

CLASS 24

THE UTILITY REQUIREMENT

PATENT LAW & POLICY
PROFESSOR WAGNER



Today's Agenda

Operable Utility

Beneficial Utility

Practical Utility

The Policy of the Utility Requirement

35 U.S.C § 101 - Inventions patentable

Whoever invents or discovers any new and useful process, ¹ **The Utility Requirement** ^{osition of} matter, ^{it thereof,} or may obtain a patent therefor, subject to the conditions and requirements of this title

1

Operable Utility

Patented inventions must be operable.

No models or prototypes required for patenting.

A presumption that inventions are operable as described.

"Reasonable doubts as to operability"
[applicant then has burden of proof]

**"inherently unbelievable or implausible
scientific principles"**

In re Cortright (Fed. Cir. 1999)



The Federal Circuit:

§ 101 rejection improper

§ 112 written description rejection (of claim 15) proper

Why?



UN000033576A

United States Patent [19]

[11] **Patent Number:** 6,033,676

Cortright

[45] **Date of Patent:** Mar. 7, 2000

[54] **TREATMENT OF SCALP BALDNESS WITH 8-HYDROXYQUINOLINE SULFATE** 4,895,727 1/1990 Allen 514596

OTHER PUBLICATIONS

[75] **Inventor:** Joyce A. Cortright, Pine Bush, N.Y.

The Merck Index, p. 770 (1989), 11th ed.

[73] **Assignee:** Joseph B. Tophorn, Poughkeepsie, N.Y.

Primary Examiner—Thurman K. Page
Attorney, Agent, or Firm—Joseph B. Tophorn

[21] **Appl. No.:** 07/848,191

[22] **Filed:** Mar. 11, 1992

[51] **Int. Cl.:** A61K 7/06

[52] **U.S. Cl.:** 424/401; 514/580; 424/70.1

[58] **Field of Search:** 424/401, 70; 514/580

[57] **ABSTRACT**

A process and product restoring hair to bald-headed men involves massaging the scalp with a commercially available ointment known as BAG BALM.

[56] **References Cited**

U.S. PATENT DOCUMENTS

3,886,277 5/1975 Radebeck 514812

1 Claim, No Drawings

In re Swartz (Fed. Cir. 2000)

Claims to methods for achieving to cold fusion.

Why is the claim rejected?
Is this the right policy? Any concerns?

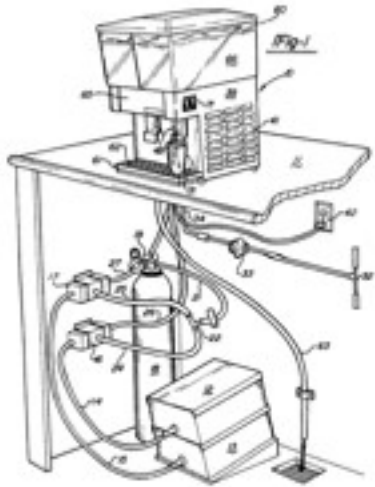
2

Beneficial Utility

All that the law requires is, that the invention should not be frivolous or injurious to the well-being, good policy, or sound morals of society. The word 'useful,' therefore, is incorporated into the act in contradistinction to mischievous or immoral.

— Story, J.
Lowell v. Lewis (CCD Mass. 1917)

The End of Beneficial (Moral) Utility?



**Juicy-Whip v. Orange
Bang (Fed. Cir. 1999)**

§ 2181. Inventions relating to atomic weapons.

No patent shall hereafter be granted for any invention or discovery which is useful solely in the utilization of special nuclear material or atomic energy in an atomic weapon. Any patent granted for any such invention or discovery is revoked, and just compensation shall be made therefor.





US 2003/0079240 A1

(39) United States

(32) Patent Application Publication (30) Pub. No.: US 2003/0079240 A1
Newman (43) Pub. Date: Apr. 24, 2003

(34) CHIMERIC EMBRYOS AND ANIMALS
CONTAINING HUMAN CELLS

Related U.S. Application Data

(36) Inventor: Stuart A. Newman, Pleasantville, NY
(US)

(42) Division of application No. 08/993,568, filed on Dec.
18, 1997.

Publication Classification

Correspondence Address:
COLLIER SHANNON SCOTT, PLLC
3650 K STREET, NW
SUITE 400
WASHINGTON, DC 20007 (US)

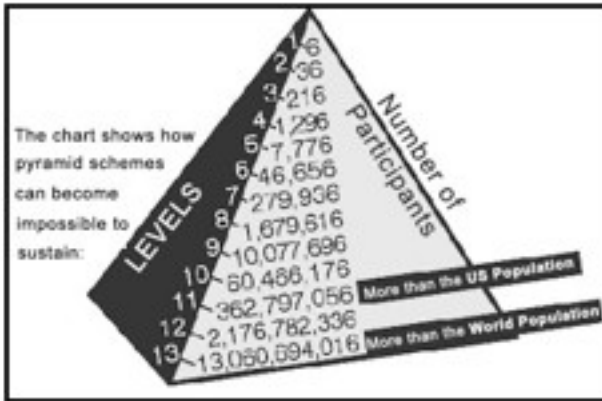
(51) Int. Cl. 7 _____ A61K 47/00
(52) U.S. Cl. _____ 806/9

(57) ABSTRACT

A mammalian embryo developed from a mixture of embryo
cells, embryo cells and embryonic stem cells, or embryonic
stem cells exclusively, in which at least one of the cells is
derived from a human embryo, a human embryonic stem cell
line, or any other type of human cell, and any cell line,
developed embryo, or animal derived from such an embryo.

(21) Appl. No.: 10/306,035

(22) Filed: Dec. 3, 2002



3

Practical (or Substantial) Utility

Brenner v. Manson (1966)

Operable Utility	Beneficial Utility	Practical Utility
-----------------------------	-------------------------------	------------------------------

How does the claim meet each of these?

Does the Brenner rule set the bar too high?

[Will it have differential effects across fields? And is this a bad thing or a good thing?]

When is utility evaluated?

[What effects does this have on incentives?]

In re Fisher (Fed. Cir. 2000)

In re Fisher (Fed. Cir. 2000)

Claim	Utility Disclosure
ESTs coding for maize proteins	disclosed several possible uses, e.g. probes, detectors, monitors

What is the rule?

[What do applicants need to show in their utility disclosure for ESTs? Is this too high/low?]

The 2001 USPTO Utility Guidelines



The Court holds that concerns related to patents on ESTs specifically should not be considered under § 101.

[Is this right as a matter of policy?]

Judge Rader's Dissent:

Utility as a research tool meets the requirement

[Is he right on what Brenner holds?]

[Is he right on the policy? Consider his microscope example.]

4

The Policy of the Utility Requirement

Why have a Utility requirement at all?

[Don't inventors have strong incentives to apply for "useful" inventions?]



How is Utility all about timing?



Stronger Utility Requirement	Weaker Utility Requirement
Later patenting	Earlier patenting
Better allocation of rewards (some cases)	Earlier disclosure

Other reasons for a 'weak' Utility requirement?

Avoid subjective determinations about technological utility.

How much harm can 'useless' patents do?

On the Exam

Mostly multiple choice (bring #2 pencils)

Some short answer.

Time Limit: 2.5 to 3 hours

Approximately 50-60 questions.

Open book, open notes, open computers.

Exam Samples on the Website

On the Exam (2)

Exam: 9:30 AM on Wednesday, Dec. 14

Question policy during exam period:

- please post questions to the blog or email to me -
 - I will respond on the blog -
- no questions answered after 6:00 PM on December 13 -

THE END

PATENT LAW & POLICY
PROFESSOR WAGNER

