United States: Solicitor General On Patent Eligibility

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The Solicitor General (SG) was invited by the Supreme Court to provide comments on the certiorari petitions filed by Berkheimer and Hikma to review the Federal Circuit's 101 decisions adverse to them. The two briefs have numerous similarities including identifying the Court's decision in *Bilski*[1] as starting the patent eligibility confusion by not grounding its decision on interpreting the meaning of the 35 U..S.C. 101 terms "process, machine, manufacture, [and] composition of matter." The SG asserts that in *Bilski* the Court did not ground its decision on the stature terms but instead found three exceptions to be not required by the statutory text: laws of nature, physical phenomenon, and abstract ideas. While these concepts are found earlier Supreme Court decisions, *Bilski* represented the first time they were used independent of the statutory language or constitutional concept of the "useful arts." The SG then described *Mayo*[2] as continuing the Court's *Bilski* practice of not tying patent eligibility to any of the statutory or Constitutional language. *Alice*[3] characterized the Mayo decisional approach as a two step process.

The SG's brief in *Berkheimer* then focuses on the Federal Circuit's decision, in particular its claim by claim approach to patent eligibility. The brief focuses in on the dispute as to whether or not the *Berkheimer* claims have sufficient details to meet the requirements of 35 U.S.C. 112. The SG concludes that it would be difficult to provide any meaningful clarity on 101's boundaries without first knowing whether the claims represent a particular practical implementation of broader software principles to achieve the stated objectives or simply state a desired result. As a result the SG concluded that the petition should be denied unless the *Athena* [insert footnote] petition in granted and then the petition should be held pending the Court's decision in *Athena*[4] and then considered.

In *Hikma* the SG finds both the first and second steps of the *Alice/Mayo* test to be ambiguous. As to the first step, the ambiguity is the Court's use of the term "directed at" a law of nature, natural phenomenon or abstract idea. The SG is correct, claims aren't "directed at" anything, claims contain limitations which define the claimed subject matter. The PTAB's approach of simply ignoring the law of nature, natural phenomenon, and abstract idea avoids the issue of "directed at". See *ex Parte Lee,* Appeal No. 2017-011014, decided January 14, 2019. The PTAB in *Lee* after "stripping out" the patent ineligible subject matter then looked to see if any of the steps were new or if the order was new. It found both.

The second step of determining if the remainder of the claim is directed to well-understood, routine, conventional activities previously known to industry, is similarly ambiguous

because in part of its overlap with other sections of the Patent Act, sections 102 and 103, and because its inconsistent with the Court's prior decision in *Diehr*[5] In *Diehr* the Court emphasized that the novelty of any step or element is irrelevant to the determination of patent eligibility. The SG also expressed concern that the ambiguity could result in claims with a novel arrangement of known steps being considered patent ineligible.

The SG suggested that the Court return to the history of the Patent Act to look to define the terms in 101. The SG cited to Justice Stevens concurring opinion in *Bilski* explaining that, although the term "process" standing alone might encompass "[a] process for training a dog, a series of dance steps, [or] a method of shooting a basketball," context and historical understanding preclude that interpretation of the term as it appears in Section 101.[6]

The SG did not consider Hikma to be the case to clarify 101 since, in his opinion, the Federal Circuit's opinion was correct. The SG had the same conclusion as in *Berkheimer*, deny the petition but if the the petition in *Athena* is granted, hold this petition pending the outcome in the in *Athena*.

Effectively the SG used the *Berkheimer* and *Hikma* petitions to present its views on the *Athena* petition without being asked.

Footnote

1 *Bilski v. Kappos*, 561 U.S. 593 (2010)

2 *Mayo Collaborative Servs. v. Prometheus Labs., Inc*., 566 U.S. 66 (2012) .

3 *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 573 U.S. 208 (2014)

4 *Athena Diagnostics, Inc. v. Mayo Collaborative Servs., LLC*, 927 F.3d 1333 (Fed. Cir. 2019), petition for cert. pending, No. 19-430 (filed Oct. 1, 2019)

5 *Athena Diagnostics, Inc. v. Mayo Collaborative Servs., LLC*, 927 F.3d 1333 (Fed. Cir. 2019), petition for cert. pending, No. 19-430 (filed Oct. 1, 2019)

6 Bilski, 561 U.S. at 624