

# Patent Law & Policy

## Session #5

8/27/08

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## Patentable Subject Matter

- 1793 Patent Act (1 Stat. 318)
  - “any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvement on” the aforesaid
- 1952 Patent Act, 35 U.S.C. § 101
  - “any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof”

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## Are living things patentable?

- 35 U.S.C. § 101
  - “any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof”
- What if ...
  - “any new and useful process, machine, ... provided that it is inanimate”
  - “any new and useful process, machine, ... whether inanimate or animate”

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## New Plant Varieties – 1930

- Plant Patent Act, 35 U.S.C. §§ 161-164
  - Does NOT cover “a plant found in an uncultivated state”
  - Covers “any distinct and new variety of plant”
  - Limited to plants that are “asexually reproduce[d]” – without seeds
  - Written disclosure – “as complete as is reasonably possible” [ less demanding ]

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## New Plant Varieties – 1970

- Plant Variety Prot'n Act, 7 U.S.C. § 2321
  - Administered by Agriculture Dept.
  - Leads to “Certificate of Protection,” not “patent”
  - Protects sexually reproduced varieties
  - Relaxed written disclosure requirements
  - Safe harbors against infringement liability for farmers (seed saving/planting), researchers

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## Diamond v. Chakrabarty (S. Ct. 1980)

- Regular *Pseudomonas* does not “eat” oil
- Some plasmids degrade oil components
- What did Chakrabarty invent?
  - Bacterium with four oil-degrading plasmids

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## Chakrabarty cont'd

- Chakrabarty's different patent claims ...
  - Process of making bacteria
  - Inoculum comprising bacteria and carrier
  - Bacteria themselves [ Why get this claim ? ]
- Patent Office – “no patents for living things”
- CCPA – “it's being alive is irrelevant”

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## Chakrabarty cont'd

- Statutory interpretation
  - What sources do we look to?
  - What do those sources indicate?
- What is outside the limits?
  - “laws of nature, physical phenomena, and abstract ideas have been held not patentable”
- Bacterium “is not nature's handiwork, but his own; accordingly, it is patentable”

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## Chakrabarty cont'd

- Patent Office arguments ...
- 'If § 101 already covered living things, why pass PPA or PVPA?'
  - Majority's reaction ? Dissent's ?
- 'Congress needs expressly to permit this expansion of patentable subject matter.'
  - Majority's reaction ? Dissent's ?

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## O'Reilly v. Morse (S. Ct. 1854)

### Claim 8

“... the use of the motive power of the electric ... current ... for marking or printing intelligible characters ... at any distances ...”

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## Morse cont'd

- Future inventions by others?
- Future inventions by Morse himself?
- “he claims an exclusive right to use a manner and process which he has not described and indeed had not invented, and therefore could not describe when he obtained his patent”

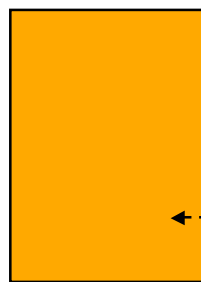
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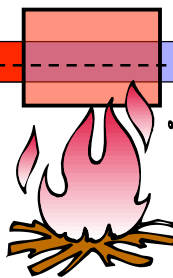
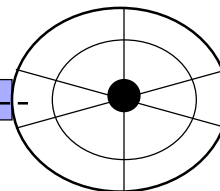
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## Neilson Furnace

**FURNACE**



**BLOWER**



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## Morse cont'd

### ■ Dissent

- Blocking claims are not a problem
- Are we calling all process claims into doubt?
- “To look at an art [ a process ] as nothing but a combination of machinery, and give it protection only as such, against the use of the same or similar devices . . . , is to refuse it protection as an art.” - all process claims are a bit abstract