



PATENT PROTECTION FOR HIGH TECHNOLOGY

TO: The Honorable David J. Kappos, Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office
FROM: Schwegman, Lundberg and Woessner, P.A.
DATE: April 10, 2012
RE: Comments to Various Proposed Rules to Implement the America Invents Act

Via Electronic Mail

TPCBMP_Definition@uspto.gov

Dear Under Secretary Kappos:

Below are our comments on the transitional program for covered business method patents—definition of technological invention in Fed. Reg. 77(28): 7095–108 (February 10, 2012).

Rule 42.301(b) gives a broad interpretation of what is covered by the covered business method patent program. The practice guide for proposed trial rules (Fed. Reg. 77(27) 6873, col. 1) discusses examples of what constitutes technological inventions. The Office should better consolidate analysis of rules or provide the same examples in different notices to collect all relevant information in one place. In the case of the practice guide, the analysis conflates the law of obviousness with statutory subject matter. For example, the analysis discusses “known technologies.” A computer programmed to perform a particular function is not a known technology. Portions of the computer might be known, but not the particular configuration of the computer. Irrespective, discussion of obviousness should not play a part in a discussion of whether a claim recites statutory subject matter.

Very truly yours,

Schwegman, Lundberg and Woessner, P.A.

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