

PATENTABILITY CHECKLIST

(Use this to review our coverage of patentability and to test your understanding.)

Nota Bene: This is merely an *introduction* to intellectual property law. In the book we chose to spend our limited space on the basic requirements for patentability. Patent law goes far beyond these issues and is the subject of separate specialized classes.

1) Subject matter eligibility under § 101 and judicial exceptions

- Is the claimed invention a process, machine, manufacture, or composition of matter?
- Is it directed to a *judicial exception*—law of nature, natural phenomenon, abstract idea? *Mayo* step 1
- If so, is there an *inventive concept*: does the claim recite additional elements that amount to *significantly more* than the judicial exception? *Mayo* step 2. Generic computer implementation is not enough to satisfy this step. *Alice*
- Look at the case law for guidance on what is naturally or non-naturally occurring, what constitutes an abstract idea, and what kinds of inventions include an inventive concept sufficient for patentability.
 - Patent eligible: *Chakrabarty* (genetically modified bacteria), *Myriad* (cDNA), *Diehr* (industrial process of operating a rubber-molding press), *DDR Holdings* (e-commerce outsourcing system/generating a composite web page)
 - Patent ineligible: *Mayo* (process for determining drug dosage), *Myriad* (isolated DNA), *Bilski* (method for hedging risk), *Alice* (generic computer implementation of intermediated settlement), note new cases such as *Ultramercial* (ad supported content delivery) and older cases *Funk Brothers*, *Benson*, *Flook* (see citations within cases)
- Consider special issues associated with business method, software, and biotech patents

2) Utility § 101

- Does the asserted use show that the invention has *substantial, specific, credible* utility?
- *Brenner*: no patents over research intermediaries, “a patent is not a hunting license”
- *See Fisher* for definitions of substantial and specific utility and application to ESTs

3) Novelty § 102

- Is the invention novel? Or is it anticipated by prior art?
- There must be meaningful public access to the prior art (*Gayler*), and to anticipate, every element must be present in a single prior art reference (*Coffin*), but the elements can be expressly, implicitly (*Verdegaal*), or inherently (*Cruciferous Sprout*) described.
- Statutory bar: if, more than 1 year before filing the application, the inventor makes the invention available, the invention is not novel (§ 102(a), *Pennock*), unless the experimental use exception applies (*City of Elizabeth*, *Allen Engineering*).

4) Non-obviousness § 103

- Is the invention non-obvious to a PHOSITA? Apply the 4-part test from *Deere*. 1.) “the scope and content of the prior art are to be determined”; 2.) “differences between the prior art and the claims at issue are to be ascertained”; 3.) “and the level of ordinary skill in the pertinent art resolved”; 4.) “Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.”
- We illuminated that test through the following cases: *Stratoflex* (all 4 factors are analyzed), *Clay* (analogous art is in the same field of endeavor or reasonably pertinent to the problem), *Bell* (obvious to try only defeats patentability when the inventor is choosing from a finite number of identified, predictable solutions). NB the PHOSITA is a hypothetical, imaginary being. *Kimberly-Clark*.

