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Dear Mr Hirshfeld

## **Memorandum dated 4 March 2104 2014 Procedure for Subject Matter Eligibility Analysis**

We are responding to the opportunity given at the May 9 forum to submit comments to assist in the updating of the above guidance.

The Chartered Institute of Patent Attorneys (CIPA) represents around 2000 UK patent attorneys qualified by professional examination, but has a world-wide professional membership. We have a deep interest in patent law worldwide. In particular, for the benefit of inventors and technical progress, we seek convergence of patent laws throughout the world, as far as practical, towards an optimal common system. We believe this aspiration is widely shared - by successive US administrations, among others.

We have studied the guidance, the slides submitted in support of presentations at the May 9 forum and the comments made available on the USPTO website up to July 22, 2014.

We share the concerns of most commentators that the guidance is unjustifiably broad. We argue that:

- (a) respect for the Court's decisions means accepting the result in the cases before them, not extending the reasoning to other totally different fact situations;
- (b) it will put back by decades the US government's efforts to obtain sensible common standards in patent laws worldwide; and
- (c) the proposed far-reaching interpretation of the Supreme Court's recent decisions will harm innovation.

These concerns are developed at greater length in the attached paper. We fully support similar arguments filed by others, including those filed by Professor Paul Cole and the views expressed by Courtenay Brinckerhoff, Leslie Fischer and Warren Woessner at the May 9 forum.

We urge the USPTO to limit application of the Supreme Court's decisions to their specific holdings and the associated fact situations in which they arose: for example, that 'natural isolated DNA' unaccompanied by any new utility is not patentable. The appropriate test is a difference (e.g. of structure, concentration, freedom from contaminants, physical form) created by the hand of man and accompanied by new utility. No other yardstick such as 'significance' is required.

Yours sincerely,



Catriona Hammer  
President, Chartered Institute of Patent Attorneys

Enc: Detailed comments paper