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Back to the ‘Useful Arts’

Supreme Court reins in the expansive interpretation of patent eligibility.

Section 8 of the United States Constitution authorizes Congress to “promote the progress of science and the useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries.” Our patent and copyright laws are derived from this intellectual property (IP) clause, which continues to confound jurists and legal commentators. What are the *useful arts* of medieval sounding origin? Do they include commercial applications of mathematics and economic theory? Or are the latter excluded as liberal arts?

In the 12th century, the theologian Hugh of St. Victor defined the seven mechanical (or useful) arts as weaving, armoring, navigation, agriculture, hunting, medicine and the science of entertainment.

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Historically, the useful arts offered a contrast to the seven liberal arts of grammar, logic, rhetoric, arithmetic, geometry, astronomy and the theory of music.

Patent-eligible subject matter in the United States, however, is not statutorily defined in terms of useful arts categories. 35 U.S.C. § 101 instead provides that “[w]hoever 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.” Inventors cannot claim any exclusive rights in laws of nature, natural phenomena or abstract ideas. They constitute implicit exceptions to patent-eligible subject matter.

From the standpoint of the Industrial Revolution’s technological advancements, the scope of patent eligibility is generally a nonissue. Inventions that transform physical matter in novel, nonobvious and useful ways are generally patentable.

The scope of patent eligibility grew murkier with the ascendancy of computerized technology in the Information Age. Institutional resistance initially arose against issuing patents for software and computerized business methods. The formation of a specialized, pro-patenting federal appellate court (the Federal Circuit) in 1982 altered that anti-patenting stance.

Patent eligibility for software and business method inventions reached its zenith in 1998. The Federal Circuit’s *State Street Bank* decision issued that year held that business method inventions are patent-eligible so long as they produce a “useful, concrete and tangible result.”

The Supreme Court reined in the Federal Circuit’s expansive interpretation of patent eligibility most recently through a two-part test vigorously applied in *Alice Corp. v. CLS Bank Int’l* (2014):

- **Step one** is a determination whether the claims at issue are directed to one of the patent-ineligible concepts, for example, laws of nature, natural phenomena or abstract ideas. If so, you must then ask, “What else is there in the claims?” To answer that question, you must consider the elements of each claim both individually and “as an ordered combination” to determine whether the additional elements transform the nature of the claim into a patent-eligible application.
- **Step two** is a search for an “inventive concept” — that is, an element or combination of elements that is sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the ineligible concept itself. A claim that recites an abstract idea must include “additional features” to ensure that the claim is more than a drafting effort designed to monopolize the abstract idea. A patent-eligible application requires more than simply stating the abstract idea while adding the words “apply it.” Nor is it permissible to limit the use of an abstract idea to a particular technological environment.

Influential jurists interpret *Alice* as imposing a *de facto* “technological arts” test for determining patent-eligible subject matter. Patent law may be circling back to its *useful arts* roots. How the *Alice* test will be applied promises to be a focal point for patent litigation in 2015.

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