PHYSICALITY IN THE INFORMATION AGE: FROM BILSKI TO NON-PHYSICAL METHODS

BEN MCENIERY*

Abstract

There has been much conjecture of late as to whether the law relating to patent eligibility contains a physicality requirement. Many commentators had criticized the machine-or-transformation test introduced by the Federal Circuit in In re Bilski as being inconsistent with established principles dictated in Supreme Court precedent and inconsistent with the need for the patent system to respond appropriately to all “new and useful” innovation in whatever form it appears. Those criticisms were vindicated when the Supreme Court in Bilski v Kappos ruled that the “machine-or-transformation test” is not the sole test for deciding whether an invention is a patent eligible process. In doing so, it dispensed with any suggestion that the patentable subject matter test involves a physicality requirement. In this paper, the issue is addressed from a normative perspective: it asks whether the patentable subject matter test should contain a physicality requirement. The conclusion reached is that it should not, because a physicality requirement is not an appropriate means of encouraging much of the valuable innovation we are likely to witness during the Information Age. It is argued that it is not only the traditional mechanical, industrial and manufacturing processes that are patent eligible, but that patent eligibility extends to include non-machine implemented and non-physical methods that do not have any connection with a physical device and do not cause a physical transformation of matter. The view put is that concerns raised that there is a trend of overreaching commoditization or propertization, where the boundaries of patent law have been expanded too far, are unfounded since the strictures of novelty, inventiveness and sufficiency of description will exclude undeserving subject matter from patentability. Further, the argument made is that introducing a physicality requirement will have unintended adverse effects in various fields of technology, particularly those emerging technologies that are likely to have a profound social effect in the future.

* BA LLB (Hons) (UQ) LLM (QUT), Lecturer, Faculty of Law, Queensland University of Technology.