2016 Phoenix Issues

The Naples Roundtable

Phoenix Issue I.

To what extent is the Patent System served by judicially extending denial of patent eligibility under 35 U.S.C. § 101 beyond the concept of obviousness as enacted in 35 U.S.C. § 103? What subject matter lacks patent-eligibility that is *not* already denied patentability under §§ 102, 103, 112? How broadly should the § 101 eligibility standard be applied; e.g., in the biotech area, for medical diagnostics, and for all machines controlled by any computer program?

Phoenix Issue II.

Has the Patent System been well served by judicial pronouncements of patent preemption? (Cf. *Bilski, Mayo, Alice* denying patent-eligibility on the basis of "preemption" of the basic building blocks of science.) Should patents preempt experimentation on, and not with, the patented invention? (*Deuterium Corp. v. U.S.*, 21 Cl. Ct. 132). Should the "all elements" rule that excludes infringement of a combination claim obviate the "preemption" concern where an otherwise ineligible element is paired in a combination claim that together provides an "inventive" (nonobvious) advance?

Phoenix Issue III.

Is innovation well served by the limitation on international patent exhaustion reflected in the result in *Jazz Photo*? (Cf. *Lexmark* on the way to the Supreme Court.) To what extent do notions of copyright exhaustion shed light on issues of patent exhaustion?

Phoenix Issue IV.

What policies should the USPTO adopt to streamline and expedite prosecution; e.g., placing limits on RCEs, creating greater certainty in making actions final, and resurrecting the doctrine of undue multiplicity?

Phoenix Issue V.

What changes are necessary to constructively better implement the AIA?

Phoenix Issue VI.

With the new requirement in the Federal Rules to address proportionality for determining the scope of discovery, how should the District Courts proceed in making the determination?