Question 2B

I disagree with the idea that there should be a higher utility requirement for receiving a patent on an invention, process, etc. As an initial matter, I do believe that the utility requirement is itself self-enforcing—there would be little value to an inventor to taking the time and expense to get a patent on a device that truly had no utility, and no one would buy a product that had no use, so the inventor would receive no return on that investment.

Beyond that, as noted, I think the additions in other sections that speak to the true value of the invention do a better job of ensuring an invention has value than a higher utility requirement. Changing the bar for utility from “providing some identifiable benefit” (*Juicy Whip v. Orange Bang*) to adding “very substantially to the public good” as proposed here has several potential downfalls that could lead to a lot of meritorious inventions being denied a patent for incredibly subjective reasons, an increase in lengthy patent litigation, and an increase in expensive expert testimony, of whose determinations of credibility will add a burden to the court.

First, we will discuss the problems with a “very substantial” addition to the “public good”. Asking first the Patent Office, then the PTAB, and later the courts to all settle on an objective definition of the incredibly subjective “very substantial” standard would be an exercise in futility. How would one articulate a standard that can be applied fairly to every patent application to establish a utility that is “very substantial?” Progress is not always made in huge leaps and bounds—often times it is made in small increments, with many inventions adding new steps and new pieces to what previously exists. There is a reason that there are patents for useful improvements as well as things that are wholesale “new”. In many fields I feel like requiring a utility to be substantial would bar any patent in that field from ever being issued because there was no giant leap forward from one invention to the next—basically, this standard of utility would be resurrecting the old and abandoned “flash of genius” requirement that was dropped from the novelty analysis.

Secondly, what counts as the “public good?” Who, exactly, is the “public?” If we’re talking about the public at large, then there are a lot of inventions that aide a niche group or industry that would be denied patents because they only benefit a very small section of the public. What if someone makes a new invention that makes life a lot easier for left-handed cross-stitchers? The segment of the “public” that cross-stitches is small, and the percent of that segment that is left-handed is even smaller. Would that bar the patent from being issued, or would it be enough that the invention had a utility for even some small definition of the public? A requirement like that would require a potential patentee to have to invest in serious market and consumer surveying to be able to show a likelihood of adding substantially to the “public good”. This would be akin, I feel, to making a patentee prove a “long-felt need” before there is even a challenge against their patent.

Third, a new, higher utility requirement would lead to increased litigation and costs for both the patentees and the courts. As it stands right now, utility is one of the least litigated of the patent requirements. If a new, higher bar for utility was required, there would be a lot more challenges to patent validity based on whether or not the benefit was “substantial” or not and whether it contributed to the public good. A hearing for that would require a lot of evidence from both sides, potentially including customer surveys and expert witnesses, which would increase the cost of getting a patent and take up the time of the Patent Office and the courts. As
another concern, the breadth of fields that people seek patents in would require there to be a breadth of “experts” called, and asking an adjudicatory body to make decisions on who counts as an expert in the field of, say, the trade of antique silverware-dating, would place another burden on the Patent Office or the Court.

If the fundamental aim of a patent is to promote innovation and reward inventors for their work and their investment of resources, I don’t think that having a higher utility bar is going to accomplish those goals. As the prompt noted, ensuring utility is built into the rest of the patent clauses like safeguards, and I think that’s how it should remain. If an invention truly has no utilitarian value, then there is no harm in getting a patent on it because it’s not going to “embarrass the public” if they aren’t allowed to use it—because no one wants to anyway. If an inventor wants to spend the filing fee and the maintenance fees and come out on the wrong side of every balance of hardships equation, who are we to say no?

(WC: 845)