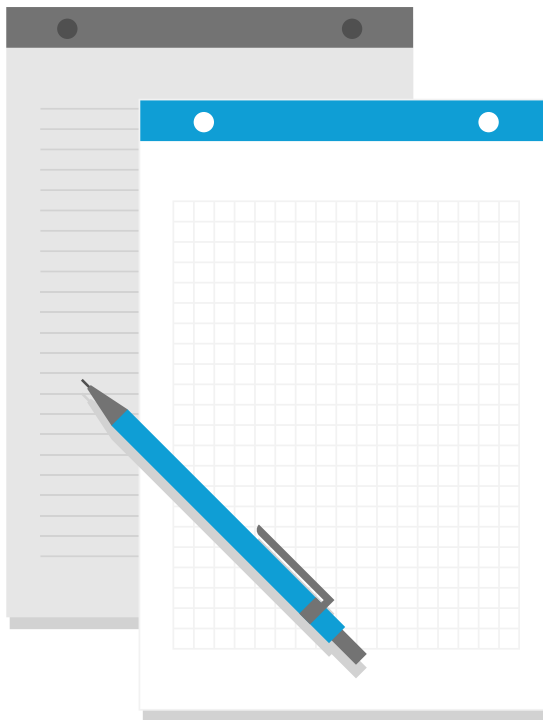
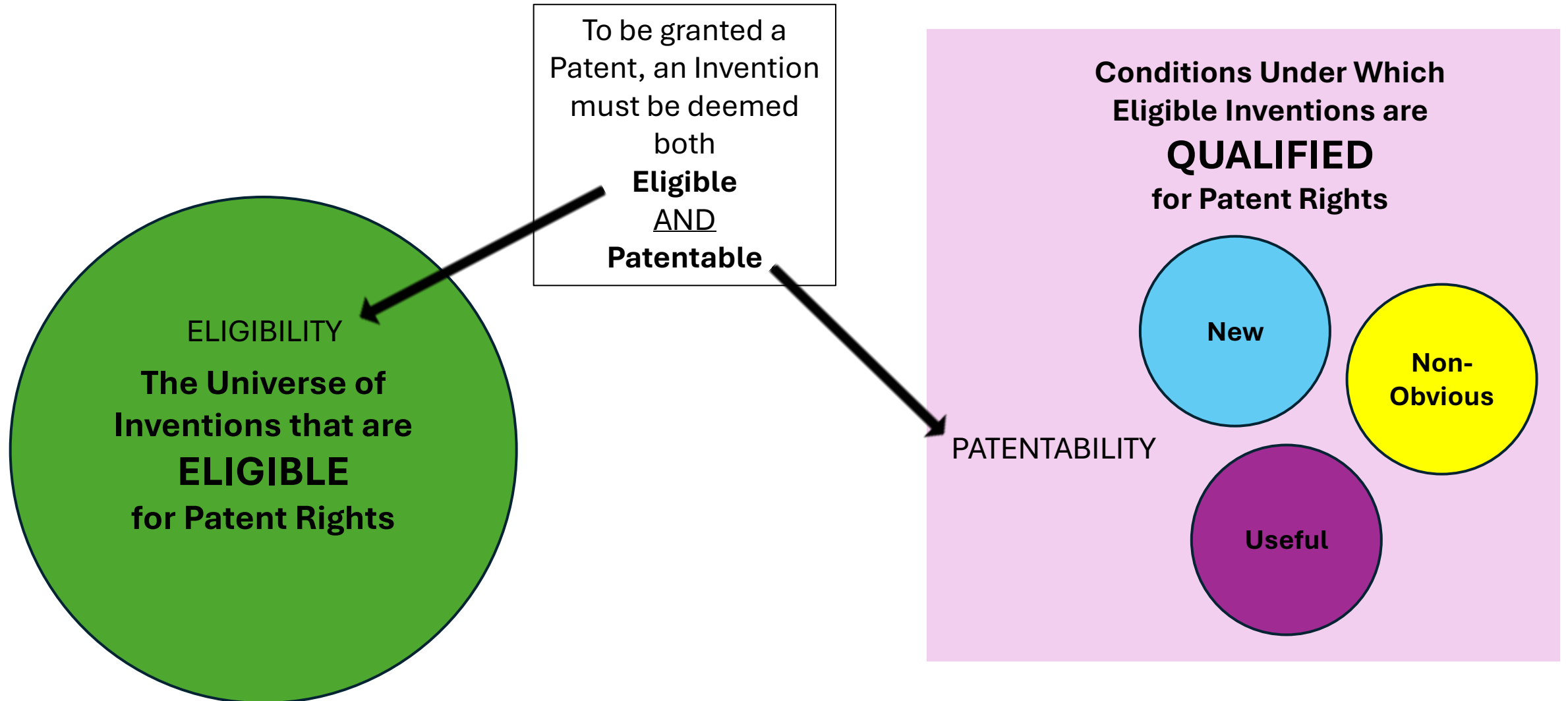


Eligibility & Patentability **Illustrated**



Eligibility and Patentability: Two Distinct Concepts



CONSTITUTIONAL FOUNDATIONS: Patent Rights

[The Congress shall have Power . . .] To promote the Progress of Science and useful Arts, by securing for limited Times to **Authors** and **Inventors** the exclusive Right to their respective **Writings** and **Discoveries**.

U.S. Constitution

Article One, Section Eight, Clause Eight

STATUTORY BASIS:

Patent Rights

PART I—UNITED STATES PATENT AND TRADEMARK OFFICE (§§ 1 – 42)

PART II—PATENTABILITY OF INVENTIONS AND GRANT OF PATENTS (§§ 100 – 212)

PART III—PATENTS AND PROTECTION OF PATENT RIGHTS (§§ 251 – 329)

PART IV—PATENT COOPERATION TREATY (§§ 351 – 376)

PART V—THE HAGUE AGREEMENT CONCERNING INTERNATIONAL
REGISTRATION OF INDUSTRIAL DESIGNS (§§ 381 – 390)

United States Code

Title 35

STATUTORY BASIS:

Eligibility and Patentability of Inventions

§ 100. Definitions

§ 101. Inventions patentable

§ 102. Conditions for patentability; novelty

§ 103. Conditions for patentability; non-obvious subject matter

United States Code

Title 35

Patent Examination

When a patent application is filed with the **U.S. Patent & Trademark Office**, “there are a number of legal requirements that must be met, including **novelty** (35 U.S.C. 102), **utility** and **eligibility** (35 U.S.C. 101), **non-obviousness** (35 U.S.C. 103), and **written description** (35 U.S.C. 112)...”

A patent examiner, “review[s] the contents of the application to determine if it meets all legal requirements for a patent to be granted. The examination consists of a study for compliance with legal requirements... and a search through U.S. patents, publications of patent applications, foreign patent documents, and available literature.”

“This is to see if the claimed invention is new, useful, and non-obvious, and if the application meets patent statute requirements and rules of practice.”

U.S. Patent & Trademark Office

“Patent Process Overview”

Invention: Defined

When used in this title unless the context otherwise indicates—

(a)The term “invention” means invention or discovery.

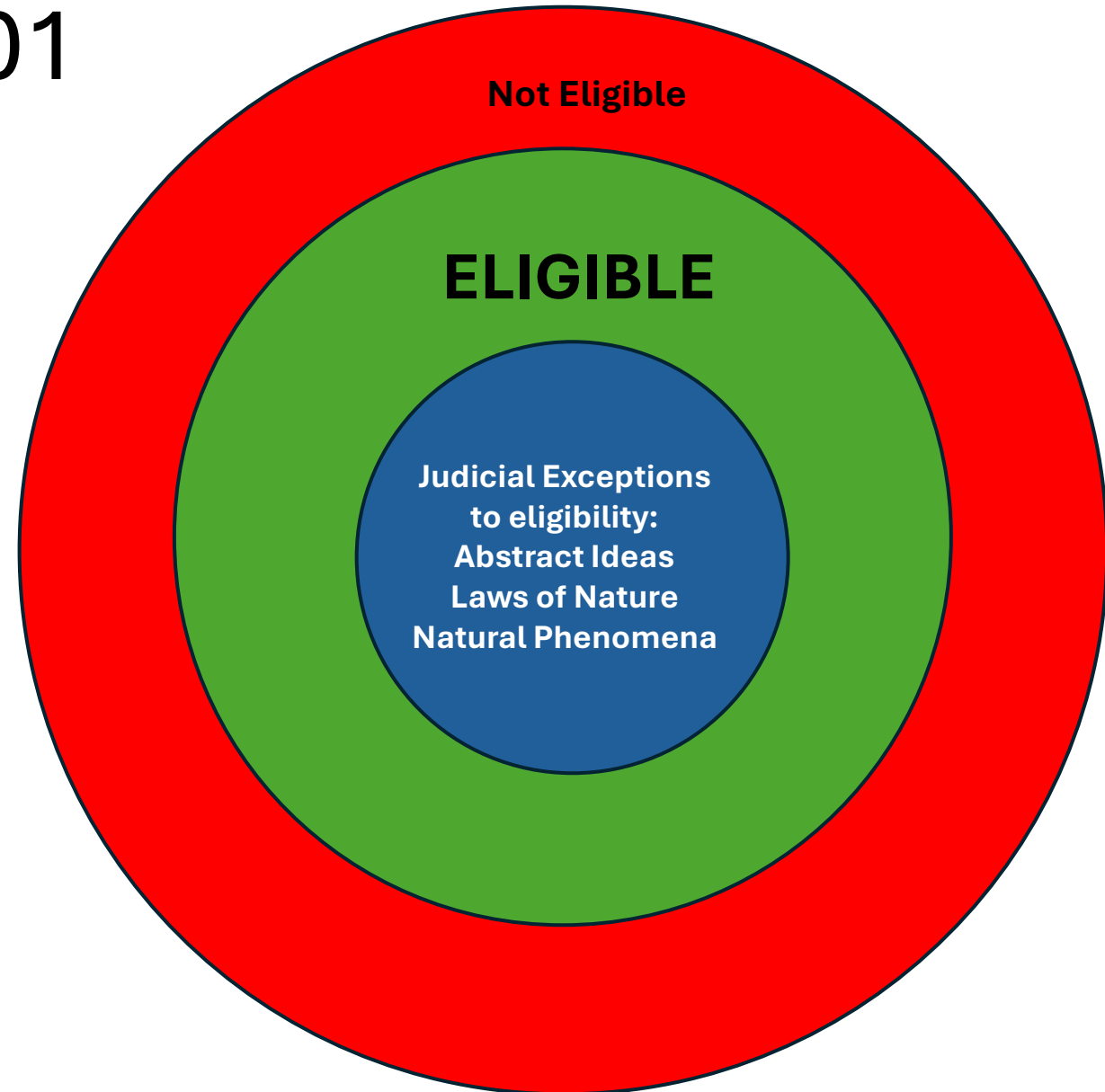
35 U.S. Code § 100 - Definitions

I. Eligibility -- USC 35 § 101

The Eligibility statute describes the scope of subject matter for which inventions may be eligible for patents:

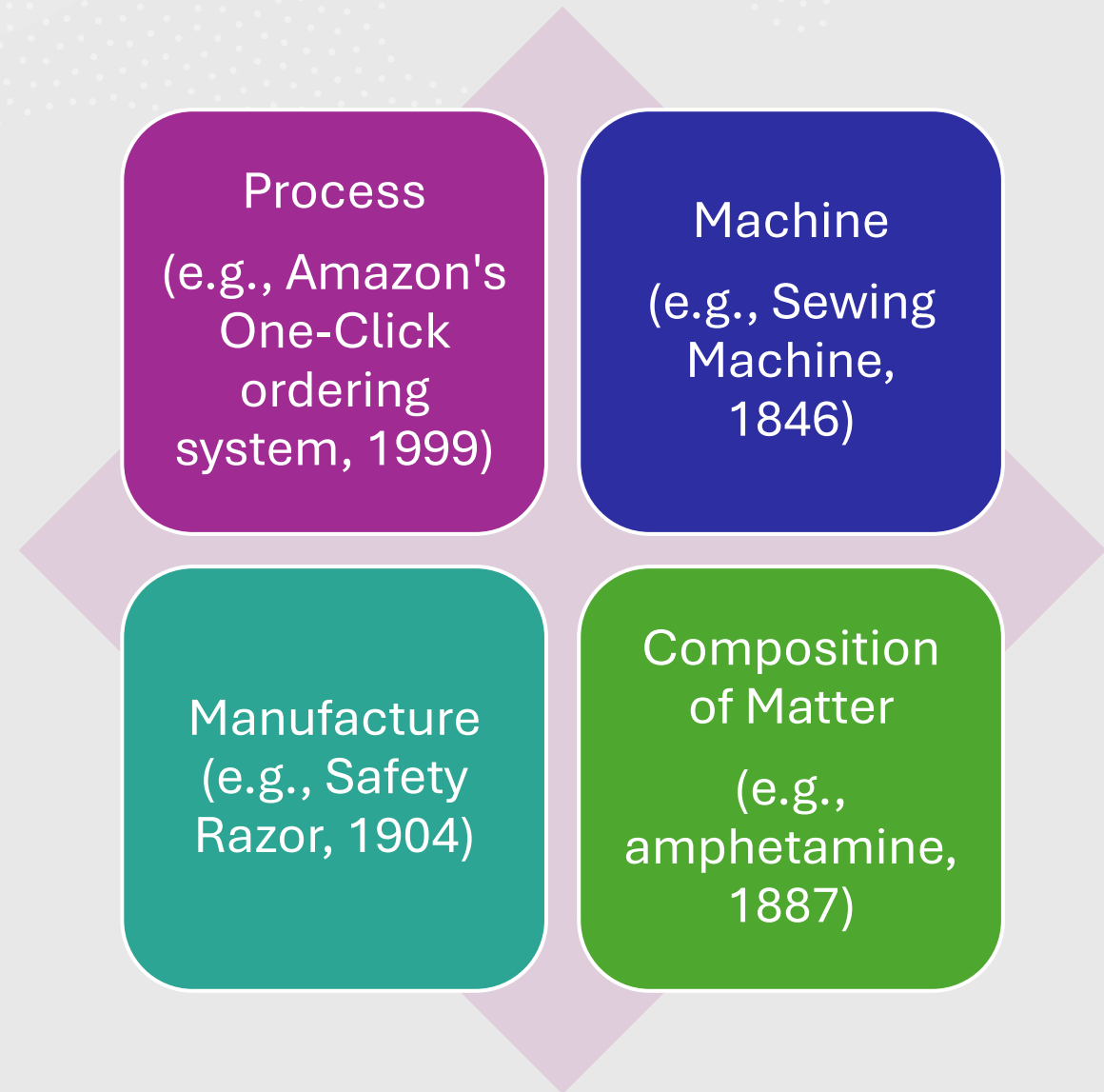
“Whoever invents or discovers any **new** and **useful** **process, machine, manufacture, or composition of matter**, or any **new** and **useful** **improvement** thereof, may obtain a patent therefor, subject to the **conditions and requirements** of this title.”

(July 19, 1952, ch. 950, 66 Stat. 797.)



What is an Eligible Invention (or Discovery)?

A New and Useful:



Is a Patent-Eligible Invention or Discovery

What Classes of Inventions (or Discoveries) Have Been Deemed Patent-Ineligible by the Courts?



ABSTRACT IDEAS



LAWS OF NATURE



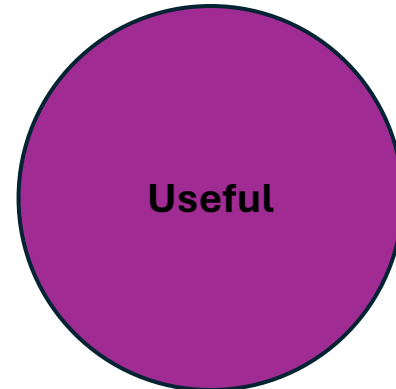
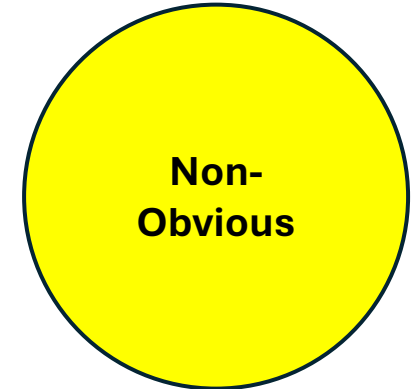
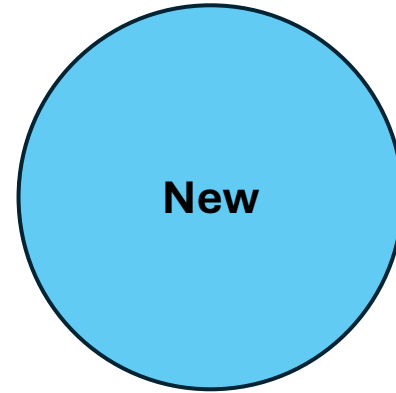
NATURAL PHENOMENA

Examples include mathematical relationships, gravity, or hurricanes, for instance, claims related to which may implicate one or more of the above judicial exceptions.

II. Patentability -- USC 35 § 101, 102, 103

The Invention Must Be:

- **New**
- **Useful**
- **Non-Obvious**

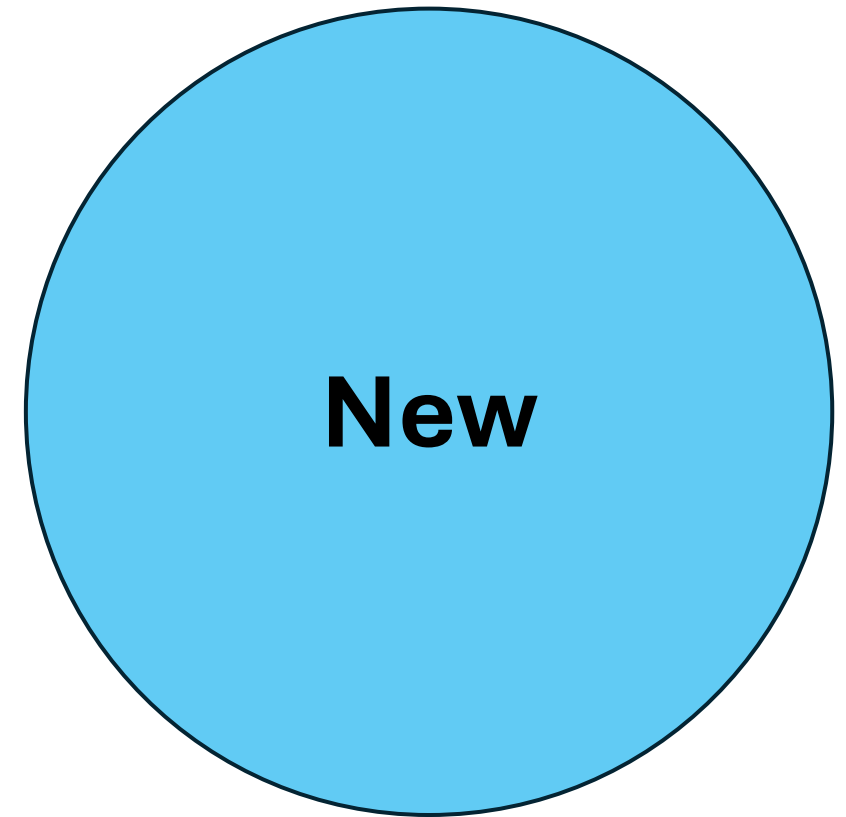


What Inventions are Patentable?

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”

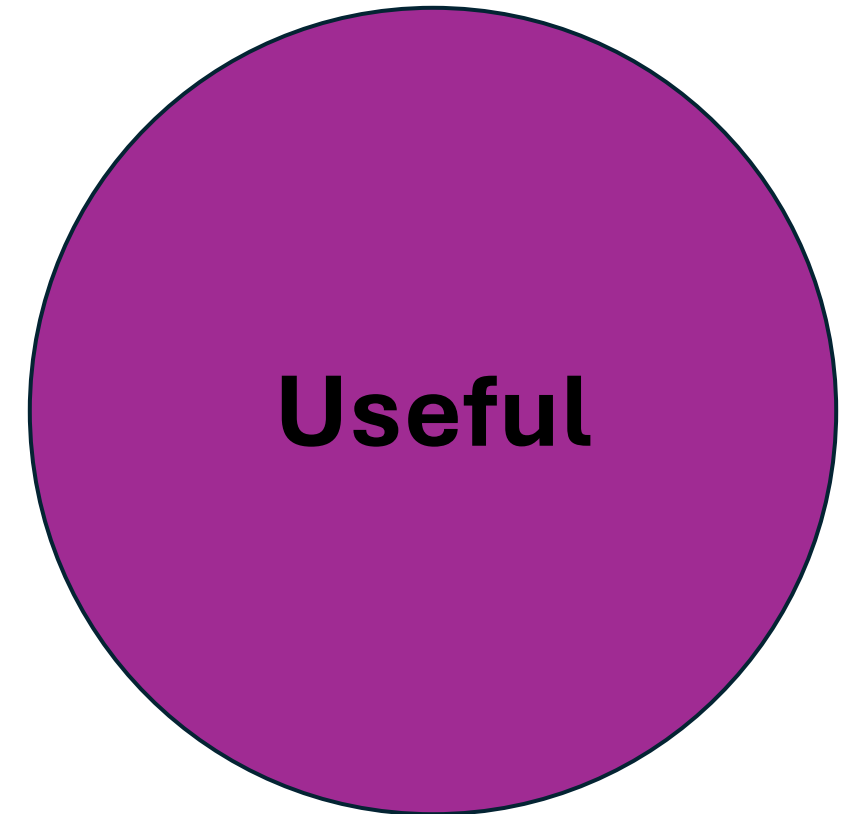


What Inventions are Patentable?

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



What Inventions are Patentable?

The Invention must be Non-Obvious

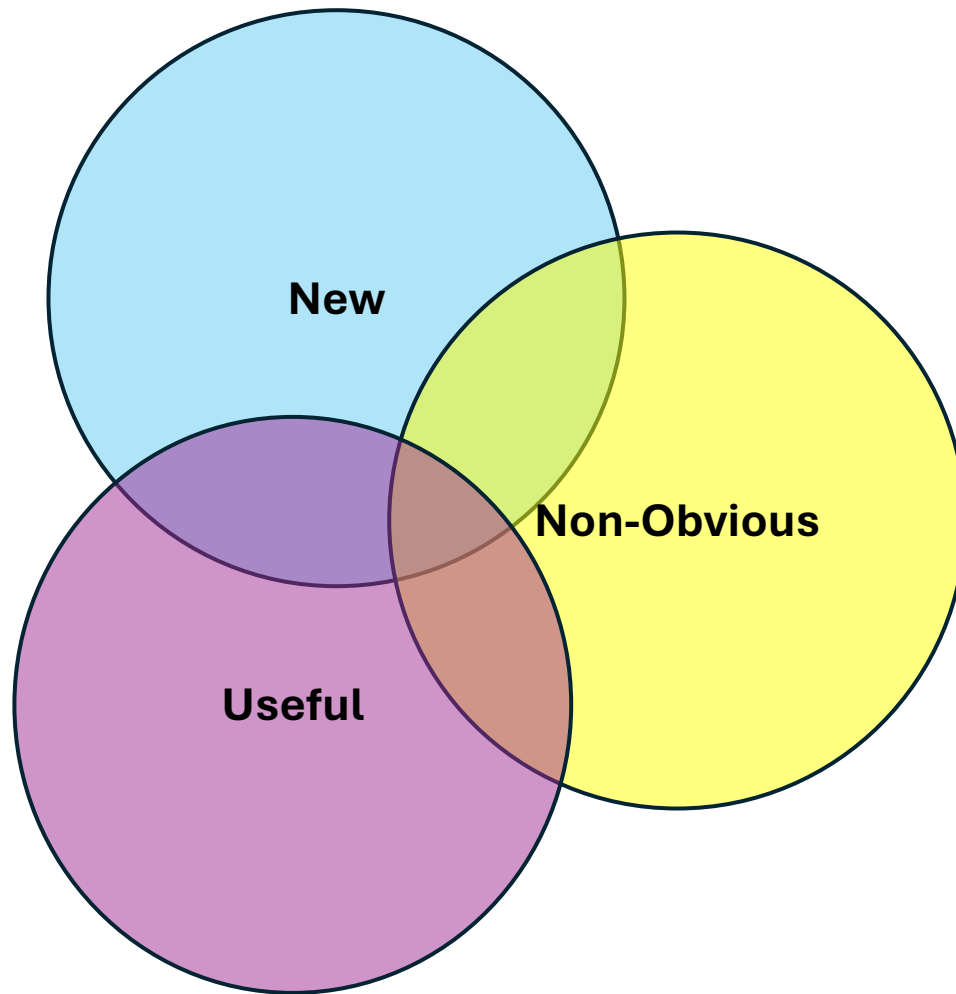
An invention is deemed unpatentable if:

“....[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...”



**Non-
Obvious**

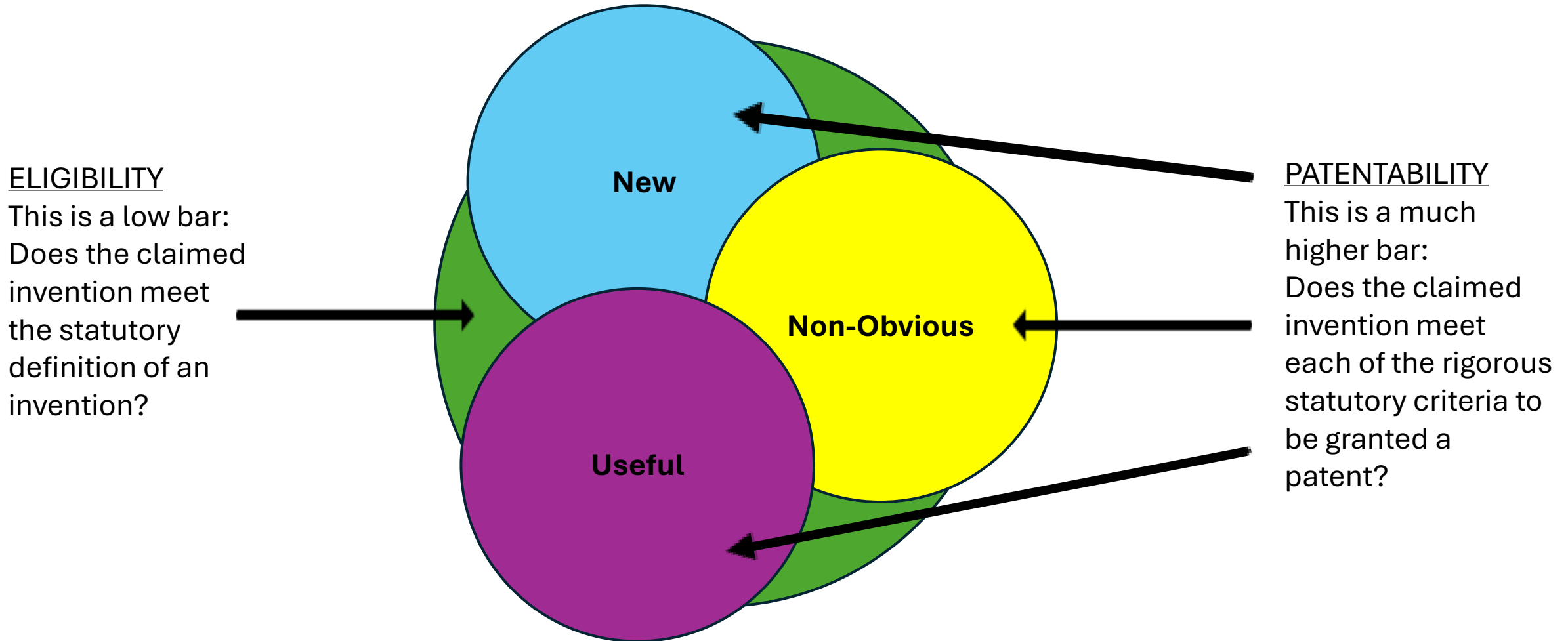
What Inventions are Patentable?



PATENTABILITY

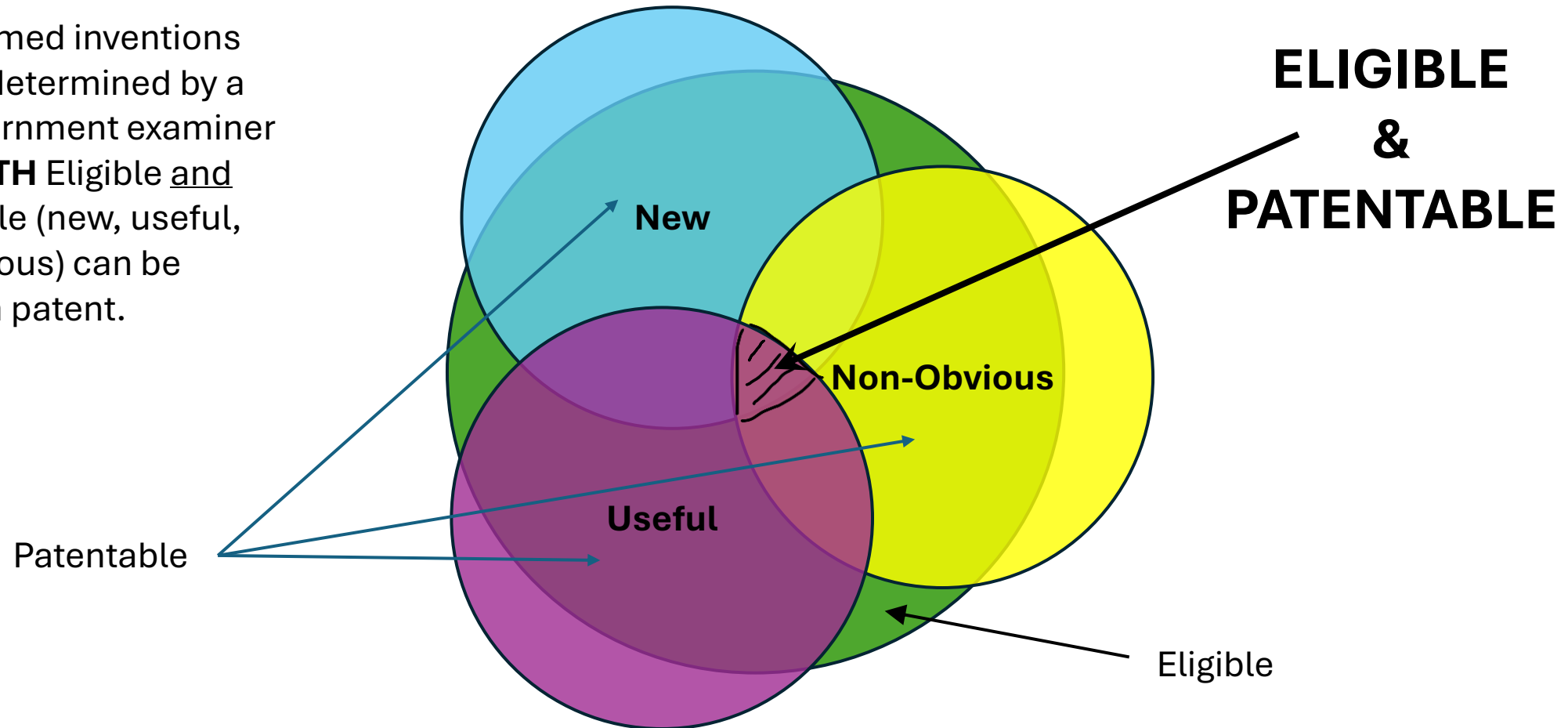
In order to be “patentable” an invention must be NEW and USEFUL and NON-OBVIOUS

III. Eligibility and Patentability Work Together to Ensure Appropriate Scope of Patent Rights



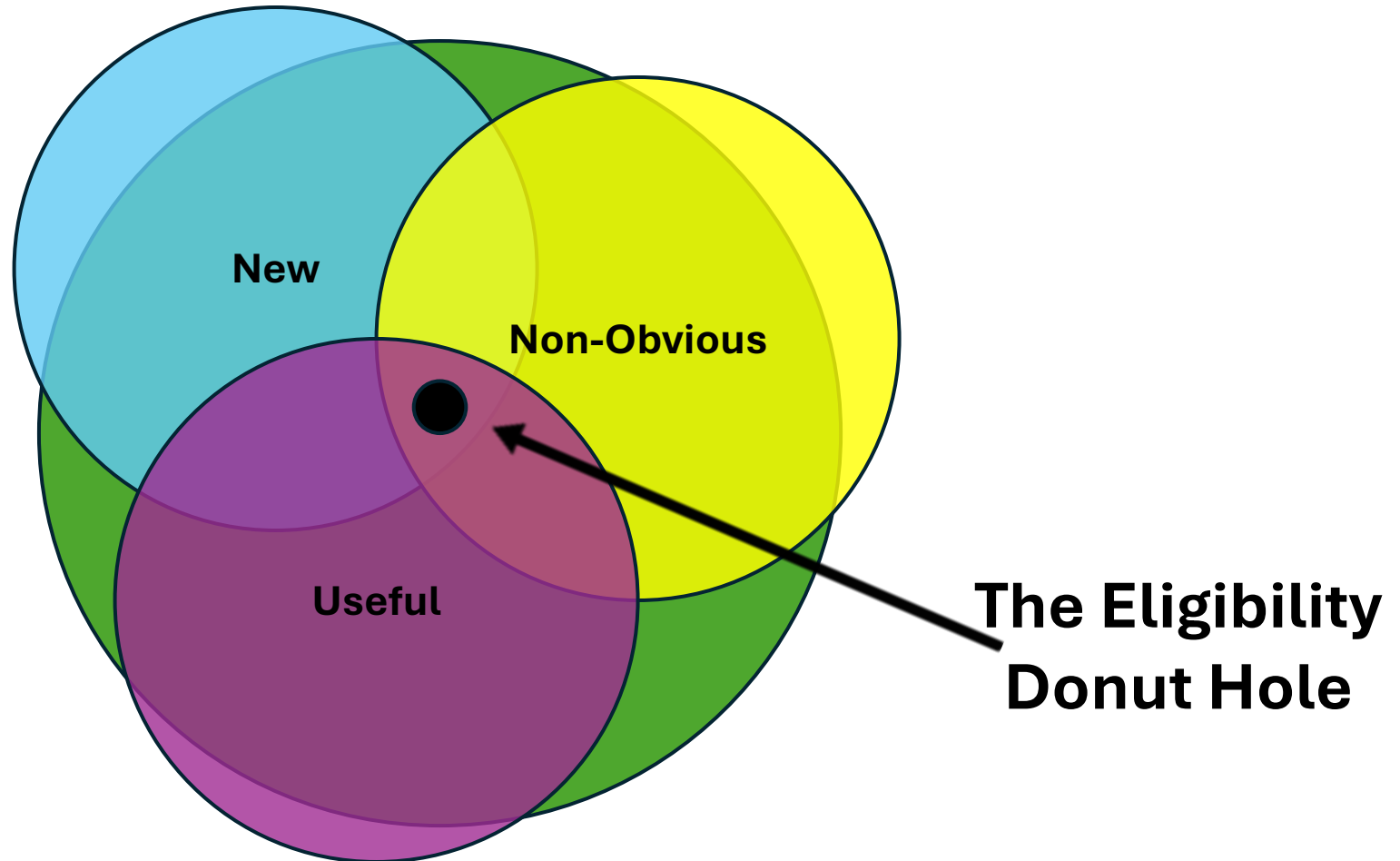
Eligibility and Patentability Work Together to Ensure Appropriate Scope of Patent Rights

Only claimed inventions that are determined by a U.S. government examiner to be **BOTH** Eligible and Patentable (new, useful, non-obvious) can be granted a patent.



The Eligibility Donut Hole

Some inventions 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.



Primary Resources:

U.S. Patent & Trademark Office, Patent Process Overview
(<https://www.uspto.gov/patents/basics/patent-process-overview#step1>)

Cornell Law School, Legal Information Institute, Title 35,
United States Code
(<https://www.law.cornell.edu/uscode/text/35>)