



Section 101 Legislation

Giles S. Rich Inn of Court
September 10, 2019

May 22, 2019 Bipartisan, Bicameral Draft Legislative Proposal

Senate

- **Sen. Thom Tillis (R-NC)**
(Chair, Senate Judiciary IP Subcommittee)
- **Sen. Chris A. Coons (D-DE)**
(Ranking Member, Senate Judiciary IP Subcommittee)

House

- **Rep. Doug Collins (R-GA)**
(Ranking Member, House Judiciary)
- **Rep. Hank Johnson (D-GA)**
(Chair, House Judiciary Subcommittee on Courts, Intellectual Property, and the Internet)
- **Rep. Steve Stivers (R-OH)**

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- Senate Judiciary Revives Subcommittee on Intellectual Property in February 2019
- 101 Roundtables Commenced in December 2018
 - 60-80 Stakeholders
- Earlier draft framework released in April 2019

<https://news.bloomberglaw.com/ip-law/senate-judiciary-revives-intellectual-property-panel>

<https://www.law360.com/articles/1108393/sens-set-meeting-to-talk-revamp-of-patent-eligibility-law>

<https://www.coons.senate.gov/news/press-releases/sens-coons-and-tillis-and-reps-collins-johnson-and-stivers-release-draft-bill-text-to-reform-section-101-of-the-patent-act>

<https://www.coons.senate.gov/news/press-releases/sens-coons-and-tillis-and-reps-collins-johnson-and-stivers-release-section-101-patent-reform-framework>

Section 101 Comparison

May 22 Draft Text

Current Section 101

Section 100:

(k) The term “useful” means any invention or discovery that provides specific and practical utility in any field of technology through human intervention.

Section 101:

(a) Whoever invents or discovers any useful process, machine, manufacture, or composition of matter, or any useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

(b) Eligibility under this section shall be determined only while considering the claimed invention as a whole, without discounting or disregarding any claim limitation.

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.

Section 112 (f) Comparison

May 22 Draft Text

Functional Claim Elements

— An element in a claim expressed as a specified function without the recital of structure, material, or acts in support thereof shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

Current 112(f)

~~Element in Claim for a Combination.~~

— An element in a claim ~~for a combination~~ ~~may be expressed as a means or step for performing a specified~~ function without the recital of structure, material, or acts in support thereof, ~~and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.~~

Additional Legislative Provisions:

- **The provisions of section 101 shall be construed in favor of eligibility.**
- **No implicit or other judicially created exceptions to subject matter eligibility, including “abstract ideas,” “laws of nature,” or “natural phenomena,” shall be used to determine patent eligibility under section 101, and all cases establishing or interpreting those exceptions to eligibility are hereby abrogated.**
- **The eligibility of a claimed invention under section 101 shall be determined without regard to:
the manner in which the claimed invention was made; whether individual limitations of a claim are well known, conventional or routine; the state of the art at the time of the invention; or any other considerations relating to sections 102, 103, or 112 of this title.**

101 Hearings: “The State of Patent Eligibility in America”

- **Chaired by Senator Tillis (R-NC) and attended by Ranking Member Senator Coons (D-DE), as well as Senator Hirono (D-HI) and Senator Blumenthal (D-CT)**
- **Three (3) days of hearings: June 4, 5, and 11**
- **45 Witnesses**
 - **June 4: Patent Scholars**
 - **June 5: Bar and Trade Associations**
 - **June 11: Industry**

<https://www.judiciary.senate.gov/meetings/the-state-of-patent-eligibility-in-america-part-i>
<https://www.judiciary.senate.gov/meetings/the-state-of-patent-eligibility-in-america-part-ii>
<https://www.judiciary.senate.gov/meetings/the-state-of-patent-eligibility-in-america-part-iii>

Part I: Patent Scholars

Hon. Paul Michel
(Former Chief Judge, CAFC)

Q. Todd Dickinson
(Former Director, USPTO)

David Kappos
(Former Director, USPTO)

Charles Duan
(R Street Institute)

Prof. Jeffrey Lefstin
(UC Hastings)

Bob Armitage
(IP Strategy and Policy)

Prof. David Taylor
(SMU)

Sherry Knowles
(Knowles Intellectual Property Strategies)

Alex Moss
(Electronic Frontier Foundation)

Prof. Mark Lemley
(Stanford)

Michael Rosen
(American Enterprise Institute)

Prof. Paul Gugliuzza
(Boston University)

Prof. Joshua Sarnoff
(DePaul University)

Patrick Kilbride
(GIPC, Chamber of Commerce)

Prof. Adam Mossoff
(Antonin Scalia Law School)

Part II: Bar and Trade Associations

Barbara Fiacco (AIPLA)	Scott Partridge (ABA)	Henry Hadad (IPO)	David Jones (High Tech Inventors Alliance)	Stephanie Martz (United for Patent Reform)
Paul Morinville (U.S. Inventor)	Phil Johnson (Coalition for 21st Century Patent Reform)	William Jenks (Internet Association)	Christopher Mohr (Software and Information Industry Association)	Jeffrey Birchak (Innovation Alliance)
Jeff Francer (Association for Accessible Medicines)	Hans Sauer (BIO)	Natalie Derzko (PhRMA)	Rick Brandon (Association of American Universities)	Kate Ruane (ACLU)

Part III: Industry

**Manny
Schechter
(IBM)**

**Laurie Self
(Qualcomm)**

**Byron Holz
(Nokia)**

**Kim
Chotkowski
(InterDigital)**

**Sean Reilly
(The Clearing
House
Payments
Company)**

**Laurie Hill
(Genentech)**

**Sean George
(Invitae)**

**Gonzalo
Merino
(Regeneron)**

**Peter O'Neill
(Cleveland
Clinic)**

**David Spetzler
(Caris Life
Sciences)**

**Michael
Blankenstein
(Scientific
Games)**

**Corey
Salsberg
(Novartis)**

**Nicholas
Dupont
(Cyborg)**

**Robert
Deberardine
(Johnson &
Johnson)**

**John
Vandenberg
(Klarquist
Sparkman,
LLP)**

Testimony Summary

- **Need for some Congressional action**
 - Anti-reform recognized need for reform for medical advance
- **Pro-reform wanted a tech-neutral approach**
- **Whether genes would be patentable**
- **Whether legislation would preempt scientific research**
 - Whether to codify an enhanced experimental use and research exception
- **100(k)**
 - Ambiguity of “field of technology”
- **112(f)**
 - The need for early resolution of lawsuits
 - Whether small changes could now avoid infringement

THANK YOU