# INTRODUCTION TO INTELLECTUAL PROPERTY LAW

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PHILOSOPHICAL FOUNDATIONS

1. Three foundational philosophies
   a. Natural Rights Theory
      i. From John Locke
      ii. We all have fundamental rights, including that of “property”
      iii. Theory of Appropriation
          1. Nature was created for all to share; it is common
          2. We each own our body
          3. Subject to caveats and provisos; not an absolute claim
   iv. Three Provisos
      1. Sufficiency Proviso
         a. You can take from nature as long as you leave some for others
      2. Spoliation Proviso
         a. No waste
      3. Charity Proviso
         a. People who disserve charity have a title plan to resources
   v. Absolute Claim to Title
      1. No one has the right to use/modify what is appropriated by the original owner
   b. Personhood Theory
      i. From Hegel
      ii. Characteristics
         1. Individual Will
         2. Autonomy (freedom to choose and act)
      iii. To become fully self-realized, an individual must be able to “protect” his or her will onto objects in the external world
         1. This requires a stable set of claims over those objects—i.e., property rights
   iv. Why Appropriation?
      1. Permanency
         a. Ability to return to an object, work on it, refine it over time
      2. Control
   v. Labor vs. Will
      1. Labor may be the result of conscious choice
      2. But will is the part of us that “does the choosing”; it is more an integral part of who we are than labor—which is more a quality or product
         a. For example, keeping the “integrity” of your work in its original form
c. Utilitarian Theory
   i. From Jeremy Bentham
   ii. Moves away from individual rights to “does this rule promote the greatest
good for the greatest number?”
   iii. Rights follow only from the calculation of collective welfare
   iv. Asks what is more efficient?
       1. *i.e.*, What leads to more collective wealth, injunction or damages?

**PATENTS**

1. In General.
   a. Theories Underlying Justification
      i. Bargain/Contract Theory
         1. People will be encouraged to produce new inventions if there is some
            reward as an incentive
      ii. Natural Rights Theory
          1. The product of mental labor is by right the property of the person
             who created it
   b. Types of Patents
      i. Utility Patents
         1. Issued for the invention of a new and useful process, machine,
            manufacture, or composition of matter, or a new and useful
            improvement thereof, it generally permits its owner to exclude others
            from making, using, or selling the invention for a period of up to
            twenty years from the date of patent application filing
      ii. Design Patents
          1. Issued for a new, original, and ornamental design for an article of
             manufacture, it permits its owner to exclude others from making,
             using, or selling the design for a period of fourteen years from the
             date of patent grant.
      iii. Plant Patents
          1. Issued for a new and distinct, invented or discovered asexually
             reproduced plant including cultivated sports, mutants, hybrids, and
             newly found seedlings, other than a tuber propagated plant or a plant
             found in an uncultivated state, it permits its owner to exclude others
             from making, using, or selling the plant for a period of up to twenty
             years from the date of patent application filing
   c. Patent Application & Examination
      i. Patent application must contain:
         1. a “specification”
            a. written description of the invention and claims § 112
         2. drawings
            a. if necessary to understand the invention (and frequently used
               even when not necessary) § 112
         3. oath by the applicant and a fee § 113
4. and sometimes a model or, for compositions of matter, specimens of ingredients for inspection or experiment § 114

ii. If examiner rejects, the applicant may appeal to the Board of Patent Appeals and Interferences … and then to the federal district court in the District of Columbia or directly to the U.S. Court of Appeals for the Federal Circuit (the Federal Circuit)

iii. If examiner issues, applicant gains the right to exclude others from making, using, selling, offering to sell, or importing the invention for 20 years from the date of filing the application (not from the issue date)

2. Patentable Subject Matter
      i. “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 therefore, subject to the conditions and requirements of this title.”
      ii. Invention = Creating or Discovering
   b. Five Categories of Patentable Subject Matter
      i. Process Inventions (easier to obtain/less powerful)
         1. Process
      ii. Products Inventions (harder to obtain/more powerful)
         1. Machine
         2. Manufacture
         3. Composition
      iii. Patent can also include any (5) improvements on processes and products
   c. Exceptions (Nonpatentable)
      i. Laws of Nature
         1. i.e., Theory of relativity
      ii. Natural/Physical Phenomena
         1. **Chakrabarty**
            a. Particular organism was not a “product of nature” because it did not occur naturally in that form
            b. Rather genetic material had been added to a naturally occurring micro-organism
            c. After, biotech inventions are within the scope of patent law
            d. Life-forms may be patentable
      2. A new mineral discovered in the earth or a new plant found in the wild is not patentable subject matter
      3. Substances that occur in nature (genes, hormones, and other chemicals) nonetheless maybe patentable subject matter if they are purified, isolated, or concentrated (or otherwise changed to a different form) … Such processing of the substance renders it a new product for practical purposes
   4. **Parke-Davis & Co. v. H.K. Mulford Co.**
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a. Judge Learned Hand: A natural substance so isolated and purified can be patentable

iii. Some Abstract Ideas (Herein of Mathematics, Computer Software & Business Methods)

1. Abstract ideas may not be patented
2. Pure mathematics may not be patented

d. Other Abstract Ideas (Possibly Patentable)

i. State Street (1998) – “Useful, Concrete & Tangible Test”

1. An invention with numbers as input and numbers as output may be patentable as long as it has practical utility (“useful, concrete, and tangible result”)
2. Examples
   a. step-by-step guide to sobriety, affiliated awards programs, auction methods online, method for creating an investment vehicle
3. Courts are likely to look less at whether an invention falls into some judicially created exception into patentable subject matter
4. Rather, case emphasized that the other requirements of patent law (utility, novelty, nonobviousness, etc.) should serve the watchdog function


1. Business Method; Claim for Process Patent
2. Test: processes can be patented only if they are (1) implemented by a machine or (2) transformed something into a new or different thing
   a. Bilski’s method was not patentable because “transformations or manipulations of…business risks, or other such abstractions cannot meet the test because they are not physical objects or substances….”
   b. Problems: lack of tangibility; lack of physicality; abstractness

iii. Abele (1998)

1. Involved X-ray data that clearly represented physical and tangible objects such as the structure of bones, organs, and other body tissues—found patentable
2. Certain types of data transformations might still be patentable, especially if the transformation involves data that represents physical things

e. Five Categories of Patentable Subject Matter (In-Depth)

i. Processes

1. Type 1: Processes
   a. In General.
      i. § 100(b); Definition of “Process”
      ii. Process, art, or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material
   b. Method for making something
i. *i.e.*, method for making high-strength polymer fabric

c. Method for using something
   i. *i.e.*, method for controlling weeds near rice plants by applying a specific chemical compound

d. Method for doing something
   i. *i.e.*, administering a mutual fund or creating an anti-gravity illusion

e. A typical process is the chemical one, which produces a compound through a series of steps that may be embodied in a particular machine in which case both the process and the machine may be patentable, although that is not always true.

f. May not produce a product or may not produce a product that is patentable
   i. *i.e.*, inventor devises a new process which creates a standard model chair
      1. The chair would not be patentable because it lacks novelty but the process might be
   ii. *i.e.*, process could produce a chemical but cannot determine the nature of the new chemical
      1. Chemical would not be patentable because it cannot be fully described

g. Conversely, may use an nonpatentable process to product a patentable product

ii. Products
    1. In General.
       a. Three types
          i. Machines
          ii. Articles of Manufacture
          iii. Compositions of Matter
       b. Not mutually exclusive; may be one or all three concurrently
       c. No substantial difference other than for purpose of categorization
    2. Type 2: Machine
       a. “...Includes every mechanical device or combination of mechanical powers and devices to perform some function and product a certain effect or result”
       b. an inventive thing that does something
          i. *i.e.*, piano, hammer, a compact disc player, merry-go-round
          ii. *i.e.*, a cell in an organism is a machine: it performs various intracellular processes such as producing hormones
          iii. *i.e.*, a computer, software (which are often claimed both as a product and a process...giving the patentees broader rights)
c. A machine may be nonpatentable if it attempts to capture a process which is too general and abstract
d. A patent on a machine does not automatically apply to the processes that the machine carries out

3. Type 3: Manufacture
   a. “the production of articles for use from raw or prepared materials by giving to these materials new forms, qualities, properties, or combinations, whether by hand-labor or by machinery”
      i. *i.e.*, clothing, furniture, toys, food, and anything else made by man could potentially fall within the category of “article of manufacture”
   b. May include things that are made by humans but last only momentarily (so propagated electronic signal, such as a computer program, thus can be a article of manufacture)
   c. Requirements
      i. Unnatural
      ii. Functional
         1. *i.e.*, an author may not patent book with the text of her new novel, but a publishing engineer may patent the invention of a new form of book

4. Type 4: Composition of Matter
   a. “All compositions of two or more substances and... all composite articles, whether they be the results of chemical union, or of mechanical mixture, or whether they be gases, fluids, powders, solids”
   b. The inventor can take the most basic and well-known things, and if she composes them in a particularly novel and nonobvious format, and it results in something useful, she may patent the resulting chemical
   c. It does not matter if the basic elements are natural
   d. *i.e.*, human genes to toothpaste
   iii. Improvements (or “Blocking Patents”)
      1. Type 5: Improvements
         a. Scenario: Inventor 1 invents; Inventor 2 improves
            i. Inventor 2 may patent the improvement
            ii. No one is able to make, use, sell, offer to sell, and import the improved version of the rocket launcher w/out permission from both inventors
            iii. Doing so infringes both patents
            iv. Thus called “Blocking Patents”
            v. Both inventors may make or license the improved version only by entering into some kind of agreement (*i.e.*, cross-license)
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vi. May be “Non-Blocking” as well (i.e., improving a non-patented invention)

3. Requirements (3)
   a. In General.
      i. Three Elements of Patentability
         1. Novelty
            a. § 101 (and detailed in § 102)
            b. § 102
               i. Creates statutory bars to protection in addition to lack of novelty
         2. Utility
            a. § 101 (and detailed as courts have construed utility)
         3. Nonobviousness (over the prior art)
            a. Detailed in § 103
   b. Novelty
      i. Invention must be new in 3 ways
         1. Anticipation (§ 102(a), (e))
            a. It was not already known to the public or in public use (in the United States) and
            b. Had not been published (anywhere) or described in a pending U.S. patent application (which led subsequently to an issued patent)
               i. Anticipation events that defeat a claim of novelty if they occur anytime prior to invention:
                  1. Domestic
                     a. Prior patent by anyone
                     b. Printed publication
                     c. Knowledge or unabandoned, unsuppressed, unconcealed invention by others
                     d. Description in another’s previously filed and eventually granted application
                  2. Foreign
                     a. Prior patent by anyone
                     b. Printed publication
         2. Priority (§ 102(g))
            a. It was not already invented by someone else who was diligently proceeding toward making the invention and patenting it
         3. Derivation (§ 102(f))
            a. The patent applicant must be the inventor, not one who has learned of an invention from someone else
   ii. Statutory Bars (also § 102)