Gavel to Gavel: Unpatentable Ideas

By: David Woodral Guest Columnist July 20, 2022

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What kinds of inventions qualify for patent protection? U.S. statutes, plainly enough, allow patent rights for "any new and useful process, machine, manufacture, or composition of matter." Apart from the issue of what exactly is new and useful, patent-eligible subject matter appears, at first glance, clearly defined. On the other hand, judicial law denies patents for abstract ideas, laws of nature, and natural phenomena. You can patent a new mousetrap or technique for trapping mice, but you can't patent the number six, special relativity, or sunsets. Easy, right?

Wrong. Identifying unpatentable ideas, laws, and phenomena has never been satisfactorily clear. For example, in 1852, the Supreme Court invalidated a patent for press-forming pipes. While the subject matter *seemed* like a manufacture or process, the court regarded it as the tendency of solid lead to reunite under pressure that is, a mere property of lead or a law of nature. *Le Roy* was a contentious 5-3 decision.

Today is no better. Since 2014, courts have used the *Alice/Mayo* test for subject matter eligibility. *Alice/Mayo* asks, first, whether the patent is directed to an abstract idea, natural law, or natural phenomenon. If so, then it looks for an "inventive concept" to "transform the nature of the claim" by adding "significantly more than the patent ineligible concept." Easy? Hardly. The U.S. Patent Office's own guidance describes it as "difficult."

The Federal Circuit, which specializes in patent appeals, often disagrees at both steps of the *Alice/Mayo* test. In *Am. Axle & Mfg. v. Neapco*, a two-judge majority invalidated a patent claiming a technique for damping vibrations in an axle by installing a liner. The majority read the claims as directed a law of nature – perhaps Hooke's law – without the required "significantly more." However, at step one, the dissenting Judge Moore did not see a natural law but, rather, a method of axle tuning. She also thought the claims involved sufficient inventiveness. Overwhelmingly, onlookers seem to think Judge Moore had the better argument.

Am. Axle seemed perfect for the Supreme Court to revise and clarify *Alice/Mayo*. Patent-savvy judges characterize the test as "almost impossible to apply consistently and coherently" and a "confusing abyss." Former USPTO Director Iancu asked the court to "finally resolve this issue that has plagued our system for the past decade." Solicitor General Thomas Krause requested it heal divisions in the USPTO and Federal Circuit.

Alas! "The petition for writ of certiorari is denied."

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