NOTE

Standing Up for the Dead Inventor: Ensuring a Personal Representative's Standing to Sue for Patent Infringement

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ABSTRACT

The patent system is the product of federal law, while the probate system is that of state law. As one can imagine, issues arise when these two interact—and, because statutes give patents the attributes of personal property, the two inevitably do. One problem is an apparent void of standing to sue for patent infringement when the patent is part of an estate in probate. By subverting the prior understanding that a personal representative holds title to a patent in the decedent's estate in Akazawa v. Link New Technology International, Inc.*, the Federal Circuit has established an ambiguity over who can assert infringement. Accordingly, Congress should enact a provision to explicitly ensure that standing passes on to a personal representative; this Note recommends language for such a provision. In the alternative, Congress should amend the patent laws to provide a statutory basis for a personal representative's standing by adding "personal representative" to 35 U.S.C. § 154(a)(1). The resulting statute would then grant the exclusive right in a patent to "the patentee, his personal representative, heirs, or assigns." Doing so fulfills the states' presumption that a personal representative already has standing, comports with a personal representative's existing duties over patents as well as his analogous duties over copyrights, and promotes policy cooperation between patent law*

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and succession law. Other possible solutions such as imparting patents with the qualities of contracts are ineffective because they subvert established law, deny the harmony of the patent and probate systems' policy goals, and give rise to problematic incentives.

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Introduction

Imagine for a moment the universe of *Back to the Future*.[1] If Doc Brown were a particularly profit-minded inventor, he would have pursued patent protection for his invention, the DeLorean outfitted with

[1] Back to the Future (Amblin Entertainment & Universal Pictures 1985).

a time machine. That patent would grant Doc an exclusive right to prevent anyone else from using, producing, or selling his invention without permission. Anyone who wished to capitalize on his technology would first need a license; otherwise, Doc could seek an injunction to stop the infringement. And if Doc were a particularly well-prepared person, he also would have drafted a will to direct the distribution of his estate. Doing so would allow him to designate specifically who should receive his assets after he dies. Doc would be wise to include his patent in a listing of his assets, so that he would be free to decide who should acquire his patent rights after his death. Based on their longstanding friendship and adventures together, Doc might be inclined to designate Marty McFly as the heir to his patent. That would give Marty the exclusive right over the time machine after Doc passes away. Before Marty can actually receive the patent, however, Doc's estate would need to pass through probate, a process that can take several years. Now imagine that, while Doc's estate is tied up in that probate process, Biff Tannen somehow manages to get his hands on Doc's schematics for the time machine and begins manufacturing and selling new time machines. Biff is clearly infringing Doc's patent, but Doc has unfortunately passed away and is therefore unable to bring Biff to court. Until the end of the probate proceedings, Marty technically does not even own the patent and so cannot seek an injunction. Who, then, can stop Biff from continuing to infringe while the patent is stuck in probate?

The answer to that question is worryingly ambiguous. Federal courts have long held that, during probate, the personal representative of an estate receives title over a patent.[2] This would provide the personal representative with the necessary standing to initiate an infringement action for that patent.[3] But the Federal Circuit in a recent case quashed this understanding: it asserted that title in a patent does not automatically vest in the personal representative, meaning that he does not have standing to assert infringement of the patent.[4] The personal representative nevertheless is the best person for the job. The states recognize this with a presumption that a personal representative has standing. Standing by a personal representative comports with his existing duties over patents and analogous duties over copyrights, and promotes policy cooperation between patent law and succession law. In light of this, Congress should statutorily ensure that a personal rep-

2 *See infra* Section II.B.

3 *See infra* Section II.B; text accompanying notes 93–96.

4 *See infra* Section II.B.

resentative has standing to sue for infringement of a patent within the respective probate estate.

Towards the end of advocating for this statutory solution, this Note proceeds in three parts. Part I gives a brief overview of the federal patent system as well as an introduction to state succession laws, with a particular spotlight on the personal representative and his role in the probate process. Part II addresses the troubles that arise when patent law and probate law collide. It begins by explaining the federal policy of deferring to state probate laws and then turns to a discussion of how the issue of standing to assert patent infringement during probate developed. Part III of this Note asserts that Congress should pass a statute giving a personal representative standing because doing so fulfills states' presumption that a personal representative already has standing, comports with a personal representative's existing duties over patents as well as his analogous duties over copyrights, and promotes policy cooperation between patent law and succession law. Part III also addresses why an alternative solution—applying contract law to patents—is inferior.

I. The Patent and Probate Systems

A. An Overview of the Federal Patent System

In the United States, an inventor's right to seek a patent emerges from federal law.[5] The Constitution authorizes Congress "[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."[6] Beyond this cursory mention of the need for a patent system, however, the Constitution gives no real guidance as to what that system should look like or how it should work.[7] From its earliest days, Congress has grappled with the task of creating a patent system that balances "the need to promote innovation and the recognition that imitation and refinement through imitation are both necessary to invention itself and the very lifeblood of a competitive economy."[8] The end result of that endeavor is a federal statutory framework that imposes particular requirements on an inventor in or-

5 *See generally* 35 U.S.C. §§ 1–376 (2012) (establishing the federal patent law regime); *see also* Camilla A. Hrdy, *State Patent Laws in the Age of Laissez Faire*, 28 Berkeley Tech. L.J. 45, 47 (2013) ("Today patent law is purely a federal creature.").

6 U.S. Const. art. I, § 8, cl. 8.

7 *See id.*; *see also* Bonito Boats, Inc. v. Thunder Craft Boats, Inc., 489 U.S. 141, 146 (1989) (describing the few limitations upon Congress's power to create a patent system).

8 *Bonito Boats*, 489 U.S. at 146.

der to earn the protections of a patent: an inventor must establish the novelty, utility, and non-obviousness of an invention and must provide a written description with enough clarity to enable the public to best practice the invention.[9]

The rights provided by a patent, however, are somewhat counter-intuitive. Though one might expect a patent to give the inventor an affirmative right to profit from her invention, in actuality the patent provides only an exclusive right.[10] The holder of a patent has "the right to *exclude others from* making, using, offering for sale, or selling the invention."[11] In effect, a patent creates a monopoly in the patentee.[12] While a patent does not explicitly give its inventor the right to practice the invention,[13] it does allow her to invoke federal authority to prevent others from doing so.[14] When a person infringes a patent by making an unauthorized use or sale of the patented invention, courts can provide the patent holder with equitable relief through of an injunction, and legal relief through damages.[15] Thus, anyone that infringes the patent can be stopped and forced to compensate the patent holder.

But this exclusive right is not without limitations. Most notably, the term of a patent is generally limited to seventeen years from the date of grant.[16] After seventeen years have passed, the inventor can no longer stop others from using his invention; his exclusive right expires.[17] Once the patent expires and the inventor can no longer seek judicial protection, the invention covered by the expired patent is dedicated to the public, which is then free to make, use, or sell it.[18]

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9 *See* 35 U.S.C. §§ 101–103, 112; *Bonito Boats*, 489 U.S. at 150. The nuances of these doctrines of novelty, utility, non-obviousness, written description, and best mode are beyond the scope of this Note.

10 *See* 35 U.S.C. § 154.

11 *Id.* (emphasis added).

12 *See* Transparent-Wrap Mach. Corp. v. Stokes & Smith Co., 329 U.S. 637, 643 (1947); Precision Instrument Mfg. Co. v. Auto. Maint. Mach. Co., 324 U.S. 806, 816 (1945).

13 *See* Clair v. Kastar, Inc., 138 F.2d 828, 831 (2d Cir. 1943).

14 *See* 35 U.S.C. § 281; Zenith Radio Corp. v. Hazeltine Research, Inc., 395 U.S. 100, 135 (1969).

15 *See* 35 U.S.C. §§ 271, 283–284. *But see* eBay Inc. v. MercExchange, L.L.C., 547 U.S. 388, 391–92 (2006) (limiting a court's ability to provide injunctive relief).

16 *See* 35 U.S.C. § 154(c). While the statute does specify that the term of a patent might be defined as twenty years from the date of filing, *see id.* § 154(a)(2), the statute further guarantees a maximum of three-year application pendency, *see id.* § 154(b)(1)(B). As such, the term of the patent, if defined by the date of filing, would also be approximately seventeen years.

17 *See id.* § 154(c).

18 *See* Brulotte v. Thys Co., 379 U.S. 29, 31–32 (1964); Riverbank Labs. v. Hardwood Prods. Corp., 236 F.2d 255, 257 (7th Cir. 1956).

Even before the patent expires, an inventor's right to enforce his patent is time-sensitive. There is a statute of limitations: an inventor cannot receive damages for patent infringement that occurred more than six years before the filing of claim.[19] This means that a patent holder can only recover money damages to compensate for loss within the past six years, even if someone had been infringing for much longer than six years.[20] It is thus in the patent holder's best interest to assert his exclusive right promptly, so as to ensure that neither expiration nor recovery limits get in the way.

Reassuring though these limits may be, something plainly unsettling lingers throughout the patent system in general: it creates monopolies. The United States has long recognized the evils of monopoly,[21] and yet patents are recognized as "an exception to the general rule against monopolies."[22] Courts eagerly rationalize this apparent contradiction, emphasizing the importance of the patent system as encouraging scientific progress and innovation.[23] While judges celebrate the utilitarian justification of the patent system (i.e., that it is designed to efficiently develop and distribute technological information), scholars have also considered alternative justifications.[24] Some scholars have justified the patent system as preserving the public domain, so that otherwise public information does not become privatized.[25] Another justification recognizes the importance of proportionality and notes that the patent system provides a right that corresponds to the amount of effort that went into developing an invention.[26] Still another justification celebrates the patent system's protection of an inventor's dignity.[27] Regardless of which of these policy arguments best justifies the patent system, they all support affording inventors the opportunity to exclude others from making, using, or

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19 35 U.S.C. § 286. The equitable defense of laches may also prevent recovery for patent infringement. *See* A.C. Aukerman Co. v. R.L. Chaides Constr. Co., 960 F.2d 1020, 1032 (Fed. Cir. 1992). Unlike laches, however, the statutory limit on monetary recovery does not require a showing of material prejudice caused by an unreasonable delay.

20 *See* 35 U.S.C. § 286.

21 *See, e.g.*, Standard Oil Co. v. United States, 221 U.S. 1, 53–57 (1911).

22 Precision Instrument Mfg. Co. v. Auto. Maint. Mach. Co., 324 U.S. 806, 816 (1945).

23 *See, e.g.*, Bonito Boats, Inc. v. Thunder Craft Boats, Inc., 489 U.S. 141, 150–51 (1989); United States v. Masonite Corp., 316 U.S. 265, 278 (1942); Saf-Gard Prods., Inc. v. Serv. Parts, Inc., 532 F.2d 1266, 1270 n.8 (9th Cir. 1976).

24 *See* ROBERT P. MERGES, JUSTIFYING INTELLECTUAL PROPERTY 6 (2011).

25 *See id.* at 6–7.

26 *See id.* at 8.

27 *See id.* at 8–9.

selling their inventions and as such ought to be kept in mind when considering changes to the patent system.

B. Property Transfer After Death in State Probate Systems

Under U.S. law, the question of what happens to our property after we die is largely one we answer for ourselves: any adult is free to devise his property after death by preparing a will—a written document that complies with certain formalities.[28] With few exceptions, a person may choose to devise his property to anyone he sees fit.[29] Despite this broad freedom, however, an estate must pass through probate proceedings before anyone can claim the property.[30] Those proceedings are the central means by which the validity and terms of a will are affirmed.[31] At the center of these proceedings is the personal representative, an officer appointed by a court to manage the estate and to guide it through the probate process.[32] To better understand the role of the personal representative, this Subsection begins with an overview of succession law; it then gives a brief explanation of the personal representative's role in probate proceedings.

1. An Overview of Succession Law

The entire body of succession law has developed in response to one cruel fact of human existence—"you can't take it with you."[33] Grim though it may be, death is an inevitable part of life, and the property one holds will invariably outlast him. As such, each state has developed laws to manage and distribute any assets remaining after a person, or decedent, dies.[34] State laws dictate the methods for understanding how a decedent intended to distribute his estate to those that

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28 *See* UNIF. PROB. CODE §§ 2-501 to -502 (UNIF. LAW COMM'N 2010). This Note makes reference to the Uniform Probate Code to illustrate general principles of succession law. Although the Uniform Probate Code has not been adopted by all states, it is sufficiently similar to the laws of the majority of states for the purposes of providing background information. In later Sections, reference is made to specific state laws to highlight more particularized aspects of succession law.

29 *But see* LAWRENCE M. FRIEDMAN, DEAD HANDS: A SOCIAL HISTORY OF WILLS, TRUSTS, AND INHERITANCE LAW 46–47 (2009) (describing a notable albeit immaterial exception).

30 *See* UNIF. PROB. CODE § 3-102 (UNIF. LAW COMM'N 2010).

31 *See infra* text accompanying notes 51–54.

32 *See* UNIF. PROB. CODE §§ 1-201(35), 3-703(a) (UNIF. LAW COMM'N 2010).

33 FRIEDMAN, *supra* note 29, at 3.

34 *See* UNIF. PROB. CODE § 1-102(b) (UNIF. LAW COMM'N 2010) (listing the underlying policy goals of the Uniform Probate Code and implicitly recognizing the uniqueness of each state's succession laws in its call for uniformity).

survive him.[35] Promulgating those laws is a power exclusively reserved to the states, as federal courts have a long history of refraining from considerations of succession law, crafting a probate exception to federal subject matter jurisdiction.[36] Although federal courts admittedly lack a clear understanding of where it comes from,[37] the exception prevents a federal court from interpreting a will or distributing the assets in a decedent's estate.[38] It is the state probate courts that are tasked with discerning a decedent's intent.[39]

A decedent's intent—how and to whom he wished to give how much of his assets—is at the core of succession law, the result of the widely recognized and celebrated freedom of testation.[40] "[V]irtually the entire law of wills derives from the premise that an owner is entitled to dispose of his property as he pleases in death as in life."[41] This freedom gives any person the right to designate who shall receive what property from his estate after he dies.[42] And while several established exceptions to this freedom do exist,[43] state probate courts generally strive to give effect to the decedent's testamentary intent. The framework for distributing an estate whose owner never crafted a will are meant to approximate the decedent's intent.[44] Courts have even gone so far as to allow the freedom of testation to supersede constitutional considerations.[45] Any person is free to designate how he wants

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35 *See id.* § 1-102(b)(2).

36 *See* Marshall v. Marshall, 547 U.S. 293, 308, 311–12 (2006); *see also* Sutton v. English, 246 U.S. 199, 205 (1918) (holding that matters of probate are beyond the jurisdiction of federal courts); Waterman v. Canal-La. Bank & Trust Co., 215 U.S. 33, 45 (1909) (recognizing that most matters handled by state probate courts are beyond the diversity jurisdiction of federal courts).

37 *See* Peter Nicolas, *Fighting the Probate Mafia: A Dissection of the Probate Exception to Federal Court Jurisdiction*, 74 S. CAL. L. REV. 1479, 1482–83 (2001) (describing the confusion surrounding the exception).

38 *See Marshall*, 547 U.S. at 311–12.

39 *See* UNIF. PROB. CODE § 1-102(b)(2) (UNIF. LAW COMM'N 2010).

40 *See* FRIEDMAN, *supra* note 29, at 46; *see also* LEWIS M. SIMES, PUBLIC POLICY AND THE DEAD HAND 21 (1955) ("Complete freedom of testation should be permitted except to the extent that there is some public policy against it.").

41 John H. Langbein, *Substantial Compliance with the Wills Act*, 88 HARV. L. REV. 489, 491 (1975).

42 *See* Eike G. Hosemann, *Protecting Freedom of Testation: A Proposal for Law Reform*, 47 U. MICH. J.L. REFORM 419, 421 (2014).

43 *See* FRIEDMAN, *supra* note 29, at 46–47 (describing exceptions for spouses and pension benefits).

44 *See* Susan N. Gary, *The Probate Definition of Family: A Proposal for Guided Discretion in Intestacy*, 45 U. MICH. J.L. REFORM 787, 789 (2012).

45 *See, e.g.*, *In re* Estate of Feinberg, 919 N.E.2d 888, 891, 904–05 (Ill. 2009) (holding that a provision of a will requiring children to marry Jewish spouses was valid and did not conflict with due process or equal protection because the decedent was not a state actor).

his property to be handled after his death, and the courts are obliged to comply.

But why should the freedom of testation be so broad? Why should courts defer to a decedent's intent, even when that intent seems contrary to public policy? A number of reasons are often cited to justify testamentary freedom. One popular argument points to the economic benefits of providing such a broad freedom. The freedom of testation is considered "an incentive for the accumulation of wealth,"[46] with some going so far as suggesting that it optimizes wealth transfer between parties.[47] Another argument offered in favor of broad testamentary freedom is the recognition of individual autonomy,[48] which draws from traditional understandings of natural law and property ownership[49] to posit that, because a person worked hard in life to accumulate his estate, he should be able to devise it as he pleases.[50] Arguments such as these support courts' broad deference to a decedent's intent in will interpretation by pointing to both the public and private benefits of testamentary freedom, and it is important to keep these policy rationales in mind when reviewing the applications of succession law.

2. The Personal Representative

Despite courts' commitment to obeying a decedent's testamentary intent, the property that makes up his estate cannot pass to any inheritor without first going through the probate process.[51] Each state's laws establish a system of probate, "the legal process of settling the estate of a deceased person."[52] During probate, a court will oversee the distribution of assets.[53] Probate is the legal system's way to ensure that the right assets go to the right people. Simple though it

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46 SIMES, *supra* note 40, at 4–5; *accord* Adam J. Hirsch, *Freedom of Testation / Freedom of Contract*, 95 MINN. L. REV. 2180, 2187 (2011) ("Giving persons the right to make a will therefore encourages them to produce and to save more wealth.").

47 *See* Hirsch, *supra* note 46, at 2187 (describing the freedom of testation as "Pareto optimal").

48 *See* Mary Louise Fellows, *In Search of Donative Intent*, 73 IOWA L. REV. 611, 611 (1988); Bruce J. Winick, *On Autonomy: Legal and Psychological Perspectives*, 37 VILL. L. REV. 1705, 1754 (1992).

49 *See* JOHN LOCKE, THE SECOND TREATISE OF CIVIL GOVERNMENT AND A LETTER CONCERNING TOLERATION 15 (J.W. Gough ed., Basil Blackwell 1948) (1690).

50 *See* Adam J. Hirsch & William K.S. Wang, *A Qualitative Theory of the Dead Hand*, 68 IND. L.J. 1, 6 (1992).

51 *See* UNIF. PROB. CODE § 3-102 (UNIF. LAW COMM'N 2010).

52 FRIEDMAN, *supra* note 29, at 2.

53 *See* UNIF. PROB. CODE §§ 3-901 to -915 (UNIF. LAW COMM'N 2010).

may seem, the probate process can easily become a prolonged ordeal: courts typically spend several years sorting out the details and provisions of a will in an ordinary case.[54] Extraordinary cases can last much longer.[55] But while a probate court presides over the probate process generally, the responsibility for managing and eventually distributing the assets falls to one person—the personal representative.[56] The entire probate process surrounds the actions of this one individual:

> The essence of the [probate] process is this: somebody has to be appointed to manage the estate until it is finally distributed. This is the "personal representative." . . . The personal representative takes charge of the property, draws up an inventory of the assets . . . and does whatever else has to be done while the estate is under his care. When these jobs are finished, the personal representative . . . hands the property over to the heirs[] and then bows out.[57]

Thus, the personal representative is at the center of the probate process. After having been appointed by the probate court, he assumes a set of duties and obligations for managing the estate.[58] A court may oversee the probate process, but a personal representative sees it through.[59]

A crucial aspect of the personal representative's role in the probate process is taking control of the decedent's estate.[60] He must then "take all steps reasonably necessary for the management, protection and preservation of[] the estate in his possession."[61] Rather than directly giving him title over the decedent's property, this duty is said to give a personal representative power over title.[62] That power is broadly "conceived to embrace all possible transactions which might result in a conveyance or encumbrance of assets, or in a change of

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54 *See* Mark Reutlinger, *State Action, Due Process, and the New Nonclaim Statutes: Can No Notice Be Good Notice if Some Notice Is Not?*, 24 REAL PROP. PROB. & TR. J. 433, 459–60 (1990) (specifying that the average time for probate proceeding is at least three years).

55 *See, e.g.*, Marshall vs. Marshall, 547 U.S. 293, 300 (2006). This particularly notorious case surrounded the inheritance Anna Nicole Smith received from her late husband and did not close until a Supreme Court decision more than ten years after his death. *Id.*

56 *See* UNIF. PROB. CODE § 1-201(35) (UNIF. LAW COMM'N 2010) (defining "personal representative").

57 FRIEDMAN, *supra* note 29, at 9–10.

58 *See* UNIF. PROB. CODE § 3-103 (UNIF. LAW COMM'N 2010).

59 *See* FRIEDMAN, *supra* note 29, at 9–10.

60 *See* UNIF. PROB. CODE § 3-709 (UNIF. LAW COMM'N 2010).

61 *Id.*

62 *See id.* §§ 3-709, 3-711; *see also, e.g.*, ARK. CODE ANN. § 28-49-101(a) (2016); IOWA CODE § 633.350 (2017). This Note references Arkansas and Iowa state statutes to exemplify states that have not adopted the Uniform Probate Code.

rights of possession."[63] In shepherding an estate through the probate process, a personal representative must not only take control of but also take care of the property therein.[64]

II. The Problematic Treatment of Patents in Probate

Although the patent system and state probate systems correspond to entirely distinct bodies of law, they necessarily intersect when a patent is devised by a will. Because patents are treated as a form of personal property by statute, they can be devised by will just as any other form of property. Though this may seem simple in theory, in reality, the collision of these legal systems produces a number of problems. This Subsection addresses those problems, first addressing the scheme that federal courts have adopted for subjecting patents to state probate systems and then describing the issue of standing that arises from a recent Federal Circuit opinion altering that scheme.

A. Resolving Conflicts of Law

The entirety of the patent system originates in federal law; the Constitution laid the groundwork for it, and Congress followed through by constructing it. The Framers recognized early on, and federal courts still maintain, that patent laws are better left to the federal government instead of the states so the patent system can retain uniformity.[65] In a pair of cases decided on the same day, the Supreme Court held that certain state unfair competition laws were invalid because they conflicted with the objectives of the federal patent system.[66] Furthermore, because a claim for patent infringement is a federal cause of action,[67] there is not much that the states can do to change the way the patent system plays out.[68] The federal government has made clear that the states are barred from affecting the patent system.[69]

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63 Unif. Prob. Code § 3-711 cmt. (Unif. Law Comm'n 2010).

64 *See id.*

65 *See* The Federalist No. 43 (James Madison).

66 *See* Sears, Roebuck & Co. v. Stiffel Co., 376 U.S. 225, 231 (1964); Compco Corp. v. Day-Brite Lighting, Inc., 376 U.S. 234, 237 (1964); *see also* Bonito Boats, Inc. v. Thunder Craft Boats, Inc., 489 U.S. 141, 160–62 (1989) (analyzing the effect of a state law on specific objectives of patent laws).

67 *See* 35 U.S.C. § 281 (2012).

68 *See, e.g.*, Paradise Creations, Inc. v. UV Sales, Inc., 315 F.3d 1304, 1308 (Fed. Cir. 2003) ("Whether a party has standing to sue in federal court is a question of federal law."); *see also* U.S. Const., art. VI, cl. 2.

69 *See supra* text accompanying note 66.

But what happens to a patent after its inventor dies?[70] According to the Patent Act, a patent has the attributes of personal property, so an inventor can devise a patent in a will just as any other real or personal property.[71] "The original title of a patentee to a patent issued to him is presumed to continue until he is shown to have parted with it."[72] This means that an inventor is free to designate an heir to his patent in his will.[73] The language of the federal patent statutes contemplates this capability—securing the exclusive right of a patent for "the patentee, his heirs or assigns" necessarily presumes the inheritability of a patent.[74]

Before an heir receives the patent, the inventor-decedent's will must pass through probate.[75] Subjecting a patent to the probate process nevertheless gives rise to a peculiar conflict of laws: a patent is a purely federal form of property, which the states have been barred from handling; probate, meanwhile, is a purely state law matter, which the federal courts have refused to consider.[76] The Federal Circuit has crafted a quirky fix to the situation: it sees patents in two different lights. A patent is, in essence, a right, and the existence, exercise, and protection of that right is a federal matter.[77] At the same time, however, a patent is a form of property, the treatment of which is subject to state laws.[78] Just as any other form of property, a patent can be devised by its owner through a will.[79] And so, just as any other form of property, a patent goes through probate before reaching an heir.[80]

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70 The distinction between ownership and inventorship is beyond the scope of this Note. While an inventor is the first owner of a patent by definition, *see* Ethicon, Inc. v. U.S. Surgical Corp., 135 F.3d 1456, 1460 (Fed. Cir. 1998), an assignment of rights may change ownership. For the purposes of this Note, however, "owner" and "inventor" are largely used interchangeably. This Note assumes that an inventor has full ownership rights over a patent and that the inventor is under no obligation to assign the patent.

71 35 U.S.C. § 261.

72 Keller v. Sprout, Waldron & Co., No. Civ. 109–23, 1961 WL 8135, at *1 (S.D.N.Y. Apr. 18, 1961).

73 *See* Stickle v. Heublein, Inc., 716 F.2d 1550, 1557–58 (Fed. Cir. 1983).

74 35 U.S.C. § 154.

75 *See* UNIF. PROB. CODE § 3-1002 (UNIF. LAW COMM'N 2010).

76 *See supra* Section I.B.1.

77 *See* Jim Arnold Corp. v. Hydrotech Sys., Inc., 109 F.3d 1567, 1572 (Fed. Cir. 1997); *see also* 35 U.S.C. § 154.

78 *See Jim Arnold Corp.*, 109 F.3d at 1572; *see also* 35 U.S.C. § 261.

79 *See* UNIF. PROB. CODE § 1-201(38) (UNIF. LAW COMM'N 2010).

80 *See id.* § 3-1001.

B. Patent Enforcement During the Probate Limbo

An important question that lingers at the junction between federal patent laws and state probate laws is who has standing to assert patent infringement while the relevant patent is in the midst of probate proceedings. Standing to enforce a patent is closely tied to ownership of the patent—the Federal Circuit has made clear that "in order to assert standing for patent infringement, the plaintiff must demonstrate that it held enforceable title to the patent at the inception of the lawsuit."[81] As the presumptive owner of the patent,[82] the patent's inventor clearly has standing to initiate an infringement action. Anyone who might own the patent after the inventor also has standing.[83] Courts have further recognized that a patentee can transfer an ownership interest for the purposes of standing by transferring substantially all rights in the patent.[84] In addition, any party that has suffered a legal injury from an act of infringement can assert standing,[85] but this is typically limited by a requirement that the patent owner be joined in the infringement action.[86] Thus in each case, a party's standing to bring an infringement action is dependent on the patent owner, who must be a party to the litigation or else have assigned the rights of the patent to the plaintiff.

Given this ownership-based standing, who can bring an action for patent infringement while a patent is in probate? There is no apparent answer: the original patent owner has died, so he certainly does not have standing; and, until probate closes and the estate is distributed, any heir to the patent lacks title and therefore also lacks standing, even if that heir would eventually receive title.[87] The early predecessors to the Circuit Courts of Appeals recognized this issue and sug-

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81 Paradise Creations, Inc. v. UV Sales, Inc., 315 F.3d 1304, 1309 (Fed. Cir. 2003) (emphasis removed).

82 *See* Ethicon, Inc. v. U.S. Surgical Corp., 135 F.3d 1456, 1460 (Fed. Cir. 1998).

83 Federal statute recognizes that the inventor is not the only person who might have an ownership interest in a patent. *See* 35 U.S.C. § 281 (providing a patentee with civil remedy for patent infringement); *see also id.* § 100(d) (including successors in title in the definition of patentee).

84 *See* Morrow v. Microsoft Corp., 499 F.3d 1332, 1339–40 (Fed. Cir. 2007); Propat Int'l Corp. v. Rpost, Inc., 473 F.3d 1187, 1189 (Fed. Cir. 2007).

85 *See Propat*, 473 F.3d at 1193. This type of standing is typically reserved for exclusive licensees of a patent. *See id.*

86 *See* Indep. Wireless Tel. Co. v. Radio Corp. of Am., 269 U.S. 459, 468 (1926).

87 *Cf.* Paradise Creations, Inc. v. UV Sales, Inc., 315 F.3d 1304, 1309–10 (Fed. Cir. 2003). The Federal Circuit held that a corporation lacked standing to bring a patent infringement claim because at the time of filing the corporation was administratively dissolved. The corporation could not assert standing based on an expectancy of regaining standing when the corporation would eventually be reinstated during the proceedings. *Id.* Similarly, here the heir to a patent

gested that a personal representative rightfully has the standing to bring a patent infringement action.[88] These courts went so far as to hold that the title to the patent vests in the personal representative.[89] This notion was long understood to mean that a personal representative becomes the owner of a patent until he makes an assignment to the heir upon closing the estate.[90] Thus, when a patent owner dies, title in his patent vests in his personal representative,[91] who—until probate closes and the personal representative assigns the patent to the true heir—has standing to enforce the patent.[92]

The Federal Circuit, however, recently rejected that long-held concept in *Akazawa v. Link New Technology International, Inc.*[93] Examining the early court cases that gave rise to this line of reasoning, the Federal Circuit posited that they do "not stand for the proposition that patent rights vest in [the personal representative] at death";[94] rather, those decisions support the modern deference that federal courts give to state probate courts in handling probate matters.[95] "[T]he question of when and to whom title [in a patent] is transferred is determined by state law."[96]

The Federal Circuit's holding generates a great deal of confusion. According to state law, a personal representative merely takes control of the decedent's estate; he does not receive title to any property within the estate.[97] Thus, the personal representative apparently now lacks the standing to bring a claim of patent infringement.[98]

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cannot assert standing based on eventually receiving the title to the patent. Essentially, standing cannot be based on an expectation interest.

88 *See* Hodge v. N. Mo. R.R., 12 F. Cas. 279, 280 (C.C.E.D. Mo. 1869) (No. 6561) (holding that, until a written assignment from the personal representative to the heir has been made, the action should have been brought in the personal representative's name).

89 *See* Bradley v. Dull, 19 F. 913, 913 (C.C.W.D. Pa. 1884) (citing Shaw Relief Valve Co. v. City of New Bedford, 19 F. 753, 755 (C.C.D. Mass. 1884)) (holding that, when a patentee dies intestate, the patent becomes vested in the personal representative).

90 *See* Owen v. Paramount Prods., 41 F. Supp. 557, 560 (S.D. Cal. 1941).

91 *See id.*

92 *See supra* text accompanying notes 81–86.

93 520 F.3d 1354 (Fed. Cir. 2008).

94 *Id.* at 1357.

95 *See id.*

96 *Id.*

97 *See* UNIF. PROB. CODE §§ 3-709, -711 cmt (UNIF. LAW COMM'N 2010).

98 Even if the personal representative could establish indirect standing by showing that he suffers legal injury from the infringement, he would need to join the patent owner as a party to the litigation. Because the patent owner is indeterminable until the close of probate, that simply is not possible.

The issue of who can enforce a patent during probate proceedings may seem pedantic. If the heir will eventually be determined at the end of probate, why does it matter who can enforce a patent during probate? The answer is simple: patents are time-sensitive. Once a patent expires, there is nothing one can do to enforce it.[99] Even before the patent expires, a patent infringement action is subject to a statute of limitation on the availability of money damages.[100] That time-sensitivity is particularly worrisome in light of how long the probate process can take. Despite the best efforts of personal representatives and probate courts,[101] probate proceedings for an average estate will typically take about three years, and there are numerous examples of probate proceedings that took much longer.[102] Given that fact, it is very possible that a patent stuck in probate might expire before reaching an heir.[103] Unless someone is able to enforce the patent while it is tied up in probate, the patent is practically worthless to the heir. Before *Akazawa*, that person was clearly the personal representative, and Congress should amend the patent laws to statutorily guarantee that the personal representative has standing to enforce a patent, regardless of whether he has title in the patent. *Akazawa* created a mess, and Congress needs to step in to clean it up.

III. Cleaning Up After *Akazawa*

A. Providing Personal Representatives with Statutory Standing to Assert Patent Infringement Claims

By subverting the longstanding assumption that a personal representative receives title to a patent in the decedent's estate and simulta-

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99 *See supra* notes 16–20 and accompanying text.

100 *See supra* notes 19–20 and accompanying text.

101 Among the many obligations of a personal representative is the requirement that he act "expeditiously and efficiently." Unif. Prob. Code § 3-703 (Unif. Law Comm'n 2010). The states have similarly called on their respective probate courts to pursue efficiency by imposing statutory time limits on the length of probate proceedings. *See id.* § 3-108.

102 *See, e.g.*, Palozie v. Palozie, 927 A.2d 903, 908 (Conn. 2007) (adjudicating an issue that arose during probate proceedings that were still ongoing almost twenty years after the decedent's death); *see also* Robert A. Stein, *Probate Administration Study: Some Emerging Conclusions*, 9 Real Prop. Prob. & Tr. J. 596, 602–03 (1974) (discussing the duration of probate administration). *But see* David Horton, *In Partial Defense of Probate: Evidence from Alameda County, California*, 103 Geo. L.J. 605, 651–52 (2015) (arguing that complaints of probate proceedings taking too long are exaggerated).

103 *See supra* Section I.A. A patent that is a part of the probate estate may be at particular risk if it is considered to be commercially valuable. When a probate estate includes "considerable money, claimants—distant cousins of all shades and sorts, or alleged cousins—will come out of the woodwork, and a distasteful squabble over the money is bound to follow." Friedman, *supra* note 29, at 28.

neously insisting on deference to state probate courts for questions of patent ownership, the Federal Circuit complicated the question of who has standing to assert infringement of a patent that composes part of an estate in probate.[104] The resultant issues of standing are the unfortunate consequence of that jurisprudence. Instead of waiting for the Federal Circuit to change course, Congress ought to act.[105] Congress could enact a provision to explicitly ensure that standing passes on to a personal representative, such as the following:

> Any right of action given by this chapter to a patentee shall survive to his or her personal representative, for the benefit of the heir to the patent, as designated by the patentee's will, and, if no will exists, to the heir as determined by the laws of intestate succession of the appropriate State. In such cases, there shall be only one recovery for the same harm.[106]

An even simpler solution would be to amend the federal patent laws to provide a statutory basis for a personal representative's standing by adding "personal representative" to 35 U.S.C. § 154(a)(1). The resulting statute would then grant the exclusive right in a patent to "the patentee, his personal representative, heirs, or assigns."[107] Statutorily providing standing over patent infringement claims to a personal representative is appropriate, as shown below, because it fulfills states' existing presumption that a personal representative has standing, it comports with a personal representative's existing duties over patents as well as his analogous duties over copyrights, and it promotes policy cooperation between patent law and succession law.

1. States Already Presume that a Personal Representative Has Standing

The Federal Circuit's decision in *Akazawa* mandates deference to state laws in the handling of patents during the probate process.[108] The states, however, already presume that a personal representative has

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104 *See* Akazawa v. Link New Tech. Int'l, Inc., 520 F.3d 1354, 1357 (Fed. Cir. 2008) (asserting that personal representatives do not automatically receive title to devised patents and insisting that ownership of a patent during probate must be resolved by a state probate court).

105 It is not uncommon for Congress to step in and correct improvident judicial holdings by enacting federal statute. *See generally* Neal Devins, *Congressional Responses to Judicial Decisions*, *in* ENCYCLOPEDIA OF THE SUPREME COURT (Mark Graber et al. eds., Gale MacMillan 2008). This issue, in particular, may benefit from a legislative response; the problem arises as a judicial side effect, and it might be better handled with a fine-tuned legislative correction.

106 This proposed statutory language is loosely based on 45 U.S.C. § 59 (2012), which preserves the right of action of an employee injured in his or her work for a railroad company.

107 *See* 35 U.S.C. § 154(a)(1) (2012).

108 *See Akazawa*, 520 F.3d at 1357.

standing: in addition to explicitly but ineffectively giving him standing to assert the claim,[109] the states impose on the personal representative duties and obligations that can be read as requiring him to enforce a patent. Succession law requires a personal representative to take possession of the decedent's property and then to take all reasonable steps necessary to manage and protect it.[110] Because this includes any patents in the decedent's estate, the states thus command personal representatives to take care of patents. As asserting a claim of infringement is tantamount to protecting the patent, the states expect a personal representative to enforce a patent. To maintain a patent, a personal representative must be statutorily enabled to enforce it.[111]

The importance of asserting infringement in protecting a patent is most obvious in the equitable doctrine of laches. This doctrine provides an equitable defense to patent infringement, barring recovery when the patent owner unreasonably delayed in initiating the action.[112] This defense creates an expectation, if not an obligation, that a patent owner diligently pursue litigation against an infringer.[113] Enforcing a patent is part and parcel of owning a patent: one may not be under any obligation to exercise a patent,[114] but the doctrine of laches

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109 The statutory description of the scope of a personal representative's duties and powers notably includes the provision of standing. A personal representative "has the same standing to sue and be sued in the courts of this state . . . as his decedent had immediately prior to death." UNIF. PROB. CODE § 3-703(c) (UNIF. LAW COMM'N 2010); *accord* IOWA CODE § 633.81 (2017); Estate of Banks v. Wilkin, 272 S.W.3d 137, 139 (Ark. Ct. App. 2008) (holding that orders of appointment confer standing to personal representative). On its face, this would seem to handle the issue at hand—the federal courts defer to state law, and state law provides the personal representative with standing. But it is not that simple. Patent infringement is a federal cause of action, *see* 35 U.S.C. § 281 (2012), so the states cannot outright provide standing to enforce a patent, *see* Paradise Creations, Inc. v. UV Sales, Inc., 315 F.3d 1304, 1308 (Fed. Cir. 2003) ("Whether a party has standing to sue in federal court is a question of federal law."). As such, any provision of standing for patent infringement must come from the federal government.

110 *See supra* Section I.B.2.

111 Because standing to assert patent infringement is so closely related to title over the patent, *see supra* Section II.B, the states could also indirectly confer standing by vesting title over the patent in the personal representative. As the Uniform Probate Code explains, states choose not to do so, because giving the personal representative power over title preserves the chain of title and simplifies the ultimate transfer. *See* UNIF. PROB. CODE § 3-711 cmt. (UNIF. LAW COMM'N 2010). Simply put, it is easier not to give the personal representative title. As such, his standing to enforce must come from elsewhere, such as Congress.

112 *See* A.C. Aukerman Co. v. R.L. Chaides Constr. Co., 960 F.2d 1020, 1028, 1032, 1039–40 (Fed. Cir. 1992). The nuances of the affirmative defense of laches are beyond the scope of this Note.

113 *See* Starr Piano Co. v. Auto Pneumatic Action Co., 12 F.2d 586, 588 (7th Cir. 1926).

114 The non-requirement of practicing a patent has given rise to a number of non-practicing entities, which have recently been the subject of public outcry and have been pejoratively termed "patent trolls." *See, e.g.*, William M. Bulkeley, *Aggressive Patent Litigants Pose Growing Threat*

makes clear that one may be required to assert that patent or lose its benefit. By tying the exclusive right of a patent to the exercise thereof, laches effectively creates a duty to enforce the patent.

Despite his current inability to legally do so, the personal representative is beholden to that de facto duty.[115] The personal representative maintains his duty to manage, preserve, and protect the decedent's estate.[116] Diligently enforcing a patent is at the core of maintaining the patent; otherwise, as laches makes clear, the value of the patent diminishes. A personal representative is thereby obliged to preserve a patent by enforcing it. Unfortunately, the states lack the power to grant the personal representative the right to enforce a patent.[117] Congress therefore ought to intercede and statutorily provide personal representatives with the standing to assert claims of patent infringement.

2. *The Ability to Assert Patent Infringement Comports with a Personal Representative's Existing Duties Regarding Patents*

Asserting a claim of patent infringement is far from the only interaction a personal representative might have with a patent in the decedent's probate estate. On the contrary, there are a number of other issues regarding an inventor's patent protection that may require the personal representative's action. In two notable examples—patent prosecution[118] and assignment—the personal representative maintains certain existing duties that support providing the personal representative with standing, because they are analogous to providing him the right to exclude under the patent.

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to Big Business, WALL ST. J., https://www.wsj.com/articles/SB112666647063840131 (last updated Sept. 14, 2005, 12:01 AM); Jonathan Krim, *Patenting Air or Protecting Property?*, WASH. POST (Dec. 11, 2003), https://www.washingtonpost.com/archive/business/2003/12/11/patenting-air-or-protecting-property/a1d8769c-384c-4d29-9b72-fad42029c8a7/?utm_term=.e17446f7b922.

115 It is unclear whether laches could bar recovery for infringement of a patent that had been tangled up in probate proceedings as it is unlikely that the probate proceedings would be considered an unfair delay, *see A.C. Aukerman Co.*, 960 F.2d at 1032, or that the period of delay would run during probate proceedings, *see* Wanlass v. Gen. Elec. Co., 148 F.3d 1334, 1337 (Fed. Cir. 1998). The fact remains, however, that the effect of the doctrine of laches is to create an obligation to enforce a patent; that effect is the force behind this Note's argument.

116 *See* UNIF. PROB. CODE § 3-709 (UNIF. LAW COMM'N 2010); *see also supra* Section I.B.2.

117 *See supra* note 109.

118 The term "patent prosecution" in this Note refers generally to the process of filing a patent application and the subsequent negotiations with the U.S. Patent and Trademark Office, which ultimately lead to the grant or rejection of a patent.

Congress has already recognized the personal representative's important role in the patent system. When an inventor dies before filing an application for a patent, federal law specifies that her personal representative may file the application on her behalf.[119] The personal representative prosecutes the patent on behalf of the deceased inventor and ultimately transfers any resultant patent to her heirs.[120] Federal regulations even go so far as to dictate that, when an inventor dies during prosecution and a personal representative steps in to prosecute the application, the resulting patent ought to be issued directly to the personal representative.[121] Similarly, probate courts also recognize the special authority of a personal representative to prosecute a patent on behalf of a deceased inventor.[122] Current federal law empowers, if not encourages, the personal representative to pursue the legal protection of an inventor's work if she dies before receiving a patent.[123]

Even when an inventor does live long enough to fully prosecute her own patent, the personal representative may be forced to manage the patent in ways other than asserting infringement claims. The personal representative has an obligation to complete contractually arranged assignments of the patent: an inventor is free to assign her rights in her patent,[124] but if she dies before completing an assignment, courts have forced personal representatives to do so on her behalf.[125] Courts point to the importance of fulfilling the deceased inventor's contractual obligations and recognize that specific performance is appropriate for an agreement to assign a patent.[126] Courts also consider a personal representative's role in assigning a decedent's patent to be an implication of the transfer of rights.[127] Under this reasoning, statute vests the rights of a patentee in the personal representative. Thus, the personal representative cannot exercise further power to refuse to make an assignment.[128] A personal representative is obligated to exercise the rights of the deceased patent owner as she would have done,

119 *See* 35 U.S.C. § 117 (2012); *see also* 37 C.F.R. § 1.43 (2012).

120 *See* Fox v. Kingsland, 81 F. Supp. 433, 437 (D.D.C. 1948) (interpreting an earlier version of the statute).

121 *See* 37 C.F.R. § 1.43.

122 *See In re* Russell's Estate, 98 N.E.2d 592, 592–93 (Hamilton Cty. Prob. Ct., Ohio 1951).

123 *See* 37 C.F.R. § 1.43.

124 *See* 35 U.S.C. § 261 (2012).

125 *See, e.g.*, Superior Elec. Co. v. Burski, 193 A.2d 898, 900 (Conn. Super. Ct. 1963).

126 *See id.* An order compelling a personal representative to make an assignment can even come from a state probate court. *See* Heller v. Leisse, 13 Mo. App. 180, 183 (Ct. App. 1883).

127 *See* Newell v. West, 18 F. Cas. 50, 51–52 (C.C.N.D.N.Y. 1875) (No. 10,150).

128 *See id.*

and that encompasses making any assignment the patent owner had intended to make.

Both these duties demonstrate the extent to which a personal representative is called on to embrace the rights of a patent owner. They nevertheless fall short of granting the personal representative the core right of a patent: the right to exclude. For the purposes of patent prosecution, a personal representative is required to step into the shoes of the inventor—the situation should be the same in patent enforcement. When a patent holder is unable to assert a claim of patent infringement because he has died before filing the complaint, the personal representative should be able to do so. Otherwise, a personal representative cannot be said to hold "the same rights [the patentee] would have enjoyed if [she] had lived."[129] On the contrary, the rights of the personal representative are much more restricted than those the deceased patent owner held. Without the standing to bring a claim of patent infringement, a personal representative is denied the ability to act on behalf of the decedent, as he already does for other aspects of the patent.

3. *The Ability to Assert Patent Infringement Comports with a Personal Representative's Analogous Duties Regarding Copyrights*

Ensuring a personal representative has standing to assert patent infringement makes sense in light of his ability to do so for other forms of intellectual property. A notable example is copyright. Patents are certainly not the only form of intellectual property that a personal representative might encounter in managing a decedent's estate; the treatment of copyrights during probate proceedings can be informative in considering the treatment of patents. While patent and copyright law are entirely distinct from one another and have largely developed separately,[130] they do emerge from the same clause of the Constitution.[131] Even the Supreme Court has borrowed principles from each body of law when considering the other.[132] Looking to a personal representative's role in handling copyrights can therefore be

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129 *Id.* at 51.

130 *See* Eldred v. Ashcroft, 537 U.S. 186, 217 (2003); Sony Corp. of Am. v. Universal City Studios, Inc., 464 U.S. 417, 439 n.19 (1984).

131 *See* U.S. CONST. art. I, § 8, cl. 8 (authorizing Congress to protect both the works of inventors and the writings of authors).

132 *See, e.g.*, Golan v. Holder, 565 U.S. 302, 322–23 (2012) (discussing the previously litigated validity of analogous patent statutes in assessing the validity of copyright protection pursuant to an international treaty); *Eldred*, 537 U.S. at 201–02; *see also* Eva E. Subotnik, *Copyright*

helpful when assessing the problems in his handling patents. In doing so, one recognizes that the much broader control that personal representatives have over copyrights supports providing similarly broad control over patents.

Copyrights, much like patents, are a federally established form of intellectual property that provide copyright holders an exclusive right over the protected work.[133] Whereas patents apply to inventions, copyrights apply to written or recorded work.[134] Ownership of a copyright can also be transferred by will or intestacy.[135] Unlike patents, however, standing to bring a claim for copyright infringement is less exacting, allowing for either the "legal or beneficial owner" of a copyright to institute a civil action.[136] This broader grouping of potential plaintiffs has been understood to include the personal representative of a deceased copyright holder. The Middle District of Florida recognized this in *Corwin v. Walt Disney Co.*,[137] albeit somewhat indirectly. In that case, Corwin, in his capacity as personal representative of the estate of Mark Waters II, sued Disney alleging that it had infringed a copyright on Waters' painting in the design of the Epcot theme park.[138] In its motion for summary judgment, Disney asserted that Corwin lacked standing to assert the claim of copyright infringement in his capacity as personal representative.[139] Without specifically addressing the question of whether a personal representative has standing to initiate an action for copyright infringement, the Middle District of Florida concluded that Corwin did have standing.[140] Other cases have also implicitly recognized that a personal representative has the standing to bring a claim of infringement for a copyright in the dece-

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and the Living Dead?: Succession Law and the Postmortem Term, 29 HARV. J.L. & TECH. 77, 83 (2015).

133 *See* 17 U.S.C. § 106 (2012).

134 *Compare* 35 U.S.C. § 101 (2012) (describing patent eligible technology), *with* 17 U.S.C. § 102 (describing subject matter of copyrights), *and* 17 U.S.C. § 202 (distinguishing copyright ownership from ownership of material object).

135 *See* 17 U.S.C. § 201(d)(1). While the ability to transfer ownership of a patent by will arises largely as an implication of its statutory treatment as personal property, *see* 35 U.S.C. § 261, the copyright statute specifically addresses that a copyright can be transferred by "any means of conveyance," including "by will," 17 U.S.C. § 201(d)(1). That the statute specifically envisions this transfer may explain why a personal representative's control over a copyright has been less troublesome.

136 17 U.S.C. § 501(b).

137 No. 6:02-cv-1377-Orl-19KRS, 2004 WL 5486639 (M.D. Fla. Nov. 12, 2004).

138 *See id.* at *5.

139 *See id.* at *13.

140 *See id.* at *15.

dent's estate.[141] Personal representatives are thus permitted to enforce the exclusive right of the decedent's copyright.

If a personal representative has standing to assert a claim for copyright infringement on behalf of the decedent, it seems nonsensical to deny him the right to assert a claim for patent infringement. Both are federal forms of intellectual property protection whose value rests in the ability to control who may make use of the property. Both are treated as personal property for the purposes of succession law. And yet only copyrights can be enforced by an estate's personal representative. Why should patents be treated differently? If anything, it would seem that patent infringement cases bear a greater degree of urgency due to the much shorter term of a patent.[142] A personal representative ought to have the same control over a patent as over a copyright, and a statutory provision of standing for a claim of patent infringement would make it so.

4. Patent Enforcement During Probate Promotes Policy Cooperation Between Patent and Succession Laws

A statutory basis for a personal representative's standing to enforce patents would facilitate the cooperation of the patent system and the probate process. This is particularly desirable as the policy goals of the two systems align: both patent law and succession law are generally rooted in economic and humanistic justifications.[143] Ensuring patent enforcement during probate allows the two bodies of law to work in tandem toward their goals.

The patent system is often supported by the utilitarian goal of encouraging useful innovation.[144] That understanding of the patent system recognizes its role in encouraging continued scientific progress.[145] In doing so, the patent system creates a regime that simultaneously incentivizes continued useful innovation and motivates disclosure of that innovation to the public. While not explicitly focused on scientific developments, the testamentary freedom at the

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141 *See, e.g.*, Tennyson v. Am. Soc'y of Composers, Authors & Publishers, 477 F. App'x 608, 611 (11th Cir. 2012) (denying the plaintiff standing to assert copyright infringement because the plaintiff was not the personal representative of the estate).

142 *Compare* 35 U.S.C. § 154(a)(2) (2012) (establishing twenty-year term for patents), *with* 17 U.S.C. § 302 (2012) (establishing general copyright term as life of author plus seventy years after author's death). That the term of a copyright is defined with respect to the death of the author makes it unlikely, if not impossible, for a copyright to expire during probate proceedings.

143 *See supra* text accompanying notes 22–26, 45–49.

144 *See, e.g.*, Bonito Boats, Inc. v. Thunder Craft Boats, Inc., 489 U.S. 141, 150–51 (1989).

145 *See* U.S. CONST. art. I, § 8, cl. 8.

core of the probate system also strives toward economic benefits for the public.[146] Free testation, it is said, encourages the accumulation and transfer of wealth by giving people broad control over their assets.[147] Both patent law and succession law have the economic goals of producing and distributing wealth, and simplifying their intersection allows them to collaborate in that goal.

The patent system is also supported by more humanistic justifications that appreciate the hard work of the inventor.[148] The exclusive right of a patent is said to be an inventor's reward for all her effort in producing the invention.[149] Testamentary freedom is likewise grounded in a respect for the decedent's industrious diligence.[150] It gives life to the natural law understanding that each person has an absolute right over "[t]he labour of his body and the work of his hands."[151] Just as an inventor's patent over her invention is earned by her work, a decedent's testamentary freedom is earned by his work. Both patent law and succession law defer to the dignity and industriousness of a person's labor. The two can join forces in this humanistic goal by providing a personal representative standing to assert patent infringement and thereby simplifying the enforcement of a patent during probate.

B. A Problematic Alternative: Treating Patents as Contracts

Establishing a statutory basis for personal representatives' standing to assert claims of infringement is by no means the only possible remedy for the troublesome treatment of patents during probate. An alternative solution draws from contract law: courts have on occasion described patents as a kind of contract between an inventor and the government, on behalf of the public.[152] In this sense, a patent is an agreement, whereby an inventor earns an exclusive right in exchange for disclosing the patented invention to the public.[153] As such, one might think to turn to contract law in search of an answer for how to treat a patent whose owner has died. Doing so seems sensible, as it prevents the issue from arising at all, because when a party to a con-

146 *See* Hirsch, *supra* note 46, at 2187.

147 *See id.*

148 *See* MERGES, *supra* note 24, at 8–9.

149 *See id.*

150 *See* Fellows, *supra* note 48, at 611; Winick, *supra* note 48, at 1754.

151 LOCKE, *supra* note 49, at 15.

152 *See* Century Elec. Co. v. Westinghouse Elec. & Mfg. Co., 191 F. 350, 354 (8th Cir. 1911).

153 *See* Ariad Pharms., Inc. v. Eli Lilly & Co., 598 F.3d 1336, 1347 (Fed. Cir. 2010); ICU Med., Inc. v. Alaris Med. Sys., Inc., 558 F.3d 1368, 1377 (Fed. Cir. 2009).

tract dies, performance is generally discharged and the contract is dissolved.[154] Courts dismiss breach of contract actions brought against the estate of a party to the contract because the death of the party precludes performance.[155] If approaching a patent as a contract, this doctrine would similarly suggest that a patent should expire on the death of the owner. There would thus be no issues of standing, because there would be no patent to infringe. Although somewhat extreme,[156] this method would deftly avoid all the problems of subjecting a patent to probate.

But this solution is not without its own flaws. Both Congress and the courts already recognize that a patent survives its owner's death.[157] Allowing a patent to expire subverts that established law. Although the specifics of their treatment have evolved over time, patents have long been understood as personal property that passes through probate.[158] Furthermore, applying contract law in this way denies the harmony of the patent and probate systems' policies.[159] The economic and humanistic goals of patent law cannot collaborate with those of succession law if the two bodies of law do not ever converge. Temptingly straightforward though it may be, applying contract law to a patent after its owner's death overlooks reasons for maintaining the current arrangement.

Beyond that oversight, however, treating patents as contracts for the purposes of probate also has an unsavory consequence: it incentivizes homicide. Should a patent simply expire upon the death of its owner, a would-be competitor or infringer could avoid the delay and cost of waiting for a natural expiration; rather, he might take matters into his own hands and force the patent to expire. Grisly though it may seem, the states already consider and address this problem. Suc-

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154 *See* RESTATEMENT (SECOND) OF CONTRACTS § 262 (AM. LAW INST. 1981). Because contract law varies between states, this Note refers to the *Restatement (Second) of Contracts* for general principles.

155 *See id.* § 262 cmt. a, illus. 1; *see also, e.g.*, CNA Int'l Reinsurance Co. v. Phoenix, 678 So. 2d 378, 378–80 (Fla. Dist. Ct. App. 1996); *In re* Estate of Sheppard, 789 N.W.2d 616, 620 (Wis. Ct. App. 2010).

156 This solution could be implemented by the courts, which have been responsible for construing patents as contracts, but if Congress were to codify this treatment, it would be able to limit its scope by, for example, limiting expiration of a patent on death to a patent already nearing expiration. Indeed, Congress might need to implement this solution in order to circumvent the current statutory treatment of patents as personal property. *See* 35 U.S.C. § 154(a)(1) (2012).

157 *See supra* Section II.A.

158 *See supra* Section II.B.

159 *See supra* Section III.A.4.

cession laws generally avoid it with so-called "slayer statutes" that lapse or void any bequests to a person who killed the decedent.[160] These laws prevent killers from reaping legal benefits from their illegal activities.[161] Similar laws do not exist for patents, nor are they particularly tenable: if the content of a patent is committed to the public upon expiration,[162] then there is no reasonable way to single out a killer as proscribed from using that knowledge. Even if he were subjected to a permanent injunction, he might still be able to reap the benefits of the patent's subject matter through a business associate or some other proxy. It might not be possible to statutorily avoid this incentive to murder. Thus, the alternative solution of treating a patent as a contract would likely create more problems than it would fix; as such, it should be avoided.

Conclusion

A personal representative ought to be able to sue for patent infringement. The states largely expect a personal representative to do so, but they are unable to provide standing for the federal cause of action. Furthermore, asserting a claim of infringement is in line with the duties a personal representative already has with regard to patents. A personal representative even has standing to sue for infringement of a copyright, an analogous form of intellectual property protection. Providing a personal representative with standing also better aligns and achieves the shared policy goals of patent law and succession law. But because the Federal Circuit has so broadly deferred to the states for probate matters, personal representatives now lack the standing to do so. As such, Congress should intervene and enact federal legislation that ensures a personal representative has standing.

Reconsidering the *Back to the Future* scenario illustrates how well this statutory solution works. Recall that, after Doc's death, Biff had been manufacturing and selling models of Doc's patented time machine. Marty, named in the will as the heir to the patent, had been unable to stop Biff, because Doc's estate was still subject to probate. The proposed legislation, however, makes matters very different. Although Marty may not be able to assert the patent himself, Doc's personal representative can do so on his behalf. Because a clear statutory provision firmly establishes his standing, the personal representative

160 *See* Unif. Prob. Code § 2-803 (Unif. Law Comm'n 2010); *see also* Hirsch, *supra* note 46, at 2214.

161 *See* Hirsch, *supra* note 46, at 2214.

162 *See* Brulotte v. Thys Co., 379 U.S. 29, 31 (1964).

can bring an infringement action against Biff to enjoin his manufacture. If my calculations are correct, Biff is going to see one serious lawsuit.