

AIPLA/IPO/ABA-IPL Joint Principles Paper on Section 101

Congress Must Remedy Uncertainty in 35 U.S.C. §101 and Return Balance to the U.S. Patent System

- Uncertainty about what types of inventions qualify at the most basic level for patenting undermines the US patent system. Due in part to this uncertainty, the strength of the US Patent System has been called into question.
- In order to restore its strength, our patent system must again be forward-looking, flexible enough to embrace entirely new unimaginable fields of endeavor, and not restricted to historical conceptions of technology. Just as the new technologies of the past two decades were unknown and unpredictable in the 70's and 80's, the technologies of the future are unknown to us today.
- Unfortunately, the Supreme Court's interpretation of patent eligibility in cases such as *Mayo*, *Myriad* and *Alice* overrides the subject matter categories set forth in the 1952 Patent Act. These cases undermine the fundamental principles of patent scope established by that statute which was intended to serve as the basis for our modern innovation economy when adopted.
- The Supreme Court's jurisprudence has injected significant ambiguity into the eligibility determination by blurring the lines between eligibility on the one hand and patentability (novelty, non-obviousness, and sufficiency of the disclosure) on the other, which were delineated in the 1952 Act. For example, this jurisprudence has improperly instructed courts and the PTO to assess whether claimed subject matter is "well known," "routine," or "conventional or obvious" as part of the eligibility determination.
- The uncertainty created by *Mayo*, *Myriad* and *Alice* is threatening investment in new technologies including new medical products and software technology. This raises a significant risk to the U.S.'s continued leadership in innovation, in those and many other technologies.
- The Supreme Court's refusal to further review [lower court decisions following *Mayo*, *Myriad*, and *Alice*](#) underscores that a judicial solution to this problem will not be forthcoming in the foreseeable future.
- As even the Supreme Court itself has recognized, the proper scope of coverage of our nation's patent system is a policy matter for Congress. *See* *Gottschalk v. Benson*, 409 U.S. 63, 72-73 (1972). Thus, legislative reform is needed now to restore predictability to the patent system and to maintain incentives to invest in future cutting-edge technologies and discoveries.
- A legislative solution must provide for the following:
 - To avoid potential confusion between the patentability requirements of novelty expressed in Section 102 and patent eligibility under Section 101, the term "new" should be removed from the current version of Section 101.

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- To clarify that patent eligibility under Section 101 should be found if an invention or discovery meets the statutory classes of eligibility contained in the current version of Section 101, Section 101 should provide that an invention shall qualify, not “may” qualify, if it meets those statutory classes.
- Congress must make clear that an invention qualifies for patent eligibility if it falls into one of the existing categories in current Section 101, i.e., if the invention is a useful process, machine, manufacture, or composition of matter, or any useful improvement thereof.
- Limited statutory exceptions to the qualification of an invention as patent eligible are appropriate provided those exceptions are written clearly and narrowly. These exceptions should be subject-matter neutral so as to not discriminate in favor of or against any field of invention that has been developed or may be developed in the future.
- Patent eligibility is to be determined based upon consideration of the claims of the patent or application as a whole, without ignoring or reading out any limitation recited in the claims. Patent eligibility is not to be determined based on “the gist of the invention” or an assessment of whether the claims define an “inventive concept.”
- Patent eligibility under Section 101 shall not be negated based on considerations of patentability defined in Sections 102, 103 and 112, including whether the claims recite elements or subject matter that is considered “conventional,” “routine,” “well known,” “not unique” or that operates according to “known principles”, or the like.
- Once a patent is granted, the claimed subject matter should be presumed eligible.