

# The surprising consequences of exempting patents from copyright protection

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## Abstract

*Over the course of two centuries the US patent system has generated an expansive compilation of millions of patents and patent applications. Collectively these documents describe the details of inventions in virtually every field of technology. Each document is privately created on behalf of an inventor and typically entails a somewhat laborious drafting process.*

*Since every invention builds upon the work of previous technologists, many patent documents are not entirely unique. A patent document often describes some aspects or components that are described in other patent documents. The drafter of a patent document can either copy appropriate descriptions from one or more previous patent documents, or can draft one from whole cloth. The latter is obviously much less efficient as well as prone to errors.*

*Patent drafters could be inspired to follow the example set by the open source software community, in which members share software components and freely reuse the work of others. Rather than reinvent the wheel hundreds of times, one software component is made and distributed to those who have need of it, possibly many years later. A similar approach for patent documents would save countless hours and increase document quality as the best document components would be shared and propagated among drafters over time.*

*However, certain laws have made the reuse of portions of a third party's patent document impractical. Patent documents are composed of text, so they are subject to copyright protection. Currently there is no mechanism that facilitates the exchange of these documents among parties. Consequently, not only is there little sharing and reuse of portions of patent documents, very few drafters even consider this possibility. The copyright issue stifles new methods that could be tremendously productive and socially beneficial.*

*In this paper I conclude that although a patent document constitutes copyrightable subject matter, several legal doctrines reduce the benefits of copyright protection in patents, and could possibly eliminate all copyright protection for patents. These limitations on the extent of copyright protection appear to have been overlooked by the literature. Evidently, copyright protection for patents is simply presumed to be as unfettered as it is for most works of authorship.*

*I also argue that limitations on copyright protection for patents would be the soundest policy. Affording even modest copyright protection to patents not only would significantly undermine the primary goal of the patent system – public disclosure of inventions and the technical information underlying those inventions - it also would provide no offsetting benefit to authors or to the public. If patents were completely unfettered by copyright protection, the public would benefit from more-freely disseminated technical information, and creators of improvement inventions could avail themselves of previously unrecognized techniques to efficiently reuse portions of previous patent documents. In particular, different types of software systems to facilitate reuse could be created. Such software systems could assemble a database of technical descriptions, and automatically generate summaries of one or more patents.*

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## I. INTRODUCTION

A patent document<sup>1</sup> includes text and drawings<sup>2</sup> that describe an invention and that are included in a patent application filed with the U.S. Patent and Trademark Office (“PTO”). The PTO typically publishes the patent application eighteen months after it is filed.<sup>3</sup> If the application is granted, the PTO also publishes a patent that is almost identical to the application, subject to

1 In this paper all references to “patents” denote only U.S. utility patents. However, much of the analysis will apply to U.S. design patents as well.

2 An application must include a drawing where necessary for the understanding of the subject matter sought to be patented. 35 U.S.C. 113 (2013).

3 35 U.S.C. § 122(b) (2013). See *infra* Part V.A.

any amendments made after the application was filed. Both published applications and patents are freely available via a number of online electronic databases, including the PTO's web site.<sup>4</sup> Publication of patents and applications serves one of the primary functions of the patent system: to disclose the details of novel inventions to the public.<sup>5</sup> Indeed, the complete description of an invention by the patentee is the quid pro quo for the grant of patent rights.<sup>6</sup>

While the patent system is designed to disseminate technical information to the public, the copyright system exists to promote the creation of expressive works, such as literature and other art.<sup>7</sup> Much like the patent laws, the copyright laws give creators of such works the right to prevent copying and other activities without authorization.<sup>8</sup>

Patent documents fit comfortably within the definition of works which are subject to copyright since they include text and most often<sup>9</sup> drawings, both paradigmatic examples of copyrightable subject matter. Indeed, the PTO regulations contemplate copyrights in patent documents by permitting a copyright notice to be placed in the application adjacent to copyrighted material.<sup>10</sup> Thousands of patents include a statement that some portion of the document contains material which is subject to copyright protection.<sup>11</sup> This clearly indicates that the respective patent applicants hope to utilize some of the benefits of copyright protection for their patent documents. Moreover, patent documents are most often drafted by patent attorneys or patent agents<sup>12</sup> who invest a substantial amount of time in crafting the appropriate legal protection for the invention.<sup>13</sup> In this sense patent documents are very much like other

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4 See Patent Full-Text Databases, available at <http://patft.uspto.gov/>.

5 *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470, 481 (1974). See *infra* Part II.A.

6 *Universal Oil Products Co. v. Globe Oil & Refining Co.*, 322 U.S. 471, 484 (1944). See *infra* Part II.A.

7 *Sony Corp. of America v. Universal City Studios, Inc.*, 464 U.S. 417, 429 (1984). See *infra* Part II.B.

8 17 U.S.C. § 106 (2013). See *infra* Part II.B.

9 For example, of all utility patents issued in 2012 and 2013, 77% included both the section heading “Brief Description Of The Drawings” and a reference to either “fig. 1” or “figure 1”. A finer search would have found patents with other phrases that indicate the presence of drawings. For example, some patents include the text “figures 1A and 1B” but not the text pattern “figure 1”.

10 37 C.F.R. § 1.71(d) (2013). See *infra* Part V.A.

11 Of all utility patents issued from 2000 to 2013, 8,225 include the text “copyright owner has no objection to the facsimile reproduction by anyone of the patent document or the patent disclosure, as it appears in the Patent and Trademark Office patent file or records”, which is the notice required by the PTO regulations. See *infra* Part V.A.

12 A patent agent is someone who is not an attorney but has been authorized to practice before the PTO. 37 C.F.R. § 11.6(b) (2013). Patent agents and patent attorneys are permitted to draft and file patent applications with the PTO on behalf of clients. 37 C.F.R. § 11.5(b)(1) (2013). For simplicity I will use the phrase “patent attorney” to denote an attorney or agent.

13 According to a survey of patent practitioners, the typical charge for drafting a patent application is \$6,500 for

copyrightable documents that attorneys create.<sup>14</sup>

There are numerous productive uses of patent documents that generally remain unexploited for fear of copyright infringement. For example, often two different inventors create related inventions: an original invention and a subsequent improvement to the original. Both the original invention and the improvement can be separately patentable<sup>15</sup> and each patent can be owned by the respective inventor. The patent for the improvement might need to describe numerous technical details already explicated in the patent for the original invention. The most straightforward strategy in drafting the application for the improvement may be to copy portions of the technical description from the original patent application. However the drafter of the improvement application may be reluctant to do so because of the risk of charges of plagiarism or copyright infringement.

More generally, many of the thousands of patent applications drafted each year could benefit from reusing portions of previous patents. A single patent could employ paragraphs or pages from each of several previous patents. Many of the copied portions could describe the requisite details of known technological components that are common to thousands of inventions, such as hard drives, flat panel displays, DC motors, and gasoline engines. Rather than having the community of drafters repeatedly recreate common technical descriptions, it would be much more efficient to permit drafters to select and reuse the best existing descriptions in patent documents. Again, the threat of copyright infringement stifles any discussion of this potentially useful new scheme.

The rich set of technical descriptions in patents could be used in productive ways besides patent drafting. Computer-created summaries of patent documents, could be used to describe the state of the art in a particular field. There are software systems capable of processing large amounts of text, extracting the semantic content therefrom, and outputting a summary comprising the most relevant portions of the text. As computer-based text processing becomes more powerful, software-generated technical summaries will become cheaper and more accurate replacements for their human generated counterparts.

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an invention of minimal complexity, and \$10,000 for a relatively complex invention. Am. Intellectual Prop. Law Ass'n, Report of the Economic Survey 27 (2013).

<sup>14</sup> See *infra* Part III.A.

<sup>15</sup> See, e.g., Mark A. Lemley, The Economics of Improvement in Intellectual Property Law, 75 Tex. L. Rev. 989, 1008 (1997).

Despite the manifest advantages of computer summarization over laborious manual summarization, copyright concerns could hinder initiatives to bring this tool to fruition. A summary of one or more patents would constitute a derivative work of the patent documents summarized, and any owner of a copyright in one of the patent documents could claim infringement.

In short, it would be entirely reasonable to conclude that patent documents can be protected by copyright, and that the owner of such a copyright could utilize this intangible asset in the usual manner. Nevertheless, in this paper I describe several serious but previously unrecognized limits on the extent of U.S. copyright protection for patents.<sup>16</sup> A number of doctrines in patent and copyright law interact in interesting ways to reduce, if not eliminate, copyright protection for patents.

These limitations in copyright protection serve an important function. In general, restricting the right to exclude others from copying and creating derivative works from patent documents, or from portions thereof, bolsters the objective of the patent system: the dissemination of technology and technological information via patent documents. Reducing copyright protection for patents therefore directly benefits the different types of consumers of the information contained in patents. Inventors of improvement inventions as well as the public at large would be enriched by a restricted scope of copyright protection for patent documents.

Part II is devoted to discussing the respective policies underlying the patent and copyright systems, as well as the policy conflict caused by copyrights for patents. I explore in Part III the copyrightability of patent documents and the extent of copyright protection for patent documents. Such copyright protection could be infringed by various productive activities of members of the public, a topic I address in Part IV.

In Part V I contend that, notwithstanding the rights afforded the copyright owner, there are numerous legal and practical impediments to asserting any copyright in a patent document. I conclude in Part VI by describing some novel tactics involving patent documents. These tactics would benefit the public and further the goals of the patent system, but would be widely adopted

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<sup>16</sup> The analysis in this paper addresses only the extent of US copyright protection for US patents and patent applications. Notwithstanding any limits in US copyright protection, the same US patent may be entitled to copyright protection in a foreign jurisdiction, and that protection may be greater or narrower than that of the US copyright. In addition, aspects of certain foreign copyright laws would restrict protection for foreign patents, as described in Part V.G. *infra*.

only if the public were assured that there would be no copyright liability whatsoever.

## II. PATENT AND COPYRIGHT POLICIES

### A. THE DISCLOSURE FUNCTION OF THE PATENT SYSTEM

Every U.S. patent must satisfy three disclosure requirements: enablement, written description, and best mode.<sup>17</sup> The purpose of the enablement requirement is to place the subject matter of the patent generally in the possession of the public.<sup>18</sup> Enablement requires that the specification of the patent describe “the manner and process of making and using [the invention], in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains . . . to make and use the same”<sup>19</sup> A patent fails this enablement requirement if the specification would not permit the person of ordinary skill in the art to practice the invention without “undue experimentation.”<sup>20</sup>

The written description requirement is independent of enablement, and requires that the specification reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date of the corresponding patent application.<sup>21</sup> The best mode requirement requires disclosure of the best mode contemplated by the inventor of carrying out the invention.<sup>22</sup> Under the recent changes to the patent laws, patent applications must still satisfy the best mode requirement, but the failure to disclose the best mode is not a basis on which a claim of a patent may be canceled or held invalid or unenforceable.<sup>23</sup>

The enablement requirement is designed to add knowledge to the public.<sup>24</sup> Dissemination

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17 35 U.S.C § 112(a) (2013).

18 *Spectra-Physics, Inc. v. Coherent, Inc.*, 827 F.2d 1524, 1532 (Fed. Cir. 1987).

19 35 U.S.C § 112(a) (2013).

20 *In re Wands*, 858 F.2d 731, 737 (Fed. Cir. 1988).

21 *Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc).

22 35 U.S.C § 112(a) (2013).

23 35 U.S.C. § 282(b)(3)(A) (2013).

24 *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470, 481 (1974) (stating that information disclosed in a patent adds to the “general store of knowledge”); *Graham v. John Deere Co.*, 383 U.S. 1, 6 (1966) (noting that the Intellectual Property Clause of the Constitution, U.S. Const. art. I, § 8, cl. 8, requires that patents add to knowledge); *In re Argoudelis*, 434 F.2d 1390, 1394 (C.C.P.A. 1970) (Baldwin, J., concurring) (stating that the full and complete disclosure of how to make and use the claimed invention “adds a measure of worthwhile knowledge to the public storehouse”).

of the technical information contained in patents permits society to make and use the patented invention after expiration of the patent.<sup>25</sup> Moreover, since a patent application is typically made available to the public before the patent issues,<sup>26</sup> and even if it never issues, its disclosure is made available to the public well before the patent term expires. This permits the public to productively use the technical information to design around the patented invention<sup>27</sup> and otherwise to create new inventions.<sup>28</sup> Enablement, but not written description or best mode, is important enough to be required by the International Agreement on Trade-Related Aspects of Intellectual Property Rights (“TRIPS”),<sup>29</sup> which establishes minimum levels of intellectual property protection to be provided by the laws of well over one hundred WTO member nations.

In addition to providing technical enrichment to the public, patents also serve to convey valuable signals about the invention<sup>30</sup> and about the company that created it.<sup>31</sup> Such signals can allow others to guess the research that the company will conduct and what product lines it might create or expand.<sup>32</sup>

The disclosure of the invention to the public is often characterized as the quid pro quo for the grant to the inventor of the right to exclude.<sup>33</sup> Under this theory, patent rights are awarded as

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25 *Universal Oil Prods. Co. v. Globe Oil & Ref. Co.*, 322 U.S. 471, 484 (1944); *Gill v. Wells*, 89 U.S. 1, 25–26 (1874).

26 Most utility patent applications are published 18 months from the date of filing or earliest priority date. 35 U.S.C. § 122(b)(1) (2013). Applications are not so published if the invention will not be the subject of a patent application in another jurisdiction and the patent applicant requests that the application not be published. 35 U.S.C. § 122(b)(2) (2013).

27 *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1583 (Fed. Cir. 1996).

28 See *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470, 481 (1974) (stating that the information disclosed in patents “will stimulate ideas and the eventual development of further significant advances in the art”); Jeanne C. Fromer, *Patent Disclosure*, 94 IOWA L. REV. 539, 548-49 (2009).

29 See Agreement on Trade-Related Aspects of Intellectual Property Rights art. 29, Apr. 15, 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, 1869 U.N.T.S. 299, 33 I.L.M. 1197 [hereinafter TRIPS] (“Members shall require that an applicant for a patent shall disclose the invention in a manner sufficiently clear and complete for the invention to be carried out by a person skilled in the art”).

30 Clarisa Long, *Patent Signals*, 69 U. CHI. L. REV. 625, 636-37 (2002).

31 Mark A. Lemley, *Rational Ignorance at the Patent Office*, 95 NW U. L. REV. 1495, 1505-06 (2001) (“Venture capitalists use client patents ... as evidence that the company is well managed, is at a certain stage in development, and has defined and carved out a market niche.”)

32 See Long, *supra* note 30 at 648.

33 See, e.g., *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 736 (2002) (“[E]xclusive patent rights are given in exchange for disclosing the invention to the public.”); *J.E.M. Ag Supply, Inc. v. Pioneer Hi-Bred Int’l, Inc.*, 534 U.S. 124, 142 (2001) (“The disclosure required by the Patent Act is ‘the quid pro quo of the right to exclude.’” (quoting *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470, 484 (1974))); *Pfaff v. Wells Elecs., Inc.*, 525 U.S. 55, 63 (1998) (“[T]he patent system represents a carefully crafted bargain that encourages both the creation and the public disclosure of new and useful advances in technology, in return for an exclusive monopoly for a limited period of time.”); *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 151 (1989) (“In consideration of disclosure and the consequent benefit to the community, the patent

an incentive to disclose rather than keep the details of the invention secret.<sup>34</sup>

In summary, the disclosure function of the patent system is designed to disseminate technical information widely and rapidly to the public via patent documents. This disclosure in turn promotes technological progress and reduces the unproductive duplication of prior research.

## B. UTILITARIAN GOALS OF THE COPYRIGHT SYSTEM

Much like the patents laws, the copyright laws provide an incentive for investment in the creation and distribution of expressive works such as literature and artwork.<sup>35</sup> The similarity in patent and copyright laws is unsurprising since Congressional authority for both is derived from the same clause of the Constitution.<sup>36</sup>

Since the costs in copying many types of works are typically much lower than the costs incurred in their creation,<sup>37</sup> copyright protection permits an author to prevent copying and other acts that would erode the profits she hopes to receive from the work.<sup>38</sup> Without this protection,

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is granted.”) (quoting *United States v. Dubilier Condenser Corp.*, 289 U.S. 178, 186 (1933)); *Kewanee Oil*, 416 U.S. at 481 (additions from patent disclosures “to the general store of knowledge are of such importance to the public weal that the Federal Government is willing to pay the high price of 17 years of exclusive use for its disclosure”); *Sinclair & Carroll Co., Inc. v. Interchemical Corp.*, 325 U.S. 327, 331 (1945) (“[The patent system’s] inducement is directed to disclosure of advances in knowledge which will be beneficial to society; it is not a certificate of merit, but an incentive to disclosure.”); *Grant v. Raymond*, 31 U.S. (6 Pet.) 218, 247 (1832) (“[A] correct specification . . . is necessary in order to give the public . . . the advantage for which the privilege is allowed, and is the foundation of the power to issue a patent.”).

34 *Bilski v. Kappos*, 130 S. Ct. 3218, 3252 (2010) (“[W]e interpret ambiguous patent laws as a set of rules that ‘wee[d] out those inventions which would not be disclosed . . . but for the inducement of a patent’ . . . .” (quoting *Graham v. John Deere Co.*, 383 U.S. 1, 11 (1966))). There has been some criticism of the disclosure theory. See, e.g., Mark A. Lemley, *The Myth of the Sole Inventor*, 110 Mich. L. Rev. 709, 745 (2012) (“Disclosure theory cannot . . . support the modern patent system.”).

35 See, e.g., *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 428 (1984) (the grant of copyright privileges are “intended to motivate the creative activity of authors and inventors by the provision of a special reward, and to allow the public access to the products of their genius after the limited period of exclusive control has expired.”); *United States v. Paramount Pictures, Inc.*, 334 U.S. 131, 158 (1948) (“reward to the author or artist serves to induce release to the public of the products of his creative genius.”). Netanel argues that copyright is also necessary in order to ensure that works are created privately rather than under government influence. Neil Weinstock Netanel, *Copyright and a Democratic Civil Society*, 106 Yale L. J. 283 (1996).

36 U.S. Const. art. I, § 8, cl. 8 (“The Congress shall have Power . . . [t]o 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 . . . .”).

37 Lydia Pallas Loren, *Redefining the Market Failure Approach To Fair Use In An Era of Copyright Permission Systems*, 5 J. Intell. Prop. L. 1, 223 (1997).

38 William M. Landes & Richard A. Posner, *An Economic Analysis of Copyright Law*, 18 J. Legal Stud. 325, 330-31 (1989).

the prospect of copying by competitors would deter many authors from ever creating works at all.<sup>39</sup>

The copyright laws are also designed to balance the interests of authors with “society's competing interest in the free flow of ideas, information, and commerce.”<sup>40</sup> Indeed, the sole interest of the U.S. and the primary object in conferring the copyright monopoly lies in the general benefits the public derives from the labors of authors.<sup>41</sup> For this reason the extent of an author's right to exclude is not unlimited, but is instead limited by various doctrines designed to protect the public.<sup>42</sup>

### C. THE INCONGRUITY OF COPYRIGHTS IN PATENTS

Since patent documents are original works of authorship like so many other copyrightable works, one might summarily conclude that patent documents enjoy the same benefits of copyright that other works do. In fact, copyright for patents might seem to be yet another type of work that is afforded dual copyright and patent protection.<sup>43</sup>

However, in this respect the patent and copyright systems stand in opposition. The very foundation of the patent system requires the teachings of patents to be freely disseminated to the public. Copyright protection for patents would hamper dissemination by conferring the right to prevent various uses of patent documents.<sup>44</sup> This conflict raises several interesting issues.

In general, an owner of a copyrighted document has the right to prevent the reproduction, distribution and display of that document.<sup>45</sup> However, as discussed below in Part IV.A, even a patent subject to copyright protection would most likely not be encumbered by all of these rights. On the contrary, it is very likely that, since the patent applicant voluntarily filed a patent document knowing that the PTO would publish it for use by the public, the patent applicant has

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39 Id.

40 Sony, supra note 7 at 429.

41 Fox Film Corp. v. Doyal, 286 U.S. 123, 127 (1932).

42 See infra Part III.B.

43 Mazer v. Stein, 347 U.S. 201, 217 (1954) (“patentability ... does not bar copyright ... . Neither the Copyright Statute nor any other says that because a thing is patentable it may not be copyrighted.”). For example, computer software is amenable to both copyright and patent protection. See generally, Mohammad Amin Naser , Computer Software: Copyrights v. Patents, 8 Loy. Law & Tech. Ann. 37 (2008).

44 See infra Part IV.

45 17 U.S.C. § 106(1), (3), and (5) (2013). See infra Part IV.

at the very least implicitly consented to such use.

Although copyright should not inhibit the reproduction of the patent document in its entirety,<sup>46</sup> another exclusive right that merits significant consideration is the right to create derivative works of the patent. The copyright owner has the exclusive right to prepare, and authorize others to prepare, derivative works based on her copyrighted works.<sup>47</sup> Such derivative works would generally include any work based upon the patent, such as a translation, abridgment or any other form in which the patent document, or portions of the patent document, could be transformed.<sup>48</sup>

A particularly important type of derivative work is a third party patent application that incorporates portions of an earlier, copyrighted patent. For example, the third party may have developed a modification or improvement of the invention described in the copyrighted patent. Promoting such improvements is one goal of publishing patents.<sup>49</sup> In the course of drafting the patent application for the improvement, the third party must describe some or all of the earlier invention which she has improved, since some or most of the components of the two inventions are similar or identical. If the patent application for the improvement invention included portions or all of the original patent, that improvement patent application would be a derivative work of the original.<sup>50</sup>

It clearly benefits the drafter to reuse the portions of the copyrighted patent in order to describe the common components. Drafting entirely new descriptions of those components is time consuming and can be error prone if due care is not exercised. More importantly, reusing portions of the earlier patent in the improvement patent would benefit the public. Having substantially identical description in both patents would make it easier to locate related patents in a search, since both patents would employ the same terminology. Identical descriptions would also facilitate comparison of the two patents, and would allow the public to identify the identical components with ease and in turn avoid wasteful rereading.

Similar benefits from copying would ensue even if the third party's invention were not

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46 See *infra* Part V.A.

47 17 U.S.C. § 106(2) (2013).

48 17 U.S.C. § 101 (2013).

49 See *supra* notes 27 and 28.

50 See, e.g., *Lewis Galoob Toys, Inc. v. Nintendo of Am., Inc.*, 964 F.2d 965, 967 (9th Cir. Cal. 1992) (stating that a derivative work often physically incorporates the original work).

strictly an improvement of the earlier invention, but merely utilized the earlier invention in another manner. The new invention might utilize the prior invention as a component, or might find a new way to use the prior invention. For example, if the earlier invention were a new type of sensor, many sorts of novel electronic devices could include the sensor as a component or utilize the sensor in a new process. In fact, one could envision an extreme example in which the new patent application is simply a novel combination of old components.<sup>51</sup> The application for the combination invention could be composed almost entirely of portions copied from several prior patents, each describing some existing component that is utilized in the new combination.

Another important type of derivative work is an excerpt or synopsis of a patent. Different portions of a patent can be useful for different learning purposes. For example, each patent includes a detailed description of how to make and use the novel invention. A patent also includes a background section which sets forth the state of the art and particular problems in the pertinent field. A patent also includes drawings, which can describe with particularity features that would be difficult to convey with text. The public would benefit from being able to extract the portion of interest when desired.

Moreover, the public would benefit from studying a collection of portions extracted from different patents. One could envision a summary, report, or treatise which featured, e.g., the backgrounds of dozens of patents describing the state of the art in semiconductor manufacturing, or the portions of patents that describe all alternative methods of manufacturing a particular substance. A new summary or synopsis could even be synthesized from patents by a computer system.<sup>52</sup>

The examples that guide the analysis in the remainder of this paper will be the two uses described above: creating a patent document from portions of other patents, and automatically generating a summary from a corpus of patents. As discussed in Part V, it is possible, though not certain, that copyright in patents would not impede the creation of these two types of derivative works. Nevertheless, the mere threat that such rights might be asserted would hamper the creation of derivative works of patents and would stifle knowledge sharing. Accordingly, it is

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51 Many or perhaps most inventions are combinations of existing components. *In re Kahn*, 441 F.3d 977, 986 (Fed. Cir. 2006); *In re Kotzab*, 217 F.3d 1365, 1369 (Fed. Cir. 2000); *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998).

52 See *infra* Part VI.

worth assessing the extent of copyright protection for patents to clarify whether the public can avail itself of such productive uses of patent documents.

### III. EXTENT OF COPYRIGHT PROTECTION FOR PATENTS

#### A. BASIC ELIGIBILITY CRITERIA

In order to receive copyright protection, a work must be an “original work of authorship” and fixed in a “tangible medium of expression.”<sup>53</sup> As the discussion below makes clear, the typical patent document comfortably satisfies both criteria. In fact, if such a document is *not* filed with the PTO, but instead is merely created and printed from the author's computer, there is little doubt that it is subject to copyright protection.

The originality requirement requires merely that the work must be independently created, not copied, and possesses a minimal degree of creativity.<sup>54</sup> Neither uniqueness nor novelty are required.<sup>55</sup> Fixation requires that the work be “fixed in any tangible medium of expression, now known or later developed, from which [the work] can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device”.<sup>56</sup> For example, one type of work which is copyrightable subject matter is a literary work,<sup>57</sup> defined as a work “expressed in words, numbers, or other verbal or numerical symbols or indicia, regardless of the nature of the material objects, such as books, periodicals, manuscripts, . . . , in which they are embodied”.<sup>58</sup>

One category of textual works for which copyrightability has been assessed is legal documents, such as legal complaints, prepared by attorneys on behalf of clients. One of the leading treatises on copyright concludes that there are “no valid grounds why legal forms such as contracts, insurance policies, pleadings and other legal documents should not be protected under the law of copyright.”<sup>59</sup> The literature agrees with this assessment, although many point out that

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53 17 U.S.C. § 102(a) (2013).

54 *Feist Publ'n's Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991); *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53 (1884).

55 *Feist*, 499 U.S. at 358; *Mazer v. Stein*, 347 U.S. 201, 218 (1954).

56 17 U.S.C. § 102(a) (2013).

57 *Id.*

58 17 U.S.C. § 101 (2013).

59 1-2 Melville B. Nimmer & David Nimmer, *Nimmer on Copyright* § 2.18[E] (2014) [hereinafter “Nimmer”].

copyright protection is often ignored by potential infringers.<sup>60</sup> Some commentators have indicated the few, possibly rare, situations in which copying legal documents would *not* give rise to liability for infringement.<sup>61</sup> The literature has not yet addressed the extent of copyright protection for the type of legal document analyzed in this paper: patent documents.<sup>62</sup>

## B. STANDARD LIMITATIONS ON COPYRIGHT

There are three doctrines in copyright which are especially important in limiting the rights of the copyright owner: the idea-expression dichotomy, the merger doctrine and the doctrine of fair use.

Under the idea-expression dichotomy, copyright protects expression but not any ideas, processes, concepts, principles or discoveries underlying that expression.<sup>63</sup> Similarly, facts cannot be protected by copyright.<sup>64</sup>

A related limitation on copyright is the merger doctrine. When there are only a limited number of ways to express an idea, these expressions are merged and as unprotectable as the idea itself.<sup>65</sup> The merger doctrine is particularly relevant for patent documents. A patent is rife with unprotectable “facts”, primarily the underlying technical details of the invention. In fact, the reader of a patent is most likely interested in only these facts, not in any expressive component of

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60 See, e.g., Stanley F. Birch, Jr., Copyright Protection for Attorney Work Product: Practical and Ethical Considerations, 10 J. Intell. Prop. L. 255, 256 (2003) (describing how one law firm copied "hundreds of pages of land restrictions and covenants" from another); Thomas G. Field, Jr, From Custom To Law in Copyright, 49 IDEA 125 (2008) (describing situations in which norms of lawyers copying practice-related documents have been misperceived as trumping copyright law).

61 Lisa P. Wang, The Copyrightability of Legal Complaints, 45 B.C. L. Rev 705 (2004) (concluding that legal complaints are copyrightable subject matter, and their authors likely would prevail in a copyright infringement suit); Davida H. Isaacs, The Highest Form of Flattery? Application of the Fair Use Defense Against Copyright Claims for Unauthorized Appropriation of Litigation Documents, 71 Mo. L. Rev. 391, 393 (2006) (arguing that the typical litigation document is copyrightable but sometimes fair use would permit its copying by others).

62 I did locate one article that references the issue in a two-sentence footnote: “The patent document itself is presumably a ‘work of the United States Government’ under 15 [sic 17] U.S.C. 105 (1988) and hence not subject to copyright protection. However, nothing precludes the publication of the patent application (in whole or in part) in an article, or book or otherwise.” A. Samuel Oddi, An Uneasier Case for Copyright Than for Patent Protection of Computer Programs, 72 Neb. L. Rev. 351, 435 n. 338 (1993). As discussed in Part V.G *infra*, a patent is almost certainly not a work of the U.S. Government.

63 17 U.S.C. § 102(b) (2013). See, e.g., *Baker v. Selden*, 101 U.S. 99, 104-05 (1879); *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121 (2d Cir. 1930).

64 *Harper & Row Publishers v. Nation Enters.*, 471 U.S. 539, 556 (1985).

65 *Apple Computer, Inc. v. Franklin Computer Corp.*, 714 F.2d 1240, 1253 (3d Cir. 1983), cert. dismissed, 464 U.S. 1033 (1984); *Morrissey v. Procter & Gamble Co.*, 379 F.2d 675, 678-79 (1st Cir. 1967).

the patent.

If there are only a limited number of ways to describe, e.g., a component of an invention, then there would be no copyright protection for any such description. This may be true for certain types of technical subject matter, such as standard machine components. Moreover, if the intended audience, people having ordinary skill in the pertinent field, would expect the subject matter to be described a particular way using particular terminology, this would further limit the number of ways in which the described technology could be expressed. Other ways of expressing an idea might be feasible because they are grammatically correct and not inaccurate, but they could put the drafter at risk of violating the enablement requirement.<sup>66</sup> For example, every person in the relevant field of the invention might understand a standard term such as “power supply”, but the same audience might consider a non-standard term such as “electrical load feeder” to be ambiguous or to have a meaning different from the one intended by the drafter. Terminology chosen to avoid the reach of the merger doctrine can jeopardize the patent rights that are the sole reason for filing a patent application.

Both the idea-expression dichotomy and the merger doctrine are designed to prevent copyright from harming the public by impeding the sharing of ideas. Similarly, the disclosure function of the patent system is designed to disseminate ideas, which are unprotectable by copyright. Therefore the two doctrines should play a prominent role in assessing the copyrightability of patents, as discussed below in Part V.

A final doctrine is the fair use defense.<sup>67</sup> A use which would otherwise be infringing is permitted if it constitutes fair use. The fair use doctrine requires courts “to avoid rigid application of the copyright statute when, on occasion, it would stifle the very creativity which that law is designed to foster.”<sup>68</sup> A four-factor test is employed to determine whether the actions of the accused infringer are considered fair use.<sup>69</sup> Courts weigh all four factors “in light of the purposes

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66 A patent must 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 relevant field to make and use the invention. 35 U.S.C. § 112(a) (2013).

67 17 U.S.C. § 107 (2013); Harper & Row, supra note 64 at 560-69; *Nihon Keizai Shimbun, Inc. v. Comline Bus. Data, Inc.*, 166 F.3d 65, 72-73 (2d Cir. 1999).

68 *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 577 (1994), quoting *Stewart v. Abend*, 495 U.S. 207, 236 (1990).

69 17 U.S.C. § 107 (2013); *Campbell*, 510 U.S. at 577-78; *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 560-61 (1985).

of copyright.”<sup>70</sup> The four factors include:

“the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;

the nature of the copyrighted work;

the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and

the effect of the use upon the potential market for or value of the copyrighted work.”<sup>71</sup>

Of particular relevance to the extent of copyright in patent documents is the fourth factor – the effect upon the potential market for or value of the copyrighted work. The fair use factors and their application are discussed below, leading to the conclusion that fair use applies to productive uses of patent documents, primarily because there is no market in patent documents.<sup>72</sup>

#### **IV. POTENTIAL INFRINGEMENT OF COPYRIGHT IN PATENTS**

This Part provides examples of the most anticipated uses of a patent which could be considered to infringe a copyright in that patent. There are generally two types of infringers in these examples. One is the drafter who incorporates portions of the earlier (copyrighted) patent into her own patent document. The other is a member of the public who desires to understand the copyrighted patent, perhaps to learn about the technology it describes or to avoid infringing the patent.

Copyright grants the copyright owner certain exclusive rights, among which we will consider three: reproduction, distribution, and creation of derivative works.<sup>73</sup> The exclusive right to reproduce the work extends not only to complete copies, but also to certain partial copies,<sup>74</sup> and is independent of whether that copy is sold.<sup>75</sup> The reproduction right would clearly be implicated at the moment that a drafter copies portions of a copyrighted patent into her own

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70 Campbell, 510 U.S. at 578.

71 17 U.S.C. § 107 (2013).

72 See infra Part V.B.

73 17 U.S.C. § 106 (2013).

74 See generally, *MAI Systems v. Peak Computer Inc.*, 991 F.2d 511 (9th Cir. 1993).

75 See, e.g., *Walt Disney Prods. v. Filmmation Assocs.*, 628 F. Supp. 871 (C.D. Cal. 1986).

patent document, or simply when an interested reader downloads the copyrighted patent from an online search engine.

Liability for distribution of a copyrighted work requires that the infringer actually disseminate copies, regardless of whether the infringer also makes those copies.<sup>76</sup> For example, when part of a copyrighted patent is incorporated into a subsequent patent document, anyone who provides the subsequent patent to another (e.g., via email, via postal mail to clients or other interested readers) distributes the copyrighted work.

A derivative work is defined as “a work based upon one or more preexisting works, such as a translation, . . . , abridgment, condensation or any other form in which a work may be recast, transformed, or adapted.”<sup>77</sup> A derivative work is created when a drafter includes portions of a copyrighted patent into her own patent document, though it may be different and may even improve upon the original work.

In summary, the two productive uses of a patent document described above would certainly give rise to a prima facie case of infringement of the copyright. I now turn to various limitations that in some situations would remove any infringement liability.

## V. LIMITATIONS ON COPYRIGHT IN PATENTS

In this Part I explain that, although a patent document is eligible for copyright protection, the author's exclusive rights are diminished by the act of filing the patent document as a patent application with the PTO. For simplicity, I assume that the patent application is drafted according to the following typical situation. The author of the copyrighted patent document, in consultation with one or more inventors, drafts an original work of authorship describing an invention. The author of the patent document does not copy another work or make a derivative work of any other copyrighted material, except possibly another patent document.<sup>78</sup> In addition, the author prepares the document intending it to be used only as a utility patent application. I ignore the

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<sup>76</sup> See *In re Napster, Inc. Copyright Litigation*, 377 F. Supp. 2d 796, 802-804 (N.D. Cal. 2005); Nimmer § 8.11[A].

<sup>77</sup> 17 U.S.C. § 101 (2013).

<sup>78</sup> I further assume that no “upstream” patent document incorporates any copyrighted work other than material included in other patent documents.

extremely rare situations in which the author intends the document to have additional uses.<sup>79</sup>

### **A. THE ENTIRE PATENT CAN BE FREELY REPRODUCED AND DISTRIBUTED**

The first and most clear limitation on copyright for patents is that the patent<sup>80</sup> itself (that is, the patent as a whole rather than a portion thereof) may be freely copied and distributed regardless of any copyright in the patent. This certainly makes intuitive sense, since the purpose of the patent system is to publish patents for the public.<sup>81</sup> Below I discuss two significant doctrines which mandate this limitation. First, the patentee has granted the PTO and the public an implied license to copy and reproduce the patent. Second, since a patent imposes obligations on the public like a statute, the patent must be open to public, just as statutes and similar legislative documents must be freely accessible.

#### Implied license

Although exclusive licenses under a copyright must be in writing,<sup>82</sup> nonexclusive licenses do not<sup>83</sup>. A nonexclusive license may therefore be granted orally, and may even be implied from conduct.<sup>84</sup> Anyone authorized by the copyright owner to use the copyrighted work is not an infringer of the copyright with respect to such use.<sup>85</sup>

Most circuits recognize the creation of an implied license when “(1) a person (the licensee) requests the creation of a work, (2) the creator (the licensor) makes that particular work and delivers it to the licensee who requested it, and (3) the licensor intends that the licensee-requestor copy and distribute his work.”<sup>86</sup> The above three criteria are sufficient but not

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79 For example, I assume that the application does not include portions of a poem.

80 For simplicity I will often refer to the “patent” instead of “the patent and the published patent application, if any.”

81 See supra note 24.

82 Any transfer of copyright ownership must be in writing. 17 U.S.C. § 204(a) (2013). One type of transfer of copyright ownership is an exclusive license. 17 U.S.C. § 101 (2013).

83 17 U.S.C. § 101 (2013) (A “transfer of copyright ownership” does not include nonexclusive licenses). *Jacob Maxwell, Inc. v. Veeck*, 110 F.3d 749, 752 (11th Cir. 1997); *I.I.A.E., Inc. v. Shaver*, 74 F.3d 768, 775 (7th Cir. 1996); *MacLean Assoc., Inc. v. Wm. M. Mercer-Meidinger-Hansen, Inc.*, 952 F.2d 769, 778 (3d Cir. 1991); *Effects Assocs., Inc. v. Cohen*, 908 F.2d 555, 558 (9th Cir. 1990), cert. denied sub nom.; *Danforth v. Cohen*, 498 U.S. 1103 (1991).

84 *Nimmer* § 10.03[A][7]. See, e.g., *Effects Associates, Inc. v. Cohen*, 908 F.2d 555, 558 (9th Cir. 1990).

85 *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 433 (1984).

86 *I.A.E., Inc. v. Shaver*, 74 F.3d 768, 776 (7th Cir. 1996) (citing *Effects Associates, Inc. v. Cohen*, 908 F.2d 555,

necessary for the creation of an implied license to a copyright. Instead, the intent of the copyright owner to grant a license is dispositive.<sup>87</sup>

Several statutes and regulations give clear notice to all potential patent applicants that any patent can be reproduced by the PTO and the public. Therefore, by filing a patent application the applicant impliedly agrees to the reproduction of her patent document.

I first briefly analyze the three step implied license test, though it is not dispositive, in order to determine whether it might be satisfied when a patent applicant files a patent application with the PTO. The first step<sup>88</sup> is perhaps the least clearly satisfied. Although the PTO might not affirmatively request a *specific* application from a *particular* applicant, a primary responsibility of the PTO certainly is to accept patent applications from any member of the public. The PTO clearly specifies the procedural requirements for applications,<sup>89</sup> and invites any member of the public to file her patent application. From this it is reasonable to infer that any patent application filed with the PTO is created for the PTO and not for another use, which seems to be the policy on which the first step is predicated.

The second and third requirements are clearly satisfied. The patent applicant makes that patent application and delivers it to the PTO, and the applicant intends that the PTO will copy and distribute the patent once it is granted. The applicant clearly has at least constructive notice, and probably actual knowledge, that the patent document will be published and reproduced by the PTO and the public. Not only are there unambiguous statutory and regulatory provisions mandating publication,<sup>90</sup> every patent has been printed upon issuance since the first U.S. patent

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558-59 (9th Cir. 1990) (footnote added); *Asset Mktg. Sys. v. Gagnon*, 542 F.3d 748, 754-55 (9th Cir. 2008).

87 See, e.g., *Nelson-Salabes, Inc.*, 284 F.3d at 515 (intent is “the determinative question”); *John G. Danielson, Inc. v. Winchester-Conant Props., Inc.*, 322 F.3d 26, 40 (1st Cir. 2003) (“The touchstone for finding an implied license ... is intent.”); *Estate of Hevia v. Portrio Corp.*, 602 F.3d 34, 41 (1st Cir. 2010) (“We ask whether “the totality of the parties' conduct indicates an intent to grant such permission ”); *Johnson v. Jones*, 149 F.3d 494, 502 (6th Cir. 1998).

88 It is not clear from the case law that the creation of an implied license *requires* some affirmative request from the licensee to create a specific work. It is true that many implied license cases have involved a commercial entity requesting the creation of a work, e.g., from a contractor who later asserts no intention of transferring the copyright. However, there have been no reported cases holding that a license *failed* to be created because only the last two steps were satisfied.

89 For example, the PTO has promulgated regulations regarding procedural requirements for patent applications. 37 C.F.R. § § 1.51 – 1.58 (2013).

90 See, e.g., 35 U.S.C. § 122(b) (2013) (“each application for a patent shall be published”); 35 U.S.C. § 9 (2013) (“The Director [of the PTO] may furnish certified copies of specifications and drawings of patents ..., and of other records available either to the public or to the person applying therefor.”); 35 U.S.C. § 10(a)(1) (2013) (“The Director may publish ... [p]atents and published applications ... together with copies of the same”); 35 U.S.C. § 12 (2013) (“The Director may supply copies of ... patents and published applications ... to public

in 1790.<sup>91</sup>

Aside from the three step test for showing the existence of an implied copyright license, it is likely that the applicant who files a patent application has understood and acquiesced in the publication of the patent application by the PTO. The patent statute clearly requires that all patent applications be published, and lists six exceptions to this requirement. None of these exceptions involve anything involving copyrights or possible copyright infringement. The PTO has no discretion to withhold publication of a patent or application in any other circumstances.<sup>92</sup>

The patent statute requires that “each application for a patent shall be published ... promptly after the expiration of a period of 18 months from the earliest filing date.”<sup>93</sup> The statute also lists several exceptions, including:

"An application shall not be published if that application is—

- (i) no longer pending;
- (ii) subject to a secrecy order under section 181;
- (iii) a provisional application filed under section 111(b); or
- (iv) an application for a design patent filed under chapter 16.”<sup>94</sup>

Another exception provides for non-publication if the invention “has not and will not be the subject of an application filed in another country.”<sup>95</sup> Finally, the only other situation in which an application will not be published is “if the publication or disclosure of such invention would be detrimental to the national security.”<sup>96</sup> This provision addresses the same concern as the “secrecy order” in the list above, but applies when the PTO becomes aware of a potential

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libraries”). Various PTO regulations generally match these statutory provisions. See, e.g., 37 C.F.R. § 1.11(a) (2013), § 1.211(a) (2013), and § 1.215(a) (2013).

91 For example, every patent ever granted can be viewed using the PTO's US Patent Full-Page Images database, which is available at <http://patft.uspto.gov/netahtml/PTO/patimg.htm>. The contents of this database include all patents issued since 1790, as described at Patent Full-Text Database Contents, available at <http://patft.uspto.gov/netahtml/PTO/help/contents.htm>.

92 Not only must the PTO follow the statutory mandates, the PTO has no substantive rulemaking authority. See *infra* notes 102 - 105 and accompanying text.

93 35 U.S.C. § 122(b)(1)(A) (2013).

94 35 U.S.C. § 122(b)(2)(A) (2013).

95 35 U.S.C. § 122(b)(2)(B) (2013).

96 35 U.S.C. § 122(d) (2013).

national security concern that other government agencies or departments have missed.<sup>97</sup>

Since the statute emphatically commands that each application be published, and since the statute provides only six exceptions to this mandate, the statute can be interpreted as providing no additional exceptions.<sup>98</sup> Accordingly, there is no statutory provision to withhold publication of a patent because it was copyrighted or included copyrighted material. An applicant submitting a patent application to the PTO must understand and agree that the PTO will publish her application notwithstanding any copyright in that document.

Finally, certain PTO regulations provide applicants with notice that any member of the public can freely reproduce any patent. By filing her application, the applicant impliedly grants the public a license to reproduce her patent document. PTO regulations contemplate copyrights in patent documents by permitting a copyright notice, such as “© 2014 John Doe,” to be placed in the application adjacent to copyrighted material.<sup>99</sup> If the applicant desires to include a copyright notice, then the applicant must also include an “authorization” stating that the copyright owner “has no objection to the facsimile reproduction by anyone of the patent document or the patent disclosure, as it appears in the Patent and Trademark Office patent file or records.”<sup>100</sup>

This regulation serves an important function relating to copyright protection for patent documents. The regulation extracts from the applicant the agreement to permit “the facsimile reproduction by anyone of the patent document or the patent disclosure.” That is, when an applicant includes this statement in the patent application, the applicant is granting a license according to the plain terms of the statement.

Similarly, when an applicant fails to include the required copyright notice in her patent application, it would be reasonable to assume that she has evinced an intent to refrain from exercising any copyright she may have had in the document. On the other hand, since a notice is

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97 Secrecy orders are issued on the initiative of an entity such as the Defense Department or the Atomic Energy Commission. 35 U.S.C. § 181 (2013). In contrast, a similar determination is made by the PTO under the authorization of 35 U.S.C. § 122(d) (2013).

98 Under this rule of “*expressio unius est exclusio alterius*,” the expression of one subject, object, or idea in a statute is the exclusion of other subjects, objects, or ideas. Clifton Williams, *Expressio Unius Est Exclusio Alterius*, 15 Marquette L. Rev. 191 (1931). See *Botany Mills v. United States*, 278 U.S. 282, 289 (1929) (“When a statute limits a thing to be done in a particular mode, it includes the negative of any other mode.”); *National R.R. Passenger Corp. v. National Ass'n of R.R. Passengers*, 414 U.S. 453, 458 (1974).

99 37 C.F.R. § 1.71(d) (2013).

100 37 C.F.R. § 1.71(e) (2013).

not required to obtain copyright protection in a work,<sup>101</sup> the mere lack of a notice per se need not imply the grant of any license.

There is another important caveat to the above analysis of the PTO's copyright notice regulation. The PTO does not have substantive rulemaking authority,<sup>102</sup> unlike most other federal agencies.<sup>103</sup> That is, the PTO cannot promulgate any regulations that affect any rights or obligations.<sup>104</sup> The broadest of the PTO's rulemaking powers authorizes the promulgation of regulations directed only to the conduct of proceedings in the PTO.<sup>105</sup> Therefore, the PTO's regulations relating to a copyright notice in a patent document are merely procedural. They permit the applicant to include the notice provided the form of the notice is as specified by the regulations. The PTO's regulations regarding copyright notice cannot alter any copyright or other substantive rights of the patent applicant or any person. Failure to include the copyright authorization specified by the PTO does not imply that the PTO is somehow in a position to deny copyright protection to the applicant. Similarly, the PTO regulations cannot in any way *grant* an applicant copyright protection or broaden the extent of copyright protection in exchange for including the required notice in her patent application.

Finally, even if an applicant were capable of exercising all exclusive rights under the copyright law for her patent document, that still would not permit the applicant to prevent the PTO from publishing her patent document. At best she could recover damages for unauthorized publication of her work. The doctrine of sovereign immunity severely limits lawsuits against the

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101 Inclusion of a copyright notice and other formalities are not required for works created after March 1, 1989.

See Christopher Sprigman, Reform(aliz)ing Copyright Law, 57 Stan. L. Rev. 485, 488-91 (2004).

102 See, e.g., Koninklijke Philips Elecs. N.V. v. Cardiac Sci., 590 F.3d 1326, 1336 (Fed. Cir. 2010); Tafas v. Doll, 559 F.3d 1345, 1352 (Fed. Cir. 2009), reh'g en banc granted, 328 F. App'x 658 (Fed. Cir. 2009), appeal dismissed, Tafas v. Kappos, 586 F.3d 1369, 1371 (Fed. Cir. 2009); Cooper Techs. Co. v. Dudas, 536 F.3d 1330, 1336 (Fed. Cir. 2008); Merck & Co. v. Kessler, 80 F.3d 1543, 1549-50 (Fed. Cir. 1996).

103 Stuart Minor Benjamin & Arti K. Rai, Who's Afraid of the APA? What the Patent System Can Learn from Administrative Law, 95 Geo. L.J. 269, 297 (2007) ("First, unlike most significant agencies, the PTO does not have any significant substantive rulemaking authority."). See also, Sarah Tran, Patent Powers, 25 Harv. J. Law & Tec 609, 614 (2012) (noting that many other agencies, such as the FTC, FDA, and FCC, are instead vested with the authority to issue any regulations that are "necessary or appropriate" to administer their respective organic acts). But see Melissa F. Wasserman, The Changing Guard of Patent Law: Chevron Deference for the PTO, 54 WM. & Mary L. Rev. 1959 (2013) (arguing that the PTO has received some substantive rulemaking authority under the recent America Invents Act).

104 A rule is substantive when it effects a change in existing law or policy which affects individual rights and obligations. Animal Legal Defense Fund v. Quigg, 932 F.2d 920, 927 (1991) (quoting Cubanski v. Heckler, 781 F.2d 1421, 1426 (9th Cir.1986), vacated as moot sub nom., Bowen v. Kizer, 485 U.S. 386, 108 S. Ct. 1200, 99 L. Ed. 2d 402 (1988)).

105 Merck & Co. v. Kessler, 80 F.3d 1543, 1549-1550 (Fed. Cir. 1996)

Federal Government,<sup>106</sup> including its agencies such as the PTO. The Federal Government has specifically waived its immunity from copyright infringement lawsuits.<sup>107</sup> This waiver applies to federal agencies such as the PTO.<sup>108</sup> Remedies in such a copyright suit are limited to “recovery of . . . reasonable and entire compensation as damages for such infringement, including the minimum statutory damages”, and cannot include attorneys' fees, an injunction, or statutory damages in excess of the minimum.<sup>109</sup>

#### Patents, like statutes, are not protected by copyright

It has long been the case that judicial opinions and laws cannot be protected by copyright.<sup>110</sup> The 1976 Copyright Act codified this doctrine by explicitly denying protection to federal statutes and regulations,<sup>111</sup> but the reasoning of the earlier case law is seen as applicable to state statutes and regulations as well.<sup>112</sup>

Similarly, laws which incorporate otherwise copyrightable third party material can be exempt from copyright protection. In *Veeck v. Southern Building Code Congress International, Inc.*<sup>113</sup> the Fifth Circuit held that the adoption by a municipality of a privately-created model code renders the resulting law free from copyright protection. The Court held that “as law, the model codes enter the public domain and are not subject to the copyright holder's exclusive prerogatives.”<sup>114</sup>

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106 United States v. Testan, 424 U.S. 392, 399 (1976); United States v. Sherwood, 312 U. S. 584, 586 (1941) 107 28 U.S.C. § 1498(b) (2011).

108 See *Boyle v. United States*, 200 F.3d 1369, 1373 (Fed. Cir. 2000) (“The plain language of the statute states that the United States has waived sovereign immunity in three instances: (1) when the United States itself infringes a copyright, (2) when a corporation owned or controlled by the United States infringes, and (3) when a contractor, subcontractor, or any person, firm, or corporation, acting for the Government and with its authorization or consent, infringes.”).

109 See 28 U.S.C. § 1498(b) (2011) (the “exclusive action which may be brought” is for recovery of his reasonable and entire compensation as damages for such infringement, including the minimum statutory damages set forth in 17 U.S.C. § 504(c) ); 28 U.S.C. § 2412(a) (2011) (costs do not include the fees and expenses of attorneys).

110 *Wheaton v. Peters*, 33 U.S. (8 Pet.) 591, 668 (1834) (“no reporter has or can have any copyright in the written opinions delivered by this Court. . .” and “Statutes were never copyrighted. . . it is the bounden duty of government to promulgate its statutes in print . . .”); *Banks v. Manchester*, 128 U.S. 244 (1888).

111 17 U.S.C. § 105 (“Copyright protection under this title is not available for any work of the United States Government”).

112 See generally L. Ray Patterson & Craig Joyce, *Monopolizing the Law: The Scope of Copyright Protection for Law Reports and Statutory Compilations*, 36 U.C.L.A. L. Rev. 719, 751-58 (1989); 1 Nimmer § 5.06[C] at 5-92 (“state statutes, no less than federal statutes, are regarded as being in the public domain”).

113 293 F.3d 791 (5th Cir. 2002).

114 *Id.* at 793.

On the other hand, mere reference in a law to a copyrighted source as a legal standard does not lead to loss of copyright protection.<sup>115</sup> In determining whether a government's use of copyrighted material extinguishes the author's rights, courts have found it useful to consider two factors: whether the public requires access to the work, and whether the authors had sufficient incentives to create the work.<sup>116</sup>

When viewed through this lens, it is clear that patents are very similar to statutes, and should be free of copyright protection for the same reasons. Like a statute, a patent imposes obligations on every member of the public: to avoid infringing any claim of the patent, even unintentionally.<sup>117</sup> There is also a substantial penalty for violating these obligations.<sup>118</sup> These aspects of the patent laws create a very strong public interest in understanding the obligations that are defined by patents. For this reason there is a substantial body of case law predicated on the assumption that interested members of the public are able to access and understand patents.<sup>119</sup>

In the remaining sections of this Part, I turn away from the example of wholesale reproduction of the copyrighted patent, which is almost certainly permitted according to the analysis above. Instead, below it is assumed that the potentially infringing use of the patent involves copying only a portion of the patent or creating some derivative work of the patent. For these types of potentially infringing uses other doctrines should permit the use notwithstanding any copyright in the patent document. I also conclude this Part with a number of practical impediments to asserting a copyright in a patent.

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115 *CCC Information Services, Inc. v. Maclean Hunter Market Reports*, 44 F.3d 61, 74 (2d Cir. 1994) (holding that a state's reference to a copyrighted work as a legal standard for valuation does not destroy the copyright).

116 *County of Suffolk v. First American Real Estate Solutions, Inc.*, 261 F.3d 179, 193-94 (2d Cir. 2001) (citing *Practice Mgmt. Info. Corp. v. AMA*, 121 F.3d 516, 518-19 (9th Cir. 1997) and *Bldg. Officials & Code Adm'r v. Code Tech., Inc.*, 628 F.2d 730, 734-35 (1st Cir. 1980), both of which rely on *Banks v. Manchester*, 128 U.S. 244 (1888)); *Veeck*, supra note 113.

117 35 U.S.C. § 271 imposes liability on anyone who “makes, uses, offers to sell, or sell any patented invention”, and for various other acts involving patented inventions. Direct patent infringement is a strict liability claim. See, e.g., *BMC Res., Inc. v. Paymentech, L.P.*, 498 F.3d 1373, 1381 (Fed. Cir. 2007); *In re Seagate Tech., Inc.*, 497 F.3d 1360, 1368 (Fed. Cir. 2007) (en banc).

118 The penalty for patent infringement is payment of “damages adequate to compensate for the infringement but in no event less than a reasonable royalty”. 35 U.S.C. § 284. Certain conduct before the patent is granted can impose liability as well. 35 U.S.C. § 154(d). The cost of patent litigation is a significant burden as well.

119 See, e.g., *Wanlass v. GE*, 148 F.3d 1334, 1343 (Fed. Cir. 1998) (Rader, J., dissenting) (referencing “the fundamental principle that the public has a duty to avoid infringement”); *Halliburton Energy Servs. v. M-I LLC*, 514 F.3d 1244, 1249 (Fed. Cir. 2008) (“competitors cannot avoid infringement” unless there is a strong “public notice function of patent claims”).

## B. FAIR USE

Even where a prima facie case of copyright infringement exists, the doctrine of fair use can shield certain conduct from liability.<sup>120</sup> The fair use doctrine compels courts “to avoid rigid application of the copyright statute when, on occasion, it would stifle the very creativity which that law is designed to foster.”<sup>121</sup> The statute outlines types of uses which would constitute fair use, including “reproduction . . . for purposes such as criticism, comment, news reporting, teaching . . . , scholarship, or research”.<sup>122</sup> A four-factor test is employed to determine whether the activities of the accused infringer constitute permissible fair use.<sup>123</sup> Courts weigh all four factors “in light of the purposes of copyright.”<sup>124</sup>

Below I describe the application of the fair use factors to the reuse of copyrighted patent documents in subsequent patent documents. In summary, it is likely that the fair use doctrine would excuse this type of copying. Reuse of patent documents not only would benefit the public, but also would leave the copyright owner no worse off.

The first fair use factor is the purpose and character of the use, which depends on considerations such as the degree to which the new work is transformative, the work's potential public benefit, and whether the use was commercial.<sup>125</sup> Turning first to the transformation inquiry, of significant note is whether the copy “merely supersedes the object of the original creation” or “instead adds something new, with a further purpose or different character, altering the first with new expression, meaning, or message.”<sup>126</sup> The more transformative the copy, the more likely it is to constitute fair use.<sup>127</sup> If the new use “adds value to the original” such as by using the original work as raw material “in the creation of new information, new aesthetics, new insights and understandings” then this use “is the very type of activity that the fair use doctrine

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120 17 U.S.C. § 107 (2013). See *supra* Part III.B.

121 *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 577 (1994), quoting *Stewart v. Abend*, 495 U.S. 207, 236 (1990).

122 17 U.S.C. § 107 (2013).

123 17 U.S.C. § 107 (2013); *Campbell*, 510 U.S. at 577-78; *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 560-61 (1985).

124 *Campbell*, 510 U.S. at 578.

125 See *Id.*; *Sega Enters. Ltd. v. Accolade, Inc.*, 977 F.2d 1510, 1523 (9th Cir. 1992).

126 *Campbell*, 510 U.S. at 579 (internal quotations omitted).

127 *Id.*

intends to protect for the enrichment of society.”<sup>128</sup>

Copying a portion of an earlier patent document for use in a subsequent patent document should be considered a transformative use. The purpose of the original patent application is to comply with the formal obligations necessary to receive patent rights in the invention. Specifically, the application must disclose certain technical information on how to make and use the invention. Only the underlying non-copyrightable ideas, systems, methods of operation, concepts, principles or discoveries matter in determining the patentability of the application; the manner in which such information is expressed is irrelevant to patentability. Whatever “object” there may be for the original patent application is therefore both completely functional and wholly unaffected by subsequent copying for use in subsequent patents. No amount of such copying can “supersede” the use of the original patent application because the application stands alone in the determination of patentability – subsequent applications do not enter into this determination.

Moreover, this type of copying enriches society because it utilizes the original patent as raw material in the creation of new information: a description of a new invention different from the original. Even if the entirety of the original patent document is utilized in a subsequent patent, such as in an improvement patent which adds to the original material, an exact copy of a copyrighted work nevertheless can be transformative.<sup>129</sup>

This type of copying also benefits the public by enhancing a goal of the patent system: the creation of patent documents that disclose to the public the details of novel inventions.<sup>130</sup> This disclosure is intended to facilitate the study and improvement of patented subject matter by the public.<sup>131</sup> For this reason patents frequently incorporate by reference material from previous patents.<sup>132</sup> Such a reference can simply identify the previous patent, e.g., by its unique patent number, and indicate which paragraphs of the patent are relied upon. However, the intelligibility of the document could suffer if the reader were forced to navigate a maze of several referenced

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128 *Castle Rock Entm't, Inc. v. Carol Publ'g Grp., Inc.*, 150 F.3d 132, 142 (2d Cir. 1998).

129 See *Perfect 10, Inc. v. Amazon.com, Inc.*, 508 F.3d 1146, 1165 (9th Cir. 2007) (holding that the use of original images in a computer search index served the new purpose of creating an electronic reference); *A.V. ex rel. Vanderhye v. iParadigms, LLC*, 562 F.3d 630, 638 (4th Cir. 2009) (holding that an exact copy can have a transformative function or purpose).

130 See *supra* notes 24 – 28.

131 *Integra Lifesciences I, Ltd. v. Merck KGaA*, 331 F.3d 860, 875 (Fed. Cir. 2003) (Newman, J., dissenting).

132 See *infra* part V.D.

documents rather than read all of the desired material in a single document. That is, the document could be more readily understood if references were replaced with the referenced text.

Finally, the last aspect of the first fair use factor, whether the use was commercial, does not ask “whether the sole motive of the use is monetary gain, but whether the user stands to profit from exploitation of the copyrighted material without paying the customary price.”<sup>133</sup> It might at first appear that the copying of a portion of a patent document for use in a subsequent patent application is commercial. After all, this copying is motivated in part by a desire to lower the costs of preparing a patent application. However, in these circumstances there is no customary price paid to the copyright owner since there is no market for such documents. Similarly, there is no use of the original patent that can be superseded by the use of portions in subsequent applications. In addition, the copying patent attorney may not profit at all from reusing portions of an earlier patent document if the attorney bills the client by the hour. Though copying would allow the attorney to draft the application in less time, she also would charge her client less. The time savings for the attorney would not translate to any cost savings or increased revenue.

Turning to the second fair use factor, the nature of the copyrighted work, “[t]he scope of fair use is greater when 'informational' as opposed to more 'creative' works are involved.”<sup>134</sup> “The law generally recognizes a greater need to disseminate factual works than works of fiction or fantasy.”<sup>135</sup>

Patent documents are clearly informational and factual, and are prepared and filed in order to acquire patent rights for the inventor. Patent documents describe technical material, and are meant to convey information sufficient to satisfy the enablement requirement.<sup>136</sup> Any expressive content of a patent application almost certainly serves no purpose whatsoever, since the application must only satisfy the various requirements for acquiring and maintaining patent rights. The technical information must be accurate, complete, and unambiguous. Notwithstanding the fact that the author of a patent document may employ creativity to convey the ideas and facts in a patent document, it is primarily the ideas and facts themselves that are of

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133 Harper & Row Publishers, Inc. v. Nation Enters., 471 U.S. 539, 560 (1985).

134 Hustler Magazine, Inc. v. Moral Majority, Inc., 796 F.2d 1148, 1153-54 (9th Cir. 1986).

135 Harper, 471 U.S. at 563. See also Stewart v. Abend, 495 U.S. 207, 237 (1990) (stating that “fair use is more likely to be found in factual works than in fictional works.”).

136 See supra Part II.A.

value to those who read that patent document.<sup>137</sup>

Moreover, patent documents are not even created with the intention of benefiting from the protection of the copyright law, as there is no market for patent documents. Similarly, copyright protection is not necessary to the dissemination of the underlying technical information in patent documents. The patent system has always been designed to disseminate the technical details of inventions, ideas, and procedures to the public.<sup>138</sup> Copyright is utterly superfluous in this regard. The nature of this type of work is such that fair use should be afforded a broad scope.

Application of the third fair use factor, the amount and substantiality of the portion used in relation to the copyrighted work as a whole, depends on the amount that the second patent drafter copies. The inquiry focuses on “whether the extent of . . . copying is consistent with or more than necessary to further the purpose and character of the use.”<sup>139</sup>

Assuming the most extreme example, the entirety of an earlier patent is copied, for example in order to describe an improvement invention. Additional text describing the particular improvement (e.g., an added component) would simply be added to the text of the earlier patent. Copying a work in its entirety can weigh against fair use, but is not dispositive.<sup>140</sup> Accordingly this factor might weigh against fair use, but perhaps not if the extent of copying was “consistent with” the desirable use of describing technology efficiently.

The final factor, the effect upon the potential market for or value of the copyrighted work, “is undoubtedly the single most important element of fair use.”<sup>141</sup> “Fair use, when properly applied, is limited to copying by others which does not materially impair the marketability of the work which is copied.”<sup>142</sup> In assessing the marketability of a work, the court considers only those uses that creators of the original work would in general develop, or license others to develop.<sup>143</sup>

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137 Cf. *American Geophysical Union v. Texaco Inc.*, 60 F.3d 913, 925 n.11 (2d Cir. 1994).

138 See supra Part II.A. The first US patent statute explicitly codified the goal of public dissemination. Section 2 of the Patent Act of 1790 provided the “specification shall be so particular” as “to enable a workman or other person skilled in the art or manufacture . . . to make, construct, or use” the invention “*to the end that the public may have the full benefit thereof*, after the expiration of the patent term.” An Act to Promote the Progress of Useful Arts, ch. 7, sec. 2, 1 Stat. 109 (Apr. 10, 1790) (emphasis added).

139 *Castle Rock*, supra note 128 at 144.

140 *Sony*, supra note 7 at 450.

141 *Harper & Row*, 471 U.S. at 566.

142 *Id.* at 566 – 77.

143 *Campbell*, supra note 121 at 592; *American Geophysical*, supra note 134 at 930 (“Only an impact on potential licensing revenues for traditional, reasonable, or likely to be developed markets should be legally cognizable when evaluating a secondary use's effect upon the potential market.”).

Quite simply, there is *no* market for a copyrighted patent document, so there are no uses which could impair the marketability of any patent document. While a patent might have significant value because of its patent rights, the patent document itself and any copyright in the document have no value. There is no evidence that the creator of a patent document has ever sold the document or otherwise benefited in any way from any market for the document, aside from any underlying patent rights. This is logical since patents are, and have always been, freely available and intended solely to disclose inventions to the public.<sup>144</sup>

Moreover, since patent documents are written merely to satisfy the legal requirements for obtaining patent rights, their contents are often less useful than even patent policy desires. One of the most frequently noted faults with patent disclosures is that patents are extremely difficult to understand,<sup>145</sup> and there is little faith that the technical information disclosed is entirely accurate.<sup>146</sup> Consequently, at least according to many commentators, patents are infrequently used by the very audience for which they are intended: technologists seeking to learn about the state of the art.<sup>147</sup> This phenomenon is additional evidence that there is no market for patent documents.

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144 See *supra* Part V.A.

145 See, e.g., Jeanne C. Fromer, Patent Disclosure, 94 Iowa L. Rev. 539, 560 (2009) (“technologists, trained in the relevant art, frequently find the legalized jargon in the patent document incomprehensible”); Sean B. Seymore, The Teaching Function of Patents, 85 Notre Dame L. Rev. 621, 626 (2010) (arguing that patents have “little technical value” because they are “unreadable”); Mark A. Lemley, The Myth of the Sole Inventor, 110 Mich. L. Rev. 709, 746 (2012) (“many of those patents obfuscate the technology at issue, deliberately or because we lack a clear language for communicating some types of inventions”); Note, The Disclosure Function of the Patent System (or Lack Thereof), 118 Harv. L. Rev. 2007, 2025-26 (2005) (legal rules “create incentives for patent applicants to draft their disclosures opaquely”).

146 See, e.g., Alan Devlin, The Misunderstood Function of Disclosure in Patent Law, 23 Harv. J.L. & Tech. 401, 403 (2010) (“[T]he extent to which patent documents successfully teach the inner workings of cutting-edge technologies is quite limited.”); Seymore, *supra* note 145, at 626 (arguing that patents are often not easily reproducible); Lisa Larrimore Ouellette, Do Patents Disclose Useful Information, 25 HARV. J.L. & TECH. 545, 534-35 (2012) (only 38% of survey respondents in the nanotechnology field believed that patents they were reading were reproducible); The Disclosure Function of the Patent System (or Lack Thereof), *supra* note 145 at 2025-26 (“[m]any patented inventions cannot be recreated or put into use based on the information in the patent itself”).

147 See, e.g., Fromer, *supra* note 145, at 560 (“[A] good deal of evidence suggests that technologists do not find that [the patent document] contains pertinent information for their research.”); The Disclosure Function, *supra* note 145, at 2023 (“patent disclosures and the patent database as a whole are poor media for communicating technical information to engineers”); Mark Lemley, Ignoring Patents, 2008 Mich. St. L. Rev. 19, 21 (2008) (arguing that researchers and companies “simply ignore patents. Virtually everyone does it.”); Lemley, *supra* note 145 at 746 (“the payoff from reading those [patent] applications is often dubious.”); Wesley M. Cohen et al., R&D Spillovers, Patents and the Incentives to Innovate in Japan and the United States, 31 Res. Pol’y 1349, 1362-64 (2002) (presenting empirical evidence that in the United States patents rank third behind publications and informal information exchange as information sources for disseminating research and development).

The analysis above indicates a strong likelihood that the reuse of a patent document in a subsequent patent document would constitute fair use. A recent set of district court decisions deal with another type of fair use involving the patent system. They evaluate fair use in light of the goals of the patent system, and so they may be helpful in evaluating the fair use arguments above.

Publishers sued law firms for copying scientific journal articles that were used in proceedings before the PTO to demonstrate the relevant prior art.<sup>148</sup> The law firms copied the articles and distributed the copies among firm lawyers via email. In two of the cases the defendants' motions for summary judgment were granted because the defendants were entitled to the fair use defense as a matter of law.<sup>149</sup> The third case remains pending before the court in the Northern District of Illinois.

Because scientific articles are similar to patent documents, the fair use analysis of scientific articles has many parallels with the analysis of copyright in patent documents. Both types of documents are intensely factual rather than expressive, and thus are entitled to a broader scope of fair use. Like the copying of patent documents, the copying of scientific articles for patent proceedings furthers a goal of the patent system, is not designed to yield a profit, and does not detract from the market in the original work.

It is worth highlighting that in these publisher lawsuits the copyrighted journal articles indisputably had a large and lucrative market of scientific readers. Nevertheless the courts determined that the copying for patent proceedings did not affect the market. Instead the copying was merely to provide information required by the PTO, and more generally by the patent system. Given that copying patent documents has *no* effect on the market for these works, because there is no market for copyrighted patent documents, the case for fair use protecting that activity is even stronger than it is for copying the scientific journal articles.

### **C. DANGERS FROM THE IDEA-EXPRESSION DICHOTOMY**

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148 American Institute of Physics and John Wiley & Sons, Inc. v. Schwegman, Lundberg & Woessner, P.A. (D. Minn. Civ. No. 12-528); American Institute of Physics and Blackwell Publishing, Ltd. v. Winstead PC (N.D. Tex. No. 3:12-CV-1230); Wiley & Sons, Ltd. and American Institute of Physics v. McDonnell Boehnen Hulbert & Berghoff LLP (N.D. Ill. No. 12 C 1446).

149 Institute of Physics and John Wiley & Sons, Inc. v. Schwegman, Lundberg & Woessner, P.A. and Am. Inst. of Physics v. Winstead.

Copyright protection does not extend to any facts or ideas, only to the author's expression of those ideas.<sup>150</sup> The statutory codification of the idea-expression dichotomy explicitly excludes procedures, processes, systems, and methods of operation,<sup>151</sup> all of which are the subject matter of patents. Any copyright in a patent certainly would not confer any monopoly rights in ideas such as the disclosed invention itself, and likewise could not prevent others from describing the invention in an original manner.

Herein lies a pragmatic and subtle, but powerful, obstacle to enforcing a copyright in a patent. Since every patent is rife with unprotectable facts, methods, and systems, the defendant in a copyright suit should attempt to demonstrate that enforcement of the copyright would hamper the communication of the underlying ideas. This would force the plaintiff into an uncomfortable analysis of the ideas and expression in her patent.

This analysis of ideas and expression can endanger the copyrighted patent in two ways. First, the patentee, her opponent, and the court would have to identify the particular ideas, and therefore explain exactly what the underlying ideas are. This is anathema to patent attorneys; characterizing the invention can be, and often is, used against the patentee to curtail patent rights by delineating exactly what the invention does *not* entail.<sup>152</sup> Potential infringers can use such characterization to avoid patent infringement and to invalidate the patent. While a patent owner might begrudgingly accept a certain amount of such characterization during patent litigation, she would likely be less willing to risk patent invalidation merely to enforce a copyright in the patent document.

Second, drawing the line between ideas and expression will affect the interpretation of the patent, and thus could affect the patent's scope. To show broad copyright protection for a portion of a patent, the copyright owner would show that the underlying idea was expressible in many ways.<sup>153</sup> This necessitates distinguishing the ideas from the ways to express the ideas. In such parsing, the patentee must take care not to inadvertently reduce the scope of the idea, since that

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150 17 U.S.C. § 102(b) (2013). See *supra* Part III.B.

151 *Id.*

152 *Seymore*, *supra* note 145, at 635-36 (explaining that “the Federal Circuit has identified several linguistic pitfalls that the patentee must evade in order to avoid a narrow claim construction” including so-called “patent profanity”).

153 Otherwise the merger would prevent copyright protection for any expression of the idea.

would reduce the scope of what the patent could protect. The patentee's opponent, and possibly the court as well, would offer different and unfavorable perspectives on the extent of the unprotectable idea.

#### **D. IMPLIED LICENSE TO DERIVATIVE WORKS**

As described in Part V.A, when the creator of the patent document files it as an application with the PTO, an implied license is granted to the PTO and the public to reproduce and distribute the patent as a whole. Another PTO regulation provides each patent applicant with notice that some or all of her patent may be reproduced in a subsequent patent application.

The PTO regulations allow any later-filed patent application to incorporate an earlier patent or application. Incorporation by reference provides a method for integrating material from various documents into a host document, and the material is treated as part of the host document as if it were explicitly contained therein.<sup>154</sup> A portion or the entirety of a prior work may be incorporated by reference into a later patent application.<sup>155</sup> The subject matter incorporated by reference can be from any patent, patent application, or non-patent literature, and can be written by any party.<sup>156</sup>

To incorporate subject matter from another patent or patent application, a subsequent patent application may simply refer to the prior document,<sup>157</sup> rather than including a copy of the referred-to material.<sup>158</sup> After the reference has been included in a patent application, the applicant can amend her application to replace the reference with the material itself.<sup>159</sup> In other words, any patent applicant is permitted to copy some or all of an incorporated patent into her own. This regulation thus provides notice to patent applicants that their patent documents might be reproduced in third-party patent applications. These third party patent documents are published<sup>160</sup>

154 See *Zenon Envtl., Inc. v. U.S. Filter Corp.*, 506 F.3d 1370, 1378 (Fed. Cir. 2007); *Telemac Cellular Corp. v. Topp Telecom, Inc.*, 247 F.3d 1316, 1329 (Fed. Cir. 2001); *SanDisk Corp. v. Kingston Tech. Co.*, 695 F.3d 1348, 1366 (Fed. Cir. 2012).

155 *Harari v. Lee*, 656 F.3d 1331, 1334-1336 (Fed. Cir. 2011).

156 37 C.F.R. § 1.57 provides no limitations on the author of the incorporated document. See, e.g., *Atmel Corp. v. Information Storage Devices*, 198 F.3d 1374 (Fed. Cir. 1999) (third party technical article validly incorporated by reference into patent).

157 The reference must “clearly identify” the incorporated document. 37 C.F.R. § 1.57(b)(2) (2013).

158 37 C.F.R. § 1.57 (2013).

159 37 C.F.R. § 1.57(f) (2013).

160 See *supra* Part V.A.

though they contain portions of previous, copyrighted patent documents.

When an applicant files an application, she has notice of this practice and acquiesces to it, in much the same manner described above in Part V.A. The knowledge of the PTO rule and subsequent filing of a patent application create an implied license between the applicant and subsequent applicants who reproduce the (copyrighted) patent in their own patent applications.

### **E. AUTHORSHIP, OWNERSHIP, AND THE RIGHT TO SUE**

Another practical impediment to enforcement of a copyrighted patent lies in the ownership of the copyright. A suit for infringement of a copyrighted work may only be brought by the owner or exclusive licensee of the copyright.<sup>161</sup> At the time a work is created, the owner of the copyright is generally the author of the work.<sup>162</sup> However, if a work deemed to be “made for hire” by an employee or contractor, then the copyright owner is the employer or other person for whom the work was prepared.<sup>163</sup>

A work is considered to be made for hire if it either is made by an employee within the scope of her employment, or is specially ordered or commissioned from a non-employee.<sup>164</sup> In the latter case, the parties must expressly agree in writing that the work is made for hire, and the work must be for use as one of nine predetermined manners provided in the statute.<sup>165</sup>

Most instances of patent application drafting fall into one of two circumstances. First, the inventor and patent attorney may be employed by the same entity. For example, many of the largest patentees are firms, such as IBM and Microsoft,<sup>166</sup> that employ dozens of patent attorneys.<sup>167</sup> Patent applications drafted by these employees would be works made for hire and so the copyrights would be owned by the employer. Second, the patent applicant can retain the services of a patent attorney who works alone or for a firm.

<sup>161</sup> 17 U.S.C. § 501(b) (2013).

<sup>162</sup> 17 U.S.C. § 201(a) (2013).

<sup>163</sup> 17 U.S.C. § 201(b) (2013).

<sup>164</sup> 17 U.S.C. § 101 (2013).

<sup>165</sup> The work must be “specially ordered or commissioned for use as a contribution to a collective work, as a part of a motion picture or other audiovisual work, as a translation, as a supplementary work, as a compilation, as an instructional text, as a test, as answer material for a test, or as an atlas.” 17 U.S.C. 101 (2013).

<sup>166</sup> Firms such as IBM and Microsoft are issued thousands of patents each year. See, e.g., Intellectual Property Owners Association Top 300 Organizations Granted U.S. Patents in 2012, available online at [http://www.ipo.org/wp-content/uploads/2013/06/Top-300\\_6.23.13.pdf](http://www.ipo.org/wp-content/uploads/2013/06/Top-300_6.23.13.pdf).

<sup>167</sup> PTO Register of Active Practitioners, available online at <https://oedci.uspto.gov/OEDCI>.

When a client hires a lawyer to draft a patent application, there will typically be no written agreement specifying that the patent application is a work made for hire for copyright purposes. Therefore, if the author of the patent application is to be the patent applicant rather than the attorney, the attorney must be an “employee” of the client, rather than an independent contractor, and drafting the patent application must be within the scope of the attorney's employment.

To determine whether a hired party is an employee, courts employ a multifactor test<sup>168</sup> in which no single factor is determinative.<sup>169</sup> The leading copyright treatise notes that if the author and hiring party do not have a traditional employment relationship then there is generally “a judicial antipathy” to claims that the two are employer and employee.<sup>170</sup> A brief description of these relevant factors shows that most likely neither the law firm nor a lawyer working for the firm would be considered an “employee” of the client for purposes of the work made for hire analysis.

One factor is the skill required in performing the work. Patent drafting requires a high level of skill,<sup>171</sup> weighing against employee status. Another factor is “the source of the instrumentalities and tools” used in creating the work. Since the attorney would use her own word processor, computer, research tools, and support staff to create the patent document, and the client would probably provide no such tools, this weighs strongly against employee status. The “location of the work” is a factor that would probably not involve the client at all. Though the attorney might visit the client's premises to learn about the scope of the project and the nature of the invention to be patented, the attorney would probably create the patent application in her own office or home, weighing against employee status.

Another factor, “the duration of the relationship between the parties,” probably favors no employee status because many attorneys will draft one or a handful of applications for a client,

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168 *Community For Creative Non-Violence v. Reid*, 490 U.S. 730, 751-52 (1989).

169 *Id.* at 752.

170 1 Nimmer § 5.03[B][1][a][iii].

171 See, e.g., Jason R. Riley, *The Community Patent, or: How I Learned to Stop Worrying and Love the English Language*, 18 *Santa Clara Computer & High Tech. L.J.* 299, 324 n. 53 (2002) (“A patent specification is a legal and technical document, and drafting one calls for considerable skill and experience. Patent agents and attorneys are members of an elite profession specially trained and experienced in the art of drafting patents.”); Kenneth M. Bush, *Advising Clients: How To Recognize and Protect Intellectual Property*, 62 *Ala. Law.* 380, 381 (2001) (“The form and skill with which the application is drafted and prosecuted in the Patent Office can dramatically affect the scope of patent protection that may be obtained.”)

and have no further relationship thereafter. On the other hand, many attorneys do have enduring relationships with their clients, with some even devoting most of their time to a single client. In such circumstances this factor could lean in favor of employee status.

Another factor is “whether the hiring party has the right to assign additional projects to the hired party.” Although an attorney might strongly desire more work from her client, it is unlikely that a client would have a *right* to assign more work to a lawyer in a law firm. It is more likely that the attorney has no obligation whatsoever to accept additional work from a client. Many attorneys execute engagement letters with their clients in order to explain and circumscribe the scope of legal services to be provided.<sup>172</sup>

The “extent of the hired party's discretion over when and how long to work” is a factor that likely weighs against a finding of employee status. The attorney typically has unfettered freedom to decide when to work and how long to work on drafting the patent application, albeit within the constraints of some deadline.<sup>173</sup> If the attorney charges by the hour, the client may exert some pressure to work as few hours as possible. However, that would merely reflect the desire of all clients to pay less for a service, not the ability of an employer to control how long an employee works. The attorney would be free to work as many hours as she desired provided she did not charge the client for hours in excess of some maximum.

Three other factors strongly favor the independent contractor status of the patent attorney. The “hired party's role in hiring and paying assistants” is likely to be non-existent since the client typically has no involvement with the attorney's paralegals and other support staff. Similarly, the “provision of employee benefits” by the client is a rarity, and the client's “tax treatment of the hired party” almost certainly would not be that of an employee. For example, the client would not pay the attorney's Social Security tax obligations.

The final two factors depend on the particular arrangements the client has with the attorney and therefore could favor or disfavor an employee relationship. The “method of

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<sup>172</sup> See, e.g., D. Christopher Wells, *Engagement Letters in Transactional Practice: A Reporter's Reflections*, 51 *Mercer L. Rev.* 41, 67 (1999) (stating the common practice that the engagement letter between attorney and client describe as precisely as possible what professional services the client expects from the lawyer); James S. Bolan, *The Profession: Breaking Up Is Hard To Do*, 49 *B.B.J.* 16 (2005) (recommending that an attorney's engagement letter set forth the scope of the engagement, because a clear scope of the relationship is “critical”).

<sup>173</sup> The client may set a deadline by which the patent application is to be prepared. In addition, many patent applications must be prepared and filed before certain legal deadlines, such as the one year deadline triggered by the inventor's disclosure of the invention. 35 U.S.C. § 102(b)(1) (2013).

payment” can take various forms. For example, attorneys may be paid a fixed fee for a task, based on the number of hours spent performing the task, or a monthly retainer regardless of the tasks performed. Finally, “whether the work is part of the regular business of the hiring party” can weigh in favor of employee status for clients that regularly file dozens or even hundreds of patent applications annually. In fact, patent activity is the sole business activity for some clients.<sup>174</sup>

In summary, when a client hires a law firm to prepare a patent application, the client will most often not be the author and owner of the copyright. One way to remedy this situation is for the firm to execute a written assignment of the copyright to transfer ownership to the client.<sup>175</sup> Ideally the client's ownership of the copyright should be established before the patent application is drafted. If the assignment of copyright is attempted after the application has been drafted, intervening events may complicate the ability to identify the copyright owner and negotiate the terms of the assignment.

The client may have hired the law firm, but the patent document is authored by an attorney working for that firm. If the attorney is considered an employee of the firm for purposes of the work for hire doctrine, then the copyright in the attorney's patent application would be owned by the firm upon its creation. However, if the patent document is drafted by a non-employee attorney, this could complicate the transfer of copyright if, for example, the attorney had departed the firm before the assignment of the copyright to the client.

Many attorneys, such as associates, of counsel, and even some types of partners, would be considered employees.<sup>176</sup> However, partners who essentially own the firm and have significant actual control over the management and finances of the firm might not be considered employees.

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<sup>174</sup> For example, a defensive patent fund is an entity whose primary purpose is to acquire patents and license those patents back to the fund's members, “thereby defensively protecting ... members from potential [patent] infringement actions”. Alex S. Li, *Accidentally on Target: The MSTG Effects on Non-Practicing Entities' Litigation and Settlement Strategies*, 28 *Berkeley Tech. L.J.* 483, 491 (2013).

<sup>175</sup> Any transfer of copyright ownership must be in writing. 17 U.S.C. § 204(a). One type of transfer of copyright ownership is an assignment. 17 U.S.C. § 101.

<sup>176</sup> The majority of the relevant factors strongly favor of employee status for such attorneys. For example, the firm would provide the attorney with “the location of the work” and “the source of the instrumentalities and tools” used in creating patent applications, the “duration of the relationship” between the firm and attorney would typically be long and continuous, the firm would have “the right to assign additional projects” to the attorney, the firm would have significant “discretion over when and how long” the attorney worked, the firm would be solely responsible for “hiring and paying assistants” and “providing employee benefits” for the attorney, and for tax purposes the attorney would be treated as an employee.

The patent documents they drafted would not be owned by the firm as works made for hire.<sup>177</sup>

A further complication arises when a patent document incorporates an earlier patent. For example, when an invention is improved, there may be one patent for the original invention and another patent for the improvement. The improvement patent may require description of so much of the original invention that it should incorporate a substantial part of the original patent. Since the improvement patent would be a derivative work of the original patent,<sup>178</sup> the permission of the original patent's copyright owner is required to draft the improvement patent. In many cases a single patent document incorporates portions of several previous patent documents, each subject to a copyright owned by a different owner. It is not uncommon for an attorney to reuse portions of previous patent applications she has drafted, and to incorporate portions of previous applications written by other attorneys in the same firm. Even if a derivative work includes substantial original material, permission of the original copyright owner would be required to create the derivative work.

Obtaining permission from the copyright owner of the earlier patent document may not be straightforward. If an attorney from a different firm is to draft the second application, that attorney wouldn't necessarily have the permission of the copyright owner – e.g., the first firm. Even if the attorney who drafted the original application is retained to draft the second application as well, that attorney may have changed firms and similarly would not have permission of the owner of the original copyright.

Analogous complications could arise in enforcing a copyright in patents. A defendant accused of infringing the copyright in a patent document would have an incentive to investigate the provenance of each portion of the document. If any portion of the plaintiff's patent had itself been copied from an earlier patent, the defendant would attempt to turn the tables on the plaintiff by demonstrating that the plaintiff had infringed the copyright of one or more earlier works. If so, then the plaintiff's copyright would not extend to any of the earlier works and might not even be infringed by the defendant's copying.

In summary, the owner of the copyright in a patent document may not be the patentee or even the law firm retained by the patentee to prepare the derivative patent application.

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<sup>177</sup> Their documents might nevertheless be considered partnership property under certain circumstances, depending on the relevant state partnership laws.

<sup>178</sup> 17 U.S.C. § 103(b) (2013).

This can create potentially serious complications even when the patentee seeks to generate derivative works of its own patents.

#### F. ATTORNEY ETHICAL OBLIGATIONS

The description in Part V.E above demonstrates that any copyright in patents would have a deleterious effect on the provision of patent drafting services. A firm that employs a lawyer would often own the copyright in the patent documents prepared by the lawyer. If that lawyer left the firm, she might not be able to reuse portions of the patent documents she had drafted while at that firm because she would have no ownership in or license to the relevant copyright.

This in turn would hamper the lawyer's future drafting efforts, since she would need to draft new text rather than reuse the language she had used previously in the copyrighted patent document. A lawyer might even conservatively avoid reusing text that might be permissible to include<sup>179</sup> simply to avoid any allegations of copyright infringement. This disadvantage increases with the number of different firms the lawyer is affiliated with during her career. All of this puts her future clients at a disadvantage, which potentially causes a conflict of interest.<sup>180</sup>

The copyrightability of patent documents would also impose on the attorney an obligation to disclose those rights. Since the client pays the law firm to prepare the patent document, many clients would reasonably expect to own any copyright in that patent document, rather than to relinquish it to the firm. If it is possible for such rights to exist in a patent, then the law firm should have so informed the client and provided an opportunity for the client to acquire those rights.<sup>181</sup>

If a lawyer does not inform the client immediately upon the creation of the patent document, she has a duty to do so soon thereafter.<sup>182</sup> A significant delay could even impair the client's right to commence civil litigation to enforce the copyright.<sup>183</sup>

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<sup>179</sup> For example, the copying might be permissible due to the merger doctrine or fair use. See Part III.B *supra*.

<sup>180</sup> The American Bar Association Model Rules of Professional Conduct and the rules of most states generally mandate that a lawyer shall not represent a client if there is a significant risk that the representation of one or more clients will be materially limited by the lawyer's responsibilities to another client, a former client, or herself. See, e.g., Model Rules of Prof'l Conduct R. 1.7(a) (2013).

<sup>181</sup> See, e.g., *Id.* at R. 1.4(a) ("A lawyer shall promptly inform the client of any decision or circumstance with respect to which the client's informed consent ... is required by these Rules").

<sup>182</sup> *Id.*

<sup>183</sup> An action must be commenced within three years after the claim accrued. 17 U.S.C. § 507(b) (2013).

In summary, if there is any copyright protection for patent documents, then hundreds of lawyers and law firms have unknowingly impaired their clients' rights over the years.

### **G. U.S. GOVERNMENT WORKS ARE NOT COPYRIGHTABLE**

I have argued that the extent of copyright protection for patents is limited or nonexistent. In this Part I briefly refute an attractive but incorrect argument in favor of the same conclusion. According to this argument, patents are exempt from copyright protection because they are works of the U.S. Government.<sup>184</sup>

The US and many other jurisdictions limit copyright protection for laws, court decisions, and other works of the government. This exemption can be implemented in at least two different ways. Some jurisdictions limit copyright protection for works *published* by the government, while the US more narrowly limits copyright for works *created* by the government. This distinction is important for patent documents, which are prepared by private applicants but then published by the government pursuant to the patent laws.

US copyright law exempts from protection works that are prepared by an officer or employee of the United States Government as part of that person's official duties.<sup>185</sup> In contrast, many other countries exempt government documents from the ambit of copyright protection altogether, regardless of the authorship of those documents.

The copyright status of patent documents in different countries is subject to a wide variety of local laws regarding copyright for official texts. The Berne Convention does not mandate the scope of protection that must be provided to government works; each member state has discretion to determine the protection to be granted to such works.<sup>186</sup> At one extreme is Switzerland, which explicitly bars copyright protection for patent specifications and published patent applications.<sup>187</sup> The legislation of many other countries does not specifically identify

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184 See, e.g., A. Samuel Oddi, An Uneasier Case for Copyright Than for Patent Protection of Computer Programs, 72 Neb. L. Rev. 351, 435 n. 338 (1993) (“The patent document itself is presumably a 'work of the United States Government' under 15 [sic 17] U.S.C. 105 (1988) and hence not subject to copyright protection.”).

185 17 U.S.C. § 105 (2013) excludes works of the United States Government from copyright protection, and 17

U.S.C. § 101 (2013) defines “work of the United States Government” as one prepared by government workers.

186 Berne Convention for the Protection of Literary and Artistic Works, art. 2(4), Sept. 28, 1979, S. Treaty Doc. No. 99-27.

187 Federal Act on Copyright and Related Rights of Oct. 9, 1992, SR 231.1, § 5(1)(d) (Switzerland).

patent documents as outside the ambit of copyright, but nevertheless their comprehensive exclusions from copyright almost certainly include patents along with other government works.<sup>188</sup> For example, in Canada there is no private copyright in any work published by the government.<sup>189</sup> Still other countries permit copyright in government works but limit the accompanying exclusive rights. For example, Australian law provides that copyright in a government work is not infringed by making one copy thereof.<sup>190</sup>

The US had a similarly broad exemption for government works before 1978. Throughout most of the twentieth century government publications were not subject to copyright at all.<sup>191</sup> The Copyright Act of 1976 relaxed this prohibition to its current form.<sup>192</sup> In making this change Congress intended “to make clear that the copyright protection of a private work is not affected if the work is published by the Government.”<sup>193</sup> The use of the term “work of the United States Government” was clearly intended to be different from a mere “publication of the United States Government”.<sup>194</sup>

Clearly patent applications are not works of the United States Government as specified by the statute. Since copyright protection arises upon fixation, the author of a patent application would acquire copyright protection creation, well before the document was filed with the PTO. Nothing in the statute alters the ownership of the copyright merely because the PTO publishes the document.

It is also true that no patent applicant could be considered to have transferred her copyright to the U.S. Government by the act of filing her patent application. Although the U.S. Government may receive and hold copyrights transferred to it by assignment,<sup>195</sup> any such

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188 In a jurisdiction that bars copyright protection for its patents, a patent could receive stronger copyright protection in the US than it would in that jurisdiction. Assume that a patent application is drafted in that foreign jurisdiction and filed with the patent office of that jurisdiction. If that application is not also filed as a US patent application, then the author would enjoy no copyright protection in the foreign jurisdiction, but might have the full range of protections normally afforded by US copyright law.

189 Copyright Act, R.S.C., ch. C-42 §12 (1985) (“where any work is, or has been, prepared or *published by* or under the direction or control of Her Majesty or *any government department*, the copyright in the work shall, subject to any agreement with the author, belong to Her Majesty.”) (emphasis added).

190 Copyright Act, 1968, §182A (Austl.).

191 Printing Law of 1895, ch. 23, § 52, 28 Stat. 601, 608 (1895) (codified as amended at 44 U.S.C. § 505).

192 Copyright Act of 1976, Pub. L. 94-553, § 105(a)(1), 90 Stat. 2541, 2599.

193 Notes of Committee on the Judiciary, House Report No. 94-1476 (1994).

194 Id.

195 17 U.S.C. § 105 (2013).

assignment must be in writing<sup>196</sup>. Therefore no assignment can be implied from conduct, such as filing a patent application.

## VI. SOME PRODUCTIVE USES OF UNCOPYRIGHTED PATENTS

If there were no copyright protection whatsoever for patents, the public could engage in a number of productive uses of patents. Three examples are provided below but no doubt additional uses of this impressive source of technical information are feasible as well.

### Reusing Previous Patent Documents in Applications for Improvement Inventions

An improvement to a patented invention can be extremely similar to the original. Describing the improvement could require just a few paragraphs more than the description of the original. It would be most efficient to allow the patent application for the improvement to essentially consist of the original patent plus additional paragraphs as necessary to describe the features that have been improved.

Reuse of portions of patent documents would confer benefits analogous to those of software component reuse. Reusing text from a patent document obviates the costs of recreation, and also confers the benefits of any prior “debugging” of that work to ensure it contains no errors.<sup>197</sup> Reuse thereby increases the productivity of the drafter and can improve the quality of finished product.<sup>198</sup>

Creating a patent document by reusing portions of several different patent documents would also confer benefits analogous to those of community development, such as open source software development or Wikipedia-style content creation. Often a group can collectively produce a higher quality work than any single member could produce even with ample time and other resources.<sup>199</sup> Different members have different strengths and perspectives which collectively render the group able to solve a wider variety of problems. Similarly, when assembling a new patent document from portions of existing patent documents, the drafter could

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196 Any transfer of copyright ownership must be in writing. 17 U.S.C. § 204(a) (2013). One type of transfer of copyright ownership is an assignment. 17 U.S.C. § 101 (2013).

197 Cf. Mark A. Lemley & David W. O'Brien, Encouraging Software Reuse, 49 Stan. L. Rev. 255, 260-61 (1997).  
198 Id. at 265.

199 Shun-Ling Chen, Wikipedia: A Republic Of Science Democratized, 20 Alb. L.J. Sci. & Tech. 247, 259 (2010).

select the best portions from dozens or even hundreds of candidate documents. This drafting process would tend to propagate the best descriptions of technical components because those would be most likely to be included repeatedly in newly drafted patent documents. A drafter could even improve portions she reused from previous patent documents, and that improved text would in turn be copied by future generations of patent documents. The description of components would evolve in a manner that could not happen unless such sharing and reuse were permitted.

Reusing portions of previous patent documents would not only save resources and increase quality, it could also strengthen the rights of the patentee. If the patentee of the original invention asserted its copyright against the patentee of an improvement, the original patentee would not have all the usual invalidation techniques available. Since the improvement patent has much in common with the original patent, certain invalidation attacks against the improvement patent would apply with equal force to the original patent. For example, if the text in common between the two patents was potentially ambiguous or incorrect, both patents would be susceptible to invalidation for this reason.<sup>200</sup> This results in a stronger improvement patent.

#### Database of Reusable Technical Descriptions

Many patent documents describe the same standard components in different but essentially equivalent ways. This indicates the benefits of allowing such components to be shared rather than being repeatedly recreated. If third parties could freely use portions of previous patents in constructing their own patent documents, a library of such portions could be created by an organization of users, the government, or any third party. The library would allow a drafter to easily assemble the appropriate portions in a new patent.

Such a database that facilitated the sharing and use of descriptions of technical components would be analogous to mechanisms through which software components are shared.<sup>201</sup> It would make the drafting task much easier and cheaper. More importantly it would

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200 Specifically, if the incorrect text failed to convey critical technical information about the invention, the patent would be susceptible to invalidation for failing to enable one of ordinary skill in the art to practice the invention without undue experimentation. *ALZA Corp. v. Andrx Pharms., LLC*, 603 F.3d 935, 940 (Fed. Cir. 2010).

201 see, e.g., Greg R. Vetter, *The Collaborative Integrity of Open-Source Software*, 2004 Utah L. Rev. 563, 606 (2004) (describing how the open-source movement involves sharing source code and collaborating on the design and development of software components and projects); David Schumann, *Obviousness with Business*

eliminate the socially wasteful practice of numerous patent drafters continually rewriting descriptions of the same component, technology, or process. It would also allow the drafter to think at a higher level, rather than become bogged down in the task of selecting the proper words and phrasing to describe known components.

### Automatically Generated Summaries

A collection of patents in the same field of technology would typically describe related but different inventions. A summary of the teachings of the field could convey knowledge more concisely and directly than any single patent could, and would obviate the need to review numerous documents, portions of which would be somewhat redundant. A summary could be generated from these patents, and could even be generated automatically.

The subfield of computer science that deals with “automatic summarization systems” involves methods for extracting content from an information source and presenting the most important content in condensed form.<sup>202</sup> One contemporary application of this technology is the automatic summarization of news from various electronic sources.<sup>203</sup> Even the relatively simple Microsoft Word word processor has a simple “AutoSummarize” feature.<sup>204</sup>

## **VII. CONCLUSION**

Patent documents are copyrightable subject matter, but such a copyright would likely be limited in numerous ways. Existing doctrines as well as policy considerations favor extremely limited, or no, copyright protection for patents. This would provide many social benefits and entail virtually no drawbacks for either the public or patent owners.

Unfortunately, there is no consensus on the extent of such limits, or even public

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Methods, 56 U. Miami L. Rev. 727, 771 n. 64 (2002) (describing software exchanges where developers contribute and download modules of software code).

202 See generally, Inderjeet Mani, *Advances in Automatic Text Summarization*, The MIT Press (July 1999); *Proceedings of the Second NTCIR Workshop on Research in Chinese & Japanese Text Retrieval and Text Summarization*, (May 2000- March 2001), National Institute of Informatics, Tokyo, Japan.

203 Amir Efrati, *Google Acquires Wavii to Bolster Web-Search ‘Knowledge Graph*, *WII Street Journal Tech Blog*, (April 23, 2014), available at <http://blogs.wsj.com/digits/2013/04/23/google-acquires-wavii-to-beef-up-web-search-knowledge-graph> (last visited April 24, 2014).

204 See <http://office.microsoft.com/en-us/word-help/automatically-summarize-a-document-HA010255206.aspx> (last visited March 20, 2014).

discussion that there are such limits. The lack of clarity as to the extent of copyright protection dissuades the public from attempting to engage in many productive uses of patent documents. Probing the actual contours of copyright protection for patents would dispel many misconceptions, and hopefully spur uses of patent documents that would further the goals of both the patent and copyright systems: the dissemination of information for public benefit.