

# Drafting and Prosecuting Under Current Section 101 Guidance

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USPTO Madison Building

*haynesboone*

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## Agenda

- 35 U.S.C. § 101 Introduction
- 2019 Revised Patent Subject Matter Eligibility Guidance (“2019 PEG”)
- New Subject Matter Eligibility Examples
- Takeaways and Tips
  - Takeaways
  - Tips
    - Preparation
    - Prosecution

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# 35 U.S.C. § 101

“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 . . . .”\*

\*Courts have created judicial exceptions:

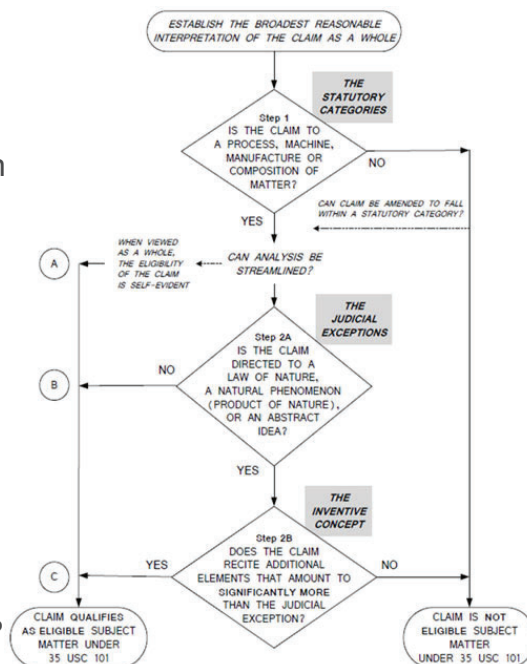
- abstract ideas
- laws of nature
- natural phenomenon

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## Mayo/Alice Test

- **Step 1 (Statutory Categories):** Is the claim to a process, machine, manufacture or composition of matter?
- **Step 2A (Judicial Exceptions):** Is the claim “directed to” a judicial exception?
- **Step 2B (Inventive Concept):** Does the claim recite “significantly more” than the judicial exception?



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# 2019 Revised Patent Subject Matter Eligibility Guidance

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## USPTO Eligibility Analysis

- Step 1\*: Statutory Category?
- Step 2A - Prong One: Judicial Exception Recited?
  - Limited to three groupings
- Step 2A - Prong Two: Integrated Into a Practical Application?
- Step 2B\*: Inventive Concept?

\*Steps 1 and 2B unchanged

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## Title search: Drafting and Prosecution Under Current Section 101 Guidance: Technology

Also available as part of the eCourse

[2019 Advanced Patent Law \(USPTO\) eConference](#)

First appeared as part of the conference materials for the  
14<sup>th</sup> Annual Advanced Patent Law Institute session

"Drafting and Prosecution Under Current Section 101 Guidance: Technology "