118TH CONGRESS
1ST SESSION

S. 2140

To amend title 35, United States Code, to address matters relating to patent subject matter eligibility, and for other purposes.

IN THE SENATE OF THE UNITED STATES
JUNE 22, 2023

Mr. TILLIS (for himself and Mr. COONS) introduced the following bill; which was read twice and referred to the Committee on the Judiciary

A BILL
To amend title 35, United States Code, to address matters relating to patent subject matter eligibility, and for other purposes.

Be it enacted by the Senate and House of Representa-
tives of the United States of America in Congress assembled,

SECTION 1. SHORT TITLE.

This Act may be cited as the “Patent Eligibility Resto-
ration Act of 2023”.

SECTION 2. FINDINGS.

Congress finds the following:

(1) As of the day before the date of enactment of this Act, patent eligibility jurisprudence inter-
preting section 101 of title 35, United States Code, requires significant modification and clarification.

(2) For many years after the original enactment of section 101 of title 35, United States Code, the Supreme Court of the United States and other courts created judicial exceptions to the wording of that section, thereby rendering an increasing number of inventions ineligible for patent protection.

(3) Efforts by judges of district courts and courts of appeals of the United States to apply the exceptions described in paragraph (2) to specific circumstances have led to extensive confusion and a lack of consistency—

(A) throughout the judicial branch of the Federal Government and Federal agencies; and

(B) among patent practitioners.

(4) Many judges of the United States Court of Appeals for the Federal Circuit and of various district courts of the United States have explicitly expressed the need for more guidance with respect to the meaning of section 101 of title 35, United States Code, and many patent owners, and persons that engage with patent owners, complain that the interpretation of that section is extremely confusing and difficult to discern and apply with any confidence.
(5) Under this Act, and the amendments made by this Act, the state of the law shall be as follows:

(A) All judicial exceptions to patent eligibility are eliminated.

(B) Any invention or discovery that can be claimed as a useful process, machine, manufacture, or composition of matter, or any useful improvement thereof, is eligible for patent protection, except as explicitly provided in section 101 of title 35, United States Code, as amended by this Act, as described in subparagraphs (D) and (E) of this paragraph.

(C) Sections 102, 103, and 112 of title 35, United States Code, will continue to prescribe the requirements for obtaining a patent, but no such requirement will be used in determining patent eligibility.

(D) The following inventions shall not be eligible for patent protection:

(i) A mathematical formula that is not part of an invention that is in a category described in subparagraph (B).

(ii) A mental process performed solely in the mind of a human being.
(iii) An unmodified human gene, as that gene exists in the human body.

(iv) An unmodified natural material, as that material exists in nature.

(v) A process that is substantially economic, financial, business, social, cultural, or artistic.

(E) Under the exception described in subparagraph (D)(v)—

(i) process claims drawn solely to the steps undertaken by human beings in methods of doing business, performing dance moves, offering marriage proposals, and the like shall not be eligible for patent coverage, and adding a non-essential reference to a computer by merely stating, for example, “do it on a computer” shall not establish such eligibility; and

(ii) any process that cannot be practically performed without the use of a machine (including a computer) or manufacture shall be eligible for patent coverage.

SEC. 3. PATENT ELIGIBILITY.

(a) IN GENERAL.—Chapter 10 of title 35, United States Code, is amended—
(1) in section 100—

(A) in subsection (b), by striking “includes a new use of a known process” and inserting “includes a use, application, or method of manufacture of a known or naturally-occurring process”; and

(B) by adding at the end the following:

“(k) The term ‘useful’ means, with respect to an invention or discovery, that the invention or discovery has a specific and practical utility from the perspective of a person of ordinary skill in the art to which the invention or discovery pertains.”; and

(2) by amending section 101 to read as follows:

“§ 101. Patent eligibility

“(a) IN GENERAL.—Whoever invents or discovers any useful process, machine, manufacture, or composition of matter, or any useful improvement thereof, may obtain a patent therefor, subject only to the exclusions in subsection (b) and to the further conditions and requirements of this title.

“(b) ELIGIBILITY EXCLUSIONS.—

“(1) IN GENERAL.—Subject to paragraph (2), a person may not obtain a patent for any of the following, if claimed as such:
“(A) A mathematical formula that is not part of a claimed invention in a category described in subsection (a).

“(B)(i) Subject to clause (ii), a process that is substantially economic, financial, business, social, cultural, or artistic, even though not less than 1 step in the process refers to a machine or manufacture.

“(ii) The process described in clause (i) shall not be excluded from eligibility for a patent if the process cannot practically be performed without the use of a machine or manufacture.

“(C) A process that—

“(i) is a mental process performed solely in the human mind; or

“(ii) occurs in nature wholly independent of, and prior to, any human activity.

“(D) An unmodified human gene, as that gene exists in the human body.

“(E) An unmodified natural material, as that material exists in nature.

“(2) CONDITIONS.—For the purposes of subparagraphs (D) and (E) of paragraph (1), a human
gene or natural material shall not be considered to be unmodified if the gene or material, as applicable, is—

“(A) isolated, purified, enriched, or otherwise altered by human activity; or

“(B) otherwise employed in a useful invention or discovery.

“(c) ELIGIBILITY.—

“(1) IN GENERAL.—In determining whether, under this section, a claimed invention is eligible for a patent, eligibility shall be determined—

“(A) by considering the claimed invention as a whole and without discounting or disregarding any claim element; and

“(B) without regard to—

“(i) the manner in which the claimed invention was made;

“(ii) whether a claim element is known, conventional, routine, or naturally occurring;

“(iii) the state of the applicable art, as of the date on which the claimed invention is invented; or

“(iv) any other consideration in section 102, 103, or 112.
“(2) INFRINGEMENT ACTION.—

“(A) IN GENERAL.—In an action brought for infringement under this title, the court, at any time, may determine whether an invention or discovery that is a subject of the action is eligible for a patent under this section, including on motion of a party when there are no genuine issues of material fact.

“(B) LIMITED DISCOVERY.—With respect to a determination described in subparagraph (A), the court may consider limited discovery relevant only to the eligibility described in that subparagraph before ruling on a motion described in that subparagraph.”.

(b) TECHNICAL AND CONFORMING AMENDMENT.—

The table of sections for chapter 10 of title 35, United States Code, is amended by striking the item relating to section 101 and inserting the following:

“101. Patent eligibility.”.