



A TUTORIAL AND UPDATE ON PATENTABLE SUBJECT MATTER

WHAT CONSTITUTES A PATENTABLE INVENTION AND HOW TO OBTAIN A PATENT

QUICK REVIEW OF BASICS OF US PATENT LAW

WHAT IS THE LAW REGARDING PATENTABLE SUBJECT MATTER

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BASICS OF US PATENT LAW

- 35 USC 101

- 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.
 - NEW: What constitutes “new” is covered by 35 USC 102. Essentially, not new if the invention is disclosed, in use or on sale more than one year prior to filing a patent application.
 - NEW also includes “obvious” under 35 USC 103, which is defined as the elements of the invention each being disclosed in a manner that would make it reasonable that it would be obvious to a person of ordinary skill in the art to combine the elements to form the invention.

MACHINE

- The US Supreme Court has defined the term "machine" as "a concrete thing, consisting of parts, or of certain devices and combination of devices." *Burr v. Duryee*, 68 U.S. (1 Wall.) 531, 570 (1863). This "includes every mechanical device or combination of mechanical powers and devices to perform some function and produce a certain effect or result."
- If you invent a machine, there is typically no issue regarding whether the invention constitutes patentable subject matter.

ARTICLE OF MANUFACTURE

- The Supreme Court has defined "manufacture" as "the production of articles for use from raw or prepared materials by giving to these materials new forms, qualities, properties, or combinations, whether by hand-labor or by machinery" and thus an **article of manufacture** as things resulting from the process of manufacturing.
- Accordingly, essentially anything tangible can be said to be an article of manufacture.
- Again, there is typically no issue regarding the whether such things are patentable.

COMPOSITION OF MATTER

- A composition of matter is formed by the intermixture of two or more ingredients, and possessing properties which belong to none of these ingredients in their separate state. The intermixture of ingredients in a composition of matter may be produced by mechanical or chemical operations, and its result may be a compound substance resolvable into its constituent elements by mechanical processes, or a new substance which can be destroyed only by chemical analysis.

PROCESS

- A process (or method) can generally be thought of as a set of steps for manufacturing or producing something tangible or for having a practical effect on something tangible. A process may also be a set of steps that improves the operation of a machine.
- Most challenges to patentable subject matter come from claims to inventions that recite a method.

TYPICAL CHALLENGES TO PATENTABILITY

- The most common challenges to patentability are related to prior art
 - During examination by the USPTO, the Examiner identifies a single patent that the Examiner asserts discloses each of the elements of the claimed invention
 - The Examiner identifies one or more patents that can be combined with each other or with common knowledge such that each element is known and that it would be reasonable to assume that one of ordinary skill in the art would know to make the combination
- Almost all challenges to patentability, not related to prior art, are based on the contention that the claim attempts to patent an abstract idea

ABSTRACT IDEAS

- The USPTO has put out new guidelines for determining whether a claim of a patent application recites an abstract idea
 - A fundamental step is to determine whether the claim recites an element that falls into one of three “groupings”:
 - a mathematical concept,
 - certain methods of organizing human activity or practices, or
 - mental processes.

INTEGRATION INTO A PRACTICAL APPLICATION

- A claim that integrates a judicial exception into a practical application will **apply, rely on, or use** the judicial exception in a manner that imposes a **meaningful limit** on the judicial exception, such that the claim is more than a drafting effort designed to **monopolize** the judicial exception.
- An additional element reflects an **improvement** in the functioning of a computer, or an improvement to other technology or technical field
- an additional element that applies or uses a judicial exception to effect a particular **treatment or prophylaxis** for a disease or medical condition
- an additional element implements a judicial exception with, or uses a judicial exception in conjunction with, a particular machine or manufacture that is integral to the claim
- uses the judicial exception in some other meaningful way beyond generally linking the use of the judicial exception to a particular technological environment