



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?

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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.