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Maier & Maier

Demonstrating Patent Eligibility Post-*Alice*

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PATENTABLE SUBJECT MATTER

- **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).**

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

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 pre-empt the mathematical formula."**
- **"Phenomena of nature, though just discovered, mental processes, and abstract intellectual concepts are not patentable, as they are the basic tools of scientific and technological work."**

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."**

Title search: Demonstrating Patent Eligibility Post-Alice

Also available as part of the eCourse
2019 Advanced Patent Law (USPTO) eConference

First appeared as part of the conference materials for the
14th Annual Advanced Patent Law Institute session
"Navigating Patent Subject Eligibility Challenges in High Technology Cases"