



Section 101 Issues in Patent Litigation

Matthew J. Rizzolo, Ropes & Gray LLP, Washington, DC

James M. Heintz, DLA Piper LLP US, Reston, VA



ROPES & GRAY

Agenda

- **35 U.S.C. § 101**
- **Recent Developments in the Courts**
- **Who benefits from current state of the law?**
 - Pro-Plaintiff Considerations
 - Pro-Defendant Considerations

Patentable Subject Matter

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.

Eligibility Framework (*Alice*)

- Step 1
 - Are the claims directed to a patent ineligible concept?
 - Laws of Nature
 - Natural Phenomena
 - Abstract Idea
- Step 2
 - If so, does the claim contain an “inventive concept” sufficient to “transform” ineligible concept into a patent-eligible subject matter?

Judicial Exceptions

- **Laws of Nature**
 - Gravity
 - The chemical principle underlying the union between fatty elements and water.
- **Natural Phenomenon**
 - Naturally occurring plants and minerals
 - Isolated naturally occurring DNA fragments (*Myriad*)
 - Naturally occurring associations between genes and diseases
- **Abstract Ideas**
 - Intermediated settlement (*Alice*)
 - Risk hedging (*Bilski*)
 - Managing relationships or transactions between people (*buySAFE*)
 - Collecting, analyzing, and displaying information (*Electric Power Group*)

Agenda

- 35 U.S.C. § 101
- **Recent Developments in the Courts**
- **Who benefits from current state of the law?**
 - Pro-Plaintiff Considerations
 - Pro-Defendant Considerations

Find the full text of this and thousands of other resources from leading experts in dozens of legal practice areas in the [UT Law CLE eLibrary \(utcle.org/eLibrary\)](https://utcle.org/eLibrary)

Title search: Section 101 Issues in Patent Litigation

First appeared as part of the conference materials for the
15th Annual Advanced Patent Law Institute session
"Section 101 Issues in Patent Litigation"