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# Patent Eligibility: Reinventing Title 35

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On September 16, 2011, the most significant change in the US patent system in decades took place when the Leahy-Smith America Invents Act was signed into law.<sup>1</sup> While legal professionals were assessing and adapting to the new legislation, notable developments took place at the Federal Circuit and the Supreme Court via the landmark decisions of *Mayo Collaborative Services v. Prometheus Laboratories, Inc.* and *Alice Corporation Pty., Ltd. v. CLS Bank International*. In the wake of those opinions and others discussed below, practitioners may find themselves considering another round of legislative reform, particularly with regards to 35 U.S.C. §§ 101-103. The history and contours of certain aspects of patent law, as embodied in Sections 101-103 are explored below, and modifications of the statute are proposed to replace the current analysis of patent eligibility.

The Constitution of the United States gives Congress the power to establish a patent system.<sup>2</sup> Although Congress is not required to exercise that power, it has chosen to do so. The first Patent Act was enacted in 1790.<sup>3</sup> The second Patent Act, which, for all intents and purposes, established the modern claiming and

examination system, as well as the current patent numbering scheme, was enacted in 1836.<sup>4</sup> The Patent Act was codified in its present form, at Title 35 of the United States Code, in 1952, although there have been many subsequent amendments, including major amendments in 1994 (Uruguay Round Agreements Act),<sup>5</sup> 1999 (American Inventors Protection Act)<sup>6</sup> and 2011 (Leahy-Smith America Invents Act).<sup>7</sup>

Section 101 of Title 35, Inventions Patentable, states:

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.

While it has been held that Section 101 “is overall a general statement of the type of subject matter that is eligible for patent protection subject to the conditions and requirements” of Title 35, and that Congress did not intend to create “an independent requirement of novelty nor non-obviousness distinct from the more specific and detailed requirements of 35 U.S.C. §§ 102 and 103,” *In re Bilski*,<sup>8</sup> it is generally agreed that Section 101 establishes a requirement of “utility” (from “useful”),<sup>9</sup> and that any claimed invention must fall into one of the four “statutory classes”—“process, machine, manufacture or composition of matter.”<sup>10</sup> Although an invention only needs to provide “some identifiable benefit”<sup>11</sup> to be deemed useful, not every useful invention will be considered patent-eligible subject matter.<sup>12</sup>

It also generally is agreed that Section 101 was not intended to change the pre-1952 law of patent eligibility, but only to codify it.<sup>13</sup> The courts have long held that notwithstanding the broad statement of patent eligibility in the statute, there are three “judicial exceptions” to patent eligibility: (1) laws of nature, (2) natural phenomena, and (3) abstract ideas. However, these “judicial exceptions” were to be just that—exceptions—and were not intended to “swallow all of patent law,”<sup>14</sup> and “anything under the sun made by man”<sup>15</sup> ought to be patent-eligible.

Nevertheless, as a reaction to the issuance of overly broad patents by the US Patent and Trademark Office in the 1990s and 2000s, particularly in the relatively new fields of biotechnology and computer software (including computer-implemented business methods), the courts, including the Supreme Court, have turned

more and more to Section 101 to combat those “bad” patents. Their rationale is that the “judicial exceptions” to patent eligibility prevented “basic building blocks of human ingenuity,” which should be free to all, from being “preempted.”<sup>16</sup>

However, “preemption” is one of the biggest red herrings in patent law. “Preemption” is what patent claims do—they preempt, by definition, everything that is legitimately within their scope. The trick is to define that scope appropriately. The “judicial exceptions” to patent eligibility are not the appropriate way to define claim scope.

The “basic building blocks” language is a late 20th Century New Age rationalization for the “judicial exceptions.” To properly understand the judicial exceptions—laws of nature, natural phenomena or abstract ideas—one must first recognize that while it is tempting to treat them all together, they do not all have the same basis.

The first two categories of “exceptions,” laws of nature and natural phenomena, are relatively easy to understand. It is suggested here that these “exceptions” arise from the problem that the patent laws have a hard time addressing unwritten prior art. While the law recognizes public sales and uses as prior art, those forms of prior art are difficult to prove. It is much easier to rely on publications, including patents, to assess whether a claimed invention is novel and non-obvious. In contrast, although laws of nature and natural phenomena may be the archetypes of prior art—“published” in the fabric of the universe at the dawn of time—those laws are not always written down and may not be entirely known at any point in time. Consequently, the courts have dealt with the indefinite realm of the laws of nature and natural phenomena by excepting them from patent eligibility.

The third category of “exceptions,” the abstract idea, is more difficult to comprehend. It originated in law over 150 years ago, as Justice Thomas correctly stated in *Alice Corp. Pty. Ltd. v. CLS Bank International*.<sup>17</sup> It first appeared in British patent cases in the 1850s and quickly found its way to these shores.<sup>18</sup> However, the original formulation was not “abstract idea,” but rather “idea in the abstract.”<sup>19</sup> English being the way it is that formulation was relatively quickly short-handed to “abstract idea.”<sup>20</sup> But despite the change in formulation, there was no intent to change the meaning. In those days, before there was a well-developed law of reduction to practice, an “idea in the abstract” was simply an idea that had not been reduced to practice.<sup>21</sup> It had nothing to do with abstractness vs. concreteness as it is used today.

In modern abstract-idea jurisprudence, the closest concept to the original “idea in the abstract” is “an idea of itself.”<sup>22</sup> The rest of modern abstract-idea jurisprudence is a crutch, meant to avoid the rigors of proving obviousness or lack of novelty. Any invention can be

generalized, if desired, to the point of abstraction. For example, it could be argued that Thomas Edison merely recognized the well-known phenomenon that an object heated hot enough in a non-oxidizing atmosphere will glow without burning. Yet one would be hard-pressed to argue that Edison did not deserve his incandescent light bulb patent.

Under modern application of the “judicial exceptions,” those exceptions have indeed “swallow[ed] all of patent law,”<sup>23</sup> notwithstanding the Supreme Court’s admonition against doing so. The proposed solution is better definitions, in the patent statutes, of what is novel and what is non-obvious.

Below is a proposal for amending Sections 101-103 of the Patent Act, as well as adding a new Section 104 (which was conveniently removed by Congress in the America Invents Act, obviating the need to add a Section 103A).<sup>24</sup> The proposal simplifies Section 101, specifying that there are no exceptions to patentability as long as the invention falls into one of the four statutory classes. Proposed amended Section 101 also specifies for the first time that the “conditions for patentability” are those set forth in Sections 102 and 103, as well as new Section 104.

#### **§ 101. Inventions patentable eligible for patenting**

(a) ~~Whoever invents or discovers any new and useful~~ Any process, machine, manufacture, or composition of matter, without exception, or any new and useful improvement thereof, may obtain a patent therefor, shall be eligible for patenting, subject to the conditions and requirements of this title.

(b) CONDITIONS FOR PATENTABILITY- The conditions for patentability are set forth in sections 102, 103 and 104. In any assessment, under this section, of eligibility for patenting, the conditions for patentability shall not be considered.

New Section 104 is the proposed home of the utility requirement, which is removed from Section 101. The intent is to formally recognize usefulness as a condition to patentability, but not to change the related law. In other words, the legislative history would state that moving the utility requirement from Section 101 to Section 104 is not meant to change established utility law.

#### **§ 104. Conditions for patentability; utility**

A patent for a claimed invention may not be obtained unless the claimed invention is useful.

To more clearly address the laws of nature and natural phenomena “exceptions” as prior art, and not “exceptions,”

the proposed amendment of Section 102 includes a new subsection (e) that states that a law of nature or natural phenomenon, regardless of when discovered, is to be considered to have been published more than one year prior to the filing date of any patent application. Likewise, here, the legislative intent would clarify that the addition of Section 102(e) does not alter any prior interpretations of “law of nature” or “natural phenomenon.”

#### § 102. Conditions for patentability; novelty

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(e) Other Prior Art. — For purposes of this title, any law of nature and any natural phenomenon, regardless of when discovered or first observed, shall be considered to have been published more than 1 year before the effective filing date of any claimed invention. However, the result of the operation of a natural phenomenon on a non-naturally-occurring substance shall not be considered a natural phenomenon or a law of nature.

Lastly and most importantly, Section 101 is proposed to be amended to eliminate the abstract-idea exception, and considerations of novelty or non-obviousness are prohibited in assessing patent eligibility, meaning a claimed invention cannot be deemed patent-ineligible by virtue of being well-known (although it still might not be novel). However, the problem at the heart of most abstract-idea cases—*i.e.*, how to deal with claims to the mere use of a generic computer to perform a well-known function—is addressed by amending Section 103 to recite that mere use of a generic computer to automate something that is otherwise not novel, or that is otherwise obvious, is itself to be considered obvious.

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

(a) A patent for a claimed invention may not be obtained, notwithstanding that the claimed invention is not identically disclosed as set forth in section 102, if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains. The person having ordinary skill in the art is a hypothetical practitioner of the art who is presumed to know all of the relevant prior art at the time of the invention, but thinks along the line of conventional wisdom in the art and is not one who undertakes to innovate.

(b) Patentability shall not be negated by the manner in which the invention was made. However, the mere recitation of the use of a machine element to implement subject matter that is otherwise identically disclosed as set forth in section 102, or to implement subject matter that is otherwise considered obvious under this section, without recitation of a specific function of the machine element, shall be considered obvious

The proposed amendment of Section 103 also addresses the excesses of *KSR International Co. v. Teleflex Inc.*,<sup>25</sup> (*KSR*). In that decision, the Supreme Court, without acknowledging that it was doing so, changed the definition of a person of ordinary skill in the art from the traditional definition, which encompassed a person with perfect knowledge of the prior art, and the ability to see how prior art references can be combined, but no inventive ability, to a person of “ordinary creativity.”<sup>26</sup> If “invention” is not excluded from “creativity,” the decision in *KSR* is a return to the pre-1952 “flash of genius” judicial test for non-obviousness<sup>27</sup> that was supposed to have been legislatively overruled by the final sentence of current Section 103 (“Patentability shall not be negated by the manner in which the invention was made.”).

Therefore, the proposed amendment adopts the definition of a person of ordinary skill in the art set forth by Judge Rich in *Std. Oil Co. v. Am. Cyanamid Co.*<sup>28</sup> Here, the legislative history would state that the redefining of the person of ordinary skill in *KSR* is overruled, without necessarily returning to the TSM test.<sup>29</sup>

It is tempting to resort to patent eligibility to deal with overbroad patents on new technologies as the patent examination process catches up with those technologies, but the result is the “swallowing [of] all of patent law.” The proposed amendments are meant to reconfigure the statute so that it is repositioned with longstanding principles, in a way that aligns it more readily with new technologies. No single component of these amendments will solve the challenges faced by patent practitioners; however, as a collection, they are offered as an improvement over the current patent-eligibility analysis.

## Collection of Proposed Amendments of Title 35

#### §101. Inventions patentable eligible for patenting

(a) Whoever invents or discovers any new and useful Any process, machine, manufacture, or composition of matter, without exception, or any new and useful improvement thereof, may obtain a patent therefor, shall be eligible for patenting, subject to the conditions and requirements of this title.

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(b) CONDITIONS FOR PATENTABILITY- The conditions for patentability are set forth in sections 102, 103 and 104. In any assessment, under this section, of eligibility for patenting, the conditions for patentability shall not be considered.

**§102. Conditions for patentability; novelty**

(a) Novelty; Prior Art.—A person shall be entitled to a patent unless—

(1) 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; or

(2) the claimed invention was described in a patent issued under section 151, or in an application for patent published or deemed published under section 122(b), in which the patent or application, as the case may be, names another inventor and was effectively filed before the effective filing date of the claimed invention.

(b) Exceptions.—

(1) Disclosures made 1 year or less before the effective filing date of the claimed invention.—A disclosure made 1 year or less before the effective filing date of a claimed invention shall not be prior art to the claimed invention under subsection (a)(1) if—

(A) the disclosure was made by the inventor or joint inventor or by another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor; or

(B) the subject matter disclosed had, before such disclosure, been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor.

(2) Disclosures appearing in applications and patents.—A disclosure shall not be prior art to a claimed invention under subsection (a)(2) if—

(A) the subject matter disclosed was obtained directly or indirectly from the inventor or a joint inventor;

(B) the subject matter disclosed had, before such subject matter was effectively filed under

subsection (a)(2), been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor; or

(C) the subject matter disclosed and the claimed invention, not later than the effective filing date of the claimed invention, were owned by the same person or subject to an obligation of assignment to the same person.

(c) Common Ownership Under Joint Research Agreements.—Subject matter disclosed and a claimed invention shall be deemed to have been owned by the same person or subject to an obligation of assignment to the same person in applying the provisions of subsection (b)(2)(C) if—

(1) the subject matter disclosed was developed and the claimed invention was made by, or on behalf of, 1 or more parties to a joint research agreement that was in effect on or before the effective filing date of the claimed invention;

(2) the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement; and

(3) the application for patent for the claimed invention discloses or is amended to disclose the names of the parties to the joint research agreement.

(d) Patents and Published Applications Effective as Prior Art.—For purposes of determining whether a patent or application for patent is prior art to a claimed invention under subsection (a)(2), such patent or application shall be considered to have been effectively filed, with respect to any subject matter described in the patent or application—

(1) if paragraph (2) does not apply, as of the actual filing date of the patent or the application for patent; or

(2) if the patent or application for patent is entitled to claim a right of priority under section 119, 365(a), 365(b), 386(a), or 386(b), or to claim the benefit of an earlier filing date under section 120, 121, 365(c), or 386(c), based upon 1 or more prior filed applications for patent, as of the filing date of the earliest such application that describes the subject matter.

(e) Other Prior Art. — For purposes of this title, any law of nature and any natural phenomenon, regardless of when discovered or first observed, shall be considered to have been published more than 1 year before the effective filing date of any claimed invention. However, the result of the operation of a natural phenomenon on a non-naturally-occurring substance shall not be considered a natural phenomenon or a law of nature.

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

(a) A patent for a claimed invention may not be obtained, notwithstanding that the claimed invention is not identically disclosed as set forth in section 102, if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to

which the claimed invention pertains. The person having ordinary skill in the art is a hypothetical practitioner of the art who is presumed to know all of the relevant prior art at the time of the invention, but thinks along the line of conventional wisdom in the art and is not one who undertakes to innovate.

(b) Patentability shall not be negated by the manner in which the invention was made. However, the mere recitation of the use of a machine element to implement subject matter that is otherwise identically disclosed as set forth in section 102, or to implement subject matter that is otherwise considered obvious under this section, without recitation of a specific function of the machine element, shall be considered obvious.

### §104. Conditions for patentability; utility

A patent for a claimed invention may not be obtained unless the claimed invention is useful.

1. Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284 (2011).
2. U.S. Const. art I, § 8, cl. 8.
3. Act of Apr. 10, 1790, ch. 7, 1 Stat. 109 (1790).
4. Patent Act of 1836, ch. 356-57, 5 Stat. 117 (1836) (Patents for useful Inventions). Patents issued under the Patent Act of 1790, known as “name and dated patents,” were unnumbered, and most of the related records were destroyed by fire on December 15, 1836. Patent Act of 1837, ch. 45, 5 Stat. 191 (1837). Restored patents, which were assigned arbitrary numbers with an “X” suffix, are now referred to by “X-numbers.” Records of the Patent and Trademark Office (241.2 – Reconstructed Records), ARCHIVES.GOV, <http://www.archives.gov/research/guide-fed-records/groups/241.html#241.2> (last visited July 5, 2016).
5. Uruguay Round of the General Agreement on Tariffs and Trade. Uruguay Round Agreements Act, Pub. L. No. 103-465, 108 Stat. 4809 (1994).
6. American Inventors Protection Act of 1999, Pub. L. No. 106-113, 113 Stat. 1501A-552 (1999).
7. AIA, *supra* note 1.
8. *In re Bilski*, 545 F.3d 943, 958 (Fed. Cir. 2008).
9. *Juicy Whip, Inc. v. Orange Bang, Inc.*, 185 F.3d 1364, 1366 (Fed. Cir. 1999) (“Section 101 of the Patent Act of 1952, 35 U.S.C. § 101, provides that ‘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 on the invention or discovery. The threshold of utility is not high: An invention is ‘useful’ under section 101 if it is capable of providing some identifiable benefit.”) (internal citations omitted).
10. *Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 713-714 (Fed. Cir. 2014) (“A § 101 analysis begins by identifying whether an invention fits within one of the four statutorily provided categories of patent-eligible subject matter: processes, machines, manufactures, and compositions of matter. 35 U.S.C. § 101.”); *Genetic Techs. Ltd. v. Merial L.L.C.*, 818 F.3d 1369, 1380 (Fed. Cir. 2016) (“Utility is not the test for patent-eligible subject matter.”) (internal citation omitted).
11. *Juicy Whip*, 185 F.3d 1364, 1366.
12. *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1380 (Fed. Cir. June 12, 2015), *cert. denied*, *Sequenom, Inc. v. Ariosa Diagnostics, Inc.*, No. 15-1182, 2016 U.S. LEXIS 4087, at \*1 (June 27, 2016) (“We do not disagree that detecting cfDNA in maternal plasma or serum that before was discarded as waste material is a positive and valuable contribution to science. But even such valuable contributions can fall short of statutory patentable subject matter, as it does here.”).
13. *In re Nuijten*, 500 F.3d 1346, 1352 (Fed. Cir. 2007) (“Language setting forth a variety of categories of matter deemed patentable has existed throughout the history of American patent law. The country’s first patent statute permitted a patent on ‘any art, manufacture, engine, machine or device.’

Soon thereafter, Congress amended the patent laws, changing the language to allow a patent for ‘any new and useful art, machine, manufacture or composition of matter.’ The next substantial amendment to the patent laws left this statutory language unchanged. This four-category language has persisted to the present day, with the exception of the technical change of ‘art’ to ‘process,’ defined as ‘process, art or method,’ in 1952.”) (internal citations omitted).

14. *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 573 U.S. \_\_\_, \_\_\_, 134 S. Ct. 2347, 2354 (2014) (*Alice*) (“At the same time, we tread carefully in construing this exclusionary principle lest it swallow all of patent law. At some level, ‘all inventions... embody, use, reflect, rest upon, or apply laws of nature, natural phenomena, or abstract ideas.’ Thus, an invention is not rendered ineligible for patent simply because it involves an abstract concept. ‘[A]pplication[s]’ of such concepts ‘to a new and useful end,’ we have said, remain eligible for patent protection.”) (internal citations omitted).
15. *Bilski v. Kappos*, 561 U.S. 593, 642-43 (2010) (“The full sentence in the Committee Reports reads: ‘A person may have ‘invented’ a machine or a manufacture, which may include anything under the sun that is made by man, but it is not necessarily patentable under section 101 unless the conditions of [this] title are fulfilled.’ Viewed as a whole, it seems clear that this language does not purport to explain that ‘anything under the sun’ is patentable. Indeed, the language may be understood to state the exact opposite: that ‘[a] person may have ‘invented’... anything under the sun,’ but that thing ‘is not necessarily patentable under section 101.’... The 1952 Act, in short, cannot be understood as expanding the scope of patentable subject matter by suggesting that any series of steps may be patented as a ‘process’ under § 101. If anything, the Act appears to have codified the conclusion that subject matter which was understood not to be patentable in 1952 was to remain unpatentable.”) (internal citations omitted).
16. *Alice*, 134 S.Ct. at 2354 (“‘We have long held that this provision contains an important implicit exception: Laws of nature, natural phenomena, and abstract ideas are not patentable.’ We have interpreted § 101 and its predecessors in light of this exception for more than 150 years. We have described the concern that drives this exclusionary principle as one of pre-emption. Laws of nature, natural phenomena, and abstract ideas are ‘the basic tools of scientific and technological work.’ “[M]onopolization of those tools through the grant of a patent might tend to impede innovation more than it would tend to promote it,’ thereby thwarting the primary object of the patent laws.”) (internal citations omitted).
17. *Id.*
18. *Id.*
19. *Le Roy v. Tatham*, 55 U.S. 156, 174-175 (1853) (“The word principle is used by elementary writers on patent subjects, and sometimes in adjudications of courts, with such a want of precision in its application, as to mislead. It is admitted, that a principle is not patentable. A principle, in the abstract, is a

- fundamental truth**; an original cause; a motive; these cannot be patented, as no one can claim in either of them an exclusive right.”) (emphasis added).
20. See, e.g., *Atkinson v. Boardman*, 2 F. Cas. 97, 98 (D.D.C. 1847) (“In the absence of all evidence to the contrary, the presumption, therefore, is that he was also the inventor; and the burden of proof is thrown upon Mr. Atkinson to show, not merely that he first suggested to Mr. Boardman the **abstract idea** of a steam-pump—but that he invented the improvements which entitled it to a patent.”) (emphasis added); *Johnson v. Root*, 13 F. Cas. 807, 809 (C.C.D. Mass. 1861) (“When an independent instrument in the immediate vicinity of the needle is used for feeding, it is applied directly to the material to be fed, and near the point where the stitches are being formed. But whether the vibrating piercing instrument used be the needle, or an independent instrument in the immediate vicinity of the needle, the third claim of the plaintiff’s patent is not for an **abstract idea** or principle; nor for every means of applying power directly to the cloth at or near the point where the stitches are being formed, for the purpose of feeding it in a sewing-machine, in contradistinction to applying power for that purpose to a plate, clamp, or bar, to which the cloth is attached. On the contrary, it is, as before stated, for such means of applying power to the cloth for the purpose of feeding it in a sewing-machine, as the inventor has substantially described in the specification of his patent.”) (emphasis added); *Watson v. Cunningham*, 29 F. Cas. 429, 430 (C.C.W.D. Pa. 1871) (“In the light of the proofs in the case, the novelty of the invention is as clear as its utility is obvious. It is satisfactorily proved, that the patentee had fully conceived the **abstract idea** of his invention as early as January, 1868, and that in April of that year, he embodied it in the form of a model in wood, as completely and exactly as he described it afterward in his specification.”) (emphasis added).
  21. See, e.g., *Bader v. Vajen*, 14 App. D.C. 241, 249 (D.C. Cir. 1899) (“Now, it is an elementary principle in the patent law that he who first reduces to practice is to be regarded as the true inventor of the idea or device so reduced from a mere abstraction to a concrete form, in the absence of proof that he has only elaborated the idea of others, or of proof that there has been prior conception of the invention by another or others, with a showing of due diligence in the way of effort to reduce it to practice.”).
  22. *Alice*, 134 S.Ct. at 2355 (“The ‘abstract ideas’ category embodies ‘the long-standing rule that [a]n idea of itself is not patentable.’”) (citations omitted).
  23. *Id.* at 2354 (“At the same time, we tread carefully in construing this exclusionary principle lest it swallow all of patent law. At some level, ‘all inventions...embody, use, reflect, rest upon, or apply laws of nature, natural phenomena, or abstract ideas.’ Thus, an invention is not rendered ineligible for patent simply because it involves an abstract concept. ‘[A]pplication[s] of such concepts ‘to a new and useful end,’ we have said, remain eligible for patent protection.”) (internal citations omitted).
  24. Section 104: Repealed. Pub. L. 112-29, §3(d), 125 Stat. 287 (2011).
  25. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007).
  26. *Id.* at 421 (“A person of ordinary skill is also a person of ordinary creativity, not an automaton.”).
  27. *Cuno Eng’g Corp. v. Automatic Devices Corp.*, 314 U.S. 84, 91 (1941) (“That is to say, the new device, however useful it may be, must reveal the flash of creative genius, not merely the skill of the calling. If it fails, it has not established its right to a private grant on the public domain.”).
  28. *Std. Oil Co. v. Am. Cyanamid Co.*, 774 F.2d 448, 454 (Fed. Cir. 1985) (“The issue of obviousness is determined entirely with reference to a hypothetical ‘person having ordinary skill in the art.’ It is only that hypothetical person who is presumed to be aware of all the pertinent prior art. The actual inventor’s skill is irrelevant to the inquiry, and this is for a very important reason. The statutory emphasis is on a person of ordinary skill. Inventors, as a class, according to the concepts underlying the Constitution and the statutes that have created the patent system, possess something—call it what you will—which sets them apart from the workers of ordinary skill, and one should not go about determining obviousness under Section 103 by inquiring into what patentees (*i.e.*, inventors) would have known or would likely have done, faced with the revelations of references. A person of ordinary skill in the art is also presumed to be one who thinks along the line of conventional wisdom in the art and is not one who undertakes to innovate, whether by patient, and often expensive, systematic research or by extraordinary insights, it makes no difference which.”) (emphasis in the original).
  29. *KSR*, 550 U.S. at 415-418 (“Throughout this Court’s engagement with the question of obviousness, our cases have set forth an expansive and flexible approach inconsistent with the way the Court of Appeals applied its TSM test here. ... Following these principles may be more difficult in other cases than it is here because the claimed subject matter may involve more than the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for the improvement. Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. ... As our precedents make clear, however, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.”).