The Limited Monopoly™

"Anything Under the Sun That Is Made by Man" …Well, Not Quite.

by John Hammond, PE and Robert Gunderman, PE

The Quote and the Law.

A well known phrase (to patent practitioners at least) is that patentable subject matter may include "anything under the sun that is made by man." The phrase originated during testimony[1] on the landmark legislation, "The Patent Act of 1952," the provisions of which remain mostly in effect to this day, as enacted in '52.

Federal statute 35 U.S.C. 101 establishes the patentability of inventions, stating that, "Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title." Thus for any of these four classes of "statutory subject matter," as long as the novelty, unobviousness, and written description requirements defined by law[2,3,4] are met, one may obtain a patent.

"Yes officer, but I was just testing YOUR radar. It's working fairly well, but if you could tune that FFT algorithm a bit, you could probably increase its range to two miles…"

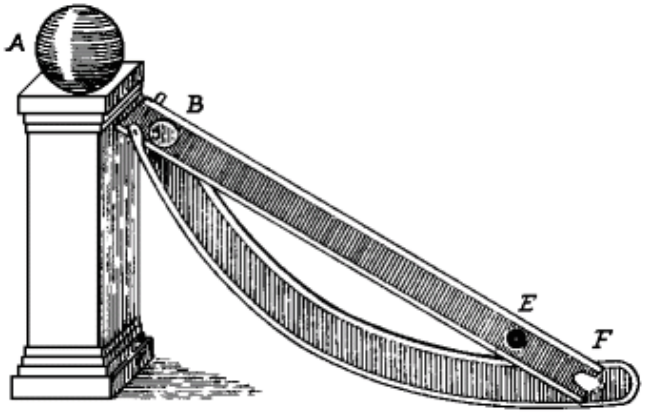
Not Everything Falls "Under the Sun."

Yet not every invention is patentable, even if it falls within the four classes of "statutory subject matter," and the novelty, unobviousness, and written description requirements can be met. This is because there are inventions for which it is not in the public interest for the general public to either a.) know about them; b.) be enabled to make and use them; c.) be exposed to them; and/or d.) be misled by them.

One category of inventions that cannot be patented is nuclear weapons. Nuke patents are specifically banned[5] under Title 42 of the United States Code, which deals generally with public health, social welfare, and civil rights. (So one option for that enriched unobtanium you've been hoarding *deep* in your basement is off the table.)

In a somewhat related category, if you file a patent application on an invention that has significant homeland security and/or defense applications – say you invent an imaging technology that can see buried weaponry through 100 feet of dirt and 10 feet of concrete from outer space – the odds of getting a patent on it aren't good. Your application will get flagged in a Department of Defense security review and may then become secret, never to be published or otherwise referenced as a public record. It will cease to exist to the public, and the U.S. government will handle compensation related matters with the inventor, the terms of which will also be secret.

Another category includes inventions that are useful only for illegal purposes. A couple of examples are burglary and auto theft tools, and securities and currency counterfeiting devices. You might ask, what about police radar detectors? They have been patented, as being devices useful to "test" police radar, or remind drivers not to speed. (Try this one in Virginia: "Yes officer, but I was just testing YOUR radar. It's working fairly well, but if you could tune that FFT algorithm a bit, you could probably increase its range to two miles…"



The USPTO may also refuse to grant a patent on offensive subject matter, for example, something deemed offensive to any race, religion, sex, ethnic group, or nationality. How offensive? From what we understand, it has to be pretty bad. Not an area we're familiar with, though.

Breaking the First, Second, and/or Third Laws

There's also the category of "non-operable" inventions. Perpetual motion machines and other energy related devices are common examples. Every time we have an energy crisis, the Patent Office gets a spike in these filings. Given that we're well along in the current one, it looks like the pattern is holding. A search using the terms "cold fusion" and "energy" turns up 25 patent applications that have been published within the past year. Maybe the solution to our energy problems is in one of those applications. No doubt though, more than a few of them are probably headed for a "101" rejection as "non-statutory subject matter."

The AMA Has Their Say

Lastly, while not making surgical procedures non-statutory subject matter, Public Law 104-208 was signed by the President in 1996. This law limits the remedies available with respect to a medical practitioner's performing a patented medical activity. The American Medical Association (AMA) adopted a resolution that vigorously condemned the patenting of medical and surgical procedures, and this opposition became law several years ago[6]. More on this topic in next month's column.

1. Testimony of P. J. Federico in hearings on H.R. 3760 before Subcommittee No. 3 of the House Committee on the Judiciary, 82d Cong., 1st Sess., 37 (1951).
2. 35 U.S.C. 102.
3. 35 U.S.C. 103.
4. 35 U.S.C. 112.
5. 42 U.S.C. Ch. 23, Subch. XII, §2181.
6. 35 U.S.C. 287 (c)
7. Image: "Magnetic Perpetual Motion Device," Bishop John Wilkins (1614 – 1672).

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