actually made useful. With reasonable safeguards this provision can be operated to protect inventors and their rights." Holst, supra note 5, at 41. This reference to "true economic interests" is a covert acknowledgement that corporate convenience may be the touchstone for Recommendation V.

\(^{34}\) For discussion of the alleged problems of identifying inventors, see, e.g., Godula, Inventorship in Chemical Patents, 46 ADV. CHEM. SERIES 15 (1964); Tresansky, Inventorship Determination, 56 J. PAT. OFF. SOC’Y 551 (1974).

It has been suggested that "the modern corporation with its vast research facilities has undergone substantive changes in inventorship entities . . . [Because of the 'research team' approach employed by corporations, an increasing number of new inventions are developed not through the work of individuals, but rather through team efforts." Note, The Doctrine of Inventorship: Its Ramifications in Patent Law, 17 W. RES. L. REV. 1342, 1342 (1966) (footnote omitted). See also Roth & Luecke, The Misjoinder and Nonjoinder Pitfall, 49 J. PAT. OFF. SOC’Y 219 (1967).

The relation of research teams and their work to the patent system was considered in Potts v. Roe, 140 F.2d 470 (D.C. Cir. 1944), but the focus there was upon problems of invention, not inventorship. Id. at 478.

At least one economist suggested that any system of rewards that focuses on inventors is anachronistic in this era of corporate research teams and heavy government funding of research. See Hamberg, Our Antiquated Patent System, 10 CHALLENGE, Jan. 1962, at 24. Contra, Dirlan & Thorkelson, Implications of the Individualist Theory of Invention, 6 ANTITRUST BULL. 173 (1961) (in rebuttal to an earlier oral presentation of Hamberg's position). For other discussions of the social or economic implications of the research team in a variety of contexts, see Blizard, The Future of Discovery and Invention, 56 TECH. REV. 395 (1954); Gordon, Operational Approach to Creativity, 34 HARV. BUS. REV. Nov.-Dec. 1956, at 41; Green, Research Administrators Appraise Proposals to Revise the Patent System, 12 IDEA 778 (1968); Middendorf & Brown, Orderly Creative Inventing, 76 ELECT. ENG.”866 (1957); Van
for foreign applicants have also complained over many years that the
obligation to file an application signed and attested to by the
inventors is inconvenient and difficult to explain to foreign
colleagues, steepped as they are in their own countries' assignee filing
practices. These latter individuals have long urged that they would
be greatly conveinenced by authorization to supply the inventors'
ratifications and oaths subsequent to filing the patent application
rather than concurrently therewith.

Objective 5 and Recommendation XXXV of the Commission Report
afford support for this provision that the reference to

Deusen, The Inventor in Eclipse, FORTUNE, Dec. 1954, at 132-35; The Engineer and
His Profession, 40 PROD. ENG'T 52 (1969).

The Richardson letter also alludes to an alleged corporate problem of inventor
identification and suggests a sympathetic legislative approach. Richardson letter,
supra note 19.

35. A United States application filed under § 119 — in patent lawyers' parlance, a
"convention" application — is always derived from, and substantially based upon, a
the foreign application is usually supplied to the United States patent lawyer for use
in preparing an application in the English language and in the proper United States
form. Afterwards it is incumbent upon that lawyer to forward the completed United
States application for signature and execution of the oath by the foreign inventor, in
accordance with §§ 111, 115, and 116. Id. §§ 111, 115, 116. See note 32 supra. By
contrast, when an application originally filed in the United States is transmitted to
a foreign country which permits assignee filing, the patent practitioner in that country
simply prepares an application in the appropriate language and form, and then files
it. See, e.g., Neumeyer, Employees' Rights in Their Invention, 83 INT'L LABOUR REV.
36, 47 (1968).

36. Most major foreign countries permit assignee filing and few attach any
importance to the identification of inventors. See, e.g., Neumeyer, supra note 35, at 50.
One significant exception, West Germany, permits assignee filing, but requires the
inventors to be identified and given a share in the proceeds of any patent issued. Id. at
54. Some doubt exists, however, as to whether the term "inventor" has the same
meaning under German law as under current American law, but the point is not
within the scope of this article. See id. at 55.

In general, modern foreign patent systems, like their predecessors, place far
less emphasis upon public rights and public interest and far greater emphasis upon
commercial and marketplace considerations, than does United States patent law. See,
e.g., Robbins, Some Comments on Proposed General Revisions of the Patent Laws, 10
IDEA 579 (1967). Robbins acknowledges that one result of adopting Senate bill 1042, S.
1042, 90th Cong., 1st Sess. (1967), including its corporate patent provisions, would
have been "to convert the United States patent system as it now exists partially . . .
into a mixed British-European type of patent system." Robbins, supra, at 579.

37. COMMISSION REPORT, supra note 4, at 12. The Commission Report lists as
Objective 5: "To make U.S. patent practice more compatible with that of other major
countries, wherever consistent with the objectives of the U.S. patent system." Id.

38. Id. at 63. Recommendation XXXV states in its entirety:
The Commission believes that the ultimate goal in the protection of inventors
should be the establishment of a universal patent, respected throughout the
world, issued in the light of, and inventive over, all of the prior art of the world,
and obtained quickly and inexpensively on a single application, but only in
return for a genuine contribution to the progress of the useful arts. To this end
the Commission specifically recommends the pursuit of: (1) international
harmonization of patent practice, (2) the formation of regional patent system
groups, and (3) a universal network of mechanized information storage and
retrieval systems.

Id.
“delay” in connection with Recommendation V was somewhat inapt and that “inconvenience” would have been a more accurate term. Pointedly, Commission Report Objective 5 and Recommendation XXXV are both directed toward bringing United States patent practice into congruence with the patent practice of major foreign countries insofar as possible.\textsuperscript{39} In addition, the Commission Report’s other expressly stated reasons for the corporate patent proposal take cognizance of the supposed difficulty of determining inventorship in corporate organizations, as follows:

At present, it is often difficult to determine who should be named as the inventor in any given application. A contributing factor is court rulings that for a valid patent to be granted to joint inventors, each person named must have been a joint inventor with respect to each claim in the patent.

Many complex inventions result from the combined efforts of persons working separately, often at different times and in different sections of an organization. In such cases, adequate protection cannot be presented properly in a single application, and the individual contributions cannot properly be made the subject matter of separate patents.

This recommendation would simplify the initial determination of who should be named as inventors in a given application and render it unnecessary for each person named to be the joint inventor of the invention asserted in each claim in a patent.\textsuperscript{40}

Still further, the Commission clearly treated inventorship as a technicality, rather than a substantive requirement at the heart of the eligibility of the applicant to obtain a patent, either for himself

\textsuperscript{39} Id. at 12, 64. The Commission Report specifically expresses the conviction “that harmonization of U.S. practice with prevailing foreign practice . . . should be introduced as a first step toward . . . a universal patent system, and urges that in this harmonization, “consideration applies both to the substantive law and to the forms and procedures for implementing it.” Id. at 64. The Commission Report does suggest that efforts be made “to secure harmonization with U.S. practice” when it “appears to be the superior one” id., but clearly prejudices the issue concerning inventorship law in favor of foreign practice, without taking cognizance of the possibility of a constitutional obstacle. See id. The failure to make clear why or how the conclusion of superiority of foreign inventorship law was reached not only weakens its impact but suggests that the Commission could not find a justification, factual or legal.

\textsuperscript{40} Id. at 23. The suggestion that each person denominated an inventor on the application need not have participated in the subject matter of each claim of the patent encompasses radical departures from existing law. See notes 1 & 2 supra. So far, this fact has received scant attention, notwithstanding that it would tend to debase “the quality and reliability of the U.S. patent” in direct derogation of the Commission’s noncontroversial Objective 1, which is “to raise . . . [that] quality and reliability . . . .” COMMISSION REPORT, supra note 4, at 11.
or an assignee. In this regard, the commentary accompanying Recommendation V asserted:

Today, a patent in which a sole inventor is incorrectly named will be held invalid. In the case of joint inventors, the omission or improper inclusion of a name will not necessarily invalidate a patent; however, correction procedures may be burdensome and the issue of whether correction is required can become an item of costly litigation.41

The conclusion that inventorship correction procedures under the current law “may be burdensome,” is not supported by apposite case law or legal literature. Moreover, the “issue of whether correction is required” is of dubious existence,42 and litigation, “costly” or otherwise, has only occasionally arisen on the issue of whether correction could properly be permitted.43 The bases for the Commission’s apparently contrary beliefs remain unrevealed. Perhaps most importantly, the constitutionality of the statutory section permitting correction has yet to be considered and is open to reasonable doubt.

IV. CONSTITUTIONAL CONSIDERATIONS

The Constitution is explicit in empowering Congress to establish, a patent system solely “To promote Progress of Science and useful Arts,” and in specifying the exclusive means for doing so: “[S]ecuring for limited Times to . . . Inventors the exclusive Right to their respective . . . Discoveries . . . .”44

For over 160 years, Congress has clearly manifested its understanding of this limited constitutional authority by stipulating in every patent statute effective between 1790 and 1952 that the inventor apply for the patent, if alive and legally capable of doing so, even though grant of the patent to an assignee has always been permitted.45 On reflection, it becomes apparent that if the inventor

41. Commission Report, supra note 4, at 23.
42. In a real sense, there can be no “issue of whether correction is required.” Under §§ 116 and 256 of the 1952 Act, correction may be granted only sparingly, on the basis of a good faith showing of facts demonstrating that inventorship misjoinder or nonjoinder in the application as filed was effected “through error” and “without any deceptive intention.” 35 U.S.C. §§ 116, 256 (1970). The issue, therefore, is whether correction is permitted in order to afford the assignee a right against the public which, but for the correction, would be null and void.
43. For a list of the relatively few cases which determine whether correction might be permitted in particular situations based on specific facts presented, see note 129 infra.
44. U.S. Const. art. I, §8, cl. 8.
45. Section 1 of the Patent Act of 1790 required that application for a patent be made by “petition . . . to the Secretary of State, the Secretary for the department of war, and the Attorney General of the United States, setting forth that he, she, or they
files the application and himself insures and attests to the accuracy of its description of his invention, the "exclusive Right" in that invention is "secured" to him. In such event, it becomes unimportant whether or not he designates someone else, such as an assignee, to receive and enjoy the resulting patent. The relevant legislation since 1790 demonstrates that this has been the understanding of Congress.  

While the Patent Act of 1952 (1952 Act) deviates slightly from the strict requirements of the preexisting law for inventor filing, its deviations are of restricted scope and localized consequence, and the great preponderance of fact situations continue to be governed by

hath or have invented or discovered" the subject matter sought to be patented. Patent Act, ch. 7, §1, 1 Stat. 109 (1790). However, it authorized the grant of the patent "to such petitioner or petitioners his, her or their heirs, administrators or assigns . . . ." Id. (emphasis added).

The same mode of application was required by §1 of the Patent Act of 1793, which likewise authorized patent grants to assignees. Patent Act, ch. 11, §1, 1 Stat. 318 (1793). Section 3 of that statute further provided that "every inventor, before he can receive a patent, shall swear or affirm, that he does verily believe that, he is the true inventor or discoverer" of the subject matter in issue. Id. §3, 1 Stat. 318 (1793). This section was the statutory ancestor of the present requirement of the 1952 Act of an oath by the inventor. See 35 U.S.C. §115 (1970).

The Patent Act of 1836 permitted "any person or persons having discovered or invented" certain subject matter to "make application in writing to the Commissioner of Patents . . . ." Patent Act, ch. 357, §6, 5 Stat. 117 (1836). Section 7 also required a written description of the invention that pointed out, inter alia, "the part, improvement, or combination, which he [the inventor] claims as his own invention or discovery," and further required him "to make oath or affirmation that he does verily believe that he is the original and first inventor or discoverer . . . ." Id. §7, 5 Stat. 117 (1836). Section 5 of the statute authorized patents to be issued to an assignee of the inventor. Id. §5, 5 Stat. 117 (1836). Notably, §7 required the inventor to make a new oath or affirmation each time he elected to continue to prosecute the application in face of a rejection from the Patent Office based on prior art or prior invention grounds, and thus insured inventor participation in every stage of patent acquisition. Id. §7, 5 Stat. 117 (1836).

The Patent Act of 1870, in §26, compelled the "inventor or discoverer" to make the application. Patent Act, ch. 230, §26, 16 Stat. 198 (1870). Section 30 required an oath of the inventor's belief in the originality and priority of his inventorship. Id. §30, 16 Stat. 198 (1870). Section 33, not unlike previous patent acts, permitted assignees to receive the patent grant. Id. §33, 16 Stat. 198 (1870).

Section 26 was amended in 1915 and 1930 without affecting its essential requirement that the inventor file and sign the application. See Patent Act, ch. 94, §1, 38 Stat. 958 (1915); Patent Act, ch. 312, §2, 46 Stat. 376 (1930).

Although patent laws prior to 1908 did not explicitly authorize the legal representative of a deceased, insane, or otherwise legally incapacitated inventor to apply for a patent on behalf of the inventor, the courts had always considered the right to so act to be inherent in the statutory provisions. See, e.g., Eagleton Mfg. Co. v. West, Bradley & Cary Mfg. Co., 111 U.S. 490 (1884). The Patent Act of 1908 expressly conferred the right to apply for a patent and to make the required oath on the executor or administrator of a deceased inventor, or the legally appointed guardian of a legally incapacitated inventor. Patent Act, ch. 188, §4896, 35 Stat. 245 (1908). This provision is presently codified in §117 of the 1952 Act. 35 U.S.C. §117 (1970).

46. See note 45 supra. See also note 50 infra.
the inventor filing requirement. The broad-based corporate patent concept for the first time assumes that Congress has the power to redefine the word “Inventors” in the patent clause, in derogation of the consistent legislative interpretation of that clause from 1790 to the present, so as to make the term embrace all assignees under any circumstance whatever.

Proponents of this sharp departure from existing law apparently overlook the separate status accorded inventors and assignees in patent statutes from 1790 to the present, as well as in the courts. They also overlook the primary public interest in obtaining a full, complete, and accurate description of the alleged invention directly from the inventor — the person or persons who are responsible for the existence of the subject matter sought to be covered by the patent. To permit assignee filing, with subsequent inventor ratification and verification, is perforce to permit the assignee to impose its notion of what the invention should be upon the description given in the application, and thus, to derogate the importance of a full, complete, and accurate description of the invention as made and perceived by the inventor. Assignee filing would invite a variety of trespasses against the requirement for such a description of the invention.

49. Id. §§ 111, 115, 116.
50. For example, in Wilson v. Rousseau, 45 U.S. (4 How.) 646 (1846), the Supreme Court remarked that, in adopting certain patent legislation,
   Congress had not at all in view protection to assignees [of patents]. . . . [T]heir condition on account of dealing in the subject of the invention, whether successful or otherwise, was not in the mind of that body, nor can any good reason be given why it should have been.

   They had purchased portions of the interest in the invention, and dealt with the patent rights as a matter of business and speculation; and stood in no different relation to the government or the public, than other citizens engaged in the common affairs of life.
   Id. at 678 (emphasis added). Consonantly, a patent issued on an application made by a partnership was held “illegally issued . . . and void” because “neither the application nor the statutory oath in support thereof was ‘signed by the inventor’ in any true sense, or within the meaning of the applicable statute.” Brewer-Tichenor Corp. v. American Forging & Socket Co., 300 F. 335, 336 (E.D. Mich. 1924). Similarly, in Universal Sales Corp. v. California Press Mfg. Co., 20 Cal. 2d 751, 128 P.2d 665 (1942) (en banc), the California Supreme Court noted that a corporation may not validly file a patent application, since that right is “a personal privilege” available only to natural, as distinguished from fictional, “persons.” Id. at 772, 128 P.2d at 677. To the same effect, see Leonard v. Shepherd, 99 U.S.P.Q. (BNA) 63, 67 (Pat. Off. Bd. Intfs. 1947). See also United States Gypsum Co. v. Bestwell Mfg. Co., 15 F.2d 704, 705 (N.D. Ill. 1925) (employer has no right to designate as the “inventor,” for purposes of filing a patent application, any person who did not actually participate in making the involved invention, and a patent based on an improper application is void).

51. For cases emphasizing the primacy of the public interest, see note 3 supra.
52. See note 2 supra.

53. For example, an inventor confronted with a request to ratify and attest to an already filed patent application signed by the assignee which described the invention in a materially incomplete or inaccurate way would have a difficult choice regardless of whether he elected ultimately to accommodate the request or refuse it. To explicate,
The first patent case to reach the Supreme Court, *Evans v. Eaton*, evinces an appreciation of the necessary relationship — both under the Constitution alone and as it was interpreted by Congress in early patent legislation — among the inventor, the subject matter invented or discovered, and the statutory requirement for a complete and accurate description thereof, including a specific differentiation of the patented subject matter from prior inventions. The Court in that case recognized an opportunity to determine broadly whether the patent clause of the Constitution permits the Congress to designate a particular individual as an inventor. Declining to do so directly, the Court ruled that the specific act before it — a private law enacted solely for the relief of Oliver Evans — did not expressly denominate Evans an "inventor," but rather granted him an exclusive right to any "invention" he

ratification and verification of a materially incomplete or inaccurate description would open the inventor to possible prosecution for perjury, and would subject the improperly ratified and sworn application to invalidation because of noncompliance with the requirement now embodied in §112 of the 1952 Act, 35 U.S.C. §112 (Supp. V 1975), or fraud, or both. Refusal to sign, however, would carry with it a risk of an expensive breach of contract suit by the assignee. In addition, the assignee of an application which the inventor refused to ratify would be faced with the difficult problem of determining whether to persist and attempt to show that the refusal of ratification was improper, or to refile the application in accordance with the inventor's own understanding of the invention, thereby running risks that intervening statutory bars or other impediments might prevent issuance of a valid patent. See *Id.* §102 (1970 & Supp. V 1973). It must be expected that a significant proportion of inventors would simply ratify and make oath to an already filed patent application presented by an assignee on what amounts to a "rubber stamp" basis, without significant inquiry into the accuracy and completeness of the application. The justification, in large part, would be real or imagined psychological pressure from the assignee. But it must be expected that the essential depersonalization of the application process under an assignee filing system would also take its toll in reduced inventor awareness and concern for the correctness and completeness of the application.

It can be argued that even with the present inventor filing requirement, the incidence of inventor concurrence in the content of applications prepared by assignees is scarcely more than negligible because of real or imagined psychological coercion. Whether or not this is true — and certainly there are isolated instances where inventor concurrence has been given unwisely — one must expect that the incidence would be increased under an assignee filing system. Thus, the assignee would have greater reason to resort to coercive tactics to avoid the inherent pitfalls of refiling already noted above. Similarly the inventor would no longer be able to argue, as he always can so long as inventor filing is required and he must see the application before filing, that alterations may easily be made. So long as inventor filing remains the general rule, moreover, it is frequent — even usual — for the attorney preparing the patent application to confer with the inventor about the content of the application. Often one or more drafts are exchanged and discussed before the application is placed in final form for filing. A statutory authorization for assignee filing would remove much of the impetus for prefiling consultations with the inventor, and would transfer to the assignee's business people a greater share of responsibility for the scope and content of the application as filed.

54. 16 U.S. (3 Wheat.) 454 (1818).
55. *Id.* at 517-18.
56. *Id.* at 513-14.
might have made, and left open for determination under the general patent laws the issue of what had been invented. As the Court put it, "[t]he real inquiry is, does the patent of Oliver Evans comprehend more than he has discovered?"

By thus limiting and articulating the issue in the Evans v. Eaton dispute, the Court implicitly emphasized the essential inconsistency of denominating any person as an "inventor" of "more than he . . . discovered." Clearly presuming that Congress did not intend such illogic, the Supreme Court interpreted both the general patent law of 1793 and the special patent act for the relief of Oliver Evans to avoid it.

In the second Evans v. Eaton case, the Court concluded that the patent was void for failing to distinguish the improvement Evans made from the known prior art, and thereby implicitly failing to inform the public of the limits of the patent. This requirement that the application "particularly point out and distinctly claim what the applicant regards as his invention" appears in section 112 of the current patent act, and appeared in the same section as the requirement that the inventor sign the application in all predecessor patent statutes.


57. Id. at 513.
58. In this regard, the Court specifically stated:
Without inquiring whether Congress, in the exercise of its power "to secure for limited times, to authors and inventors, the exclusive right to their respective writings and discoveries," may decide the fact, that an individual is an author, or inventor, the court can never presume Congress to have decided that question in a general act, the words of which do not render such a construction unavoidable. The words of this act do not require this construction. They do not grant to Oliver Evans the exclusive right to use his invention, discovery, and improvements; leaving the question of invention and improvement open to investigation, under the general patent law.

Id. at 513, quoting U.S. Const. art. I, § 8, cl. 8.
59. 16 U.S. (3 Wheat.) at 514.
60. Id.
61. Id. at 515-17.
62. 20 U.S. (7 Wheat.) 356 (1822). This case was an appeal from the trial that followed the Supreme Court's earlier remand. Id.
63. Id. at 433-34. "Prior art" in patent parlance is a convenient term that embraces all relevant scientific or technical information made available by the patent statutes to defeat, or limit the scope of, a patent. See 35 U.S.C. §§ 101-103 (1970).
65. Id. § 112 (Supp. V 1975).
66. For a discussion of the United States patent statutes, see note 45 supra.
by a Congress which included a significant contingent of constitutional framers. These statutes and their interpretation in the courts, including the Supreme Court, are recognized as particularly persuasive of constitutional meaning.  

The constitutional patent clause itself, and these early subservient patent laws, must be viewed in the context of the larger concern for the individual rights of liberty and property which distinguish the American governmental experiment from the antecedent political systems with which the constitutional framers were familiar. More pointedly, in pre-Revolutionary England, and in Europe for some centuries before the adoption of the United States Constitution, the right to practice a given art or trade was not only the assigned property of a guild, but was denied to all ordinary citizens ineligible for membership in the requisite guild. Early patent systems on the European continent arose largely because some alert and forward looking rulers perceived the stagnation of the arts and trades under guild domination and sought to encourage creative individuals to produce improved articles and methods in exchange for the “patent” right — an exclusive privilege of limited duration which permitted its recipient to exploit his invention, notwithstanding the existence of a conflicting guild monopoly. In return for this “patent” privilege, the patentee was required to instruct other citizens of the realm in making and using the thing invented.

The first European “patent” systems originated prior to the invention of the printing press, at a time when a requirement for a written description or disclosure of the invention would have been impractical — even unthinkable. In addition, the central interest of autocrats, however enlightened, was in furthering their personal fortunes and those of their closest associates by increasing trade and commerce. To that end the early European patent right was available only for articles of manufacture or processes in com-  


72. Irons & Sears, supra note 71, at 660.

73. Id.

cially usable form, with the capability for immediately enhancing the trade, commerce, and wealth of the realm.\textsuperscript{75}

Early English patent grants were in large part similarly motivated, but in addition, England, as an island, was particularly concerned with improving its domestic manufacture in the interests of its trade. It elected to reward not only those exhibiting creativity by originating inventions, but also those with sufficient courage and initiative to find and import into the English realm new inventions from other parts of the world.\textsuperscript{76} The American colonists were particularly aware of the notorious Elizabethan abuses of patents, which continued into the reign of James I and even after adoption of the Statute of Monopolies, involving free grant to court favorites of exclusive control over old commodities in derogation of public right.\textsuperscript{77} Many colonists emigrated from England and continental European countries, not only to avoid religious and political persecution, but in the hope of achieving freedom from these "patents," guild monopoly restraints, and other inhibitions on the economic endeavors of the individual.\textsuperscript{78}


\textsuperscript{76} See, e.g., Federico, supra note 75, at 292-93. There is evidence that patents were granted in England as early as the thirteenth century, during the reign of Edward III. \textit{Id.} at 293. For a detailed discussion of the evolution of the English patent system, see B. Bugbee, supra note 75; H. Fox, \textit{Monopolies and Patents} (1947). See also Federico, supra note 75; \textit{Early Growth}, supra note 75.

\textsuperscript{77} B. Bugbee, supra note 75, at 12-48; H. Fox, supra note 76, at 127-89. The Statute of Monopolies did not, as popularly supposed, abolish all monopolies and patents within the English realm. It preserved patents for original inventions and importations, and retained the various forms of monopolies, designated as "patents," charters, and franchises, which guaranteed exclusive trading and manufacturing privileges to various guilds and associations. See Irons & Sears, supra note 71, at 662 & n.39. Notwithstanding the adoption of the statute, which purported to abolish the power of the Crown to grant "patents" arbitrarily on all manner of old commodities, English sovereigns continued to exercise the power for at least fifty years thereafter, thus precipitating political unrest in England which became so pronounced at one point that a brief civil war ensued. See B. Bugbee, supra note 75, at 12-48; H. Fox, supra note 76, at 127-89.

\textsuperscript{78} Irons & Sears, supra note 71, at 663-64. The American colonies adopted laws guaranteeing individual rights and liberties which condemned all monopolies except those granted for new inventions and recognized the right of every individual to use his talents and skills in pursuit of a trade. See id. at 664-66. For a verbatim collection of the early laws enacted in the colonies, see 1 B. Schwartz, \textit{The Bill of Rights: A Documentary History} (1971). Of particular interest are the \textit{Body of Liberties},
The Supreme Court noted in *Graham v. John Deere Co.*, "[i]t was a monopoly on tea that sparked the Revolution." Resentment of this and other English monopolies that inhibited colonial trade and commerce and taxed ordinary life was undoubtedly an important factor in the Declaration of Independence and the decision to form a new country. It must further be remembered that the colonists' desire to protect individual rights of liberty and property ran so high at the outset that agreement could be reached only for adoption of a weak form of national government. The existence of strong antimonopoly feelings among the constitutional framers and many of their politically active contemporaries can be seen in the various writings debating the desirability of ratifying the Constitution, which appeared within a period of several years after its proposal to the states. A particularly eloquent summation of American concepts of "property and liberty" — concepts which were downright radical in the prevailing world political climate of their day — was written by James Madison and published in 1792. In this work, Madison defined the inherent property rights of every individual to include "the free use of his faculties and free choice of the objects on which to employ them." Madison particularly


80. Id. at 7.
81. See id. at 7–8.
82. Immediately after the Declaration of Independence, virtually all of the individual colonies adopted declarations or constitutions setting forth guarantees of individual liberties and rights to property. For the full text of each promulgation, see 1 B. Schwartz supra note 78, at 175–379. Various colonies, including Maryland and North Carolina, condemned monopolies as a matter of principle in their declarations. See id. at 284, quoting Maryland Declaration of Rights art. XXXIX (1776), contained in 3 Thorpe, The Federal and State Constitutions, Colonial Charters, and Other Organic Laws 1687–91 (1909); 1 B. Schwartz, supra note 78 at 288, quoting North Carolina Declaration of Rights art. XXXIII (1776), contained in 2 Poore, The Federal and State Constitutions, Colonial Charters and Other Organic Laws of the United States 1409–11 (1877). No doubt it was the strong feeling in favor of individual rights and of permitting people to pursue their lives with the least possible governmental interference, that led to the adoption of the wholly ineffectual central government established by the Articles of Confederation. Irons & Sears, supra note 71, at 667.
83. In addition to The Federalist, a number of pamphlets were circulated by many politicians of the day. See, e.g., Pamphlets on the Constitution of the United States, reprinted in 1 B. Schwartz, The Bill of Rights: A Documentary History 435–620 (1971); Pamphlets on the Constitution (P.L. Ford ed. 1888). See also The Complete Madison (S.K. Padover ed. 1953) [hereinafter cited as Madison]; The Writings of Thomas Jefferson (H.A. Washington ed. 1861).
84. Madison, supra note 83.
85. Id. at 267, quoting National Gazette, March 29, 1792.
emphasized that there can be no "just government . . . where arbitrary restrictions, exemptions, and monopolies deny to part of its citizens that free use of their faculties, and free choice of their occupations, which not only constitute their property in the general sense of the word; but are the means of acquiring property strictly so-called . . . ."\textsuperscript{86}

Clearly, Madison, one of the primary drafters of the Constitution, did not envision that the patent clause would ever permit the Congress to create or tolerate monopolies akin to those enjoyed by the guilds, which did deny to citizens the "free use of their faculties, and free choice of their occupations . . . ."\textsuperscript{87} Equally clearly, Madison and other constitutional framers believed that the patent clause would foreclose Congress from creating arbitrary, exclusive privileges akin to those afforded by English absolute sovereigns. Madison and his fellow framers also certainly believed that no statute was needed under the Constitution for an inventor to exercise freely the right to make, use, sell, and profit from the fruits of his own creativity.\textsuperscript{88} Rather, the purpose of a patent statute was intended to be to "secure" to the inventor an exclusive right of limited duration to prevent others from practicing or enjoying his invention without his express authorization, during the life of the right.

To insure that the authorization contained in the patent clause would be recognized for what it was — an exception to the general disfavor of monopolies — the words of the patent clause were strictly limited. The limitations concerning "securing for limited Times to . . . Inventors the exclusive Right to their . . . Discoveries"\textsuperscript{89} are manifestly of no less significance and are to be construed no less rigorously than the limitation implicit in the stated purpose — "To promote the Progress of Science and useful Arts . . . ."\textsuperscript{90}

The concept of permitting the modern corporation to amalgamate in one patent application the results of the collective efforts of an

\textsuperscript{86} MADISON, supra note 83, at 269, quoting National Gazette, March 29, 1792.

\textsuperscript{87} MADISON, supra note 83, at 269, quoting National Gazette, March 29, 1792.

\textsuperscript{88} MADISON, supra note 83, at 267-69. The Supreme Court in Crown Co. v. Nye Tool Works, 261 U.S. 24 (1922), and Bauer v. O'Donnell, 229 U.S. 1 (1912), recognized the common law right of individual citizens of the United States to make, use, and sell their own inventions on a nonexclusive basis. 261 U.S. at 35; 229 U.S. at 10. Under the patent laws, the right is somewhat qualified by the fact that the inventor of an improvement upon an existing patented invention may not exercise his right to enjoy his own invention in a manner that infringes a valid dominating patent. See Bement v. National Harrow Co., 186 U.S. 70 (1902); McClurg v. Kingsland, 42 U.S. (1 How.) 202, 238 (1841).

\textsuperscript{89} U.S. CONST. art. I, § 8, cl. 8.

\textsuperscript{90} Id. The Supreme Court, in Graham v. John Deere Co., 383 U.S. 1 (1966), relied upon the early American abhorrence of monopoly to conclude that the patent clause "is both a grant of power and limitation," a "qualified authority" to legislate which imposes "restraints" upon the congressional exercise of the patent power. Id. at 5-6.
entire team with a broad research assignment and to preempt an integral segment of technology as an "invention," in a single "patent," is closely related to the medieval concept of the guild monopoly. That concept is far removed from the constitutional concept of promoting individual creativity by securing to the inventor who fully discloses his invention, and thereby advances public knowledge, a limited, exclusive right with which to bargain in the marketplace for whatever economic reward his invention might merit.92

The evolution in England and on the Continent of guilds and exclusive trading companies into modern "chartered" corporations had already commenced when the United States Constitution was adopted.93 Notwithstanding the preeminently agrarian character of 18th century American society, it must be presumed that the constitutional framers, many of whom were well educated and had traveled to England or the Continent, recognized as inevitable the eventual obtrusion of corporate institutions into the American milieu. Accordingly, it must be concluded that the word "Inventors" was intentionally utilized in the Constitution in a limiting sense, and that the word cannot be ignored in designing modern legislation. Moreover, the concept of assignment of property was well understood contemporaneously with the adoption of the Constitution, as evidenced, inter alia, by the use of the word "assigns" in the Patent Acts of 1790 and 1793.95 If the Constitutional Convention had seen merit in "securing" any rights to the "assigns" of inventors, it would have been an easy matter to word the patent clause to insure that result. The omission of reference to persons other than inventors, such as financiers and employers, must, therefore, be deemed deliberate and limiting.

Because patent legislation to the present — apart from the limited deviations in the 1952 Act discussed hereinafter96 — has closely tracked the inventorship requirement in the Constitution, the Supreme Court has had no real occasion to consider any seemingly aberrant statute. The question of whether the language of the patent clause could permit Congress to legalize filing by an entire class of noninventors, such as assignees, has not arisen. Decisions rendered by the Court before 1900 on the propriety of patent applications by

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91. See note 71 and accompanying text supra.
92. See, e.g., Becton, Dickinson & Co. v. Sherwood Medical Indus., Inc., 516 F.2d 514, 516 (5th Cir. 1975).
93. See generally V. MUND, supra note 71.
96. See notes 126-133 and accompanying text infra.
noninventors interpret the language of the extant patent laws, rather than that of the Constitution because there was no hint of inconsistency.\(^7\) Nevertheless, it is noteworthy that the Court twice held that a patent granted on an application of a noninventor is *null* and *void*, rather than invalid, because the underlying application is a nullity.\(^8\) In *Kennedy v. Hazelton*,\(^9\) the Court refused to compel assignment, pursuant to a written agreement, of a purported “patent” that had been granted on the application of a person who was procured by the inventor to file, sign, and swear to the application in an effort to evade an assignment contract.\(^10\) The Court reasoned that since the patent law requires the patent to be “granted on the application, supported by the oath, of the original and first inventor, (or of his executor or administrator) . . .,” a patent granted on the application and oath of another individual is a nullity, incapable of conveying any right, much less of being assigned.\(^11\)

In *Eagleton Manufacturing Co. v. West, Bradley & Cary Manufacturing Co.*,\(^12\) a patent issued on an application materially amended subsequent to the death of the named inventor was held null and void because the amended description of the invention differed so markedly from the original description that the perpetrator of the amended description was deemed to be the true inventor of the patented subject matter.\(^13\) The Court reasoned that since neither the named inventor nor the originator of the different amended description had signed and sworn to the latter, the amended application was a nullity, incapable of supporting the erroneously granted patent.\(^14\)

Even before either of these two decisions, the rules of the Patent Office, adopted December 1, 1879, implicitly recognized the nullity of applications “signed or sworn to in blank, or without actual inspection of the petition and specification, or altered or partly filled up after being signed or sworn to,” and required that they be

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\(^8\) In other words, the Court distinguished these void patents from patents granted upon the proper signature and oath of a bona fide inventor but later found to be invalidated by prior art of which he had no knowledge when the oath was given. For a discussion by the Court of invalid patents generally, see, e.g., Graham v. John Deere Co., 383 U.S. 1 (1966).

\(^9\) 122 U.S. 667 (1888).

\(^10\) *Id.* at 671–73.

\(^11\) *Id.* at 672.

\(^12\) 111 U.S. 490 (1884).

\(^13\) *Id.* at 498.

\(^14\) *Id.* at 499.
stricken from the files "upon the discovery of such irregularity."  

A parallel provision of the present rules permits, but does not require, the Commissioner of Patents and Trademarks (Patent Commissioner) to strike a patent application in any of the same circumstances, or when any fraud has been practiced. These rules are part and parcel of the principle of the Kennedy and Eagleton decisions — i.e., that an application not signed and sworn to and otherwise approved by the inventor before filing is a nullity. The lower courts have not always distinguished between void and invalid patents in applying this principle, but they have, virtually without exception, adhered to its substance.

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106. 37 C.F.R. § 1.56 (1975). As recently as February 25, 1977, the Patent Commissioner ruled that an application not read by one of the three coinventors prior to his execution thereof should be stricken from the files, noting that the primary reason for the errant coinventor's laxity was a desire to expedite filing of the application. Patent Commissioner, Copyright Journal (BNA), Mar. 10, 1977, at A-11. The Patent Commissioner commented: "Such haste... cannot be condoned as an excuse for failure to read, with reasonable care, a specification..." Id. at A-12.

Ironically, comparable "haste" on the part of assignees is one of the excuses advanced by the Commission Report for the adoption of laws permitting assignee filing. See note 27 and accompanying text supra. No legislative hearings to date have directly confronted the question of whether haste on the part of assignees can "be condoned as an excuse for" any activity resulting in the inventor's failure to read a specification with reasonable care. Yet, the assignee filing proposal would permit assignees to effect indirectly what inventors have expressly been prohibited from doing directly for at least a century — to file a patent application that the inventor has never read which may not correctly or completely describe the alleged invention.


The misconception that inventorship is a technicality may have its genesis in statements by many courts that inventorship defects, including inventor misjoinder,
As recently as 1975, in Becton, Dickinson & Co. v. Sherwood Medical Industries Inc., the Fifth Circuit held a patent void for deliberate misjoinder of inventors, and expressly noted that the inventor filing requirement is constitutionally based. Subsumed within the broad principle that any patent granted on an application signed and sworn to by an entity other than the true inventor is void, is its necessary concomitant, that a patent applied for by more or less than all of the true inventors of the subject matter covered is likewise void. This subprinciple was implemented consistently by the courts prior to the 1952 Act.

108. See, e.g., Kendall Co. v. Tetley, 189 F.2d 558, 562 (1st Cir. 1951). A "technical defense," however, is wholly unlike a "technicality" of law. Careful reading of the case law reveals that defenses based on inventorship impropriety are considered "technical" not because inventorship is deemed to be unimportant or nonsubstantive, but because courts strongly presume that persons who swore solemnly to the fact of their own inventorship did not do so perjuriously, but acted correctly and in good faith based on the exercise of due care. See, e.g., Kendall Co. v. Tetley, supra, and Federal Trust v. Sperry-Rand Corp., 444 F.2d 408, 408 (4th Cir. 1971).

109. This subprinciple was codified in the first set of Patent Office Rules adopted in 1836 when that office was established. Rules of Practice in Patent Cases (1836). The rule stated: "Joint inventors are entitled to a joint patent, but neither one can claim separately." Id. at 516. The Court stated that: "Patent-monopoly protection is designed to reward the creativeness deemed by the Founding Fathers to be of value to the Republic . . . . As a corollary, the rule is patent protection may not issue in favor of persons not responsible for the creation of advances otherwise qualifying for the specified protection." Id., citing U.S. Const., art. I, §8, cl. 8. See also Iowa State Research Foundation v. Sperry-Rand Corp., 444 F.2d 408, 408 (4th Cir. 1971).


111. See, e.g., Kendall Co. v. Tetley Tea Co., 189 F.2d 558 (1st Cir. 1951); Larson v. Crowther, 26 F.2d 780 (8th Cir. 1928); Joseph Ross & Co. v. Wigder, 290 F.2d 788 (3d Cir. 1923); Smart v. Wright, 227 F.2d 84 (6th Cir. 1951). See also note 98 supra.
Also subsumed within the same broad principle that any application not filed by the true inventor—entity is void is a second subprinciple — *viz.*, that an application filed by a larger number of persons than those who are actual inventors, is a nullity. This subprinciple was explicitly a part of the relevant Patent Office rules from 1836 to 1949.\textsuperscript{112}

Logic suggests that the only recourse from a void application, whether a consequence of filing by too many inventors, thereby creating a “misjoinder” problem, or too few, giving rise to a “nonjoinder” problem, is to abandon the null and void application and file a new application in the name of the correct inventors. Unquestionably, this logic prevails whenever the error in the original filing is deliberate, even today.\textsuperscript{113}

The question of whether accidental misjoinder of one or more noninventors in an application also signed by all the actual inventors is governed by the same strict rule, first arose in *In re Roberts*\textsuperscript{114} before the Court of Appeals for the District of Columbia Circuit. In that case, an appeal from a Patent Office ruling holding an application to be void because of such inadvertent misjoinder,\textsuperscript{115} the court viewed the unintentional error as correctible by simply amending the original application to remove the surplus noninventors and supplying a new, proper oath.\textsuperscript{116} The court accordingly reversed the Patent Office, holding that the true inventor should not be forced to file a new application and suffer the consequence of loss of the original filing date\textsuperscript{117} “merely to correct a formal error.”\textsuperscript{118}

While at first blush there is a seeming inconsistency between this holding and both the reasoning and express language of the

\textsuperscript{112} For the text of these rules, see note 110 supra.

\textsuperscript{113} See, e.g., Becton, Dickinson & Co. v. Sherwood Medical Indus., Inc., 516 F.2d 514, 516 (5th Cir. 1975).

\textsuperscript{114} 263 F. 646 (App. D.C. 1920).

\textsuperscript{115} *Id.* at 647. The Patent Office not only held the Roberts application void, but apparently did so with strong conviction. Before the Roberts appeal could be heard, that office relied upon its own decision to issue a patent on the same subject matter covered by the Roberts application to a third party who had filed later than Roberts. *See id.*

On appeal, the court was no doubt influenced by its recognition of the effect of this intervening patent which 1) would constitute a prior art bar to the issuance to Roberts of a patent on a new application filed at a still later date by the true inventor entity, but 2) could not prevent Roberts from obtaining a patent on the earlier filed defective application if the defect could be cured by amendment. *Id.* at 646–49.

\textsuperscript{116} *Id.* at 648–49.

\textsuperscript{117} See note 115 supra. The court’s knowledge as to what loss of the original filing date would mean to Roberts no doubt affected this holding. Specifically, if the original application date could not have been salvaged by amending the application, Roberts would not only have lost any hope of obtaining his own patent, he would also have lost his right to practice his own invention. The latter loss would have followed from the award by the Patent Office to a third party of a patent conferring the exclusive right to prevent others, including Roberts, from practicing the involved invention.

\textsuperscript{118} 263 F. at 648.
Supreme Court decisions in *Kennedy* and *Eagleton*, the holdings can be rationalized. Firstly, inadvertent or accidental error is of a different character from intentional misrepresentation of known facts. Secondly, where each of the true inventors has joined in, signed, attested to, and hence approved the application, the innocently erroneous inclusion of a noninventor may reasonably be considered as immaterial surplusage. Early writings on inventor misjoinder and nonjoinder problems did not consider the question ruled upon in the *Roberts* case, and did not suggest a possibility that the law might justifiably regard *unintentional* errors in inventor entity differently from deliberate deceptions.

The so-called “Roberts Rule” gave rise to a spate of related case law in the Patent Office and its reviewing courts. The Patent Office eventually adopted a formal rule which permitted the conversion of a joint application to a sole application upon a showing that: 1) the error was made without deceptive intention, and 2) the applicant was diligent in making the correction soon after discovering the error.

The relaxation of the strict legal rule to permit correction of applications in which a superfluous noninventor had been joined through unintentional error did not prompt a corresponding change of attitude toward applications in which an inventor had been inadvertently omitted through error. The Patent Office continued to hold, in the latter nonjoinder situation, that the erroneous patent

119. See text accompanying notes 99–104 supra.


121. For a comprehensive review of the relevant precedent from the Patent Office and the reviewing courts from the 1920 *Roberts* decision to 1945, see Relson, supra note 120. The author discusses the many different fact situations in which a sole inventor was permitted to rely upon the filing date of an earlier joint application in order to obtain a patent that might otherwise have been barred by intervening prior art. *Id.* at 548–55. Decisions similar to those discussed in the article were rendered between its publication date, 1945, and the January 1, 1953 effective date of the 1952 Act. Patent Act of 1952, ch. 950, § 4(a), 66 Stat. 815 (1952). Compare *In re Field*, 161 F.2d 372 (C.C.P.A. 1947) (sole inventor’s application held unpatentable over patent issued on earlier-filed joint application of same inventor and third party), with *Draeger v. Bradley*, 156 F.2d 64 (C.C.P.A. 1946) (sole inventor permitted to rely on filing date of original joint application he and another had erroneously filed).

122. See 263 F. at 647, 649. The first such Patent Office Rule of Practice was adopted on March 1, 1949 as rule 45(b). Patent Office Rules of Practice, Rule 45(b) (1949). It permitted removal of the names of one or more erroneously joined joint inventors from an application upon the requisite showings of diligence and good faith and presentation of an oath by the true inventor as to his priority and originality. *Id.* The rule, nonetheless, expressly prohibited adding the name of an omitted joint inventor to an application. *Id.* See note 123 infra.

123. See *Ex parte Benes*, 1925 Dec. Com. Pat. 75 (1925). See also Patent Office Rules of Practice, Rule 45(b) (1949). Rule 45(b) states in pertinent part: “An application can not be amended to add the name of a joint inventor who was omitted, but a new independent application must be filed.” *Id.*
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application was a nullity. The only remedy available was for all of the true inventors to file an entirely new application, effective only as of its own filing date. In light of the Kennedy and Eagleton decisions of the Supreme Court, the Patent Office position was well taken.

In 1952, however, Congress adopted new statutory provisions enabling correction of applications involving errors of both inventor misjoinder and nonjoinder so long as all persons acted inadvertently and without deceptive intent and permitting the correction of inventorship misjoinder or nonjoinder on issued patents, on a showing of bona fide mistake and lack of deceptive intent. The legislative history of the 1952 Act revealed that Congress was remarkably inattentive to the fact that those provisions effected changes in the law, much less to the constitutional implications of the changes. There have been relatively few cases decided under

125. See notes 99–104 and accompanying text supra. See also Wailes Dove-Hermiston Corp. v. Oklahoma Contracting Co., 48 F.2d 901 (N.D. Tex. 1931), affd, 56 F.2d 143 (6th Cir. 1932). The district court in that case refused to afford a subsequently filed joint application the benefit of the filing date of an earlier application filed by a sole inventor. 48 F.2d at 902. To the same effect, see Pinkerton v. Stahly, 144 F.2d 881 (C.C.P.A. 1944).
127. Id. § 256.
In its statement to the subcommittee, the American Patent Law Association noted that: "Section 116 liberalizes the treatment of applications of joint inventors by permitting the addition as well as the deletion of a nonjoined or misjoined inventor and represents a realistic treatment of the many problems arising in the handling of joint inventions." Id. at 45. The Association further noted that § 206 of the bill, H.R. 3760, 82d Cong., 1st Sess. § 206 (1951) (codified at 35 U.S.C. § 256 (1970));
provides for deletion or addition of a misjoined or nonjoined inventor in the case of an issued patent and provides that a patent cannot be held invalid for inadvertent misjoinder or nonjoinder. These are salutary [sic] innovations in the law since there is no valid reason why a patent should not be corrected the same as an application in this regard.
Hearings, supra, at 46.

The Department of Justice, which often is quite sensitive to the constitutional ramifications of proposed legislative changes, did not even allude to the inventorship correction provisions of the proposed statute in its statement. Id. at 93–98.

Mr. P. J. Federico, testifying for the United States Patent Office, said that § 206 of the bill
is a new section in the law that is correlated with Section 116 . . . relating to a mistake in joining a person as a joint inventor. Very often two or three people make an invention together. They must apply as joint inventors. If they make a mistake in determining that the third one is one of the three inventors that actually made the invention, they do so at their peril.

This provision permits a bona fide mistake in joining a person as inventor or a failing to join a person as an inventor to be corrected.
Id. at 104.
the correction provisions, and not one has involved the constitutional issue of the power of Congress to enact this legislation. The 1952 Act, as earlier noted, generally preserved the strict inventor filing requirements of prior law. It relaxed those requirements in minor respects when an inventor "cannot be found or reached after diligent effort" or has refused to execute the application for patent to permit a coinventor or an assignee to file for the missing or recalcitrant inventor. The record of legislative hearings held antecedent to the adoption of the 1952 Act reveals that only superficial consideration was given to the wisdom or constitutionality of departing, even in this minor way, from previous law of over 160 years' standing.

Somewhat remarkably, moreover, there seems to have been no discussion of the possibility that an inventor might refuse to sign the committee that is by implication critical of the proposed provisions in so far as they contemplated corrections of nonjoinder errors. He said:

The inclusion as applicant of an extra person, i.e., one in addition to the true inventor, seems to be entirely harmless in all instances except when he himself would improperly gain by it, and in these instances the possible invalidity of the patent is often no discouragement to him but only penalizes the real owner who is innocent.

It would be far better to provide simply: "The naming of an extra person as applicant or patentee shall be disregarded, except that courts may refuse to enforce on behalf of such person his apparent rights as copatentee and, if he dishonestly permitted himself to be named, his rights by assignment. The Commissioner may strike his name, if satisfied that no claim would be jeopardized."

Id. at 218.

The hearing record also contains a written statement in which R. S. Ould, a Washington, D.C. patent practitioner, criticized §§116, 118, and 206 of the bill in extenso. Id. at 223-25. This statement pointed out, inter alia, that "[t]here is no power conferred by the Constitution on anyone to declare that a person is the inventor, who in fact is not the inventor." Id. at 223. The thought is not developed, however, and the statement appears to have been given no thoughtful attention, either in Congress or elsewhere, at the time.


131. Id.

132. Specifically, the subcommittee hearings show that only five of the numerous witnesses even adverted to this change, and then only in passing. Hearings, supra note 128, at 38, 45, 95-96, 211. P. J. Federico, Examiner-in-Chief of the United States Patent Office, acknowledged that §§116 and 118 introduce a new thing in our law. Our statute is very strict in requiring that only the inventor may apply for a patent. These two sections provide for certain types
because the version of the application presented to him did not correctly or completely describe what he had invented, or ascribed to him an invention he had not made. It is safe to say that Congress had no idea it was opening the way for patents to be granted on patent applications that earlier would have been deemed nullities.133

Throughout the twenty-five years since the assignee and coinventor filing provisions of sections 116 and 118 of the 1952 Act became effective, they have been implemented by the Patent Office in accordance with its Rule 47.134 This rule purports to impose rigorous requirements upon the form and content of the fact presentation necessary to justify the assignee or coinventor filing of an application in which an inventor has not joined.135 A 1958 study revealed there had been infrequent resort to this type of filing during

of situations where it may be impossible for the inventor to apply . . . ; the sections provide all of the safeguards necessary for the inventor.

Id. at 38.

The American Patent Law Association expressed an understanding that the departure from prior law was intended to be invoked only in a situation where "the filing of an application is necessary to prevent a loss of rights, such as the running of a public use or the like." Id. at 45. The Association commented further: The rights of the inventor are safeguarded by providing that the patent will issue to him so that the section will not invite indiscriminate filing by others than the inventor and the Commissioner of Patents will not be required to decide any questions as to the title of rights of an alleged assignee or other person in interest.

Id.

The Department of Justice also recognized "a new concept heretofore unknown to the United States patent law" and lauded it as highly desirable in that it would permit employers, including the Government, to file applications for patents on inventions made by employees who are unavailable when an application is ready to be filed. This is not unknown in these troubled days when many military and other personnel are beyond the seas when needed for execution of a patent application. The section does not change any substantive rights. It merely permits the timely filing of an application by the party who thinks he has an interest therein without in any way affecting the inventor's rights.

Id. at 95–96.

The only other pertinent comments during the hearings were made by individual attorneys. Harvey R. Hawgood of Cleveland, Ohio, hailed §§116 and 118 as: "a distinct step forward as there have been instances in which inventions have been lost by arbitrary refusals to sign or by people getting out of contact, particularly at the end of a period raising a statutory bar." Id. at 211.

The final commentator, R.S. Ould of Washington, D.C., did raise a constitutional objection. Id. at 223–25; see note 128 supra. He remarked, inter alia, that the departure from prior law embodied in §§116, 118, and 256 "is likely to prove to be simply an entering wedge to entirely destroy the American concept of inventorship, and to permit the filing of patent applications in the first instance by an alleged employer, or assignee, thus converting the patent system entirely into a system of property rights." Hearings, supra note 128, at 224.

133. The Reviser's Note accompanying the bill at enactment does, however, emphasize the limited ambit of the applicability of §118 by its assertion that "[t]his section is new and provides for the filing of an application by another on behalf of the inventor in certain special hardship situations." Reviser's Note, 35 U.S.C. §118 (1970).
135. Id., Rule 47(b).
the first five years of its availability. Study of subsequent precedent shows a similar pattern of infrequent use at the Patent Office level. The same study shows there has been no infringement and validity litigation that raised the issue of whether a patent maturing from an assignee — or coinventor — filed application is a nullity. The constitutional implications of the statutory provisions accordingly have not been considered in any court.

A word of caution is appropriate with respect to this lack of a constitutional test. The Supreme Court long ago pointed out, in *Andrews v. Hovey*, that neither the administrative construction of a federal patent statute over a substantial period of time, nor its judicial construction in lower federal courts, can be regarded as

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137. Cogar v. Schuyler, 464 F.2d 747 (D.C. Cir. 1972), uniquely involved an assignee-filed application. In that case, the alleged inventor refused to execute the application, because of his belief that “the invention was obvious to any skilled electronic circuit designer,” id. at 748, and sought to prevent issuance of a patent for the same reason. In so doing he relied upon a purported right, under the fifth amendment guarantee of procedural due process, to an oral hearing in the Patent Office on the patentability issue. Id. at 750. The inventor failed to raise the far more cogent questions of whether the application must constitutionally be deemed a nullity because of his refusal to sign it, and whether § 118 of the 1952 Act and 37 C.F.R. 1.47 (1977) must be deemed unconstitutional if construed to permit an assignee to file an application actively disapproved by the inventor.

In an opinion rendered on August 26, 1977, written by Chief Judge Howard T. Markey of the Court of Customs and Patent Appeals, sitting by designation, the Court of Appeals for the District of Columbia Circuit departed sharply from existing statutes and precedent to permit the nunc pro tunc correction by reissue, under § 251 of the 1952 Act, of a patent maturing from an application erroneously executed and filed by the assignee, to substitute the true inventors as applicants. A. F. Stoddard & Co. v. Dann, 564 F.2d 556 (D.C. Cir. 1977). The opinion ignores the strictures of law, 35 U.S.C. §§ 118, 251, 256 (1970 & Supp. V. 1975), and rule, at least of 37 C.F.R. 1.47, 1.56 (1977). No mention is made of the fact that the inventors never signed or swore to the original application even though they were not missing or recalcitrant at the time of filing, 564 F.2d at 562. No account is taken of the paramount rights of the public in the patent system, which, inter alia, include an unmitigated right to free public enjoyment of all illicitly patented and unpatented subject matter. For a list of cases emphasizing this right, see note 3 supra. Ignoring this paramount public interest, the opinion untenably assumed that no one would be harmed by permitting the correction that allowed the patent to subsist. 564 F.2d at 565.

Building from this assumption, this confessed exercise in judicial legislation, id. at 564, rests on two premises. The first and major of these premises is the simplistic and questionable conclusion that under the Constitution, the sole "purpose of the patent system is to encourage disclosures," id. at 563, a premise that does not square with the Supreme Court precedent emphasizing the dominant public interest in obtaining only valuable disclosures of meritorious information, and only in strict accord with statutory strictures. See note 3 supra. The minor premise, which is noncontroversial, but misapplied, is that the Constitution ordains "a patent system based on justice, wherein honesty and candor are encouraged, not penalized." 564 F.2d at 563.

Properly applied, this premise would necessarily afford due respect to the preeminent public interest in free access to information not validly patented. See note 3 supra.

authoritative absent concurring Supreme Court adjudication. In Andrews, the Court repudiated Patent Office rules in effect for 49 years to hold that public use or sale of a patented item more than two years prior to the date of the application for a patent would invalidate such patent regardless of whether or not the inventor had consented to such use. Reasoning from Andrews, the need for Supreme Court adjudication is more acute where constitutionality, rather than mere interpretation of a federal patent statute, is at stake.

The apparently unruffled existence enjoyed by sections 116, 118, and 256 of the 1952 Patent Act for nearly twenty-five years obviously cannot guarantee their constitutionality. The very fact that there has been no opportunity for conclusive adjudication of the meaning and scope, much less constitutionality, of these provisions should alone give pause to Congress in its contemplation of the more sweeping statutory inroads upon traditional concepts of inventors'ship represented by the corporate patent concept. The possibility that legislation enacting this concept might not be subject to conclusive judicial test in the Supreme Court for many years, during which large numbers of highly questionable corporate patents might issue, should certainly deter the enactment of such legislation. At the very least this broad proposed legislation should be tabled until after meaningful adjudication of the related, but far less drastic, measures now in effect under sections 116, 118, and 256 of the 1952 Act. Legislation which would authorize the Patent Office to grant legions of corporate patents of dubious validity in probable derogation of the constitutional rights of the public is in the most virulent sense a capitulation to "special interests."

Whether or not the Supreme Court would, or could, hold constitutional some or all of the limited provisions now in sections 116, 118, and 256 of the 1952 Act, it seems apparent that the restricted congressional power of "securing for limited Times to . . . Inventors the exclusive Right to their . . . Discoveries" is not sufficiently elastic to encompass the corporate patent concept, including the redefinition of the word "Inventors" to embrace assignees broadly.

139. Id. at 716.
140. Id. at 719.
141. See Scott & Unkovic, supra note 10, at 968-69. These knowledgeable authors caution that Congress must use its own judgment, based on extended hearing and study, and not permit "special interests" in any field, including patent legislation, "to usurp the legislative function . . . to write the rules of the game . . . ." Id. at 969.
143. See text accompanying notes 151-155 infra. Whether a watered down assignee filing proposal of the scope included in Senate Bill 2255, S. 2255, 94th Cong.
Over and above the probability that the corporate patent concept would violate the patent clause, there has been little appreciation of the potential fifth amendment clash. Legislation implementing the corporate patent concept might well be deemed arbitrarily discriminatory class legislation in violation of the fifth amendment. Pointedly, the proposal envisioned by the Commission Report would permit the inclusion in any patent having a plurality of inventors, whether or not an assignee-filed patent, of claims directed to subject matter invented by any number less than all of the full complement of persons named as inventors. Manifestly, a single patent application, covering the distinct inventive contributions of a plurality of inventor entities from among a large group of “joint” inventors named on the application, could easily carve out a broader scope of exclusivity for its assignee or joint owners than could ordinarily be obtained from separate applications each presenting a separate invention of each of the individual inventor entities involved. The result would be rank discrimination against sole inventors who could never obtain patents on more than they invented or “pool” inventions to obtain broader coverage.

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2d Sess., 122 CONG. REC. 2383 (daily ed. Feb. 26, 1976), might be constitutional is a closer question, but this seems doubtful in view of the bill's contemplation that the inventor need not read or know the content of the application prior to filing. Id. § 111, 122 CONG. REC. 2383 (daily ed. Feb. 26, 1976). See note 17 supra. It could be argued that the bill's requirement of ratification and inventor's oath within two months of filing would greatly reduce the incidence of problems resulting from the inventor's failure to concur in the correctness or completeness of the application prepared at the behest of his assignee.

It should be noted in this regard, however, that one group particularly interested in obtaining permission for assignee filing — aliens desirous of applying for patents pursuant to § 119 of the 1952 Act, 35 U.S.C. § 119 (1970 & Supp. V 1975), or the parallel section of Senate Bill 2255, S. 2255, § 119, 94th Cong., 2d Sess. (1976) — normally files applications, very close to the expiration of the one year grace period for claiming the priority of a first-filed foreign application.

In consequence, the likelihood is great that many of them might lose any hope of obtaining a United States patent if the original date, and the foreign priority dates, were lost because the application was not ratified and accordingly became a nullity. Foreign assignees, who are largely ignorant of, or disinterested in, American constitutional law and the inventor's importance thereunder, could accordingly be expected to employ coercive tactics quite unscrupulously to insure ratification and preservation of the earliest filing date. Predictably, patents issued to these entities would exhibit increased incidence of failure 1) to disclose the best mode known to the inventor for carrying out his invention and 2) to particularly point out and distinctly claim what the inventor regards as his invention, as required by § 112 of the 1952 Act, 35 U.S.C. § 112 (Supp. V 1975), and the parallel provision of Senate Bill 2255. S. 2255, § 112, 94th Cong., 2d Sess. (1976).

144. COMMISSION REPORT, supra note 4, at 11.

145. No possible difference between sole inventors and either joint inventors or assignees could justify affording the latter two groups an opportunity for much broader patent protection. For representative cases as to what constitutes discriminatory class legislation, violative of the fifth amendment, see, e.g., Johnson v. Robinson, 415 U.S. 361 (1974); Handy v. Delaware Trust Co., 285 U.S. 352 (1932); Heiner v. Donnan, 285 U.S. 312 (1932).
illustrate briefly the type of discrimination that would inevitably occur from such legislation: Suppose that Inventor A, a corporate employee member of a research “team,” discovers a specific chemical compound “X” which he identifies and determines to be useful, and then turns over to Inventor B, a coworker, the task of ascertaining whether a structurally closely related, but different, family of compounds can also be made and used for similar purposes. Under present law, the prior invention of A is available prior art against any later invention of B. Accordingly, A’s work may prevent B from receiving a patent, thus forcing B’s purported invention into the public domain at a very early date. Under the corporate patent concept, however, A and B as coworkers employed by the same assignee could file a joint application or be named as coinventors on such an application filed by their assignee. This application would be required, under the corporate patent concept, to present only one “joint” claim to a “family” of compounds embracing both “X” and B’s group of related but different compounds. Its other claims could separately cover A’s invention and B’s alleged invention. The Patent Office would be effectively forestalled from rejecting the later B work as unpatentable over the earlier A work because it would have no practical way of discerning which came first, or of separating the original A invention from the B invention. The resultant issuance of a broad patent embracing the contributions of both A and B would derogate the rights of the public. Since an independent inventor in the same posture as A with respect to compound “X” could never receive the same scope of patent grant as the corporate patent would afford either to A and B jointly, or to their assignee, the discriminatory effect is obvious. Many other similar examples

146. 35 U.S.C. §§102, 103 (1970). Section 103 prohibits the granting of a patent though the invention is not identically disclosed or described . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

Id.


In In re Sarett, 327 F.2d 1005 (C.C.P.A. 1964), it was noted, albeit ruefully, that “the patent could not legally contain a claim to Sarett’s sole invention under
could be envisioned. The abuses become more aggravated as "inventor" groups are enlarged, increasing the possible permutations of inventor subgroups and the number of inventions to be joined in a single application.

It can be argued that the statutory permission to so amalgamate the work of different entities would not change the substantive law defining patentable subject matter as now set forth in sections 101, 102, and 103 of the 1952 Act, absent a clear statement of statutory intent to do so. Pursuing that argument, the above postulated joint patent of A and B would be granted by the Patent Office at the assignee's peril. The argument is defective because it assumes litigation to be inevitable and further assumes that the true facts would then necessarily be exposed. In actual practice, however, litigation might never ensue. And if it did, disentanglement of complex facts relating to individual inventorship years after the event, when memories have faded, research team members have dispersed or died, and written records may be less than satisfactory to show anything beyond the specifics of experimental work performed, is no simple matter.

Notably, the proposal for amalgamation of many corporate employees' inventions in one composite patent application originated prior to the appointment of the President's Commission, in suggestions of practicing corporate employee patent lawyers. One of these individuals has recently acknowledged the intention of these suggestions — to permit corporations to avoid rejection of a patent application filed by one corporate inventor entity on grounds of unpatentability over an earlier application describing an earlier invention of a different inventor entity within the same laboratory.

existing law because it would not have been the invention of the joint patentees." *Id.* at 1010 n.7 (emphasis in original).

One article has incorrectly asserted that Senate Bill 2255 would change current law because "[i]t would require each of the joint inventors to have made an inventive contribution to the subject matter of each claim of the application." *Whale, Patent Law Revision — A Dark Look at S. 2255, 59 J. PAT. OFF. SOC'Y 153, 157 (1977).* This statement is not only incorrect but may reveal more than the author intended about the real impetus behind the corporate patent — the legitimization of a practice already being illicitly used by some corporate employee patent practitioners to the detriment of the public.


149. See Commentaria, 46 J. PAT. OFF. SOC'Y 301 (1964) (letter from Louis Altman to editors, suggesting changes in patent law to permit joint applications for contributors to an invention); Commentaria, 45 J. PAT. OFF. SOC'Y 655 (1963) (letter from Bernard Franz to editors, suggesting § 116 be modified to permit inclusion as joint applicants those making some inventive contribution to claims of the application).

150. Franz, *Prosecution Problems With A Plurality Of Inventions From A Single Project*, 51 J. PAT. OFF. SOC'Y 559 (1969). The introductory portion of this article states:
An even more recent proposal by a member of the Board of Patent Appeals of the Patent and Trademark Office\footnote{151} would approach the corporate patent less directly by amending sections 102(e) and (g) of the 1952 Act — and presumably, by implication, at least sections 102(a) and 103 \textit{also} — to prohibit the citation as prior art of the work of one research team member against an application filed by a coworker.\footnote{152} Reference to the example above demonstrates that this proposal would discriminate against both the sole independent inventor and the public. Pointedly, the sole inventor would be disadvantaged in relation to corporate team inventors, because all prior art would continue to apply against his patent applications.\footnote{153} And the public would more often be defrauded of the unfettered right to use imitative technology failing to meet the constitutional criterion that patented subject matter must “promote the Progress of Science and the useful Arts.”\footnote{154} The Supreme Court predictably would not ultimately tolerate a legislative relaxation in the constitutional patentability standard, particularly one that would enlarge the ambit of patent protection available to special interests in the corporate field.\footnote{155}

With the increasing complexity of modern research and development, it frequently happens that a single project spawns several inventions. Such projects usually require a group effort, and the resulting inventions are not all contributed by the same “inventive entity.” However, it may be difficult or impossible to select an invention for filing, and write an application disclosing only matter contributed by a single “inventive entity.” It is also usually impractical to file applications on all of the inventions on the same day. If the attorney proceeds in what would seem to be a normal manner, and files several applications over a period of time, then the provision of 35 U.S.C. 102(e) is likely to be used to reject the later filed applications on the disclosure of a patent issued on one or more of the earlier filed applications.

\textit{Id.} at 559 (footnote omitted). This author has failed to consider the constitutional implications of his suggestion, and appears blind to the bias against sole inventors that is necessarily implicit in the scheme.

For additional treatments of the use under present law of earlier filed applications of corporate employees as prior art against subsequently filed applications of their research team coworkers, see Lorenzo, \textit{The Inventive Entity and the Law of Double Patenting}, 50 J. PAT. OFF. SOC’Y 519 (1968); Meyer, \textit{Obvious Differences — What Should the Points of Reference Be?}, 55 J. PAT. OFF. SOC’Y 516 (1973); Pitlick, \textit{A Proposed Compromise to the “Prior Act” Controversy Surrounding In re Hellsund and In re Bass}, 56 J. PAT. OFF. SOC’Y 699 (1974); Rosenstock, \textit{Prior Art Under 35 U.S.C., Section 103 Includes Prior Invention}, 56 J. PAT. OFF. SOC’Y 263 (1974).

\footnote{152} Id. at 348-49.
\footnote{153} See notes 144–145 and accompanying text supra.
\footnote{154} See notes 89–90 and accompanying text supra.
V. Conclusion

Summing up, it seems clear that statutory deemphasis of the inventor's role in the United States patent system is not only unconstitutional per se, but would tend to deemphasize the inventor's product — the invention itself — and attenuate the high standard it must attain to merit a valid patent under present law.\(^ {156} \)

In this day of persistent lip service to the "lone," independent inventor, whose financial plight is repeatedly urged as the justification for makeshift patching together of our antiquated patent granting procedure in lieu of adopting a truly modernized \textit{inter partes} procedure, it is indeed ironic that his loudest self-styled sympathizers and admirers are also most persistent in seeking and supporting the corporate patent proposal.\(^ {157} \) Certainly it is hard to envision provisions more discriminatorily destructive of the relative value of a "lone" inventor's patent rights than those embodied in this clearly unconstitutional and well-nigh medievally regressive proposal.

Quite apart from constitutional considerations, moreover, if the lone inventor and the \textit{sole employed} inventor continue to be important in the generation of fresh new technical ideas, infused with outstanding originality and creativity, and of a character crucial to \textit{real} advancement of the arts and sciences — and many knowledgeable people assert that they are\(^ {158} \) — it is particularly

\(^{156}\) This conclusion follows from the fact that joint inventors, by pooling many distinct but related inventions in one case, could easily avoid citing pertinent prior art which originated in their own laboratories, in derogation of the invention standard consistently recognized and demanded by the Supreme Court. \textit{See} Irons \& Sears, \textit{supra} note 71; Sears, \textit{Tinkering With The Invention Standard: No Solution to Problems of Patent Quality}, 59 MNN. L. REV. 965 (1975).

\(^{157}\) For example, one writer has suggested that a modernized patent reform bill designed to improve patent quality, \textit{inter alia}, by permitting public participation in the patent granting process, in contrast to the present outmoded practice of secret, ex \textit{parte} dealings between the Patent Office and the patent application owner, would result in "fewer applications filed, particularly by private inventors and small companies." Whale, \textit{supra} note 147, at 162.

Mr. Whale, a former American Patent Law Association president, thus joins the Association's official position that a modernized patent granting procedure is undesirable because it is too costly for most "lone" inventors. \textit{Id}. \textit{See}, \textit{e.g.}, Letter from Edward F. McKie, then President of American Patent Law Association, to The Honorable James O. Eastland, Chairman of the Senate Committee on the Judiciary (Feb. 3, 1976). This letter criticized Senate Bill 2255 because "individuals and small companies are more in need of the patent incentive than larger companies, yet are less able to afford added expense." \textit{Id.}, reprinted in 1976 BULL. AM. PAT. L. 7, 78.

\(^{158}\) For a sampling of articles suggesting that "team" work not only fails to substitute for individual originality, but may even have a depressive effect on creativity, \textit{see} Blizard, \textit{The Future of Discovery and Invention}, 56 TECH. REV. 395 (1954); Chandler, \textit{Duplicate Inventions?}, 62 AM. ANTHROPOLOGIST 495 (1960); da Silva, \textit{Invention as Creative Art}, 5 CHEMTech 520 (1975); Hayes, \textit{The Independent Inventor's Interest}, 47 J. PAT. OFF. SOC'Y 298 (1965); Land, \textit{Thinking Ahead}, 37 HARV. BUS. REV. 7 (1959); Ooms, \textit{Patents, Small Business, and the Age of Research}, 40 J.
important that patent legislation should not demean their individual dignity or erode their morale.\textsuperscript{159} The corporate patent proposal, by depersonalizing and deemphasizing their role in the patent system, would necessarily have such an effect.

\textsuperscript{159} One author suggested that even corporate employee research "team" inventors would feel a decline in their morale. Bangs, \textit{supra} note 22, at 1007.