THE RIGHT TO EXPERIMENT "ON" A PATENTED INVENTION: EXORCISING THE GHOSTS OF CASE LAW PAST[*]

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"[T]he reason for the exclusion [from patent protection under 35 USC § 101 of laws of nature, natural phenomena, and abstract ideas] is that sometimes ***too much*** patent protection can impede rather than 'promote the Progress of Science and useful Arts,' the constitutional objective of patent and copyright protection."

Hon. Stephen Breyer[***]

Professor Karshtedt, in an important work, demonstrates that the former copyright law scholar, the Hon. Mr. Justice Stephen Breyer, conflates patent and copyright doctrines to conclude that patent protection can *impede* innovation. *See* Dmitry Karshtedt, *Photocopies, Patents, and Knowledge Transfer: "The Uneasy Case" of Justice Breyer's Patentable Subject Matter Jurisprudence,* 69 Vand. L. Rev. 1739 (2016).

As explained by Professor Karshtedt, the patent and copyright laws have fundamental differences that have not been fully appreciated either by the esteemed Justice (or some former members of the Federal Circuit).

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[***] *Laboratory Corp. of America Holdings v. Metabolite Laboratories, Inc.,* 548 U.S. 124, 126-27 (2006)(Breyer, J., joined by Stevens, Souter, JJ., dissenting from dismissal for improvident grant of certiorari)(quoting U.S. Const., Art. I, § 8, cl. 8)(original emphasis).

The *Faux* Premise that Patents Impede Research

If one takes as a premise that there is *no* right to "experiment on" a patented invention, then the patent jurisprudence of the Hon. Stephen Breyer makes sense, that there can then, indeed, be "too much" patent protection.

But, the patent and copyright laws cannot always be equated, as seen from patent case law dating from more than two hundred years ago penned by the late great Justice Joseph Story, who confirms the right to "experiment on" a patented invention.[1]

[1] *Whittemore v. Cutter*, 29 F. Cas. 1120 (C.C.D.Mass.1813) (No. 17,600)(Story, J.). *See also Sawin v. Guild*, 21 F.Cas. 554 (C.C.D. Mass. 1818) (No. 12,391) (Story, J.)("This court has already had occasion to consider the clause in question, and upon mature deliberation, it has held that the making of a patented machine to be an offence within the purview of it, must be the making with an intent to use for profit, and not for the mere purpose of philosophical experiment, or to ascertain the verity and exactness of the specification. *Whittemore v. Cutter*[, 29 F. Cas. 1120 (C.C.D.Mass.1813) (No. 17,600)(Story, J.)]. In other words, that the making must be with an intent to infringe the patent-right, and deprive the owner of the lawful rewards of his discovery."); *Byam v. Bullard*, 4 F.Cas. 934 (C.C.D. Mass. 1852) (No. 2,262) (Curtis, J.)("Mr. Justice Story, in *Whittemore v. Cutter* [Case No. 17,600], [ ] held that making a machine for a philosophical experiment, or to test the sufficiency of the specification, would not be an infringement; and in *Sawin v. Guild* [Id. 12,391], where he says the act must be with intent to deprive the patentees of some lawful profit; and also by Mr. Justice Patteson, in *Jones v. Pearce*, Webst. Pat. Cas. 125, where he excepts the making of a patented article for mere amusement, and not for profit. In these cases, inasmuch as there was supposed to be no damage, there was thought to be no action. * * * [N]o sale was [an infringement] except one which would be within the terms of the grant contained in the letters-patent, which is a grant of an exclusive right to make, use, and vend to others to be used."); *Oxley v. Holden*, 141 E.R. 1327, 1340 (Common Bench 1860)("In *Jones v. Pearce*, 1 Webster's P.C. 121, the defendant had made a pair of wheels upon the principle of the plaintiff's patent: and in answer to a question from the jury, Patteson, J., said: "If he did actually make these wheels, his making them would be a sufficient infringement of the patent, *unless he merely made them for his own amusement, or as a model*.") (emphasis added; footnote deleted).

Federal Circuit Exorcism of Aberrant Panel Precedent

The Federal Circuit has maintained an *en banc* silence for too long.

The Federal Circuit needs to clarify the erroneous misunderstandings of opinions such as *Embrex v. Service Eng'g Corp*., 216 F.3d 1343 (Fed.Cir.2000) (Rader, J., concurring), and *Madey v. Duke Univ.*, 307 F.3d 1351 (Fed.Cir.2002) (Gajarsa, J.).

The Federal Circuit should confirm that there <u>is</u> a right to "experiment on" a patented invention, contrary to the views of one of its most vocal former members who has steadfastly denied such a right in the *Embrex* case, following his trial court opinion as a freshly minted jurist in *Deuterium Corp. v. United States*, 19 Cl.Ct. 624 (1990)(Rader, J.), virtually on the eve of his ascendancy to the Federal Circuit.

Additionally, the Federal Circuit has yet to definitively distinguish between the noninfringing right of the public to "experiment on" a patented invention (e.g., study how a patented microscope works), as opposed to an infringing "experiment with" a patented invention (e.g., use of a patented microscope to study a cell structure). *See* Janice M. Mueller, *No 'Dilettante Affair': Rethinking the Experimental Use Exception to Patent Infringement for Biomedical Research Tools*, 76 Wash. L.Rev. 1 (2001).

The author of *Embrex* is not the only former member of the Court to fail to understand the right to experiment on a patented invention as seen in this context from *Madey v. Duke.*

Exorcising the Ghosts of Opinions Past

While the authors of *Embrex* and *Madey* have resigned their commissions to the Federal Judiciary, the ghosts of their past opinions have yet to be exorcised through an *en banc* clarification.

The price paid by this shortcoming is implicit support for the continued denial of patent-eligibility at the Supreme Court . The Supreme Court continues to entertain the mistaken view that "too much" patent protection thwarts research: If a court such as the Federal Circuit that has a specialized knowledge of patent law is unable to articulate a clear rule on the right to experiment on a patented invention, it is asking too much of jurists on other courts to do so.