

# §101 Subject Matter Eligibility Reform

By

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## 35 U.S.C. 101: *INVENTIONS PATENTABLE*

- “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.”
- Translation

## Presentation Overview

- Subject Matter Eligibility in the U.S.
- Translation
- Coons-Tillis Framework
- What's Next?

## §101 Treatment In Federal Courts

- Judicial Exceptions:  
*Diamond v. Diehr*  
(1981)
  - Laws of Nature
  - Natural Phenomena
  - Abstract Ideas
- Translation

## §101 Treatment In Federal Courts

- Abstract Analysis: *Mayo Collaborative Services v. Prometheus Labs, Inc.* (2012) & *Alice Corporation v. CLS Bank International* (2014)
  - Step 1: Is the claim for a “process, machine, manufacture, or composition of matter”?
    - No->Ineligible
    - Yes->Step 2
- Translation

## §101 Treatment In Federal Courts

- *Mayo-Alice Test Continued...*
  - Step 2A: Is the claim “directed to” a judicial exception?
    - No->Eligible
    - Yes->Step 2B
  - Step 2B: Is there an ‘inventive concept’ that is “significantly more than the excluded subject matter to transform that abstract idea into a patent-eligible invention”?
    - No->Ineligible
    - Yes->Eligible
- Translation

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## Title search: Section 101 Subject Matter Eligibility Reform

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[2020 Advanced Patent Law \(USPTO\) eConference](#)

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

"Section 101: High Tech v. Life Sciences"