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April 19, 2018

The Honorable Andrei Iancu  
Under Secretary of Commerce for Intellectual Property and  
Director of the U.S. Patent and Trademark Office  
U.S. Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-14550

Via email to: [101Roundtable2@uspto.gov](mailto:101Roundtable2@uspto.gov)

**RE:** Comments of the Intellectual Property Law Association of Chicago (IPLAC) on Notice of Roundtables and Request for Comments Related to Patent Subject Matter Eligibility, 81 Fed. Reg. 71485, 10/17/2016.

Dear Under Secretary Iancu:

The Intellectual Property Law Association of Chicago ("IPLAC") appreciates the opportunity to provide comments to the US Patent and Trademark Office ("PTO") regarding possible changes to statutory law governing patent subject matter eligibility. These comments respond to the October 17, 2016 Federal Register Notice, 81 Fed. Reg. 71485 ("Notice") and the PTO July 2017 report ("Patent Eligible Subject Matter: Report on Views and Recommendations from the Public") summarizing public input to the Notice.

Founded in 1884, IPLAC is the country's oldest bar association devoted exclusively to intellectual property matters. Located in Chicago, a principal locus and forum for the nation's authors, artists, inventors, scholarly pursuits, arts, creativity, research and development, innovation, patenting, and patent litigation, IPLAC is a voluntary bar association of over 1,000 members with interests in the areas of patents, trademarks, copyrights, and trade secrets, and the legal issues they present. Its members include attorneys in private and corporate practice representing clients before federal courts throughout the United States, as well as the U.S. Patent and Trademark Office and the U.S. Copyright Office.

Having reviewed the July 2017 report summarizing public input to the Notice, IPLAC believes that the revisions to 35 U.S.C. § 101 that have been proposed by the Intellectual Property Owners Association (IPO) and American Intellectual

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ASSOCIATION OF CHICAGO**

Property Law Association (AIPLA) represent the most straightforward and comprehensive revisions to Section 101. Based on these two similar proposals, IPLAC recommends a harmonized proposal by adopting language from each. IPLAC's resolution to amend the language of 35 U.S.C. § 101 is attached as Appendix A. (We also include a comparison to the IPO and AIPLA recommendations to show how IPLAC seeks to harmonize the two proposals.)

Between IPLAC, IPO, and AIPLA, these three organizations include over 25,000 members who are involved in the practice of intellectual property law and who represent a wide variety of industries and technologies in the U.S. and abroad. We believe IPLAC's proposal that seeks to combine the recommendations from IPO and AIPLA into a single proposal furthers the current dialog regarding possible Section 101 revisions that can address the ambiguity and uncertainty recent Supreme Court precedent has created.

The United States patent system provides significant incentives that promote investment in the research and development of new technologies; protects emerging businesses and universities seeking investment; and protects established businesses who want to reinvest their capital into new products.

Over the last few years, the Supreme Court has been injecting ambiguity into the Section 101 subject-matter eligibility requirement, moving farther away from the language of the statute itself. *See Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 566 U.S. 10, 132 S. Ct. 1289 (2012) ("Mayo") (creating a new, ambiguous test for determining whether patents impermissibly claim a law of nature, natural phenomena, or abstract idea); *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 134 S. Ct. 2347 (2014) ("Alice") (further extending the uncertainty and ambiguity surrounding patent eligibility to software inventions). The recent patent eligibility case law is confusing and creates uncertainty as to both the availability of future patents and the validity of existing patents.

IPLAC believes that the current state of judicial interpretation of section 101 has reached a point where further judicial interpretation is unlikely to correct existing ambiguity and uncertainty. IPLAC also believes that legislation clarifying and re-establishing the distinct role of section 101 in limiting patent eligibility to practical uses of processes, machines, manufactures, and compositions of matter as recited in the statute is necessary. For example, the role of 35 U.S.C. § 101 should not overlap the roles of other sections of the statute, such as anticipation and obviousness. IPLAC, consistent with IPO and AIPLA, believes the separate analysis of anticipation, obviousness, and clarity *after* a subject matter determination will adequately limit inventions that do not meet statutory requirements for patentability. Nor should subject matter eligible for potential patent protection be subject to changing definitions developed and adjusted by courts over time. Rather, Congress should work to set forth a standard for defining patent eligible subject matter within the statute itself, namely, 35 U.S.C. § 101.



*INTELLECTUAL PROPERTY LAW  
ASSOCIATION OF CHICAGO*

IPLAC thanks the Patent and Trademark Office for considering these comments and would welcome any further dialogue or opportunity to support the Patent and Trademark Office in connection with clarifying the law of patent subject matter eligibility.

Very truly yours,

By Paul R. Kitch  
President, 2017-18



*INTELLECTUAL PROPERTY LAW  
ASSOCIATION OF CHICAGO*

## **Appendix A**

RESOLVED, the Intellectual Property Law Association of Chicago (IPLAC), supports, in principle, replacing in its entirety the current statutory language of 35 U.S.C. § 101 with language substantively consistent with the following:

**101(a) Eligible Subject Matter:** Whoever invents or discovers, and claims as an invention, any useful process, machine, manufacture, composition of matter, or any useful improvement thereto, shall be entitled to a patent for a claimed invention thereof, subject only to the exceptions, conditions, and requirements set forth in this Title.

**101(b) Sole Exceptions to Subject Matter Eligibility:** A claimed invention is ineligible under subsection (a) if and only if the claimed invention as a whole exists in nature independently of and prior to any human activity, or exists solely in the human mind. In determining eligibility, each claimed invention shall be considered as a whole.

**101(c) Sole Eligibility Standard:** The eligibility of a claimed invention under subsections (a) and (b) shall be determined without regard to (i) the requirements or conditions of sections 102, 103, and 112 of this Title, (ii) the manner in which the claimed invention was made or discovered, or (iii) the claimed invention's inventive concept.