

# Subject Matter Eligibility



Presentation at the U.S. Patent and Trademark Office  
Forum on

Guidance For Determining Subject Matter Eligibility Of Claims  
Reciting Or Involving Laws of Nature, Natural Phenomena, &  
Natural Products

May 9, 2014

# Exceptions to the broad patent-eligibility principles of Section 101

- The ABA-IPL appreciates the Office's public outreach efforts through the use of forums and round table events.
- The ABA-IPL is reviewing the newly issued guidelines carefully and will provide written comments to the Office.
- The following presentation is an overview of certain aspects of the American Bar Association's current policy position on subject matter eligibility.

# Exceptions to the broad patent-eligibility principles of Section 101

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- The American Bar Association supports the principle that laws of nature, physical phenomena, and abstract ideas are not eligible for patenting under 35 U.S.C § 101, even if they had been previously unknown or unrecognized.

# The Claim Must Be Read as a Whole

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- The American Bar Association supports the principle that a process meets the requirements of Section 101 where—
  1. the claimed process *as a whole*, other than a mental process, is limited to a specific application of a law of nature, natural phenomenon, or abstract idea; or
  2. the claimed process requires or involves a transformation of matter.

# No Conflation of 101 with Other Statutory Requirements

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- The American Bar Association supports the principle that the inquiry into subject matter eligibility for patenting under 35 U.S.C. § 101 is a ***separate and distinct*** requirement for patent eligibility which should be ***resolved independently from*** the conditions of patentability under Sections 102 and 103, and the requirements for obtaining a valid patent under Section 112.
  - The American Bar Association opposes importing Section 102, 103 or 112 criteria into the patent eligibility analysis