

From: Brad Pedersen
Sent: Monday, November 07, 2011 5:37 PM
To: ai_a_implementation
Subject: Transitional program for covered business method patents

Patterson Thuent e Suggesti ons for Group 2 Rulemaki ngs:
Subgroup 8 – Busi ness Method Revi ew (BMR) Speci fi c Rules; and
Subgroup 9 – Defi ni ti on of Technol ogi cal Inventi on Rules

The law firm of Patterson Thuent e Christensen Pedersen (“Patterson Thuent e”) appreciates the opportunity to provide input with respect to the Request by Janet Gongola for Public Comments Urged for Group 2 Proposed Rule Maki ngs, dated October 28, 2011 on the USPTO America Invents Act (AIA) website. The suggesti ons contained in this email are submitted with respect to Group 2 Rulemaki ngs – Subgroup 8 –Busi ness Method Revi ew (BMR) Speci fi c Rules, and Subgroup 9 –Defi ni ti on of Technol ogi cal Inventi on Rules.

Patterson Thuent e is a firm with significant experience in the areas of ex parte reexami nation, inter partes reexami nation and interference practice. The firm is also nationally recognized for its expertise with respect to the AIA. Patterson Thuent e represents a wide and diverse spectrum of individuals, companies, and institutions before the United States Patent and Trademark Offi ce.

The comments submitted herewith reflect the general views of Patterson Thuent e and do not necessarily reflect the view of opinions of any individual members of the firm, or any of their clients. Patterson Thuent e understands that the USPTO will not directly respond to these suggesti ons, and Patterson Thuent e reserves the right to formulate speci fi c comments pursuant to formal rule promulgati on with respect to the Group 2 Rulemaki ngs.

With respect to Subgroup 8 – BMR Speci fi c Rules, Patterson Thuent e has the following suggesti ons:

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 – Defi ni ti on of Technol ogi cal Inventi on Rules, Patterson Thuent e has the following suggesti ons:

9.1 Defi ni ti on of Technol ogi cal Innovati on

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*.

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