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Demonstrating Patent Eligibility Post-Alice

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PATENTABLE SUBJECT MATTER

- Whoever invents or discovers <u>any</u> new and useful <u>process</u>, <u>machine</u>, <u>manufacture</u>, or <u>composition of matter</u>, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title. 35 U.S.C. § 101.
- The term "process" means process, art or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material. 35 U.S.C. § 100(b).
- "Excluded from such patent protection are <u>laws of nature</u>, <u>natural</u> <u>phenomena</u>, and <u>abstract ideas</u>." Diehr (S. Ct. 1981).

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JUDICIALLY CREATED EXCEPTIONS

- Does the claimed invention fit in one of the four statutory categories of § 101?
- If so, does the claim contain an abstract idea?
- If so, does it recite patent-eligible subject matter?
 - The mental-steps doctrine (Gottschalk v. Benson)
 - The point of novelty test (Parker v. Flook)
 - The machine or transformation test (Bilski v. Kappos)
 - The abstract idea test (Bilski v. Kappos)
 - The generic computer test (Alice v. CLS)

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Treatment of 35 U.S.C. § 101 at the Supreme Court

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GOTTSCHALK V. BENSON (S. CT. 1972)

- The patent claimed "converting binary-coded decimal (BCD) numerals to pure binary numerals."
 - "Here the 'process' claim is so abstract and sweeping as to cover both known and unknown uses of the BCD to pure binary conversion."
- The practical effect of patenting the formula ... would be to patent an idea and "would wholly <u>pre-empt</u> the mathematical formula."
- "Phenomena of nature, though just discovered, <u>mental processes</u>, and abstract intellectual concepts are not patentable, as they are the basic tools of scientific and technological work."

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GOTTSCHALK V. BENSON (S. CT. 1972)(CONT'D)

- '(w)hile a scientific truth, or the mathematical expression of it, is not patentable invention, a novel and useful structure created with the aid of knowledge of scientific truth may be.' That statement followed the longstanding rule that '(a)n idea of itself is not patentable.'
- "If these programs are to be patentable...action by the Congress is needed."

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