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Paper Information

Title:	Toward a Theory of Inventorship in Patent Law
Abstract:	The persistence and expansion of categories of unpatentable subject matter—abstract ideas, laws of nature, and physical phenomena—is both controversial as a matter of statutory construction and normatively mysterious. In this article, we offer a qualified defense of the Supreme Court's approach to patentable subject matter in its quartet of recent cases from Bilski through Alice. We argue that the Court has drawn a conceptually clear line between what is patentable and unpatentable, and articulated a reasonable methodology that, if properly implemented, enables courts to adjudicate that line in individual cases. But the line it has drawn—between invention and discovery—is in need of stronger normative justification. The cases are missing a theory of inventorship in patent law. In each of its recent cases, the Court has found patent claims invalid because they were indistinguishable from ideas or things that were not the products of human invention—the metabolic relationship that gave rise to a diagnostic test in Mayo, the concepts of hedging and escrows in Bilski and Alice, and the naturally occurring human gene in Myriad. Separating unpatentable discoveries from patentable inventions of course raises the classic problem of determining the appropriate level of abstraction. This problem is not unique to patent law, and neither is the Court's solution. In copyright, for example, merger doctrine denies an exclusive right in otherwise copyrightable expression when that expression is the only way in which an idea can be articulated. So too here, the Court appears to be asking when, in light of the current state of technology, the application of an unpatentable discovery functionally merges with the discovery itself. We argue that this methodology can yield predictable results and a middle ground between "everything" and "nothing" being patentable. Missing, however, from this implicit ontology of invention and discovery is a theory for distinguishing one from the other. The conventional focus on cost, in which exclusions from patentable subject matter are drawn when the beneficial effect of an incentive to invent is far outweighed by the downstream cost of reduced access for follow-on inventors, is unsatisfying. For one thing, it is deeply indeterminate, with little empirical data to support the judgments that courts appear to be making. For another, it is both under-and over-inclusive of patentability. Consider, for example, that some fundamental discoveries—like the Higgs boson or many natural medicines—are hugely expensive, while some inventions—like new software approaches—are cheap. Similarly, the cost rationale also fails to distinguish the subject matter of patent from that of other IP fields; compare again cheap software, for example, costly blockbuster movies. Turning once more to copyright as a source of analogy, we argue that just as the idea/expression dichotomy can be justified by a theory of authorship, the invention/discovery dichotomy needs a theory of inventorship. We close with preliminary thoughts about the content of such a theory, drawing in particular on the history and language of the IP clause and the Patent Act.