

Cain, Brigit

From: Jay Hann <jhann@hannip.com>
Sent: Monday, February 27, 2012 3:03 PM
To: TPCBMP_Definition
Subject: Comment: strike "using a technical solution"

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Dear USPTO,

I attended the USPTO roadshow on February 24, 2012, at the Sunnyvale public library. I would like to thank the USPTO for coming out to California and providing the opportunity for public comment. This comment is in regards to the Transitional Program for Covered Business Method Patents-Definition of Technological Invention.

My proposed change to the definition is to strike "using a technical solution" from the end of the section 42.301 definition.

First, it would seem that if an invention somehow manages to solve a technical problem with what could be deemed to be a non-technical solution then it would be one of the most innovative kind of intention. It appears that the effect of this additional condition "using a technical solution" is only effective when applied to the most innovative inventions. This result on its face appears undesirable.

Second, if the extra condition "using a technical solution" is kept a part of the existing definition it is somewhat at odds with the consideration of "unobvious over the prior art." To demonstrate that the invention uses a technical solution a practitioner would likely be arguing that the invention is a common application of science or engineering; however, common or routine applications of science or engineering could reasonably be determined to be obvious.

KSR states "The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." KSR Intern. Co. v. Teleflex Inc., 127 S. Ct. 1727, 1739 (2007). Thus a practitioner arguing that the invention uses a technical solution is very nearly arguing that the invention uses familiar elements of science and engineering according to known methods. The best way to eliminate this conflict with obviousness is to strike "using a technical solution" from the definition.

With my proposed change section 42.301(b) would read:

Technological invention. In determining whether a patent is for a technological invention solely for purposes of the Transitional Program for Covered Business Methods (section 42.301(a)), the following will be considered on a case-by-case basis: whether the claimed subject matter as a whole recites a technological feature that is novel and unobvious over the prior art; and solves a technical problem.

Thank you for considering my suggestion.

Sincerely,
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