March 6, 2019

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Senior Legal Advisors
Office of Patent Legal Administration
U.S. Patent and Trademark Office
Via email: Eligibility2019@uspto.gov

Re: 2019 Revised Patent Subject Matter Eligibility Guidance [Docket No. PTO-P-2018-0053]

The Association of American Universities (AAU), Association of Public and Land-grant Universities (APLU), and Council on Governmental Relations (COGR), which together represent all major research universities in the United States, welcome this opportunity to respond to the U.S. Patent and Trademark Office's request for comments on its **2019 Revised Patent Subject Matter Eligibility Guidance [Docket No. PTO-P-2018-0053]**. Our member institutions rely on the patent system to transfer their discoveries and inventions to companies willing to invest in developing those discoveries and inventions for the public good.

Current patent eligibility law under 35 USC 101, as interpreted by the courts, has created a challenging environment of confusion and uncertainty for universities striving to patent certain cutting-edge technologies for society's benefit. In this fraught context, we appreciate the USPTO's provision of guidance on subject matter eligibility and find that this new guidance is a significant step forward insofar as it seeks to narrow overly broad judicial interpretations of Section 101 that have had a detrimental effect on university innovations, particularly vis-à-vis software-embodied inventions and medical diagnostics.

In short, we agree that an invention should be considered patentable subject matter unless it exists in nature independently of human activity or it can be performed solely in the human mind. In addition, we believe the question of whether or not an invention is implemented via conventional means is irrelevant to whether or not that invention constitutes patent eligible subject matter. Moreover, other hurdles in the patent statute (namely, Sections 102, 103, and 112) already provide sufficient limits on unpatentable inventions.

Accordingly, we take a favorable view of both the "2019 Revised Patent Subject Matter Eligibility Guidance" – with respect to the judicial exception on abstract ideas – and the guidance on "Examining computer-implemented functional claim limitations for compliance with 35 USC 112." These represent a welcome move towards greater certainty and predictability of the patent law.

We join our colleagues at the Association of University Technology Managers (AUTM) in their request that USPTO consider expanding its subject matter eligibility guidance on the proper application of the first step (Step 2A) of the *Alice/Mayo* test to other judicial exceptions – that is, to laws of nature and natural phenomena. We further agree with AUTM that the order to

"(e)valuate whether the judicial exception is integrated into a practical application" should apply with equal force to laws of nature and natural phenomena.

We want to reiterate our appreciation for the good working relationship our associations have established with USPTO, as well as USPTO's willingness to engage in consultative dialogue with stakeholders. We stand ready to assist USPTO and other patent stakeholders in thinking about ways to bring yet more clarity to this area, and we look forward to continuing to participate with USPTO in this important process.

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