September 18, 2024

The Honorable Richard J. Durbin
Chairman
Committee on the Judiciary
United States Senate
Washington, DC 20510

The Honorable Lindsey O. Graham
Ranking Member
Committee on the Judiciary
United States Senate
Washington, DC 20510

Dear Chairman Durbin and Ranking Member Graham:

We are 17 academics who study and write about patent law. We are writing to urge you to oppose the Patent Eligibility Restoration Act ("PERA"), S. 2140, which the Judiciary Committee has listed for mark up. Specifically, PERA is premature for this Committee's consideration and as written would be harmful to patent jurisprudence and innovation for at least the following reasons:

- **PERA would overturn centuries of jurisprudence that prevents patent law from effectively restricting the public domain of science, nature, and abstract ideas that benefits all of society.** It would do so by permitting patents on claims of invention that *uncreatively* apply categorically ineligible discoveries of science, nature, and abstract ideas. If such discoveries should not be eligible "as such" because they should be "free for all" and remain in the public domain, there is no "invention" in the uncreative applications of those ineligible discoveries. Allowing such claims to be treated as "inventions" would harm rather than promote the progress of science and technology.

- **PERA will not solve the wrongly alleged problems of uncertainty regarding what constitutes a patent-eligible "invention."** PERA is not needed, because patent eligible subject matter doctrine is no more uncertain in application than any other area of patent law. Claims of uncertainty regarding judicial application are not grounded in actual empirical evidence or fail to account for improper guidance (later revised) from the Patent Office. Eligibility determinations remain predictable to sophisticated patent practitioners. If there is any "uncertainty" problem, it can be addressed by better guidance, more training, and more time for examination, rather than by changing eligibility doctrine.

- **Rather, PERA will increase such uncertainty, generate wasteful litigation, and cause extensive harms in a wide range of fields.** PERA is poorly drafted, and would generate needless, extensive litigation over the new terminology that it adopts. Courts would need to make unguided decisions regarding when claims are drawn to excluded subject matter "as such." Courts would also have to distinguish whether subject matter is excluded as a process that is "substantially" economic, financial, business, social, cultural, or artistic (rather than technological). In practice, the "as such" and "substantially" limitations would likely be construed in a very limited manner, overextending the patent system to protect non-technological advances, again contrary to centuries of established practice. In sum, PERA will harm scientific discovery, health care, and other important societal activities.

PERA simply is not a good solution for any alleged problems regarding patent subject matter eligibility. We would be happy to work with the Committee to help to draft a reasonable and sensible bill to address any real problems that may be found to exist with eligibility doctrine, as well as to better educate

the judiciary, the Patent Office, and practitioners on the current state of the law and how to follow and apply it properly. As the bill is drafted, however, we urge you and the Committee not to move forward with it.

Signed: (titles and affiliations for identification purposes only):

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