**Appendix B:**

**Witnesses from the Hearings Before the Subcommittee on IP of the Senate Committee on the Judiciary, 116th Cong. (2019) who Testified to the Uncertainty of Current S. 101 Law**

**Witnesses supporting reforms:**

Statement of Hon. Paul R. Michel, Former Chief Judge United States Court of Appeals for the Federal Circuit (“If I, as a judge with 22 years of experience deciding patent cases on the Federal Circuit’s bench, cannot predict outcomes based on case law, how can we expect patent examiners, trial judges, inventors and investors to do so?”)

Statement of Hon. Q. Todd Dickinson, Former Under-Secretary of Commerce for Intellectual Property and Director, United States Patent and Trademark Office (“Unfortunately, the current rules are unnecessarily ambiguous and uncertain, and this uncertainty ends up serving no one at the end of the day.”)

Statement of Hon. David J. Kappos, Former Director, United States Patent and Trademark Office Partner at Cravath, Swaine & Moore LLP (“Our current patent eligibility law truly is a mess” and the case decisions “are irreconcilable, incoherent, and against our national interest.”)

Statement of Professor Jeffrey A. Lefstin, Associate Academic Dean University of California Hastings College of the Law (Section 101 has become an “‘I-know-it-when-I-see-it’ standard.”)

Statement of Mr. Robert A. Armitage, Consultant, IP Strategy and Policy (“whether a claimed invention is or is not ‘patent eligible’ today is fraught with an unacceptable degree of uncertainty.”)

Statement of Professor David O. Taylor, Co-Director of the Tsai Center for Law, Science and Innovation, Associate Professor of Law Southern Methodist University Dedman School of Law (“It is exceedingly difficult to understand whether a patent examiner or a court should find subject matter eligible for patenting given the overarching test for eligibility articulated by the Supreme Court.”)

Responses to Questions for the Record of Ms. Sherry M. Knowles, Esq., Principal,

Knowles Intellectual Property Strategies (“I fully agree with Judge Lourie and Judge Newman” that “‘the law needs clarification.’”)

Statement of Mr. Michael Rosen, Adjunct Fellow, American Enterprise Institute (Because of *Mayo* and *Alice*, “patent practice has been thrown into tumult.”)

Statement of Mr. Patrick Kilbride, Senior Vice President, Global Innovation Policy Center, U.S. Chamber of Commerce (*Mayo* and *Alice* have “led to considerable uncertainty for innovators and the legal community.”)

Statement of Professor Adam Mossoff, Professor of Law Antonin Scalia Law School, George Mason University (“The *Alice-Mayo* framework has created a tremendous amount of uncertainty for innovators.”)

Statement of Ms. Barbara Fiacco, President-Elect, American Intellectual Property Law Association (“The Court’s decisions have created significant uncertainty about what is eligible for patenting in the United States.”)

Statement of Mr. Scott Partridge, Immediate Past Chair, Intellectual Property Law Section

American Bar Association (The eligibility standard has created “ambiguity, unpredictability and uncertainty.”)

Statement of Mr. Henry Hadad, President, Intellectual Property Owners Association (The law has led to “great uncertainty and confusion.”)

Statement of Mr. Paul Morinville, President U.S. Inventor (noting that *Alice* “threw the definition of what is patentable subject matter under 35 USC 101 into chaos”)

Statement of Mr. Phil Johnson, Chair, Steering Committee Coalition for 21st Century Patent Reform (“No one in the IP profession can now predict with certainty whether any given invention that relies in any way upon a law of nature, natural phenomenon, or abstract idea, or utilizes a naturally derived material, will be ultimately held patent eligible.”)

Statement of Jeff Birchak, General Counsel, Vice President of Intellectual Property, and Secretary, Fallbrook Technologies, On behalf of Innovation Alliance (Section 101 jurisprudence “has led to uncertainty, unpredictability, and hindered innovation.”)

Statement of Mr. Hans Sauer, Deputy General Counsel for Intellectual Property, Biotechnology Innovation Organization (There is “continuing uncertainty, tension in the caselaw, and inconsistent or unpredictable outcomes.”)

Statement of Ms. Natalie M. Derzko, Of Counsel, Covington & Burling LLP, On behalf of Pharmaceutical Research and Manufacturers of America (“The uncertainty of the current framework, as interpreted by the courts, makes it hard for an inventor to know which inventions will be patentable or not.”)

Statement of Mr. Rick Brandon, Associate General Counsel, The University of Michigan, On behalf of Association of American Universities and the Association of University Technology Managers (“In recent years, our federal courts have made the determination of what is or is not patentable an increasingly murky process.”)

Statement of Mr. Manny Schecter, Chief Patent Counsel, IBM (“[T]he current lack of clarity created by judicially imposed patent eligibility standards” and the “inherent ambiguity of these standards has made it more difficult to obtain and enforce patents” and “do not provide the certainty needed to enable modern business to operate effectively.”)

Statement of Ms. Laurie Self, Senior Vice-President and Counsel, Government Affairs, Qualcomm (“The Supreme Court’s recent section 101 jurisprudence has left the scope of patent eligible subject matter unsettled and caused tremendous confusion in the courts, at USPTO, and among innovators.”)

Statement of Mr. Byron Holz, Senior Intellectual Property Rights Licensing Counsel, Nokia (“The uncertainty surrounding patentability of emerging technologies, including artificial intelligence (AI) and other software-based innovations, hampers investment and risks America’s global competitiveness in these fields.”)

Statement of Ms. Kim Chotkowski, Vice President, Head of Licensing Strategy and Operations, InterDigital (“In view of the current lack of clarity surrounding patent eligibility . . . a pillar of our nation’s economic success, the patent system, along with the Federal Courts, have been bogged down, with needless challenges and increased uncertainty.”)

Statement of Ms. Laurie Hill, Vice President Intellectual Property, Genentech (“The present uncertainty surrounding Section 101 threatens to disrupt development of a wide range of important medicines, diagnostics, treatments, and other innovations that benefit society.”)

Statement of Mr. Gonzalo Merino, Vice President and Chief Intellectual Property Counsel, Regeneron Pharmaceuticals (“Even if we are successful in overcoming” rejections in the patent office, “we would still face absolute uncertainty” in court.)

Statement of Mr. Peter O'Neill, Executive Director, Cleveland Clinic Innovations (“In recent years, decisions from the federal courts have cast a cloud of uncertainty over our work in the field of diagnostic tests and life sciences.”)

Statement of Dr. David Spetzler, President and Chief Scientific Officer, Caris Life Sciences (“Under the current state of the law, whether an invention is or is not patentable has become murky. This uncertainty deters the substantial investment necessary to develop new healthcare technologies.”)

Statement of Mr. Michael Blankstein, Senior Vice President and Deputy General Counsel, Patents and Licensing, Scientific Games (“The status quo on patent eligibility is unacceptable because it . . . leads to unpredictable outcomes.”)

Statement of Mr. Corey Salsberg, Vice President, Global Head IP Affairs, Novartis (We agree that “the patent eligibility status quo [i]s ‘uncertain,’ ‘unpredictable,’ and ‘a mess’ . . . . [T]he vagueness of the Supreme Court’s eligibility framework, and its lack of guidance as to how to apply it, has made it exceedingly difficult for us to predict whether even today’s innovations are patent-eligible.”)

Statement of Mr. Nicolas Dupont CEO and Executive Chairman Cyborg Inc. (“A second consequence results from the inability to predict patent eligibility.”)

Statement of Mr. Robert Deberadine, Chief Intellectual Property Counsel, Johnson & Johnson (“The patent system in the United States today is anything but predictable . . . . [T]he current state of the law surrounding Section 101 creates confusion.”)

Written Statement of Mr. Steven P. Caltrider, Vice President and General Patent Counsel, Eli Lilly and Company (“Patients, particularly those helped by the medical diagnostic industry, as well as inventors and employers are waiting for Congress to clarify and settle the law that has failed, unfortunately, to provide a sufficient degree of predictability and certainty to the threshold question of what subject matter is eligible for a patent.”)

**Witnesses opposing reforms:**

Statement of Professor Mark A. Lemley, William H. Neukom Professor of Law, Director, Program in Law, Science & Technology, Stanford University School of Law (“The law of patentable subject matter is a mess . . . . The Federal Circuit’s application of 101 law is inconsistent and uncertain. Unfortunately, courts have found it hard to apply the *Alice* test.”)

Statement of Professor Joshua D. Sarnoff, Professor of Law, DePaul University (Acknowledging the “current uncertainty in eligibility doctrine,” but opposing reforms)

Statement of Mr. David Jones, Executive Director, High Tech Inventors Alliance (“[W]e recognize that [the current eligibility test] may present challenges for segments of stakeholders in other sectors [beyond software]. It is not our intent to deny these difficulties . . . .” but “HTIA strongly favors retaining the current eligibility test and allowing the courts to continue to refine its application through a case-by-case common-law process.”)

Statement of Dr. William G. Jenks, Principal, Jenks IP Law, On behalf of Internet Association (Supporting USPTO’s 2019 Eligibility Guidance as a “promising start that, with modification, will help PTO examiners do their job with more uniformity,” and agreeing that the resulting “uniformity and accuracy in PTO decisions will be good for the system overall.”)

Statement of Mr. Christopher Mohr, Vice President for Intellectual Property and General Counsel, Software and Information Industry Association (“[W]e acknowledge the criticisms of the current approach to patent eligibility,” but “the benefits of Alice have outweighed any negative policy impact in the software and information industries.”)

Responses to Questions for the Record of Mr. Jeff Francer, General Counsel, Association for Accessible Medicines (“[The judicial] exceptions do not need to be maintained unmodified, as there may be some need to clarify their scope.”)

Statement of Mr. Sean Reilly, Senior Vice President and Associate General Counsel, The Clearing House Payments Company (“We do recognize . . . that there are very real and valid concerns related to Section 101 in certain specific sectors (e.g. medical diagnostics).”)

Statement of Mr. Sean George, Chief Executive Officer, Invitae (Supporting the current judicially-created standards, but stating that if Congress acts, “the right thing to do is to start by codifying the existing case law on patent subject matter eligibility and *working to improve their clarity*.”) (emphasis added)