

# Overcoming Sect. 101 Rejections: USPTO Guidance, Recent Decisions to Meet Sect. 101 Patent Eligibility Requirements

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## AGENDA

1. Brief overview of § 101
  - A. How we got here
  - B. Patent Eligibility Restoration Act of 2022
  - C. Eligibility Highlights and Tips
  - D. Supreme Court
  - E. Fed. Cir. Cases Finding Eligible Inventions
  - F. *Elec. Pwr. Group* Line of Cases
2. Recent Fed. Cir. § 101 Software/Computer Cases
3. USPTO 2019 § 101 Guidelines
4. PTAB § 101 Precedential/Informative Decisions
5. USPTO Subject Matter Eligibility Presentation 3/15/22

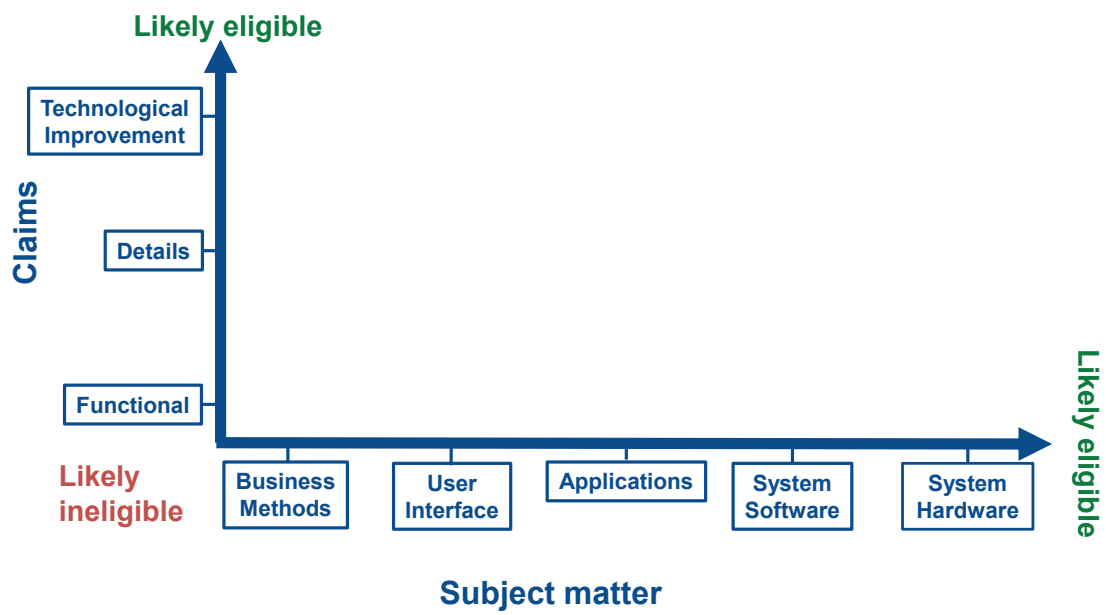
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# Overview

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1972-1981	<i>Benson, Flook, and Diehr</i> (S.Ct.)
1995	USPTO Computer implemented guidelines
1998	<i>State Street Bank</i> (Fed. Cir.)
2010	<i>Bilski</i> (S.Ct.)
2011	<i>Cybersource</i> (Fed. Cir.)
2012	<i>Mayo</i> (S.Ct.)
2014	<i>Alice</i> (S.Ct.)
2021	<i>Yu and USR</i> (Fed. Cir.)

## Patent Eligibility Restoration Act of 2022

### SEC. 2. PATENT ELIGIBILITY.

(a) IN GENERAL.—Chapter 10 of title 35, United States Code, is amended—

(1) in section 100—

(A) in subsection (b), by striking “includes a new use of a known process” and inserting “includes a use, application, or method of manufacture of a known or naturally-occurring process”; and

(B) by adding at the end the following:

“(k) The term ‘useful’ means, with respect to an invention or discovery, that the invention or discovery has a specific and practical utility from the perspective of a person of ordinary skill in the art to which the invention or discovery pertains.”; and

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18<sup>th</sup> Annual Advanced Patent Law Institute session

"Section 101"