In re Bilski, Proxies, and the Role of Subject-Matter Thresholds in the Patent System

The Federal Circuit’s recent en banc decision in In re Bilski and the various viewpoints it presented are just the latest in the debate over how best to define patentable subject matter. That patentable subject matter presents such thorny issues is not surprising. Patent law is a one-size-fits-all system that nonetheless must cover a wide diversity of scientific fields that evolve in often unexpected ways. Creating patentable subject matter guidelines to govern developments in these ever-changing fields with an even but predictable hand presents obvious difficulties. Complicating patentable subject matter is yet another phenomenon, however. The case law on the topic suggests that what should and should not be patentable in any given case is at least much intuition as anything else. And as is true of all intuition-based judgments, these tacit conceptions of patentable subject matter appear highly labile to context and inevitably a subject on which reasonable minds can differ. Indeed, we see this in the dissents in Bilski, not to mention the vigorous debate over patentable subject matter rules more generally. In the end, then, it is perhaps the ineffable nature of this intuitive sense that makes patentable subject matter so difficult to delineate.

When viewed in this light, the various tests for patentable subject matter can be seen as simply approximations of – proxies for – what we intuit should be patentable subject matter in any given case. The use of proxies itself is non-controversial; we use proxies all the time in the law, particularly where direct evidence of what we are looking for is not readily available. Yet even the most carefully selected proxy can serve only as well as the concept it represents, and many question the value of patentable subject matter itself as a serviceable concept. Indeed, many scholars have asserted that patentable subject matter itself is merely a proxy for other patentability requirements such as non-obviousness, enablement, and utility. Even controlling for potential overlap with other patentability requirement, however, we seem to have some underlying intuition about whether something should be patentable subject matter, even if it meets the other patentability requirements.

This project therefore takes a look at the various tests for patentable subject matter and what intuitions might lie beneath them. What is our intuition about why some innovations are clearly patentable – while others make us more uncomfortable? The project then suggests that perhaps the best answer to these questions is to stop asking them. We could instead simply accept that the individual patentability requirements, including patentable subject matter, are not so much proxies for concepts that can never be accurately or even clearly defined but rather are themselves the defining concepts that simply express what we hope the patent system will achieve. If this more realist (deterministic?) view of patent law bears weight, maybe we should focus less on selecting better “proxies” for patentable subject matter or other patentability requirements as if we could find proxies that accurately represent some fundamentally a priori Holy Grail of patentability. Rather, perhaps we should settle for clearer, more predictable standards and rules, even if somewhat arbitrary in nature, that would at least have us all on the same page.