UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE

JUN - 1 2011

The Honorable Lamar S. Smith
Chairman, Committee on the Judiciary
U.S. House of Representatives
Washington, DC 20515-4321

Dear Mr. Chairman:

I am pleased to share with you a copy of a letter sent to me by Michael B. Mukasey, who served as the Attorney General of the United States from November 2007 to January 2009, expressing his view that the first-inventor-to-file provision embodied in the America Invents Act is "both constitutional and wise."

As indicated in Secretary Locke's recent views letter on H.R. 1249, the Administration strongly supports the proposed transition of the United States to a first-inventor-to file system. The first-inventor-to file provision simplifies the process of acquiring rights while protecting innovators, provides a more transparent and cost-effective process, is consistent with the practices of our trading partners, puts U.S. businesses on a level playing field with the rest of the world, and enables inventors to market and fund their technology with a reduced threat of patent challenges. These advantages will benefit stakeholders across industries, helping businesses small and large alike.

I hope this letter is helpful, and thank you again for your leadership in advancing patent reform legislation.

Sincerely,

David J. Kappos
Under Secretary and Director

Enclosure

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May 26, 2011

Mr. David J. Kappos
Under-Secretary of Commerce for Intellectual Property and
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The America Invents Act

Dear Mr. Kappos:

You have asked for my views on the constitutionality of the first-inventor-to-file rule embodied in the above legislation, which has passed the Senate and is now before the House of Representatives as HR 1249. I am happy to provide them. For the reasons summarized below, I believe the provision is constitutional, and helps assure that the patent laws of this country accomplish the goal set forth in the Constitution: "To promote the Progress of Science and useful Arts."

First, the new legislation leaves unchanged the existing requirement that a patent issue only to one who "invents or discovers." That assures that the legislation is constitutional.

The issue that has been raised concerns the situation presented by one who invents but does not file for a patent, and who then sees a later inventor file for a patent. Under the new legislation, that second inventor, provided that he or she did in fact invent the device or process at issue, would be able to obtain and retain the patent despite proof that someone else actually had invented the device or process but did not apply for a patent. The second inventor is no less an inventor for having invented second. Because the Constitution permits Congress to protect those who "invent or discover," that person is no less within the anticipated protection than the first inventor.

The Constitution is silent on the subject of how Congress should go about providing that protection, or indeed whether it should

do so at all. However, Congress is certainly free to choose to provide it in a way that Congress believes best accomplishes the goal of the patent laws, which is "To promote the Progress of Science and useful Arts." It is at least arguable that for an invention to lie undisclosed or undeveloped does not accomplish that goal, and therefore the best way to assure disclosure and development is to reward with Constitutional protection the first inventor to file, and thus to assure that an invention is shared with society at large through disclosure as part of the patent process.

Indeed, that the patent laws have applied a variety of standards since the first one was enacted in the Eighteenth Century, including standards that awarded patents to other than the first inventor, shows that there is no Constitutional impediment to such a standard now.

Further, I believe that the policy argument to the effect that a first-to-file rule will encourage premature patent applications is more than outweighed by the demonstrated shortcomings of the current system, which permits some inventors to pursue their fortunes in the courts rather than in the U.S. Patent Office, and thereby to raise for all of us the cost of progress.

In sum, I believe the new legislation is both constitutional and wise.

Yours sincerely,

Michael B. Mukasey