Finally, while the ~~success~~ deem it successful as well as economic success of BD is more than enough to justify the economist's belief that the Act was "possibly the most inspired piece of legislation to be enacted in America over the past half-century" (4) the nay-sayers failing to recognize the Act's complete success in giving government funded inventors not only the right to see their invention reach the marketplace through the patent system but to know that their employer used their best efforts to do so but failed as envisaged by Cottrell (5). ~~But~~ Indeed, it is this fact alone that may explain the extraordinary increase in invention reporting by government funded inventors (6)

are "priced fairly". This concept was unsuccessfully tried by NIH from 19? to 19? and abandoned after industry refusal to enter into any licensing agreements with NIH during that period (8) and is not required by Bayh-Dole. To mandate such a requirement would require amendment of both Bayh-Dole and the FTTA and would on the basis of the NIH experience make BD, FTTA and SB1R inoperative for their intended purposes.

We now turn our attention to the author's primary reliance on the work of individuals characterized by Senator Bayh.

Retaining First-to-Invent: Continued Promotion of the Progress of Useful Arts

The Supreme Court has found a standard expressed in the Constitution, "inherent requisites" of "innovation, advancement, and things which add to the sum of useful knowledge." It is a standard that "may not be ignored."[56] To conclude our analysis of how the Constitution would prevent adoption of any first-to-file system, it is appropriate to consider which system better promotes "the progress of useful Arts" and fulfills the Court's inherent requisites. The answer is clear, and is consistent with the rest of the Constitution's patent clause. The first inventor, unlike another person who "invents" later but files earlier, is the one who brings an innovation or advancement into being. It is that person who fulfills the constitutional objective and is entitled to its prescribed reward. Thus the Constitution shows its wisdom; it expressly prohibits what would hinder the results it requires.

In consonance with this view, the Supreme Court observed that the patent laws promote the constitutional goal of progress

> by offering a right of exclusion for a limited period as an incentive to inventors to risk the *often enormous costs in terms of time, research, and development.* The *productive effort thereby fostered* will have a positive effect on society through the introduction of new products and processes of manufacture into the economy, and the emanations by way of increased employment and better lives for citizens.[57]

The Court did not speak of incentives to "win a race to the Patent Office." It spoke, instead, in the traditional American terms of invention, of research and development, of productive effort.

The United States is under intense pressure to conform to the rest of the world and adopt a first-to-file system. As we have seen, however, the Constitution of this country simply does not allow for such a change. Yet it is entirely appropriate for the United States, a country that progressed from a small band of colonists to being the single largest source of worldwide patent filings,[58] to continue standing apart in rewarding "compensation for [the] ingenuity, labor, and expense"[59] of first inventors in producing their discoveries.

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56 *Graham*, 383 U.S. 1.

57 *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470 (1974) (emphasis added).

58 United States residents originated about 40% of all PCT applications during 1998 and 1999, more than twice the percentage filed by residents of any other single country. WIPO, *The Patent Cooperation Treaty (PCT) in 1999*, available on the Internet at www.wipo.int/pct/en/activity/1999/pctin99.htm#P22_952.

59 *Allen v. Hunter supra* note 51.

surrogates
of vested
monopolies

and foreign

~~self~~ unqualified
experts

Notwithstanding the
outstanding success of the
Act set out above the
Act has attracted a
cottage industry of scatter-
brain academics presenting
themselves as "experts"
within the ~~federal~~ government
with ~~the~~ amendments to
the exceptional circumstances
and march-in provisions
of the Act and its implementing
regulations. They describe
these amendments as being
supported by ~~an~~ a number of
~~unproven or unworkable~~ theories
that are unproven or ~~shown~~
~~to be~~ have been shown to be
failures in practices
utilized before the
passage of the
Act. and

situations"[41] and thus would not prohibit a first-to-file system. Clearly, however, no interpretation can be so expansive as to entirely vitiate a significant term in a constitutional requirement.[42] Patents simply cannot be granted to any but "inventors" for anything but "discoveries."[43]

Even modernists rely on "deeply embedded traditional ways of conducting government" to give meaning to the words of a text or even supply them.[44] What then, have been the "deeply embedded traditional ways" in which the U.S. government has granted exclusive rights to inventors for their discoveries? Perhaps the most enduring and consistently followed principle of American patent law has been to grant such rights to first and original inventors. The statutes and published decisions found throughout the nearly two centuries of legal history since ratification of the Constitution are an important consideration.[45] In view of that "gloss which life has written upon" its words, the patent clause overwhelmingly favors a first-to-invent interpretation of its mandate.

We begin with the decision of the 1791 patent board to reject a first-to-file proposal, which is appropriate for two reasons. First, it was arguably the first administrative decision regarding such a proposal under the Constitution, which had been in effect only three years. Nothing could be considered more "deeply embedded," or the start of a more "traditional way of conducting government" than that early decision.[46] Second, Jefferson was one of the three board members, and his influence on American patent law is well established.[47]

In 1826, the Circuit Court for the Southern District of New York observed that the whole law relating to patents, which remained essentially under the Act of 1793, could still be regarded as novel in the United States.[48] That state of affairs did not prevent the court from pointing out that

41 *Youngstown Sheet & Tube Co. et al. v. Sawyer*, 343 U.S. 579, 682 (1952) (Vinson, C.J., dissenting). Also, *see* WHITTINGTON *supra* note 32 at 196.

42 GREGORY BASSHAM, ORIGINAL INTENT AND THE CONSTITUTION 93 (1992). Bassham, though generally eschewing the originalist view, quotes Thomas Jefferson as expressing concern about elected officials rendering the Constitution "a blank paper by construction."

43 *See supra* notes 11-14.

44 *Youngstown supra* note 41.

45 Kenneth Burchfiel, *Revising the "Original" Patent Clause: Pseudohistory in Constitutional Construction*, 2 Harv. J. Law & Tech. 155, 209 (1989) ("In the effort to determine the original meaning of a constitutional term, as in any legal history, a *sine qua non* is consideration of the most coherent and persuasive available data, contained in statutes and published decisions").

46 Federico considered it "very unlikely that duplicate patents were granted [by the board] to the four steamboat claimants without deciding the question of priority." *See supra* note 2 at 249.

47 *See Graham*, 383 U.S. at 7. Also, *see* text at note 39 *supra*.

48 *Thompson v. Haight*, 23 Fed. Cas. 1040, 1041.

> [i]t is very true that "the right to a patent belongs to him who was the first inventor, even before the patent is granted." [No citation given.] That is, none but the first inventor can have a patent.[49]

Shortly after the Act of 1839 (and less pertinent Acts of 1842, '46, '48, and '52)[50], another federal district court observed that

> [n]o exclusive right can be granted for anything which the patentee has not invented or discovered. . . . the right of the patentee entirely rests on his invention or discovery of that which is useful, and *which was not known before*. And the law gives him the exclusive use of the thing invented or discovered, for a few years, as a *compensation for 'his ingenuity, labor, and expense in producing it.'*[51]

The court, in instructing the jury, addressed the question of whether the plaintiff, who had been issued a patent for his invention, had protection against issuance of a rival patent to the defendant under the early caveat system then still in effect:

> [The plaintiff] is protected by the law [against issuance of a rival patent], unless the defendant's invention entitled him to a patent before the plaintiff applied for his patent.[52]

Interestingly, the jury found for the defendant, evidently heeding the court's instruction that "the one who perfected his invention first" would be entitled to protection if both the plaintiff and defendant could properly be considered rival inventors. This case, then, is an example of a first applicant losing out to a first inventor under legislation enacted some 60 years after ratification of the Constitution.

First-to-invent maintained its steady hand on the course of American patent law through the remainder of the nineteenth century and into the twentieth. In 1920, the D.C. Court of Appeals affirmed an award of priority to an interference party who was first to conceive and first to reduce to practice.[53] The court observed that the award was grounded on what had been the rule in the Patent Office since 1872, a rule that had received the approval of the court in earlier cases.[54] Since then, it has never become the law that one who "invented" later but filed first would receive a patent against a first inventor who had not forfeited rights.[55]

49 *Id.* at 1048.

50 *See* ROBINSON *supra* note 11 at 78-79.

51 *Allen v. Hunter*, 1 Fed. Cas. 476, 477 (D. Ohio 1855) (emphasis added).

52 *Id.* at 482.

53 *Erben v. Yardley*, 267 F. 345.

54 *Hubbard v. Berg*, 40 App. D.C. 577; *Thompson v. Storrie*, 46 App. D.C. 324.

55 The first inventor can forfeit his constitutional rights by his action or inaction, just as the citizen can forfeit his constitutional rights (*e.g.*, to vote) by his actions (*e.g.*, felonious crimes). The statutory and common law has long cautioned the first inventor to act diligently lest he lose his rights. See 35 U.S.C. 102(b),(c),(d)(g); *Howe v. Shumaway*, 12 Fed. Cas. 678 (D. Mass. 1854) (First inventor "gave nothing to the public." Court held he had "only an idea, never carried out in a machine [i.e., actually reduced to

while ~~these experts maintain that~~
~~such amendments~~ are
merely