

The National Security Threat of the First-To-File Provision

In April, the Inventors Network of the Capital Area (INCA) sent a letter opposing H.R. 1249, the Obama/Leahy/Smith America Invents Act, to Speaker Boehner warning that the First-To-File (FTF) provision in the bill inherently endangers U.S. national security. (See the letter here [\[URL\]](#)).

The INCA letter explains that the United States already has major problems with Chinese hackers stealing the newest U.S. defense related technologies. The proposed FTF system will further reward this Chinese cyber-theft by enabling their hackers to then become the exclusive legal U.S. patent owners of these stolen American inventions.

The threat is due to the proposed change in patent law from a system that awards the patent to the first and true inventor to a system that awards the patent to the first to file an application in the Patent Office. This new law would facilitate usurpation of American companies' intellectual property compromised during its earliest secret development.

Cyber-espionage would enable foreign engineers to gain access to American firm's internal new invention records. Patent law firms' records and email communications with inventors that contain drafts of thousands of new patent applications in preparation for filing would be the obvious "one-stop shopping" target of foreign cyber-thieves.

Foreign cyber-thieves would then be able to produce patent applications using the compromised subject matter with slight variations and file earlier than the American inventors and receive the patent under the first-to-file law. To add insult to injury, the proposed legislation repeals existing safeguards in the procurement of patents – permitting companies to file patent applications without the participation of an inventor and eliminating the rulemaking ability of the Patent Office to require an inventor oath.

With no evidence available to connect cyber-theft with the earlier applicant, American victims of such patent rights' theft would be unable to prove that the earlier application was derived from their invention and no proof of prior invention would be relevant under FTF law. In contrast, current first-to-invent law permits the American company to simply produce its own corroborated records showing prior invention to establish ownership of the invention and to cancel the patent of the first-filer. H.R. 1249's permanent removal of this fundamental basic legal protection would induce substantial foreign cyber-espionage investments to exploit the basic cyber-vulnerability of thousands of American firms and institutions who are not equipped to deal with this threat.