

CONTENT BASED RESTRICTIONS ON ELIGIBILITY FOR INTELLECTUAL PROPERTY PROTECTION AND THE FIRST AMENDMENT

Abstract

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Restricting the subject matter of intellectual property protection places a disincentive on expression. Content based denials of trademark protection restrict the ability to choose which words will uniquely identify and distinguish a product or service. When a restriction is made on patentable subject matter, an invention that would have been disclosed in a patent generally remains a trade secret. Without copyright protection, authors are unable to control the reproduction or distribution of their works. These types of restrictions traditionally have not been subject to First Amendment scrutiny.

While copyright protection currently encompasses subject matter broader than that covered by the First Amendment, such as obscene works, content based limitations on trademark and patent eligibility are the subject of fierce debate. Disputes over whether the term “Redskins” should be entitled to trademark protection have spanned almost two decades. Congress is currently considering whether to exclude inventions that affect tax liability from the scope of patent protection; the courts are reviewing whether business methods and signals are patentable subject matter; the Patent Office has stated it will reject patent applications where the claimed invention encompasses a human being.

The Federal Circuit has held that the denial of trademark protection does not raise First Amendment concerns because the non-trademarked indicator can still be used, though without protection for its exclusive identification function. Although scholars have often considered whether the enforcement of intellectual property violates the First Amendment, courts and commentators appear to have overlooked whether the First Amendment applies to restrictions on eligibility for patent protection. Similar to the rationale regarding the ability to use a non-trademarked indicator, perhaps the First Amendment has not been considered in the patent context because any invention not disclosed in a patent could nevertheless be published, although absent protection for the invention itself.

Placing a financial disincentive on expression often triggers a First Amendment analysis, even where the speech could be expressed in other, less favorable ways. Courts have found that laws charging a higher postal rate or tax for certain types of magazines, based on their content, required a First Amendment analysis. A law requiring placement of income from accused or convicted criminals’ descriptions of their crimes into escrow for victim compensation also raised First Amendment scrutiny. While the publications in

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these examples still could have been mailed and sold, the financial disincentive on speech raised First Amendment concerns.

In this Article, I explore whether content based restrictions on eligibility for trademarks and patents should be subject to a First Amendment analysis. Content based denials of trademark protection restrict which words may be chosen for unique identification of a product or service. Trademarks also have a consumer protection function, aiming to prevent confusion as to source or association. The patent system provides incentives for innovation and encourages the public disclosure of inventions. While recognizing deficiencies in the disclosure function of patents, restrictions on the scope of patentable subject matter not only deprive the speaker of the ability to disclose an invention with protection, but also deny the advantages of disclosure to the public. Content based restrictions on patent protection, however, also reflect a decision about the types of inventions that are worth the limited monopoly that the patent grant provides, regardless of their disclosure.

I also discuss how applying First Amendment scrutiny to restrictions on intellectual property eligibility might end up harming speech, given that patents lack even minimal First Amendment protections, such as copyright's fair use exception and idea-expression dichotomy.