NORTON ROSE FULBRIGHT

Advanced Patent Law Institute: Section 101 in the Life Sciences



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1

COVID-19: Why you might be more interested in life sciences in 2020

- Methods claims
  - Diagnostic assays for detecting if you are infected with the novel coronavirus known as SARS-CoV-2
  - Diagnostic assays for detecting if you have been previously infected with SARS-CoV-2 and possibly have immunity to the virus
  - Methods of generating an immune response against SARS-CoV-2 (vaccination)
  - Methods of treating COVID-19
- Composition claims
  - Vaccines (attenuated virus, mRNA, peptide)
  - New therapeutics (antibodies or small molecule drugs)

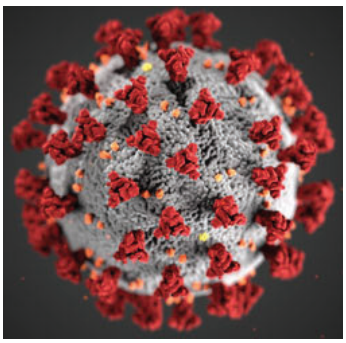


Photo from CDC website

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USPTO Guidance

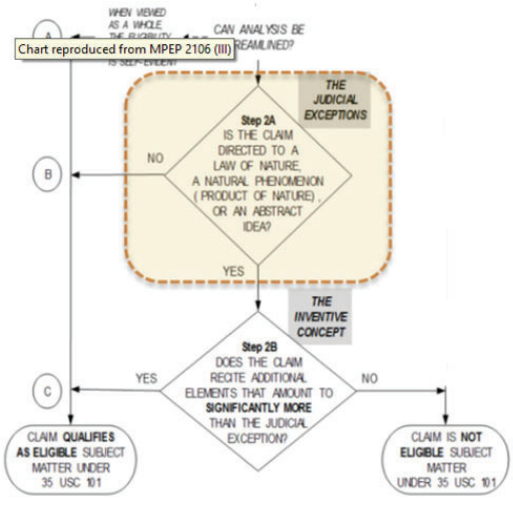
- *2019 Revised Patent Subject Matter Eligibility Guidance* (2019 PEG) (January 7, 2019)
- *Berkheimer* Memorandum
- *Finjan* Memorandum
- MPEP §§ 2103 – 2106 (2106.04(II) superseded and 2106.07(a) and (b) affected)
- *Subject Matter Eligibility Examples Abstract Ideas* (Examples 37-42) (January 7, 2019)
- *October 2019 Update with* Appendices *1-3* (October 17, 2019)
  - Appendix 1: Life Sciences & Data Processing Examples 43-46
  - Appendix 2: Comprehensive Index of Examples for Use with 2019 PEG
  - Appendix 3: List of Selected Eligibility Cases from Supreme Court and Federal Circuit

3

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3

Prior USPTO Guidance

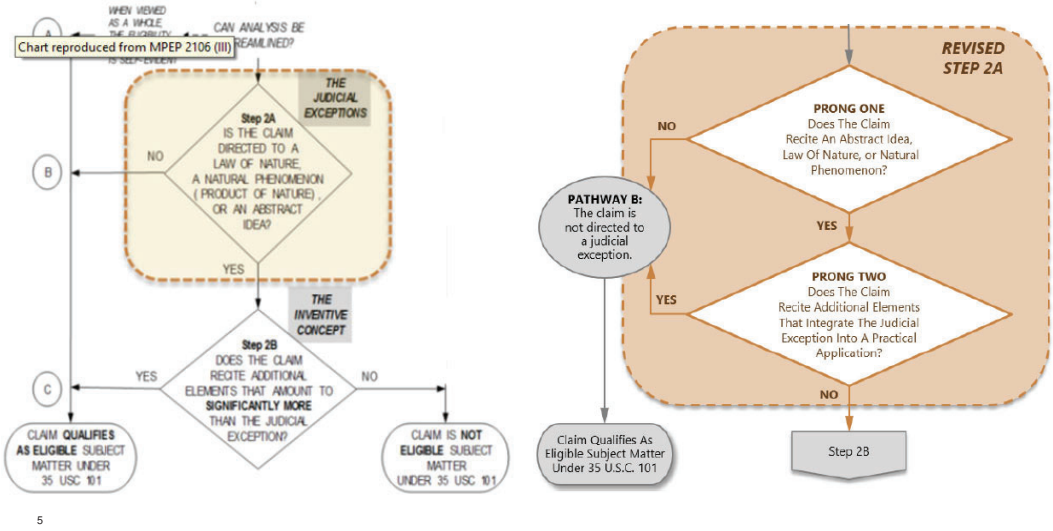


4

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4

New Guidance: Revised Judicial Exception (Step 2A)



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5

USPTO Guidelines

- Revised Step 2A – Second Prong
  - Determine whether there are any additional elements recited in the claim beyond the judicial exception(s).
  - Determine whether the additional elements integrate the judicial exception into a practical application of the judicial exception.
    - Practical application will apply, rely on, or use the judicial exception in a manner that imposes a meaningful limit on the judicial exception, such that the claim is more than a drafting effort designed to monopolize the exception.
    - No evaluation of whether additional elements amount to well-understood, routine, and conventional activity permitted at Revised Step 2A – Second Prong.

6

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Also available as part of the eCourse
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First appeared as part of the conference materials for the
25th Annual Advanced Patent Law Institute session
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