

INVENTIVE APPLICATION: A HISTORY

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The boundaries of the patent system, as defined by the doctrine of patent-eligible subject matter, have rarely been so uncertain. A major source of this uncertainty has been the Supreme Court's opinion in *In Mayo v. Collaborative Services v. Prometheus Laboratories, Inc.* The *Prometheus* Court, seemingly reviving the analytical framework of *Parker v. Flook*, held that a process claim based on a law of nature, or abstract idea, is patent-eligible subject matter only if the claim embodies an "inventive concept" beyond the underlying fundamental principle. Both *Prometheus* and *Flook* drew upon *Neilson v. Harford*, an 1841 case decided by the Court of Exchequer, to suggest a long-standing practice of restricting patents to an *inventive application* of newly discovered fundamental principles.

History tells a different story. *Neilson* was indeed the starting point from which 19th-century courts, both English and American, drew the boundary between discovery and invention. But *Neilson's* foundation was diametrically opposed to the one supposed by the Court in *Flook* and *Prometheus*: the patent in *Neilson* was sustained not because it represented an inventive application of the patentee's discovery, but because the patentee's application was entirely routine and conventional once the patentee's discovery had been disclosed. Nineteenth century English courts and commentators understood *Neilson* and its companion cases to stand for the proposition that while discoveries in the abstract could not be the subject of patents, practical applications of that discovery might be patented without novelty or inventiveness in the means of application.

The same understanding prevailed in the United States. *Neilson* remained the starting point for discussions of patent-eligible subject matter, patent scope, and the patentability of processes, but the Supreme Court's discussion of the *Neilson* cases is devoid of any suggestion that patentability depended upon inventive application. The 19th-century treatise-writers addressed the question directly, and reached the same conclusion as their English counterparts: practical application of a discovery sufficed. And until 1948, the weight of American authority agreed.

It was then that *Funk Brothers*, not *Flook*, first set inventive application as the boundary between discovery and invention. Contrary to more recent accounts of *Funk*, contemporary commentary recognized both that *Funk* had imposed a requirement of inventive application, and that such imposition represented a radical shift in patent jurisprudence. That recognition continued through the 1960s, as courts employed a test of inventive application to invalidate claims much like the those currently contested in *Prometheus's* wake.

The present boundary between invention and discovery is difficult to discern. Despite placing the requirement for inventive application at the heart of *Prometheus*, the Supreme Court ignored it entirely in *Myriad*; divided as the Federal Circuit was in *CLS Bank*, the court was uniform in its denial that *Prometheus*'s "inventive concept" meant inventive application. At the least, a historical examination clarifies when patent law has embraced and when it has rejected such a test, and illustrates the types of claims that will be vulnerable to challenge if inventive application remains the test for patent-eligible subject matter.