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Kristen Osenga

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WHAT DO AMERICA'S FIRST PATENTS HAVE TO DO WITH TODAY'S?

*Kristen Osenga**

I was excited to read Michael Risch's latest Article, *America's First Patents*, in large part because he and I generally agree, especially when it pertains to the topic of patent-eligible subject matter.¹ In this Article, Professor Risch examines patent-eligible subject matter through a unique lens—history based on early patents. After studying a number of early patents, in particular those from the “registration era” in patent law,² he develops three key insights. First, he describes a disconnect between what inventors of the time believed to be patent-eligible and how the law surrounding patent-eligible subject matter developed in that era.³ Second, based on the patent applications filed by these early inventors, he argues that previously advanced notions of what constitutes “technology” are inaccurate.⁴ Third, he demonstrates that reliance on the “machine-or-transformation” test to determine whether processes are patent-eligible would knock out many historical patents and therefore, at the very least, has no basis in history.⁵

I found Professor Risch's Article to be an interesting read and a refreshing take on one of the most well-worn debates in patent law—patent-eligible subject matter; it certainly adds to the ever-growing body of scholarship in patent law. But with respect to his three insights, I think this Article proves too much and too little. On a related point, however, I think Professor Risch continues to hit the nail squarely on the head.

I. PROVING TOO MUCH: THE INVENTOR'S BELIEF

Professor Risch's first two insights are based on the premise that inventors seek patents on patent-eligible subject matter. He refers to his study as looking at “inventions that Americans thought were patentable in our early history, without editing by the Patent Office, courts, or legislature” compared to the law of the time and our current view of how the founders used the word “technology.”⁶ In essence, he posits

* Professor of Law, University of Richmond School of Law.

1. See e.g., Michael Risch, *America's First Patents*, 64 FLA. L. REV. 1279, 1302 n. 34 (noting one of our main areas of agreement in this area).

2. Between 1793 and 1836, patent applications were not reviewed by the Patent Office as they are today; rather, nearly anyone who applied for a patent received one. See Risch, *supra* note 1, at 1282.

3. See *id.* at 1283.

4. See *id.* at 1284.

5. See *id.* at 1284–85.

6. See *id.* at 1282. He also notes that “the primary relevance of these non-examined patents is . . . that they show what *types* of inventions inventors thought *could or should be*

that inventors filed patent applications on inventions they believed were patent-eligible, thereby illuminating what inventions were historically patent-eligible.⁷ But even if that argument were not circular, there are numerous reasons why an inventor may seek a patent on an invention that provides no insight into patent-eligibility. For example, considering first the less-than-honest inventor, he may seek a patent covering something that he knows is not patent-eligible because it is virtually certain that the patent will issue anyway during the registration era; in fact, the devious inventor may even use the lack of clarity in patent specifications at that time to further obfuscate the matter.⁸ Putting aside the deceitful applicant, an innocent inventor may seek a patent on something that is not patent-eligible simply because he did not know better. After all, Professor Risch cites Justice Story as remarking that “No one, however, in the least acquainted with law, would for a moment contend” that this subject matter is eligible for a patent.⁹ Certainly in the 1800s, when information dissemination was difficult and inventors could not pick up a copy of a “do-it-yourself patent application guide,”¹⁰ many inventors were not acquainted with the law. Concluding that these early patent applications demonstrate what was patent-eligible is far too broad a conclusion to draw from the data.

While I agree with the implications that Professor Risch draws from his data—namely that the law developed by the early courts may have been based on an inaccurate understanding of “principles” and that many scholarly historic definitions of “technology” are off-base—I think that the reliance Professor Risch places on the inventors’ beliefs is too great.

II. PROVING TOO LITTLE: THE EXPANDING MACHINE OR TRANSFORMATION TEST

Professor Risch also argues that the notion of a historically grounded “machine-or-transformation” test is inapt, in part because many early patent applications he studied would fail the test as now stated.¹¹ He starts with a slippery slope argument that the “machine-or-transformation” test could be applied to all processes, even ones that

patentable.” *Id.*

7. *See id.* at 1303 (discussing the misguided development of patent-eligibility by noting that “neither American inventors nor even the Patent Office believed patents were so limited”).

8. Whether intentional or not, early patents were not terribly clear as to what was invented and claimed. *See id.* at 1287–89.

9. *See Risch, supra* note 1, at 1306 (quoting *Barrett v. Hall*, 2 F.Cas. 914, 923 (C.C.D. Mass. 1818) (No. 1,047)) (emphasis added).

10. *See, e.g.,* David Pressman, PATENT IT YOURSELF (NOLO Pubs. 15th ed.) (2011); “Patents” available at LegalZoom (<http://www.legalzoom.com/trademarks-patents-copyrights/patent-overview.html>) (accessed July 4, 2012).

11. *See Risch, supra* note 1, at 1284.

clearly fit within the modern (and historic) view of patent-eligible subject matter.¹² He then discusses the uncertainty of what constitutes a satisfactory “machine” or “transformation” to render the method patent-eligible as well as the inconsistency with how the test is being applied.¹³ With these criticisms of the “machine-or-transformation” test in hand, Professor Risch turns to the historic patents that were identified as methods, noting that many of them did not include a satisfactory “machine” or “transformation,” even though the invention in question was something that would be found patent-eligible without question today.¹⁴

Here I think Professor Risch takes his slippery slope argument too far and without basis. The Patent Office and the Federal Circuit are not applying the “machine-or-transformation” test to all method claims – only those that walk along the edge of patent-eligible subject matter. For example, claim 1 of U.S. Patent No. 8,237,010, issued August 7, 2012, recites:

A method of manufacturing a therapeutic device for promoting the healing of a wound in a mammal comprising the steps of:

- Providing a molten substrate material;
- Providing a mold defining a plurality of depressions and a plurality of contact elements;
- Applying the molten substrate material to the mold;
- Cooling the molten substrate material to form the therapeutic device in the mold; and
- Removing the therapeutic device from the mold [wherein the therapeutic device has a number of characteristics].¹⁵

Just as in the examples cited by Professor Risch, this method is performed by no particular “machine” and there is no “transformation” of the ingredients—basically the molten substrate is applied to a mold and cooled. However, the U.S. Patent Office did not question the patent eligibility of this invention, nor would anyone else realistically.¹⁶ Professor Risch

12. *See id.* at 1328.

13. *See id.* at 1328–29.

14. *See id.* at 1332 (pointing out an exemplary important patent, one that describes a method of coating pipes with tin).

15. U.S. Patent No. 8,237,010 (August 7, 2012).

16. The transactions between the US Patent Office and the inventors is available in the Public Pair section of the US PTO website, *available at* http://www.uspto.gov/patents/process/search/public_pair/guidance/index.jsp. I looked at the transaction history for this patent and, not surprisingly, the Patent Office did not question its patent-eligibility.

is correct that “the allure of easy decision-making beckons,”¹⁷ but to believe that the “machine-or-transformation” test will suddenly be used to judge all method claims is a bit of an overstatement.

The “machine-or-transformation” test was never meant to be applied to all method claims; rather it is simply a tool, however imperfect, to determine what is a non-patent-eligible abstract idea.¹⁸ Many inventions, especially the low-technology ones that Professor Risch is concerned about (whether coating tin or crafting a therapeutic device), would not be remotely seen as abstract and thus the test would be irrelevant.

III. HITTING THE NAIL ON THE HEAD

At the end of the day, the point that comes most clearly out of Professor Risch’s paper is that even from the beginning of the patent system in this country, courts and others have confused the law of patent-eligible subject matter with other patent law doctrines, such as novelty or non-obviousness.¹⁹ Professor Risch cites early cases that deny patent protection because “for in them there is nothing new,”²⁰ or allow patent protection for “an application of a principle, whether previously in existence or not, to some new and useful purpose.”²¹ The early patents he identifies as problematic business methods feel like they *do* something, but what they do is so obvious or trivial that patent protection should not be accorded.²² Just like the business methods that cause the most uproar today, the problem is not really based on the fact that someone wants to patent a method of doing something; it’s that the underlying invention feels so well-known, trivial or even ridiculous to us. But the appropriate area to address these concerns is not in the realm of patent-eligibility, but in the areas of patentability under 35 U.S.C. §§ 102 and 103, because, as Professor Risch has noted before—*Everything is Patentable*.²³

17. See Risch, *supra* note 1, at 1334.

18. See *Bilski v. Kappos*, 130 S.Ct. 3218, 3230 (2010) (distinguishing between a patent-eligible process and an abstract idea (“The [*Benson*] Court then held the application at issue was not a ‘process,’ but an unpatentable abstract idea.”)).

19. See Risch, *supra* note 1, at 1296 (patent-eligibility vs. what was patented), 1333–34 (patent-eligibility vs. novelty and non-obviousness).

20. See *id.* at 1297 (quoting *Boulton v. Bull*, 2 H. Bl. 463, 486 (1795)).

21. See *id.* at 1307 (quoting *Whitney v. Carter*, 29 F. Cas. 1070, 1072–73 (1810) (No. 17,583)).

22. See *id.* at 1321–22 (describing patents on a new way to teach writing, a method of managing bees, and a manner of holding a skein of yarn, among others).

23. See Michael Risch, *Everything is Patentable*, 75 TENN. L. REV. 591 (2008).