

GOLDEN GATE UNIVERSITY LAW REVIEW

VOLUME 16, NUMBER 2 SUMMER 1986

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ARTICLE

STATUTORY INVENTION REGISTRATION: DEFENSIVE PATENTABILITY

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I. INTRODUCTION

Congress recently enacted legislation that provides for Statutory Invention Registration (SIR) as an alternative for an inventor who does not want to obtain a patent.¹ To obtain a SIR, an inventor must file a complete application for a patent accompanied by a waiver of the rights obtained under a patent grant.² This waiver of rights takes effect when the SIR is published and leaves the inventor with only defensive protection.³ The inventor completely loses his offensive rights, i.e., the right to exclude others from making, using, or selling the invention.⁴

In exchange for an inventor's right to exploit his invention, the SIR program provides the inventor with an abbreviated prosecution process which is more expedient and less costly. The SIR program also replaces the Patent and Trademark Office's

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1. 35 U.S.C. § 157 (Supp. 1985).

2. *Id.* § 157(a)(3).

3. *Id.* § 157(b).

4. *Id.* § 112 (1984). *See also id.* § 154.

(PTO) Defensive Publication Program,⁵ and provides an effective reference date equal to the date the SIR application is filed instead of the date the SIR is published. The SIR program will, therefore, be of considerable benefit to governmental agencies and organizations who publish research results for defensive purposes, but of little benefit to individuals and organizations who seek commercial profit from their inventions.

II. BACKGROUND

Multi-faceted organizations with research facilities, particularly governmental agencies, large corporations, and universities, frequently require the defensive protection granted under the patent laws, but do not wish to spend the time and the money required to obtain a patent. This situation usually occurs when research has resulted in a patentable invention that is of limited commercial value, or an organization, particularly a governmental agency, decides that it is unlikely that the rights obtained under a patent against an infringer will be enforced.⁶ This, however, creates a dilemma for the organization if it decides not to obtain the patent. Another independent inventor may discover the invention, obtain a patent, and require the organization to pay royalties to the patent holder for the use of the invention. This means that the organization must pay royalties for the invention that it has spent the time, money, and resources to develop.

Solutions to this dilemma generally involve publishing the details of an invention in technical disclosure bulletins, publishing a journal article describing the research, or using the Defen-

5. 37 C.F.R. § 1.139 (1985).

6. See generally 41 C.F.R. §§ 101-4.100—4.105. It is the policy of the United States to grant, through the appropriate agency, nonexclusive, royalty free licenses to all government owned inventions upon request. Such licenses are revocable either upon the failure of the licensee to market the invention within a reasonable period or to report on its utilization. If after the invention has been published as available for licensing on a nonexclusive, royalty free basis for a period of at least six months, no such licenses have been granted, and utilization is believed not to exist, the invention will then be offered to the general public on an exclusive license basis for a limited period, not to exceed five years, unless the head of the government agency involved determines on the basis of a written submission supported by a factual showing that a longer period is reasonably necessary to permit the licensee to enter the market and recoup his reasonable costs in so doing. *Id.* See also 35 U.S.C. §§ 208-209 (1984 & Supp. 1985) (regulations and restrictions on federal licensing).

sive Publication Program⁷ provided by the PTO. Publication of an invention and placing the details of how to make and use the invention into the public domain should prevent other inventors from patenting the same invention, and therefore, solve this problem.⁸ These solutions, however, have limitations, and do not completely protect an invention from exploitation by others.

Publication in a scientific journal by an inventor is limited because a published article may not disclose how to make and use an invention as required by the patent laws.⁹ A publication which does not contain sufficient technical information to enable a skilled artisan, working at a point in time preceding an inventor's invention date, to make and use an invention without having to perform extensive experimentation, will not prevent others from patenting the same invention.¹⁰ The journal article, usually prepared by the inventor, is generally not reviewed by a patent attorney before publication; this review would ensure that the disclosure is sufficient to prevent patentability by other inventors working independently who discover the same invention. Similarly, the journal article is not reviewed by the PTO and has not had patentability tested in the prosecution process. An inventor cannot, therefore, predict how a publication will be

7. 37 C.F.R. § 1.139 (1985).

8. 35 U.S.C. § 102(a),(b) (1984). "A person shall be entitled to a patent unless . . . the invention was described in a printed publication in this or a foreign country." *Id.*

9. *Id.* § 112.

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Id.

10. *Id.* The "enabling disclosure" requirement may be stated as follows: To be anticipatory of a claimed invention, a reference (1) must contain sufficient technical information to enable a person of ordinary skill in the art to which the claimed invention pertains to make and use the claimed subject matter, without first having to perform extensive experimentation or make an unobvious contribution, and (2) must furnish such information at a point in time preceding the applicant's date of invention (or more than one year prior to the applicant's effective United States application filing date). *See, e.g., In re Smith*, 481 F.2d 910 (1973) (35 U.S.C. § 112 requires that the claimed invention must be both described in, and enabled by, the disclosure; if both of those requirements are satisfied, and the best mode is set forth in the application, the disclosure is sufficient under § 112 no matter how broad or narrow the claimed invention may be).

viewed by the courts when they evaluate the publication as prior art.

Technical disclosure bulletins, in contrast, are prepared for the purpose of disclosing technology to the public, thus preventing others from obtaining a patent on the same subject matter. The articles are generally prepared or reviewed by a patent attorney to guarantee that the disclosure requirements of the patent laws are satisfied.¹¹ The bulletins, however, are neither reviewed by the PTO in the prosecution process nor can an inventor predict how courts will view the information disclosed in the bulletin, particularly as prior art.

Journal articles and technical disclosure bulletins are also limited in that they become effective references only on the publication date. A patent, in contrast, has an effective reference date equal to its filing date even though the contents of the patent are not disclosed to the public until the patent is granted and published by the PTO, typically twelve to twenty-four months after the filing date.¹² An inventor working independently who reduces his invention to practice during this period, will not be able to obtain a patent even though it is impossible for the inventor to learn about the other patent application.¹³ In addition, a patent applicant can obtain a patent by "swearing behind" publication references. This process involves filing a declaration showing that the applicant made the invention before the invention is disclosed to the public, even if the reference was published before the applicant filed for a patent.¹⁴

Consequently, a prior inventor who conceives of an invention before a journal article or technical disclosure bulletin's publication date, diligently reduces the invention to practice, and files a patent application, can obtain a patent even if the same invention has been made previously by the journal article author.¹⁵ The inventor who publishes his invention, however,

11. 35 U.S.C. § 112 (1984).

12. 37 C.F.R. § 1.53(b) (1985).

13. 35 U.S.C. § 122 (1984).

14. 37 C.F.R. § 1.131 (1985). If the article was published more than one year before the filing date, the application is barred under 35 U.S.C. § 102(b) (1984).

15. 35 U.S.C. § 102(e) (1984).

A person shall be entitled to a patent unless . . . the invention was described in a patent granted on an application for patent

must rely on the publication date since the reference cannot be used to establish an invention date prior to publication. This distinction between publications and patent applications, with patent applications obviously being favored, led the PTO to establish the Defensive Publication Program in an effort to solve the dilemma facing an inventor who does not want to seek a patent.

The PTO Defensive Publication Program¹⁶ was intended to provide an inventor with defensive rights similar to those provided by the SIR program. The defensive publication, generally prepared by an attorney and reviewed by the PTO, was intended to establish a prior art reference with an effective date equal to the filing date for the publication, not the publication date. The use of defensive publication as a prior art reference has, however, been limited by the courts. In *Ex parte Osmond, Smith, and Waite*,¹⁷ the Board of Appeals decided that the ef-

by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirement of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent. . . .

Id. See also *Alexander Milburn Co. v. Davis-Bournonville Co.*, 270 U.S. 390 (1926).

16. 37 C.F.R. § 1.139 (1985).

17. 191 U.S.P.Q. 334 (Bd. App. 1973) (BNA). See also *Ex parte Osmond, Smith, and Waite*, 191 U.S.P.Q. 340 (Bd. App. 1976) (BNA).

In order for a rejection under 35 U.S.C. 102(g) to be sustainable, the evidence presented by the Examiner must establish at least prima facie, that the invention was made in this country by another before the invention thereof by the applicant. The making of an invention involves two acts; the mental act of conceiving the invention, and the physical act of reduction to practice. The reduction to practice may be actual or constructive.

The key evidence held relied upon by the Examiner with respect to substantiating his position under 102(g) is the Jacobson Defensive Publication as amplified by the application from which the publication stemmed. The Jacobson application here relied upon, as noted above, is an abandoned application. There is no evidence that the subject matter of that application has been carried forward to any application which is now pending or to an issued patent and which can trace its pendency back to copending with the abandoned Jacobson application. Indeed, such a pending application or issued patent would be inconsistent with the Defensive Publication Program. Nor is there any evidence of record that the subject matter of the Jacobson application was actually reduced to practice. (Emphasis in original.)

fective date of a defensive publication as a reference is the date upon which a document is published, not the filing date of the application. The court stated:

A Defensive Publication is not a patent
A Defensive Publication is in reality no more than a publication, and as such, cannot be effective to defeat another's right to a patent prior to its publication date. The application forming the basis of the publication is not available to the public until the date of the publication of the abstract
Therefore, there does not appear to be any legal foundation for making the publication retroactively effective to defeat another's right to a patent.¹⁸

The court ruled that, "[T]he disclosure of a Defensive Publication application is not available as evidence of prior knowledge as of the filing date of the application."¹⁹

This decision was upheld and explained in *Ex parte Smolka and Schwuger*.²⁰ The court stated:

We call attention to the decisions by the Board of Appeals in the case of *Ex parte Osmond* (citations omitted), which concerned rejections made under 35 U.S.C. 102(a) and (g) with respect to the effective date of a Defensive Publication as a reference. In each of these cases, the Board of Appeals held that the effective date of the Defensive Publication as a reference, *at best*, is the date upon which the document was *published*, and not the filing date of the application from which the publication stemmed.²¹

This determination, in effect, gives the defensive publication the same status as a journal article or a technical disclosure bulletin. Conceivably, an inventor could be in a worse position if it took longer to prosecute the application as a defensive publication in

Ex parte Osmond, 191 U.S.P.Q. at 341-42 (1976).

18. *Ex parte Osmond*, 191 U.S.P.Q. at 337 (1973).

19. *Id.* at 338.

20. 207 U.S.P.Q. 232 (Bd. App. 1980) (BNA).

21. *Id.* at 235 (emphasis added).

the PTO than it would to get a journal article or a technical bulletin published; this is so because the publication date is the date the material becomes an effective reference to prevent others from patenting the same invention.

Therefore, an inventor is left without an effective method of protecting his invention unless he wants to wait for the publication of technical disclosure bulletins, journal articles, or defensive publications, or spend the time and money to file a patent application and obtain a reference date as of the application filing date. The dilemma faced by an inventor, under these circumstances, exemplifies the problems and limitations that SIR is intended to overcome.

III. STATUTORY INVENTION REGISTRATION

SIR overcomes the problems with technical disclosure bulletins, journal articles, and PTO defensive publications, by providing an inventor with an abbreviated procedure for disclosing his invention to the public which gives the inventor a reference date equal to the filing date, not the publication date.²² SIR also provides for review by the PTO and, in general, should be prepared by a patent attorney in the same manner as a patent application. SIR offers a procedure for obtaining defensive protection for inventions by giving an inventor the same defensive rights as does a patent; other individuals are prevented from patenting the invention. SIR does not, however, allow an inventor to exclude others from making, using, or selling the invention.²³

A. PROCEDURE FOR OBTAINING A SIR

The procedure used to obtain a SIR will depend upon

22. 37 C.F.R. § 1.53(b) (1985).

23. 35 U.S.C. § 111 (1984).

Application for patent shall be made, or authorized to be made, by the inventor, except as otherwise provided in this title, in writing to the Commissioner. Such application shall include (1) a specification as prescribed by section 112 of this title; (2) a drawing as prescribed by section 113 of this title; and (3) an oath by the applicant as prescribed by section 115 of this title. The application must be accompanied by the fee required by law.

Id. See also *id.* § 154 (1984) (contents and term of patent).

whether an application is originally filed as a SIR or converted to a SIR during prosecution, and whether the PTO accepts the original application as filed or requires an applicant to amend his application before publication.

1. *Filing*

An inventor who wishes to have his invention protected by a SIR must file a complete application for a patent including the specification, drawings, oath, and fee.²⁴ An inventor must also file a request that the application be examined as a SIR along with a waiver of the right to enforce patent rights.²⁵ The waiver of the right to enforce a claimed invention will only become effective at the time the SIR is published.²⁶ Until the SIR is published, the application essentially remains an application for a patent. An applicant, therefore, has an opportunity to obtain a patent if circumstances change after the application is filed but before the SIR is published.

An applicant can change his mind and convert the SIR to a patent by abandoning the original application and filing a continuation or continuation in part application,²⁷ and a petition to withdraw the request for a SIR.²⁸ An applicant gets the benefit of the filing date of the SIR for the matter disclosed therein. A

24. *Id.* § 157(a) (Supp. 1985).

Notwithstanding any other provision of this title, the Commissioner is authorized to publish a statutory invention registration containing the specification and drawings of a regularly filed application for a patent without examination if the applicant—

- (1) meets the requirements of section 112 of this title;
- (2) has complied with the requirements for printing, as set forth in regulations of the Commissioner;
- (3) waives the right to receive a patent on the invention within such period as may be prescribed by the Commissioner; and
- (4) pays application, publication and other processing fees established by the Commissioner.

Id.

25. *Id.* § 157(a)(3).

26. *Id.* § 157(b).

27. *Id.* § 120. See generally 37 C.F.R. §§ 1.60, 1.62. See also *Bendix Corporation v. Balax, Inc.*, 421 F.2d 809 (7th Cir.), *reh'g denied*, 399 U.S. 911 (1970) (specifies the requirements for continuing applications).

28. 37 C.F.R. § 1.296 (1985).

petition must, however, be filed before the SIR is published. The Code of Federal Regulations (C.F.R.) provides:

A request for a statutory invention registration, which has been filed, may be withdrawn prior to the date of the notice of the intent to publish a statutory invention registration issued pursuant to § 1.294(c) by filing a request to withdraw the request for publication of a statutory invention registration. The request to withdraw may also include a request for a refund of any amount paid in excess of the application filing fee and a handling fee of \$100 which will be retained. Any request to withdraw the request for publication of a statutory invention registration filed on or after the date of the notice of intent to publish issued pursuant to § 1.294(c) must be in the form of a petition pursuant to § 1.183 accompanied by the fee set forth in § 1.17(h).²⁹

Thus, the decision to file an application as a SIR is not irreversible if an applicant decides to pursue the patent. This situation could occur, for example, if an invention was later determined to be commercially valuable.

An applicant can also file an application and later change it to a SIR. A petition must be filed, including the waiver and fee, with basically the same procedure used for filing an application as a SIR.³⁰ There are, however, penalties if an applicant waits until the PTO has completed the first office action on the application. If an examiner's first office action has been mailed, the fee for converting to a SIR is \$800.³¹ If an examiner's first office action has not been mailed, the fee for having the application published as a SIR is only \$400.³²

This extra fee discourages an applicant from "feeling out" the status of an application by waiting until the application has been rejected by the PTO to see what prior art has been cited before deciding to convert the application to a SIR. If an appli-

29. *Id.*

30. *See supra* notes 24-26 and accompanying text.

31. 37 C.F.R. § 1.17(o) (1985).

32. *Id.* § 1.17(n).

cant can wait until after the first office action to convert to a SIR, the PTO will be required to conduct a prior art search and write the first office action. The application will be reviewed under 35 United States Code (U.S.C.) sections 102, 103, and 112, and will not, therefore, be examined in the contemplated abbreviated examination process which requires the examiner to review the application under only 35 U.S.C. section 112.³³ The prosecution process will be prolonged, thus destroying the main purpose of the SIR process—to save the time and the expense of prosecuting an application.

2. Examination

An application received by the PTO with a request for examination as a SIR will be examined in an abbreviated process. The responsible examiner will review the application to ensure that the enabling and best mode requirements of 35 U.S.C. section 112 are met, the applicant has complied with the requirements for printing, the waiver of the right to receive a patent is included, and the application, publication, and other processing fees have been paid.³⁴ The C.F.R. provides:

Any request for a statutory invention registration will be examined to determine if the requirements of § 1.293 have been met. The application to which the request is directed will be examined to determine (1) if the subject matter of the application is appropriate for publication, (2) if the requirements for publication are met, and (3) if the requirements of 35 U.S.C. 112 and § 1.293 of this part are met.³⁵

In contrast, a patent application not filed as a SIR is assigned to an examiner.³⁶ The examiner reviews the application

33. See *infra* notes 40-41 and accompanying text.

34. 35 U.S.C. § 157(a) (Supp. 1985). See also 37 C.F.R. § 1.293 (1985).

35. 37 C.F.R. § 1.294(a) (1985).

36. 35 U.S.C. § 131 (1985). "The Commissioner shall cause an examination to be made of the application and alleged new invention; and if on such examination it appears that the applicant is entitled to a patent under the law, the Commissioner shall issue a patent therefor." *Id.* Having complied with 35 U.S.C. § 111, an applicant is entitled to an examination of his application, but not necessarily to a patent. Section 131 is an express mandate to the Commissioner to examine a patent application. For reasons of

to guarantee that the enabling and best mode requirements of 35 U.S.C. section 112 are met, and conducts a "prior art search" to see if the invention has been patented previously³⁷ or if the invention would be obvious to a skilled artisan.³⁸ This process often results in a rejection by the examiner of the application and subsequent amendments by an applicant to overcome the examiner's rejections.³⁹ These rejections are usually based on "anticipation" under 35 U.S.C. section 102 or "obviousness" under 35 U.S.C. section 103, and not the enabling and best mode requirements under 35 U.S.C. section 112.⁴⁰ Consequently, a significant part of the prosecution process for both the PTO and the applicant involves the rejection-amendment process over anticipation and obviousness. This extra time and effort, however, is avoided by filing a SIR because an examiner reviews an application only under 35 U.S.C. section 112 and does not fully examine the application under 35 U.S.C. sections 102 and 103.⁴¹

3. Rejections

If, however, an examiner finds that an SIR application does not meet the requirements for publication,⁴² the SIR request will be rejected.⁴³ The applicant will be given a chance to correct the

practicality, the Commissioner delegates this mandate to the corps of examiners.

37. *Id.* § 102.

38. *Id.* § 103 (Supp. 1985).

39. *Id.* § 132 (1985).

Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Commissioner shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined. No amendment shall introduce new matter into the disclosure of the invention.

Id. See, e.g., In re Wiechert, 370 F.2d 927 (1967) (although the Commissioner may deny an applicant a U.S. patent by rejecting claims or by objecting to the application or by making requirements, the applicant is afforded the rights of due process and notice with respect to that denial).

40. 2 P. ROSENBERG, PATENT LAW FUNDAMENTALS 15-18 to 15-22 (2d ed. 1985).

41. *Id. See also* 35 U.S.C. § 157(a) (Supp. 1985).

42. *See supra* note 34.

43. 37 C.F.R. § 1.294(b) (1985).

Applicant will be notified of the results of the examination set forth in paragraph (a) of this section. If the require-

problem with the application through amendment, and resubmit the application to the PTO for reconsideration. If the application is still deemed too defective to publish as a SIR, the examiner will issue a final rejection indicating that the PTO will not publish the application as a SIR.⁴⁴ The applicant, dissatisfied with the PTO's final position, can appeal the examiner's refusal to allow publication.

4. *Appeal*

An applicant who has had a SIR application finally rejected has two options for appeal. First, the applicant has the right to petition the Commissioner to review an examiner's final rejection.⁴⁵ Second, the applicant also has the right to appeal the fi-

ments of § 1.293 and this section are not met by the request filed, the notification to applicant will set a period of time within which to comply with the requirements in order to avoid abandonment of the application. If the application does not meet the requirements of 35 U.S.C. 112, the notification to applicant will include a rejection under the appropriate provisions of 35 U.S.C. 112. The periods for response established pursuant to this section are subject to the extension of time provisions of § 1.136.

Id.

44. *Id.*

After response by the applicant, the application will again be considered for publication of a statutory invention registration. If the requirements of § 1.293 and this section are not timely met, the refusal to publish will be made final. If the requirements of 35 U.S.C. 112 are not met, the rejection pursuant to 35 U.S.C. 112 will be made final.

Id.

45. *Id.* at § 1.295(a).

Any requester who is dissatisfied with the final refusal to publish a statutory invention registration for reasons other than compliance with 35 U.S.C. 112 may obtain review of the refusal to publish the statutory invention registration by filing a petition to the Commissioner accompanied by the fee set forth in § 1.17(h) within one month or such other time as is set in the decision refusing publication. Any such petition should comply with the requirements of § 1.181(b). The petition may include a request that the petition fee be refunded if the final refusal to publish a statutory invention registration for reasons other than compliance with 35 U.S.C. 112 is determined to result from an error by the Patent and Trademark Office.

Id.

nal rejection to the Board of Patent Appeals and Interferences.⁴⁶

The Commissioner or the court can either overturn an examiner's refusal to publish the SIR and order publication, or uphold the examiner's position and refuse publication. The applicant may pursue the issue in court if publication is refused.⁴⁷ However, if an applicant has to amend, appeal, and go to court to get the SIR published, the abbreviated prosecution process has been frustrated and the advantages of the SIR process, saving time and money, have been lost. If the prosecution process advances to this stage, an inventor would have been better off to have published the material or have applied for a patent.

B. SIR PUBLICATION

If an applicant is successful in overcoming an examiner's rejections by amendment or appeal or if an application complies with all of the requirements for publication when the SIR is initially submitted, the PTO will publish the application as a SIR.⁴⁸ The SIR published by the PTO must be labeled as a "Statutory Invention Registration" and include language to the effect that the publication "is not a patent."⁴⁹ Each statutory invention registration published must include the following

46. *Id.* § 1.295(b).

Any requester who is dissatisfied with a decision finally rejecting claims pursuant to 35 U.S.C. 112 may obtain review of the decision by filing an appeal to the Board of Patent Appeals and Interferences pursuant to § 1.191. If the decision rejecting claims pursuant to 35 U.S.C. 112 is reversed, the request for a statutory invention registration will be approved and the registration published if all of the other provisions of § 1.293 and this section are met.

Id.

47. 35 U.S.C. §§ 141-145 (Supp. 1985). *See also* 37 C.F.R. §§ 1.301-03 (1985).

48. 37 C.F.R. § 1.297(a).

If the request for a statutory invention registration is approved the statutory invention registration will be published. The statutory invention registration will be mailed to the requester at the correspondence address as provided for in § 1.33(a). A notice of the publication of each statutory invention registration will be published in the Official Gazette.

Id. *See also* 37 C.F.R. § 1.294(c) (1985) ("If the examination pursuant to this section results in approval of the request for a statutory invention registration the applicant will be notified of the intent to publish a statutory invention registration.")

49. *Id.* § 1.297(b) (1985).

statement relating to the attributes of a SIR:

A statutory invention registration published pursuant to 35 U.S.C. 157 is not a patent but it has all of the attributes specified for patents in title 35, United States Code, except those specified in 35 U.S.C. 183 and sections 271 through 289. A statutory invention registration does not have any of the attributes specified for patents in any other provision of law other than title 35, United States Code. The invention with respect to which a statutory invention registration is published is not a patented invention for purposes of the marking provisions of 35 U.S.C. 292.⁵⁰

This section was apparently added to avoid confusion between patents and SIRs and to signify to those searching the prior art that a SIR has been granted in the abbreviated prosecution process.

C. SIR AS PRIOR ART

A SIR is "prior art" under all subsections of 35 U.S.C. sections 102 and 103, and therefore, has the same defensive status as would a patent covering the same subject matter.⁵¹ SIR overcomes the limitations of technical disclosure bulletins, journal articles, and PTO defensive publications, by providing that a SIR will be a reference as of its filing date even though it may not be made public for several months.⁵²

Use of a SIR to establish a reference date equal to the filing date may be limited by the courts in the same manner as defensive publications.⁵³ SIR, however, has a clear statutory basis that establishes a SIR as a reference as of the filing date of the application on which it is based.⁵⁴ SIR basically serves as a reference to prevent future patenting of the same or obviously similar subject matter by assuring the status of SIR as prior art, and removing the remedies available to the inventor had the subject

50. *Id.*

51. 35 U.S.C. § 157(c) (Supp. 1985).

52. *See supra* notes 9-16 and accompanying text.

53. *See supra* notes 16-21 and accompanying text.

54. 35 U.S.C. § 157 (Supp. 1985).

matter been patented in the normal prosecution process.

D. EFFECT OF SIR ON REMEDIES

Sections 271-289 of 35 U.S.C. provide a patentee with a definition of patent infringement and with remedies for infringement of a patent by others. According to section 271, "Except as otherwise provided in this title, whoever without authority makes, uses or sells any patented invention, within the United States during the term of the patent therefor, infringes the patent."⁵⁵ Other sections in the statute provide redress for infringement through a "remedy by civil action"⁵⁶ for infringement and specifically authorize injunctions,⁵⁷ damages,⁵⁸ and, in exceptional cases, attorney's fees.⁵⁹ The statute also authorizes *compensation for an inventor who has had a patent withheld or kept secret because of the government's interest in national security*.⁶⁰

Upon issuance of a United States patent, a statutory rule of evidence provides that the issued patent shall be presumed valid and that the burden of establishing invalidity of a patent shall rest on the party asserting invalidity. This evidentiary presumption has the effect of placing the burden of proving unpatentability on the party challenging the patent's validity. It then becomes the responsibility of the challenging party to present clear and convincing evidence that the claimed invention previously existed in the prior art or that an act or event occurred that defeated the patentee's right to be granted a patent.⁶¹ These remedies provide the mechanism used by a patent holder to exploit an invention for profit by providing a means

55. *Id.* § 271 (1984 & Supp. 1985).

56. *Id.* § 281 (1984).

57. *Id.* § 283. "The several courts having jurisdiction of cases under this title may grant injunctions in accordance with the principles of equity to prevent the violation of any right secured by patent, on such terms as the court deems reasonable." *Id.*

58. *Id.* § 284. "Upon finding for the claimant the court shall award the claimant damages adequate to compensate for the infringement, but in no event less than a reasonable royalty for the use made of the invention by the infringer, together with interest and costs as fixed by the court." *Id.*

59. *Id.* § 285. "The court in exceptional cases may award reasonable attorney fees to the prevailing party." *Id.*

60. *Id.* § 183.

61. *Id.* § 282 (1984 & Supp. 1985).

with which a patent holder may seek redress if others make, use, or sell his invention.

Publication of a SIR and the resulting effect of the waiver of all rights to receive a patent means that an applicant has waived the remedies in 35 U.S.C. section 183 and 35 U.S.C. sections 271-289 for enforcement of patent rights.⁶² An inventor loses his offensive rights in his invention when the invention is disclosed as a SIR. This requirement only accentuates the purpose of SIR; to provide defensive protection but to remove the offensive right an inventor has in his invention, i.e., the right to exclude others from making, using, or selling the invention.⁶³

IV. DISCUSSION

SIR provides an inventor with a simplified procedure that side steps the difficult and costly rejection-amendment part of patent prosecution. This simplified procedure, however, eliminates the most beneficial part of patent prosecution; the right to exclude others from making and using an invention. SIR is, however, not without some benefit to an inventor who wants to protect his rights against subsequent independent inventors. SIR establishes a prior art reference as the filing date. Subsequent inventors are prevented from patenting the same invention, and the first inventor is forced to pay royalties to the patentee. An inventor will not face the dilemma of another inventor working independently to obtain a patent by showing that he reduced the invention to practice after the SIR is filed but during the pre-publication review by the PTO.

62. *Id.* § 157(c) (Supp. 1985).

A statutory invention registration published pursuant to this section shall have all of the attributes specified for patents in this title except those specified in section 183 and sections 271 through 289 of this title. A statutory invention registration shall not have any of the attributes specified for patents in any other provision of law other than this title. A statutory invention registration published pursuant to this section shall give appropriate notice to the public, pursuant to regulations which the Commissioner shall issue, of the preceding provisions of this subsection. The invention with respect to which a statutory invention certificate is published is not a patented invention for purposes of section 292 of this title.

Id.

63. *See supra* notes 3-4 and accompanying text.

Governmental agencies should benefit greatly from the new SIR program. The government normally does not enforce its patents and will grant a license to anyone who requests it.⁶⁴ In fact, the newly enacted SIR statute specifically contemplates the government's use of the new statutory invention registration process:

The Secretary of Commerce shall report to the Congress annually on the use of statutory invention registrations. Such report shall include an assessment of the degree to which agencies of the federal government are making use of the statutory invention registration system, the degree to which it aids the management of federally developed technology, and an assessment of the cost savings to the Federal Government of the use of such procedures.⁶⁵

The SIR procedure, however, is not without possible limitations. SIR is a newly enacted provision that has neither been interpreted by the courts nor evaluated by the PTO in the prosecution process. The courts may refuse to determine, albeit over clear statutory authority,⁶⁶ that SIR gives an inventor a priority date equal to the filing date, and thereby, place the SIR on an equal status with technical disclosure bulletins, journal articles, and defensive publications.⁶⁷ In addition, applicants not concerned with section 102 and section 103 rejections may file applications with very broad claims that will initiate interference proceedings with other patent applications during the prosecution process.⁶⁸

V. CONCLUSION

SIR will be very useful to large corporations, universities, and governmental agencies who want to publish inventions that result from research but do not want to exploit the invention

64. See *supra* note 6 and accompanying text.

65. 35 U.S.C. § 157(d) (Supp. 1985).

66. See *supra* note 54 and accompanying text.

67. See *supra* notes 15-19 and accompanying text.

68. 35 U.S.C. § 157(a) (Supp. 1985). "If an interference is declared with respect to such application, a statutory invention registration may not be published unless the issue of priority of invention is finally determined in favor of the applicant." *Id.*

commercially, either because of policy or economics. SIR will serve as an expedient and inexpensive means to make inventions public and prevent others from patenting the same or obviously similar invention. SIR will also supplement technical disclosure bulletins and replace PTO defensive publications as a means for disclosing inventions. However, SIR will be of little value to an inventor who wishes to exploit his invention commercially because the right to exclude others from exploiting the invention has been lost.