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# Deceptive Patents: Deconstructing Juicy Whip

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## Deceptive Patents: Deconstructing *Juicy Whip*

*Moral utility largely prevents the granting of a patent if the patent would be injurious to the well-being of society. The moral utility doctrine has prevailed through much of American patent history and still endures in many parts of the world. In Juicy Whip I, the Federal Circuit chose to abandon the doctrine, but the court's rationale in support of the decision was ill-suited. The court's holding sanctioned deceptive patent applications but, intentionally or unintentionally, neglected applicable unfair competition, free speech, and consumer deception doctrines. In light of the Intellectual Property Clause of the U.S. Constitution, deceptive patents should be barred, because they convey no inherently useful qualities beyond deceiving consumers.*

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## I. INTRODUCTION

Imagine you are browsing the internet and an advertisement pops up. You are interested in the product presented and click on the ad. The link sends you to a separate webpage that does not actually sell the advertised product. Instead, it sells a knock-off product of lower grade and quality. This would likely be a frustrating scenario for many people. Now, imagine that the company that devised such a scenario received a patent on its advertising methods. In other words, the government actually *rewarded* this company for developing this deceptive bait-and-switch. As frustrating as it is, this is a possible scenario<sup>1</sup> in the current state of intellectual property law due to the erosion of the moral utility doctrine and the development of deceptive patents.

This Note calls for the revival and codification of the moral utility doctrine for deceptive patent applications. Specifically, it examines the history of the moral utility doctrine, from its inception up to its erosion in the 1999 case *Juicy Whip I*. As this Note will explain, the patent in question in *Juicy Whip I* is intentionally manufactured for point-of-sale deception, a pernicious type of deception. Moreover, the Federal Circuit's reasoning in *Juicy Whip I* is flawed. First, although the court applauded the utility of post-sale imitative products, the court neglected the complications that result from condoning consumer confusion and deception at the point-of-sale. Second, the court turned a blind eye to the moral question at issue because Congress has not addressed deception as it applies to patents. In doing so, they failed to acknowledge well-established trademark and false advertising laws aimed to avert consumer deception. Congress need not expressly restrict deceptive patents where other laws and regulations seek to prohibit similar deceptive acts. Finally, the incongruity between deceptive patents and the utilitarian purposes of patent law should be evident. Specifically, the Constitution marshals the Patent and Trademark Office to promote the progress of science and the useful arts. Promoting point-of-sale deception is contrary to prevailing public policy.

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1. This scenario assumes that the software claims are drafted such that they overcome an *Alice* rejection. See *Alice Corp. v. CLS Bank Int'l*, 134 S. Ct. 2347 (2014).

This Note proceeds as follows: Part II explores the history and context of the moral utility doctrine. Namely, it will explain that the moral utility doctrine fits within the context of general patent utility and draws upon international origins and its affirmation throughout early American law. Part III examines *Juicy Whip I*, the foremost case affecting the moral utility doctrine. This section challenges the novelty of the *Juicy Whip* patent and rebuts the court's holding by invoking trademark and First Amendment laws that seek to prevent consumer deception. Part IV juxtaposes deceptive patents against the utilitarian purposes of patent law. Part V discusses drawbacks associated with reviving the moral utility doctrine. Finally, Part VI suggests a course of action to reinstate the moral utility doctrine as it applies to deceptive patents.

## II. MORAL UTILITY HISTORY AND CONTEXT

Moral utility is a subset of the utility doctrine, which draws its authority from Article I, Section 8 of the Constitution,<sup>2</sup> whereby Congress is empowered “[t]o promote the Progress of Science and *useful* Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.”<sup>3</sup>

The First Congress enacted the Patent Act of 1790 to codify the Intellectual Property Clause.<sup>4</sup> Under it, a person who “hath . . . invented or discovered any *useful* art, manufacture, engine, machine, or device, or any improvement therein not before known or used” shall be granted a patent “if [the patent examiner] shall deem the

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2. One of the objectives of this paper is to highlight the purpose of the Intellectual Property Clause. See Paul M. Schwartz & William Michael Treanor, Eldred *and* Lochner: *Copyright Term Extension and Intellectual Property as Constitutional Property*, 112 *YALE L.J.* 2331, 2331 (2003) (noting that the Copyright and Patent Clause “until very recently . . . received little attention from constitutional law scholars”).

3. U.S. CONST. art. I, § 8, cl. 8 (emphasis added); see also *Bilski v. Kappos*, 561 U.S. 593, 634–41 (2010) (noting that scholars, courts, and legislators have interpreted the term “useful art” to mean “technological art” or process).

4. *Graham v. John Deere Co.*, 383 U.S. 1, 6 (1966) (“Congress quickly responded to the bidding of the Constitution by enacting the Patent Act of 1790 during the second session of the First Congress.”).

invention or discovery *sufficiently useful* and important, to cause letters patent to be made out in the name of the United States.”<sup>5</sup>

The requirement that a patent be useful, broadly known as the utility requirement, has four varieties derived by the courts:<sup>6</sup> substantial utility, specific utility, credible utility, and moral utility.<sup>7</sup> This paper focuses almost exclusively on moral utility.

### *A. Moral Utility's International Origins*

Moral utility, the requirement that patents should not be granted for inventions that are contrary to morality or public policy, originated, like other patent doctrines, in Europe. The 1624 Statute of Monopolies, the first English patent law, contained a clause preventing issuance of patents that were “contrary to the law,” “mischievous to the state,” or “generally inconvenient.”<sup>8</sup> Later, the moral utility doctrine was again incorporated into one of the first international treaties addressing intellectual property, the 1883 Paris Convention. The Convention stated that the partnering countries could not grant patents that “mislead the public.”<sup>9</sup> In the nineteenth century, European countries began to incorporate an “*ordre public* [public order] exception” into various treaties, and eventually the language disallowing patents that were “contrary to ordre public or morality” was incorporated into the 1963 Strasbourg Convention on the Unification of Certain Points of Substantive Law on Patents for Invention.<sup>10</sup> This language prevailed through the unification of the European patent system in 1973, whereby all the negotiating

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5. Patent Act of 1790, ch. 7, § 1, 1 Stat. 109, 110 (1790) (amended 1793) (emphasis added).

6. UNITED STATES PATENT & TRADEMARK OFFICE, MANUAL OF PATENT EXAMINING PROCEDURE MPEP § 2107.01(I) (9th ed. rev. 2015) (“Courts have used the labels ‘practical utility,’ ‘substantial utility,’ or ‘specific utility’ to refer to this aspect of the ‘useful invention’ requirement of 35 U.S.C. 101.”).

7. 1 DONALD S. CHISUM, CHISUM ON PATENTS §§ 4.01, 4.04(2)(c)(iv) (2000).

8. Chris Dent, ‘*Generally Inconvenient*’: *The 1624 Statute of Monopolies as Political Compromise*, 33 MELB. U. L. REV. 415, 442 (2009).

9. PATENT LAW IN GLOBAL PERSPECTIVE 326 (Ruth L. Okediji & Margo A. Bagley eds., 2014).

10. *Id.* at 327. This was signed by Italy, France, Belgium, Luxemburg, the Netherlands, Ireland, Denmark, Norway, Sweden, the United Kingdom, Greece, Turkey, Austria, Cyprus, and Switzerland.

countries quickly agreed that the European system should include a clause preventing patents that were contrary to public policy or morality.<sup>11</sup> This was done without any significant discussion on the matter, suggesting that the public policy and morality clause was uncontroversial and obvious to the contracting parties.<sup>12</sup> Ultimately, the most comprehensive multilateral agreement on intellectual property to date,<sup>13</sup> the TRIPS agreement of 1994, incorporated an optional “*ordre public*” clause to exclude the granting of immoral patents.<sup>14</sup> This was signed by all 182 World Trade Organization countries.<sup>15</sup>

### B. Moral Utility in the United States

Moral utility in the United States can be traced back to Justice Joseph Story, “one of the architects of American patent law.”<sup>16</sup> In the 1817 case of *Lowell v. Lewis*,<sup>17</sup> he implemented the European-derived rule of moral utility as a bar to patentability. In *Lowell*, the plaintiff claimed that the defendant’s pump had to be “a better pump than the common pump” to be “useful.”<sup>18</sup> Setting a baseline for utility, Justice Story affirmed the issuance of the patent, stating, “All that the law requires is, that the invention should not be frivolous or injurious to the well-being, good policy, or sound morals of society. The word ‘useful,’ therefore, is incorporated into the [Patent Act of 1793] in contradistinction to mischievous or immoral.”<sup>19</sup> Justice Story cited several inventions that would fail the moral utility

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11. *Id.* at 325.

12. *Id.*

13. *Overview: the TRIPS Agreement*, WORLD TRADE ORG., [https://www.wto.org/english/tratop\\_e/trips\\_e/intel2\\_e.htm](https://www.wto.org/english/tratop_e/trips_e/intel2_e.htm) (last visited Nov. 14, 2017).

14. CARLOS M. CORREA, INTELLECTUAL PROPERTY RIGHTS, THE WTO AND DEVELOPING COUNTRIES: THE TRIPS AGREEMENT AND POLICY OPTIONS 62 (2000).

15. *Id.* at 9.

16. Frank D. Prager, *The Influence of Mr. Justice Story on American Patent Law*, 5 AM. J. LEGAL HIST. 254, 254 (1961) (noting that it is “often said that Story was one of the architects of American patent law”).

17. *Lowell v. Lewis*, 15 F. Cas. 1018 (C.C.D. Mass. 1817) (No. 8568), *abrogation recognized by* *In re Fisher*, 421 F.3d 1365 (Fed. Cir. 2005).

18. *Lowell*, 15 F. Cas. at 1019.

19. *Id.*

bar—inventions that “poison people,” “promote debauchery,” or “facilitate private assassination.”<sup>20</sup>

Later, Justice Story reaffirmed his interpretation of the moral utility requirement in *Bedford v. Hunt*:<sup>21</sup>

[A] useful invention, in the statute, is . . . such a one as may be applied to some beneficial use in society, in contradistinction to an invention, which is injurious to the morals, the health, or the good order of society. . . . It is sufficient, that it has no obnoxious or mischievous tendency, that it may be applied to practical uses, and that so far as it is applied, it is salutary. If its practical utility be very limited, it will follow, that it will be of little or no profit to the inventor; and if it be trifling, it will sink into utter neglect. The law . . . simply requires, that it shall be capable of use, and that the use is such as sound morals and policy do not discountenance or prohibit.<sup>22</sup>

Justice Story’s interpretation was generally adopted to invalidate immoral patents over the next century and a half.<sup>23</sup> Courts used the doctrine of moral utility to invalidate patents in two main categories: gambling devices (those “injurious” to the morals of society) and fraudulent or deceptive devices (inventions with a “mischievous tendency”).<sup>24</sup>

### *1. Gambling devices were generally deemed immoral*

The whittling away of the moral utility doctrine generally corresponds with the widespread public acceptance of gambling.<sup>25</sup> In the early years of the American moral utility doctrine, courts invalidated patents for gambling even if they were capable of

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20. *Id.*

21. *Bedford v. Hunt*, 3 F. Cas. 37, 37 (C.C.D. Mass. 1817) (No. 1217).

22. *Id.*

23. “For many years, the Story view of utility . . . was generally accepted by the courts.” I CHISUM, *supra* note 7, § 4.02.

24. *Id.* § 4.03; *Bedford*, 3 F. Cas. at 37.

25. Laura A. Keay, *Morality’s Move Within U.S. Patent Law: From Moral Utility to Subject Matter*, 40 AIPLA Q.J. 409, 411 (2012) (asserting that “the [moral utility] doctrine’s decline correlates with increased public acceptance of gambling activities”).

substantial use apart from gambling situations.<sup>26</sup> Throughout the 1880s and 1890s courts denied patents for slot machines and punch-board lottery devices.<sup>27</sup> Interestingly, the public sentiment against gambling rose to such heights that “[b]y 1910 virtually all forms of gambling were prohibited in the [United States].”<sup>28</sup> Later, however, gambling found greater acceptance as a form of economic stimulus during the Great Depression and was once again permitted.<sup>29</sup> In 1977, the Board of Patent Appeals and Interferences disregarded the application of moral utility to gambling inventions.<sup>30</sup> On the other hand, the prohibition on fraudulent and deceptive inventions lasted longer than the prohibition on gambling inventions, as I will discuss in the next section.

*2. Throughout much of early American law, fraudulent and deceptive patents were prohibited as immoral*

Like gambling patents, fraudulent and deceptive patents were not allowed throughout much of the history of American patent law. The first instance in which the Supreme Court invalidated a patent based on deceptiveness was *Klein v. Russel* (1873).<sup>31</sup> The patent at issue claimed a process for treating lamb and sheep skin to imitate the softness of “dogskin”<sup>32</sup> in gloves.<sup>33</sup> The patent intended to substitute a less valuable article (sheep skin) for dogskin and impose this impression upon the public by “representing gloves made of softened sheep and lamb skins as dogskin gloves.”<sup>34</sup> In affirming the

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26. See, e.g., *Nat'l Automatic Device Co. v. Lloyd*, 40 F. 89, 90 (C.C.N.D. Ill. 1889) (denying patent on toy horse race course because it was used in bar-rooms and saloons and “no [other] such use has been as yet made”).

27. 1 CHISUM, *supra* note 7, § 4.03.

28. ROGER DUNSTAN, GAMBLING IN CALIFORNIA, at II-6 (1997), <https://www.library.ca.gov/CRB/97/03/97003a.pdf>; see also Nelson Rose, *Gambling and the Law®: The International Law of Remote Wagering*, 40 J. MARSHALL L. REV. 1159, 1162–1163 (2007) (recounting the three “waves” of legalized gambling in U.S. history).

29. DUNSTAN, *supra* note 28.

30. *Ex parte Murphy*, 200 U.S.P.Q. (BNA) 801 (B.P.A.I. Apr. 29, 1977).

31. *Klein v. Russell*, 86 U.S. (19 Wall.) 433 (1873).

32. The leather made from the skin of dogs. *Dogskin*, MERRIAM-WEBSTER, <https://www.merriam-webster.com/dictionary/dogskin> (last visited Nov. 14, 2017).

33. *Klein*, 86 U.S. at 445.

34. *Id.*

invalidation of the patent, the Court also affirmed the trial court's jury instructions that "[i]f the process patented cannot be made useful for any honest purpose, and can be used only for perpetrating a fraud upon the public, and is therefore not useful, but pernicious, the plaintiff cannot recover."<sup>35</sup>

In time, the deceptive patent assessment was modified by the *Rickard* doctrine in *Rickard v. Du Bon* (1900).<sup>36</sup> The patent in question revealed a process for artificially producing spots on tobacco leaves that were used to wrap cigars. The inventor touted the process as producing superior burning quality for the leaf, but ultimately the Second Circuit found the only usefulness of the invention was to "counterfeit the [superior Sumatra] leaf spotted by natural causes."<sup>37</sup> The Second Circuit held the patent was invalid for lack of utility and laid forth the *Rickard* doctrine:

In authorizing patents to the authors of new and useful discoveries and inventions, congress did not intend to extend protection to those which confer no other benefit upon the public than the opportunity of profiting by deception and fraud. To warrant a patent, the invention must be useful; that is, capable of some beneficial use as distinguished from a pernicious use.<sup>38</sup>

Unlike the invalidation of some gambling patents, which were invalidated even if they contained a non-pernicious utility, the *Rickard* doctrine does not apply to patents that confer some utility other than deception.<sup>39</sup> In other words, under the *Rickard* doctrine, deceptiveness will not spoil a patent if the patent contains some other non-deceptive use. In that case, it seems the deceptive claim is immaterial to the patentability of an invention because, were it not for the *bona fide* beneficial use contained within the patent, the deceptive feature, by itself, would not be patentable.

Intuitively, a purely deceptive improvement should not be patentable. This makes sense even with a contemporary analysis. The

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35. *Id.* at 445, 468.

36. *Rickard v. Du Bon*, 103 F. 868 (2d Cir. 1900).

37. *Id.* at 869–72.

38. *Id.* at 873.

39. Patents that contain "some beneficial use" will not fail for having "no other benefit upon the public than the opportunity of profiting by deception." *Id.*

leading patent law treatise, *Chisum on Patents*, begrudgingly acknowledges the prospect of such a patent.<sup>40</sup> Some senior patent examiners today, who are not aware of the moral utility doctrine, do not believe that a competent patent examiner would grant a deceptive patent<sup>41</sup> because it runs contrary to patent law's supreme purpose: "To promote the Progress of Science and useful Arts."<sup>42</sup> Yet, the Federal Circuit opened up the possibility of such patents in the landmark case *Juicy Whip I*.<sup>43</sup>

### III. JUICY WHIP I

In 1999, 180 years of American moral utility doctrine precedent<sup>44</sup> were abandoned in a seemingly innocuous case involving a juice dispenser:<sup>45</sup> *Juicy Whip, Inc. v. Orange Bang, Inc.* ("*Juicy Whip I*").<sup>46</sup>

#### A. Juicy Whip Patent Claims

The juice dispenser assessed in *Juicy Whip I* (shown in Figure 1) incorporates aspects of a post-mix and pre-mix juice machine. A "post-mix" beverage dispenser stores beverage syrup concentrate and water separately until they are mixed shortly before the drink is dispensed. On the other hand, a "pre-mix" dispenser contains water and syrup concentrate pre-mixed in a clear bowl, ready to be dispensed.<sup>47</sup> A pre-mix dispenser prompts impulse buying by providing the consumer with a visual beverage display. However, this benefit comes at a cost:

40. Refusing to give full weight to the *Juicy Whip I* decision, *Chisum on Patents* notes, "[A]n invention the only use of which is to deceive or commit fraud has been deemed to lack utility, but the Federal Circuit's decision in *Juicy Whip v. Orange Bang, Inc.* (1999), cast doubt on that proposition." 1 CHISUM, *supra* note 7, § 4.03(2).

41. Personal conversation with Denver Senior Patent Examiners (Aug. 2016).

42. U.S. CONST. art. I, § 8, cl. 8.

43. *Juicy Whip, Inc. v. Orange Bang, Inc.* (*Juicy Whip I*), 185 F.3d 1364 (Fed. Cir. 1999).

44. This is the period from Justice Story's pronouncement in *Lowell v. Lewis*, 15 F. Cas. 1018 (C.C.D. Mass. 1817) (No. 8568) to *Juicy Whip I*, 185 F.3d 1364. *But see* Ulrich Schatz, *Patents and Morality, in* BIOTECHNOLOGY, PATENTS AND MORALITY 159, 159 (Sigrid Sterckx ed., 1997) (asserting that barring the patenting of inventions that are contrary to public order and morality is "as old as patent law itself").

45. *But see* 1 CHISUM, *supra* note 7, § 4.03(2) (noting that *Juicy Whip I* "cast doubt" on the proposition that a device to commit fraud lacks utility).

46. *Juicy Whip I*, 185 F.3d at 1364.

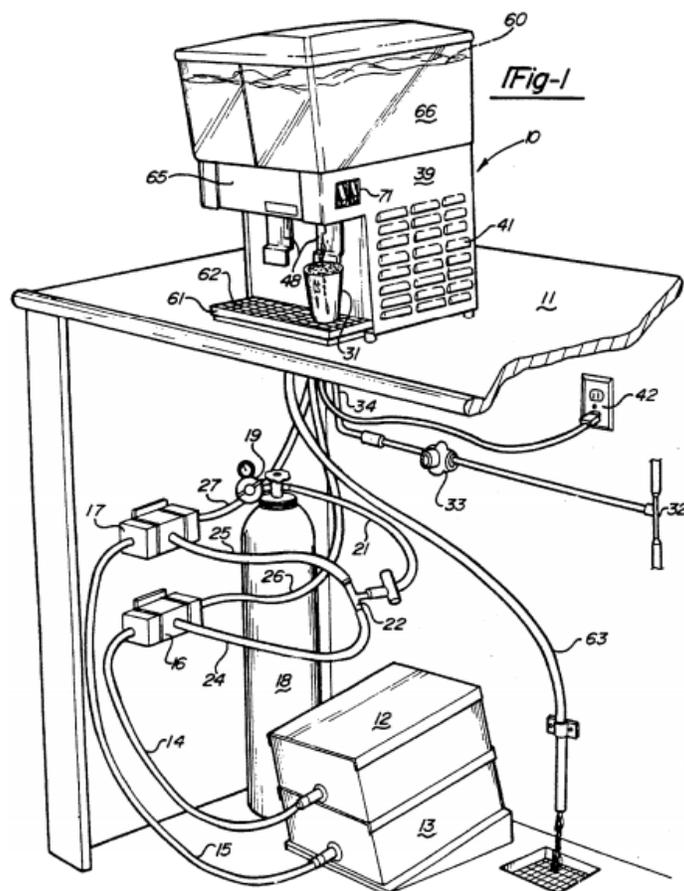
47. *Id.* at 1365.

pre-mix dispensers require not only constant refilling, because the pre-mix bowl has limited volume, but also frequent, laborious cleaning because the juice within the bowl is more vulnerable to bacterial contamination than juice in a post-mix dispenser.<sup>48</sup> The patent in *Juicy Whip I*, United States Patent No. 5,575,405 (the '405 patent), incorporates the better qualities of both dispensers—a simulation pre-mix bowl that appears to dispense the beverage, but does not, and a post-mix dispenser and pressure tank below that actually dispenses the beverage (see Figure 1).<sup>49</sup>

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48. *Id.*; *see also* U.S. Patent No. 5,575,405 col. 2 ll. 38–44, col. 3 ll. 1–6, 33–42.

49. *Id.* col. 5 ll. 51–62.



**Figure 1** The juice dispenser of the '405 patent.<sup>50</sup> Generally, everything above the counter [11] is the simulation pre-mix bowl and everything below the counter is the post-mix component.

50. *Id.* fig. 1.

Claims 1 and 2 of the '405 patent state:

1. In a post-mix beverage dispenser of the type having an outlet for discharging beverage components in predetermined proportions to provide a serving of dispensed beverage, the improvement which comprises:

a transparent bowl having no fluid connection with the outlet and visibly containing a quantity of fluid;

said fluid being resistant to organic growth and simulating the appearance of the dispensed beverage;

said bowl being positioned relative to the outlet to create the visual impression that said bowl is the reservoir and principal source of the dispensed beverage issuing from the outlet; and

said bowl and said quantity of fluid visible within said bowl cooperating to create the visual impression that multiple servings of the dispensed beverage are stored within said bowl.

2. The post-mix dispenser of claim 1 which further comprises means for generating visible movement of said fluid in said bowl.<sup>51</sup>

The sole *inventive* aspect of the '405 patent is the combination pre-mix simulation with the post-mix dispensing mechanism—the illusionary aspect. All other aspects draw upon prior scientific knowledge. Specifically, the first post-mix soda-fountain was patented by William Gee in 1875,<sup>52</sup> and pre-mix dispensers have existed at least since the invention of beer barrel taps. Likewise, although having liquid in the pre-mix bowl that is “resistant to organic growth” seems innovative, it is specious. Both methods specified by the '405 patent by which the fluid could be resistant to organic growth were long since known at the time of filing. Claims 4 and 5 teach that resistance to organic growth can be achieved either by sterilizing the liquid or by using an alcohol.<sup>53</sup> First, sterilization of a liquid is a process dating back to Louis Pasteur’s discovery in 1861 that heating milk and other liquids could kill harmful bacteria, a process appropriately named

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51. *Id.* col. 12 ll. 23–42.

52. U.S. Patent No. 159,915 A (filed Feb. 16, 1875).

53. '405 Patent col. 12 ll. 23–42.

“pasteurization.”<sup>54</sup> Furthermore, Pasteur also proved that a closed environment, such as the sealed<sup>55</sup> pre-mix bowl in the '405 patent, would not culture any bacteria.<sup>56</sup> Second, preventing bacterial growth by using alcohol to disrupt the cell membranes and denature proteins of vegetative bacterial cells was a method employed as early as 200 AD.<sup>57</sup>

Ultimately, the primary purpose of the '405 patent is to trick consumers into thinking they are receiving something that they are not. It gives the appearance of dispensing unadulterated, natural juice but only dispenses canned concentrate. In the preferred embodiment of the '405 patent, the pre-mix bowl would hold antifreeze fluid<sup>58</sup> with a dye to simulate any color of liquid desirable.<sup>59</sup> By way of example, the preferred embodiment lays out how the antifreeze fluid could simulate orange juice. It states that “[t]he formulation may be rendered cloudy and opaque by adding a suitable dispersoid . . . for example an alkenyl modified oxyalkylene polymer to simulate a pulpy beverage such as orange juice.”<sup>60</sup> However, although the appearance of the pre-mix container would simulate a pulpy, fresh, organic orange juice with dispersed pulp-like chemicals, the liquid coming out of the Juicy Whip *post-mix* container *cannot* be a pulpy juice. *Chemistry and Technology of Soft Drinks and Fruit Juices*, a compilation of articles written by veteran food scientists and intended for graduate students

54. JEFFREY C. POMMERVILLE, *ALCAMO'S FUNDAMENTALS OF MICROBIOLOGY: BODY SYSTEMS EDITION* 9–11, 16 (2d ed. 2013).

55. '405 Patent col. 5 ll. 59–62.

56. POMMERVILLE, *supra* note 54, at 8–11, 16.

57. JEFFREY C. POMMERVILLE, *ALCAMO'S FUNDAMENTALS OF MICROBIOLOGY* 211–12 (9th ed. 2011); Yosef Ali et al., *Alcohols, in DISINFECTION, STERILIZATION, AND PRESERVATION* 229 (Seymore S. Block ed., 5th ed. 2001); *see also id.* (stating that “[a]lcohol is perhaps the oldest of antiseptic agents”).

58. '405 Patent col. 6 ll. 1–2 (“A preferred fluid is an alcohol, such as polypropylene glycol by way of example.”). Antifreeze mainly consists of polyethylene glycol or polypropylene glycol. *An Introduction to Coolant Technology*, RECOCHEM INC., (last visited Nov. 14, 2017), [http://www.coolantexperts.com/coolant\\_overview/](http://www.coolantexperts.com/coolant_overview/); *see also* Juicy Whip, Inc. v. Orange Bang, Inc. (*Juicy Whip II*), 292 F.3d 728, 738 (Fed. Cir. 2002) (“Well, I was speaking to Dave Fox . . . and what he had done is said he had a fluid like an antifreeze fluid that there would be no spoilage but looked like his fruit punch Ole drink . . .”).

59. *Juicy Whip II*, 292 F.3d at 739 (testimony stating “if it was Orange Bang it would be orange. If it was Punch Bang, it would be red”); '405 Patent col. 5 ll. 13–19.

60. '405 Patent col. 6 ll. 8–12.

going into production, marketing, or quality control in the soft drink industry, stipulates that

No matter how fine it is, pulp in a carbonated post-mix syrup will inevitably lead to a blockage in the system, for it will rise to the top in the [syrup container] and then enter the valve in a concentrated form. Accordingly, fruit drinks must be reformulated for dispensing by replacing conventional concentrated juices and comminutes with clarified [pulpless] concentrated juice.<sup>61</sup>

Natural fruit juices have a variety of health benefits,<sup>62</sup> and pulp is an indicator of those benefits.<sup>63</sup> Nevertheless, even if the concentrate were *healthier* than the natural fruit juice, consumers are entitled to differentiate between commodities and select their product of choice. Imitating natural, unfiltered juice, while providing something else, is manifestly deceptive because it leads consumers to believe they are purchasing something that they are not.

The dispensing function of the '405 patent is also illusionary. The '405 patent contains an agitating function to make it appear that the pre-mix fluid is flowing out of the dispensing outlet. Claim 2 requires that the antifreeze inside of the bowl create "visible movement,"<sup>64</sup> which is done by creating artificial movement. The fluid is agitated by a mechanical device to make it appear like the juice is flowing from the transparent pre-mix bowl above the dispensing outlet when it is not.<sup>65</sup>

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61. CHEMISTRY AND TECHNOLOGY OF SOFT DRINKS AND FRUIT JUICES 365 (Philip A. Ashurst ed., 2d ed. 2005). Note that the juice dispenser shown in the drawing and notated in the "Description of the Preferred Embodiment" of the '405 patent is a carbonation-propelled system. '405 Patent col. 7 ll. 20–38, fig.1. Uncarbonated juice dispensers "operate on a post-mix basis, using as a 'syrup' aseptically filled concentrated juice (diluted to a suitable viscosity). Sometimes a low level of sulphur dioxide is added to protect juice in the dispense valve, which for citrus juices must be modified to cope with high pulp content." CHEMISTRY AND TECHNOLOGY OF SOFT DRINKS AND FRUIT JUICES, *supra* at 367.

62. Peggy J. Noonan, *Juice Up Your Diet*, CNN, <http://www.cnn.com/2008/HEALTH/diet.fitness/06/11/cl.antioxidant.juices/> (last updated June 11, 2008, 9:33 AM).

63. See U.S. PATENT & TRADEMARK OFFICE, EXAMINATION GUIDE 1-11 (2011), <http://www.uspto.gov/sites/default/files/trademarks/resources/ExamGuide1-11.doc> (commenting on the *Trademark Manual of Examining Procedure* §1203.02(d)(i), which stipulates, "[A] perceived health benefit from an ingredient or feature generally supports a presumption that the ingredient or feature is material to a consumer purchasing decision").

64. '405 Patent, col. 12 ll. 41–42.

65. *Id.* col. 6 ll. 2–4 (stating that the preferred embodiment provides the means "for agitating the fluid to effect the appearance that it is flowing freshly into the container").

The agitator itself is not new,<sup>66</sup> but the combination of the “visual impression that said [pre-mix] bowl is the reservoir and principle source of the dispensed beverage”<sup>67</sup> combined *with* the agitating function inside the bowl is the innovative aspect that the patent claims. This is misleading and a main component of the patent’s deceptive nature.

In summary, the preferred embodiment of the ’405 patent displays colored antifreeze with pulp-like components to make it appear like fresh orange juice is flowing out of the top bowl when, in fact, concentrated, pulpless juice is flowing out of a box hidden beneath the dispensing machine.

### B. Juicy Whip *Holding and Its Flaws*

The Federal Circuit in *Juicy Whip I* never fully judged the deceptiveness of the ’405 dispenser, partly because the appellees seeking to invalidate the patent, Orange Bang, did not assert the facts stated above.<sup>68</sup> Even so, the court stated in dicta that “even if the use of a reservoir containing fluid that is not dispensed is considered deceptive, that is not by itself sufficient to render the invention unpatentable.”<sup>69</sup> In a brief line of reasoning the court cited two rationales: first, it is not unusual for a product to appear to be something it is not, and second, the Patent and Trademark Office (USPTO) is not entrusted to be arbiters of deceptive trade practices, a responsibility that the court thought should be left to the Federal Trade Commission or the Food and Drug Administration.<sup>70</sup> Ultimately, the court’s holding expressed a deferral of responsibility and a metaphorical “washing of hands”:

Of course, Congress is free to declare particular types of inventions unpatentable for a variety of reasons, including

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66. Disclosure of the patent reveals that agitators have been used in an assortment of pre-mix machines. *Id.* col. 3 l. 20.

67. *Id.* col. 12 ll. 33–35.

68. *Juicy Whip, Inc. v. Orange Bang, Inc. (Juicy Whip I)*, 185 F.3d 1364, 1367–68 (Fed. Cir. 1999) (“Orange Bang has not argued that it is unlawful to display a representation of the beverage in the manner that fluid is displayed in the reservoir of the invention, even though the fluid is not what the customer will actually receive.”).

69. *Id.* at 1368.

70. *Id.* at 1367–68.

deceptiveness. . . . Until such time as Congress does so, however, we find no basis in section 101 to hold that inventions can be ruled unpatentable for lack of utility simply because they have the capacity to fool some members of the public.<sup>71</sup>

In the following paragraphs, I will explain why the court's holding in *Juicy Whip I* was incorrect, as a matter of both law and public policy. First, the '405 patent fails the *Rickard* doctrine because it confers no other benefit than deception and fraud. Second, the '405 patent exploits an especially pernicious type of deception—point-of-sale deception. Third, the USPTO is a capable arbiter of deceptive trade practices, as they already regulate deceptive trademarks. Fourth, deceptive patents fly in the face of First Amendment case law that affords no protection to deceptive commercial speech.

*1. The '405 patent fails the Rickard doctrine*

As discussed above, the '405 patent employs two deceptive mechanisms: (1) a concoction of artificial elements in the pre-mix bowl gives the appearance that fresh, unadulterated juice will dispense out of the reservoir and (2) an agitator function simulates flow such that the consumer believes pre-mix liquid is flowing into his cup. In total, the '405 patent confers no benefit other than deception.

It should be mentioned that the '405 patent could, apart from the preferred embodiment, function in a minimally deceptive way. For example, if an owner of the '405 dispenser stored the same artificial juice in the pre-mix bowl as that coming from the post-mix dispenser, customers would be ignorant only as to the inner-workings of the juice dispenser. Customers would get the juice they wanted (artificial juice), just not in the manner they assumed. The company has no intention of deceiving customers in this scenario, and giving the court the benefit of the doubt, this might be what the Federal Circuit had in mind when it assessed the '405 Patent;<sup>72</sup> however, if that was the case, the court should not have labeled the '405 Patent as a deceptive

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71. *Id.* at 1368.

72. *Id.* at 1367–68 (“Orange Bang has not argued that it is unlawful to display a representation of the beverage in the manner that fluid is displayed in the reservoir of the invention, even though the fluid is not what the customer will actually receive.”).

invention,<sup>73</sup> nor should it have overturned the *Rickard* doctrine or engaged in a deceptiveness analysis. Multiple legitimate products fit into a general class of inventions that, in a broad sense, ‘fool some members of the public’ only because the consumer is unaware of the product’s functionality. For example, the large majority of automobile owners and technology users have no idea how their product works, only that it produces the result they desire.<sup>74</sup> Yet, no one would justifiably classify those products as “deceptive.” In essence, the court’s use of the word “deceptive” was a misnomer. Granted, the least deceptive use of the juice dispenser is not extremely pernicious, but allowing *all* deceptive patents, even extremely pernicious patents, because the ‘405 patent is innocuous is shortsighted.

This critique aside, the ‘405 patent, as understood by the court, fails the *Rickard* doctrine because it has no use besides a pernicious use.

## 2. *Imitative deception is particularly pernicious at the point of sale*

In stating that it is common for products to appear as something they are not—the Federal Circuit’s first rationale in concluding that the ‘405 patent is a permissible deception—the court neglected to distinguish between pernicious and non-pernicious consumer deception. The court referenced several imitative products to buoy their argument: cubic zirconium is designed to imitate a diamond, imitation gold leaf is designed to simulate real gold leaf, synthetic fabrics are designed to simulate expensive natural fabrics, imitation leather is designed to look like genuine leather, laminate flooring is designed to look like hardwood flooring, and imitation hamburgers are designed to look like real hamburgers.<sup>75</sup>

Although the court did not specify *when* the imitation was occurring, each favorable instance the court utilized is, essentially, an example of “post-sale confusion” that is unrelated to the type of

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73. *Id.* at 1368 (“Moreover, even if the use of a reservoir containing fluid that is not dispensed is considered deceptive, that is not by itself sufficient to render the invention unpatentable.”)

74. In that case, the product is just a “black box” to those consumers, where they put something into the device and it spits something out.

75. *Id.* at 1367–68.

deception resulting from the *Juicy Whip I* dispenser. Post-sale confusion, a concept employed mainly in the context of trademark law, is confusion by the general public after a sale has occurred. This differs from “point of sale” confusion, where the purchaser is confused as to the source and quality of the product when the purchase is made. For example, post-sale confusion might occur if an auto-body mechanic accepted orders to re-shape a Pontiac to imitate the body style of a limited edition Ferrari.<sup>76</sup> The consumer who requested the alterations would know exactly where the car was initially manufactured, but as it is driven down the road the general public may be deceived into thinking it is a Ferrari because of its strikingly similar body style.<sup>77</sup> In other words, post-sale confusion occurs when the purchaser of a good is not confused as to the source or quality of the good at the time of purchase, but others who see the product later are confused or misled.<sup>78</sup>

The important distinction between these two types of confusion is that the imitative usefulness of the products cited by the *Juicy Whip I* court (cubic zirconium, laminate flooring, imitation leather) occurs *after* the purchase has been made. A cubic zirconium ring may be useful in intimating to friends and colleagues that a person can afford a diamond much more expensive than they actually can. However, the buyer of a diamond ring would be thoroughly distraught to discover that the stone is actually cubic zirconium, possessing only a fraction of the value and quality the buyer had assumed.<sup>79</sup> True, synthetic fabrics and laminate flooring are useful in their imitative form, possessing tensile strength and hardness, but their imitative usefulness is nullified if the consumer cannot differentiate qualities of products at the point of sale. This is the distinction the court should have drawn: many products have imitative usefulness outside of the point of sale, but the imitative usefulness is negated when it deceives customers as they are

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76. *Ferrari S.P.A. v. Roberts*, 944 F.2d 1235, 1238 (6th Cir. 1991).

77. *Id.* at 1243.

78. J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS § 23:5 (4th ed. 2011).

79. See Guides for the Jewelry, Precious Metals, and Pewter Industries, 16 C.F.R. § 23.1 (2017) (“It is unfair or deceptive to misrepresent the type, kind, grade, quality, quantity, metallic content, size, weight, cut, color, character, treatment, substance, durability, serviceability, origin, price, value, preparation, production, manufacture, distribution, or any other material aspect of an industry product.”).

purchasing those products. True, point-of-sale deception may increase sales, but as a matter of public policy, laws generally favor protecting buyers over sellers.<sup>80</sup>

The court tried to rationalize the point-of-sale deception by casting the '405 patent as a post-mix machine imitating a pre-mix machine,<sup>81</sup> but the relevant customers are not buying the machine, they are buying the juice within the machine. Furthermore, even if purchasers were buying the machine, they would be displeased to discover that they were deceived at the point of sale, and what they thought to be a pre-mix dispenser was actually a post-mix dispenser in disguise. Either way, the imitative usefulness is virtually nullified if the customer cannot evaluate the qualities of the product they are buying at the point of sale.

Thus, the imitative nature of the '405 dispenser is unlike the simulative products the court cited, because it produces deception at the point of sale.

### *3. Current practices demonstrate the USPTO is a capable arbiter of deceptive trade practices*

The court in *Juicy Whip I* reasoned that the USPTO is not charged to be the arbiter of deceptive trade practices, but by doing so, the court disregarded trademark law, the Federal Circuit's own deceptive trademark analysis, appropriate jurisdictional scope, and the constitutional authority granted by the Intellectual Property Clause.

First, the USPTO is entrusted to prevent consumer deception explicitly by trademark statute. In the Lanham Act, Congress gave the USPTO the right to refuse registration of trademarks that are "immoral" or "deceptive,"<sup>82</sup> and deceptive trademarks may be

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80. *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 157 (1989) ("The law of unfair competition has its roots in the common-law tort of deceit: its general concern is with protecting *consumers* from confusion as to source. While that concern may result in the creation of 'quasi-property rights' in communicative symbols, the focus is on the protection of consumers, not the protection of producers as an incentive to product innovation.").

81. *Juicy Whip, Inc. v. Orange Bang, Inc. (Juicy Whip I)*, 185 F.3d 1364, 1367 (Fed. Cir. 1999) ("Thus, in this case the claimed post-mix dispenser meets the statutory requirement of utility by embodying the features of a post-mix dispenser while imitating the visual appearance of a pre-mix dispenser.").

82. 15 U.S.C. § 1052(a) (2012).

canceled in a proceeding with the USPTO at any time.<sup>83</sup> The Federal Circuit affirmed this practice as recently as December 2015:

Under the Lanham Act, the PTO must register source-identifying trademarks unless the mark falls into one of several categories of marks precluded from registration. . . . Many of these categories bar the registration of deceptive or misleading speech, because such speech actually undermines the interests served by trademark protection and, thus, the Lanham Act's purposes in providing for registration. For example, a mark may not be registered if it resembles a registered mark such that its use is likely to "cause confusion, or to cause mistake, or to deceive," § 2(d), or if it is "deceptively misdescriptive," § 2(e). These restrictions on registration of deceptive speech do not run afoul of the First Amendment. *See Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm'n*, 447 U.S. 557, 563 (1980) ("The government may ban forms of communication more likely to deceive the public than to inform it.").<sup>84</sup>

*In re Budge* provides the prototypical example of a deceptive trademark.<sup>85</sup> In this case a company appealed a rejection for registration by the USPTO's Trademark Trial and Appeal Board for their mark "LOVEE LAMB."<sup>86</sup> Although the name implied natural materials made of sheepskin, the company sold only synthetic automotive seat covers.<sup>87</sup> Due to its deceptive nature, the court found the mark deceptively misdescriptive.<sup>88</sup> Furthermore, by building upon two tests formulated by the USPTO's Trademark Board, the court set

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83. 15 U.S.C. § 1064(3) (2012).

84. *In re Tam*, 808 F.3d 1321, 1329 (Fed. Cir. 2015) (citation omitted). The Supreme Court recently reviewed *In re Tam*, striking down the "disparagement" clause of the Lanham Act as a violation of the First Amendment. However, in doing so, the Supreme Court implicitly ratified the Lanham Act's prohibition on deceptive trademarks. *See Matal v. Tam*, 137 S. Ct. 1744, 1753 (2017) ("[A] trademark cannot be registered if it is 'merely descriptive or deceptively misdescriptive' of goods, § 1052(e)(1), or if it is so similar to an already registered trademark or trade name that it is 'likely . . . to cause confusion, or to cause mistake, or to deceive,' § 1052(d).")

85. *In re Budge Mfg.*, 857 F.2d 773 (Fed. Cir. 1988).

86. *Id.* at 774.

87. *Id.*

88. *Id.* at 775-77.

forth the current test for deceptiveness in trademarks.<sup>89</sup> In other words, the Federal Circuit has relied upon the USPTO's own arbitration of deceptive trade practices to formulate its standard for deceptive trade practices.<sup>90</sup> Declaring that the USPTO is not directed to or capable of assessing deceptive trade practices is historically inaccurate.

The *Juicy Whip I* court asserted that the USPTO is not designated as an arbiter of deceptive trade practices, but the USPTO accomplished that directive in the realm of patents for 180 years before *Juicy Whip I*, with no disapproval from Congress. The fact that Congress chose not to alter the moral utility doctrine in the many revisions to the Patent Act from 1790 to 1950 is compelling evidence that the USPTO is a capable arbiter of deceptive trade practices.<sup>91</sup>

Third, if deceptive patents like those in *Juicy Whip I* were policed by the Federal Trade Commission and the Food and Drug Administration, as the court suggests, it would blur jurisdictional lines. The Supreme Court has indicated that it is not the prerogative of the Federal Trade Commission to invalidate patents.<sup>92</sup> Furthermore, a deceptive patent would be enjoined only if it was exceptionally bad, such that it caught the attention of those federal agencies.<sup>93</sup> On the other hand, it would not require much more of a

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89. *Id.* at 775; *In re Shapely, Inc.*, 231 U.S.P.Q. (BNA) 72, 73 (T.T.A.B. 1986); *In re Simmons, Inc.*, 192 U.S.P.Q. (BNA) 331 (T.T.A.B. 1976). The benchmark for deceptiveness in trademarks is “(1) Is the term misdescriptive of the character, quality, function, composition or use of the goods? (2) If so, are prospective purchasers likely to believe that the misdescription actually describes the goods? (3) If so, is the misdescription likely to affect the decision to purchase?” *Budge*, 857 F.2d at 775. With some modification, this test could be applied to deceptive patent applications.

90. *Budge*, 857 F.2d at 775.

91. *Bilski v. Kappos*, 561 U.S. 593, 636 (2010) (noting that “the Patent Act was amended, revised or codified some 50 times between 1790 and 1950” (citing *Graham v. John Deere Co.*, 383 U.S. 1, 10 (1966))).

92. *FTC v. Actavis, Inc.*, 133 S. Ct. 2223, 2243 (2013) (Roberts, C.J., dissenting) (“Our cases establish that antitrust law has no business prying into a patent settlement so long as that settlement confers to the patent holder no monopoly power beyond what the patent itself conferred—unless, of course, the patent was invalid, but that again is a question of patent law, not antitrust law.”).

93. See Thomas B. Pahl, *Stick with Security: Insights into FTC Investigations*, FTC (July 21, 2017, 10:57 AM), <https://www.ftc.gov/news-events/blogs/business-blog/2017/07/stick-security-insights-ftc-investigations> (“We like to think of the FTC as a small federal agency that – in appropriate circumstances – can pack a powerful law enforcement punch. But we’re always conscious of the need to be good stewards of taxpayer dollars. Sometimes a company’s

USPTO examiner to concurrently assess the deceptive nature of an invention while assessing novelty, obviousness, patentable subject matter, and utility in general. Patent examiners become intimately familiar with technologies as they assess them over months or years, and the deceptive nature of a patent should be evident to the ordinary examiner.

Finally, patent examiners have greater constitutional authority to assess deceptive patents than trademark examiners. Trademark law, wherein the USPTO currently assesses deceptive trade practices, is not explicitly mentioned in the Constitution, but draws its legitimacy from the Commerce Clause of the Constitution. This clause is a broad authorization that has been used to justify regulations applicable to everything from racial discrimination<sup>94</sup> to homegrown marijuana.<sup>95</sup> In contrast, the utility requirement for patents and copyrights is explicit in the Constitution: “To promote the Progress of Science and *useful* Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries . . . .”<sup>96</sup> As discussed above, point-of-sale deception does not convey any usefulness or utility as required by the Constitution. When something is explicitly found in the Constitution, it receives more deference than ordinary congressional directives.<sup>97</sup> Accordingly, the USPTO should be given the authority to evaluate usefulness and invalidate deceptive patent applications.

The USPTO is a capable arbiter of deceptive trade practices as shown by trademark law, the federal circuit’s deceptiveness analysis formulated from the USPTO’s deceptiveness analysis, and the USPTO’s constitutional and jurisdictional scope to grant and invalidate patents.

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practices may raise initial concerns, but there are other factors that suggest law enforcement wouldn’t be in the public interest.”).

94. *Heart of Atlanta Motel v. United States*, 379 U.S. 241 (1964).

95. *Gonzales v. Raich*, 545 U.S. 1 (2005).

96. U.S. CONST. art. I, § 8, cl. 8 (emphasis added).

97. *Id.* art. VI, § 2 (emphasis added) (“This Constitution, and the laws of the United States *which shall be made in Pursuance thereof*; and all Treaties made, or which shall be made, under the Authority of the United States, shall be the supreme Law of the Land . . . .”).

4. *Deceptive patents are a loophole in the laws seeking to prevent consumer deception*

The foremost point the court makes in *Juicy Whip I* is that “Congress is free to declare particular types of inventions unpatentable for a variety of reasons, including deceptiveness.”<sup>98</sup> Although Congress has not spoken specifically about deceptiveness in patent utility, a significant amount of federal code, regulation, and case law is devoted to eliminating deceptive trade practices similar to those implicated in *Juicy Whip I* and will be discussed hereinafter. Allowing the USPTO to invalidate deceptive patents would be consistent with the congressional intent and policy objectives indicated in these enactments.

*a. Federal laws seek to prevent consumer deception.* As part of federal Trademark law, Congress enacted 15 U.S.C. § 1125, which makes a person liable in a civil action if they “in connection with any goods or services . . . use[] . . . any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which . . . in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person’s goods.”<sup>99</sup> This is the very center of Trademark law, the prevention of consumer confusion.<sup>100</sup>

Furthermore, in 1967 Congress enacted the Fair Packaging and Labeling Act (FPLA) to protect customers in the marketing of consumer goods.<sup>101</sup> In the declaration of policy, Congress proclaimed that “[i]nformed consumers are essential to the fair and efficient functioning of a free market economy. Packages and their labels should enable consumers to obtain accurate information as to the quantity of the contents and should facilitate value comparisons.”<sup>102</sup>

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98. *Juicy Whip, Inc. v. Orange Bang, Inc. (Juicy Whip I)*, 185 F.3d 1364, 1368 (Fed. Cir. 1999).

99. 15 U.S.C. § 1125(a)(1) (2012).

100. “Likelihood of confusion” is the central test for common-law and statutory trademark infringement. The test is whether the use of the trademark is likely to cause confusion, to cause mistake, or to deceive. MCCARTHY, *supra* note 78, § 23:1.

101. 15 U.S.C. §§ 1451–1461 (2012).

102. *Id.* § 1451.

Although this Act excludes unpackaged goods,<sup>103</sup> such as the juice in the '405 patent, the wording conveys what appears to be Congress's wide-ranging goal—"to prevent the deception of consumers or to facilitate value comparisons as to *any* consumer commodity."<sup>104</sup> Although it is true that Congress has not spoken specifically concerning the moral utility of patents, the reasoning in *Juicy Whip I* that Congress is free to enact a law to prevent deceptive patents ignores other laws Congress has already enacted.

*b. Federal regulations seek to prevent consumer deception.* Along with Congress's laws to prevent consumer deception, many regulations have been enacted to prevent consumer deception in a wide array of industries.<sup>105</sup> Analogous to the soft-drink industry and the '405 patent, regulations have been enacted to curb deception in the advertising of distilled spirits. The code specifies that:

An advertisement of distilled spirits shall not contain:

....

(h) Deceptive advertising techniques. Subliminal or similar techniques are prohibited. "Subliminal or similar techniques," as used in this part, refers to any device or technique that is used to convey, or attempts to convey, a message to a person by means of images or sounds of a very brief nature that cannot be perceived at a normal level of awareness.<sup>106</sup>

The visual display bowl in the '405 patent is a veritable advertisement for the drink that is dispensed: "a message to a person by means of images."<sup>107</sup> Although the court is not bound by this

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103. *Id.* § 1459.

104. *Id.* § 1454.

105. *See, e.g.*, Guides for the Nursery Industry, 16 C.F.R. §§ 18.1–8 (2017) (preventing deceptive practices in the nursery industry); Guides for the Rebuilt, Reconditioned and Other Used Automobile Parts Industry, 16 C.F.R. §§ 20.1–3 (2017) (deception in the used automobile parts industry); Guides Concerning Use of Endorsements and Testimonials in Advertising, 16 C.F.R. §§ 255.1–5 (2017) (addressing deception in endorsements and testimonials in advertising); Guides for the Use of Environmental Marketing Claims, 16 C.F.R. §§ 260.1–17 (2017) (deception in environmental marketing); Funeral Industry Practices, 16 C.F.R. §§ 453.3–8 (2017) (addressing deception in funeral industry practices).

106. Advertising of Distilled Spirits, 27 C.F.R. § 5.65(a), (h) (2017) (emphasis omitted); *see also* Advertising of Wine, 27 C.F.R. § 4.64 (2017) (similar regulation for the advertising of wine).

107. 27 C.F.R. § 5.65(h).

regulation in the ‘405 Patent’s context, the court turned a blind eye to the deceptive advertising technique in the ‘405 patent instead of prohibiting it.

*c. First Amendment case law seeks to prevent consumer deception.* The *Juicy Whip* invention violates First Amendment protections. The invention 1) proposes a commercial transaction, 2) misleads the consumer, and 3) lacks a disclaimer to dissipate potential consumer deception. The visual display bowl of the ‘405 patent assumes the basic features of an advertisement. As stated in the ‘405 patent disclosure, the pre-mix bowl is a “visual beverage display that is a powerful merchandising tool for stimulating impulse buying.”<sup>108</sup> Essentially, the pre-mix bowl “propose[s] a commercial transaction,”<sup>109</sup> which is a signifier of commercial speech and deserves a separate First Amendment analysis.<sup>110</sup> Normally, speech that is false is protected by the First Amendment unless the speaker is motivated by actual malice;<sup>111</sup> however, commercial speech that is false and misleading is wholly unprotected.<sup>112</sup> This type of speech, found in commercial advertising, is designated as “lower value” speech.<sup>113</sup> It receives less protection than political speech or even hate speech because it is much easier to verify. A person who creates and advertises a product knows its specifications and, as such, incurs greater liability for propagating falsity.<sup>114</sup>

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108. U.S. Patent No. 5,575,405 col. 1 ll. 47–49.

109. *Pittsburgh Press Co. v. Pittsburgh Comm’n on Human Relations*, 413 U.S. 376, 385 (1973).

110. *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm’n of N.Y.*, 447 U.S. 557, 562 (1980).

111. *N.Y. Times Co. v. Sullivan*, 376 U.S. 254, 283 (1964).

112. *Va. State Bd. of Pharm. v. Va. Citizens Consumer Council, Inc.*, 425 U.S. 748, 777–78 (1976). *Rubin v. Coors Brewing Co.*, 514 U.S. 476, 496 (1995) (“The evils of false commercial speech, which may have an immediate harmful impact on commercial transactions, together with the ability of purveyors of commercial speech to control falsehoods, explain why we tolerate more governmental regulation of this speech than of most other speech.”).

113. See Genevieve Lakier, *The Invention of Low-Value Speech*, 128 HARV. L. REV. 2166 (2015).

114. *Va. State Bd. of Pharm.* 425 U.S. at 777–78 (internal quotation marks omitted) (“The advertiser’s access to the truth about his product and its price substantially eliminates any danger that governmental regulation of false or misleading price or product advertising will chill accurate and nondeceptive commercial expression. There is, therefore, little need to sanction some falsehood in order to protect speech that matters.”).

The doctrine that “the Constitution accords less protection to commercial speech than to other constitutionally safeguarded forms of expression” is telling.<sup>115</sup> Politically false statements and hate speech are accepted in the marketplace of ideas with the presumption that the truth will eventually rise to the top, but this is not tolerated in the marketplace of ideas for commercial speech. This is due to the government’s substantial interest in facilitating commerce by “insuring [sic] that the stream of commercial information flow[s] cleanly as well as freely.”<sup>116</sup>

In *Central Hudson Gas and Electric Corp. v. Public Service Commission of New York*,<sup>117</sup> the Supreme Court set forth a seminal test for assessing the protections afforded to commercial speech. The analysis balances the nature of the speech and the government interest asserted.<sup>118</sup> However, the test completely excludes commercial speech that is false, illegal, or deceptive, concluding that “[t]he government may ban forms of communication more likely to deceive the public than to inform it.”<sup>119</sup> If the court would have applied the First Amendment in *Juicy Whip I*, the ‘405 patent’s ability to deceptively advertise and propose a commercial transaction would likely have been forbidden.

Finally, as demonstrated by the requirements in the Fair Packaging and Labeling Act above, Congress may compel speech in certain circumstances, even though “compelling speech raises a First Amendment issue just as much as restricting speech.”<sup>120</sup> In the commercial context, the government can compel speech because “the extension of First Amendment protection to commercial speech is justified principally by the value to consumers of the information such speech provides.”<sup>121</sup> There is little value in consumer deception, hence “warning[s] or disclaimer[s] might be appropriately required . . . in

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115. *Bolger v. Youngs Drug Prods. Corp.*, 463 U.S. 60, 64–65 (1983).

116. *Va. State Bd. of Pharm.*, 425 U.S. at 772.

117. *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm’n of N.Y.*, 447 U.S. 557 (1980).

118. *Id.* at 563.

119. *Id.* at 563–64.

120. *Glickman v. Wileman Bros. & Elliott*, 521 U.S. 457, 505 (1997) (Thomas, J., dissenting).

121. *Zauderer v. Office of Disciplinary Counsel of Supreme Court of Ohio*, 471 U.S. 626, 651 (1985).

order to dissipate the possibility of consumer confusion or deception.”<sup>122</sup> As discussed in the following paragraph, the inventors of the ‘405 patent thought to use a disclaimer with their invention but chose not to do so.

After *Juicy Whip I*, a second suit ensued seeking to invalidate the ‘405 patent for, among other grounds, inequitable conduct (“*Juicy Whip II*”).<sup>123</sup> Originally, after a phone conversation with the California Department of Health Services, the inventors of the ‘405 juice dispenser intended to put a disclaimer on the pre-mix juice bowl because they were concerned “that the department [of Health Services] would have an objection to the dispenser because of potential consumer confusion.”<sup>124</sup> Gus Stratton, one of the inventors of the ‘405 dispenser,<sup>125</sup> drafted a letter to the California Department of Health Services stating that a disclaimer sticker would be placed on the bowl indicating that the liquid in the clear bowl is “for advertising purposes only,” with a sketch of a dispenser included in the letter.<sup>126</sup> However, the letter was never mailed, and the examining USPTO officer never received a copy of it.<sup>127</sup> The court in *Juicy Whip II* did not find this evidence probative because, as they concluded in *Juicy Whip I*, “an invention’s deceptive nature has no bearing upon its utility.”<sup>128</sup> However, this indicates the inventors of the ‘405 patent comprehended the marketing nature<sup>129</sup> of the juice dispenser. The clear pre-mix bowl functioned as nothing more than a visual advertisement, and it should have been treated as such.

Had the court assessed the speech value of the clear pre-mix bowl it would have applied intermediate scrutiny for commercial speech based upon the visual advertising functions of the bowl,<sup>130</sup> and it

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122. *In re R.M.J.*, 455 U.S. 191, 201 (1982).

123. *Juicy Whip, Inc. v. Orange Bang, Inc. (Juicy Whip II)*, 292 F.3d 728 (2002).

124. *Id.* at 735.

125. U.S. Patent No. 5,575,405.

126. *Juicy Whip II*, 292 F.3d at 735.

127. *Id.*

128. *Id.* at 745.

129. U.S. Patent No. 5,575,405 col. 1 ll. 47–49 (stating that a pre-mix bowl is a “visual beverage display that is a powerful merchandising tool for stimulating impulse buying”).

130. *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm’n of N.Y.*, 447 U.S. 557, 563 (1980) (“The First Amendment’s concern for commercial speech is based on the informational function of advertising.”).

would have found that it was unprotected commercial speech because of its misleading and deceptive nature—step one of the *Central Hudson* analysis.<sup>131</sup> In other words, the deceptive simulating function of the pre-mix bowl could have been prohibited because “there can be no constitutional objection to the suppression of commercial messages that do not accurately inform the public about lawful activity.”<sup>132</sup>

In sum, the *Juicy Whip* invention directly runs afoul of First Amendment protection: 1) the pre-mix bowl operates as an advertising mechanism that proposes a transaction, 2) the advertisement is misleading, and 3) no warning or disclaimer is used to correct its misleading nature.

#### IV. PUBLIC POLICY

Deceptive patents should be prohibited, for one reason, because they counteract the utilitarian objectives of patent law. It is broadly accepted that the purpose of the patent system is utilitarian—to promote innovation.<sup>133</sup> To achieve this purpose, a simple quid pro quo is required: a quasi-monopoly is created in exchange for the usefulness of the invention. The invention is useful in itself, in that it allows the public access to buy and use it, but the disclosure also advances the progress of science by disseminating how to create or practice the invention. This balance of interests between incentives for the inventor and benefits to the public is something that the legislature has grappled with for some time.<sup>134</sup>

Thomas Jefferson, although uncomfortable with granting limited monopolies, conceded to the idea upon a utilitarian basis. In correspondence with James Madison in 1788 Jefferson wrote: “[I]t is better to . . . abolish . . . Monopolies, in all cases, than not to do it in any . . . . The saying there shall be no monopolies lessens the

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131. *Id.*

132. *Id.* (“The government may ban forms of communication more likely to deceive the public than to inform it.”).

133. David S. Olson, *Taking the Utilitarian Basis for Patent Law Seriously: The Case for Restricting Patentable Subject Matter*, 82 TEMP. L. REV. 181, 182–83 (2009).

134. *Bilski v. Kappos*, 561 U.S. 593, 636 (2010) (Stevens, J., concurring) (“[T]he Patent Act was amended, revised, or codified some fifty times between 1790 and 1950” (quoting *Graham v. John Deere Co.*, 383 U.S. 1, 10 (1966))).

incitements to ingenuity, which is spurred on by the hope of a monopoly for a limited time, as of 14. [sic] years . . . .”<sup>135</sup> Madison replied, “With regard to Monopolies they are justly classed among the greatest nuisances [sic] in Government. But is it clear that as encouragements to literary works and ingenious discoveries, they are not too valuable to be wholly renounced?”<sup>136</sup> Later, Jefferson stated the rationalization of granting patents as “drawing a line between the things which are worth to the public the embarrassment of an exclusive patent, and those which are not.”<sup>137</sup> Surely if commercially-sound inventions are hardly worth the embarrassment of an exclusive patent, deceptive patents are not.

Ultimately, the Intellectual Property Clause of the Constitution is the highest authority on the utilitarian rationale of intellectual property: “To promote the Progress of Science and useful Arts” by way of “securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries . . . .”<sup>138</sup> The Constitution states the foremost purpose of intellectual property is to promote the progress of science and useful arts, and the means to fulfill that end is giving exclusive rights to writings or discoveries.

If the trade-off is a utilitarian one, not merely a property or common law right,<sup>139</sup> what benefit is derived from a purely deceptive invention? Where is the benefit to the deceived public? First, when consumers are deceived, there are already increased search costs as the consumer seeks to find out what the product actually is. Then, if

135. Letter from Jefferson to Madison (July 31, 1788), *in* 13 THE PAPERS OF THOMAS JEFFERSON 440, 442–43 (Julian P. Boyd & Mina R. Bryan eds., 1956).

136. Letter from Madison to Jefferson (Oct. 17, 1788), *in* 14 THE PAPERS OF THOMAS JEFFERSON 16–21 (Julian P. Boyd et al. eds., 1958) (footnote omitted).

137. 13 WRITINGS OF THOMAS JEFFERSON 335 (Andrew A. Lipscomb & Albert Ellery Bergh eds., 1904).

138. U.S. CONST. art. I, § 8, cl. 8. For analysis on the context and interpretations of the Intellectual Property Clause see Dotan Oliar, *Making Sense of the Intellectual Property Clause: Promotion of Progress as a Limitation on Congress’s Intellectual Property Power*, 94 GEO. L.J. 1771 (2006).

139. DONALD S. CHISUM ET AL., PRINCIPLES OF PATENT LAW 44 (3d ed. 2004) (“Locke’s natural rights theory and its impact with respect to intellectual property is dubious.”) For arguments that the Intellectual Property Clause is a property right see Adam Mossoff, *Who Cares What Thomas Jefferson Thought About Patents? Reevaluating the Patent “Privilege” in Historical Context*, 92 CORNELL L. REV. 953 (2007). *But see* *Graham v. John Deere Co.*, 383 U.S. 1, 5–10 (1966).

the consumer is deceived as to the product's nature, there are additional costs associated with finding the product they thought they were purchasing in the first place.<sup>140</sup> If a patent is already “dead weight”<sup>141</sup> on the market, to the extent that it exacts tolls from the public,<sup>142</sup> must we add additional search costs by condoning deceptive patents?

Second, it is unclear how novelty and obviousness, bars to patentability, would be evaluated for deceptive inventions. If a solely deceptive invention meets the standard for utility, such as the ‘405 patent in *Juicy Whip I*, what constitutes novelty?<sup>143</sup> Would the next deceptive invention have to exceed the deceptiveness of the first to be non-obvious? Would we assume the person having ordinary skill in the art possesses a certain amount of malignity?

Finally, if we are “promot[ing] the Progress of Science and useful Arts” through patent law,<sup>144</sup> is the government promoting consumer deception? Are we seeking to progress the art of deception? Do the makers of deceptive products deserve penalties in other areas of commerce yet a windfall in the patent realm? It would be duplicitous for Congress to establish trademark law to reduce consumer confusion and deception and, on the other hand, provide incentives in patent

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140. Mark P. McKenna, *A Consumer Decision-Making Theory of Trademark Law*, 98 VA. L. REV. 67 (2012). These are search costs not for a particular brand of product, but for a particular quality of product (natural v. artificial juice), which can be directly correlated from trademark law into deceptive patent features.

141. Daniel J. Gifford, *How Do the Social Benefits and Costs of the Patent System Stack Up in Pharmaceuticals?*, 12 J. INTELL. PROP. L. 75, 82 (2004) (“The patent system also generates inefficiencies: The patentee’s exclusive rights permit it to charge super-competitive prices for the patented product, with the result that some potential customers who value the invention at more than its cost of production but at less than the price charged by the patentee go unserved. In the language of economists, this is a deadweight loss, or a loss to society resulting from a misallocation of resources.”).

142. *Great Atl. & Pac. Tea Co. v. Supermarket Equip. Corp.*, 340 U.S. 147, 154 (1950) (emphasis added) (“Every patent is the grant of a privilege of *exact[ing] tolls from the public*. The Framers plainly did not want those monopolies freely granted. The invention, to justify a patent, had to serve the ends of science—to push back the frontiers of chemistry, physics, and the like; to make a distinctive contribution to scientific knowledge.”).

143. *Bilski v. Kappos* 561 U.S. 593, 655 (2010) (Stevens, J., concurring) (“As early as the 19th century, we explained that the patent laws are not intended to ‘creat[e] . . . monopolies, which enable [inventors] to lay a heavy tax upon the industry of the country, without contributing anything to the real advancement of the arts.’” (quoting *Atlantic Works v. Brady*, 107 U.S. 192, 200 (1883))).

144. U.S. CONST. art. I, § 8, cl. 8.

law to promote and encourage consumer deception. Surely, this is not what Congress intended.

#### V. AGAINST REVIVING MORAL UTILITY

Of course, it is difficult to fully gauge which industries may be affected by a change in the moral utility doctrine. After all, who could have foreseen that a patent on a juice dispenser could undo the longstanding moral utility doctrine. Legal commentaries often argue for or against the implementation of moral utility in the field of biotechnology,<sup>145</sup> however, depending how the moral bar to patentability is implemented it could have broad or narrow effects on various industries.

Two noteworthy industries that may be affected are gambling and biotechnology. With the background presented in this paper we could parse the moral utility doctrine into two views: an expansive view,<sup>146</sup> set forth by Justice Story and comprising any immoral invention, and a restricted view, encompassing point-of-sale deception.<sup>147</sup> Under the restricted view, for which this paper advocates, gambling patents are most at risk. Yet, under a more expansive view biotechnology patents could also be at risk.

Although only some gambling patents would be at risk, there are major economic incentives keeping the gambling industry undisturbed. Gambling is a mainstay for some states, such as Nevada. It is also a very lucrative business that brings U.S. merchants \$240 billion every year.<sup>148</sup> However, gambling machines employ various

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145. A large majority of recent publications on the moral utility doctrine have focused on biotechnology. See, e.g., Margo A. Bagley, *Patent First, Ask Questions Later: Morality and Biotechnology in Patent Law*, 45 WM. & MARY L. REV. 469 (2003); Benjamin D. Enerson, Note, *Protecting Society from Patently Offensive Inventions: The Risk of Reviving the Moral Utility Doctrine*, 89 CORNELL L. REV. 685 (2004); Laura A. Keay, *Morality's Move Within U.S. Patent Law: From Moral Utility to Subject Matter*, 40 AIPLA Q.J. 409, 411 (2012).

146. See *supra* Section II.A.

147. See *supra* Section III.B.2.

148. Kimberly Pierceall, *The US Gambling Industry Is Worth \$240 Billion*, BUS. INSIDER (Sep. 30, 2014, 5:55 PM), <http://www.businessinsider.com/the-us-gambling-industry-is-worth-240-billion-2014-9>.

forms of psychological trickery, such as “near misses,”<sup>149</sup> that are deceptive in nature.<sup>150</sup> Taken together, these gambling devices would not be patentable under a restricted view of moral utility, because they promote deception at the point of sale.<sup>151</sup> This measure may be fiercely opposed by the gambling industry, but it is merely a necessary initial step in introducing consumer protection to gambling devices.<sup>152</sup> After all, a rejected patent is not the death knell for any technology, only an indication that the technology is undeserving of a state-sanctioned monopoly. As discussed throughout this paper, deceptive patents are incongruous with multiple areas of the law, and their undoing justifies the incidental effects the moral utility doctrine would have on some gambling patents.

The primary concern associated with reviving a broad view of the moral utility doctrine is the effect it will have on biotechnology.<sup>153</sup> Biotechnology has evolved exponentially over the past few decades. This has also allowed scientists to perform unimaginable tests and perfect life-enhancing alterations, but it has also allowed scientists to play God through cloning and gene editing technologies.<sup>154</sup> CRISPR/CAS9, a recently discovered gene editing technique, holds

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149. See generally Ferris Jabr, *How the Brain Gets Addicted to Gambling*, SCI. AM. (Nov. 1, 2013), <https://www.scientificamerican.com/article/how-the-brain-gets-addicted-to-gambling>.

150. John Rosengren, *How Casinos Enable Gambling Addicts*, ATLANTIC (Dec. 2016), <https://www.theatlantic.com/magazine/archive/2016/12/losing-it-all/505814> (explaining that “near misses,” deliberately misleading features, are included in many gaming machines). Nelson Rose, one of the world’s leading experts on gaming law, notes that

Nevada regulations operate on the theory that a sophisticated player would be able to tell the real odds of winning by playing a machine long enough. The gambling industry maintains that deceptive near misses do not occur in North American gaming machines, but as Schüll has noted, it has developed a more narrow definition of *deceptive near misses*, which still allows for ‘subliminal inducements.’

*Id.*

151. *Id.*

152. *Id.* (“Informed choice [is] the central tenet of consumer protection, which is why when you apply for a loan, the bank has to tell you the interest rate and how it’s calculated. It’s why many state lotteries have to disclose their odds, and it’s why even the contests on the backs of cereal boxes list the chances of winning a prize. Yet such essential disclosure is not required of electronic gaming machines.”).

153. See *supra* note 145.

154. See David Benjamin Turitz Cox et al., *Therapeutic Genome Editing: Prospects and Challenges*, 21 NATURE MED. 121 (2015).

immense promise.<sup>155</sup> Through this technique many, if not all, genetic diseases could be cured,<sup>156</sup> but researchers could also use this technique to form chimeras,<sup>157</sup> human-animal species. Thus, the technology would have vast use in society, but it might also cross into an unethical realm. Some think these patents should exist to promote life-saving technologies,<sup>158</sup> while others argue patents are unnecessary to promote this type of biotechnological innovation.<sup>159</sup> Scholars have advocated for the revival of the moral utility doctrine to block biotechnology patents because of their potential moral failures,<sup>160</sup> but this paper strictly proposes reviving the moral utility doctrine for deceptive patents.

Strong opinions are involved wherever morals are at issue, so there is no “easy” answer, but this Note has sought to simplify the analysis by analyzing a distinct subcategory: deceptive patents.

## VI. CONCLUSION

The legislature or judiciary should carve out an exception to patentability, specifically prohibiting point-of-sale deception for patent applications. It would not be the first time the legislature has carved out an exception, as indicated by the court in *Juicy Whip I*.<sup>161</sup> This restriction to patentability would not be new, only a return to principles that guided the previous 180 years of American patent law.

In part, I agree with the *Juicy Whip I* court. The legislature should enact a law preventing deceptive patents. However, I do not believe the Federal Circuit had sufficient grounds to forsake the doctrine in the first place. Congress’s silence on the moral utility doctrine is not a denunciation of it. Moral utility is a fundamental aspect of patent law and can be traced to intellectual property’s very origins. It plays a

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155. *Id.*

156. Megan Molteni, *CRISPR May Cure All Genetic Disease—One Day*, WIRED (June 7, 2017, 5:03 PM), <https://www.wired.com/2017/06/crispr-may-cure-genetic-disease-one-day>.

157. Megan Molteni, *First Human-Pig Chimera is a Step Toward Custom Organs*, WIRED (Jan. 26, 2017, 3:04 PM), <https://www.wired.com/2017/01/first-human-pig-chimera-step-toward-custom-organs/>.

158. See Enerson, *supra* note 145, at 685.

159. See Bagley, *supra* note 145, at 469.

160. *Id.*

161. *Juicy Whip, Inc. v. Orange Bang, Inc. (Juicy Whip I)*, 185 F.3d 1364, 1368 (Fed. Cir. 1999) (noting that Congress previously exempted special nuclear material and atomic weapons from patentability).

complementary role to other doctrines that prevent consumer deception and should be embraced, either judicially or legislatively, as an inherent principle of the Intellectual Property Clause.

I do not take the position that all deception is bad, only the deception that occurs when consumers make a value judgment about the quality of goods at the point of sale. Post-sale confusion and initial interest confusion may serve a useful function, as the court indicated, through imitative products such as cubic zirconium, laminate flooring, or any number of articles brought about through the Industrial Revolution. However, indistinguishable imitative features become more pernicious the nearer a purchaser is to the point of sale.

Neither do I advocate the prohibition of deceptive inventions entirely. That is not the prerogative of the Patent and Trademark Office. That, as the court in *Juicy Whip I* correctly stated, is the job of the Federal Trade Commission and the Food and Drug Administration, to “protect[] consumers from fraud and deception in the sale of food products.”<sup>162</sup> The Patent and Trademark Office’s responsibility is to *promote* the progress of science and arts. To promote a practice is appreciably different from prohibiting a practice or merely allowing it to occur. This is the point that the court in *Juicy Whip I* failed to acknowledge: if the deceptive feature has utility to the consumer, it will prevail without the endorsement of a quasi-monopoly. A rejection to patentability is not the death knell for an invention. In fact, the Supreme Court, and many others, have questioned whether patents are even necessary to encourage certain forms of innovation.<sup>163</sup>

The Federal Circuit’s acquiescence of deceptive patents in *Juicy Whip I* not only cuts against moral utility precedent and sound public policy, but also conflicts with trademark, free speech, and federal code prohibitions. The legislature or judiciary should take steps to implement the deceptiveness bar to patentability to promote true

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162. *Id.*

163. *Bilski v. Kappos*, 561 U.S. 593, 651 (2010) (Stevens, J., concurring) (holding the large majority of business methods unpatentable). “Many have expressed serious doubts about whether patents are necessary to encourage business innovation.” *Id.*

innovation, prevent dead-weight loss, and ensure that “the stream of commercial information flow[s] cleanly as well as freely.”<sup>164</sup>

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164. Va. State Bd. of Pharm. v. Va. Citizens Consumer Council, Inc., 425 U.S. 748, 772 (1976).

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