

# The Exceptional Nature of Method Claims: A Response to Professor Holbrook

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The premise of Timothy Holbrook’s recent article, *Method Patent Exceptionalism*, is that while patent claims to methods may be exceptional, courts have found that exceptionalism in all the wrong doctrinal places.<sup>1</sup> Rather than treating method claims differently where it makes sense—in patentable subject matter determinations—courts have treated these claims differently in the context of infringement, thus creating a tension within patent law jurisprudence.<sup>2</sup> The differences in the treatment of method claims that Holbrook identifies are real and troubling for anyone who subscribes to the view that patent law ought to exhibit at least some meaningful level of consistency and uniformity.

Although I agree with many of Holbrook’s observations and much of his reasoning, the exceptionalism that Holbrook identifies begs the question: *Why* are method patents treated differently, especially by the Federal Circuit which, after all, was created with the aim of promoting uniformity in patent law? In Part I of this response, I place Holbrook’s observations into a broader context in which patent rights are not merely a set of discrete, independent doctrines but instead function as a cohesive whole. Although I agree with Holbrook’s account of courts’ recent struggles with method claims in the

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1. See generally Timothy R. Holbrook, *Method Patent Exceptionalism*, 102 IOWA L. REV. 1001 (2017). As Holbrook does, I use “method” and “process” interchangeably, except when quoting from another source. For consistency, I mainly stick with “method.”

2. See *id.* at 1030–40 (describing inconsistencies in the treatment of sales for method patents); see also *id.* at 1029–52 (describing issues with the treatment of extraterritoriality for method patents).

areas of infringement and novelty, ultimately these doctrines are merely different faces of a single, many-sided die. One of those other faces involves the kinds of subject matter that can even be eligible for a patent.

As Holbrook notes and history confirms, patentable subject matter doctrine is filled with tangles flowing from the doubly-intangible nature of method claims.<sup>3</sup> Back when the boundaries between doctrines were much less sharp, the Supreme Court grappled with method claims, resolving the challenges posed by their slipperiness in a way that modern students of patent law might find analytically deficient.<sup>4</sup> But by the last quarter of the 20th century, patent law doctrine had crystalized into a form that left few outlets for the pressure exerted by method claims on the patent system.<sup>5</sup> In this context, the doctrinal tensions between infringement and anticipation that Holbrook observes emerging in the last few decades are arguably as much a product of historical path dependence as anything else, driven by a feeble patentable subject matter doctrine and robust use of noninfringement as the primary argument for avoiding liability.

In Part II of this response, I challenge Holbrook's argument that there is no legal basis for treating method claims differently for purposes of infringement.<sup>6</sup> Although one might plausibly find a textual linkage in the categories of section 101, one need not rest courts' different treatment of method patents on the statutory text. Rather, there is another source: the claims themselves—in particular, the use of method, process, or similar language to define the scope of the invention. In other words, the difference in treatment of method claims flows less from section 271(a)<sup>7</sup> than from the claim's limitations. Claimed as a method, the claim may only be infringed by actually performing the method—or perhaps by imposing an obligation that the method be performed. Anything else vitiates a limitation of the claim and allows the patent right to extend to something that is not claimed. As Professor Holbrook implicitly acknowledges, the choice of method language is a conscious decision on the part of the claim drafter.<sup>8</sup> Just as with other language in the claim, the decision to claim an invention as a method—as opposed to a manufacture, apparatus, or composition of matter—ought to be given meaning, precisely what Holbrook criticizes the Supreme Court for failing to do.<sup>9</sup>

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3. *Id.* at 1005 (“Patents on inventive methods and processes generally have been controversial. Even back in the 19th century, it was not clear whether such inventions could be or should be patented.”); *id.* at 1003 (“So, the intangibility dynamic is magnified—the intangible patent covers acts that, even in the real world, are fairly intangible.”).

4. *See infra* Part I.A.

5. *See infra* Part I.B.

6. Holbrook, *supra* note 1, at 1052–59.

7. 35 U.S.C. § 271(a) (2015).

8. Holbrook, *supra* note 1, at Part 1058–59.

9. *Id.*

## I. METHOD CLAIMS—OLD AND NEW STRUGGLES

Why is it that the Federal Circuit treated method claims differently in the decisions Holbrook discusses? In this section I offer a partial explanation: Entangled with the inherent intangibility and abstractness of method claims is the legal context in which decisions about their enforcement take place—a legal context that limits and frames the types of viable arguments that advocates may present.

As Holbrook observes, although the doctrinal tensions involving method claims are a relatively recent phenomenon, claims to methods are not new, nor are the problems presented by their inherent intangibility and abstractness.<sup>10</sup> Just as modern commentators have observed issues presented by claims to methods as opposed to other types of inventions, so too did courts and scholars in the 19th century recognize that method claims were different—“exceptional”—in their own ways. Indeed, a major theme of nineteenth century patent law involved the struggle over claims to methods.<sup>11</sup>

Despite recognizing this backdrop, Holbrook sees a difference between the method claims of the 19th century and modern method claims, one rooted in physicality. I am less sure that this distinction matters, at least for purposes of understanding why the jurisprudential tensions arose. Holbrook describes the methods of the 19th century as more closely tied to the physical instantiation of the method than they are today.<sup>12</sup> In contrast with processes from the 19th century, he writes, “[m]ethod claims in the information age are viewed as broad and over-protective.”<sup>13</sup>

While manipulations of data certainly seem much less tangible than factories producing chemicals, and the 19th century was replete with other manifestations of physicality,<sup>14</sup> process claims in the 19th century could be

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10. See *id.* at 1005 (“Even back in the 19th century, it was not clear whether such inventions could be or should be patented. The concern then was that claims to methods were merely claiming the abstract functioning or result of an actual machine. Efforts to patent the method, therefore, represented an effort to patent something beyond the actual invention.” (footnotes omitted)).

11. See, e.g., Jeffrey A. Lefstin, *Inventive Application: A History*, 67 FLA. L. REV. 565, 594–602 (2015) (discussing the conflict in the nineteenth century defining the separation between unpatentable principle and patentable invention for methods).

12. See Holbrook, *supra* note 1, at 1010 (“In the industrial age, though, methods generally related to something concrete and often produced a tangible product. In the modern information age, however, methods and processes often produce only data or information.”).

13. *Id.* at 1011.

14. See 1 WILLIAM C. ROBINSON, *THE LAW OF PATENTS FOR USEFUL INVENTIONS* § 166 (1890) (“[A] plan or theory of action which, if carried into practice, could produce no physical results proceeding directly from the operation of the theory or plan itself, is not an art within the meaning of the Patent Law . . . .”); Christopher A. Cotropia, *Physicalism and Patent Theory*, 69 VAND. L. REV. 1543, 1554–55 (2016) (describing the decrease in importance of physicality for patents in the 19th Century).

just as intangible and abstract as the claims at the heart of modern disputes.<sup>15</sup> For example, although William Robinson's 1890 treatise on patent law viewed method claims as limited by a requirement that they produce physical effects, these types of inventions existed independent of any specific apparatus.<sup>16</sup> Robinson wrote:

While an art cannot be practised except by means of physical agents through which the force is brought in contact with or is directed toward its object, the existence of the art is not dependent on any of the special instruments employed. It is a legal, practical invention in itself. Its essence remains unchanged, whatever variation takes place in its instruments, as long as the acts of which it is composed are properly performed.<sup>17</sup>

Other patent law treatises of the time contained similar pronouncements. The 1895 edition of *Walker on Patents*, for example, explained that "[a] process is not a substance which can be handled. It is seen only by noting its constituent acts as they are being performed."<sup>18</sup>

With their intangibility came disputes over what could be claimed. Jeffrey Lefstin describes the great struggle over method claims as the contest between unpatentable principle and patentable process. "Principles, such as scientific discoveries or laws of nature, were unpatentable because they were mere abstractions."<sup>19</sup> Patentability could reside only in practical application: "But once embodied in a practical application—whether device or process—principles became patentable, although the question of patent scope remained a difficult one."<sup>20</sup> Many of the most famous patent disputes of the 19th century—Morse's telegraph,<sup>21</sup> Bell's telephone,<sup>22</sup> Tilghman's method of manufacturing fats<sup>23</sup>—involved, at their core a method claim raising the

15. See ROBINSON, *supra* note 14, at § 167 ("An Art is Distinct from the Instruments which it Employs: may Employ any Available Instrument.").

16. See *id.*

17. *Id.*

18. ALBERT H. WALKER, TEXT-BOOK OF THE PATENT LAWS OF THE UNITED STATES OF AMERICA § 7 (3d ed. 1895).

19. Lefstin, *supra* note 11, at 609.

20. *Id.* For more sources chronicling this struggle, see CHRISTOPHER BEAUCHAMP, INVENTED BY LAW: ALEXANDER GRAHAM BELL AND THE PATENT THAT CHANGED AMERICA 69–70 (2015); and Joshua D. Sarnoff, *Patent-Eligible Inventions After Bilski: History and Theory*, 63 HASTINGS L.J. 53, 71–77 (2011). See generally Michael Risch, *America's First Patents*, 64 FLA. L. REV. 1279 (2012).

21. U.S. Patent No. RE1117 (issued June 13, 1848).

22. U.S. Patent No. 174,465 (issued Mar. 7, 1876) ("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 sound, substantially as set forth.").

23. U.S. Patent No. 11,766 (issued Oct. 3, 1854) ("The manufacturing of fat acids and glycerine from fatty bodies by the action of water at a high temperature and pressure.").

tension between principle and process.<sup>24</sup> The Supreme Court's 1854 decision in *O'Reilly v. Morse* is illustrative. The heart of the Court's opinion focused on Morse's eighth claim:

I do not propose to limit myself to the specific machinery or parts of machinery described in the foregoing specification and claims, the essence of my invention being the use of the motive power of the electric or galvanic current, which I call "electro-magnetism," however developed, for marking or printing intelligible characters, signs, or letters, at any distances, being a new application of that power of which I claim to be the first inventor or discoverer.<sup>25</sup>

Morse's claim bears many of the hallmarks of a method claim, referring specifically to the "use" of electro-magnetism for "marking or printing" characters at any distance.<sup>26</sup> Arguably, it is broader than a typical method—as the debate between the majority and the dissent illustrates, Morse claims something even beyond a prototypical method: the entire art of telegraphy itself.<sup>27</sup> Ultimately, it is the Court's characterization of the claim as to a principle rather than a process that spells its doom.<sup>28</sup>

Another example of the tension between principle and process is found in *The Telephone Cases*,<sup>29</sup> recently the subject of Christopher Beauchamp's excellent work on Alexander Graham Bell and the telephone.<sup>30</sup> As Beauchamp explains, Bell's key claim during litigation was "Claim 5"—a method claim. That claim read:

5. The method of, and apparatus for, transmitting vocal or other sounds telegraphically, as herein described, by causing electrical

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24. Walker, for example, discusses all of these cases in the section on distinguishing principle from process. See WALKER, *supra* note 18, at 7–8.

25. U.S. Patent No. RE117 (issued June 13, 1848).

26. *Id.*

27. Compare *O'Reilly v. Morse*, 56 U.S. 62, 112 (1853) ("It is impossible to misunderstand the extent of this claim. He claims the exclusive right to every improvement where the motive power is the electric or galvanic current, and the result is the marking or printing intelligible characters, signs, or letters at a distance.") with *id.* at 134–35 (Grier, J. concurring) ("Is it not true, as set forth in this eighth claim of the specification, that the patentee was the first inventor or discoverer of the use or application of electro-magnetism to print and record intelligible characters or letters? . . . If it be in the use of the words 'however developed' that the claim is to be adjudged too broad, then it follows that a person using any other process for the purpose of developing the agent or element of elector-magnetism, than the common one now in use, and described in the patent, may pirate the whole art patented.").

28. *Id.* at 112–13. But see generally Adam Mossoff, *O'Reilly v. Morse*, GEO. MASON L. & ECON. RES. PAPER SERIES, 14–22, 2014, available at [https://papers.ssrn.com/sol3/papers.cfm?abstract\\_id=2448363](https://papers.ssrn.com/sol3/papers.cfm?abstract_id=2448363) (challenging the conventional view of *O'Reilly v. Morse*).

29. "The Telephone Cases" refers to the Supreme Court's decisions on the various litigations involving Bell's patent. These cases fill the entirety of Volume 126 of the United States Reporter. See generally *Dolbear v. American Bell Tel. Molecular Tel. Co.*, 126 U.S. 1 (1888).

30. See BEAUCHAMP, *supra* note 20, at 58–85.

undulations, similar in form to the vibrations of the air accompanying the said vocal or other sound, substantially as set forth.<sup>31</sup>

It was the broad scope offered by the claim over the use of the “undulating current” that allowed the American Telephone and Telegraph Company to establish its early monopoly over telephone services in the United States.<sup>32</sup> Ultimately Bell’s claim was upheld as a claim to a patentable process.<sup>33</sup> Yet another example is that of *Tilghman v. Proctor*, in which the Court specifically rejected limiting Tilghman’s claim to only the method as performed by the apparatus disclosed.<sup>34</sup>

Treatises, too, struggled with the divide between unpatentable principle and patentable process.<sup>35</sup> William Robinson devoted extensive analysis to the quandary posed by method claims in his treatise, calling them “the most Comprehensive of Inventions.”<sup>36</sup> In discussing method claims, Robinson drew upon his distinction between two meanings of “principle” in the context of inventions.<sup>37</sup> “‘Principle,’ in one sense, Means Force,” Robinson announced.<sup>38</sup> “‘Principle,’ in the other sense, Signifies the Idea of Means.”<sup>39</sup> The former is unpatentable, the latter the proper subject of a patent. “One belongs equally to all mankind; the other is the exclusive property of him who has devised it, until it pleases him to give it to the world.”<sup>40</sup> A method—which Robinson referred to as an “art or operation” necessarily involved the concept of means—a force alone was not an art.<sup>41</sup> The inherent abstractness of method claims, Robinson thought, led to confusion over what might be patentable. “This abstract character of an art was the occasion of much difficulty in the earlier development of Patent Law.”<sup>42</sup> Ultimately, Robinson thought the issue

31. U.S. Patent No. 174,465 (issued Mar. 7, 1876).

32. See BEAUCHAMP, *supra* note 20, at 58–85.

33. 126 U.S. 532–34.

34. See *Tilghman v. Proctor*, 102 U.S. 707, 728 (1880) (“Perhaps the process is susceptible of being applied in many modes and by the use of many forms of apparatus. The inventor is not bound to describe them all in order to secure to himself the exclusive right to the process, if he is really its inventor or discoverer.”); Jason Rantanen, *The Doctrinal Structure of Patent Law’s Enablement Requirement*, 69 VAND. L. REV. 1679, 1691–92 (2016) (explaining the history of and comparative breadth of the claims at issue in *Tilghman v. Proctor*).

35. See WALKER, *supra* note 20, at § 7 (“Whether a given patent is one for a process or one for a principle is a question upon which its validity may wholly depend.”).

36. ROBINSON, *supra* note 14, at § 164.

37. *Id.* at §§ 133–41.

38. *Id.* at § 135.

39. *Id.* at § 139.

40. *Id.* at § 139.

41. *Id.* at § 159 (defining “art or operation” as “an act or series of acts performed by some physical agent upon some physical object, and producing in such object some change either of character or of condition”). “It is also called a ‘process,’ or a ‘mode of treatment.’” *Id.*

42. *Id.* at § 160.

resolved through the distinction between ends and means, force and *modus operandi*—and, in a view akin to Professor Holbrook’s observation, a requirement that some physical effects be produced.<sup>43</sup>

This history suggests that Holbrook’s observation that “what’s old is new again,”<sup>44</sup> is truer than he suggests. Method claims have long been understood to be exceptional; to be of a different sort than claims to machines, manufactures, or compositions of matter. It was precisely because of their intrinsic characteristics—the “fleeting acts or steps” as Holbrook describes them—that method claiming in the 19th century was both so potent and so controversial.<sup>45</sup> The underlying difference between present concerns over method patents and those of the 19th century is less than one might suspect.

What is different is how courts addressed the inherent tension posed by method claims. This difference supports a narrative of historical path dependence that ultimately led to the doctrinal tensions that Holbrook identifies and presents a cautionary tale for changes to the patent law that fail to take account of the pressures exerted by method claims.

The first part of the narrative involves the doctrinal approach to method claims in the second half of the 19th century. Surrounding the decisions identified above was a robust decades-long conversation about principles versus processes that allowed for the flexible containment of issues arising from the nature of method claims.<sup>46</sup> Indeed, flexibility as opposed to doctrinal clarity, characterized much of 19th century patent jurisprudence.<sup>47</sup> Patentable subject matter was not a formal doctrine for litigation purposes in the way that it has come to be treated in patent law over the last half-century. Rather, it was part and parcel of the construction of a patent claim,<sup>48</sup> an integrated part of the many-sided die that made up patent law rather than a standalone, independent requirement.

In contrast, patent law during the second half of the 20th century was characterized by crystallization through doctrinal clarity and differentiation. In his excellent article about the changes wrought by the Court of Customs and Patent Appeals, Jeffrey Lefstin described the court’s approach to substantive patent law, especially doctrines related to patent disclosure and scope: “Starting in the 1960s, the CCPA began to impose the order we recognize today upon this heterogeneous collection of ‘undue breadth’ doctrines. The techniques it used were again statutory fidelity and conceptual

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43. *Id.* at § 166 (“An Art must Produce Physical Effects.”).

44. Holbrook, *supra* note 1, at 1006.

45. Holbrook, *supra* note 1, at 1010.

46. See Lefstin, *supra* note 11, at 593–609 (discussing method patents and their breadth); *supra* notes 27–33 and accompanying text.

47. See generally Jeffrey A. Lefstin, *The Constitution of Patent Law: The Court of Customs and Patent Appeals and the Shape of the Federal Circuit’s Jurisprudence*, 43 LOY. L.A. L. REV. 843 (2009).

48. *Id.* at 851.

differentiation.”<sup>49</sup> Doctrines became clearer, more differentiated, and issues such as claim scope were not permitted to bleed over into areas such as utility.<sup>50</sup> With this doctrinal crystallization, arguments about lack of patentability necessarily needed to be placed into a discrete doctrinal box to succeed.

Even as patent law doctrines crystallized, patentable subject matter was largely relegated to the doctrinal dustbin. The Federal Circuit took the Supreme Court’s invitation in *Diamond v. Chakrabarty* to permit the gradual relaxation of constraints imposed by § 101. Anything under the sun that was made by man was patentable.<sup>51</sup> Through successive decisions, challenges based on patentable subject matter were rejected, causing one 2008 hornbook to observe, “The tale of the modern application of § 101 is one of uncertainty, debate, and (especially) gradually receding importance . . . the actual application of § 101 in the modern patent law is rather rare.”<sup>52</sup> The high water mark of the rejection of challenges based on a lack of patentable subject matter came after the Federal Circuit’s 1998 decision in *State Street Bank and Trust v. Signature Financial Group, Inc.*, when the court observed, “The question of whether a claim encompasses statutory subject matter should not focus on *which* of the four categories of subject matter a claim is directed to—process, machine, manufacture, or composition of matter—but rather on the essential characteristics of the subject matter, in particular, its practical utility” in concluding that “the transformation of data, representing discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price” was patent eligible subject matter.<sup>53</sup> In short, accused infringers were not winning on subject matter challenges.<sup>54</sup> Placed in this historical context, the doctrinal developments Holbrook identifies make sense. As Holbrook recognizes, claims to methods *are* exceptional—or at least, very different from claims to machines, manufactures, and compositions of matter.<sup>55</sup> Without the flexibility of a

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49. *Id.* at 866.

50. *Id.* at 881–82.

51. See *Diamond v. Chakrabarty*, 447 U.S. 303, 309 (1980) (citing Congressional reports).

52. CRAIG ALLEN NARD AND R. POLK WAGNER, *PATENT LAW* 122 (2008).

53. *State St. Bank & Trust, Co. v. Signature Fin. Grp., Inc.*, 149 F.3d 1368, 1373, 1375 (Fed. Cir. 1998) (emphasis in original).

54. See ROGER E. SCHECTER AND JOHN R. THOMAS, *INTELLECTUAL PROPERTY: THE LAW OF COPYRIGHTS, PATENTS AND TRADEMARKS* 292 (2003) (“In recent years, however, the patent system has demonstrated an increasing permissiveness towards patentable subject matter. In particular, the Federal Circuit has steadily dismantled earlier prohibitions upon patent eligibility, ranging from computer software, to printed matter, to methods of doing business. . . . The present state of affairs suggests that few, if any restrictions limit the range of patentable subject matter. . . . It is hardly an exaggeration to say that under current law, if you can name it, you can claim it.”).

55. Holbrook, *supra* note 1, at 7; see also ROBERT C. FABER, *FABER ON MECHANICS OF PATENT CLAIM DRAFTING*, 4-1 to 4-49 (7th ed. 2016) (containing a separate chapter on writing process claims).



meaningful patentable subject matter doctrine to relieve some of the pressure arising from their inherent intangibility and abstractness, accused infringers turned to alternate arguments to avoid liability. And given the exceptional nature of method claims, those alternate arguments found purchase in different forms.

Consider, for example, the Federal Circuit's analysis of the "sell," "offer to sell," and "import" issue in *NTP v. Research in Motion*.<sup>56</sup> The court's struggle with the issue of infringement is palpable—and is a direct response to the elusive nature of method claims.<sup>57</sup> Here, RIM employed the action-based structure of the method claims as the basis for its argument that its conduct—the sale of or offer to sell handheld devices—could not constitute infringement of the method itself. Despite the court's eventual narrow holding that such sales did not constitute infringement, its analysis focused almost exclusively on the question of how a method invention might be "sold" or "offered for sale" given its intangible nature.<sup>58</sup>

Since parties present disputes, and courts resolve those disputes, the framing of the dispute in terms of infringement limited the Federal Circuit's doctrinal choices.<sup>59</sup> In other words, the treatment of method claims as "exceptional" for purposes of infringement determinations flowed directly from litigants' presentation of the dispute in terms of infringement. Within those choices, the court was forced to decide. In a counterfactual world, one in which patentable subject matter remained a viable doctrine, it is entirely possible that such disputes would have been resolved in a much more integrated way—similar to disputes over processes in the 19th century. That said, the Federal Circuit need not have resolved the dispute the way that it did; it might have concluded that a method *could* be sold. And yet, such a conclusion was apparently difficult for the court to stomach.

Furthermore, from an institutional perspective, at the time *NTP v. RIM* was decided, the Federal Circuit did not favor patentable subject matter as a doctrinal pathway to limit patents, process or otherwise. Although courts are limited by the issues brought before them, the Federal Circuit is widely considered to be driven by institutional forces at some level.<sup>60</sup> If nothing else, *State Street Bank* tells us that the Federal Circuit did not put much weight on patentable subject matter as a meaningful constraint on patents.

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56. *NTP, Inc. v. Research in Motion, Ltd.*, 418 F.3d 1282, 1315 (Fed. Cir. 2005); *see also* Holbrook, *supra* note 2, at 1033–34 (discussing *NTP, Inc.*).

57. *NTP, Inc.*, 418 F.3d at 1319.

58. *Id.* at 1320.

59. *See* In re City of Houston, 731 F.3d 1326, 1335 (Fed. Cir. 2013) ("[W]e decide the case that is before us."); *Atl. Thermoplastics Co. v. Faytex Corp.*, 974 F.2d 1279, 1299 (Fed. Cir. 1992) (Rich, J. dissenting) ("Our task is to decide actual cases that come before us, not to broadly settle issues that aren't before us.").

60. *See generally* Rochelle C. Dreyfuss, *Percolation, Uniformity, and Coherent Adjudication: The Federal Circuit Experience*, 66 SMU L. REV. 505 (2013) (discussing ideological pressures within the Federal Circuit).

The core idea here is that method claims impose a certain amount of *pressure* on the patent system due to their inherent intangibility and abstractness. The doctrinal points that Holbrook identifies may simply have been the most convenient paths for relieving that pressure. By embracing an extremely limited role for the patentable subject matter doctrine, the Federal Circuit was necessarily forced to deal with the consequences of its decision—like squeezing a water-filled balloon, one part bulges out as another part is constricted.<sup>61</sup> It may or may not burst.

## II. CLAIMING METHODS

Holbrook's primary legal objection to the Federal Circuit's current treatment of method claims is that it no basis in the statute.<sup>62</sup> As Holbrook notes somewhat ironically, in the one place where that courts should be treating method claims differently yet do not—patentable subject matter—the statute provides a reasonable textual hook: the four categories identified in § 101, one of which is “process.”<sup>63</sup>

In my view, Holbrook is right that courts have moved too far away from the categories identified in section 101. Instead, the current analytical framework involves asking only whether a given claim survives the *Mayo/Alice* analysis.<sup>64</sup> As numerous commentators have pointed out, however, the *Mayo/Alice* framework suffers from serious problems, and while it may be a necessary last resort in resolving patentable subject matter disputes at the margin, it is ill-suited for resolving the vast majority of patentable subject matter questions.<sup>65</sup> Is a utility patent available for a new, nonobvious, and useful book about the way a neuron works? Of course not—we don't need the *Mayo/Alice* framework to tell us that.<sup>66</sup> Is a new type of plow patentable subject matter? Of course—and we don't need the *Mayo/Alice* framework to tell us that either.

A better approach might be to shed the insistence that patentable subject matter is limitless and instead acknowledge that patents do not apply to all human creations. We might do this by applying some meaningful interpretations of the section 101 categories that recognize patent law's historical anchor to technological advancements. This acknowledgement

61. See generally Mark A. Lemley, *The Surprising Resilience of the Patent System*, 95 TEX. L. REV. 1 (2016) (describing the resilience of the patent system to changes in case law).

62. Holbrook, *supra* note 1, at 1031–49.

63. 35 U.S.C. § 101 (2015).

64. See Holbrook, *supra* note 1, at 1049–52. But see Interim Guidance on Patent Subject Matter Eligibility, 79 Fed. Reg. 74,618, 74,621 (Dec. 16, 2014) (indicating that step 1 is to determine whether the claimed invention is in a statutory category).

65. See Brief of Professors Jeffrey A. Lefstin and Peter S. Menell as *Amici Curiae* in Support of Petition for a Writ of Certiorari at 15, *Sequenom, Inc. v. Ariosa Diagnostics, Inc.*, 136 S. Ct. 2511 (2016) (stating that *Mayo* is a flawed framework to determine patentable subject matter).

66. Although arguable we may need the printed matter doctrine. See generally Kevin Emerson Collins, *Semiotics 101: Taking the Printed Matter Doctrine Seriously*, 85 INDIANA L.J. 1139 (2010).

would align better with traditional views of the types of subject matter that one can obtain a patent on better than the current “*Mayo* or bust” approach.<sup>67</sup>

Yet, while I agree with Holbrook that the patentable subject matter analysis should primarily revolve around the four enumerated categories in § 101, I want to offer an alternative possible basis for the distinction that the courts have drawn between method claims and claims to machines, manufactures, and compositions of matter: the claims themselves.

In other words, perhaps method claims can legitimately be treated differently not because of any statutory pronouncements to that effect, but because of the words of the claims themselves. By choosing to claim an invention in the language of methods, rather than through other verbiage, the claim drafter has selected the consequences that flow from employing such limitations, both those that are advantageous and those that are not.<sup>68</sup> Viewed in this way, claiming a method rather than a machine, manufacture, or composition of matter is just another limitation. And just as with other limitations, the consequence of this choice is to limit the circumstances in which the claim will be infringed. By claiming a method, the drafter is forgoing infringement by conduct consisting merely of the making, offering for sale, selling or importing a device that performs the method—only actual performance—or perhaps a clear obligation of actual performance—of the method meets all the limitations of the claim. It is not enough that the method *might* be performed at some future date, or even is actually performed by another person—each and every limitation must actually be met.

Section 271 (a) lists a series of acts that must be performed for an accused party to be considered an infringer. It states:

Except as otherwise provided in this title, whoever without authority makes, uses, offers to sell, or sells any patented invention, within the United States or imports into the United States any patented invention during the term of the patent therefor, infringes the patent.<sup>69</sup>

But it is not enough that one of these acts occur. Rather, the act must involve the “patented invention.”<sup>70</sup> Indeed, Holbrook’s focus on the *act* rather than whether all the limitations of the claim are met may seem somewhat

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67. See Holbrook, *supra* note 1, at 1050 (“Prior to the recent onslaught of Supreme Court cases dealing with section 101, the Supreme Court was always careful to place an invention into one of the categories.”). See generally FABER, *supra* note 55 (containing separate chapters on each of the four enumerated subject matters).

68. Advantages of using method claims include: (1) avoiding ties to a particular apparatus or mechanism that performs that method, see *Tilghman v. Proctor*, 102 U.S. 707, 734 (1880); (2) avoiding application of the marking statute, see Holbrook, *supra* note 1, at 1030–31; and (3) avoiding the need to tie the steps of the method to particular aspects of drawings, as contrasted with apparatus claims, see FABER, *supra* note 55, at §§ 4:5, 10:3.

69. 35 U.S.C. § 271(a) (2015).

70. *Id.*

surprising to modern patent litigators, where the name of the game is supposedly the claim.<sup>71</sup> Most contemporary patent cases turn on whether all the limitations of the claim are met, rather than on the performance of a particular act.<sup>72</sup> Claim construction has come to dominate the infringement analysis.<sup>73</sup>

Viewed in terms of the requirements of a claim, the Federal Circuit's outcomes, if not its analyses, makes more sense. While liability may be possible when an infringer makes, uses, offers for sale, sells or imports a claimed invention, if the invention is claimed in such a way that its limitations are only met when the invention is actually put into operation—i.e., some performance of the steps of a method—then offering for sale or selling the patent invention must be tightly limited to only circumstances involving the mandatory performance of those steps by the commercial transaction or offer itself. This result arises not solely as a statutory requirement of infringement but instead from a combination of the statute and the restrictions imposed by the claims themselves.

Consider the claim at issue in *NTP v. RIM* that Holbrook focuses on. It is framed in terms of acts that, when performed, constitute the invention:

A method for transmitting originated information from one of a plurality of originating processors in an electronic mail system to at least one of a plurality of destination processors in the electronic mail system comprising: transmitting the originated information originating from the one of the plurality of originating processors to

71. I am paraphrasing Giles Rich's famous quotation. Giles S. Rich, *The Extent of the Protection and Interpretation of Claims—American Perspectives*, 21 INT'L REV. INDUS. PROP. & COPYRIGHT L. 497, 499 (1990) ("To coin a phrase, the name of the game is the claim.").

72. Cf. *NTP, Inc. v. Research in Motion, Ltd.*, 418 F.3d 1282, 1313 (Fed. Cir. 2005) ("Ordinarily, whether an infringing activity under section 271 (a) occurs within the United States can be determined without difficulty."). Empirical data on the number of patent cases involving controversies over the type of act as opposed to whether all the limitations of a claim are met would be desirable to confirm this point; unfortunately, such data does not presently exist. See Lee Petherbridge & Jason Rantanen, *Infringement*, in 2 RESEARCH HANDBOOK ON THE ECONOMICS OF INTELLECTUAL PROPERTY LAW: ANALYTICAL METHODS (Peter S. Menell, Ben Depoorter & David L. Schwartz, eds., forthcoming 2017); Christopher Beauchamp, *Notable Lacunae*, 20 GREEN BAG 2D 79 (forthcoming 2017).

73. See Janet Freilich, *The Uniform Topography of Patent Scope*, 19 STAN. TECH. L. REV. 150, 151 (2015) ("Setting and ascertaining patent scope are among the most important questions in patent law."); John M. Golden, *Constructing Patent Claims According to Their "Interpretive Community": A Call for an Attorney-Plus-Artisan Perspective*, 21 HARV. J.L. & TECH. 321, 322 (2008) ("Determination of the scope of a patented invention is one of the most contentious and difficult tasks of modern patent law."); Kimberly A. Moore, *Are District Court Judges Equipped to Resolve Patent Cases?*, 15 HARV. J.L. & TECH. 1, 8 (2001) ("Determining the scope of the patent claims is the most important issue in a patent infringement suit."). That said, the "act" requirements of section 271 are more important than this focus on the claims might suggest, as Holbrook's article illustrates. See also *Transocean Offshore Deepwater Drilling, Inc. v. Maersk Drilling USA, Inc.*, 699 F.3d 1340, 1356–57 (Fed. Cir. 2012) (addressing whether Maersk offered for sale or sold an infringing rig).

a gateway switch within the electronic mail system; transmitting the originated information from the gateway switch to an interface switch; transmitting the originated information received from the gateway switch from the interface switch to a RF information transmission network . . . .<sup>74</sup>

Practicing this invention requires the performance of each of these steps. If one is to be liable for “selling” or “offering for sale” the claimed method, then, that transaction itself must actually require the performance of the claimed steps. This is, ultimately, the trade-off for the scope that a method patent provides.<sup>75</sup> If the steps are not, and will not as a matter of transactional obligation, be performed, there has been no direct infringement.<sup>76</sup>

A claim-based approach fits more readily with the outcome of the cases Holbrook discusses than one resting on an interpretation of the statute. Although one reading of *NTP v. RIM* is that RIM did not “sell,” “offer to sell,” or “import” based on the court’s interpretation of section 271(a),<sup>77</sup> that interpretation is difficult to square with the court’s direct pronouncement that “we need not and do not hold that method claims may not be infringed under the ‘sells’ and ‘offers to sell’ prongs of section 271(a).”<sup>78</sup> Instead, the court reached a fact-specific outcome: “[W]e conclude only that RIM’s performance of at least some of the recited steps of the asserted method claims as a service for its customers cannot be considered to be selling or offering to sell the invention covered by the asserted method claims.”<sup>79</sup>

The second case discussed by Holbrook, *Ricoh Co., Lt. v. Quanta Computer Inc.*, resulted in a similarly limited holding, this time resting on the idea “that a party that sells or offers to sell software containing instructions to perform a patented method does not infringe the patent under § 271(a).”<sup>80</sup> In both cases, the critical piece that was missing was an actual requirement that the steps of the method be performed.

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74. U.S. Patent No. 5,436,960 (issued July 25, 1995).

75. See FABER, *supra* note 55, at § 10:3 (“A method claim is particularly valuable because it is not usually tied to a particular structure for accomplishing its objective. As a technical art evolves, new products and hardware are developed. But a basic method continues to be used, and new product technology may continue to perform the patented method long after the product disclosed and perhaps also claimed in the product has been superseded.”).

76. As Holbrook acknowledges, indirect infringement remains a possibility.

77. See *NTP, Inc.*, 418 F.3d at 1318 (“The cases cited by RIM are concerned primarily with the ‘use’ and ‘make’ prongs of section 271(a) and do not directly address the issue of whether a method claim may be infringed by selling or offering to sell within the meaning of section 271(a).”); see also Holbrook, *supra* note 1, at 1034 (recognizing the fact-specific nature of the court’s holding but observing that the totality of the discussion “strongly suggests, though, that the court believes the method claims can only be infringed by use and not by offers to sell”).

78. *NTP, Inc.*, 418 F.3d at 1320–21.

79. *Id.* at 1321.

80. *Ricoh Co. v. Quanta Computer Inc.*, 550 F.3d 1325, 1335 (Fed. Cir. 2008).

Focusing on the claim language to limit the circumstances under which a method may give rise to liability under section 271(a) fits well with the purpose of claims. As part of the claim “particularly pointing out and distinctly claiming the subject matter which the inventor or a joint inventor regards as the invention,” this language has legal meaning.<sup>81</sup> As with any limitation in the claim, it ought not be ignored—“vitiating” a claim, in the language of patent law, is a cardinal sin.<sup>82</sup> Of course, often this language appears in the preamble, which poses a particular challenge for construing patent claims.<sup>83</sup> But even if one sets aside the preamble, the nature of a method claim permeates the entire claim. Method claims are necessarily written using verbal phrases—typically in gerund form—since they are, after all, describing a series of actions to accomplish a particular goal.<sup>84</sup> Holbrook’s example of a method of swinging is illustrative: each step involves the performance of an action, indicated by a verb: “suspending,” “positioning,” “having the user pull,” “repeating.”<sup>85</sup>

Any other reading of that claim to encompass conduct other than the performance of the method, or an obligation of performance of the specific steps of the method, would vitiate the limitation of the claim to a method by allowing the claim to extend to other, unclaimed, subject matter. For example, consider Holbrook’s proposal that making or selling a machine whose only purpose would be to perform the claimed method would directly infringe a method claim.<sup>86</sup> The method would not actually be performed as required by the claim. Nor would there be an obligation on the part of the

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81. 35 U.S.C. § 112 (2015).

82. See *Freedman Seating Co. v. American Seating Co.*, 420 F.3d 1350, 1358 (Fed. Cir. 2005) (“Of relevance to this case is the ‘all limitations’ rule. The rule holds that an accused product or process is not infringing unless it contains each limitation of the claim, either literally or by an equivalent.” (footnote omitted)).

83. See, e.g., *Am. Med. Sys., Inc. v. Biolitec, Inc.*, 618 F.3d 1354, 1363 (Fed. Cir. 2010) (Dyk, J., dissenting) (“As a result of the lack of clarity as to whether a preamble should be construed as limiting, our case law has become rife with inconsistency, both in result and in the articulation of the test.”); Preamble May Be Given Effect, ANNOTATED PATENT DIGEST (MATTHEWS), ch. 5, § 24 (discussing cases addressing the issue of whether a claim’s preamble is a limitation); Kirk M. Hartung, *Claim Preambles: Unnecessary Matters of Change and Confusion*, 93 J. PAT. & TRADEMARK OFF. SOC’Y 330 (2011) (discussing conflicts among the cases addressing the construction of claim preambles).

84. FABER, *supra* note 55, at § 4.2 (“[I]t must be remembered that the elements of a method claim are method *steps* which should usually be verbal (gerundial) phrases, introduced by a gerund or verbal noun (the “ing” form of a verb). . . .”). A “gerund” is “any of several linguistic forms analogous to the Latin gerund in languages other than Latin; especially: the English verbal noun ending in -ing that has the function of a substantive and at the same time shows the verbal features of tense, voice, and capacity to take adverbial qualifiers and to govern objects.” WEBSTER’S NINTH NEW COLLEGIATE DICTIONARY (1990).

85. Holbrook, *supra* note 1, at 1004 (quoting U.S. Patent No. 6,368,227).

86. *Id.* at 1052–53.

buyer or maker to perform the method.<sup>87</sup> There is thus no direct infringement of the claims because the claim is only to the method, not the means for carrying out that method. Allowing “almost performance” to equate to performance would be to ignore the limitations of the claim itself.

Furthermore, concluding that making, or selling, or importing such a machine during the life of the method patent constitutes infringement of the patent would give the patent owner a claim over the machine itself—something that may or may not actually be patentable. Indeed, if the patent owner had desired such a claim, it should have sought it.<sup>88</sup> If it had, the claim to the apparatus would have been subjected to examination, and its compliance with the requirements of patentability determined.<sup>89</sup> To the extent that liability does not exist in a given factual scenario in which a method claim might be infringed in the future, once the machine is turned on, that is properly the subject of contributory and inducement-based infringement analysis.<sup>90</sup>

It might be different if patent drafters operated in a world in which claim language was given little weight. But that is not how patent law operates today. Claim drafters understand that their linguistic choices *matter*—that choosing particular words, or drafting in a particular form has consequences. Vast resources are invested in battles over the meaning of individual words or phrases in patent claims. Indeed, patent attorneys and agents, perhaps more than anyone else, are versed in the consequences of linguistic choices—in “Markush” expressions<sup>91</sup> and means-plus-function claim elements and more.<sup>92</sup> The choice between a process claim and other types of claims is one that

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87. As one hypothetical, consider a situation in which a machine whose only purpose is to perform a claimed method is sold on the day before the patent expires. It is entirely plausible that the machine will not be put into operation until the patent actually expires.

88. *Cf. id.* at 1061 (recognizing that “for some method claims, an applicant may be able to draft attendant apparatus or system claims that provide the sort of protection this proposal would afford” but contending that “applicants should not have to jump through drafting hoops merely to give themselves a certain form of protection unavailable to process and method claims”). This may be true, but it should also be recognized that these claims are literally to a different thing: the machine or system rather than to the process. Patent holders should not be entitled to that which they have not claimed.

89. In particular, it is conceivable that a method might be adequately disclosed by the inventor, but a given apparatus might not.

90. As I have argued elsewhere, I am hesitant about indirect infringement theories that dispense with any requirement of fault. *See generally* Jason A. Rantanen, *An Objective View of Fault in Patent Infringement*, 60 AM. U. L. REV. 1575 (2011). However, use of causal responsibility principles might be enough. *See generally* Dmitry Karshedt, *Causal Responsibility and Patent Infringement*, 70 VAND. L. REV. 565 (2017) (describing a theory of casual responsibility in the context of divided infringement problems).

91. *See* FABER, *supra* note 55, at § 6:2 (“Markush” Expressions)

92. *See id.* at 3:29 (“Means” or “Step” Clauses).

should be even more obvious than whether to use “comprising” or “consisting of” in the transition between preamble and claim body.<sup>93</sup>

Ultimately, rather than looking to the statute to differentiate between infringement of method claims and infringement of other types of claims, courts need only look to the claim language itself. At the end of the day, the only type of conduct that makes sense to infringe a method claim is performance of that method.

While approaching the distinction between method claims and other types of claims through the language of the claims themselves may address Holbrook’s statutory argument, it does less to diffuse the tension between an invention being “on sale” for purposes of prior art, but not “offered for sale” or “sold” for purposes of infringement. Or, for that matter, the other issues Holbrook identifies, particularly in the exhaustion context. And yet, the tension Holbrook identifies may be more theoretical than real. After all, the cases in which liability turns on whether a method was sold or offered for sale for purposes of the section 102 analysis appear to be relatively rare.<sup>94</sup> And under the post-America Invents Act version of the novelty provision, 35 U.S.C. section 102, the circumstances under which an invention may be “on sale” may be narrowed so as to fully relieve the tension.<sup>95</sup> In any event, the contours of section 102 have never matched up perfectly with section 271(a). For example, simply describing an invention in a printed publication can be enough to render it anticipated through section 102 even though such conduct would not give rise to liability under section 271(a).

### III. CONCLUDING THOUGHTS

In the end, Holbrook’s description of method claims and the unique legal issues that surround them, particularly in the context of patent infringement determinations, is a valuable contribution to the literature. Much of the existing work addressing method claims exists only in the context of claim drafting and patent prosecution rather than the analysis of these claims when assessing infringement and validity. But, as Holbrook explains, method claims are subject to different legal rules once they are granted. That, more than anything else, is an important point that lawyers, teachers, judges,

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93. *Id.* at §§ 2:5, 2:6. “Comprising” is an open-ended term that means “including the following elements but not excluding others.” *Id.* at § 2:5. “Consisting of” is a closed-ended term that means “having the recited elements, and no more or no less.” *Id.* at § 2:6.

94. *See* Holbrook, *supra* note 1, at 1035–41 (identifying cases involving processes being “on sale”).

95. *See* Robert A. Armitage, *Understanding the America Invents Act and Its Implications for Patenting*, 40 AIPLA Q. J. 1, 53–57 (2012) (arguing the AIA does not “allow secret uses or secret offers for sale or other secret or private acts, unavailable to the public, to impact patentability”); Joe Matal, *A Guide to the Legislative History of the America Invents Act: Part I of II*, 21 FED. CIR. B.J. 435, 450 (2012) (arguing that the legislative history of the AIA should be read to exclude secret commercial uses). *But see* Mark A. Lemley, *Does “Public Use” Mean the Same Thing It Did Last Year?*, 93 TEX. L. REV. 1119, 1121–22 (2015) (arguing that it is unlikely Congress intended to limit the “on sale” bar).



and especially commentators should keep in mind when discussing and applying patent law.