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## Patent Law

John G. Costa

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## PATENT LAW

*John G. Costa*

The United States Constitution grants Congress authority to "promote the Progress of Science and useful Arts."<sup>121</sup> Pursuant to this authority, Congress enacted the Patent Act,<sup>122</sup> which grants to inventors, for a limited time,<sup>123</sup> the exclusive right to use and sell their creations. The United States patent system developed by Congress and the courts promotes the development of "technologically valuable intellectual goods."<sup>124</sup> When Congress promulgated the Patent Act in 1954, however, it did not contemplate the modern technologies which comprise the information superhighway.<sup>125</sup> These technologies stress the limits of patent law in its current form.

The scope of United States patent law is determined by statute.<sup>126</sup> Accordingly, whether a specific invention is patentable or whether an issued patent is infringed depends on a court's interpretation of the appropriate statutory provision.

The primary issue in patent law is whether a certain invention is entitled to protection. Only inventions that fall into the categories enumerated in § 101 of Title 35 of the United States Code—any "new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof"—are patentable.<sup>127</sup> The Patent Act does not protect the inventor or discoverer of "an abstract idea, principle or force, law of nature, or natural phenomenon."<sup>128</sup>

A discovery or invention must be novel in order to be entitled to patent protection. Even subject matter included in one of the § 101 categories is not patentable if, before the invention thereof, the subject matter was (1) patented, invented, known, or used in the United States or (2) patented or described in a printed publication in the United States or a foreign country.<sup>129</sup> Additionally, an invention or discovery is not patentable if, more than one year prior to the date of the application for a patent in the United States, the subject matter was (1) patented or described in a printed publication in the United

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121. U.S. Const. art. I, § 8, cl. 8.

122. Pub. L. No. 593, 66 Stat. 792 (1952) (codified as amended at 35 U.S.C. §§ 1-376 (1988 & Supp. V 1993)).

123. The term of a patent granted in the United States is 17 years. 35 U.S.C. § 154 (1988).

124. Dan L. Burk, *Patents in Cyberspace: Territoriality and Infringement on Global Computer Networks*, 68 Tul. L. Rev. 1, 26 (1993).

125. See G. Andrew Barger, Comment, *Lost in Cyberspace: Inventors, Computer Piracy and "Printed Publications" Under Section 102(b) of the Patent Act*, 71 U. Det. Mercy L. Rev. 353, 353-54 (1994).

126. The laws governing patents in the United States are found at 35 U.S.C. §§ 1-376 (1988 & Supp. V 1993).

127. 35 U.S.C. § 101 (1988).

128. *In re Alappat*, 33 F.3d 1526, 1552 (Fed. Cir. 1994).

129. 35 U.S.C. § 102(a),(e),(g) (1988).

States or a foreign country or (2) used by the public or sold in the United States.<sup>130</sup>

Subject matter must also be "nonobvious" in order to obtain protection under the Patent Act. An invention or discovery fails to satisfy this requirement if the subject matter is "obvious . . . to a person having ordinary skill in the art to which said subject matter pertains" at the time of invention.<sup>131</sup>

The Patent Act provides patent holders with remedies for infringement of their patents.<sup>132</sup> It is actionable infringement to make, use, or sell any patented invention within the United States during the term of the patent without the permission of the patent holder.<sup>133</sup> One may also be held liable for patent infringement if they "actively induce[ ] infringement of a patent."<sup>134</sup> Additionally, the sale of certain items can constitute infringement under the Patent Act. For example, one who sells material components of a patented invention within the United States, with knowledge of the components' intended infringing use, is liable for contributory infringement unless the item is "a staple article . . . of commerce suitable for substantial noninfringing use."<sup>135</sup> Finally, it is infringement to import into the United States, or to sell or use within the United States, a product produced through a process protected by the United States patent law.<sup>136</sup>

Application for patent protection is also governed by statute. A patent application must contain a "specification" that describes the invention, and the manner and process of making and using it, in such a way as to enable a person skilled in the art to which the invention pertains to make and use the invention.<sup>137</sup> Additionally, the specification must "conclude with one or more claims [that] particularly point[ ] out and distinctly claim[ ] the subject matter [for] which the applicant" seeks patent protection.<sup>138</sup>

A claim contained in an application may be either a product claim, which covers a final product without reference to how the product is produced, or a process claim, which covers the use of a particular method used to produce a product.<sup>139</sup> For example, if a process claim covers the use of steps A, then B, then C to produce D, it is not the

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130. 35 U.S.C. § 102(b) (1988). The subject matter denied patent protection under § 102 is referred to as "prior art." See 35 U.S.C. § 103 (1988).

131. 35 U.S.C. § 103 (1988).

132. Remedies for patent infringement include injunctions, damages, and attorney fees. See 35 U.S.C. §§ 283-285 (1988).

133. 35 U.S.C. § 271(a) (1988).

134. 35 U.S.C. § 271(b) (1988).

135. 35 U.S.C. § 271(c) (1988). It is also infringement to supply materials outside of the United States for use in a manner that would constitute patent infringement if performed in the United States. 35 U.S.C. § 271(f) (1988).

136. 35 U.S.C. § 271(g) (1988).

137. 35 U.S.C. § 112 (1988).

138. *Id.*

139. 2 Donald S. Chisum, *Patents* § 8.05 (1995).

production of D, nor the linking of A, B, and C that infringes the patent, but only the specific utilization of A, then B, then C to produce D. In contrast, a product patent covering a system of individual components, but not the components themselves, would not be infringed by the manufacture of any one of the components, but only by the integration of those components into the patented system.

It is important to note that a patent is country specific; thus, a patent granted in the United States protects only against infringement occurring in the United States.<sup>140</sup> Moreover, because patent law differs significantly among nations, it is possible that an application for patent protection may be granted in certain countries and refused in others.<sup>141</sup> Because of these inconsistencies, it is possible that someone who is legally prohibited from manufacturing or selling an item in one country may legally manufacture or sell that item in a different country. Furthermore, as the contents of a patent are public knowledge, one could utilize a patented invention of a competitor to compete in a foreign market where no patent had been granted.

The emergence of technologies which comprise the information superhighway raises several issues pertaining to patent law. One such issue is whether computer software and computers that run software constitute patentable subject matter. These items involve "mathematical algorithms," which, as abstract ideas, are not entitled to patent protection.<sup>142</sup> An invention that is an *application* of a mathematical algorithm, however, is patentable subject matter.<sup>143</sup>

In *In re Alappat*, the court held that "a computer operating pursuant to [computer] software [could be] patentable subject matter" even though the computer is programmed to apply a mathematical algorithm.<sup>144</sup> At first glance, *Alappat* appears to have opened the door for patenting computer software. The court in *In re Trovato*, however, closed this door slightly when it denied patent protection to computer software because the patent claims did nothing more than recite a mathematical algorithm.<sup>145</sup> The *Trovato* court distinguished this decision from its holding in *Alappat*, noting that the specification in *Alap-*

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140. See Burk, *supra* note 124, at 42. When there is even a limited connection between the alleged infringement and United States territory, however, courts generally take the opportunity to enforce United States patent laws. *Id.*

141. For example, the United States follows a "first-to-invent" system, which awards the patent to the first person to conceive and put into practice a new invention. See Barger, *supra* note 125, at 368. Most other nations, however, follow a "first-to-file" system, which grants patent protection to the first person to file a valid application with the patent office, regardless of whether that person was the first to conceive the invention. *Id.* at 368-69.

142. *In re Abele*, 684 F.2d 902, 907 (C.C.P.A. 1982).

143. *Id.*

144. *In re Alappat*, 33 F.3d 1526, 1545 (Fed. Cir. 1994).

145. *In re Trovato*, 42 F.3d 1376, 1380 (Fed. Cir. 1994).

*pat* included an extensive discussion of certain hardware, while the specification in *Trovato* made only a brief mention of hardware.<sup>146</sup>

The increasing number and use of computer bulletin board systems ("bbs's") also bring to the forefront a number of patent law issues. One such issue is whether a description of an invention transmitted on a bbs constitutes a "printed publication" sufficient to preclude patent protection under the Patent Act.<sup>147</sup> The resolution of this issue by a court may depend on the accessibility of the online description.<sup>148</sup> For example, a description posted on a private bbs accessible to only a select group of users is less likely to be considered a "printed publication" than a description posted on a nationwide public bbs.<sup>149</sup>

Widespread use of bbs's may also create other patent law questions and problems. For example, a participant in an online discussion may attempt to claim sole or joint ownership of an invention later patented by another participant, based on communications that occurred during the discussion. Additionally, the vast amount of easily accessible information available on bbs's may lead to increased claims of "obviousness" by patent infringers.

The information superhighway may also affect the content of patent applications. Under the Patent Act, the description of an invention in a patent application must be sufficiently clear to enable one skilled in the art to practice the invention.<sup>150</sup> One who is skilled in the art is expected to be able to practice those aspects of the art that are common knowledge or that have been revealed in the publications pertaining to the art.<sup>151</sup> A patent applicant could argue that information available online is common knowledge not required in the specification. In addition, it is generally agreed that a specification in a patent application can incorporate publications by reference rather than reciting a description of a product or process.<sup>152</sup> The existence of bbs's

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146. See *id.* at 1383.

147. See generally Barger, *supra* note 125. For a discussion of the effect of a printed publication on an invention's patentability, see *supra* notes 129-30 and accompanying text.

148. See Barger, *supra* note 125, at 365.

149. See *id.* For the existence of an obscure computer file can serve as a defense to patent infringement, a sophisticated computer user could place trade secret information in a set of widely dispersed files. A very real dilemma for inventors is when to keep an invention a trade secret and when to seek a patent. With a trade secret an inventor runs the risk that another inventor will patent the idea and force the first inventor to cease production. With a patent, however, an inventor reveals his creation to the world, thus enabling others to use the invention when the patent expires, use the invention in a country without patent protection, or design around the patented invention. The best of both worlds is to have a trade secret that no one else can patent. The Internet may actually enable inventors to do just that, by allowing information to be published and accessible, but so widely dispersed in cyberspace that it would take decades to compile.

150. 35 U.S.C. § 112 (1988).

151. 2 Chisum, *supra* note 139, § 7.03[2], at 7-22 & n.3.1.

152. 3 *id.* § 11.02[1][f], at 11-33.

raises the issue of whether courts, in considering material incorporated by reference, will afford references to computer files the same weight as printed publications.

Another important issue concerning the effect of new technologies on the current patent law is the possibility of online infringement. As mentioned previously, a patent can be infringed only in the country where it was issued.<sup>153</sup> The global nature of the information superhighway, which allows computer users in one nation to access computers in other nations, has widespread implications for patent holders.

For example, a computer operator in the United States could access a computer network, such as the Internet, and load a software program covered by a United States process patent onto a computer located in a foreign country that has not granted a patent for the process. The computer operator could then run the patented program on the foreign computer and obtain results that are then transmitted for use back to the United States. The results, as an unpatented product produced from a patented process, could be utilized in the United States without being subject to claims of infringement.

Similarly, assume the grant of a United States patent for a computerized manufacturing process to produce a widget and for a widget produced by that manufacturing process. The patent would be infringed if a widget was produced with the patented process in the United States or if a widget produced by the patented process was used or sold in the United States. Technology exists such that one computer, running a given computer software or hardwired program, can control the running of one or more machines, anywhere in the world, to produce a number of products. Thus, a computer running in the United States could cause a machine in a foreign country to produce the hypothetical widget. The patented process was not completed in the United States and therefore it is unclear whether the patent was infringed or if the widget can legally be used or sold in the United States.

This brief consideration of the information superhighway's impact on patent law discusses several issues of contention. Undoubtedly, these issues comprise only a portion of the issues that may come before the courts for resolution. Indeed, the greatest impact of the information superhighway may be to force the countries of the world to negotiate a uniform patent treaty and, eventually, issue internationally recognized and enforceable patents.

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153. See *supra* note 140 and accompanying text.