



FÉDÉRATION INTERNATIONALE DES CONSEILS
EN PROPRIÉTÉ INTELLECTUELLE

INTERNATIONAL FEDERATION OF
INTELLECTUAL PROPERTY ATTORNEYS

INTERNATIONALE FÖDERATION
VON PATENTANWÄLTEN

15 December 2022

FICPI Statement on the Patent Eligibility Restoration Act of 2022

FICPI strongly supports the proposed Patent Eligibility Restoration Act of 2022 which was introduced by Senator Thom Tillis (R-NC) on August 3, 2022, following several years of discussions with stakeholders. FICPI played an active role in those conversations, representing our worldwide community of independent IP attorneys and their diverse range of clients and providing an international perspective.

Patent subject-matter eligibility in the US is a complex matter; made more complex by lack of clarity around defining patent subject matter eligibility after the Mayo, Myriad and Alice Supreme Court Cases in the 2010s. The complexity is highlighted by Federal Circuit Judges making regular pleas to Congress to take some action to clarify 35 USC § 101, to enable the courts to determine the metes and bounds of patent eligible subject matter in a way which makes it clearer to inventors and business what can and cannot be patented in the US.

There are particular uncertainties in the medical field around the patenting of diagnostic methods and pharmaceutical products derived from nature; in the field of computer-implemented inventions around what is an invention versus an abstract idea; and questions over the definition of the term ‘useful’ with respect to an invention or discovery.

These uncertainties have an impact outside the US into global markets: many worthy projects outside the US do not get funded as a result of the problems in the US.

The draft legislation aims to curb the judge-made exceptions to patent eligibility in the US and to restore clarity around what is patentable for IP attorneys, courts and inventors.

The new Bill must be passed by both the House and Senate.

FICPI Immediate Past President, Julian Crump, participated in a Pro-reform group led by former Director of the USPTO, David Kappos, and former Chief Judge of the CAFC (and FICPI Member of Honour), Paul Michel. An ad hoc committee of US and international FICPI members was formed to follow discussions within the pro-reform group and to support the Mr Crump’s participation in that group.

Mr Crump commented: *“I welcome the introduction of this Bill. In recent years, patent eligibility in the US has moved significantly out of step with the norm in the rest of the world, which is problematic in itself; but the lack of clarity over what can be patented has made life very difficult and expensive for applicants in some very important areas of technology. I was pleased to help the Pro-reform group with their discussions, offering insight on what works well within other patent systems, and assisting in the development of the proposed new text for US legislation. Let’s hope the Bill passes.”*

While we wait to see whether the Bill will pass, discussions continued at the FICPI World Congress held in September 2022, with a breakout session on “Eligibility: whither the patent system” including pre-recorded remarks from both Sen. Till and Judge Michel, and speakers



presenting the views of both the Pro-reform and opposite Concerned groups who have been negotiating possible legislative changes.

Becoming a FICPI member enables you to share ideas and concerns with other independent IP attorneys around the world who share a strong shared interest and commitment to quality.

Regular FICPI representation at IP Office and Association events ensures that members' views are conveyed, and that the perspective of such bodies is relayed back to the FICPI membership.

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