

Disruptive 35 U.S.C. §101 CAFC Decisions

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AGENDA

- Brief Overview of §101
- Disruptive Federal Circuit Decisions
- Impact on 2019 PEG
- Practice Tips

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§101 Overview

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Patentable Subject Matter: 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, 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 laws of nature, natural phenomena, and abstract ideas.” Diehr (S. Ct. 1981).

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Judicially Created Exceptions: *In re Nuijten* & *Alice v. CLS Bank*

- In *In re Nuijten* and *Alice v. CLS Bank*, the Federal Circuit and the Supreme Court set forth the following test for patent-eligible subject matter:
 - Does the claimed invention fit in one of the four statutory categories of § 101? (process, machine, manufacture, or composition of matter)
 - If so, does the claim contain an abstract idea? (If not, the claim is eligible)
 - If so, does it recite “something more” than the abstract idea, that would make it patent-eligible? (If not, the claim is ineligible)

Judicially Created Exceptions: *Alice v. CLS Bank*

- The *Alice* case concerned claims to a computer-implemented process for mitigating settlement risk (via an essentially known process)
- Supreme Court: The goal of §101 is to avoid preempting essential “building blocks of human ingenuity”
- Intermediated settlement was a well-known practice; the Supreme Court then determined “whether the claims here do more than simply instruct the practitioner to implement the abstract idea of intermediated settlement on a generic computer” and found they did not

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"Section 101 Review and Recent "Disruptive" Decisions from the Federal Circuit"