

Boon and Bane of Inventive Concepts and Refined Claim Construction in the Supreme Court's Patent Precedents

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The US Supreme Court has taken patent precedents, and with it all substantive patent law (SPL) precedents in emerging technologies, to a higher level of development for adjusting it to the needs of inventions in emerging technologies and needs of the just emerging patent / innovation technologies. In any school of thinking a change to a higher level of development causes friction. This paper outlines such a friction, representing boon and bane of this progress by focusing on some most recent Supreme Court and CAFC decisions. The boon is evident: The Supreme Court's *KSR/Bilski/Mayo/Myriad* line of unanimous decisions with the introduction of notions such as "inventive concept" and "preemptiveness of a claim" shows the way to scientification of patent precedents for getting the SPL interpretation of 35 USC fit for stimulating and protecting emerging technology inventions. This move indeed enables SPL precedents to deal with such inventions in a consistent and predictable way. But, this consistency/predictability was lost, as recently shown by clashes in the CAFC: The increased abstractness of such inventions generated increased uncertainties about how to apply the established SPL precedents thinking, assuming tangible inventions, if inventions get completely intangible and - even worse - are located on top of vastly vague "models". The bane is not only that most of the patent business practitioners, including in PTOs on both sides of the Atlantic, don't grasp that the US Supreme Court thus opens new dimensions of stimulating / protecting intellectual properties by IPRs, especially emerging technology inventions by patent law and thus still reject it. More specific, the fundamental bane with this significantly improved understanding of SPL is that technically leveraging on it also makes aware how vulnerable emerging technology patents (applications) are by "indefiniteness attacks". This paper also describes, a "patent support system", the Innovation Expert System (IES), and its functionalities currently implemented as a prototype in a major R&D project, (see www.fstp-expert-system.com) which is built to overcome such SPL reservations.

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