

## Section 101 USPTO Roundtable Speaking Points

1. In NYIPLA's view, the section 101 bar should be low: it should hold back as ineligible subject matter those patent claims that are infringed by all applications of an abstract idea, law of nature, or natural phenomenon; and it should allow to proceed to further analysis (under sections 102, 103, and 112) those patent claims that are infringed only by a particular application of an abstract idea, law of nature, or natural phenomenon.
2. The question is what criteria are useful to distinguish the ineligible applications from the rest. The Supreme Court's opinions and two-part test articulated in *Mayo*, *Myriad*, and *Alice* do not provide useful guidance for determining what is the right level of abstraction for a Section 101 analysis of a claimed invention.
3. The Federal Circuit is helping to answer question #2 through its analysis of patent eligible subject matter in, for example, its recent opinions in *McRo* and *Rapid Litigation Management*. In these cases, the Federal Circuit has identified patent eligible subject matter in both the computer-related and life-science-related fields by focusing on two aspects of the claimed subject matter: First, the court identified the "technical improvements" in the claim language and second, determined that the language of the claim (by virtue of its inclusion of the technical improvements) did not preempt the law of nature/abstract idea because the claims were narrowly tailored applications that were described and supported in the specification. The common theme of these cases is that the specification must explain the technical features of the particular application that are specifically recited in the claims and thus ensure that the claims do not preempt a law of nature, abstract idea, or natural phenomenon.
4. In NYIPLA's view, the section 101 analysis should consider whether or not the claims include specific steps or elements which render the claimed invention (assessed on a claim-by-claim basis) a new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, which may apply in a

particular way, but may not claim or preempt, an abstract idea, law of nature, or natural phenomenon.

5. NYIPLA believes that, although the Federal Circuit is moving in the correct direction by focusing on specific recited features in the claims and support in the specification, as well as its requirement that the claimed invention not preempt a law of nature/abstract idea/natural phenomenon, ultimately a statutory amendment will be needed to resolve this matter. To this end, NYIPLA proposes a single sentence be added to section 101, which would read: "*A claim complying with this section may recite a practical application of a law of nature, abstract idea, or natural phenomenon, but may not claim or [] preempt a law of nature, abstract idea, or natural phenomenon.*" Such an amendment will [] clarify the applicable standard for review.

6. Such a statutory amendment will lessen the burden on both courts and on the USPTO, which currently are expending excessive resources struggling with the challenges presented by the Supreme Court's opinions and test articulated in *Mayo*, *Myriad*, and *Alice*. Our goal is a Section 101 analysis that focuses on whether the claims, as properly construed, recite applications and/or technical improvements rather than a law of nature, abstract idea, or natural phenomenon itself, and then let the analysis proceed under the substantive statutory requirements addressing novelty and enablement (i.e., 102, 103 and 112).