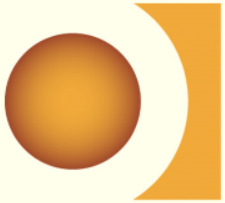


HICKMAN PALERMO
BECKER BINGHAM LLP

INTELLECTUAL PROPERTY LAW

Are Mere Discoveries Eligible?

Madison's Clause

[Congress has the power] To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries

Madison's Library

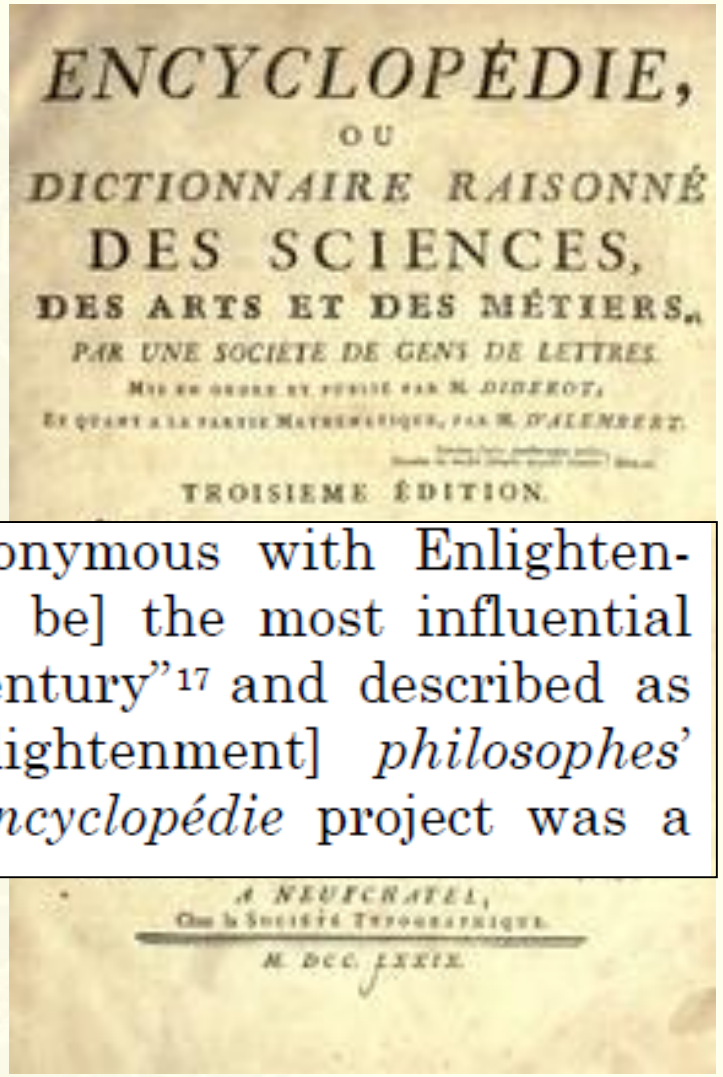
Encyclopédie, Dierot & d'Alembert

pub. 1751-1772

Cited by Madison in 1787


ENCYCLOPÉDIE,
OU
DICTIONNAIRE RAISONNÉ
DES SCIENCES,
DES ARTS ET DES MÉTIERS,
PAR UNE SOCIETE DE GENS DE LETTRES.
TROISIEME ÉDITION.
TOME VINGT-SEPTIEME.
A GENEVE,
A NEUFCHATEL,
M. DCC. LXXIX.

Madison's Library


ENCYCLOPÉDIE,
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the work that "became almost synonymous with Enlightenment"[16] and "is generally agreed [to be] the most influential work published in the eighteenth century"[17] and described as "the epitome of the [French Enlightenment] *philosophes*' achievement."[18] The great French *Encyclopédie* project was a

Madison's Library

***Discovery**: In general this name can be given to everything that is newly found in the Arts and the Sciences; however, it is scarcely applied, and ought not to be applied, **except to that which is not only new, but also curious, useful, and difficult to find, and which, consequently has a certain degree of importance. The less important discoveries are simply called inventions**.*

Madison's Clause

[Congress has the power] To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and ~~Inventions~~ Discoveries

Omissions of Lefstin & Menell

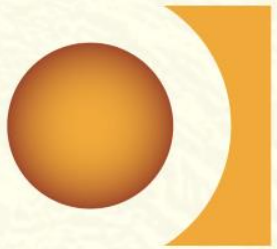
- Do not consider the meaning in 1787 of "discoveries" at all, much less from the French frame of reference. Its modern meaning of "uncovering" is presumed.
- Do not note that 50 years later in 1836, the Senate overlooked that meaning and the legislative history from then to 1952 exclusively and erroneously substitutes the modern meaning.
- Do not ask whether, at most, Congress could exercise its Constitutional power within the scope of the original meaning of "discoveries" and whether it was correct for the Supreme Court to constrain the law to the scope of the granted power.

Omissions of Lefstin & Menell

- On *Nielsen v. Harford*, do not consider a valid alternate reading: the court said that the inventor must have known the law of nature that applying heated air is superior for furnaces, but knowing that, invented a specific machine to provide it, and such an addition beyond mere knowledge of the natural principle was essential for patent eligibility because it transformed the subject of the patent into a "discovery". From this standpoint, the *Mayo* court did not misinterpret *Nielsen.*

Credit

O'Connor, Sean M., *The Overlooked French Influence on the Intellectual Property Clause* (March 15, 2014). University of Chicago Law Review, Vol. 82, No. 2, pp. 733-830 (2015); University of Washington School of Law Research Paper No. 2014-05. Available at SSRN: https://ssrn.com/abstract=2409796 or http://dx.doi.org/10.2139/ssrn.2409796



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