Ready for Patenting

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Courts and scholars have long struggled with the question of whether invention is primarily a mental act or instead primarily an act of building it – what patent law calls "reducing an invention to practice." William Robinson, the author of the leading nineteenth-century patent treatise, thought the real act of invention was mental – the formation in the mind of a new idea. Justice Story, by contrast, saw the inventor's central contribution as introducing new technology to the world, something that could only happen when the idea had been turned into a working, usable device or method.

Patent law has tried to find a middle ground between these two visions of invention. But in trying to walk that middle ground, patent law has actually discouraged inventors from getting their inventions to work in practice, rewarding those who run to the patent office before they are fully done with the invention and giving them precedence over those who take the time to make sure their invention works by building and testing it. In an important class of cases – those in which the inventor has an idea but does not yet know if it will work – the patent system encourages the inventor to patent first and figure it out later, if at all. The problem is even worse under the new America Invents Act passed in 2011, which encourages patentees to file their applications as soon as possible. Indeed, those who actually build and test an invention under the new statute before filing a patent application may even find that they have lost their rights by doing so.

The fact that the law encourages inventors to file first and figure out later how (or even if) the invention works for its intended purpose is unfortunate. It encourages underdeveloped patent applications that do not communicate useful information to the world. It encourages the rise of patent trolls who obtain patents but never bother to produce a product, instead making a business of suing those who do. And it pushes people to patent things just in case, adding more patents into a system already overburdened with them.

Some have suggested that we should require patentees to actually make products or at least build and test prototypes before filing their patent applications. But doing so would have its own worrisome consequences. Whatever the right answer to that problem, we should not be in the position in which we currently find ourselves: treating inventors less favorably if they try to build and test their inventions. In this paper, I offer some less drastic steps toward protecting those who choose to develop and test their inventions.