

RETIRING “IMPLICIT EXCEPTIONS” TO PATENT ELIGIBILITY: TWO PATHS FORWARD

- The United States must not continue to invalidate patent claims on patent eligibility grounds that would be readily patentable in other industrialized countries. International treaty obligations alone suggest the United States should not impose patentability requirements distinct from those permitted under such treaties.
- The Supreme Court jurisprudence that imposes “implicit exceptions” to patent eligibility under 35 U.S.C. § 101 is grounded on legitimate policy concerns that patents that might dominate conceptual subject matter (laws of nature, natural/physical phenomena, or abstract ideas) or products of nature hold the potential to limit access to basic tools of science and technology in a manner that might impede, rather than promote progress in the useful arts.
- Judicial restraint should demand that the § 101 “implicit exceptions”—unlike the explicit § 101 requirement that a claimed invention be expressed in terms of one of the permitted statutory categories—should not constitute a “threshold test” for patentability, but should be imposed, if at all, only as a “safety valve,” *i.e.*, for a claimed invention found to be otherwise patentable under the statute.
- Similarly, if such a “safety valve” were determined to be unnecessary because the statutory patentability requirements (as properly interpreted) and other patent-limiting judicial doctrines (as fully applied) addressed the policy concerns forming the predicate for the “implicit exceptions,” then judicial restraint should demand that the courts retire such a judge-imposed “safety valve,” once shown to serve no conceivable policy purpose.
- If legislation clarifying the interpretation to be given to existing statutory requirements—and codifying the application of other patent-limiting judicial doctrines—sufficed to demonstrate that the “implicit exceptions” no longer served any possible policy purpose, Congress could legislatively abrogate and overrule the “implicit exceptions.” It could confidently do so in a manner that would demand judicial acquiescence.
- Both the judicial and legislative paths forward for retiring the “implicit exceptions” share a common set of policy justifications for doing so, suggesting they should be pursued under common legal principles, to wit:
 - The § 101 requirement that a claimed invention must be expressed in terms of a process, machine, manufacture, or composition of matter (or an improvement thereto) should be interpreted to require that the claim as a whole must be directed to embodiments or applications of any concept (*e.g.*, law, phenomenon, or idea) to which the invention relates.
 - The 35 U.S.C. § 112(f) requirement that discrete elements in combination claims must be limited to disclosed structures, materials, or acts (and equivalents) should be interpreted in a manner consistent with *Halliburton Oil Well Cementing Co. v. Walker*, 329 US 1 (1946) to require that any claim element setting out a function to be performed (instead of structures, materials or acts for doing so) be limited as provided under § 112(f), unless the element references an established category of structures, materials, or acts for doing so. “Means for”/“step for” language would be ignored in this determination.
 - The “mental steps” and “printed matter” doctrines should be revitalized, in part to help to reign in the otherwise potentially abstract nature of some “business method” patent claims, by—
 - using § 112(f)’s existing framework to interpret (or amend) this subsection to mean that an activity performed through human thought is not an “act” for § 112(f) purposes and
 - interpreting (or amending) 35 U.S.C. § 102 to clarify that the content of information or its presentation should be disregarded in determining a claimed invention’s novelty, except when integral to the functioning of the claim as a whole.
 - For the purposes of determining if a patented invention has been infringed under 35 U.S.C. § 271, patents rights should not extend to acts of infringement that attempt to understand or improve a patented invention (as recommended by the National Academies in “Reaping the Benefits of Genomic and Proteomic Research,” <http://www.nap.edu/catalog/11487.html>) and patented subject matter should be deemed to exclude any idea, law, phenomenon, or other concept to which the invention relates, other than the claimed embodiments or applications of such a concept, and to exclude any naturally occurring form of any claimed subject matter, *i.e.*, as it exists in nature in its unaltered state.”
- The above interpretation of (or clarifying amendments to) the statutory patentability requirements and judicial revitalization (or codification in title 35) of existing patent-limiting doctrines would wholly moot any justification for continuing to apply the “implicit exceptions” to patent eligibility—and should be the end of them.