The Limits of Abstract Patents in an Intangible Economy

What makes patents abstract?
How can abstraction be fixed?
Who needs to do what to do so?
Abstract Patents = Bad Patents

• Patent system as a property rights system.
  – “Metes and bounds” must be readily, predictably determinable.
  – Validity must be objectively, transparently determinable.

• U.S. patent system suffers from a complex, unpredictable law on construction of patent claims and subjective validity standards often determined based upon information that is not publicly accessible.
Abstract Patents = Bad Patents

• Abstract patents are patents whose import and ultimate reach is not readily determinable from an examination of the claims of the patent, nor through a careful study of the supporting description of the invention.

• Abstract patents present issues for the patent system in all fields of technology.

• In a unitary patent system, a unitary response to the issues presented is an imperative.
What Makes Patents Abstract?

• Requirements limiting what can be validly patented must be rigorously applied.
• Misfiring on even one patentability requirement produces overly broad patents.
• Patent system becomes distorted when one requirement must be overworked to limit patents when another is being underworked.
• Chronic problems exist in getting the patent system to fire on all patentability cylinders.
How Can Abstraction Be Fixed?

• Simple, bright lines tests on issues such as subject matter eligibility for patenting.
• Use of the “written description” requirement to limit patenting to subject matter where the patent demonstrates a completed conception of the claimed invention.
• Invigoration of the requirement for reasonable definiteness of claims.
• Forbearance in overworking non-obviousness.
Who Needs To Do What?

• Stop seeking patents that cannot pass muster under any rigorous application of patentability requirements.
• Use invalidity defenses taken to judgment in response to charges of patent infringement.
• Join in amicus efforts to attack patents that should never have issued.
• Support 9-month PGR window after issuance for USPTO to review and cancel bad patents.
Case Study: Patent Eligibility

• Basic principles for assessing patentability:
  – In deciding whether a claim is patentable, afford the claim its broadest reasonable construction.
  – For the full scope of the claim, it must rigorously comply with the requirement for patent-eligibility.
  – For a process claim, each step of the process must be limited to one or more “acts”—and cannot be broad enough to encompass a “mental step.”

• Bright, simple rule would end abstraction.
Case Study: Written Description

• Basic principles for assessing patentability:
  – Written description must demonstrate the invention being claimed—expressed to its full scope—was actually invented, not simply posited.
  – Requires demonstration of a completed conception in the patent specification: the completed mental picture of the claimed invention.

• Eliminates patents on the desideratum rather than precisely what has been described.
Conclusions

• The 2004 recommendations of the National Academies could profoundly assist in addressing the issue of abstract patents.
  – Objective, transparent, harmonized patentability standards.
  – Expanded opportunities for public participation in USPTO decisions to issue/maintain patents.

• Users of the patent system must resolve to align strategies for seeking patents for themselves with strategies for challenging patents of others.