

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.

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

3 **SECTION 1. SHORT TITLE.**

4 This Act may be cited as the “Patent Eligibility Res-
5 toration Act of 2023”.

6 **SEC. 2. FINDINGS.**

7 Congress finds the following:

8 (1) As of the day before the date of enactment
9 of this Act, patent eligibility jurisprudence inter-

1 preting section 101 of title 35, United States Code,
2 requires significant modification and clarification.

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

9 (3) Efforts by judges of district courts and
10 courts of appeals of the United States to apply the
11 exceptions described in paragraph (2) to specific cir-
12 cumstances have led to extensive confusion and a
13 lack of consistency—

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

16 (B) among patent practitioners.

17 (4) Many judges of the United States Court of
18 Appeals for the Federal Circuit and of various dis-
19 trict courts of the United States have explicitly ex-
20 pressed the need for more guidance with respect to
21 the meaning of section 101 of title 35, United States
22 Code, and many patent owners, and persons that en-
23 gage with patent owners, complain that the interpre-
24 tation of that section is extremely confusing and dif-
25 ficult to discern and apply with any confidence.

1 (5) Under this Act, and the amendments made
2 by this Act, the state of the law shall be as follows:

3 (A) All judicial exceptions to patent eligi-
4 bility are eliminated.

5 (B) Any invention or discovery that can be
6 claimed as a useful process, machine, manufac-
7 ture, or composition of matter, or any useful
8 improvement thereof, is eligible for patent pro-
9 tection, except as explicitly provided in section
10 101 of title 35, United States Code, as amend-
11 ed by this Act, as described in subparagraphs
12 (D) and (E) of this paragraph.

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

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

20 (i) A mathematical formula that is
21 not part of an invention that is in a cat-
22 egory described in subparagraph (B).

23 (ii) A mental process performed solely
24 in the mind of a human being.

1 (iii) An unmodified human gene, as
2 that gene exists in the human body.

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

5 (v) A process that is substantially eco-
6 nomic, financial, business, social, cultural,
7 or artistic.

8 (E) Under the exception described in sub-
9 paragraph (D)(v)—

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

19 (ii) any process that cannot be prac-
20 tically performed without the use of a ma-
21 chine (including a computer) or manufac-
22 ture shall be eligible for patent coverage.

23 **SEC. 3. PATENT ELIGIBILITY.**

24 (a) IN GENERAL.—Chapter 10 of title 35, United
25 States Code, is amended—

1 (1) in section 100—

2 (A) in subsection (b), by striking “includes
3 a new use of a known process” and inserting
4 “includes a use, application, or method of man-
5 ufacture of a known or naturally-occurring
6 process”; and

7 (B) by adding at the end the following:

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

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

14 **“§ 101. Patent eligibility**

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

21 “(b) ELIGIBILITY EXCLUSIONS.—

22 “(1) IN GENERAL.—Subject to paragraph (2), a
23 person may not obtain a patent for any of the fol-
24 lowing, if claimed as such:

1 “(A) A mathematical formula that is not
2 part of a claimed invention in a category de-
3 scribed in subsection (a).

4 “(B)(i) Subject to clause (ii), a process
5 that is substantially economic, financial, busi-
6 ness, social, cultural, or artistic, even though
7 not less than 1 step in the process refers to a
8 machine or manufacture.

9 “(ii) The process described in clause (i)
10 shall not be excluded from eligibility for a pat-
11 ent if the process cannot practically be per-
12 formed without the use of a machine or manu-
13 facture.

14 “(C) A process that—

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

17 “(ii) occurs in nature wholly inde-
18 pendent of, and prior to, any human activ-
19 ity.

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

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

24 “(2) CONDITIONS.—For the purposes of sub-
25 paragraphs (D) and (E) of paragraph (1), a human

1 gene or natural material shall not be considered to
2 be unmodified if the gene or material, as applicable,
3 is—

4 “(A) isolated, purified, enriched, or other-
5 wise altered by human activity; or

6 “(B) otherwise employed in a useful inven-
7 tion or discovery.

8 “(c) ELIGIBILITY.—

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

12 “(A) by considering the claimed invention
13 as a whole and without discounting or dis-
14 regarding any claim element; and

15 “(B) without regard to—

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

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

21 “(iii) the state of the applicable art,
22 as of the date on which the claimed inven-
23 tion is invented; or

24 “(iv) any other consideration in sec-
25 tion 102, 103, or 112.

1 “(2) INFRINGEMENT ACTION.—

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

9 “(B) LIMITED DISCOVERY.—With respect
10 to a determination described in subparagraph
11 (A), the court may consider limited discovery
12 relevant only to the eligibility described in that
13 subparagraph before ruling on a motion de-
14 scribed in that subparagraph.”.

15 (b) TECHNICAL AND CONFORMING AMENDMENT.—
16 The table of sections for chapter 10 of title 35, United
17 States Code, is amended by striking the item relating to
18 section 101 and inserting the following:

“101. Patent eligibility.”.

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