

Which Way Now with U.S. Patent Office Policies?

November 5, 2021

The 26th
Annual
Advanced
Patent
Law
Institute

Topics

- Section 101
- Discretionary Denials
- Amendments in AIA Trials

§ 101

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The PEG and the Federal Circuit

“While we greatly respect the PTO’s expertise on all matters relating to patentability, including patent eligibility, we are not bound by its guidance.”

• *Cleveland Clinic Found. v. True Health Diagnostics*, 760 F.App’x 1013 (Fed. Cir. 2019).

“The Office Guidance is not, itself, the law of patent eligibility, does not carry the force of law, and is not binding in our patent eligibility analysis. We are not bound by the Office Guidance, which cannot modify or supplant the Supreme Court’s law regarding patent eligibility, or our interpretation and application thereof.”

• *In re Rudy*, 956 F.3d 1379 (Fed. Cir. 2020).

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cont.

"We apply our law and the relevant Supreme Court precedent, not the Office Guidance, when analyzing subject matter eligibility."

• *In re Jobin*, 811 F.App'x 633 (Fed. Cir. 2020).

"The Office Guidance does not modify or supplant controlling case law."

• *In re Zunshine*, 816 F.App'x 477, 478-79 (Fed. Cir. 2020).

"To the extent the guidance contradicts or does not fully accord with our caselaw, it is our caselaw, and the Supreme Court precedent it is based upon, that must control."

• *cxLoyalty, Inc. v. Maritz Holdings Inc.*, 986 F.3d 1367, 1375 n.1 (Fed. Cir. 2021).

"We need not further address the Guidance, which does not bind us."

• *In re Abel*, 838 F.App'x 558, 561 (Fed. Cir. 2021).

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Prospects for legislation

All currently pending legislation in the U.S. Senate and House of Representatives that proposes amendments to 35 U.S.C. § 101:

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First appeared as part of the conference materials for the
26th Annual Advanced Patent Law Institute session

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