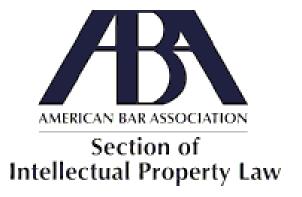
Subject Matter Eligibility



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 patenteligibility 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 patenteligibility principles of Section 101

 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

- 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

- 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

