Comments regarding Interim Guidance for Determining Subject Matter Eligibility for Process Claims in view of Bilski v. Kappos Docket PTO-P-2010-0067

The above notice requests, i.a. examples of claims that do not meet a machine-or-transformation test but nevertheless remain patent-eligible because they do not recite an abstract idea.

In this regard, I would direct your attention to claim 5 of the Morse telegraph patent which the U.S. Supreme Court held to be patentable subject matter (O'Reilly v. Morse, 56 U.S. 62, 1863) and which thus represents a long-standing class of patentable signaling "processes".

> **"'Fifth. I claim, as my invention, the system of signs, consisting of dots and spaces, and of dots, spaces, and horizontal lines, for numerals, letters, words, or sentences, [substantially as herein set forth and illustrated,] for telegraphic purposes."**

While this claim does not directly recite process steps, you should be aware that United States Court of Appeal for the Federal Circuit recently held that Morse's claim 5 **is a process claim**. (In re Nuijten 500 F.3d 1346, 2007 n9)

> "In the Morse telegraph case, the Supreme Court approved Samuel Morse's Claim 5 covering his "system of signs" (i.e., Morse code). 56 U.S. (15 How.) at 86. The written description of the patent describes Morse code as part of its description of the actual process of signaling. Id. at 94-95. While its dated language obscures the question somewhat, Morse's Claim 5 is a process claim covering the method (or "art") of signaling. The analogous claims in Nuijten's patent application are those that cover the process of generating signals rather than the signals themselves. "

Moreover it should be apparent, from principles of claim differentiation, that Morse's fifth claim is not tied to a machine- inasmuch as the next claim of his patent expressly ties the recited process to the related machinery.

> 'Sixth. I also claim as my invention the system of signs, consisting of dots and spaces, and of dots, spaces, and horizontal lines, substantially as herein set forth and illustrated, in combination with machinery for recording them, as signals for telegraphic purposes.

It further follows from Nuijten, that neither the claimed numerals, letters, words nor sentences are physical articles, thus the claim cannot be said describe a patentable transformation.

The Federal Circuit's Nuijten decision states that method claims in Nuijten's patent application 09/211,928 (now abandoned) are analogous to Morse's claim 5. Those method claims were found to be patentable by the BPAI and thus are representative of the modern format of a class of signal processing (signaling) methods which are also patentable subject matter, but are not directly tied to a machine and do not relate to transformation of a physical article. For example Claim 1:

" 1. A method of embedding supplemental data in a signal comprising the steps of:

Encoding the signal in accordance with an encoding process which includes the step of feeding back the encoded signal to control the encoding; and modifying selected samples of the encoded signal to represent the supplemental data prior to the feedback of the encoded signal and including the modifying of at least one further sample of the encoded signal preceding the selected sample if the further sample modification is found to improve the quality of the encoding process."

Similarly, another example of a patentable signal encoding process which is not expressly tied to a machine are the claims of Mr. Nuijten's granted patent 6,507,299:

"1. A method comprising the steps of: encoding an information signal; modifying, selected samples of the encoded signal to represent supplemental data and a synchronization bit pattern, the modified samples representing the supplemental data being spaced apart by at least a first number of samples, the modified samples representing the synchronization bit pattern being spaced apart by at most a second number of samples which is substantially smaller than the first number of samples; feeding back the encoded signal with the modified samples to control the encoding."

Respectfully Submitted,

Jack E. Haken

Reg. No. 26,902