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Tax Strategies Are Not Patentable Inventions

BY ANDREW A. SCHWARTZ

In the most recent issue of this Newsletter, E. Anthony Figg, the immediate past Section Chair, addressed certain policy concerns relating to patents on “tax strategies” and responded to the “quite negative” reactions of tax and estate-planning professionals “to the realization that tax preparation and planning methods represent patentable subject matter.”

This “realization” dates back to 2003, when the Patent Office awarded its first ever tax-strategy patent, thereby tacitly expressing its view that tax strategies are eligible for patenting. The Office has since stated its view that tax strategies are a type of business method and are therefore patentable under the authority of State Street Bank & Trust Co. v. Signature Financial Group Inc.

But the issue of whether tax strategies meet the statutory requirements of the Patent Act has never been resolved by any court, nor has it even been analyzed in the academic literature. At a recent hearing of the Subcommittee on Select Revenue Measures of the House Ways and Means Committee on “issues relating to the patenting of tax advice,” for example, none of the witnesses (including the General Counsel of the USPTO and the Commissioner of Internal Revenue) questioned the patentability of tax strategies. Their testimony focused entirely on the policy implications of this new type of patent and on whether Congress should amend the Patent Act to exclude tax strategies from the scope of patentable subject matter.

This article suggests, however, that tax strategies cannot be patented, no matter how novel or nonobvious, because they are not “inventions” within the meaning of Section 101 of the Patent Act of 1952, as amended to date.

I. The Invention Requirement

The Patent Act provides that a patent may issue for “any new and useful process” or product. The Supreme Court has held that this language to include within its scope “anything under the sun made by man.” But Congress did not, by enacting the Patent Act, give the Patent Office a blank check. To the contrary, Congress limited its authority by including a number of conditions and requirements for patentability, such as novelty, inventorship and nonobviousness. One of these conditions is that only “inventions” may be patented.

What is meant by the term “invention”? The definition provided in Section 100 of the Patent Act — “The term ‘invention’ means invention or discovery.” — is not helpful. A leading legal dictionary’s entry for “invention” describes it as a “word impossible of definition.” The Supreme Court, however, has not shied away from this challenge and has offered a clear and workable definition of the term “invention” from as far back as the late nineteenth century to as recently as the late twentieth century. To understand the court’s definition, however, requires a detour into the “law-of-nature” doctrine.

II. The Law-of-Nature Doctrine and Its Corollary

As discussed above, “anything under the sun made by man” is eligible for patenting. It is well settled that the converse is also true: anything that was not “made by man” may not be patented. This is referred to herein as the “law-of-nature doctrine.”

Thus, a product of nature, such as “a new mineral discovered in the earth or a new plant found in the wild[,] is not patentable subject matter.” The same can be said for laws of nature (gravity, e=mc²), natural phenomena (volcanic eruptions, the tides), abstract scientific principles (thermodynamics, quantum physics) and mathematical concepts and algorithms (the Pythagorean theorem, calculus, the Fourier series). All of these are referred to collectively herein as “laws of nature,” and they are all excluded from patentable subject matter under the law-of-nature doctrine.

The “underlying notion” of the law-of-nature doctrine is that laws of nature have “always existed,” just waiting to be discovered by humankind. Because laws of nature have always existed, it logically follows that they cannot be newly created by humans. Hence, they necessarily fail the anything-under-the-sun-made-by-man test and are excluded from patentable subject matter for that reason.

Thus, the law-of-nature doctrine holds that laws of nature are not patent-eligible.

But there is a vital corollary to the law-of-nature doctrine: while a law of nature may not itself be patented, an application of that law of nature “may well be deserving of patent protection.” The Wright brothers’ airplane was able to fly because it exploited certain laws of physics that are inherent in the universe. Whereas the underlying laws of physics that kept the plane in the air were not patentable, the airplane itself clearly would be. Similarly, when presented with Samuel Morse’s patent on the telegraph, the Supreme Court upheld the first seven of his claims, but rejected the last which claimed “the use of the motive power of the electric or galvanic current, which I call electro-magnetism, however developed for marking or printing [characters] at any distances.”

This distinction between laws of nature and the appli-
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### III. Definition of “Invention”

From at least as early as the *Telephone Cases* (1888), to as recently as *Diamond v. Diehr* (1981), the Supreme Court has construed the term “invention,” for purposes of patentability, in a single, consistent fashion: an “invention” is anything made by man that uses or harnesses one or more “laws of nature” for human benefit. This construction harmonizes well with the law-of-nature doctrine and its corollary. A simple example of a patentable invention is the watermill, which is a system of extracting power from a river and using it to run machinery. The river’s power, of course, comes from the natural force of gravity. Another example is the I-beam, a construction beam with a cross section that resembles an uppercase “I.” The I-beam is extremely strong, relative to its own weight, because it has a high “moment of inertia,” a natural phenomenon. By way of contrast, a “perpetual motion” machine does not harness any known laws of nature, but rather violates them. A perpetual motion machine therefore cannot qualify as an invention, and the Patent Office regularly rejects patents for such devices.

The earliest description of a patentable invention by the Supreme Court as something that employs laws of nature for human benefit appears to be in a colorful concurring opinion from the Morse telegraph case of 1853. In his concurrence, Justice Grier described the difference between scientists ("philosophers," as he calls them) and engineers:

> The mere discovery of a new element or law or principle of nature, without any valuable application of it to the arts, is not the subject of a patent. But he who takes this new element or power, as yet useless, from the laboratory of the philosopher and makes it the servant of man; who applies it to the perfecting of a new and useful art or to the improvement of one already known, is the benefactor to whom the patent law tenders its protection.

The first majority opinion taking this view came decades later in the *Telephone Cases* (1888), a consolidated action of numerous suits brought by Alexander Graham Bell for infringement of his patent on the telephone. In upholding his broad fifth claim, the Supreme Court explained that it was valid because it disclosed a method of harnessing a law of nature for human benefit: What made the telephone a patentable invention, said the court, was that *"one of the forces of nature is employed [E]lectricity, left to itself, will not do what is wanted. The [invention] consists in controlling the force as to make it accomplish the purpose."*

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### IV. Tax Strategies Are Not Inventions

A novel tax strategy — whether it “works” under current law or not — cannot be an invention. As explained above, for an innovation to qualify as an invention, it must be human-made and employ or harness a law of nature. But tax strategies do not employ any law of nature to reduce tax liability. Rather, they employ or exploit one or more “laws of man” to achieve that result. Consider for example the SOGRAT method, which is claimed by the first tax-strategy patent issued by the Patent Office. This “estate planning method for mini-

For a consolidated action of numerous suits brought by Alexander Graham Bell for infringement of his patent on the telephone, the Supreme Court explained that it was valid because it disclosed a method of harnessing a law of nature for human benefit: What made the telephone a patentable invention, said the court, was that *"one of the forces of nature is employed [E]lectricity, left to itself, will not do what is wanted. The [invention] consists in controlling the force as to make it accomplish the purpose."*
side the scope of “inventions” patentable under the Patent Act and cannot be patented.52

Endnotes

1. E. Anthony Fig, Keeping Current with the Chair, 24 ABA I PL NEWSLETTER, Summer 2006, at 3.
4. 149 F.3d 1368 (Fed. Cir. 1998).
5. There is one currently pending case that appears to present the question. See Wealth Transfer Group v. Rowe, No. 06 Civ. 24 (D. Conn. filed Jan. 6, 2006).
11. See id. § 100(a) (2005).
12. BALLANTINE’S LAW DICTIONARY.
13. Chakrabarty, supra note 8, at 309.
15. Chakrabarty, supra note 8, at 309 (“The laws of nature...have been held not patentable.”) (collecting Supreme Court cases).
17. Chakrabarty, supra note 8, at 309 (“Einstein could not patent his celebrated law that E = mc²; nor could Newton have patented the law of gravity”).
20. Flook, supra note 16, at 589 (“an algorithm or mathematical formula, is like a law of nature” and, hence, is not patentable).
21. Id. at 590 (“the Pythagorean Theorem would not have been patentable”).
23. Flook, supra note 16, at 593 n.15. See generally Gottschalk v. Benson, 409 U.S. 63, 67 (1972); Le Roy, 55 U.S. 156, 175 (1852) (“A principle, in the abstract, is a fundamental truth; an original cause; a motive; these cannot be patented, as no one can claim in either of them an exclusive right. Nor can an exclusive right exist to a new power, should one be discovered in addition to those already known.”); William M. Landes & Richard A. Posner, The Economic Structure of Intellectual Property Law, 294-333 (2003).
24. Chakrabarty, supra note 8, at 309 (emphasis supplied).
25. See Patent and Trademark Office, Examination Guidelines for Computer-Related Inventions, 61 Fed. Reg. 7478, 7481 (Feb. 28, 1996) (“The subject matter courts have found to be outside the four statutory categories of invention is limited to abstract ideas, laws of nature and natural phenomena”).
26. Diehr, supra note 14, at 175, 187; Funk Bros., supra note 18, at 190 (“if there is to be invention from [the] discovery [of a natural law], it must come from the application of the law to a new and useful end.”); Mackay Radio, supra note 19, at 94 (“While a scientific truth or the mathematical expression of it, is not patentable invention, a novel and useful structure created with the aid of knowledge of scientific truth may be.”); De Forest Radio Co. v. General Electric Co., 83 U.S. 664, 684-85 (1931) (“It is method and device which may be patented and not the scientific explanation of their operation.”); O’Reilly v. Morse, 56 U.S. 62, 132-33 (1853) (opinion of Grier, J.); State Street, 149 F.3d at 1374 (Fed. Cir. 1998) (“a process, machine, manufacture or composition of matter employing a law of nature, natural phenomenon or abstract idea is patentable subject matter even though a law of nature, natural phenomenon or abstract idea would not, by itself, be entitled to such protection”) (collecting Supreme Court cases).
27. See O’Reilly, supra note 26, at 132.
28. Id. at 112.
29. Flook, supra note 16, at 589 (the “line between a patentable ‘process’ and an unpatentable ‘principle’ is not always clear”).
30. Encyclopaedia Britannica defines “science” as the “pursuit of knowledge covering general truths or the operations of fundamental laws.”
31. Encyclopaedia Britannica defines “engineering” as “the application of science to the optimum conversion of the resources of nature to the uses of humankind.”
32. Cf. Gottschalk v. Benson, 409 U.S. 63, 67 (1972) (“Phenomena of nature, though just discovered...are not patentable, as they are the basic tools of scientific...work”).
34. Diehr, supra note 14, at 175, 188 n.11.
35. Of course, any such invention would only be patentable if it were new, useful, nonobvious, not subject to a statutory bar and directed to statutory subject matter.
37. See Tol-O-Matic Inc. v. Proma Product-and Marketing Gesellschaft M.b.H., 945 F.2d 1546, 1552 (Fed. Cir. 1991) (“Section 101 has...been interpreted to exclude devices deemed to be scientifically impossible, such as perpetual motion machines.”).
38. O’Reilly, supra note 26, at 62.
39. Id. at 132-33 (Grier, J., concurring) (emphasis supplied).
40. Dolbear, supra note 33.
41. Bell’s fifth claim read, “(5) The method of and apparatus for transmitting vocal or other sounds telegraphically, as herein described, by causing electrical undulations, similar in form to the vibrations of the air accompanying the said vocal or other sounds, substantially as set forth.” Id. at 1.
42. Dolbear, supra note 33, at 532.
43. 289 U.S. 178 (1933).
44. Id. at 187.
45. 333 U.S. 127, 130 (1948) (One “who discovers a hitherto unknown phenomenon of nature has no claim to a monopoly of it which the law recognizes. If there is to be invention from such a discovery, it must come from the application of the law of nature to a new and useful end.”).
46. 409 U.S. 63, 67 (1972) (quoting Funk Bros., supra note 18, at 130).
47. 450 U.S. 175, 188 n.11 (1981) (quoting Funk Bros., supra note 18, at 130).
e-Bay Effect

(continued from page 21)

able to them. (See 126 S. Ct. at 1840).
79. Id.
82. Id. at *5.
83. Id. at *6.
84. Id.
86. Id.
87. On October 4, 2006, the Federal Circuit reversed the district court’s denial of Echostar’s request for a stay of the permanent injunction. This stay will be in place while the appeal is pending.
88. 2006 WL 2398681, at *5.
89. Id. at *6.
90. Id.
91. Id.
92. Id.
93. Id.
96. Id. at *12.
97. Id. at *9.
98. Id. at *10. Additionally, the court found that since there were no other competing products on the market, but for plaintiff’s and defendants’ products, “[c]ompetition from defendants would likely lead to significant price erosion [for Canon].” Id. Thus, “absent injunctive relief, Canon will continue to lose sales and market share to defendants.” Id. The court also noted that, even if damages could be adequately calculated based on infringing sales, damages relief would likely not be adequate since defendants operations are located in various places throughout the world, and that “attaching assets sufficient to satisfy a money judgment would be exceedingly difficult.” Id.
99. Id. at *11-*12
100. Id. at *12.
102. Id. at *6.
103. Id. at *1. 35 U.S.C. § 284 provides for the award of treble damages in certain cases.
104. Id. at *5.
105. Id.
106. Id.
107. Id. at *6. One wonders whether the district court’s decision denying permanent injunctive relief here would have been different, had Scimed actually been a party to this suit. Since Scimed was actually using the patented technology, perhaps the Court would have been more likely to issue an injunction against Cordis, since the harm to Scimed would have been more easily realized.
109. Id.
110. Id. at *1-*2.
111. Id. at *2.
112. Id.
115. Id. at 10.
117. Id. at *13-*14.
118. Id. at *14.
120. 2006 WL 3000134 at *4.
121. Id.
123. Id. at 4-5.
125. 2006 WL 3446144, at *4.
126. Id. at *5.
127. Id.
128. The Eastern District of Texas is the jurisdiction with the most decisions: 4. (See, z4; Finisar; Paice; and TiVo cases discussed above).
129. See, e.g., z4; Finisar, Paice; and Voda.
130. Note, however, that the district court in TiVo stated that the fact TiVo sought to license their patented technology was not conclusive that no irreparable harm would occur absent an injunction. 2006 WL 2398681 at *6. But see, Paice (where seeking a license contributed to court’s decision to deny injunction).
131. See, e.g., Wald; Telequip; Christiana; TiVo; American Seating; Canon; 3M; Smith & Nephew; and Black & Decker.
132. eBay Inc., 126 S. Ct. at 1840.
133. Id.
134. Id. at 1840-41.
135. Although vacated by the Supreme Court, the Federal Circuit’s opinion in eBay took a much friendlier approach to “patent trolls” seeking injunctive relief, stating that “[i]njunctions are not reserved for patentees who intend to practice their patents, as opposed to those who choose to license.” eBay Inc., 401 F.3d at 1339. Thus, it will be interesting to see how the Federal Circuit deals with the issue of injunctive relief by a “patent troll.”
136. One alternative to injunctive relief is to seek an exclusion order from the International Trade Commission (“ITC”) under section 337 of the Tariff Act. 19 U.S.C. § 1337(d). Exclusion orders operate similar to injunctions by prohibiting the importation into the U.S. of infringing products. Note, however, that an exclusion order cannot protect a patentee whose patent is being infringed solely by actions within the U.S. In addition, the ITC cannot grant monetary damages relief.