

Section 101: Will We Have Legislation?

SHOOK
HARDY & BACON

24th Annual Advanced Patent Law Institute UT Law CLE

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35 U.S.C. § 101 – Legislative Activity

- **Bipartisan and Bicameral Interest in Addressing Patentable Subject Matter Issues Under Section 101**
 - IP Subcommittee of Senate Judiciary Committee held series of closed roundtables among various stakeholder groups, beginning in December 2018
 - In April 2019, Senator Coons and Tillis and Reps. Collins, Johnson and Stivers release a 101 Framework

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35 U.S.C. § 101 – Legislative Activity

DRAFT OUTLINE OF SECTION 101 REFORM

- Keep existing statutory categories of process, machine, manufacture, or composition of matter, or any useful improvement thereof.
- Eliminate, within the eligibility requirement, that any invention or discovery be both “new and useful.” Instead, simply require that the invention meet existing statutory utility requirements.
- Define, in a closed list, exclusive categories of statutory subject matter which alone should not be eligible for patent protection. The sole list of exclusions might include the following categories, for example:
 - Fundamental scientific principles; Products that exist solely and exclusively in nature; Pure mathematical formulas; Economic or commercial principles; Mental activities.

35 U.S.C. § 101 – Legislative Activity

DRAFT OUTLINE OF SECTION 101 REFORM

- Create a “practical application” test to ensure that the statutorily ineligible subject matter is construed narrowly.
- Ensure that simply reciting generic technical language or generic functional language does not salvage an otherwise ineligible claim.
- Statutorily abrogate judicially created exceptions to patent eligible subject matter in favor of exclusive statutory categories of ineligible subject matter.
- Make clear that eligibility is determined by considering each and every element of the claim as a whole and without regard to considerations properly addressed by 102, 103 and 112.

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"Section 101 in Two Realms: Where We Are and Where We Might Be Going in Life Sciences and in Software"