ABSTRACT

Has There Been Patent Law Progress in the Progress of Patent Law?

Joshua D. Sarnoff
Professor of Law, DePaul University

The United States has had patent legislation since 1790. In broad terms, the patent laws have remained remarkably consistent over more than two centuries. But numerous creative doctrinal developments have occurred within American patent law. In particular, these change: (1) have adopted new approaches to determining the type of subject matter that qualifies for patent rights (eligible "inventions"); (2) have required applicants to specify the nature of their eligible inventions through the language of patent "claims" – which must be interpreted in part by reference to the invention described in the "patent specification" – while adopting extra-claim protection under the "doctrine of equivalents"; and (3) have altered the process, evidentiary base, and standard for determining whether the requisite amount of creativity exists to justify granting patent rights, by determining if a claimed invention reflects a "nonobvious" advance over the "prior art" imputed to the public's knowledge.

These historical changes largely make "progress" by reducing some of the uncertainty and subjectivity of judgment that was inherent in the early patent law. Any legal doctrine that better clarifies its scope and application will increase certainty, by reducing the amount of discretion for subsequent legal interpretation and for application of law to fact. American patent law, of course, grew out of the highly uncertain and subjective English royal prerogative to make discretionary grants of exclusive rights. Some of the historical changes in these three broad areas of patent doctrine have made (non-uniform) progress in clarifying the law. For example, patent eligible subject matter doctrine has gone through numerous changes over time in efforts to make its distinctions clearer. However, as it continues to develop, subject matter doctrine may have become less clear and harder to apply. Further, increased clarity may come at the cost of decreased "fairness" and diminished "flexibility." Other changes, such as the doctrine of equivalents, have consciously sought to promote the progress of these competing values, at the costs of diminished certainty and increased subjectivity of judgment. We lack appropriate metrics to readily judge how much progress (or regress) has occurred in regard to certainty or fairness.

Another set of changes have sought more directly to remove subjectivity of judgment from patent law. For example, claiming doctrines have required inventors to objectify in language (for a hypothetical, objective audience) and with increasing precision the nature and scope of their inventions. This minimizes reliance on more subjective judgments of the nature and scope of inventions otherwise made by non-technically trained judges. Similarly, patent law now largely eschews resort to subjective ex-post recollections of inventors regarding their inventions. Instead, patent law requires a ore objective correspondence between the application's "written description" disclosing the inventor's subjective mental "possession" and the invention as claimed. Further, instead of relying on subjective judgments of the requisite amount of creativity required for a patent, patent law now formalizes the process of analysis and expands the evidentiary base to decide if an invention is obvious. But these changes fail to remove all subjectivity of judgment (and consequent uncertainty), particularly when they fail to clarify the underlying nature of the "objective" determination to be made. Rather, they largely shift the locus of subjective judgments to ex-post adjudications, preserving ex-ante uncertainty and ex-post flexibility.

Accordingly, we need to start thinking more carefully about the kind of "progress" we want to make in patent law, how to measure and value it, and how to best achieve it.