PONDERING PATENTS: FIRST PRINCIPLES AND FRESH POSSIBILITIES

INTRODUCTION

Greg R. Vetter[*]

As I compose this introduction, I am reminded that I do so in the middle of my eleventh year in the academy. Beyond my astonishment in pondering the decade gone by, I am also reminded that the 2012 IPIL/Houston National Conference is the eleventh installment of the event. Eleven years ago, patent law was in no way a backwater in the law. But, eleven years ago, I would not have anticipated the degree of change in the intervening decade. Change in patent law has seemingly accelerated in the later part of the decade. Capping this change are two major recent developments: the America Invents Act;[1] and a renewed interest by the Supreme Court in patent law issues. These developments frame the accomplishments of our invited scholars and their participation at the IPIL/Houston National Conference.

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* Associate Professor of Law, University of Houston Law Center (UHLC); Co-Director, Institute for Intellectual Property and Information Law (IPIL); and Organizer/Moderator, 2012 IPIL/Houston National Conference. This annual conference, and IPIL's other events throughout the year, are made possible by the continuing commitment of UHLC Dean Raymond T. Nimmer; the support of my colleagues, Paul Janicke, Craig Joyce, Sapna Kumar, and Jacqui Lipton; IPIL's capable program manager, Sindee Bielamowicz; our continuing partnership with the *Houston Law Review* (whose editors-in-chief have attended each of the conferences since the project's founding); and the generous support of the international law firms and corporations represented on the Institute's distinguished Advisory Council. To all of them, I express my own, and IPIL's, great appreciation.

1. Leahy -Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284, (2011) (to be codified at 35 U.S.C.).

The work of these remarkable scholars is set forth in this 2012 Symposium Issue, *Pondering Patents: First Principles and Fresh Possibilities*, of the *Houston Law Review*. This Issue continues a highly productive collaboration between the *Review* and the University of Houston Law Center's Institute for Intellectual Property and Information Law (IPIL).

Each year IPIL brings together, for the IPIL/Houston National Conference, internationally recognized scholars to explore a particular subject within intellectual property or information law. The 2012 Conference was held on June 1-2, 2012, in Santa Fe, New Mexico.[2] The event's goal is to provide a small-group, seminar-course-style discussion of the papers in a locale that is both enjoyable and inspirational. The in-depth review and conversation about the scholarship is unparalleled. It is intimate in a professional and beneficial way. Given the group assembled for the 2012 National Conference, I am honored to briefly introduce the resulting scholarship as reported in this Symposium Issue.

Aptly and impressively applying the notion that there is nothing new under the sun, in *Reforming Software Patents*,[3] Colleen Chien demonstrates how contemporary reforms for software patents have historical analogues. These analogues often arose from patenting in a then new or growing area of commerce. The insights of this monumental article extend beyond software and information technology as areas where patenting's detriments may have exceeded its benefits. Professor Chien's critique of contemporary reforms relates to the patent system as a whole even while illustrating the critique through software patents.

An oft-debated issue with software patents is whether they should be eligible subject matter for patenting in the first place. While that ship has perhaps sailed, Kevin Collins provides a deepened understanding of patentable subject matter doctrines in light of the Supreme Court's opinion in *Mayo Collaborative Services v. Prometheus Laboratories*.[4] In *Mental Steps, and Printed Matter*,[5] Professor Collins takes *Prometheus Laboratories*

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2. In addition to the Conference Presenters and contributors whose papers appear here, the 2012 gathering in Santa Fe benefited greatly from the insightful participation of our three Conference Fellows: Oskar Liivak, Cornell University Law School; David Olson, Boston College Law School; and Kristen Osenga, University of Richmond School of Law.

3. Colleen V. Chien, *Reforming Software Patents*, 50 HOUS. L. REV. 325 (2012).

4. *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1292 (2012).

5. Kevin Emerson Collins, Prometheus Laboratories*, Mental Steps, and Printed Matter*, 50 HOUS. L. REV. 391 (2012).

beyond its confines as a "laws of nature" case by brilliantly relating it to other patentable subject matter doctrines. Thematically, the article threads its observations into an argument cautioning against eligibility for subject matter related to encoding and cognition within the human mind.

Doctrinal change in patent law over the past decade extends beyond eligible subject matter.[6] The change encompasses issues relating to patent prosecution and litigation, including jurisdictional questions when clients desire to sue their patent attorney for malpractice. In *The Patent Malpractice Thicket, or Why Justice Holmes Was Right*,[7] Paul Janicke argues against doctrinal movement by the Federal Circuit and other courts that would keep malpractice actions out of state court when the embedded substantive law relates to patents. Cleverly deploying arguments oft-asserted (but often in the minority) by Justice Holmes, the article's historical and prudential perspectives seek to clarify arising under jurisdiction specifically for state law malpractice claims embedding patent law, while generally providing a framework for claims with a similar state–federal law structure.

The jurisdictional uncertainty attending patent law malpractice claims is but a point in the constellation of uncertainty engendered by patents. This uncertainty mostly relates to the potential parties to an infringement suit. The uncertainty is due to the vagaries of patent validity doctrines, the judicial process of claim construction, and the remaining doctrines of infringement, inequitable conduct, and remedies in a typical infringement case. Potential parties to an infringement case anticipate these uncertainties. In *Leveraging Information About Patents: Settlements, Portfolios, and Holdups*,[8] Mark Patterson explains how parties leverage these uncertainties, but also go beyond these core doctrinal uncertainties to leverage the patent grant. Professor Patterson smartly questions whether such extra-grant leveraging should be part of the patent right, particularly in the three exemplary scenarios treated by his article: contextual information about patents perhaps should not

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6. Shortly before this symposium issue published, the Supreme Court granted certiorari to review the Federal Circuit's opinion in *Association for Molecular Pathology v. U.S. Patent and Trademark Office*, 689 F.3d 1303 (Fed. Cir. 2012) (finding certain types of isolated DNA sequences patent eligible subject matter). The question presented upon which certiorari was granted is: "are human genes patentable?"

7. Paul M. Janicke, *The Patent Malpractice Thicket, or Why Justice Holmes Was Right*, 50 HOUS. L. REV. 437 (2012).

8. Mark R. Patterson, *Leveraging Information About Patents: Settlements, Portfolios, and Holdups*, 50 HOUS. L. REV. 483 (2012).

favor the patent holder in ways similar to information about the invention itself or the core exclusionary right of the patent.

Paralleling its growth in litigation activity and commercial significance over the past decade, patent law has frequently been the topic of the IPIL/Houston National Conference.[9] A starting point for the next symposium article, *The End of an Epithet? An Exploration of Legal Scholarship in Intellectual Property Decisions*,[10] by Lee Petherbridge and Dave Schwartz, arose from the 2002 IPIL/Houston National Conference. Thus, nearly eleven years ago, while attending my first IPIL/Houston National Conference, I had the great pleasure of hearing Professor Craig Nard present an article empirically evaluating the Federal Circuit's use of scholarship in its opinions.[11] One impressive, path-breaking article on jurisprudence from an empirical perspective deserves another, and this is what Professors Petherbridge and Schwartz have provided. They show how one empirical point from Professor Nard's original article has taken on a life of its own, frequently used rhetorically as support for dissatisfaction with Federal Circuit jurisprudence, perhaps a use beyond the power of what Professor Nard's original statistic proves. Building on their own recent empirical studies of the Federal Circuit's use of legal scholarship, Professors Petherbridge and Schwartz in this symposium article present a study of the Supreme Court's use of legal scholarship in intellectual property law cases. The results of the study cast doubt on the rhetorical uses of Professor Nard's original statistic as supporting claims of dissatisfaction with the Federal Circuit.

The Supreme Court also plays prominently in the final article of the 2012 Symposium Issue. The Court's interest in the topic of patentable subject matter is acute in recent years. In *Much Ado About Preemption*,[12] Kathy Strandburg presents a new approach to evaluating patentable subject matter. Her article demonstrates that the notion of "preemption" is incoherent as applied by the Court as a filter for patentable subject matter.

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9. Counting the upcoming 2013 IPIL/Houston National Conference, there are twelve events in total. The events in 2002, 2008, and 2012 took patent law as their sole topic. The 2013 event, entitled *Intellectual Property and Information Law in the Administrative State*, will inherently produce some articles taking a patent law approach to the topic. *See* www.ipilsymposium.org.

10. Lee Petherbridge & David L. Schwartz, *The End of an Epithet? An Exploration of Legal Scholarship in Intellectual Property Decisions*, 50 HOUS. L. REV. 523 (2012).

11. Craig Allen Nard, *Toward a Cautious Approach to Obeisance: The Role of Scholarship in Federal Circuit Patent Law Jurisprudence*, 39 HOUS. L. REV. 667 (2002).

12. Katherine J. Strandburg, *Much Ado About Preemption*, 50 HOUS. L. REV. 563 (2012).

Her article lays a comprehensive and insightful groundwork for an alternative approach to determine patentable subject matter based on per se exclusions that is attentive to the incentive structure of patent law. The groundwork is to "disentangle[] two threads of patentable subject matter analysis, separating concerns about overbroad impacts on downstream innovation from per se exclusions on other grounds."[13] Further, Professor Strandburg's article presents a two stage structure to evaluate per se exclusions. She notes that future work "will consider whether per se patentable subject matter exclusions are best understood by focusing on the availability of alternative innovation institutions."[14]

The past eleven years have been eventful and times of change in patent law. The past eleven IPIL/Houston National Conference events have been a source of tremendous professional enjoyment and satisfaction. It is with appreciation and pride that I recommend to the academy the works of these tremendous scholars in this 2012 Symposium Issue of the *Houston Law Review*.

13. *Id*. at 621.
14. *Id*. at 622.