Supreme Court Decisions Can Change the Game

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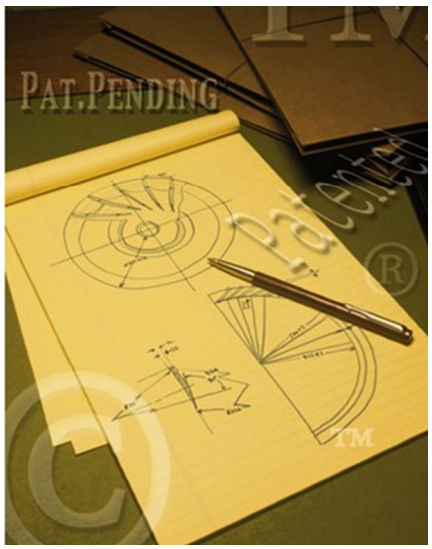
by Nancy S. Giges, ASME.org

Two Supreme Court decisions that have come down in the past few years have patent attorneys debating the implications because both are potentially game changers for mechanical engineers and especially for inventors and others applying for and holding patents.

The impact of those decisions can take time to filter down through the judicial system. Moreover, since there is no grandfathering under patent law, they can lead to a reversal of decisions about any patents issued even long ago if they are challenged, according to Andrew Langsam, partner and patent attorney at the law firm of Pryor Cashman, New York.

The most recent one, *Mayo Collaborative Services v. Prometheus Laboratories*, decided in March, had nothing to do with mechanical engineering (ME), but the implications for MEs are huge, says James R. Klaiber, also a partner and patent attorney at Pryor Cashman.

In that case (although the specifics are not pertinent), the Supreme Court found that two patents held by Prometheus related to determining optimal dosage of drugs were unpatentable because "the processes claimed by the patents effectively claim natural laws or natural phenomena … and therefore are not patentable."



The Supreme Court can have a major impact on who gets patents and who doesn't.

Klaiber, who also holds undergraduate and graduate degrees in ME from the Massachusetts Institute of Technology, the University of Michigan, and U.C. Berkeley, says that when anyone is working on something that falls into a "patent ineligible area," such as abstract ideas, laws of nature, physical phenomenon, or human body functions, "your patent has to show an 'inventive concept' above and beyond what's going on."

Patent Eligibility

For MEs, if this is applied broadly, it could affect algorithms and code they develop to control things like precision machines. "You can't get any more mechanical engineering

than that," says Klaiber. In grad school, he says, he was using a feedback sensor, sensing acoustic emissions from a steel tool to control the speed of a lathe.

"This is a very typical type of thing that mechanical engineers do. These days you're not just a blacksmith. It's people writing … code, very sophisticated stuff," says Klaiber. "The problem is those algorithms you are developing are potentially abstract ideas that aren't going to be patentable no matter how valuable they are … There is a microcontroller for everything. You may be writing a few lines of code, but you are the first person to control [a device]. You're doing it in a way no one has done it before, and I think you should get a patent on it," he explains.

In this new ruling, the Supreme Court is saying that the inventor or designer is just computerizing something already existing, and that there may not be enough of an "inventive concept" to be eligible for a patent. Since the ruling just came down, attorneys are still debating what it all means, and it can take some time before they find out how the patent office and court system apply the ruling.

Combining Ideas

In fact, it's only now, four years after another major decision came down, that the impact of another major Supreme Court ruling is becoming clearer. In that one, KSR vs. Teleflex, the Supreme Court changed the standard for determining whether an invention is patentable.

Prior to this ruling, in order to obtain a patent, an invention had to be something that was not obvious by what was done by others before, says Langsam. "If another invention in a prior patent was similar, it could clearly make the new patent application ineligible, but typically, the patent office finds more than one relevant prior patent. If the examiner found in any of them a suggestion of the concept of combining the ideas, the application would likely be unpatentable. If there was no suggestion of combining ideas, the new applicant could be eligible for a patent," he says.

However, the KSR ruling, which involved brake pedal adjustments in autos, changed the rules. The court found that even if there was no suggestion of combining ideas, an application would not be patentable if the idea of combination was one of "common sense" to someone in that field.

"That means that mechanical engineers' common sense is an important factor to be considered in the determination of what is and what isn't patentable," says Klaiber said.

And overall, it means that the standards to obtain a patent on a mechanical device are higher than before, because there are other engineers whose common sense gets called into play when a patented invention is reconsidered.

Nancy Giges is an independent writer.