



[3510-16-P]

DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

[Docket No. PTO-P-2014-0024]

Notice of Forum on the Guidance For Determining Subject Matter Eligibility Of Claims Reciting Or Involving Laws of Nature, Natural Phenomena, and Natural Products

AGENCY: United States Patent and Trademark Office, Commerce.

ACTION: Notice of public meeting.

SUMMARY: The United States Patent and Trademark Office (Office) is hosting a forum to receive public feedback from organizations and individuals on its guidance memorandum titled, “Guidance For Determining Subject Matter Eligibility Of Claims Reciting Or Involving Laws Of Nature, Natural Phenomena, and Natural Products (Laws of Nature/Natural Products Guidance),” issued on March 4, 2014 and available at www.uspto.gov/patents/announce/myriad-mayo.jsp. The Laws of Nature/Natural Products Guidance implemented a new procedure to address changes in the law relating to subject matter eligibility under 35 U.S.C. 101 in view of recent Supreme Court precedent. The forum will be open for any member of the public to participate. The forum will provide an opportunity for participants to present their interpretation

of the impact of Supreme Court precedent on the complex legal and technical issues involved in subject matter eligibility analyses during patent examination. Participants who believe that the Supreme Court decisions could be implemented in an alternative manner from the approach taken in the Laws of Nature/Natural Products Guidance should use the forum to present their alternative approach and the legal rationale for the alternative. The forum also can be used by participants to suggest additional examples for use by the Office to create a more complete picture of the impact of Supreme Court precedent on subject matter eligibility.

DATES: Event: The forum will be held on May 9, 2014, beginning at 1:00 p.m. Eastern Daylight Time (EDT), and ending at 4:00 p.m. EDT.

Registration: Registration is required to attend the forum in person or via webcast. Additionally, members of the public who wish to participate in the forum as a speaker must do so by request in writing no later than April 25, 2014. See the “Registration Information” section of this notice for additional details on how to register.

ADDRESSES: Event: The forum will be held in the Madison Auditorium North on the concourse level of the Madison Building, which is located at 600 Dulany Street, Alexandria, Virginia 22314.

Comments: Any member of the public, whether attending the forum or not, may submit written comments for consideration by the Office. There is no deadline for receipt of written comments. Persons submitting written comments should note that the Office will not necessarily provide a

response. Written comments should be sent by electronic mail addressed to myriad-mayo_2014@uspto.gov. Comments also may be submitted by mail addressed to: Mail Stop Comments – Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, marked to the attention of Raul Tamayo. Although comments may be submitted by mail, the Office prefers to receive comments via the Internet.

Comments will be available via the Office's Internet Web site at <http://www.uspto.gov/patents/announce/myriad-mayo.jsp>. Because comments will be available for public inspection, information that is not desired to be made public, such as an address or phone number, should not be included in the comments.

EVENT REGISTRATION INFORMATION: There is no fee to register for the forum, and registration will be on a first-come, first-served basis. Members of the public who would like to be considered to participate in the forum as a speaker must do so by request in writing no later than April 25, 2014. Registration on the day of the forum will be permitted for members of the public who wish solely to observe on a space-available basis beginning 30 minutes before the forum.

To register, please send an e-mail message to myriad-mayo_2014@uspto.gov and provide the following information: (1) Your name, title, and if applicable, company or organization, address, phone number, and e-mail address; (2) whether you wish to attend in person or via webcast; and (3) if you wish to make an oral presentation at the forum, the specific topic you intend to address,

and the approximate desired length of your presentation. Each attendee, even if from the same organization, must register separately.

Due to time constraints, there is the potential that not all persons who wish to make a presentation will be accommodated. After reviewing the list of potential speakers and the information regarding the presentations provided in the registration, the Office plans to select speakers in a manner that ensures that the Office is receiving a balanced array of views. The Office will contact each selected speaker prior to the event with the amount of time available and the approximate time that the speaker's presentation is scheduled to begin. The amount of time available for each presentation may be limited to ensure that all persons selected to speak will have a meaningful chance to do so. Speakers must send the final electronic copies of their presentations in Microsoft PowerPoint or Microsoft Word to myriad-mayo_2014@uspto.gov by April 25, 2014, so that the presentation can be displayed at the forum. If time permits, the Office will provide an opportunity for persons in the audience not previously selected as speakers to speak at the forum without a formal presentation.

The Office plans to make the forum available via webcast. Webcast information, as well as a list of forum participants and their associations, will be available on the Office's Internet Web site before the forum at <http://www.uspto.gov/patents/announce/myriad-mayo.jsp>.

If special accommodations due to a disability are needed, please inform the contact person(s) identified below.

FOR FURTHER INFORMATION CONTACT: Requests for additional information regarding the forum should be directed to Raul Tamayo, Senior Legal Advisor, Office of Patent Legal Administration, by telephone at 571-272-7728, or by e-mail to raul.tamayo@uspto.gov.

SUPPLEMENTARY INFORMATION: The Office issued the Laws of Nature/Natural Products Guidance on March 4, 2014 and made it available via the Office's Internet Web site at <http://www.uspto.gov/patents/announce/myriad-mayo.jsp>. The Laws of Nature/Natural Products Guidance states that it is for use in subject matter eligibility determinations of all claims (i.e., machine, composition, manufacture, and process claims) reciting or involving laws of nature/natural principles, natural phenomena, and/or natural products. The Laws of Nature/Natural Products Guidance addresses the impact of Association for Molecular Pathology v. Myriad Genetics, Inc.¹ (Myriad) on the Supreme Court's long-standing "rule against patents on naturally occurring things," as expressed in its earlier precedent including Diamond v. Chakrabarty² (Chakrabarty), and Mayo Collaborative Services v. Prometheus Laboratories, Inc.³ (Mayo). Links to copies of these Supreme Court decisions, as well as a link to the Supreme Court's decision in Funk Brothers Seed Co. v. Kalo Inoculant Co.,⁴ are available at <http://www.uspto.gov/patents/announce/myriad-mayo.jsp>.

Since releasing the Laws of Nature/Natural Products Guidance, the Office has provided a first round of training for the examiners in Technology Centers (TCs) most likely to be impacted by the Laws of Nature/Natural Products Guidance (e.g., TC 1600 and 1700). The slides used to train the examiners are available at <http://www.uspto.gov/patents/announce/myriad-mayo.jsp>. The Office is currently working on developing a second round of more in-depth examiner

training. In addition, the Office established an email box (myriad-mayo_2014@uspto.gov) for members of the public to provide feedback on any aspect of the Laws of Nature/Natural Products Guidance rollout, including the Laws of Nature/Natural Products Guidance document itself and the training slides.

The forum will provide a more direct opportunity for members of the public to present their interpretation of the impact of the Supreme Court's decisions in, e.g., Myriad, Mayo, Chakrabarty, and Funk on the complex legal and technical issues involved in subject matter eligibility analyses during patent examination. The Office would like for members of the public who believe that the Supreme Court decisions could be implemented in an alternative manner from the approach taken in the Laws of Nature/Natural Products Guidance to use the forum to present their alternative approach and the legal rationale for the alternative. The forum also can be used by the public to suggest additional examples for use by the Office to create a more complete picture of the impact of Supreme Court precedent on subject matter eligibility. The Office will carefully consider all feedback it receives.

Dated: April 11, 2014.

Michelle K. Lee,
Deputy Under Secretary of Commerce for Intellectual Property and
Deputy Director of the United States Patent and Trademark Office.

¹ 569 U.S. ___, 133 S. Ct. 2107, 106 USPQ2d 1972 (2013).

² 447 U.S. 303 (1980).

³ 566 U.S. ___, 132 S. Ct. 1289, 101 USPQ2d 1961 (2012).

⁴ 333 U.S. 127 (1948).