

Patent-Eligibility: Let's Do Something to Help Applicants!

Attached is an open letter to the leadership of the patent community. It challenges leaders to come forward at the dawn of a new Administration to change the direction of the Patent Office. We must provide a simpler system for examination of cases with Section 101 patent-eligibility issues.

The letter includes a paper outlining what *can* be done, consistent with case law, and also providing suggestions as to how test cases can be crafted to help shape the law.

What precisely should be done? The answers are found in "*The 800 Pound Faux Stare Decisis Gorilla in the Room of Patent-Eligibility: An Opportunity to Improve the System,*" an attachment to the open letter.

Naples January 14-17: Experts are encouraged to join the upcoming Naples Roundtable, January 14-17, 2017, where we will have ample time to talk in this four day event at informal portions of the conference such as a cruise out of Naples Harbor and a beachfront opening reception and dinner. Details are available from The Naples Roundtable, Inc.TM, a Sec. 501(c)3 nonprofit organization *Exploring Ways to Strengthen and Improve the Patent System*, <https://www.thenaplesroundtable.org/>.

Regards,

Hal

November 14, 2016

Harold C. Wegner
6602 Southfork Court
Naples, Florida 34108
hwegner@gmail.com

November 14, 2016

To the Leadership of the Patent Community:

Re: The 800 Pound *Faux Stare Decisis* Gorilla Denying Patent-Eligibility

Colleagues:

We approach the dawn of a new Administration: At some point a new Director of the Patent Office will be confirmed by the Senate. We should make it a priority that the new leadership implements a more applicant-friendly examination system for issues relating to Section 101 patent-eligibility.

Test cases, without more, are insufficient: We must create an environment to facilitate grant of patents in areas now constricted by rigid and unnecessary procedures. Simpler procedures should guarantee a more user-friendly examination within the ambit of what is possible in view of the case law so that when test cases are successful, applicants with inventions today will have enforceable rights.

What precisely should be done? The answers are found in *The 800 Pound Faux Stare Decisis Gorilla in the Room of Patent-Eligibility: An Opportunity to Improve the System* (attached).

Let's discuss this in Naples! If you are critically involved with this issue, join other experts at the upcoming Naples Roundtable, January 14-17, 2017. We will have ample time to talk in this four day event beyond the formal sessions such as a cruise out of Naples Harbor and a beachfront opening reception and dinner. Details are available from The Naples Roundtable, Inc.TM, a Sec. 501(c)3 nonprofit organization *Exploring Ways to Strengthen and Improve the Patent System*, <https://www.thenaplesroundtable.org/>.

Very truly yours,

Hal Wegner

Harold C. Wegner

**THE 800 POUND FAUX STARE DECISIS GORILLA
IN THE ROOM OF PATENT-ELIGIBILITY:
AN OPPORTUNITY TO IMPROVE THE SYSTEM**

Harold C. Wegner*

“The exceptions [to categories of § 101 patent- eligible subject matter] have defined the reach of the statute as a matter of statutory *stare decisis* going back 150 years [to] *Le Roy v. Tatham*, 14 How. 156, 174–75 (1853).”

-- Hon. Anthony Kennedy**

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* President, The Naples Roundtable, Inc.TM. The organization is a Sec. 501(c)3 nonprofit organization “Exploring Ways to Strengthen and Improve the Patent System”, <https://www.thenaplesroundtable.org/>.
contact: hwegner@gmail.com.

** *Bilski v. Kappos*, 561 U.S. 593, 602 (2010).

About this Paper:

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This paper is without endorsement or sponsorship from any other
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I. OVERVIEW

There are a variety of reforms to the case law exceptions to patent-eligibility that could be envisioned, but this view is blocked by the Supreme Court explanation citing *Le Roy v. Tatham*, 55 U.S. (14 How.) 156, 175 (1853)), that “these exceptions have defined the reach of the statute as a matter of statutory stare decisis going back 150 years”^{***}*Gottschalk v. Benson*, 409 U.S. 63, 67(1972). This paper explores whether the premise of “150 years” of *stare decisis* keyed to *Le Roy v. Tatham* is correct.

If the premise is not correct, this opens the door to case law reforms to the scope of patent-eligibility. To open the door to whatever changes may be contemplated, the monkey on the back of any such reform is thus the mythology that suggests the “150 year” *Le Roy v. Tatham*-based *stare decisis*.

Such *stare decisis* – so the argument goes -- locks into place any change in the case law of subject matter-based denial of patent-eligibility that has blocked grant of patents to inventions within the excluded categories.

To understand whether *stare decisis* applies to a particular case, it is first helpful to understand what *is* the doctrine of *stare decisis*. It is an abbreviation for a longer phrase which, translated into English, limits “the doctrine of stare decisis *** for what [the case] decides.” The doctrine is limited so that a future court “stand[s] by and adhere[s] to *decisions* and [does] not disturb what is settled.”^{***} See § II, *Le Roy v. Tatham: “150 Years” of Stare Decisis*.

For a century, the 1853 *Le Roy v. Tatham* case was a minor precedent that was essentially thrown onto the legal scrap heap when in the same case, six years later, a holding of patent validity was reached, effectively upsetting the 1853 denial of patentability. Like the Phoenix rising from the ashes, the case was reborn in importance when it was revived in 1948 by Justice Douglas in *Funk v. Kalo*, which in turn was basis for his opinion a generation later in *Gottschalk v. Benson* where *Le Roy v. Tatham* was relied upon for the statement that “patents cannot issue for the discovery of the phenomena of nature.” . See § II-D, *Rebirth of Le Roy v. Tatham in Funk v. Kalo*.

One may compare the legal situation here to that of the naked King in the Hans Christian Andersen fable, *The Emperor's New Clothes*: Without realizing the lack of precedential value of *Le Roy v. Tatham*, the Supreme Court has attached itself to *Le Roy v. Tatham* as basis for its decisions in *Parker v. Flook*, *Diamond v. Diehr*, *Lab. Corp. of Am. Holdings v. Metabolite Labs.*, *Diamond v. Chakrabarty*, *Bilski v. Kappos*, *Mayo v. Prometheus Laboratories* and, *Alice v. CLS Bank*. See § III, *The Mythology of Le Roy v. Tatham*, particularly § III-A, *Supreme Court decisions*.

With at least one notable exception in the case of the late Giles Sutherland Rich, the Federal Circuit has accepted without question the Supreme Court explanation of *Le Roy v. Tatham*. See § III-B, *An Uncritical Acceptance of Le Roy v. Tatham*. While most of the articles written in the various law reviews have accepted *Le Roy v. Tatham* without questions, there are notable exceptions which are worth mentioning and confirm the point that it is important to scour the legal literature to gain a full understanding of many issues. See § III-C, *Scholarship from the Academy*.

It would be one thing if the only fault in reliance on *Le Roy v. Tatham* were that we are dealing with *dictum* instead of a holding. Here, the matter is different in kind from what in the overall scheme of things is a relatively minor matter. In the first instance, the Supreme Court in 1859 in a continuation of the same litigation in the 1853 *Le Roy v. Tatham* reached the *opposite* conclusion to *uphold* the very same patent. See § IV, *Le Roy v. Tatham, Overruled a Century Ago*. At least as important, the *dictum* relied upon from the 1853 case is contrary to what the Court said a generation later in the *Goodyear Dental Vulcanite* and *Badische Anilin* cases. *Id.*

Looking at Le Roy v. Tatham in a vacuum, one may wonder precisely why the Court in 1853 neglected to consider the process used to make the patented lead pipes as a “product by process” limitation on the *definition* of the product. The answer is that the case was decided before the clear establishment of principles of claim scope and infringement for “product by process” claims which only evolved a generation after this case. *Id.* The case was a generation before principles relating to product-by-process claiming was established in cases such as *Smith v. Goodyear Dental Vulcanite*.

Much is made of the long time interval between the decision in *Le Roy v. Tatham*, that it was of a vintage of more than “150 years” ago. It would be one thing if this implies 150 years of settled practice over this period. But, the truth is that after the 1859 second decision in *Le Roy v. Tatham* the precedent was essentially abandoned for more than a century up until the time that Justice Douglas brought its *dicta* to life once again in *Funk v. Kalo*. See § IV B, *Stare Decisis... or Judicial Silence?*

To be sure, *Le Roy v. Tatham* does not stand alone amongst nineteenth century cases that should be considered in the context of *stare decisis*. These cases include the 1853 *O'Reilly v. Morse* case to the telephone; the 1853 *Rubber-Tip Pencil* case to the classic eraser-tipped “lead pencil,” and the 1880 *Tilghman v. Proctor*, the *Fat Separation* case. Beyond *stare decisis*, the Court explains that its denials of patent-eligibility find support from the English 1843 *Househill Coal* case to “hot blast” steel manufacturing. See § V, *Nineteenth Century Cases Beyond Le Roy v. Tatham*.

One of the nagging issues as seen from both *Mayo* and *Alice* is the Supreme Court focus on patent “preemption” as a basis to deny patent-eligibility. For claims presented to a combination where one element, standing alone, lacks patent eligibility, it is important to include a *Summary of the Invention* that disclaims coverage of the element lacking patent-eligibility (outside the claimed combination). See § VI, *Prophylactic Approach to Patent “Preemption.”*

II. *LE ROY V. TATHAM*: “150 YEARS” OF *STARE DECISIS*

Before considering *whether* the doctrine of *stare decisis* applies to *Le Roy v. Tatham* – or any other case –, as a predicate to the discussion it is best to first understand what is meant by *stare decisis*: “[U]nder the doctrine of *stare decisis* a case is important only for what it decides.”¹

“*Stare decisis*” are two words that do not stand alone: The two words are shorthand for the phrase “*stare decisis et non quieta movere* [, which in translation means] ‘to stand by and adhere to *decisions* and not disturb what is settled.’”²

Stare decisis is limited to the *holding* in the case.³ The doctrine is *not* applicable to what the opinion *says*, but only to “the decision, for the detailed legal consequence following a detailed set of facts.”⁴

¹*In re Osborne*, 76 F.3d 306, 309 (9th Cir. 1996)(Aldisert, J.).

²*Id.* (“*Stare decisis* is the policy of the court to stand by precedent; the term is but an abbreviation of *stare decisis et non quieta movere* – ‘to stand by and adhere to decisions and not disturb what is settled.’”).

³*Id.* (“Consider the word ‘*decisis*.’ The word means, literally and legally, the decision.”).

⁴*Id.* (“Nor is the doctrine *stare dictis*; it is not ‘to stand by or keep to what was said.’ Nor is the doctrine *stare rationibus decidendi* – ‘to keep to the *rationes decidendi* of past cases.’ Rather, *under the doctrine of stare decisis a case is important only for what it decides* – for the ‘what,’ not for the ‘why,’ and not for the ‘how’. Insofar as precedent is concerned, *stare decisis* is important only for the decision, for the detailed legal consequence following a detailed set of facts.”)(emphasis added).

A. Recent Supreme Court Citations

If one were to take a narrow view of precedent, looking only to the lifetimes of members of the profession who started their careers in the past forty years, the 1853 *Le Roy v. Tatham* decision would appear to be one of the major patent precedents in the history of the Republic.

In the wake of the second (1859) opinion in *Le Roy v. Tatham* up until the *Funk v. Kalo* (1948) – a period of eighty-nine (89) years – there was only a handful of Supreme Court cases to even *cite* the 1853 *Le Roy v. Tatham*. Since *Funk Brothers Seed Co. v. Kalo Inoculant Co.*, 333 U.S. 127 (1948), there have been numerous citations to the 1853 *Le Roy v. Tatham* opinion. See *Gottschalk v. Benson*, 409 U.S. 63, 67(1972); *Parker v. Flook*, 437 U.S. 584 (1978); *Diamond v. Chakrabarty*, 447 U.S. 303 (1980); *Diamond v. Diehr*, 450 U.S. 175 (1981); *Laboratory Corp. of America Holdings v. Metabolite Laboratories, Inc.*, 548 U.S. 124 (2006)(Breyer, J., joined by Stevens and Souter, JJ., dissenting from dismissal of writ of certiorari); *Bilski v. Kappos*, 561 U. S. 593 (2010); *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 132 S.Ct. 1289, 1293 (2012); *Alice Corp. Pty. Ltd. v. CLS Bank Intern.*, 134 S.Ct. 2347, 2354 (2014).

But, in the more than 110 years since the 1859 *Le Roy v. Tatham* opinion, up until the 1972 *Gottschalk v. Benson* decision, there were precious few opinions citing the 1853 *Le Roy v. Tatham* opinion. It became an obscure precedent that was not followed by the Supreme Court virtually throughout this period. There were five exceptions over this long period in the nineteenth century⁵ and two in the twentieth century.⁶

B. Rebirth of *Le Roy v. Tatham* in *Funk v. Kalo*

Nearly a full century after *Le Roy v. Tatham*, the case was resurrected as a leading case by the late Justice William O. Douglas to deny patent-eligibility in *Funk Bros. Seed Co. v. Kalo Inoculant Co.*, 333 U.S. 127, 130 (1948)(Douglas, J.). There, Justice Douglas resurrected the “Lead Pipe” case, *Le Roy v. Tatham*, 55 U.S. (14 How.) 156, 175 (1853)(McLean, J.), *subsequent proceedings*, *Le Roy v. Tatham*, 63 U.S. (22 How.) 132 (1859)(McLean, J.), for the proposition that “patents cannot issue for the discovery of the phenomena of nature.”

⁵*Stimpson v. Woodman*, 77 U.S. 117, 124 n.4 (1869); *Busell Trimmer Co. v. Stevens*, 137 U.S. 423, 433 (1890); *Knapp v. Morss*, 150 U.S. 221, 228 (1893); *Magin v. Karle*, 150 U.S. 387, 392 (1893).

⁶*Minerals Separation v. Butte & Superior Mining Co.*, 250 U.S. 336, 349 (1919); *De Forest Radio Co. v. General Electric Co.*, 283 U.S. 664, 685 (1931).

C. From *Funk* to *Benson*

The same Justice Douglas more than a generation later bootstrapped both *Funk v. Kalo* and *Le Roy v. Tatham* to deny patent-eligibility in *Gottschalk v. Benson*, 409 U.S. 63, 67 (1972)(Douglas, J.). He quotes from *Le Roy v. Tatham*, 55 U.S. (14 How.) 156, 175 (1853): “A principle, in the abstract, is a fundamental truth; an original cause; a motive; these cannot be patented, as no one can claim in either of them an exclusive right.”).

Since *Funk v. Kalo*, the “lead pipe” technology and the original holding have been forgotten, while *Le Roy v. Tatham* has become a leading case to deny patent-eligibility, both at the Supreme Court and at the appellate level.



III. MYTHOLOGY KEYED TO *LE ROY V. TATHAM*

A. Supreme Court Citations

At the Supreme Court, *see Parker v. Flook*, 437 U.S. 584, 589 (1978)(quoting *Gottschalk v. Benson*, 409 U.S. 63, 67 (1972)) (“ ‘A principle, in the abstract, is a fundamental truth; an original cause; a motive; these cannot be patented, as no one can claim in either of them an exclusive right.’ [The “Lead Pipe” case, *Le Roy v. Tatham*, 55 U.S. (14 How.) 156, 175 (1853)(McLean, J.), *subsequent proceedings*, *Le Roy v. Tatham*, 63 U.S. (22 How.) 132 (1859)(McLean, J.)]. Phenomena of nature, though just discovered, mental processes, and abstract intellectual concepts are not patentable, as they are the basic tools of scientific and technological work.”); *Diamond v. Diehr*, 450 U.S. 175, 185(1981)(quoting *Le Roy v. Tatham*, 55 U.S. (14 How.) 156, 175 (1853))“A principle, in the abstract, is a fundamental truth; an original cause; a motive; these cannot be patented, as no one can claim in either of them an exclusive right.”); *Lab. Corp. of Am. Holdings v. Metabolite Labs., Inc.*, 548 U.S. 124, 126 (2006) (Breyer, J., joined by Stevens and Souter, JJ., dissenting from dismissal of writ of certiorari)(citing, *inter alia*, *Le Roy v. Tatham*, 55 U.S. (14 How.) 156, 175 (1853), for the proposition that “[t]his principle [of excluding subject matter from what is patent-eligible] finds its roots in both English and American law.”); *Diamond v. Chakrabarty*, 447 U.S. 303, 309 (1980)(citing, *inter alia*, *Le Roy v. Tatham*, 55 U.S. (14 How.) 156, 175 (1853), for the proposition that “[t]he laws of nature, physical phenomena, and abstract ideas have been held not patentable.”); *Bilski v. Kappos*, 561 U.S. 593 (2010)(“While not required by the statutory text, the[] exceptions [to patent-eligibility] are consistent with the notion that a patentable process must be ‘new and useful.’ And, in any case, the exceptions have defined

the statute's reach as a matter of statutory stare decisis going back 150 years. See *Le Roy v. Tatham*, 55 U.S. (14 How.) 156, 174 (1853).”); *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 132 S. Ct. 1289, 1293 (2012)(citing, *inter alia*, *Le Roy v. Tatham*, 55 U.S. (14 How.) 156, 175 (1853), for the proposition that “[t]he Court has long held that this provision contains an important implicit exception. “[L]aws of nature, natural phenomena, and abstract ideas” are not patentable.”); *Alice Corporation Pty. Ltd. v. CLS Bank International*, 134 S. Ct. 2347, 2354 (2014)(citing, *inter alia*, the “Lead Pipe” case, *Le Roy v. Tatham*, 55 U.S. (14 How.) 156, 174-75 (1853) (McLean, J.), *subsequent proceedings*, *Le Roy v. Tatham*, 63 U.S. (22 How.) 132 (1859)(McLean, J.), for the proposition that “[w]e have interpreted § 101 and its predecessors in light of th[e] exception [that laws of nature, natural phenomena, and abstract ideas are not patentable] for more than 150 years.”)

B. An Uncritical Judicial Acceptance of *Le Roy v. Tatham*

Since *Gottschalk v. Benson*, the appellate courts have proceeded in near 100 % lockstep with the Supreme Court interpretation of *Le Roy v. Tatham*, with one exception.⁷ Cases following the Supreme Court include *In re Walter*, 618 F.2d 758, 765 (Fed. Cir. 1980)(Rich, J.)(citing, *inter alia*, the “Lead Pipe” case, *Le Roy v. Tatham*, 55 U.S. (14 How.) 156, 174 (1853)(McLean, J.), *subsequent proceedings*, *Le Roy v. Tatham*, 63 U.S. (22 How.) 132 (1859)(McLean, J.)), for the proposition that “[t]he common thread running through prior decisions

⁷To be sure, there is at least one opinion that recognizes the different issue actually raised in *Le Roy v. Tatham*. See *In re Bergy*, 596 F.2d 952, 990-91 (CCPA 1979)(Rich, J.).

regarding statutory subject matter is that a principle of nature or a scientific truth (including any mathematical algorithm which expresses such a principle or truth) is not the kind of discovery or invention which the patent laws were designed to protect.”); *In re Bilski*, 545 F.3d 943, 952 (Fed. Cir. 2008)(en banc)(Michel, C.J.)(quoting *Le Roy v. Tatham*, 55 U.S. (14 How.) 156, 175 (1852) (“A principle, in the abstract, is a fundamental truth; an original cause; a motive; these cannot be patented, as no one can claim in either of them an exclusive right.”); *In re Comiskey*, 554 F.3d 967, 977-78 (Fed. Cir. 2009)(Dyk, J.)(“As early as *Le Roy v. Tatham*, [55 U.S. (14 How.) 156, 175 (1853)], the Supreme Court explained that ‘[a] principle, in the abstract, is a fundamental truth; an original cause; a motive; these cannot be patented, as no one can claim in either of them an exclusive right.”); *Classen Immunotherapies, Inc. v. Biogen IDEC*, 659 F.3d 1057, 1063-64 (Fed. Cir. 2011)(Newman, J.)(“In *Le Roy v. Tatham*, 55 U.S. (14 How.) 156, 175 (1852), the Court reiterated that ‘A principle, in the abstract, is a fundamental truth; an original cause; a motive; these cannot be patented, as no one can claim in either of them an exclusive right.’”; *MySpace, Inc. v. GraphOn Corp.*, 672 F.3d 1250, 1264 (Fed. Cir. 2012)(Mayer, J., dissenting)(quoting *Le Roy v. Tatham*, 55 U.S. (14 How.) 156, 175 (1853))(“[A] principle is not patentable. A principle, in the abstract, is a fundamental truth; an original cause; a motive; these cannot be patented, as no one can claim in either of them an exclusive right.”); *McRO, Inc. v. Bandai Namco Games America Inc.*, ___ F.3d ___, ___, 2016 WL 4896481, slip op. at 8 (Fed. Cir. 2016)(Reyna, J.)(quoting *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 132 S. Ct. 1289, 1301 (2012)) (“‘A patent is not good for an effect, or the result of a certain process’ because such patents ‘would prohibit all other persons from making the same thing by any means whatsoever.’” *Le Roy v. Tatham*, 55 U.S. (14 How.) 156, 175 (1853).”)

C. Scholarship from the Academy

To be sure, there are scores of references to *Le Roy v. Tatham*, 55 U.S. (14 How.) 156 (1853), which uncritically accept the premise that this case is viable precedent. Some of these references are in the judicial literature but most come from practitioners and the Academy. The point of this paper is not to cite this majority, but instead to explain a very important: *Le Roy v. Tatham* is not binding precedent to dictate the future direction of the patent law.

If one simply looks at the volume of uncritical literature concerning *Le Roy v. Tatham* one may think that legal scholarship is totally dead.

But, that is not true.

Significant scholarship exists that recognizes the place of *Le Roy v. Tatham* in the overall scheme of the body of case law:

Professor Lefstin explains the significance of *Le Roy v. Tatham* in today's patent-eligibility discussions. He considers the interrelationship of this case with the English *Neilson* case: "[T]he Supreme Court's first significant engagement with the *Neilson* cases came in 1852, with *Le Roy v. Tatham*. *Le Roy* later became the fountainhead of subject-matter exclusion in American patent law, via its oft-quoted (and *largely tautological*) pronouncement on the unpatentability of principles: 'A principle, in the abstract, is a fundamental truth; an original cause; a motive; these cannot be patented, as no one can claim in either of them an exclusive right.'"⁸

⁸Jeffrey A. Lefstin, *Inventive Application: A History*, 67 Fla. L. Rev. 565, 594 (2015)(emphasis added).

Professors Holman⁹ and Durham¹⁰ also provide valuable insights. Other academic literature also has citations to *Le Roy v. Tatham* in a similar vein.¹¹

⁹ Christopher M. Holman, *Patent Eligibility Post-Myriad: A Reinvigorated Judicial Wildcard of Uncertain Effect*, 82 Geo. Wash. L. Rev. 1796, 1817 (2014)(“[I]n *Bilski*, the Court asserted that its ‘precedents provide three specific exceptions to § 101’s broad patent-eligibility principles: ‘laws of nature, physical phenomena, and abstract ideas.’” The Court acknowledged that the exceptions ‘are not required by the statutory text,’ but stated that they ‘have defined the reach of the statute as a matter of statutory stare decisis going back 150 years.’ I recently participated in an interdisciplinary roundtable in which law professors and patent attorneys sat down with scientists, linguists, and philosophers and attempted to make some sense of the current state of the patent eligibility doctrine. I found it interesting that some of the participants seemed to believe that insight into the nature of patent eligibility could be gleaned by rigorously parsing the language used by the Court in defining the ‘three exceptions.’ Implicit in this earnest inquiry was an assumption that the Supreme Court had carefully considered the language it had used to define the three exceptions, and that each of the three exceptions had independent meaning and corresponded to some discrete category of patent-ineligible subject matter. But I think that if one traces the origins of the purported three exceptions to patent eligibility it will become apparent that *any search for deep and profound meaning in the language used by the Court will prove largely futile.*” (footnotes omitted; emphasis added)

¹⁰ Alan L. Durham, *The Paradox of “Abstract Ideas”*, 2011 Utah L. Rev. 797 (2011)(“Concurring in *Bilski*, Justice Stevens complained that the majority ‘never provides a satisfying account of what constitutes an unpatentable abstract idea.’ Indeed, the 150 years of precedent to which *Bilski* alludes provides no such ‘satisfying account.’ The history of the abstract ideas exclusion is one of circular reasoning, vagueness, and obscurity, in part because courts rarely acknowledge the inherently abstract qualities of any patented invention.”)

¹¹ John M. Golden, *Patentable Subject Matter and Institutional Choice*, 89 Tex. L. Rev. 1041, 1085 n.221 (2011)(“See *Bilski v. Kappos*, 130 S. Ct. 3218, 3225 (2010) (citing *Le Roy v. Tatham*, 55 U.S. (14 How.) 156, 174-75 (1853), to support a statement that specified ‘exceptions to §101’s broad patent-eligibility principles ... have defined the reach of the statute ... going back 150 years’.”); Katherine J. Strandburg, *Much Ado about Preemption*, 50 Hous. L. Rev. 563, 570 n.18 (2002)(quoting *Le Roy v. Tatham*, 55 U.S. (14 How.) 156, 175 (1852) (“A principle, in the abstract, is a fundamental truth; an original cause; a motive; these cannot be patented, as no one can claim in either of them an exclusive right.”)); Dina

As to the *holding* in *Le Roy v. Tatham*, Professor Durham explains that “[a]lthough the applicant in *Le Roy* had in fact applied his discovery to the manufacture of superior lead pipes, he made the mistake (fatal in the majority's view) of claiming his invention as the machinery used in the process. The machinery itself was not new.”¹² The passages of the case relied upon by modern writers is simply *dictum*.¹³ Professor Menell explains the Supreme Court reference to *Bilski v. Kappos*.¹⁴

Roumiantsevad, *The Eye of the Storm: Software Patents and the Abstract Idea Doctrine in CLS Bank v. Alice*, 28 Berkeley Tech. L.J. 569, 572 n.14 (2013)(“*Bilski v. Kappos*, 130 S. Ct. 3218, 3225 (2010) (describing the exceptions as “statutory stare decisis going back 150 years” (citing *Le Roy v. Tatham*, 55 U.S. 156, 173 (1852))”); Jesse D.H. Snyder, *Have We Gone Too Far: Does the Seventh Amendment Compel Fact-Finding before Reaching a Decision on Patent-Eligible Subject Matter?*, 14 Chi.-Kent J. Intell. Prop. 436, 444 (2015)(“[T]he Supreme Court has recognized certain “important implicit exception[s]: laws of nature, natural phenomena, and abstract ideas are not patentable.” Federal courts have held fidelity to those exceptions “for more than 150 years.” [*Alice Corp. Pty. v. CLS Bank Int'l*, 134 S. Ct. 2347, 2349 (2014) (citing *Bilski v. Kappos*, 561 U.S. 593, 130 (2010)); *O'Reilly v. Morse*, 56 U.S. 62, 62 (1853); the “Lead Pipe” case, *Le Roy v. Tatham*, 55 U.S. (14 How.) 156, 160 (1853) (McLean, J.), *subsequent proceedings*, *Le Roy v. Tatham*, 63 U.S. (22 How.) 132 (1859)(McLean, J.)]. At their core, those exceptions seek to avoid preemption of “the basic tools of scientific and technological work.”)(footnotes omitted or integrated into text in brackets).

¹²Alan L. Durham, *Two Models of Unpatentable Subject Matter*, 31 Santa Clara High Tech. L.J. 251, 264-65 (2015).

¹³*Id.* (“In *Le Roy v. Tatham*, the Supreme Court considered a patent application based on the discovery that a piece of lead could be firmly bonded to another under the application of pressure and heat, a discovery that the applicant had applied in the manufacture of lead pipes. The fact that lead surfaces will adhere under those conditions can aptly be described as a principle of nature. After noting a lack of precision in the use of the word ‘principle,’ the majority nevertheless observed that ‘a principle is not patentable.’ ‘A principle, in the abstract,’ the court explained, ‘is a fundamental truth; an original cause; a motive; these cannot be patented as no one can claim in either of them an exclusive right.’ [55 U.S. 156, 175 (1853).] On the other hand, where a principle is ‘applied to any special purpose, so as thereby to effectuate a practical result and benefit not previously obtained,’ a patent for that application can be had,

IV. *LE ROY V. TATHAM*, OVERRULED A CENTURY AGO

A. Post-*Le Roy* Nineteenth Century Supreme Court Decisions

even if it is based on ‘the discovery of a great, general, and most comprehensive principle in science or law of nature.’ [*Id.* (quoting *Househill Co. v. Neilson*, Webster's Patent Cases 683 (1843)).] *Although the applicant in Le Roy had in fact applied his discovery to the manufacture of superior lead pipes, he made the mistake (fatal in the majority's view) of claiming his invention as the machinery used in the process. The machinery itself was not new.*

“Dissenting Justice Nelson, who would have looked past the infirmities of the claim, expanded upon the same concept of principle versus application introduced by the majority. The patentee, he pointed out, had turned ‘the discovery of this property of lead, which had never before been known, but on the contrary, had been supposed and believed, by all men of science skilled in metals, to be impossible’ into wrought lead pipe of such superiority that it had ‘wholly superseded [its predecessors] in the market.’ The apparatus used by the patentee ‘was but incidental, and subsidiary to the new and leading idea of the invention’--the ‘leading idea’ being ‘[t]he discovery of a new property in the article of lead.’ That discovery ‘led naturally to the apparatus,’ which itself ‘required very little ingenuity.’ Given ‘the state of the art at the time,’ the machinery could have been constructed by ‘[a]ny skillful mechanic.’ Its importance was only in making practical use of the natural properties of lead. Drawing support from English precedent involving Watt's steam engine patent, Judge Nelson observed that patenting a practical application did not amount to patenting a natural principle.⁸⁰ On the contrary, ‘[f]or every other purpose and end, the principle [remains] free for all mankind to use.’”(emphasis added).

¹⁴Peter S. Menell, *Forty Years of Wondering in the Wilderness and No Closer to the Promised Land: Bilski's Superficial Textualism and the Missed Opportunity to Return Patent Law to its Technology Mooring*, 63 Stan. L. Rev. 1289, 1301 (2011)(footnote omitted)(“Justice Kennedy [in *Bilski v. Kappos*, 130 S. Ct. 3218, 3226 (2010)],... invokes *Le Roy v. Tatham* to ground the exclusion of ‘laws of nature, physical phenomena, and abstract ideas’ from ‘the reach of the statute as a matter of statutory stare decisis going back 150 years.’ But this invocation merely begs the question. It reveals nothing of the basis for delineating these exceptions. The *Le Roy* opinion, like most nineteenth- and twentieth-century patentable subject matter decisions, does not expressly tie its analysis to specific statutory or constitutional text, but rather reasons loosely from various cases and treatise authorities as well as functional and policy considerations. It reflects the interpretive philosophy of an era in which Congress legislated tersely, recognizing that courts would evolve statutes through interpretation based on the underlying purposes.”)

It should be sufficient that the 1853 *Le Roy v. Tatham* denial of patentability is rendered without significant precedential value by the conflicting holding in that same case in 1859. Beyond this one case, however, is the fact that the case law a generation later that requires that process limitations that *define* a claimed product overturn the underlying basis for the 1853 decision. The early principles of product-by-process case law are thus found in *Smith v. Goodyear Dental Vulcanite Co.*, 93 U.S. 486 (1877), and *Cochrane v. Badische Anilin & Soda Fabrik*, 111 U.S. 293 (1884).

Le Roy v. Tatham in modern times stands for the proposition that process features in the definition of a claimed product are to be *ignored* for patentability purposes.¹⁵ *Le Roy v. Tatham* is contrary to established modern product-by-process practice where a process feature that *defines* the claimed product cannot be ignored as to the *definition* of that product.¹⁶

¹⁵ The law today is that a process feature in a product-by-process claim is a limitation to the extent that the *product* is defined by that process. If that same product *as defined by that process* is made by a *different* process, that same product is unpatentable. See *In re Thorpe*, 777 F.2d 695, 697 (Fed. Cir. 1985)(Newman, J.) (“The patentability of a product does not depend on its method of production. *In re Pilkington*, 411 F.2d 1345, 1348 (CCPA 1969). If the product in a product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Marosi*, 710 F.2d 799, 803 (Fed.Cir.1983); *Johnson & Johnson v. W.L. Gore*, 436 F.Supp. 704, 726 (D.Del.1977); see also *In re Fessman*, 489 F.2d 742 (CCPA 1974).”).

¹⁶ *Purdue Pharma L.P. v. Epic Pharma, LLC*, 811 F.3d 1345, 1354 (Fed. Cir. 2016)(Prost, C.J.) (“[I]n determining validity of a product-by-process claim, the focus is on the product and not the process of making it.’ *Greenliant Sys., Inc. v. Xicor LLC*, 692 F.3d 1261, 1268 (Fed.Cir.2012) (quoting *Amgen Inc. v. F. Hoffman–La Roche Ltd.*, 580 F.3d 1340, 1369 (Fed.Cir.2009)). ‘That is because of the ... longstanding rule that an old product is not patentable even if it is made by a new process.’ *Id.*; see also *SmithKline Beecham Corp. v. Apotex Corp.*, 439 F.3d 1312, 1317 (Fed.Cir.2006) (‘It has long been established that one cannot avoid anticipation by an earlier product disclosure by claiming ... the product as produced by a

Smith v. Goodyear Dental Vulcanite and *Badische Anilin* each takes an entirely different approach to product-by-process claiming than the 1853 *Le Roy v. Tatham*. *Goodyear Dental Vulcanite* process details that define the invention were ignored for purposes of validity determination.

The *en banc* Federal Circuit cites *Goodyear Dental Vulcanite* for the proposition that “[t]he process detailed [in the patent] is thereby made as much a part of the invention as are the materials of which the product is composed.”¹⁷ The Federal Circuit also cites *Badische Anilin* for the proposition that the Court “has long emphasized the limiting requirement of process steps in product-by-process claims.”¹⁸

particular process.’); *In re Thorpe*, 777 F.2d 695, 697 (Fed.Cir.1985) (‘If the product in a product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.’).”

¹⁷*Abbott Laboratories v. Sandoz, Inc.*, 566 F.3d 1282, 1291 (Fed. Cir. 2009)(*en banc* in relevant part)(Rader, J.) (“Supreme Court opinions [] have addressed the proper reading of product-by-process claims. See *Smith v. Goodyear Dental Vulcanite Co.*, 93 U.S. 486, 493 (1877) (‘The process detailed is thereby made as much a part of the invention as are the materials of which the product is composed.’).”

¹⁸*Abbott Laboratories v. Sandoz, Inc.*, 566 F.3d 1282, 1292 (Fed. Cir. 2009)(*en banc* in relevant part)(Rader, J.) (“*The Supreme Court has long emphasized the limiting requirement of process steps in product-by-process claims.* In [*Cochrane v. Badische Anilin & Soda Fabrik*, 111 U.S. 293 (1884)], the Court considered a patent relating to artificial alizarine. Specifically, the patent claimed ‘[a]rtificial alizarine, produced from anthracine or its derivatives by either of the methods herein described, or by any other method which will produce a like result.’ 111 U.S. at 296 (quoting U.S. Patent Reissue No. RE 4,321). In turn, the specification generally described a method for making artificial alizarine involving anthracine or its derivatives. Alizarine had been in use for thousands of years as a red textile dye, traditionally extracted from madder root. Pure alizarine has the chemical formula C₁₄H₈O₄, but ‘artificial alizarines’ available in the market at

Le Roy v. Tatham was decided at a time before patent claims were a mandatory feature of a patent: The patent in controversy was filed long before claims became a mandatory feature of a patent through an amendment to the patent law in 1870. There clearly was no formal understanding of product-by-process claiming, although a generation later the Court recognized the importance of process features of a claimed invention as part of the *definition* of the invention – consistent with the practice of today insofar as patentability or validity is concerned: One could consider *Le Roy v. Tatham* as having been overruled not later than 1877 as to its denial to recognize process features as definition of an invention for patentability purposes: In *Smith v. Goodyear Dental Vulcanite Co.*, 93 U.S. (3 Otto) 486 (1877), the patentee claimed artificial teeth including a product-by-process definition of such teeth where that definition of the product was a part of the reason that the claimed invention was sustained:

[A] set of artificial teeth as a new article of manufacture, consisting of a plate of hard rubber, with teeth, or teeth and gums, secured thereto in the manner described in the specification, by embedding the teeth and pins in a vulcanizable compound, so that it shall surround them while it is in a soft state, before it is vulcanized, and so that when it has been vulcanized the teeth are firmly and inseparably secured in the vulcanite, and a tight joint is effected between them, the whole constituting but one piece.”¹⁹

the time of the litigation varied from almost completely pure alizarine, to combinations of alizarine and anthrapurpurine, to pure purpurine containing no alizarine whatsoever. *Id.* at 309–10. The defendant's product contained approximately sixty percent anthrapurpurine.”)(emphasis added).

¹⁹*Smith v. Goodyear Dental Vulcanite*, 93 (3 Otto) U.S. at 494. The wording, here, is *not* that of an actual claim in the patent but, instead, the Court’s synthesis of what was claimed, taking into

The *en banc* Federal Circuit in *Abbott Laboratories v. Sandoz* cites *Smith v. Goodyear Dental Vulcanite* for the proposition that “[t]he process detailed [in the patent] is thereby made as much a part of the invention as are the materials of which the product is composed.”²⁰ In *Abbott Laboratories v. Sandoz* the Federal Circuit cites *Badische Anilin* for the proposition that the Supreme Court “has long emphasized the limiting requirement of process steps in product-by-process claims.”²¹

account the description in the specification. (The original patent filing of a caveat took place on May 14, 1852, long prior to the date when formal patent claims became a statutory requirement.)

²⁰*Abbott Laboratories v. Sandoz, Inc.*, 566 F.3d 1282, 1291 (Fed. Cir. 2009)(*en banc* in relevant part)(Rader, J.) (“Supreme Court opinions [] have addressed the proper reading of product-by-process claims. See *Smith v. Goodyear Dental Vulcanite Co.*, 93 U.S. 486, 493 (1877) (‘The process detailed is thereby made as much a part of the invention as are the materials of which the product is composed.’).”

²¹*Abbott Laboratories v. Sandoz, Inc.*, 566 F.3d 1282, 1292 (Fed. Cir. 2009)(*en banc* in relevant part)(Rader, J.) (“*The Supreme Court has long emphasized the limiting requirement of process steps in product-by-process claims.* In *BASF*, the Court considered a patent relating to artificial alizarine. Specifically, the patent claimed ‘[a]rtificial alizarine, produced from anthracine or its derivatives by either of the methods herein described, or by any other method which will produce a like result.’ 111 U.S. at 296 (quoting U.S. Patent Reissue No. RE 4,321). In turn, the specification generally described a method for making artificial alizarine involving anthracine or its derivatives. Alizarine had been in use for thousands of years as a red textile dye, traditionally extracted from madder root. Pure alizarine has the chemical formula C₁₄H₈O₄, but ‘artificial alizarines’ available in the market at the time of the litigation varied from almost completely pure alizarine, to combinations of alizarine and anthrapurpurine, to pure purpurine containing no alizarine whatsoever. *Id.* at 309–10. The defendant’s product contained approximately sixty percent anthrapurpurine.”)(emphasis added).

B. Stare Decisis...or Judicial Silence?

Like the overwhelming majority of Supreme Court patent cases in the era of an appeal as a matter of right – without *certiorari* – *Le Roy v. Tatham* is like the vast majority of decisions in that era where Supreme Court decisions for the most part were case-specific and rarely if ever cited again in a Court opinion. So it was with *Le Roy v. Tatham*.

Simple subtraction shows that there is an interval of more than 150 years between the 1853 *Le Roy v. Tatham* and the 2010 decision in *Bilski v. Kappos*. But, simple subtraction to determine this time interval does not translate into the earlier decision “defin[ing] the reach of the statute as a matter of statutory *stare decisis* going back 150 years.”²² Looking to the actual case law and not arithmetic, one finds that during this period of more than 150 years, the 1853 *Le Roy v. Tatham* was never quoted, *even once*. If anything, the judicial silence speaks of a long forgotten precedent of *de minimis* precedential value for the issue at hand.

²²*Bilski v. Kappos*, 561 U.S. 593, 602 (2010) (“The exceptions [to patent-eligibility] have defined the reach of the statute as a matter of statutory *stare decisis* going back 150 years. See *Le Roy v. Tatham*, 14 How. 156, 174–75 (1853).” At the appellate level below, in *In re Bilski*, 545 F.3d 943, 952 (Fed. Cir. 2008)(Michel, J.)(en banc), quoting *Le Roy v. Tatham*, 55 U.S. (14 How.) 156, 175 (1852), the court said: “A principle, in the abstract, is a fundamental truth; an original cause; a motive; these cannot be patented, as no one can claim in either of them an exclusive right.”

From the 1859 second opinion in *Le Roy v. Tatham* up until the 1948 *Funk v. Kalo* decision, there is not one single holding that quotes the passage from *Le Roy v. Tatham* made famous in *Funk v. Kalo*. From the time of the 1859 second opinion in *Le Roy v. Tatham* there are only three Supreme Court opinions which even *cite* to the 1853 opinion all the way up until 1895 when decisions were based on appeals to the Supreme Court as a matter of *right* (versus the *certiorari* process today).²³ In none of the three is there a holding on patent-eligibility based upon the now famous passage that made the 1853 case famous.²⁴ The paucity of Supreme Court cases even *citing* the *Le Roy v. Tatham* opinion in the thirty-five years following the second (1859) opinion is striking, given that there were approximately 475 patent appeals decided in the period 1860-1895.²⁵ In the period

²³*Busell Trimmer Co. v. Stevens*, 137 U.S. 423 (1890); *Knapp v. Morss*, 150 U.S. 221 (1893); *Magin v. Karle*, 150 U.S. 387 (1893).

²⁴*Busell Trimmer*, 137 U.S. at 433-34 (“We do not think that the cases cited by counsel for the appellants sustain his position that Orcutt's alleged invention is a combination of previous devices, rearranged with connections and adaptations so adjusted as to produce a novel and valuable use. In *Le Roy v. Tatham*, 55 U.S. (14 How.) 156, 157 (1853) *** the claim was for a combination of old parts of machinery to make lead pipes, in a particular manner, under heat and pressure. The combination was held not to be patentable, the court saying: ‘The patentees claimed the combination of the machinery as their invention in part, and no such claim can be sustained without establishing its novelty, not as to the parts of which it is composed, but as to the combination.’”); *Knapp v. Morss*, 150 U.S. at 227-28 (citing *Le Roy v. Tatham*, 55 U.S. (14 How.) 156 (1853)) (“[I]t is well settled by the authorities that the end of purpose sought to be accomplished by the device is not the subject of a patent. The invention covered thereby must consist of new and useful means of obtaining that end. In other words, the subject of a patent is the device or mechanical means by which the desired result is to be secured.”); *Magin v. Karle*, 150 U.S. at 392 (citing *Le Roy v. Tatham*, 55 U.S. (14 How.) 156 (1853)) (“The purpose to be accomplished was not patentable, and the particular means devised to secure that purpose did not involve invention.”).

from 1895 until the beginning of 1948 (the year of *Funk v. Kalo*) there were no Supreme Court opinions citing *Le Roy v. Tatham* on all fours.²⁶

²⁵Decisions in this thirty-five year period were based on the fact that the appeals decided in this period were without a *certiorari* filter, which eliminates the possibility that the Court was simply uninterested in granting review of certain areas of the law. The number of decided patent appeals is approximate, based on a Westlaw search of the Supreme Court database [patent and invention and da(bef 1/1/1896) and da(aft 1/1/1860)].

The year 1895 is chosen as the end point, here, as it is both significantly after the decision date, and also corresponds to the end of the period where decisions were made where appeals in patent cases could be taken as a matter of right to the Supreme Court on a patent (or other) case. (Although the Evarts Act requiring grant of *certiorari* had an effective date for appeals filed as of 1891, there was a roughly four year backlog of cases filed before the effective date. See John F. Duffy, *The Festo Decision and the Return of the Supreme Court to the Bar of Patents*, 2002 Sup. Ct. Rev. 273, 290 n.56 (2002) (“As was true for the rest of the [Supreme] Court’s docket, patent appeals were being filed faster than the Court could decide them. By the end of the 1880s the Court had a several-years-long backlog of patent appeals. In fact, after the Evarts Act of 1891 eliminated the Court’s mandatory appellate jurisdiction in patent cases, the number of patent cases decided by the Court did not drop significantly until four years later because the Court had to clear out the large backlog of cases filed prior to the effective date of the Act. (By law, the new statute eliminating mandatory Supreme Court appellate jurisdiction did not affect any appeal that had been perfected prior to July 1, 1891. See Act of March 3, 1891, 26 Stat 1115, 1116.)”).

²⁶ There were two Supreme Court cases that *cited* to *Le Roy v. Tatham* in this period. See *Minerals Separation v. Butte & Superior Mining Co.*, 250 U.S. 336, 349 (1919) (citing *Le Roy v. Tatham*, 55 U.S. (14 How.) 156 (1853)) (“The patentees discovered the [] process for producing the result or effect, the metal-bearing froth, but they did not invent that result or froth—their patent is on the process, it is not and cannot be on the result—and the scope of their right is limited to the means they have devised and described as constituting the process.”); *De Forest Radio Co. v. General Electric Co.*, 283 U.S. 664, 684-85 (1931) (citing *Le*

V. NINETEENTH CENTURY CASES BEYOND *LE ROY V. TATHAM*

Le Roy v. Tatham is not the only nineteenth century case that has been cited by the Supreme Court in the wake of *Funk v. Kalo* as basis for exceptions to the scope of patent-eligibility.

These cases include the English *Househill Coal* case to “hot blast” steel manufacturing;²⁷ the *O'Reilly v. Morse* case to the telephone;²⁸ the *Rubber-Tip*

Roy v. Tatham, 55 U.S. (14 How.) 156, 174-76 (1853)) (“[I]t is method and device which may be patented and not the scientific explanation of their operation.”).

²⁷*Househill Coal & Iron Co. v. Neilson*, Webster's Patent Case 673, 683 (House of Lords 1843)), cited in *Le Roy v. Tatham*, 55 U.S. 156, 175 (1852). See Jeffrey A. Lefstin, *Inventive Application: a History*, 67 Fla. L. Rev. 565, 594-96 (2015) (analyzing traditional notions of patent eligibility of newly discovered laws of nature); cf. *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1381 (Fed. Cir. 2015) (Linn, J., concurring) (“Sequenom's invention is nothing like the invention at issue in *Mayo* [*Collaborative Services v. Prometheus Laboratories, Inc.*, 132 S. Ct. 1289 (2012)]. Sequenom ‘effectuate[d] a practical result and benefit not previously attained,’ so its patent would traditionally have been valid. *Le Roy v. Tatham*, 63 U.S. 132, 135-36 (1859) (quoting *Househill Coal & Iron Co. v. Neilson*, Webster's Patent Case 673, 683 (House of Lords 1843)); *Le Roy v. Tatham*, 55 U.S. 156, 175 (1852) (same); see generally Jeffrey A. Lefstin, *Inventive Application: a History*, 67 Fla. L. Rev. [565, 594-96 (2015)] (analyzing traditional notions of patent eligibility of newly discovered laws of nature). But for the sweeping language in the Supreme Court's *Mayo* opinion, I see no reason, in policy or statute, why this breakthrough invention should be deemed patent ineligible.”).

²⁸The invention in *O'Reilly v. Morse*, 56 U.S. (15 How.) 62 (1853), was clearly patent-eligible, as seen from the successful enforcement of most of the claims. One that was held invalid was simply too broad. See *Gottschalk v. Benson*, 409 U.S. 63, 68 (1972) (“In *O'Reilly v. Morse*, [], Morse was allowed a patent for a process of using electromagnetism to produce distinguishable signs for telegraphy. [56 U.S. (15 How.) at 111]. But the Court denied the eighth claim in which Morse claimed the use of ‘electromagnetism, however developed for marking or printing intelligible characters, signs, or letters, at any distances.’ *Id.* at 112. The Court in disallowing that claim said, ‘If this claim can be maintained, it matters not by what process or machinery the result is accomplished. For aught that we now know, some future inventor, in the onward march of science, may discover a mode of writing or printing at a distance by means of the electric or galvanic current, without using any part of the process or combination set forth in the plaintiff's specification. His invention may be less complicated—less liable to get out of order—less

Pencil case to the classic eraser-tipped “lead pencil,”²⁹ and *Tilghman v. Proctor*, the *Fat Separation* case.³⁰

VI. PROPHYLACTIC APPROACH TO PATENT “PREEMPTION”

As explained first in *Mayo* and then refined in *Alice*, for a claim to a combination of elements one of which is, standing alone, patent ineligible subject matter, the overall combination must have “an ‘inventive concept’ – i.e., ...[a] combination of elements that is ‘sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself.’ *** [T]he approach *** considers all claim elements *** in combination [which] is consistent with the general rule that patent claims ‘must be considered as a whole.’”³¹

expensive in construction, and in its operation. But yet, if it is covered by this patent, the inventor could not use it, nor the public have the benefit of it, without the permission of this patentee.’ *Id.*, at 113.”)

²⁹*Rubber-Tip Pencil Co. v. Howard*, 87 U.S. (20 Wall.) 498, 507 (1874)(patentability of the “lead pencil” with an eraser tip, cited in *Diamond v Diehr*, 450 U.S. 175, 164-65 (1981), for “the longstanding rule that ‘an idea of itself is not patentable.’”); *see also Parker v. Flook*, 437 U.S. 584, 598-99 (1978)(Stewart, J., joined by Burger, C.J., Rehnquist, J., dissenting)(citing *Rubber-Tip Pencil*, 87 U.S. (20 Wall.) at 507), for the proposition that “[i]t is a commonplace that laws of nature, physical phenomena, and abstract ideas are not patentable subject matter [under 35 U.S.C.A. § 101]. A patent could not issue, in other words, on the law of gravity, or the multiplication tables, or the phenomena of magnetism, or the fact that water at sea level boils at 100 degrees centigrade and freezes at zero –even though newly discovered.”).

³⁰*Tilghman v. Proctor*, 102 U.S. (12 Otto) 707, 708 (1880)(The patent in question relates to the treatment of fats and oils, and is for a process of separating their component parts so as to render them better adapted to the uses of the arts.”).

³¹*Alice Corp. Pty. Ltd. v. CLS Bank Intern.*, 134 S.Ct. 2347, 2355 (2014). The overall passage from which this quotation has been taken is reproduced here with footnote 3 integrated into text in brackets:

In light of the emphasis given in *Mayo* and *Alice* to patent-eligibility of claimed subject matter being dependent of a freedom from patent “preemption,”³² it is useful to include at the end of the *Summary of the Invention* which first identifies the invention as a combination of a patent-ineligible feature and a patent-eligible feature that the claimed invention is limited to the combination and does not cover the patent-ineligible feature, standing alone.³³

“We have described step two of this analysis [from *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 132 S.Ct. 1289 (2012),] as a search for an ‘inventive concept’ – i.e., an element or combination of elements that is ‘sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself.’ *Id.*, 132 S.Ct., at 1294. [Because the approach we made explicit in *Mayo* considers all claim elements, both individually and in combination, it is consistent with the general rule that patent claims ‘must be considered as a whole.’ *Diamond v. Diehr*, 450 U.S. 175, 188 (1981); see *Parker v. Flook*, 437 U.S. 584, 594 (1978) (‘Our approach ... is ... not at all inconsistent with the view that a patent claim must be considered as a whole’).]”

³² *Mayo* explains that:

“Our conclusion [on patent-eligibility] rests upon an examination of the particular claims before us in light of the Court’s precedents. Those cases warn us against interpreting patent statutes in ways that make patent eligibility ‘depend simply on the draftsman’s art’ without reference to the ‘principles underlying the prohibition against patents for [natural laws].’ [*Parker v. Flook*, 437 U.S. 584, 593 (1978).] They warn us against upholding patents that claim processes that too broadly preempt the use of a natural law. [*O’Reilly v. Morse*, 15 How. 62, 112–120 (1854); *Gottschalk v. Benson*, 409 U.S. 63, 71-72 (1972).] And they insist that a process that focuses upon the use of a natural law also contain other elements or a combination of elements, sometimes referred to as an ‘inventive concept,’ sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the natural law itself. *Flook, supra*, at 594; see also [*Bilski v. Kappos*, 130 S.Ct. 3218, 3218 (2010)](‘[T]he prohibition against patenting abstract ideas ‘cannot be circumvented by attempting to limit the use of the formula to a particular technological environment’ or adding ‘insignificant postsolution activity’”(quoting [*Diamond v. Diehr*, 450 U.S. 175, 191-92 (1981)]).”

Mayo Collaborative Services v. Prometheus Laboratories, Inc., 132 S.Ct. 1289, 1294 (2012).

³³ For example:

“SUMMARY OF THE INVENTION

“The invention is directed to the combination of [PATENT INELIGIBLE ELEMENT A] and [ELEMENT B].

“Applicants claims are limited to the combination of these elements so the claims do not cover or in any way preempt making, using or selling [PATENT INELIGIBLE ELEMENT A], standing alone or with any combination of other features *except* the claimed combination of [PATENT INELIGIBLE ELEMENT A] and [ELEMENT B].”

VII. PROPOSED POLICY CHANGE

It is proposed that Office policy be modified in the following manner:

First, where an Examiner sees an issue of patent-eligibility that appears to be raised by the claims of an application, the Office should include in the publically available file wrapper a notification that the Office is considering making a rejection of at least some of the claims under 35 USC § 101, and permit an amendment, argument or both as to why a Section 101 rejection should not be made, particularly as to why there is no “preemption” of subject matter not eligible for patent protection.

Second, as part of the decision making practice as to whether there is or is not a Section 101 rejection possible, the Examiner should conduct a complete search of the prior art to determine whether there is basis in fact for a determination that the invention lacks an “inventive concept”

Third, in the Examiner’s notification of the possibility of a Section 101 rejection, the Examiner should spell out precisely why the invention lacks an “inventive concept”.

Fourth, the public would be free to file a Preissuance Submission explaining why there is an inventive concept in the claimed invention, nullifying an argument that the claims “preempt” use of the claimed invention.

Under the existing statutory and regulatory scheme, a third party is free to submit prior art within twenty-four months of the effective filing date (i.e., six months from the automatic 18 month publication of the application) under 35 USC § 122(e) that may be used in the first instance to cite prior art to show that an invention is obvious, i.e., it lacks an “inventive concept”.

The citation should generally be a minimum number of references and there is the obligation to provide a concise statement as to why the references render the invention obvious; with the citation of a minimum number of references, there is no fee for this submission. The submission is governed by 35 USC § 122(e)³⁴ and 37 CFR § 1.290(a).³⁵

³⁴ “35 USC § 122(e) PREISSUANCE SUBMISSIONS BY THIRD PARTIES.—

“(1) IN GENERAL.—Any third party may submit for consideration and inclusion in the record of a patent application, any patent, published patent application, or other printed publication of potential relevance to the examination of the application, if such submission is made in writing before the earlier of—

“(A) the date a notice of allowance under [35 USC §] 151 is given or mailed in the application for patent; or

“(B) the later of—

“(i) 6 months after the date on which the application for patent is first published under [35 USC §] 122 by the Office, or

“(ii) the date of the first rejection under [35 USC §] 132 of any claim by the examiner during the examination of the application for patent.

“(2) OTHER REQUIREMENTS.—Any submission under paragraph (1) shall—

“(A) set forth a concise description of the asserted relevance of each submitted document;

“(B) be accompanied by such fee as the Director may prescribe; and

“(C) include a statement by the person making such submission affirming that the submission was made in compliance with this section.”

³⁵ Under 37 CFR § 1.290(a), “[a] third party may submit, for consideration and entry in the record of a patent application, any patents, published patent applications, or other printed publications of potential relevance to the examination of the application if the submission is made in accordance with 35 U.S.C. 122(e) and this section.”

VIII. CONCLUSION

Stripping away the mask of *faux stare decisis* would open the door to a fresh consideration as to the current exceptions to patent-eligibility that dominate the Section 101 case law since *Bilski*.