Innovation and Own Prior Art

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This Article analyzes a conflict between innovation and the patent system: innovation is a dynamic, iterative process, but a patent reflects only a single snapshot in time. Despite extensive scholarly and judicial discussion of when an invention is ready for patenting, there is rarely a perfect time to file a patent application. Instead of filing a single perfect application, companies typically build a portfolio of patents by filing a series of applications over the course of research and development. Yet this is an imperfect business strategy because each patent application sets up a potential barrier for the company's future applications. The barrier arises because future applications must be both new and nonobvious as compared to most of the company's existing patent applications.

This Article examines the interaction between patent applicants' own earlier-filed applications and patentability requirements. I argue that this interaction influences a number of areas of debate in patent theory, including the disclosure function of patents, the incentives for post-discovery commercialization, and the allocation of rights between pioneer and follow-on inventors. As such, the treatment of an applicant's own earlier-filed applications can serve as a policy lever for innovation. Despite its significance, the legal treatment of successive patent filings by the same inventor or company developed haphazardly. The resulting statutory framework, built by the layering of various provisions, is not well-tailored to any particular policy goal. Moreover, in its current form, the law has unintended effects that can hamper innovation. For example, original patent applicants are favored over third-party improvers, such that original applicants can receive lengthened patent protection for insignificant improvements to existing innovation.

I propose a statutory amendment that would replace the current layered provisions with a single provision. The new provision would maintain some preferential treatment for original patent applications conditioned on a binding disclaimer of lengthened patent protection, modeled after existing doctrines. It would also provide a more straightforward delineation between original applicants and third-party improvers. This proposal would provide a better mechanism for directly tailoring the statutory framework to achieve particular policy goals, and I illustrate how its parameters can be adjusted to reflect the balancing of competing concerns.