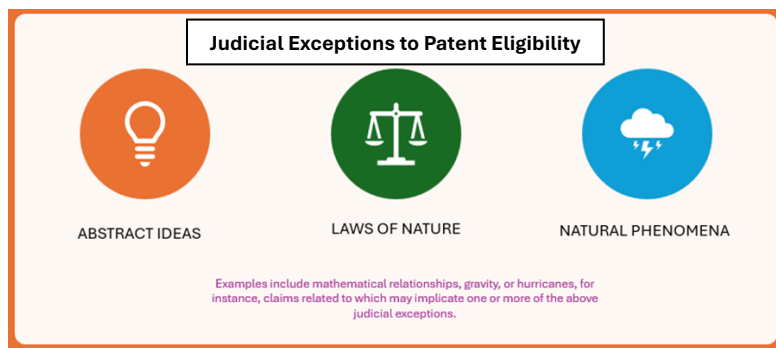
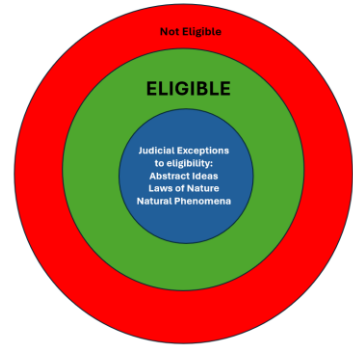
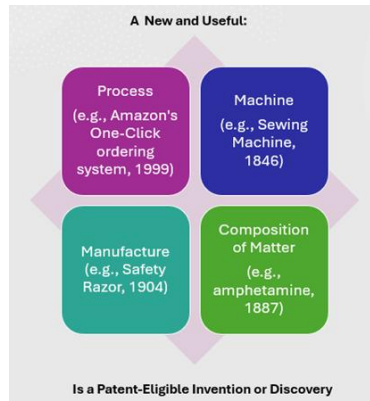


Key Concepts in IP Policy: The Distinction Between Eligibility & Patentability

Eligibility establishes the scope of patentable subject matter (minus judicial exceptions)

Title 35 U.S. Code, Section 101:
“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.”
(July 19, 1952, ch. 950, 66 Stat. 797.)

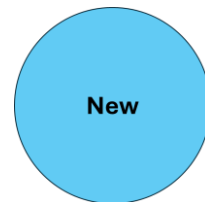


Next, **Patentability** sets the conditions that must be met to attain a patent

The Invention Must Be Novel

An invention is not considered to be “new” or “novel” if:

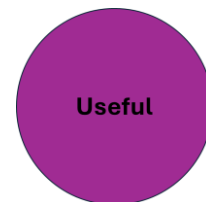
“the claimed invention was patented, described in a printed publication, or in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention”



The Invention Must Be Useful

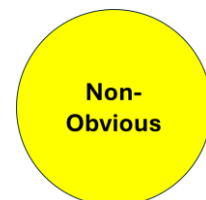
Section 101 refers to the “usefulness” or “utility” of an invention, which courts have held to mean that:

An invention must have a specific and identifiable benefit

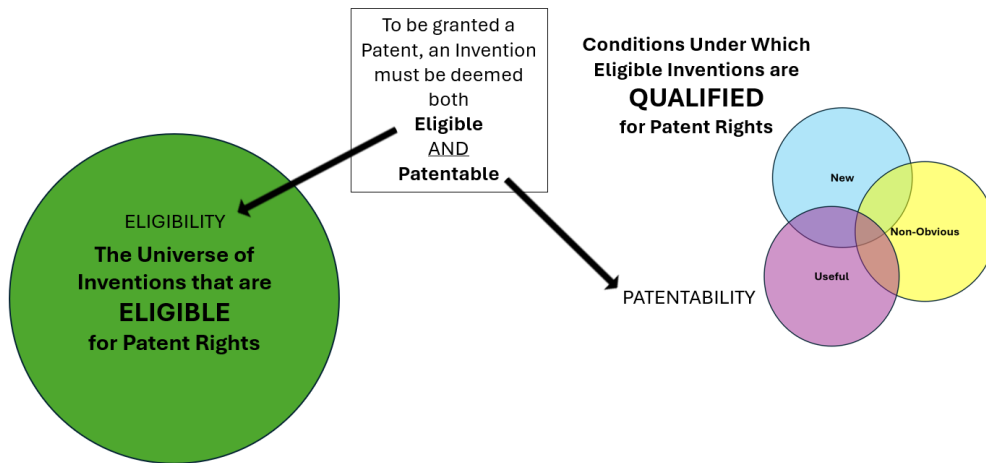


The Invention must be Non-Obvious

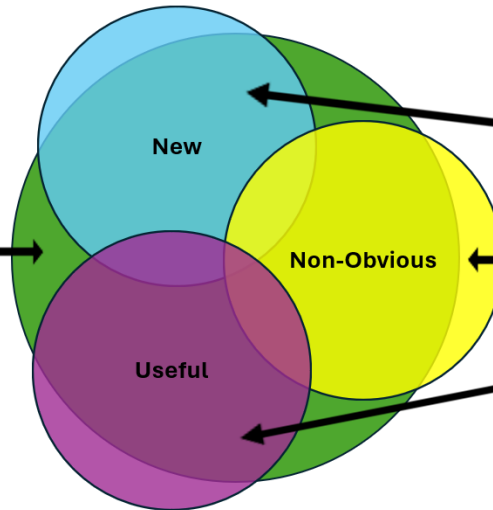
“...[T]he differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious to a person having ordinary skill in the art...”



Finally, **Eligibility and Patentability** work together to ensure appropriate scope of patent rights

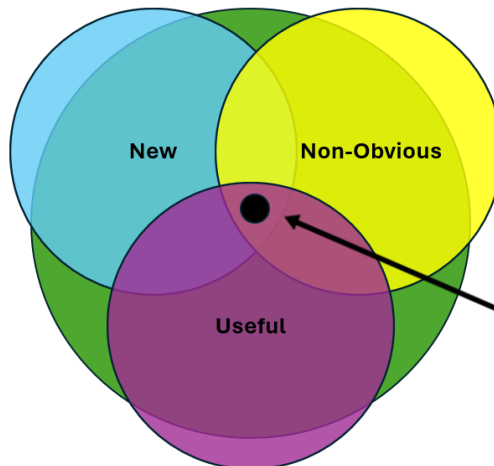


ELIGIBILITY
This is a low bar:
Does the claimed
invention meet
the statutory
definition of an
invention?



PATENTABILITY
This is a much
higher bar:
Does the claimed
invention meet
each of the rigorous
statutory criteria to
be granted a
patent?

The ambiguity of the judicial exceptions means that inventions in some emerging technologies have been deemed ineligible even while meeting the patentability criteria for Usefulness, Newness, and Non-Obviousness, creating an **eligibility donut hole** in sectors such as diagnostics, genomics, and software.



**The Eligibility
Donut Hole**