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December 30, 2022

Peter-Anthony Pappas  
Professional Staff Member Detailee, Senate Committee on the Judiciary  
United States Senate  
113 Dirksen Senate Office Building  
Washington, DC 20510

Via email: [peter\\_pappas@judiciary-rep.senate.gov](mailto:peter_pappas@judiciary-rep.senate.gov)

**Re: S. 4734 Patent Eligibility Restoration Act of 2022**

Dear Peter-Anthony Pappas:

The National Association of Patent Practitioners (NAPP) thanks you for meeting on December 13, 2022, to discuss NAPP's rationale for its proposed amendments to S. 4734 Patent Eligibility Restoration Act of 2022. As you requested, we attach a corrected proposed markup to S. 4724 from NAPP's [letter to Senator Thom Tillis dated October 28, 2022](#).

We would like to again thank Senator Tillis for addressing this critical issue facing patent practitioners, and applaud the efforts to revise the text of 35 U.S.C 101.

NAPP would be pleased to meet with you in the future to further describe NAPP's rationale for its position on 35 U.S.C. § 101, S. 4734 Patent Eligibility Restoration Act of 2022, or any other patent matters affecting NAPP members who focus their work on representing small businesses, startups, and individual inventors before the USPTO. We appreciate your leadership and your consideration.

Sincerely,

A handwritten signature in black ink that reads "Christopher M. Turoski".

Christopher M. Turoski  
National Association of Patent Practitioners, President

cc: Cirilo Perez, Professional Staff Member to Sen. Thom Tillis (via email [cirilo\\_perez@tillis.senate.gov](mailto:cirilo_perez@tillis.senate.gov))

Corrected December 23, 2022

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NAPP respectfully proposes amending S. 4734 as follows:

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

1. Short title

This Act may be cited as the "Patent Eligibility Restoration Act of 2022".

2. 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:

Section 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<sup>1</sup>:

“(A) A mathematical formula, apart from a useful ~~invention or discovery~~ process, machine, manufacture, or composition of matter, or any useful improvement thereof.

“(B) A process that—

“(i) is ~~a non-technological~~ an economic, financial, business, social, cultural, or artistic process, unless such process is embodied in machine, article of manufacture, or composition of matter.

“(ii) is a mental process performed wholly solely ~~in the~~ a human mind<sup>2</sup>; or

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

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

“(D) An unmodified natural material, as that material exists in nature independent of human activity.

“(2) CONDITIONS.—

“(A) CERTAIN PROCESSES.—Notwithstanding paragraph (1)(B)(i), a person may obtain a patent for a claimed invention that is a process described in such provision if that process is embodied in a machine or manufacture, unless that machine or manufacture is recited in a patent claim without integrating, beyond merely storing and executing, the steps of the process that the machine or manufacture perform.

“(B) HUMAN GENES AND NATURAL MATERIALS.—For the purposes of subparagraphs (C) and (D) of paragraph (1), a human gene or natural material that is isolated, purified, enriched, or otherwise altered by human activity, or that is otherwise employed in a useful invention or discovery, shall not be considered to be unmodified.

(c) Eligibility

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<sup>1</sup> By “if claimed” we suggest that the legislative history reflect that the claim be considered with precision—for example, a claim that requires at least one step to be performed “in a computer processor” by definition cannot be performed entirely in the human mind.

<sup>2</sup> In the “mental process” exception, we suggest that the legislative history reflect that the mental process be performed in a reasonable amount of time in a single, ordinary human mind.

(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.