From: John Nagle [e-mail redacted]
Sent: Tuesday, September 28, 2010 2:47 AM
To: Bilski_Guidance
Subject: Comments on "machine or transformation" test.

   The Office requests comments on the following questions"

1. What are examples of claims that do not meet the machine-or-transformation test but nevertheless remain patent-eligible because they do not recite an abstract idea?

2. What are examples of claims that meet the machine-or-transformation test but nevertheless are not patent-eligible because they recite an abstract idea?

3. The decision in Bilski suggested that it might be possible to "defin[e] a narrower category or class of patent applications that claim to instruct how business should be conducted," such that the category itself would be unpatentable as "an attempt to patent abstract ideas."
Bilski slip op. at 12. Do any such "categories" exist? If so, how does the category itself represent an "attempt to patent abstract ideas?"

In response to 1), I would suggest that the "machine or transformation"
test be interpreted to cover computer programs by expanding the concept of "machine". A software product can an article of manufacture. It may be fixed in a medium, provided as a "boxed product", and sold through retail channels. Where a program can be reduced to such a tangible form, patent coverage is appropriate.

In response to 2), I would suggest that financial constructs such as tax-minimization strategies or derivative securities do not meet the criteria for patentability because they are not embodied in an article of manufacture. A software program provided as an article of manufacture might be used as a tool in the design of such financial products, but the patentable item would be the tool, not the financial construct.

As an analogy, it is worth realizing that, in most modern manufacturing, physical objects begin their life as abstract mathematical representations in some computer aided design program. Through routine, and often automated, manufacturing processes, the designs are turned into material objects. In the areas of electronic design and integrated circuits, the designs are very similar to computer programs, and the process by which the designs are turned into material objects involves minimal human intervention and little if any creativity. Much the same reasoning applies to computer software manufacturing. Stamping out machine parts and stamping out program discs are comparable operations. Both produce an object of manufacture, a "machine", if you will.

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