The Naples Roundtable, Phoenix Issue II (February 15, 2016)

Preemption

- ***Flook*** : "Phenomena of nature, though just discovered, mental processes, and abstract intellectual concepts are not patentable, as they are the basic tools of scientific and technological work." *Benson*, 409 U.S. at 67*.*
- ***Bilski***: Thus, this Court stated in *Benson* that "[p]henomena of nature . . . , mental processes, and abstract intellectual concepts are not patentable, as they are the basic tools of scientific and technological work," *Benson*, 409 U.S. at 67 (Stevens, J. concurring).
- ***Alice****:* "We have long held that this provision contains an important implicit exception: Laws of nature, natural phenomena, and abstract ideas are not patentable." *Association for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U. S. ___, (2013) (slip op., at 11) (internal quotation marks and brackets omitted).

1. Has the Patent System been well served by judicial pronouncements of patent preemption?

2. Should patents preempt experimentation on, and not with, the patented invention?

- "This [Claims] court questions whether any infringing use can be de minimus." - ***Deuterium Corp. v. U.S.,*** 19 *Cl.Ct*. 624, 631, 14 USPQ2d 1636, 1642 (*Cl.Ct*. *1990*).
- "A use or sale is experimental for purposes of pre-AIA section 102(b) if it represents a *bona fide* effort to perfect the invention or to ascertain whether it will answer its intended purpose.… If any commercial exploitation does occur, it must be merely incidental to the primary purpose of the experimentation to perfect the invention." - ***LaBounty Mfg. v. USITC****,* 958 F.2d 1066, 1071, 22 USPQ2d 1025, 1028 (Fed. Cir. 1992) (quoting ***Pennwalt v. Akzona****.,* 740 F.2d 1573, 1581, 222 USPQ 833, 838 (Fed. Cir. 1984)).
- Research must be "reasonably related" to the pursuit of information that would be used in FDA applications to qualify for the §271(e)(1) exception, even if the research at issue was ultimately not submitted to the FDA. - **Merck KGaA v. Integra Lifesciences I, Ltd.**, 545 U.S. 193 (2005)
- Many experts in the field advise inventors against relying on the experimental use exception except to the extent that §271(e)(1) applies.

3. Should the "all elements" rule (which excludes infringement of a combination claim) obviate the "preemption" concern, where an otherwise ineligible element is paired in a combination claim, that together provides an "inventive" (nonobvious) advance?