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Dear All,
I have a proposal regarding the Request for information issued by Department of Commerce – USPTO. The proposal is for improving the parameters for determining patentable subject matter in the U.S. The proposal for amending § 101 of the Patent Act, are a combination between the Alice/Mayo two step test and the EPO (European Patent Organization) approach of a negative definition of the scope of the patentable subject matter or defining what is not eligible to be patent. So, the final look of the amended § 101 of the Patent Act will make a clearer space for the inventors and the patent examiners when they are faced with the judiciary established test for patent subject matter eligibility. This, however, gives little possibility, for arbitrary interpretation of the amended provision by the courts and the USPTO. The purpose of this amendment is not to lower the flexibility of the current text of the provision, but to produce as much certainty as possible for the involved parties in the patentable subject matter eligibility examination process.

1. Proposal for New Scope of the Patentable Entitled Inventions
When we see the text of the current § 101 of the Patent Act, as we previously compared it with its EPO counterpart, the proposed amendment of the Section will maintain the legislative minimalist approach of Congress. The proposed amendment for § 101, which encompasses a new scope of the patentable entitled inventions, is proposed as the following:
“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. In no case inventions that are merely abstract ideas and whose applications are composed only of elements that are well-understood, routine and conventional in nature as understood by a person having ordinary skill in the art, shall be considered as patentable subject matter.”
In this proposal, the second sentence from the amended § 101 of the Patent Act will include all the efforts of the judiciary, the administration, and the law of science in clearing the patentable subject matter eligibility of the applications. The proposed sentence is more compelling towards the work which is already done by the judiciary and the executive branch in the field of defining the scope of patentable subject matter. The idea is to adopt the positive and balancing aspects of the already earned experience by combining it with the

experience of the EPO. Also, the proposed amendment will make a more flexible approach towards the implementation of the provisions of the Patent Act by the courts and the USPTO and will open a path for more certainty and confidence in the process by the inventors and the other participants in patent prosecution and litigation.

2. Abstractness as One of the Requirements of the Amendment
The proposed amendment, after determining whether a certain invention is encompassed in the statutorily recognized categories of patentable subject matter, also includes determining the abstractness of an invention. This step is, as we mentioned already, established as one of the two step Alice/Mayo test developed by the federal courts. Abstractness as a standard for patentable subject matter ineligible inventions directly connects the positively determined categories of patentable inventions from the current statutory provision and the court determined categories of abstract activities. This element of the proposal in a excluding manor determines which inventions are not patentable by focusing on their implementation by a person having ordinary skill in the art.

3. Inclusion of the Well-understood, Routine and Conventional in Nature Element(s)
In the proposed amendment of §101, the well-established judiciary doctrine of the “well-understood, routine and conventional in nature element(s)” standard is included. As we explained in Part I, this standard had been an issue for the USPTO in its incorporation into the patent examining procedure. The proposal also is in line with the EPC in that it gives more certainty in defining the scope of the patentable subject matter eligible business methods, software, and other disputable processes as patents. However, the issue in defining what is patent subject matter eligible, which is the main characteristic of the EPC solution, is combined with the elements of the Alice/Mayo test. It will make a more flexible U.S. approach towards the examining of the patentable subject matter of the process type inventions and will make a step towards harmonization of the U.S. patentable subject matter eligibility examination process with the EPO’s approach.
This Proposal is elaborated in more details in my paper PERFECTING U.S. PATENTABLE SUBJECT MATTER – MERGING THE EUROPEAN APPROACH AND THE AMERICAN PRINCIPLES, 19 Chicago-Kent J. Intellectual Prop., 178.

Attachments 1

Perfecting U.S. Patentable Subject Matter - Merging the European

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