

Second Order Patent Scope

FTC Hearings

Berkeley, CA Feb. 26, 2002

Professor Robert P. Merges

Wilson Sonsini Professor of Law

UC Berkeley (Boalt Hall)

School of Law

Current Economics Literature Focuses on Two main sets of rules:

1. Enablement

2. Infringement

→ In particular, the Doctrine of Equivalents (DOE)

Many other doctrines affect patent scope

- “Written description” requirement – important determinant of “leading breadth”
- Rules on team research and prior art – favor “pioneering corporate teams”
- “Double patenting” – important, subtle advantage to pioneer in race for improvements

Written Description Requirement

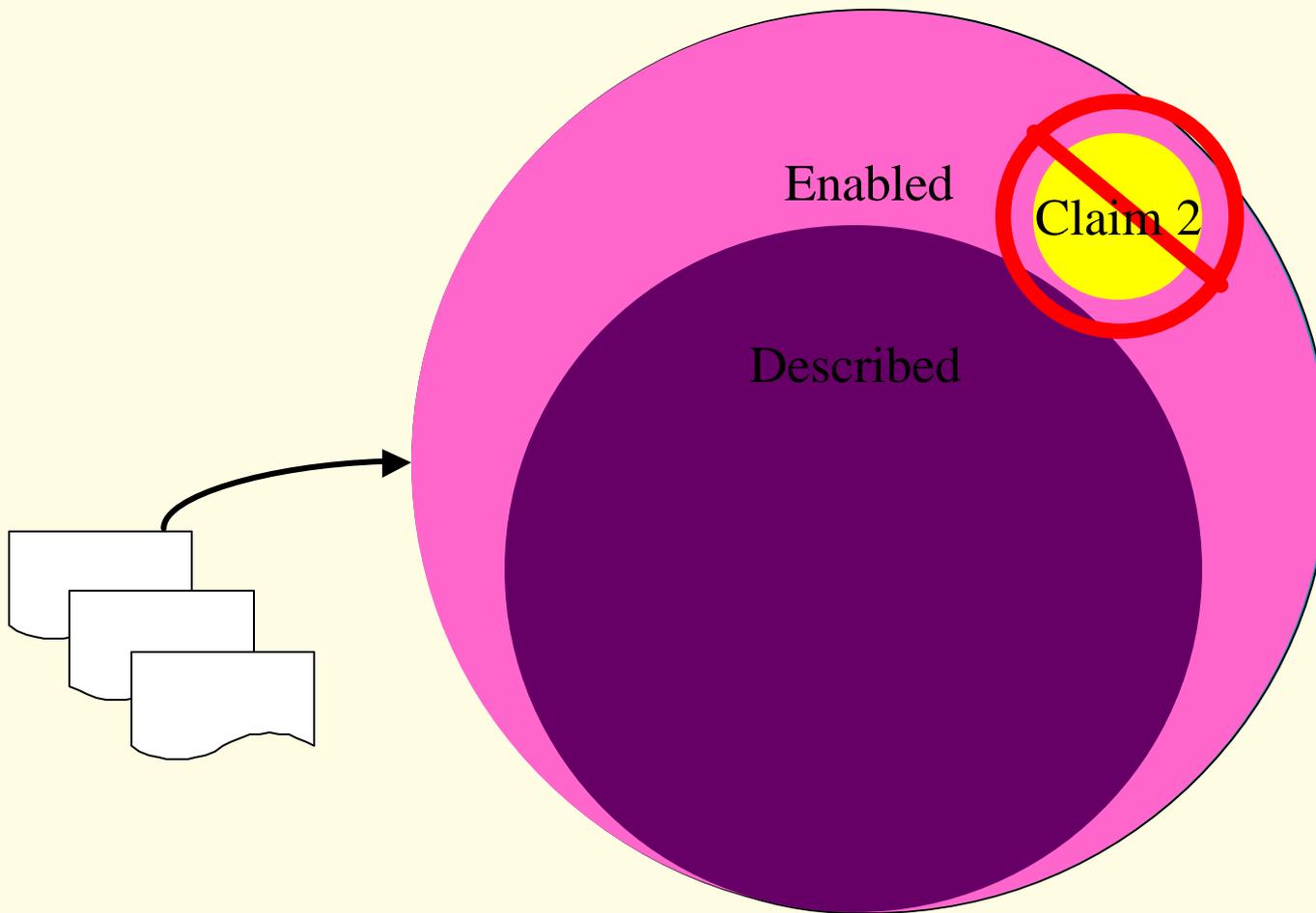
- Applies frequently when a patentee amends claims in pending application to cover new product introduced by competitor
- Expansion in claim scope during prosecution (pendency) of patent application

Common Scenario: Amending Claims to Cover Competitor's Product

1. Inventor (I) files patent application disclosing an invention and including initial claims of scope S_1 .
2. Competitor (C) begins selling an embodiment outside the range of inventor's claims S_1 .
3. I amends claims to scope S_2 to include competitor's embodiment.
4. I's patent issues with claims of scope S_2 ; I sues C; C defends on "written description" grounds.
→ Eg, Gentry Gallery, 134 F.3d 1473 (FC 98)

Specification Re-filed

If the inventor re-files the specification at a later date, she cannot claim what the first filing enabled but failed to describe.



Written Description and “Leading Breadth”

- Leading breadth notion of O’Donohue, Scotchmer & Thisse (1998)
- “After-developed improvements”
- How broad should scope be?
- Bargaining/division of profits perspective
- Relative contribution perspective: *short-term* leading breadth

Portfolio-Level Scope Issues

Prior Art Rules on Team Research

“Double Patenting” Doctrine

Team Research and Prior Art

Rules on team research and prior art – favor large corporate pioneers

- Inventions conceived, and applications filed, by team members do not count as prior art against other team members
- Facilitates building “pioneer portfolio”

Double Patenting

- Ok to claim obvious variants of pioneering invention in one or more related applications
- Subtly favors pioneer over improver/competitors in race to develop improvements
- “Terminal Disclaimer” under 35 USC 273
Required – no *term* extension
- But literature on length v. scope tells us this may be less important than broadening of scope

Quad Env't'l Techs. Corp. v. Union Sanitary Dist., 946 F.2d 870, 873 (Fed. Cir. 1991)

Voluntary limitation of the term of the later issued patent is a convenient response to an obvious-type double patenting rejection, when the requirement of common ownership is met. Any possible enlargement of the term of exclusivity is eliminated, **while enabling some limited protection to a patentee's later developments.**

The Next Frontier?

- Lobbying: Monitoring Property Rights at their Source
- D. North: Watch the Legislature!
- Supreme Court: Eldred v. Reno, copyright term extension under constitutional review – constitutional restraints on rent seeking?

Second Order Patent Scope

Scope shaped by many doctrines

Policy issues *inherent in the details*