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Imitation in Patent Applications: The Sincerest Form of Flattery, or Trouble in Paradise?

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Protecting innovation is an economic driver. Yet some enterprises treat inventions as a virtual commodity. In some industries, the high demand for efficiency in patent application drafting creates incentives to recirculate descriptive materials. To save time and avoid proverbially reinventing the wheel, patent practitioners sometimes rely on templates, boilerplate, and applications previously drafted for a client. There will often be an application, set of drawings, or block of text the practitioner can start from for a similar technology or product line that can improve patent application drafting efficiency and provide consistent, quality patent drafting while avoiding bespoke drafting. As discussed below, such imitation might lead to problems, particularly when the language or drawings were borrowed from an application that was not prepared by the practitioner's firm or were borrowed from an application for a different client, and particularly where no attribution is provided.

The practitioner does not always have an appropriate template or related application for a given client. The client may be new to patenting, new to the practitioner, or new to the technology described in the invention disclosure. Even worse, the client may have an imminent public disclosure or other bar date requiring undue haste in preparing a suitable application. The practitioner would like to spend what little time he or she has focusing on the claims and describing the patentable features, but understands that providing sufficient background and context for the technology can be important for written description support to make the application more readable for patent examiners, judges, and jurors.

Some have proposed an open-source-style approach to patent drafting, where quality text describing the state of every technology under the sun is freely available to be incorporated into patent applications, thereby increasing the efficiency, consistency, and quality of patent applications.[1] But copying and pasting text or drawings from an application not owned by a client will sound alarm bells for many patent practitioners – and for good reason.

This article discusses the legal and non-legal risks and considerations involved with copying text or drawings from other sources, such as patent applications which were either prepared for a different client, or were not prepared by the practitioner's firm. It also provides practice tips to minimize these risks for those patent practitioners considering copying text or figures from other patent disclosures.

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COPYRIGHT INFRINGEMENT

Copying and reproducing text from any source inherently creates a potential copyright infringement suit. However, it is not clear, at least in the United States,[2] whether copying and incorporating portions of another's patent or patent publication would be actionable copyright infringement.[3] The mere uncertainty surrounding copyright protection for patent specifications and the extent of its possible consequences should discourage practitioners from wholesale copying of portions of a different applicant's patent or patent publication. There are, however, options for patent practitioners to use text or drawings from another's patent application with no risk, or at least far less risk, of copyright infringement.

First, although a practitioner may not have a suitable sample to work from, the client may have filed related applications using another practitioner. The best option in this situation would be to ask the client for a related application. In this way, the practitioner likely has an express license to make use of any copyright the client may have in the application,[4] and the client now has a chance to provide input on what text or drawings should be borrowed. Since working from a related application saves the practitioner's time (and, thus, the client's money), the client likely will not hesitate to provide a related application with implied permission to use it. If, due to time constraints or other reasons, it is not practical for the client to provide an example application, the practitioner can search the U.S. Patent and Trademark Office (USPTO) or other database for applications related to the subject matter of the invention disclosure that are assigned to the client. In this case, the practitioner should verify that the client has total ownership over the application.

Second, if the client does not have any relevant patent applications, the practitioner can reduce the risk of infringing a copyright by making at least nominal changes to any text or drawings borrowed from a third-party patent application. For example, the patent practitioner may use a find-and-replace feature to substitute terms for other suitable terms, and to otherwise modify the text. To the extent that a patent specification is subject to copyright protection at all, limiting principles such as the idea/expression dichotomy and the merger doctrine are likely to make any copyright protection relatively narrow, such that even modest changes to the terms, phrasing, and/or prose of the specification will help avoid infringement. It is important to note that the amount of changes required to avoid infringing copyrighted text is inherently subjective and there is no sure way to know how much change is sufficient. Additionally, since there are often many ways to draw a structure, the risk when copying a figure may be greater given the uncertainties of using a third-party document.

LOSS PREVENTION

Copyright infringement is not the only legal risk involved with borrowing text from a specification. In *Cold Spring Harbor Laboratory v. Ropes and Gray*,[5] Cold Spring Harbor Laboratory (CSHL) sued the law firm Ropes and Gray for malpractice, fraud and concealment, and negligence because a Ropes and Gray partner copied and pasted several pages of text from a third-party patent publication into a CSHL patent application. The USPTO rejected the application, citing the third-party patent publication that the Ropes and Gray attorney copied.[6] Ropes and Gray argued that the reasons for rejection by the USPTO was not related to the copied text. However, the judge denied Ropes and Gray's motion to dismiss, and the case was ultimately settled.[7]

Although it is not clear if CSHL would have prevailed on any of its claims related to Ropes and Gray's copying of the patent text, the judge was unsympathetic to Ropes and Gray's claim that copying text from third-party patent applications was standard practice.[8] It is clear, though, that the legal risks stemming from the attorney's agreement with, and duties to the client weigh against copying text from another's patent. However, liability for these specific risks may be avoided or minimized by getting the client's input and consent to borrow text or even figures from other sources.

NON-LEGAL CONSEQUENCES

Even if the copied text does not lead to legal liability, copying text without permission may cast a bad light on the practitioner and the client. Allegations of plagiarism could be damaging to a patent practitioner's reputation – or even an entire law firm's reputation. An in-house counsel may be wary of hiring a practitioner if the in-house

counsel knows the practitioner has used potentially risky cost-saving measures in drafting applications. Further, the practitioner risks alienating a future jury if the defendant/accused infringer shows that significant portions of the patent application were copied. This risk may be worse if the copied text comes from a reference being used to demonstrate obviousness or lack of novelty.

It is difficult, however, to assess the merit and magnitude of these non-legal risks. Moreover, patent practitioners understand the potential gains in efficiency from this type of copying in drafting patent applications. Working from templates and incorporating other applications is common practice, notwithstanding one judge's views, although the subject matter copied often comes from patent specifications owned by the same clients. Clients and juries may, in general, be more sympathetic to borrowing text and drawings than those in the *Cold Spring Harbor Laboratory* fact pattern, for example.

PRACTICE TIPS

It is difficult to foresee all the possible instances where benefiting from pre-existing text could be helpful, and the advantages of doing so are considerable. If attorneys find themselves in one of these situations, consider the following practice tips:

- Ask the client for an example specification before copying text from any other source. If the client cannot find one, search in a patent database for applications owned by the client.

- If no example applications can be found, let your client know you are planning on borrowing text from another published patent document not owned by your client.

- Make at least nominal changes to any text or drawings borrowed from an application that is not your client's to reduce the risk of copyright infringement.

- Consider incorporating by reference the patent or patent application from which the text is borrowed. This provides some attribution of the subject matter and shows a good faith desire to contribute to the technological field rather than merely appropriating the text.

- A citation to the original document and using quotes around the text may also be a helpful approach to provide the content with appropriate context.

- Because the patent application from which the text is borrowed will likely be cited in an Information Disclosure Statement, a drafter should limit the amount of text or drawings to those needed to provide background and context to the field and problem the invention is solving. If a drafter cites the borrowed-text patent as a prior art reference, wholesale copies of its disclosure in portion(s) of the current specification that describe the patentable features could look bad to examiners and juries and imply there was less "invention development" than in reality.

For now, there is no over-arching legal "open source" system for patent specifications and drawings. The litigation on this question is very limited, indicating the potential risks may be small, but not nonexistent. It is up to each practitioner or law firm to weigh the risks and advantages to decide whether and how to use publicly-available patent disclosures, particularly from third-party sources, in their own practice.

Notes

1. See, e.g., Dean Alderucci, "The Surprising Consequences of Exempting Patents from Copyright Protection," available at https://web.archive.org/web/20160304112209/http://home.uchicago.edu/~alderucci/Copyright%20in%20patents.pdf.
2. The United Kingdom's Intellectual Property Office has stated that "If you were to copy the whole or a substantial part of [a patent specification] for [purposes other than disseminating the information contained in them], such as marketing or sales, this could be an infringement of the copyright (unless the use fell within one of the exceptions to copyright." See "Am I allowed to copy patent specifications?" available at https://webarchive.nationalarchives.gov.uk/20140603113132/http://www.ipo.gov.uk/types/copy/c-other/c-other-faq/c-other-faq-type/c-other-faq-type-patspec.htm.
3. 37 CFR § 1.71(d) expressly provides for copyright or mask notices to be placed in a utility patent application, provided it is accompanied by an authorization to make facsimile reproductions of the patent publication as it appears in USPTO records. However, the statues,

regulations, and caselaw do not expressly state whether an individual can "violate" copyright laws or otherwise avoid liability for such actions by incorporating text from one patent application into another. Even if a patent specification is subject to copyright protection, it is uncertain whether the limitations on copyright laws, such as Fair Use, the Merger Doctrine, and the Idea-Expression Dichotomy, would keep a patent owner from suing another for copyright infringement of the patent's text.

4. Many of the patent applications assigned to the client as patent applicant may have been drafted by other outside counsel. Because outside counsel are not employees of the client, the Work Made for Hire doctrine does not apply to specification and drawings drafted for the patent applicant. However, outside counsel would likely assign any copyright in their patent applications to the client on request in compliance with their presumed ethical obligations, if not already contemplated by a written agreement. See Stanley F. Birch Jr., "Copyright Protection for Attorney Work Product: Practical and Ethical Considerations," 10 J. Intell. Prop. L. 255, 259-61, n 13 (2003), available at http://digitalcommons.law.uga.edu/jipl/vol10/iss2/4.
5. 840 F.Supp.2d 473 (D. Mass. 2012) (Denying motion to dismiss).
6. Id. at 476.
7. "Cold Spring Harbor Laboratory Announces Settlement in Patent Malpractice Case Against Ropes & Gray," Bloomberg Business, June 2, 2014, available at https://www.bloomberg.com/press-releases/2014-06-02/cold-spring-harbor-laboratory-announces-settlement-in-patent-malpractice-case-against-ropes-gray.
8. 840 F. Supp.2d. at 478.