From: Vincent Garlock [mailto:vgarlock@aipla.org]
Sent: Monday, September 28, 2009 4:26 PM
To: AB98 Comments
Cc: Todd Dickinson; Albert Tramposch; James Crowne
Subject: AIPLA Comments on Interim Examination Instructions for Evaluating Patent Subject Matter Eligibility

TO: Caroline D. Dennison
Office of the Deputy Commissioner for Patent Examination Policy

FROM: Q. Todd Dickinson
Executive Director
AIPLA

RE: Comments on Interim Examination Instructions for Evaluating Patent Subject Matter Eligibility

DATE: 09/28/09

Caroline,

On behalf of Executive Director Todd Dickinson, please accept the attached set of comments from AIPLA related to the Interim Examination Instructions for Evaluating Patent Subject Matter Eligibility.

Receipt of these comments would be greatly appreciated.

Regards,

Vince Garlock

VINCENT E. GARLOCK
Deputy Executive Director

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September 28, 2009

The Honorable David J. Kappos
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office
Mail Stop Comments - Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Comments on Interim Examination Instructions for Evaluating Patent Subject Matter Eligibility
74 Federal Register 47780 (September 17, 2009)

Dear Under Secretary Kappos:

The American Intellectual Property Law Association (AIPLA) appreciates the opportunity to offer comments in response to the Notice of the U.S. Patent and Trademark Office (USPTO) regarding Interim Examination Instructions for Evaluating Patent Subject Matter Eligibility.

AIPLA is a national bar association whose more than 16,000 members are primarily lawyers in private and corporate practice, in government service, and in the academic community. AIPLA represents a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, copyright, and unfair competition law, as well as other fields of law affecting intellectual property. Our members represent both owners and users of intellectual property.

AIPLA supports the efforts of the USPTO to issue guidance to its more than 6000 patent examiners in areas of the law and practice that are in a state of flux. We appreciate the opportunity to consider and provide comments on that guidance, even after it is issued. Although one month to provide comments was probably adequate to obtain comments from those who are closely following the issues addressed in this Notice, the USPTO should consider additional time for

public comment, particularly where the interim instructions have apparently been issued to patent examiners and the training process has already begun.

Overall, the USPTO has done a very good job of providing instructions for evaluating subject matter eligibility under 35 U.S.C. § 101. Comments we received on the Interim Examination Instructions were principally directed to a desire for greater clarity and more information as opposed to any perceived conflicts or contradictions that were readily apparent. We have identified below some of the areas where additional guidance or elaboration would be useful.

According to the Notice, the interim instructions have been issued pending a final decision from the Supreme Court in *Bilski v. Kappos*. It has been observed that the instructions cover matters beyond the method claims at issue in *Bilski*, and it is not clear what mechanism is contemplated by the USPTO for updating or revising those instructions after the decision, or whether the public will have an opportunity to provide comments in that process. It might be useful to indicate that comments/suggestions received by the USPTO within a certain period of time after the decision are likely to receive consideration in that process.

A list of seven "non-limiting examples of claims" directed to non-statutory subject matter is provided on page 2 of the interim instructions. While some of these, such as "transitory forms of signal transmission" are both exemplified and derive from readily recognizable cases, others (e.g., game defined as a set of rules and computer program per se) are not so clear. It also should be pointed out that a naturally occurring organism may be eligible for patentability in appropriate circumstances when claimed in isolated form. The addition of a definition, examples, and/or relevant case law would provide additional useful guidance.

The interim instructions at page 2 indicate that the "claimed subject matter must <u>not</u> be wholly directed to a judicially recognized exception." How does the USPTO determine whether a

claim is "wholly" directed to an exception? Must the claim be limited to that exception? It was suggested that this term may lead to ambiguity, particularly in technologies such as computers and software. A definition of "wholly" and/or examples would provide useful assistance.

Section II A of the interim instructions discusses the recitation of a "particular practical application" as an indicia of patent eligibility. One member observed that while the Supreme Court wrote in *Diamond v. Diehr*, 450 US 175, 187 (1981) that, "[i]t is now commonplace that an application of a law of nature or mathematical formula to a known structure or process may well be deserving of patent protection," it did not state that a specific application is a requirement for patent eligibility. It was suggested that one example of an apparatus not limited to a specific application is an OR-gate (electronic logic), which has many applications. It was argued that patentability of a claim drawn to such a device should not be denied simply because the claim is not limited to a specific "practical application." But if a claim is limited to a specific practical application, it should qualify as patentable subject matter.

In the guidance provided on pages 5 and 6 of the interim instructions, two issues were identified as needing further clarification by way of definition and/or examples. First, the interim instructions appear to make a distinction (paragraph bridging pages 5 and 6) between the transformation of data vs. the transformation of electronic data when the latter has changed such that it has a different function or use. This distinction is not clear. Second, the interim instructions define (page 6) insignificant extra-solution activity to mean a step or function not "central" to the purpose of the claimed method. While slides 15 and 16 address centrality, they do not provide criteria for making such a determination.

Finally, although the interim instructions indicate (page 1) that they supersede previous guidance that conflicts with previous guidance on subject matter eligibility, they do not identify

what has been superseded. It would be helpful to both examiners and the public that at least some of the more significant changes be identified, rather than leaving that determination and interpretation to the individual reader.

We appreciate the opportunity to provide these comments in response to the Notice, and would be pleased to answer any questions our comments may raise.

Sincerely,

Q. Todd Dickinson
Executive Director
AIPLA