From: Brad Pedersen [e-mail address redacted]
Sent: Monday, November 07, 2011 5:29 PM
To: aia_implementation
Cc: [e-mail address redacted]
Subject: Transitional program for covered business method patents

MIPLA Suggestions for Group 2 Rulemakings:
Subgroup 8 – Business Method Review (BMR) Specific Rules

And

MIPLA Suggestions for Group 2 Rulemakings:
Subgroup 9 – Definition of Technological Invention Rules

The Minnesota Intellectual Property Law Association (MIPLA) is grateful for the opportunity to provide input with respect to the Request by Janet Gongola for Public Comments Urged for Group 2 Proposed Rule Makings, dated October 28, 2011 on the USPTO America Invents Act (AIA) website. The suggestions contained in this email are submitted with respect to Group 2 Rulemakings – Subgroup 8 –Business Method Review (BMR) Specific Rules, and Subgroup 9 –Definition of Technological Invention Rules.

MIPLA is an independent organization of nearly 500 members in and around the Minnesota area representing all aspects of private and corporate intellectual property practice, as well as the academic community. MIPLA represents a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent law before the United States Patent and Trademark Office.

The comments submitted herewith reflect the general views of the Board of MIPLA after consultation and input from the IP Law, Patent Practice and Patent Litigation Committees, and do not necessarily reflect the view of opinions of any individual members or firms of the committees or MIPLA, or any of their clients. MIPLA understands that the USPTO will not directly respond to these suggestions, and MIPLA reserves the right to formulate specific comments pursuant to formal rule promulgation with respect to the Group 2 Rulemakings.

With respect to Subgroup 8 – BMR Specific Rules, MIPLA has the following suggestions:

8.1 Prior Art Validity Challenges in a BMR

We suggest that once the threshold for initiating a BMR has been met, the petitioner should be able to raise any validity challenged permitted under a PGR.

8.2 Interpreting Financial/Business Limit in a BMR

We suggest that the Office establish rules that in order to serve as the basis for initiating a BMR, a claim must: (a) include only a nominal recitation of a data processing system, calculating computer or other system for performing the data processing or other operations, and the machine or manufacture limitations must not be central to the claimed invention; (b) include only nominal claim recitation of any other environment; and (c) predominantly cover the practice, administration, or management of a financial product or service.

With respect to Subgroup 9 – Definition of Technological Invention Rules, MIPLA has the following suggestions:

9.1 Definition of Technological Innovation

We suggest that the Office should promulgate separate rules that define the term “technological innovation” in a manner consistent with the latest Federal Circuit guidance interpreting the Supreme Court’s decision in Bilski.

Submitted on behalf of MIPLA.

Brad Pedersen
Patent Practice Chair

PATTERSON THUENTE CHRISTENSEN PEDERSEN, P.A.
4800 IDS Center, 80 South 8th Street
Minneapolis, MN 55402-2100