A Critique of Bilski's Textual Analysis

The majority in *Bilski* rightly decided not to categorically exclude business methods from patent-eligibility under § 101. However, in my view, the majority's "textual" analysis of § 101 is at best strains credulity, and weakens considerably the legitimacy of their strongest argument (and therefore the opinion as a whole), which is that the case should be decided based on the Court's prior decisions in *Benson*, *Flook*, and *Diehr*.

According to the majority, the "Court has more than once cautioned that courts should not read into the patent laws limitations and conditions which the legislature has not expressed."[1] However, the Court has, on more than one occasion, disregarded its own admonition. Perhaps the most egregious example of this is was in *Gandy v. Main Belting Co.*,[2] in which the Court read into the patent laws the limitation that any invalidating use or sale must be "in this country."[3] In 1892, at the time of the decision, the law allowed a patent for any invention "not in public use or on sale for more than two years prior to his application."[4] The Court conceded that "the language of this section contains no restriction as to the place or country wherein the public use is made of the invention," but nevertheless held that an invalidating use or sale must be in this country.[5]

A more recent example of the Court reading limitations into the patent laws is *Pfaff v. Wells Electronics, Inc.,*[6] in which the Court rejected the petitioner's "nontextual argument" that the on-sale bar applies only after the invention is reduced to practice, but then proceeded to provide a similarly nontextual interpretation that the on-sale bar applies as soon as the invention is "ready for patenting."[7]

In both of these cases, the Court, at least in my opinion, properly adopted "atextual" interpretations of the patent laws that furthered the policy of patent protection. In *Gandy*, the Court noted that Congress limited novelty-destroying uses and sales to those occurring "in this country," and reasoned that the same geographic limitations should apply to statutory-bar uses and sales.[8] In *Pfaff*, the Court adopted an interpretation of "sale" that allowed the inventor to "understand and control the timing" of the on-sale bar, but also to prevent the inventor from "exploit[ing] his discovery competitively after it is ready for patenting."[9] Though these interpretations of the patent laws were neither compelled nor even supported by the text of their respective statutes, these interpretations furthered sound policy determinations by the Court.

The *Bilski* majority supported its textual analysis of "process" by noting that it had similarly adopted textual analyses of "manufacture" and "composition of matter" in "accordance with dictionary definitions" and "common usage."[10] It seems unlikely, however, that the Court would follow these broad dictionary definitions and common usages to their logical extremes. For example, the Court defined a "composition of matter" as "all compositions of two or more substances and . . . all composite articles, whether they be the results of chemical union, or of mechanical mixture, or whether they be gases, fluids, powders or solids".[11] Under a textual definition of "composition of matter," an inventor could obtain a patent on a book or a sheet of music, since these are the composition of two or more substances (ink and paper fibers). Yet the Court of Customs and Patent Appeals, the predecessor to the Federal Circuit, has held that the "mere arrangement of printed matter on a sheet or sheets of paper, in book form or

otherwise, does not constitute 'any new and useful art, machine, manufacture, or composition of matter.'"[12] While the Supreme Court has not directly decided the issue of whether a book can be the subject of a patent, the Court would likely hold that a book is non-statutory subject matter because the protection of such is the province of copyright law, rather than patent law. Yet the "dictionary definition" of "composition of matter" would support the patent-eligibility of such printed matter.

Frankly, the Court's textual analysis of § 101 troubles me. At best, the Court merely overlooks those cases where it has not followed its own advice that it should not read limitations into the patent laws that Congress has not expressed, and is not mindful of the ramifications of the broad interpretations given to "process," "manufacture" and "composition of matter." At worst, the Court is cognizant of these issues, but selectively cites those cases that support its position (and ignores those that don't). Either way, in my opinion, the Court's textual analysis unfortunately (and unnecessarily) undermines the cogency of its holding: that *Benson*, *Flook*, and *Diehr* prohibit the patenting of abstract ideas.

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Endnotes

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Endnotes

1 *Bilski* Slip Opinion, **Kennedy at 6 (majority opinion) (quotations omitted).**
2 143 U.S. 587 (1892).
3 *Id.* at 593.
4 *Id.* at 592.
5 *Id.* at 592-93.
6 525 U.S. 55 (1998).
7 *Id.* at 63, 67-68.
8 *Gandy*, 143 U.S. at 592-93.
9 *Pfaff*, 525 U.S. at 67-68.
10 *Bilski* Slip Opinion, **Kennedy at 6 (majority opinion).**
11 *Diamond v. Chakrabarty*, 447 U.S. 303, 308 (1980).
12 *In re Russell*, 48 F.2d 668 (C.C.P.A. 1931).