Is Information Patentable?

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This Article explores the question of whether information can and should be patentable. Patent law has seemed traditionally to limit protection to four basic areas of subject matter: processes, machines, articles of manufacture, and compositions of matter, all of which are limited to tangible products and processes. Although many cases have used the word "tangible" in defining the boundaries of patentable subject matter, neither the language of the statute nor judicial decisions have explicitly excluded "information" from patent protection. Arguably, such a limitation is implicit both in prior judicial decisions stating that the patent system protects practical applications rather than fundamental new insights about the natural world and in cases holding that "printed matter" is ineligible for patent protection. The exclusion of information itself from patent protection is also at least implicit in the statutory requirement that patent applicants make full disclosures of information about their inventions, with no restrictions upon public access to the disclosures once the patent issues.

Advances in information technology have thus challenged the traditional rules, especially with regard to protection for processes. Indeed, many patent applications and issued patents appear to protect information per se in many areas, such as software, business methods, education, genetics, and most recently even in storyline. For example, the patent application at issue in In re Lundgren seemed to protect ideas concerning shifting of physical assets to a manager. Likewise, numerous pending patent applications aim to protect not the copyrightable expression of a unique underlying storyline, but the storyline itself -- in the form of either the process necessary to implement the unique fictional plot in an entertainment medium, or in terms of the medium itself, something that would have not been copyrightable under the "scenes a faire" doctrine. Most notably, the USPTO in its 1996's "Examination Guidelines for Computer-Related Inventions" and most recently in its 2005 "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" has also suggested that under certain circumstances compilations of data and databases can be patentable when they bear a functional relationship to the medium on which they are stored.

This Article therefore attempts to address the question of whether information can or should be protected under patent law. This Article explores this issue from a few major angles. First, it explores the historical treatment of information, arguing that information has never been protected under patent law. The Article further shows that, although developments in information technology encouraged courts to treat information as a tangible thing that has physical existence, the courts have always been uneasy with such a characterization. Second, the Article thoroughly examines the implications of patenting information, arguing that such protection represents a fundamental departure from the traditional patent bargain that has always called for free disclosure of information to the public at the outset of the patent term in exchange for exclusionary rights in particular tangible applications. Additionally, it points to First Amendments concerns, suggesting that unlike copyright law, the patent law system lacks built-in mechanisms, such as the

fair use exception and research exception, that guarantee free speech under certain circumstances. It also examines the possible economic implications of such a move, arguing that protecting information per se introduces significant transactions costs and significantly impedes progress in the "Useful Arts."