Chen, Kwok in OCBJ: What Is Patentable Subject Matter' It is Time for Congress to Act

By Tom Chen, Daniel Kwok | July 26, 2018

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Patentable subject matter is defined in 35 U.S.C. §101 as, “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.”

Since this statute was codified in 1952, there have been numerous court cases defining (or attempting to define) what exactly can be patented. The latest Supreme Court case was decided over four years ago with the Court’s unanimous ruling in *Alice*, involving patent eligibility for software and business method patents. The *Alice* decision set forth a two-part test for determining eligibility, but without clear guidance as to how to apply the test, as the Court deferred to the Federal Circuit and lower courts for clarification. However, the decisions since *Alice* have not provided much clarity.

While various Federal Circuit cases provide additional data points for the patent eligibility issue, they are very much fact-based and fail to enunciate a bright-line test that can be objectively applied in the vast field of software technology. It is telling that even Federal Circuit judges have a hard time applying the two-part test. In *Amdocs*, the court explicitly refused to articulate a “single, universal definition of an ‘abstract idea,’” noting the difficulty in fashioning a definition for “as-yet-unknown cases with as-yet-unknown inventions.”

If Federal Circuit judges cannot define patent eligibility, how can the United States Patent Office (USPTO), with its vast numbers of examiners, be expected to do so? …

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