

IPLAC 35 U.S.C. § 101 Language Reform Resolution

A chart comparing the legislative resolutions of various organizations, including IPLAC, for amending subject matter eligibility under 35 U.S.C. §101 is shown below. Additions to the current statutory law have been underlined, and deletions to the current statutory law have been stricken through. Highlighted portions correspond to key differences in the various resolutions.

<u>Current Statutory Law</u> <u>(35 U.S.C. § 101)</u>	<u>IPLAC Resolution</u>	<u>IPO Resolution</u>	<u>AIPLA Resolution</u>
Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.	<i><u>101(a) Eligible Subject Matter:</u> Whoever invents or discovers, <u>and claims as an invention</u>, any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement <u>thereto</u>, <u>shall be entitled to¹</u> thereof, may obtain a patent for a claimed invention thereof therefor, <u>subject only to the exceptions, conditions, and requirements set forth in this Title of this title.</u>²</i>	<i><u>101(a) Eligible Subject Matter:</u> Whoever invents or discovers, <u>and claims as an invention</u>, any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement <u>thereto</u>, <u>shall be entitled to</u> thereof, may obtain a patent for a claimed invention thereof therefor, <u>subject only to the exceptions, conditions, and requirements set forth in this Title of this title.</u></i>	<i><u>101(a) Eligible Subject Matter.—</u> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, <u>shall be entitled to</u> may obtain a patent therefor, <u>subject only to the conditions and requirements set forth in of this title.</u></i>

¹ The IPLAC resolution adopts the language “shall be entitled to a patent . . .” from both the IPO and AIPLA resolutions instead of the original “may obtain” or possible alternative softer language, such as “shall be eligible to a patent.” While an applicant is not entitled to a patent unless they comply with certain requirements, including paying fees, all requirements for obtaining a patent grant, including fees, are included in Title 35 (e.g., 35 U.S.C. § 41 lists all patent fees.)

² The IPLAC resolution deletes the term, “new” which is included in the current §101. The reasoning behind this deletion is because the existing statutory language in the section governing patent eligibility may have caused confusion and led various courts to conflate the issue of patent eligibility with the issue of novelty, resulting in an eligibility analysis that involved comparing the invention to the prior art. Section 101 was never intended to express the novelty requirement.

The second change that the IPLAC resolution includes is the addition of the words “*shall be entitled to*” in lieu of the words “may obtain,” which have been deleted. The reasoning behind this change is that it eliminates the inference from the language contained in the current statutory law that Congress has given the USPTO and courts discretion with respect to granting patents on patent applications that meet the requirements of the patent statute. The USPTO and courts do *not* have discretion as to whether applicants who comply with the statutory requirements of United States patent law are entitled to patent rights.

The third change featured in the IPLAC resolution is the replacement of the phrase “subject to the conditions and requirements of this title” with “subject *only* to the conditions and requirements *set forth* in this title” which makes clear that the conditions and requirements of patentability are set forth in the patent statute, and the conditions and requirements set forth in the statute are the *only* conditions and requirements of patentability. This means that Congress has not granted the USPTO nor the courts the ability to create its own conditions and requirements of patentability that are not expressly set forth in the patent statute.

<u>Current Statutory Law</u> <u>(35 U.S.C. § 101)</u>	<u>IPLAC Resolution</u>	<u>IPO Resolution</u>	<u>AIPLA Resolution</u>
	<i>101(b) Sole Exceptions to Subject Matter Eligibility: A claimed invention is ineligible under subsection (a) if and only if the claimed invention as a whole exists in nature independently of and prior to any human activity³, or exists solely in the human mind⁴. In determining eligibility, each claimed invention shall be considered as a whole.⁵</i>	<i>101(b) Sole Exception to Subject Matter Eligibility: A claimed invention is ineligible under subsection (a) if and only if the claimed invention as a whole, as understood by a person having ordinary skill in the art to which the claimed invention pertains, exists in nature independently of and prior to any human activity, or exists solely in the human mind.</i>	<i>101(b) Sole Exceptions to Subject Matter Eligibility.—A claimed invention is ineligible under subsection (a) only if the claimed invention as a whole exists in nature independent of and prior to any human activity, or can be performed solely in the human mind.</i>

³ The IPLAC resolution includes two exceptions as part of the newly created subsection (b) of §101, consistent with both IPO and AIPLA. The first exception to patent eligibility is directed to the laws of nature and natural phenomena, which are two of the judicially recognized exceptions that were first revealed in *Bilski v. Kappos*, 561 U.S. 593 (2010). The IPLAC resolution uses the phrase “*exists in nature independently of and prior to any human activity.*” As a matter of public policy, no one is entitled to a patent on something that exists in nature independently of and prior to any human activity. However, a claim to anything *beyond* what existed in nature independently of and prior to any human activity should be eligible for patenting, which this proposed exception allows for. One example of a law of nature which would trigger this exception would be Albert Einstein’s famous equation: $E=mc^2$. Einstein would not be entitled to a patent on this discovery because it already existed in nature, independent of and prior to any human activity. The IPLAC resolution does not include the phrase “as understood by a person having ordinary skill in the art to which the claimed invention pertains” from the IPO resolution. The reasoning behind this difference is that such phrase could be open to judicial interpretation. Whether an invention existed in nature independently of and prior to human activity is not open to interpretation about what a person of skill understands—it either would or would not exist in nature.

⁴ The second exception to patent eligibility is directed to abstract ideas, which is the third judicially recognized exception that was first revealed in *Bilski v. Kappos*, 561 U.S. 593 (2010). The IPLAC resolution uses the phrase “*exists solely in the human mind.*” This exception overrules *Alice Corp. v. CLS Bank Int’l*, 134 S. Ct. 2347 (2014). The U.S. Patents Committee adopted this language for its clarity and conciseness. This exception prohibits any purely mental phenomena from being patented. Thus, this exception would make eligible any claim limitation that requires some external involvement with the physical world or any representation thereof (e.g., data in a computer). The IPLAC resolution adopted the language from IPO (“exists solely in the human mind”) rather than from AIPLA (“can be performed solely in the human mind”). The reasoning behind this difference is that whether something *can be performed solely in the human mind* would be open to interpretation. It would be difficult to draw a line between what can and cannot be performed solely in the human mind. Such determination would depend on the skill of the person performing the activity in his/her mind. While a simple analysis (i.e., $2+2=4$) could be performed solely in the human mind, it would be difficult to draw a line between whether more complex inventions could or could not be performed *solely* in the human mind because it would depend on the skill of the person completing the performance.

⁵ The IPLAC resolution includes the following clause at the end of subsection (b) of §101: “*In determining eligibility, each claimed invention shall be considered as a whole.*” This sentence is intended to eliminate the ability of the USPTO and the courts to focus the patentability analysis on the “heart of the invention” or what the invention is “directed to” rather than the actual, stated claim language and limitations.

<u>Current Statutory Law</u> <u>(35 U.S.C. § 101)</u>	<u>IPLAC Resolution</u>	<u>IPO Resolution</u>	<u>AIPLA Resolution</u>
	<p><u>101(c) Sole Eligibility Standard:</u> <u>The eligibility of a claimed invention under subsections (a) and (b) shall be determined without regard to (i) the requirements or conditions of sections 102, 103, and 112 of this Title, (ii) the manner in which the claimed invention was made or discovered, or (iii) the claimed invention's inventive concept⁶.</u></p>	<p><u>101(c) Sole Eligibility Standard:</u> <u>The eligibility of a claimed invention under subsections (a) and (b) shall be determined without regard as to the requirements or conditions of sections 102, 103, and 112 of this Title, the manner in which the claimed invention was made or discovered, or the claimed invention's inventive concept.</u></p>	<p><u>101(c) Sole Eligibility Standard.—</u> <u>The eligibility of a claimed invention under subsections (a) and (b) shall be determined without regard to the requirements or conditions of sections 102, 103, and 112 of this title, the manner in which the claimed invention was made or discovered, or whether the claimed invention includes an inventive concept.</u></p>

⁶ Section 101(c) of the IPLAC resolution addresses the increasing problem with the USPTO and courts confusing patent eligibility with other standards under the Patent Act. Consistent with both the IPO and AIPLA resolutions, the IPLAC resolution in this subsection prohibits the USPTO and courts from determining patent eligibility using any of the requirements or conditions of patentability separately stated in Sections 102, 103, and 112 of the Patent Act. The IPLAC resolution includes language at the end of subsection (c) that clearly overturns the Supreme Court's second part of the current patent eligibility test articulated in *Mayo* and *Alice*. (*Alice Corp. v. CLS Bank Int'l*, 134 S. Ct. 2347, 2355 (2014) (citing *Mayo v. Prometheus* 132 S. Ct. 1289, 1297 (2012)). Specifically, the IPLAC resolution expressly prohibits the USPTO and courts from determining patent eligibility by considering whether the claimed invention, in whole or in part, include an "inventive concept."