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Bipartisan “Draft Bill” to Amend ss. 100, 101 and 112 Released for Comment

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On Wednesday, Senators Tillis and Coons, along with Reps. Collins, Johnson and Stivers released a draft, bipartisan bill to amend ss.100 and 101 to void the “judicial exceptions” to patent eligibility. Section 112(f) was also amended to tighten up the language (“for a combination” was eliminated).

On April 18th, I posted the “Draft Outline of Section 101 Reform.” I noted that the draft attempted to define “exclusive categories of statutory subject matter which alone should not be eligible for patent protection.” However, the draft’s proposed categories included “products that exist solely and exclusively in nature”- but did not mention claims reciting naturally-occurring processes, such as diagnostic tests. This was especially troubling since the draft outline would blacklist “mental activities” and the courts and the PTO routinely disregard steps in method claims that involve thinking, such as the mental activity of the actor who interprets the results of the test as indicative of a medical condition.

The “draft bill text” rejects this definitional attempt to define patent-ineligible subject matter. It amends s. 101 to eliminate the requirement that the patent eligible invention or discovery be “new,” and adds section 100(f) that states: “The term ‘useful’ means any invention or discovery that provides specific and practical utility in any field of technology through human intervention.”

Section 101 would also be amended to add the requirement that patent eligibility

shall be determined only “while considering the claimed invention as a whole, without discounting or disregarding any claim limitation,” (including mental steps, I presume.)

While not proposing specific statutory amendments, the draft bill lists “Additional Legislative Provisions” –presumably to create a legislative history– that states:

“No implicit or other judicially created exceptions to subject matter eligibility, including ‘abstract ideas’, laws of nature’ or ‘natural phenomena’ shall be used to determine patent eligibility under Section 101, and all cases establishing or interpreting those exceptions to eligibility are hereby abrogated.

The eligibility of a claimed invention under section 101 shall be determined without regard to: the manner in which the claimed invention was made; whether individual limitations of a claim are well known, conventional or routine; the state of the art of the art at the time of the invention; or any other considerations relating to sections 102, 103, or 112 of this title.”

So, there you have it, but no statutory amendment is airtight to judicial interpretation. An invention or discovery still must be a useful process, machine, manufacture or composition of matter, or any useful improvement thereof.... “Process” is defined in Section 100 as “process, art or method, and includes a new use of a known process, machine, manufacture or composition of matter.” A claim to one of these categories must be “useful” according to the draft bill, if it provides specific and practical utility in any field of technology through human intervention.

This would seem to bullet-proof claims to diagnostic tests based on the discovery of a natural correlation, since, at the least, they provide “specific and practical utility...through human intervention.” That intervention requirement can clearly – I would hope – be provided by sampling, testing and examining the information provided by the test, even though the individual steps may be routine, conventional, etc.

Let’s go farther afield. Would the broad “hedging claims” presented in Bilski be patent eligible if this bill became law? They meet the requirement for practical utility but how “specific” must a claim be to meet the utility requirement? In the Fed. Cir. decision, Judge Rader said that hedging had been taught and practiced for a long time. So, even if a business method is claimed specifically, it would be likely to be rejected for lack of novelty.

That is also true of natural phenomenon as they have been carried out in vivo, and Judge Newman has tried to make the distinction between a naturally-occurring correlation claimed per se — clearly not novel – and a laboratory test that applies the correlation to diagnose the presence or risk of a pathological condition that would appear to meet the statutory requirements for a specific utility. As I have written: “Nature contains correlations, but humans correlate.”

Or consider Myriad. The Supreme Court called the isolated BRACA genes patent-ineligible natural products, but adoption of the draft bill would render them patent-eligible as compositions of matter, isolated by the hand of man, which was the basis of the reversed Fed. Cir. opinions. The utility of a full-length gene can be debated, I

suppose, but primers useful in PCR should return to patent eligibility. So, would isolated cffDNA, since it is a composition of matter with utility in diagnostic tests. Its novelty can be tested using s.102.

In my earlier post, I wished for statutory language that would resurrect Bergy II. This draft bill would seem to accomplish this since the cultured microorganisms claimed in Bergy II were extracted from the jungle of nature by the hand of man, and were useful as biofactories for antibiotics.

Contra Chakrabarty, a mineral found in the earth or a plant discovered in the jungle would now be patent eligible subject matter, if the mineral was, e.g., a substitute for silicon or the plant produced, e.g., an anti-cancer drug. Of course, both were isolated by the hand of man, but they would fail the novelty requirement of s.103. So, would “naked” mathematical formulae, unless put to work a la Diehr.

About the only patent-ineligible inventions or discoveries would be philosophical correlations like, “The love you take is equal to the love you make” or Murphy’s Law. The “truth” or utility of such ideas cannot be tested by the scientific method and so will remain in the realm of poetry. You still won’t be able to patent everything you imagine.

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