Constitutional Hard Limits on the Patent Power

Joshua D. Sarnoff

In *Laboratory Corporation v. Metabolite Laboratories,* U.S. Supreme Court Justice Breyer (in an unusual dissent from dismissal of certiorari) articulated a utilitarian basis for the exclusions from patent eligible subject matter for laws of nature, physical phenomena, and abstract ideas. Justice Breyer appeared to ground these limits in the preambular language regarding the object of the Authors and Inventors Clause of the Constitution, to "promote the Progress of Science and useful Arts." In *Bilski v. Kappos,* the Supreme Court held that patents for business methods were statutorily authorized. In *Golan v. Holder* (addressing expressive works and copyrights), the Court is poised to eliminate limits on legislative authority to provide exclusive property rights over intangible information that has already entered the public domain. In a recent copyright case, *Eldred v. Ashcroft,* based on *McClurg v. Kingsfield* (an earlier patent precedent), the Court suggested the absence of such limits, contrary to its earlier dicta in *Graham v. John Deere* (addressing inventions) that such power is denied to Congress. In yet other cases, such as *Railway Labor Executives Association v. Gibbons,* the Court has held that Commerce Clause power may be used where authority is lacking under other heads of power, but not where it would directly conflict with express limitations on those other sources of authority ("hard limits").

This article explores the sources of hard limits on the power granted to Congress to authorize the "exclusive Right" (patents) to "Inventors … [for] their respective … Discoveries," with particular reference to what things can be treated as patent eligible inventions. It explains why the Court is unlikely to find utilitarian constraints or field of technology limits on legislative decisions to grant patents, based on language in the preamble to the Authors and Inventors Clause, but might be willing to recognize a hard limit against granting patents to pre-existing, scientific principles, natural materials, and certain kinds of ideas based on the meaning of "Inventors" and "Discoveries" in the body of that Clause. In *Bilski v. Kappos,* the Court recently preserved these limits as a statutory matter based on *stare decisis,* but failed to explain their historic origins and significance with respect to views of the Framers (particularly their religious beliefs) at the time of adopting the Constitution.

Finding such hard limits would be extremely significant, and not only by recognizing and protecting from future legislative encroachment a public domain of science, nature, and information. It would potentially affect the Court's approach to a pending decision in *Mayo Collaborative Services v. Prometheus,* where the Court will address the eligibility of a medical treatment method based on a new discovery of a natural medical phenomenon. Similarly, such a hard limit might alter the results of a recent decision of the Court of Appeals for the Federal Circuit in *Association for Molecular Pathology v. U.S. Patent and Trademark Office* (commonly known as the *Myriad* case, as the patent holder or exclusive licensee of the relevant patents is Myriad Genetics), reversing an earlier District Court decision and holding that isolated genetic sequences are patent eligible subject matter.