I. INTRODUCTION

There are many statutory requirements that must be met to obtain a patent in the United States, and among these requirements are the familiar trilogy that an invention must be novel, non-obvious, and have utility. The requirement of novelty is not absolute, however, and section 102 of the Patent Act sets forth the criteria by which novelty is legally assessed.

The United States Constitution provides for patent grants in order to promote progress of the useful arts and sciences. To that end, it is axiomatic that one purpose of U.S. patent law is to encourage innovation. But U.S. patent law has broader purposes as well.

The patent law also encourages public disclosure of inventions, at least in part because secret innovations are less likely to promote progress than those disclosed to the public. In this regard, U.S. patent law attenuates the legal effect of innovations that are not properly disclosed to the public. One such provision is codified at 35 U.S.C. § 102(g), which is an important, albeit seldom used, standard by which novelty is assessed.

In 1974, the United States Court of Appeals for the Seventh Circuit decided *Allen v. W.H. Brady* in which 35 U.S.C. § 102(g) was examined and explicated. Justice Stevens authored this opinion before his appointment to the Supreme Court. While the U.S. Court of Appeals for the Federal Circuit has had exclusive jurisdiction over appeals from district court decisions involving substantial questions of patent law since its inception in 1982, no case requiring an interpretation of this aspect of section 102(g) has been decided by the Federal Circuit since the *W.H. Brady* decision. Nonetheless, multiple district court cases have been decided since 1982 and have followed the Court’s interpretation of section 102(g) set forth in *W.H. Brady*. Thus, the law pertaining to paragraph (g) of section 102 as explicated in *W.H. Brady* appears to be accurate explicated and well settled.

This paper concurs in the *W.H. Brady* decision, but demonstrates that the Court offered an alternative rationale not necessary to decide the controversy before it, and that the rationale underlying this alternative rationale was not sound. In support of these positions, this paper **ROADMAP**.
35 U.S.C. § 102(g) negates an applicant’s entitlement to a patent when another invents the claimed subject matter before the applicant’s invention, but only if the other inventor “had not abandoned, suppressed, or concealed” the invention. According to J. Rich, a recently deceased member of the Federal Circuit Court and co-draftsperson on the committee that drafted the original section 102, Congress only intended section 102(g) to provide the Patent Office (PTO) with statutory authority to resolve which of two (or more) patent applicants was the first to make a commonly-claimed invention, and therefore, may be entitled to receive a patent to the exclusion of other applicants. Nonetheless, courts have held that the plain language of section 102(g) also makes the statute a basis to invalidate issued patents.

The Seventh Circuit in Allen v W.H. Brady had the opportunity to construe 102(g) in the context of a patent infringement suit. In this suit, the Court states that abandonment by an earlier inventor under section 102(g) is irrelevant, unless the act of abandonment occurred prior to the invention of the patent applicant.

Moreover, several federal district courts have been faced with interpreting 35 U.S.C. § 102(g) in patent infringement suits. Thus far, every district court to apply section 102(g) in the context of an infringement suit has relied on the W.H. Brady Court’s interpretation of the temporal requirements on the act of abandonment that would prevent another’s prior invention from invalidating an issued patent under section 102(g).

This paper suggests that there exists strong and persuasive reasons to believe that these decisions have nevertheless been in error.

Accordingly, a litigant in a patent infringement suit, when evaluating the likelihood of prevailing in a dispute evaluated under section 102(g) should also consider whether other district courts can be persuaded to disregard the W.H. Brady Court’s interpretation of this statute, and interpretations of this statute should be made de novo by district courts facing this question in the future. Moreover, litigants and courts should consider whether the Federal Circuit Court is prepared to reverse future decisions concurring with the antecedent decisions addressing this issue and remember that the W.H. Brady decision is not binding precedent to any court, including the Federal Circuit.

III.  ALLEN V. W.H. BRADY

To understand the holding of the court in Allen v W.H. Brady it is necessary to understand the facts of the case.
Prosser, the patentee and the second plaintiff’s assignor, had invented a method of using a colorful plastic film to mark the location of underground pipes. The method reduces the likelihood that other excavators will later damage buried pipes. In the patentee’s method, frangible colored plastic film is used as a warning strip. The warning strip is added to soil used to backfill trenches in which utility pipes have been placed. If another worker later begins excavating soil located above the pipe, the colorful film is exposed, which warns the worker that a utility pipe is below the exposed warning strip.

Patentee Prosser was not the first, however, to invent this method. Rather, an inventor named Law had earlier filed a patent application claiming the same method. Prosser had independently made the same invention after Law. Applicant Law did not receive a patent for his invention, because of a third, earlier-filed application in the name of Allen. [8]

The Allen patent application was directed to a broader method that encompassed the method of Law and Prosser. Specifically, the Allen patent application claimed a method of placing a colorful substance in utility pipe backfill to serve as a warning indicator to later excavators. [9] But Allen could not have expressly disclosed or reasonably suggested the use of frangible plastic film as the colorful substance. [10] The Patent Office noted that the claimed subject matter of the Allen and Law applications overlapped and conducted an interference proceeding to determine priority of invention. [11] If Law had invented first, the broad claim of the Allen application would have been unpatentable under the well-established principle that a species anticipates a genus, and therefore, rendered claims to the genus unpatentable. The Patent Office instead found that Allen had invented first, which assuming that no other impediments to patentability existed entitled Allen to a patent on the broader claim.

Had Law’s applications met other requirements of the law, [13] Law could have obtained a patent limited to the use of frangible colored plastic. Instead of obtaining a patent narrowly directed to this improvement of Allen’s invention, [14] Law abandoned his patent application and never commercialized the claimed product.

Prosser filed his patent application before the Law application was abandoned. Prosser was awarded a patent for the use of frangible plastic film, presumably because (i) Allen’s application did not expressly teach or reasonably suggest Prosser’s (i.e., Allen’s abandoned) invention, (ii) Law’s application had been abandoned and therefore was not available to the Examiner in the prosecution of Prosser’s application, and (iii) because any commercial (i.e., public) use of Law’s invention did not occur in time to invalidate Prosser’s patent claims. Since Allen had learned of
the Law method from the Law application and desired to use that method, Allen entered a cross-licensed with Prosser’s assignee, Dow, both of which later sold frangible plastic warning strips commercially.

Having been sued for patent infringement under the Prosser-Dow patent, the Defendant (W.H. Brady) argued that the Prosser patent was invalid under 35 U.S.C. § 102(g). This statute states, in part, that an inventor is entitled to a patent unless (i) the invention was first invented by another (ii) who had not abandoned, suppressed, or concealed the invention (roman numerals added).

Clearly, Law had invented the patented invention before Prosser. However, Law appeared to have abandoned the invention. The Court invalidated Prosser’s patent holding that (perhaps erroneously) [15]the invention (in contradistinction to Law’s application) was not abandoned, stating

… the concept of abandonment contemplates a voluntary decision by the original inventor to terminate any effort to practice his conception. In some circumstances abandonment of a patent application by acquiescing in an adverse ruling by the Patent Office might amount to an abandonment of the invention, but certainly not in the circumstances disclosed by this record. For the invention itself had no more been abandoned than if Law had assigned his interest in it to Allen. The practical effect of the interference ruling was to give Allen, rather than Law, the opportunity to profit from Law’s idea. Since there was no abandonment of the invention, and since Law’s failure to participate in its exploitation was not voluntary, we do not believe he 'abandoned' his invention within the meaning of 102(g). [16]

If this position were correct, it would have been enough to decide the case. Moreover, the this paper’s thesis is not directed to the holding above. The court did not rest with this argument, but before making this holding explicates section 102(g). The court explained “[a]s we read this language, the abandonment is irrelevant unless it occurred ‘before the applicant’s invention.’ The use of the pluperfect tense -- ‘had not abandoned’ -- plainly refers to an abandonment which occurred ‘before the applicant's invention.’”

This paper will suggest that the explication of section 102(g) by the W.H. Brady Court is in error. Unfortunately, this explication has been followed by multiple district courts[17] without independent review. Importantly, the W.H. Brady decision is not binding on any court. Accordingly, the Federal Circuit can, might, and should correct this error at its first opportunity.
IV. OAK INDUSTRIES AND MULTIPLE OTHER DISTRICT COURT CASES HAVE FOLLOWED THE DICTA STATED IN ALLEN V. W.H. BRADY

The explication of section 102(g) has been adopted by multiple district courts. One court which adopted this explication was the Northern District of Illinois in Oak Industries, Inc. v. Zenith Electronics Corp [18] in which the court considered whether it could dispose of the case on either party’s cross-motion for summary judgment.

An issue before the Court in Oak Industries was whether a third party had abandoned, suppressed, or concealed its admittedly prior invention of a patented invention. The court noted that Defendant-Zenith would bear the burden to prove by clear and convincing evidence

The Court found itself unable to decide whether the third party had suppressed or concealed its invention. The third party had not filed a patent application which would have theoretically resulted in an interference proceeding between the third party and the plaintiff’s patentee, and might [19] have obviated any question of suppression or concealment of the invention. The third party had also entitled part of its work as the “Manhattan Project” which suggested to the court an air of secrecy that might imply an intent to suppress or conceal the invention. More importantly, actual evidence of public use and public disclosure of the third party’s invention was of such a nature that a reasonable jury could have found, but would not be required to find, an absence of clear and convincing evidence of suppression or concealment. Thus, the Court could dispose of the action only if the evidence was clear that the third party had abandoned the invention.

The Court found that the third party in Oak Industries had not abandoned the invention until after the invention by the patentee. Thus, unless the Defendant-Zenith was unable to show by clear and convincing evidence that the third party had not suppressed or concealed the invention, it would prevail at trial. As noted above, a reasonable jury could have decided that question either way.

The Court’s description of the third parties activities, however, suggest that the third party could not have abandoned its invention any later than 5 months after the patentee made its invention. Specifically, the parties had agreed that as a matter of law, the date on which the patentee had made its invention was November 4, 1965. Additionally, Defendant-Zenith was able to show that the third party had worked with its invention at least until November 22, 1965, but did not adduce any evidence of any activity involving the third party’s action past March of 1966 (which may have been merely to pay a debt incurred in the Fall of 1965). Thus, the Court
concluded that there was clear and convincing evidence that the third party had abandoned its invention no less than 18 days after the patentees invention, but not more than 5 months after the patentees invention.

Accordingly, the Oak Industries Court appears to have been able to disposed of the action on summary judgment if only it had not followed the W.H. Brady Courts explication of section 102(g). Instead the Court denied all motions for summary judgment regarding validity or invalidity. No other decisions involving this action were published suggesting that a settlement between the parties was subsequently reached. The question remains then, did the W.H. Brady Court correctly explicate section 102(g), or did Defendant-Zenith settle a claim pursuant to an inaccurate explication of the law?

V. THERE ARE FOUR GENERAL METHODS OF CONSTRUING STATUTES

At its essence, the question before the Court in W.H. Brady was one of statutory interpretation. Four general methods of interpreting statutes have been applied by the courts and advocated by scholars.

The first method, and the one which is least controversial is the “plain meaning” approach. Generally, if a statute has an unambiguous and plain meaning, there is general agreement that the statute should by interpreted to comport with that plain meaning. However, if such a plain meaning is absent, other means of interpretation must be applied.

The second method is the “legislative intent” approach. Under the legislative intent approach, the court is to determine what the legislature intended to make the law when the bill was enacted into law. The legislative intent approach has been criticized because __________

The third method is the “legislative purpose” approach __________

The fourth method is the __________.

The Rule in W.H. Brady does not comport with other explications of the patent laws. In this Subsection A, below, this paper suggests that the reasoning that the W.H. Brady Court applied was flawed. In Subsection B, below, this paper contends that it was both the intention and purpose of Congress to prevent an earlier invention from negating the right to a patent only when the public would have already received the benefit of the invention, thereby negating the basic quid pro quo underlying U.S. patent law. In Subsection C, below, this paper suggests that
rejecting the overly broad explication of section 102(g) still makes sense in the twenty-first century in view of the changes in our economy, the case law, and Congressional enactments, which have taken place since Congress enacted section 102(g).

Section 102(g) stated (and is not now substantially different for the purposes of this discussion) that “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.” [21]

The court in WH Brady stated “[a]s we read this language, the abandonment is irrelevant unless it occurred ‘before the applicant’s invention.’ The use of the pluperfect tense – ‘had not abandoned’ – plainly refers to an abandonment which occurred ‘before the applicant’s invention.” Thus, without announcing its methodology, the Court took a formalist approach that states (or alternatively, applied the cannon of statutory interpretation that states): “if the statutory language is unambiguous and the statutory scheme is coherent and consistent, further inquiry ceases.” [22]

Unfortunately, it is not possible to either reasonably assert that an unambiguous meaning of section 102(g) exists, nor that the meaning the W.H. Brady Court ascribed to section 102(g) results is a coherent and consistent statutory scheme. The statute contains at least three substantial sources of ambiguity.

First, it is not clear whether the words “had not” are to apply only to the verb “abandoned,” or also to the verbs “suppressed or concealed.”

Second, the grammatical relationship of the words “had not” to other verbs in the statute is not clear from the grammatical context of the sentence. That is, it is initially ambiguous whether the “another who had not abandoned” must have abandoned (i) “before the applicant’s invention,” as stated by the Court in W.H. Brady, (ii) “before the person shall be entitled to a patent,” or (iii) before some other event or condition that is implied, but not explicitly stated or identified within the statute.

A third source of ambiguity exists, which while less compelling than the first two sources is still significant. Section 102(g) uses the term “abandonment.” Unlike other areas of property law where “abandonment” is readily defined, the term “abandonment” has a multiplicity of meanings in patent law. Accordingly, it is not clear from the face of the statute what is meant by abandonment. These ambiguities are substantial enough to defeat any assertion of a plain
meaning for section 102(g), and require that a court engage in further inquiry into the meaning of 102(g).

Each of the sources of ambiguity identified above is further explored below.

This first question of grammatical relationship identified above asks whether the words “had not” should be applied only to the verb “abandoned,” or also to the verbs “suppressed or concealed.” The interpretation that “had not” applies only to the verb “abandoned” seems more appealing than the alternative at first glance. This is because the acts of suppression and concealment are continuing acts, which would necessarily become uses and disclosures when terminated. Since the Court viewed these acts as “plainly [referring] to acts which occurred ‘before the applicant’s invention’” [23] it would then be counterintuitive for Congress to negate the invalidating effect of a prior invention “unless” it had been publicly used or disclosed.

Nonetheless, the appealing nature of the conclusion that the words “had not” should be exclusively applied to the verb abandoned withers under even mild scrutiny. Adopting this interpretation and deleting the reference to “had not abandoned” would cause the statute to read: “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 suppressed or concealed it.” In this construction the double negation achieved by the combination of the words “unless” and “not” is lost. There is no apparent reason to support the view that Congress would have intended to disentitle an applicant to a patent when another first made the claimed invention and also suppressed or concealed it. In fact, under other circumstances the Federal Circuit court has already made abundantly clear that this statute has the opposite effect. [24]

Therefore, to the extent that a “plain meaning” of the statute can be asserted, it must be asserted that the words “had not” are to be applied to all three verbs: abandoned, suppressed, and concealed. Additionally, as the W.H. Brady court has stated, the use of the pluperfect tense requires that the events have occurred before applicant’s invention. This is a hard conclusion to accept. It is not difficult to imagine that Congress would punish an earlier inventor for not promptly delivering an invention into the public domain by allowing the economic advantage and personal prestige economic advantage of a patent to be conferred upon another. One could suppose that the statute would then be “plainly” read to mean that once an earlier inventor suppresses or conceals an invention, this earlier inventor cannot prevent the patent for the invention from being granted to another. This theory, however, requires that we totally ignore the public interest, which is plainly not permissible. This is necessary because 102(g) would
then countenance the patenting of material which was once freely accessible to the public. In addition to being unfair to the public, this is expressly contrary to the effect of sections 102(a) and (b).\[25\] Accordingly, to avoid an incoherent statutory structure, 102(g) must be interpreted such that the words “had not” have some effect on the verbs “abandoned, suppressed, or concealed,” other than those considered above. Consequently, the first grammatical question identified above bars employment of the “plain meaning” approach taken by the Court in W.H. Brady.

This second question of grammatical relationship identified above asks whether the abandonment, suppression or concealment must have had to occur before the (i) invention by the applicant, (ii) before the applicant is entitled to a patent, or (iii) before another event or condition? The Court in W.H. Brady concluded that the abandonment must have occurred before the invention of the applicant/patentee, as has been previously pointed out. This position is untenable.

The statute expressly refers to two events or conditions that could have a temporal relationship with the words “had not.” The first is the time of invention by the applicant, which, of course, was identified by the W.H. Brady Court. Another is the time at which entitlement to the patent is assessed (“A person is entitled to a patent unless – ”). There is no grammatical, nor plainly apparent, basis upon which to prefer one of these two choices.

There is a third option for assessing the time-point to which the words “had not” refer. Perhaps the best interpretation of the words “had not” is “didn’t.” That is, perhaps the form of a pluperfect verb was chosen merely because it sounded “more official” or “better” to a staff member assigned to the committee who drafted the statute or was charged with “cleaning up the statutory language.” This third option asks the reader to consider whether every person who has used the pluperfect tense in writing, or perhaps even only in statutes, has understood (i) that they had used the pluperfect tense, and (ii) how a grammarian (or judge) would construe a pluperfect verb to differ from other verb constructions. This seems far-fetched when one considers that the statute is drafted using “double negatives,” which many people believe are disfavored by grammarians. The use of the double-negative conditions of “unless” and “had not” itself introduces enough uncertainty into section 102(g) to cast a question over a Court’s ability to ascertain a plain meaning interpretation of the statute.\[26\] The failure to specify a referent for the verb “had not abandoned,” however, simply precludes a Court from being able to ascertain an unambiguous plain meaning for the statute.
Once it is assumed that the referent to “had not abandoned” could refer to an act that must have been completed before a person would be entitled to a patent, the ambiguities in the statute grow. Specifically, once we entertain this possibility, it then must be determined whether entitlement to a patent is to be determined: (i) at the time the prior invention becomes known to any of the applicant, the Patent Office, or a Court, (ii) at the time the patent is to be granted or finally denied, or (iii) at the time the patent is to be enforced.

Moreover, section 102 would be incoherent if the *W.H. Brady* Court were correct in asserting that abandonment is irrelevant unless it occurs prior to the invention of the applicant. As Professor Chisum has stated, this would be the only situation in U.S. patent law in which an inventor can be penalized for making an invention too soon. Section 102(g) governs Interference Proceedings in the Patent Office. In an Interference the Patent Office is to award priority of invention (i.e., the exclusive right to be granted a patent on a commonly claimed invention) to the first person to conceive of the invention and diligently reduce it to practice. This makes sense in that the public gives an inventor a patent incentive for being the first to make an invention and properly disclose it to the public. The second person gives the public nothing it does not already have, unless the first inventor failed to deliver it to the public. It would be a bizarre interpretation of section 102(g) to conclude then that a person is entitled to a patent if (i) he invented first, or (ii) he invented after “another,” but only if (a) the “another” abandons the invention, and (b) the later inventor does not invent too soon (i.e., before the “another” abandons). In other words, under the *W.H. Brady* Court’s view the statute would disentitle a person to a patent only when that person had made the invention in a narrow time frame (which in theory could be as short as one day) that is entirely unrelated to the *quid pro quo* between the public and the inventor, which underlies section 102.

Thus, there are at least two independent reasons why section 102(g) is not amenable to the plain meaning construction employed by the Court in *W.H. Brady*.

The third source of ambiguity in section 102(g) noted above is a consequence of the use of the term “abandonment.” In an ordinary legal sense, abandonment usually means that one person who had the legal right to use or possess property intended to renounce that right. The usual result is that another is free to take possession of the property, both legally and actually.

The term “abandonment” is not quite so clear under patent law. The first source of confusion is a minor one. Of course, a patent can be acquired by the filing of a patent application. But an abandoned patent application cannot be taken up by another. In fact, an
abandoned patent application has no effect except for the limited purpose of evidencing a date of invention by the applicant. [29] Abandoning a patent application does not itself even prevent an inventor from later re-applying for a patent and being granted a valid patent. [30] Rather another must independently meet all the requirements for a patent and file their own application. Thus, “abandonment” of a patent application is more akin to “destruction,” than to the common understanding of “abandonment.” The resolution to this first point is to understand that, although a patent application may preclude a legal finding of abandonment under section 102(g), abandonment of a patent application is not the same as abandonment of an invention. [31] Thus, the abandonment of an invention could conceivably be asserted to be limited to abandonment of a patent application directed to the invention, but must be construed more broadly.

A more serious ambiguity is introduced by contrasting section 102(g) with section 102(c). Section 102(c) reads “[a] person is entitled to a patent unless – (c) he has abandoned the invention.” [32] At first glance, these two sections comport well with each other. Section 102(c) prohibits the inventor who abandons the invention from obtaining a patent and 102(g) prevents a second inventor from obtaining a patent unless the first inventor “abandoned” the invention, and thus, did not receive a patent. “Abandonment” under 102(c), however, occurs when the inventor, by word or deed, intentionally relinquishes the right to obtain a patent. [33] For example, section 102(c) abandonment can occur if the inventor states that the invention is dedicated to the public. [34] In this case, an invention “abandoned” under section 102(c) would bar a later inventor from obtaining a patent under 102(g) (and possibly, but not necessarily, other paragraphs of section 102). Thus, adoption of any particular “plain meaning” with respect to the term “abandonment” under section 102, as a whole, leads to an incoherent statutory scheme.

Therefore, there are at least three independent reasons why section 102(g) is not amenable to the plain meaning construction employed by the Court in W.H. Brady. Accordingly, section 102(g) must be construed pursuant to less reliable and more extensive examination of the statute’s meaning.

B. Even Assuming a Plain-Meaning of Section 102(g) Could Be Identified, Binding Precedent Disfavors Such A Reading

Prior interpretations of section 102(g) made by the Federal Circuit en banc also weigh against a plain-meaning approach to interpreting this Statute. In Paulik v. Rizkalla, [35] the
Court interpreted section 102(g) in the context of an Interference Proceeding. The key question before the Court was whether a first inventor is legally prejudiced if he abandons his invention, and then seeks a patent on the invention before a second person independently makes the same invention.

Section 102(g) appears to disentitle an inventor to a patent if another first makes the invention and does not abandon, suppress or conceal. By rudimentary logic, if the only other to first make the invention does abandon, suppress, or conceal it, then the second inventor is entitled to the patent. Similarly, the first inventor would not be entitled to a patent on the same invention, because section 101, as well as strong policy arguments, prohibit the awarding of two patents for a single invention.

The question presented in Paulik was whether acts of abandonment, suppression, or concealment irreversibly disentitle the first inventor to a patent by impliedly irreversibly entitling a second inventor to the patent. In Paulik, Paulik made an invention, but later abandoned the invention. After a substantial period of delay, Paulik’s interest in the invention was rekindled and commenced preparation of a patent application. Six weeks later, Rizkalla began preparation of a patent application directed to the same invention. Even though Paulik was clearly a prior inventor who had abandoned, suppressed or concealed the invention, the Court declared that Paulik was entitled to the patent.

A vigorous dissent in Paulik, to which five of twelve judges subscribed, argued that the statute “speaks in clear, simple, prohibitory terms[; an] inventor who has "abandoned, suppressed, or concealed" his invention is not entitled to priority as against a subsequent inventor who has not engaged in that conduct.” That is, section 102(g) “does not contemplate or permit” an inquiry into equities. Rather, the plain-meaning of the statute required that Rizkalla be entitled to a patent thereby extinguishing the rights of Paulik.

The majority, for its part, did not engage in rigorous statutory construction to determine whether the statute contained an unambiguous, plain-meaning which would result in a coherent statutory scheme. Rather, the majority focused on the development of section 102(g) and gave effect to what it deemed to be the Congressional intent underlying the statute. The majority stated that section 102(g) was a codification of case law which had decided other priority questions on equitable grounds. The majority determined that the equities in this case aligned with Paulik. Thus, a majority of the Federal Circuit Court, sitting en banc, must have determined either that (i) interpretation of section 102(g) was not to be governed by a plain-meaning
approach or (ii) section 102(g) lacks an unambiguous meaning which gives rise to a coherent statutory scheme as applied to the facts of Paulik v. Rizkalla.

A concurring opinion in Paulik v. Rizkalla was filed by Judge Rich. Judge Rich stated that he had been a member of the committee that drafted the Patent Act, and that the committee had only meant to provide the Patent Office with the statutory authority to conduct interference proceedings consistent with the prior case law. Thus, if it is accepted at face value, Judge Rich’s concurrence lends strong support to the contention that the Congressional intent underlying section 102(g) was to advance the purposes of patent law as these purposes had been previously developed and exposed by the courts.

C. The Congressional Intent Underlying the Enactment of Section 102(g) Cannot Be Dispositive

There are strong arguments that courts should interpret a statute according to the best evidence of what the words of the statute would have been understood to mean by the Congress that enacted the statute when the plain meaning of a statute is not unambiguous, or does not lead to a coherent statutory scheme. That is, the courts should construe the statute in accordance with legislative intent. This approach gives effect to the decisions and intent of the Congress, which has the Constitutional authority to enact law, not the intent of judges.

It is not necessary for the purpose of this paper to decide whether this approach is superior to other methods of statutory interpretation when textualism fails, because it is clear that the Congress that enacted section 102(g) would have understood those words to accurately reflect the judicially developed doctrine explicating the purpose of patent law. First, it is a matter of stare decisis that what Congress intended was to codify the common law. In other words, the best guide to what Congress intended is the case law that Congress considered in enacting section 102(g). This case law, in turn, was presumptively developed with a view to the purposes of the Constitution and the existing patent laws. Thus, an extensive interpretation of section 102(g) should view Congressional intent as synonymous with the purposes of patent law.

Second, the cumulative effect of the three sources of ambiguities within section 102(g), identified above, make it exceedingly difficult to identify a Congressional intent. It may be possible to argue that Congressional intent can be identified with a significant degree of accuracy when a statute is vague for only one reason. In contrast, when a statute contains three sources of ambiguity and each source of ambiguity challenges the coherence of the statutory scheme as a
whole, then the difficulty of divining Congressional intent is so great that the reconstructor’s intent is too easily substituted for Congressional intent (assuming Congress actually had an intent). Of course, substitution of judicial intent for Congressional intent is a usurpation of the power conferred upon the Congress by the Constitution, which is to be avoided, and decreases the public’s difficulty of determining its rights and duties under the law in cases of first impression.

With respect to section 102(g), as noted above we cannot know if Congress intended to use the pluperfect tense, and if so, to what time frame it was to apply. Moreover, we cannot simply infer what Congress thought it meant by the term “abandonment” since the term is used in at least three different ways under the patent law, is used with an apparently different meaning in paragraph (c) of the same statute, and is used in conjunction with the words “suppression and concealment” that color the words in a way that appears to conflict with what at least one appellate court (the *W.H. Brady* Court) thought the words plainly meant. Therefore, even if we assume that Congressional intent differs from the purpose underlying the enactment of section 102(g), our best guide of Congressional intent remains the statutory purpose.

D. The Purpose Underlying Section 102(g) is to Motivate Progress and to Promote Consummation of the Patent Contract

The basic purpose of section 102(g) is easily surmised from the relatively few U.S. Supreme Court decisions addressing patent law. The purpose of the entire patent law is to promote progress in the useful arts and sciences.\[41\] The Constitution, by restricting the duration of grants of exclusive rights in inventions, balances the need to encourage innovation against the stifling of competition without a concomitant advance in the arts and sciences.\[42\] For this bargain to benefit the public, however, it is necessary that the public be enabled to practice the invention, and profit from its use, without restriction.\[43\] Thus, it is clear from the most fundamental (i.e., Constitutional) principles of patent law that the phrase “who had not abandoned, suppressed, or concealed the invention” refers to a first inventor who failed to secure the benefit of the invention to the public.

The purpose of this phrase within section 102(g) is confirmed by judicial explications of patent law. In this regard, a House Report commenting on section 102(g) stated that the law "retains the present rules of [the case] law governing the determination of priority of invention."\[44\] Thus, interpretation of section 102(g) should comport with case law developed prior to Congress’ enactment of this statute.\[45\]
Congress’ understanding of the case law preceding the enactment of section 102(g) is concisely and well explained by the majority opinion in Paulik v. Rizkalla, and by the concurring opinion of Judge Rich in that case. Accordingly, this paper will not paraphrase these opinions, but will focus on the extent to which these opinions are applicable to the question at hand.

First, of course, it is useful to point out the obvious fact that the *W.H. Brady* Court did not have access to the Federal Circuit’s opinion in *Paulik* because the former was written a decade before the latter. Therefore, the *W.H. Brady* court could not have considered and disregarded as irrelevant or non-controlling the dictum contained in *Paulik*.

The *Paulik* Court agreed with the dissent that “too long” a delay between making an invention and in either commercializing the invention, or in filing a patent application, gives rise to a legal inference of suppression and concealment. [46] This was well settled by the case law prior to *Paulik*. [47] The *Paulik* Court also held that an earlier inventor is not prejudiced by the earlier conception and suppression or concealment such that if the earlier inventor pursues a patent by taking filing a patent application before a second inventor independently makes the invention, the first inventor is entitled to the patent. [48] The *Paulik* decision is thus applicable to suppression and concealment, and arguably not abandonment, which was the subject of the *W.H. Brady* decision. *Paulik*, therefore, does not clearly overrule the *W.H. Brady* decision. Nonetheless, the reasoning applied by the *Paulik* Court is applicable here.

A foundational case underlying the enactment of section 102(g) was Mason v. Hepburn. [49] In *Mason*, the first inventor had done nothing with his invention for the seven years. This first inventor, however, learned that another had patented the same invention, and “spurred” by this news, filed a patent application of his own. In an interference to determine priority of inventorship, the Court held in equity, that because the public might not ever have gained the benefit of the invention but for the actions of the second inventor, the first inventor was not entitled to a patent. Of course, in view of Paulik v Rizkalla, we can now amend this holding to state “unless the first inventor took renewed interest in his invention, prior to the second inventor’s conception of the invention.” But the main point of this early case that Congress intended to encompass in section 102(g) is that an invention by another who does not take any steps to confer the benefit of his invention on the public (“abandoned, suppressed, or concealed?”) does not prevent another from taking advantage of the bargain offered by patent law.

Similarly, in Woofter v. Carlson, [50] a first inventor’s eight-year delay forfeited his right to a patent, because he was spurred into action by learning of a second inventor’s filing of a patent
application. [51] Again, the law favored the one who brought the invention to the public and sought to accept the *quid pro quo* embodied in the patent act.

Moreover, it is impossible to find in *Mason* or *Woofer* any support for the proposition that Congress had as an intention or purpose the idea that a second inventor would only be entitled to a patent when a first inventor had abandoned the invention before the conception or application of the second inventor. Rather, *Mason* and *Woofer* support the proposition that the timing of abandonment (or suppression or concealment) is irrelevant.

The Federal Circuit Court in the examining the meaning of the terms “suppressed” and “concealed” has also indorsed the idea that the “had not …” phrase of section 102(g) is an expression of the condition that a first inventor had not in some way given the public possession of the invention. In Correge v. Murphy, [52] the Federal Circuit Court quoted with approval International Glass v. United States. [53] “The courts have consistently held that an invention, though completed, is deemed abandoned, suppressed, or concealed if, within a reasonable time after completion, no steps are taken to make the invention publicly known.” [54]

Another judicially identified purpose of section 102(g) is "encourages prompt disclosure of an invention by penalizing the unexcused delay or failure of a first inventor to share the "benefit of the knowledge of [the] invention' with the public after the invention has been completed." [55] But, as is made clear by *Mason* and *Paulik*, this penalty only applies when a second inventor independently makes the same invention. The penalty is two-fold. First, the second inventor can use the invention without restrictions imposed by a patent to the first inventor. Second, the second inventor may gain a superior right to patent the invention, and under some circumstances, prevent the original inventor from using the invention. This prompt-disclosure purpose is not furthered by a rule that makes abandonment by a first inventor relevant only if it happens prior to the independent invention of a second inventor. In contrast, the prompt-disclosure purpose is furthered by allowing inventors the right to seek patents where prior inventors have not shared the benefit of the invention with the public regardless of the timing of abandonment, suppression or concealment by others.

E. Dynamic Interpretation of Section 102(g)

Some scholars have argued that statutory interpretation should be dynamically adapted for changing legal and economic conditions. [56] Even if it is assumed for the sake of argument that dynamic statute interpretation is the best method of statutory interpretation, the time-dependent interpretation of *W.H. Brady* should still be discarded.
Two conditions that might be relevant to a dynamic interpretation of section 102(g) are the accumulation of positive citations to *W.H. Brady*, and the passage of the American Inventors Protection Act.

At footnote 17 above, this paper identifies a collection of cases that have taken the dictum from *W.H. Brady* as a dispositive explication of the “had not …” phrase of section 102(g). Importantly, some of these cases were decided after the inception of the Federal Circuit Court in 1982. Arguably then, the courts might not fairly depart from the *W.H. Brady* rule in the interest of public notice and *stare decisis*. Such an argument fails on mild scrutiny.

The *W.H. Brady* was based on a plainly false premise and no court citing the *W.H. Brady* rule has purported to independently evaluate the reasoning employed by the *W.H. Brady* Court. [57]

Second, the *W.H. Brady* decision has never been affirmed by another appellate court. Under our multi-jurisdictional system of law it is reasonable to expect differences of opinion between appellate courts. With only one appellate court having taken the position that the *W.H. Brady* Court took, one cannot argue that the issue is well-settled. Moreover, the 7th Circuit which decided *W.H. Brady*, no longer has appellate jurisdiction over patent cases.

Third, tension between *W.H. Brady* and other decisions of the Federal Circuit has been noted by at least one district court. In Roberts v. Sears, Roebuck & Co., [58] the Court noted that the *W.H. Brady* decision might conflict with In re Costello as to whether abandoned patent applications might ever be prior art. [59] In fact, if an unambiguous meaning for the “had not” phrase which leads to a coherent statutory scheme is not available, then the *W.H. Brady* decision conflicts with a substantial body of case law including *Paulik, Costello*, and *International Glass*.

Thus, for at least three reasons, the principle of *stare decisis* does not support adherence to the *W.H. Brady* rule.

The Congress recently re-drafted section 102(g). The changes are contained in the American Inventors Protection Act. [60] While these amendments do not appear to affect the proper interpretation of 102(g) with respect to the *W.H. Brady* decision, they were accompanied by the Business Methods Prior User defense. [61] This law allows prior users of a business method limited immunity from infringement suits when a patent covers a method which the user has been continually using since more than one year prior to the patent applicant. Implicitly, this
act assumes that the first user of the “business method” did not publicly use the invention (i.e.,
bring the benefits of the invention to the public) because in that case the use would constitute an
absolute bar to patentability of later users under 35 U.S.C. § 102(b). However, the defense is lost
if the prior user abandons the use of the method at any time after the critical date one year prior
to the patentees date of application.

Thus, the business method defense contemplates a patentee bringing an infringement suit
against a defendant who had “abandoned” the inventive method after the date of a second
inventor/patentee’s invention. This is, of course, a result completely contrary to the
interpretation of the W.H. Brady Court.

Similarly, the business method defense is a highly limited defense, which provides prior
users protection from infringement suits, but only if the prior user continuously uses the method
and only to the extent to which the method had previously been in use. Thus, abandonment
should be treated similarly to suppression and concealment in which as the CCPA’s decision in
Palmer v. Dudzik made clear, is evaluated by asking whether the public has gained knowledge of
the invention which will insure its preservation in the public domain. [62]

[1] For example, an inventor has a full year to file a patent application on an invention after that invention has been
disclosed publicly (whether by the inventor or a third party). 35 U.S.C. § 102(b).


[3] United States Constitution, art. I, § 8, cl. 8 (“To promote the Progress of Science and useful Arts, by securing
for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries”).


[5] 35 U.S.C. § 102(g) as it currently reads is quoted in footnote 20. Although the current form of this statute is
different than it existed in 1974, the amendments to the statute were not intended to modify the Brady decision, and
there is no reason readily apparent as to why one would conclude that these statutory amendments would affect
future reliance on Brady.


[8] Although Allen’s name appears in the caption of this case, this case deals with a patent issued to one Prosser and
assigned to Dow. Dow and Allen entered into a cross-licensing agreement and both parties sued the W.H. Brady
company for patent infringement. The subject case focuses on the validity of the Prosser-Dow patent and not on the validity of the Allen patent. Allen v W.H. Brady, 508 F.2d 64, passim (7th Cir. 1974).

[9] Since frangible, colored plastic is, in fact, a colored substance, the Patent Office construed the invention claimed by Allen to cover the invention claimed by Law, and which was later claimed by Allen. On the other hand, there is no clear reason why the use of colored sand or gravel should be deemed to teach or reasonably suggest the use of frangible colored plastic. Accordingly, Allen’s claimed invention would cover the use of Law’s invention, but not necessarily bar patentability of Law’s invention. Conversely, if Law was first to invent, then a species of the genus claimed by Allen would be anticipated, and therefore, unpatentable.

[10] This follows à fortiori from the later award of a patent to Prosser for the same subject matter. Clearly, the Allen patent being prior art to Law was prior art to Prosser. Therefore, had Allen barred patentability to Law, then Allen would have also barred patentability to Prosser. Had that been a possibility, the focus would of the Allen v W.H. Brady suit would have been the status of the Prosser patent in view of Allen (not Law) under 102(g) (as well as 102(a) and (b)).

[11] An interference proceeding is an administrative proceeding to determine which of two or more applicants was first to invent subject matter commonly claimed by the applicants. The first inventor is entitled to a patent covering the commonly claimed subject matter. Inventors determined to have invented later must amend their patent claims so that they do not cover (or “read upon”) the disputed subject matter, or abandon their application. Citation. The Patent Office gains authority to conduct such interferences pursuant to the second sentence of section 102(g), which is not the focus of this paper. 35 U.S.C. § 102(g).

[12] Anticipation is a term of art in patent law. The legal right to exclude others is determined by the claims of a patent. If a patent claim “covers” or “reads upon” an item or method that existed before the invention was made by the patentee or patent applicant, then the pre-existence of that item “anticipates” the claimed invention. By definition then, anticipation destroys the novelty of the claimed invention, and renders the claim unpatentable and/or void.

[13] For example, having an adequate written description as required under 35 U.S.C. § 112, Law would in theory have been able to obtain claims directed to the use of frangible colored plastic, which appears to be superior to the use of colored gravel or sand based on the observation that Allen eventually used that method in preference to the examples of colored substances (e.g., gravel) disclosed in his application.

[14] The author doesn’t mean that Law was aware of Allen’s invention prior to filing his application. Rather, the author merely means that Law’s method accomplished the same goal as the Allen invention, but apparently used material not contemplated by Allen and superior to that contemplated by Allen.

[15] The Courts conclusion was erroneous for two reasons. First, an applicant is not compelled by law to abandon a patent application merely as a result of losing in an interference proceeding. Rather, the applicant must amend his claims to surrender the subject matter which the Patent Office has determined that he did not first invent. 37 C.F.R. 1.633 (2000), MANUEL PATENT EXAMINING PROC. § 2363.03 (2000). Second, the Court does not explain why the character of the Patent Office’s proper refusal to grant a patent because yet another invented the claimed subject matter before the applicant changes merely because the prior invention of another is documented in a pending patent application instead of a some other document. The reason, if any, for this conclusion is not apparent.

[16] W.H. Brady, 508 F.2d at 67. An invention (as opposed to a patent application or right to a patent) is not abandoned if it is transmitted to the public in such a manner as to preserve public knowledge of the invention. See, International Glass Co. v. United States, 408 F.2d at 402-03, 159 U.S.P.Q. at 440 (Ct. Cl. 1969), Palmer v. Dudzik, 481 F.2d at 1387, 178 USPQ at 616 (C.C.P.A. 1973). Other than the Court in W.H. Brady, no court has ever determined if disclosure of an invention to an opponent in an interference proceeding is legally sufficient to secure knowledge of the invention to the public. In this regard, the W.H. Brady Court concluded without explaining its reasons that the benefit of Law’s invention, which Allen did in fact later commercialize, had been transferred to Allen, and thus, the public.
In distinct contrast, the courts often recite that an abandoned patent application is ineffective for any purpose except as evidence of the date of a patent applicant’s invention. In re Costello, 717 F.2d 1346, 1350 (Fed.Cir.1983) (calling rule well settled); but see, 37 C.F.R. § 1.114 (2000) and In re Heritage, 189 F.2d 639 (C.C.P.A. 1950) (abandoned applications cited by issued U.S. patents and incorporated by reference are prior art); additionally patent applications abandoned in favor of continuing patent applications are not deemed abandoned for this purpose. See, In re Switzer, 77 U.S.P.Q. 1 (C.C.P.A. 1948).

[17] See, Cosden Oil & Chem. Co. v. American Hoechst Corp., 543 F.Supp. 522, 537 (D. Del. 1982)(constructive abandonment of patent application after fourteen years of prosecution not relevant because it occurred after invention of patentee) note, however, the Cosden Court probably erred in that constructive abandonment is probably always relevant when it is the only means by which an invention is disclosed to the public or used in public. Also, see, Ballas Liquidating Co. v. Allied Indus. of Kan., 205 U.S.P.Q. 331, 348 (D. Kan. 1979)(abandonment of the inventive device which did not occur until after commencement of suit was irrelevant because it occurred after invention by second inventor, notwithstanding earlier abandonment of patent application directed to same); System Management Arts v. Avesta Technologies, 54 U.S.P.Q.2d 1239, 1245 (S.D.N.Y. 2000)(evidence that first inventor abandoned computer software product after patentee’s invention is irrelevant with respect to section 102(g)); Oak Indus. Inc. v. Zenith Electronics Corp., 726 F.Supp. 1525, 1533(N.D. Ill. 1989)(Use of patented device in homes of consumers after invention by patentee made irrelevant any subsequent abandonment of invention by third party); General Motors Corp. v. Toyota Motor Co., 467 F.Supp. 1142, 1168 (S.D. Ohio 1979), rev’d on other grounds; Swift Agric. Chem. Corp. v. Farmland Indus. Inc., (abandonment of patent application disclosing invention irrelevant because abandonment followed lost interference proceeding with a third party and occurred after invention by patentee in suit).

[18] 725 F.Supp. 1525, 14 U.S.P.Q.2d 1417 (N.D. Ill. 1989). Although the Northern District of Illinois is ordinarily bound by 7th Circuit decisions, appellate jurisdiction for all matters involving a substantial question of patent law has resided in the Federal Circuit since its inception in 1982. However, the Federal Circuit has never explicated section 102(g), and thus, the N.D. Ill. was able to view the W.H. Brady decision as persuasive legal authority.

[19] If timely filed.

[20] The statute now reads: “A person shall be entitled to a patent unless – (g)(1) during the course of an interference conducted under section 135 or section 291, another inventor involved therein establishes, to the extent permitted in section 104, that before such person’s invention thereof the invention was made by such other inventor and not abandoned, suppressed, or concealed, or (2) before such person’s invention thereof, the invention was made in this country by another inventor who had not abandoned, suppressed, or concealed it. In determining priority of invention under this subsection, 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.” 35 U.S.C. § 102(g) (2000)


[22] Robinson v. Shell Oil Co., 519 U.S. 337, 340 (1997) (holding that the term “employee” as used in the definition of a “qualified person” under the Americans with Disabilities was ambiguous as to whether the term covers retirees.)


[25] Recite 102(a) and (b) and explain. Of course, section 102(g), in fact, probably was intended to negate entitlement to a patent under circumstances distinct from those covered by paragraphs (a) and (b); otherwise, paragraph (g) would be mere surplusage. Nonetheless, such an interpretation would not resonate well with accepted interpretations of paragraphs (a) and (b).
Perhaps the statute could have been drafted thus: “A person shall be entitled to a patent unless—

the invention was first invented by another. This paragraph shall not serve to disentitle a person to a patent if an earlier inventor failed to disclose the invention to the public in a timely manner, either through an informing use or through the filing of a patent application, which if abandoned was first published, or (possibly) of which the public could have enjoyed the use of by way of a non-informing public use in an economically meaningful way. In determining priority of invention …”. Of course, this would require that the committee responsible for drafting the statute even conceived of the use of the statute outside the scope of an Interference Proceeding in the Patent Office. There is substantial and credible evidence that this may not have been the case. See note 6, supra.

Chisum Citation.

See, In re Katz, 687 F.2d 450, 454 (C.C.P.A.1982).

See, In re Costello, 717 F.2d 1346, 1350 (Fed. Cir. 1983).


See, Roberts v. Sears, Roebuck & Co., 665 F.Supp. 671, 675 (N.D. Ill. 1987). Although this paper is critical of the W.H. Brady the author agrees that the Court reached the proper decision, but by the wrong means.


This need not be an altruistic or irrational act. The inventor may have an interest in dedicating an invention to the public in support of an effort to have use of the invention adopted as a matter of regulatory law. Public interest would certainly not be served if the inventor implied to regulators and the public that the public could have free access to his invention, and at the same time obtained a patent through secret proceedings in the Patent Office.

760 F.2d 1270, (Fed. Cir. 1985)

See, Paulik, 760 F.2d at 1285.

See, Paulik, 760 F.2d at 1285.

But see, the concurring opinion of Chief Judge Markey, “A literal reading of § 102(g) is not here involved. That statute says not a word on whether a suppression or concealment can or cannot be cured before the filing date of another. The court is therefore presented with a choice.” Paulik, 760 F.2d at 1283. Yet, Chief Judge Markey’s interpretation may not be as sound as that of the dissenting judges. Under Chief Judge Markey’s interpretation every prohibited or disfavored action mentioned in a statute would require Congress to state, “… and this behavior may [or may not] be cured.” This may be too high a burden to place on Congress, and statutory interpretations reaching this point could be assailed as invading the province of Congress.

See, _________________; See also, Richard A. Posner, Legal Formalism, Legal Realism, and the Interpretation of Statutes and the Constitution, 37 CASE W. L. REV. 179, 190 (1986-87).

[41] See, United States Constitution, Art. I, § 8, cl. 8 (“To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.”) (italics added).


[45] The cited House Report said that Section 102(g) preserves the law regarding priority of invention, and this paper has focused on invalidation of patents where an issue of priority is not involved. While this distinction may not be important to some readers, patent law scholars will note that it is not unreasonable to distinguish determinations of priority from the use of the same statute to invalidate a patent. The distinction, however, is one without a difference. First, Judge Rich in his concurring opinion in Paulik, argued that Congress had no other intention or purpose than to give the Patent Office statutory authority for conducting interference proceedings. Paulik, 760 F.2d at 1276. Because no court has refused to invalidate a patent under section 102(g) when appropriate we must assume that the Congressional intent and the Congressional purpose in enacting section 102(g) is the same with respect to both interference proceedings and patent validity challenges. Second, as is shown infra, the concepts underlying the “had not abandoned…” phrase of section 102(g) are equally applicable to interference proceedings and patent validity challenges.

[46] See, Paulik, 760 F.2d at 1284.

[47] Id.

[48] Id., at 1276.


[51] Id., at 448.


[53] See, 408 F.2d 395,403 (Ct. Cl. 1968).

[54] See, Paulik, 760 F.2d at 1283 (Additional remarks of Chief Judge Markey) quoting International Glass.


[56] See, ESKRIDGE.

[57] See, the cases cited at note 17, supra.


[60] CITE.

[61] CITE.