

From: Ray Meiers [e-mail redacted]
Sent: Monday, September 27, 2010 4:05 PM
To: Bilski_Guidance
Subject: Comments to Interim Guidance re 101 in view of Bilski

Dear Madam/Sir:

The proposed interim guidelines are commended. The Office is thanked for the opportunity to provide these comments.

A. Consideration of “extrasolution activity”; Interim Guidance at Sections (IV)(A)(3), (B)(5), (C)(3)

It is suggested that the importance of “extrasolution activity” analysis is to prevent the allowance of a claim vesting ownership of a single law of nature to a patent applicant. It is also suggested that the analysis of extrasolution activity should be defined more objectively in the final guidelines. For example, the term “extrasolution” suggests that the examiner should be required to identify the “solution” offered by a claimed invention. In so doing, the examiner will necessarily identify a “problem” addressed by the claimed invention. However, many inventions solve more than one problem. Embodiments of the same invention might solve different problems. Extrasolution activity analysis could be an area ripe for gamesmanship on the part of practitioners and capriciousness on the part of examiners.

It is respectfully submitted that emphasis in the final guidelines can be based on more objective criteria. Extrasolution activity analysis was first suggested in *Parker v. Flook*, 437 U.S. 584 (1978), a case in which an applicant included the alleged useful result as a claim element. The claim at issue in *Parker* recited a single law of a nature (a short algorithm) and a useful result (updating an alarm limit).

It is suggested that, where conformance with §101 is not clear, one tool an examiner can apply is to confirm that the useful result alleged for the embodiment of the claimed invention is not itself recited in the claim. If the alleged useful result is set forth in the claim, the examiner can then assess whether the claim recites nothing more than a single law of nature. It is not asserted that reciting the useful result in the claim necessarily renders the claim improper under §101. Claims that would pass the machine-or-transformation test could recite the useful result in addition to other elements. However, *Parker* demonstrates that abstract ideas may be detectable when the claim recites the alleged useful result and very little else.

B. Consideration of preemption in other fields, generality; Interim Guidance at Sections (IV)(A)(1), (B)(1), (C)(1), and (D)(1), (2), (3)

It is respectfully submitted that these portions of Interim Guidance would result in undue hostility toward pioneer inventions. Arguably, pioneer inventions are most worthy of patents. These portions of the interim guidelines are also highly subjective. It is unclear how an examiner working in one art unit would have sufficient expertise to assess the impact of a claimed invention in other technological arts. It is suggested that the final guidelines not encourage patent examiners to contemplate how a claimed invention might be applicable in more than one technological area; the claim should simply be assessed under § 101 with

extrasolution analysis and in view of whether the claimed invention will in fact produce the alleged useful result.

C. General Comments

It is submitted that the focus of the final guidelines should be to help patent examiners identify claims that are directed to a single law of nature and to claims that fail to achieve usefulness. These two types of claims are concrete examples of abstract ideas. As set forth above, extrasolution activity analysis can be applied to expose claims directed to a single law of nature.

Several objective standards can be applied to reveal claims that fail to achieve usefulness, without raising hostility against pioneer inventions. It is first noted that written words, like a patent claim, are by nature abstract. Therefore, focusing exclusively on the claim language to determine if the claim is directed to an abstract idea is problematic. Under § 101, the claim language must be considered within the context that is defined by the result achieved in practicing the claim language; the result must be “useful.” The claim language and the result, together, are to be assessed. If a claim recites steps that won’t necessarily bring about the alleged useful result, it is an abstract idea. In preparing the patent application, the Applicant controls the claim language considered during examination and also selects how at least one useful result achieved by the claim language is identified.

Claims can fail to recite something that won’t necessarily work in several different ways. First, the useful result might be defined subjectively. A method for producing a “better” screenplay is an abstract idea because there is not an objective standard for assessing the quality of screenplays. The interim guidelines properly recite this test. Second, the alleged useful result will in fact not be achieved by practicing the claim steps. This occurred in *Mackay Radio & Telegraph Co. v. Radio Corp. of America*, 306 U.S. 86 (1939), where a claimed antenna would not achieve the alleged useful result of “the best directional radio propagation by the V type antenna.” *Id.* at 101. Third, achievement of the useful result is not certain. Generally, this arises because a claim is not based on laws of nature (which always work). *Bilski’s* claim suffers this problem. The useful result alleged by *Bilski* was profit – an objectively measurable attribute. However, *Bilski’s* claim requires that the party practicing the claim make purchases and sales that balance one another. A party practicing *Bilski’s* claim is subject to ever-changing market conditions; there can be no guarantee that purchases and sales balancing one another could be made. If market conditions align in favor of the practicing party, the claim achieves a useful result. If not, the practicing party will not enjoy the useful result. § 101 requires repeatable, consistent usefulness.

The focus on usefulness renders the analysis consistent with the language of § 101 and also promotes a reasonably objective process for examiners and applicants to resolve § 101 issues. For example, the examiner can raise a basis for alleging a claimed method won’t work. In a procedural sense, this allegation can be substantially similar to a basis for combining references under § 103. If possible, the applicant can refute the examiner’s allegation by showing why the claimed method will in fact, always, achieve the useful result alleged.

D. Responses to the Three Questions Posed:

i. Response to Question 1: The following claim fails the machine-or-transformation test but does not recite an abstract idea.

The invention is related to improving foot speed. Foot speed is an objectively measurable quality. The likelihood of employment as a professional athlete would be increased by improved foot speed; therefore the invention has economic merit. It is assumed that the claimed method has been the subject of a clinical study and the efficacy of the method can be verified. The claim recites several steps carried out by the human body, not a machine. No part of the body would be transformed in a perceivable sense. For the purposes of this exercise, it must be assumed that the claim defines over the prior art.

1. A method for improving foot speed comprising the steps of:
jumping rope for thirty minutes per day for three weeks; and
jumping from a first surface to a second surface twenty times every day for three weeks wherein the second surface is elevated four inches from the first surface, wherein said jumping rope step and said jumping from the first surface to the second surface are completed within one hour of each other.

It is noted that “exercise” claims have been allowed in the past. See U.S. Pat. No. 6656096. However, ironically, claim 1 of U.S. Pat. No. 6656096 would appear to be an abstract idea since it is unclear how the strengthening of “coordination between a person's hand muscles and muscles of the lower part of a person's body” could be objectively verified. The '096 patent does not set forth a scale or test of such coordination.

ii. Response to Question 2: The following claim meets the machine-or-transformation test but recites an abstract idea.

1. An electromagnetic generator comprising:
a permanent magnet having magnetic poles at opposite ends;
a magnetic core including first and second magnetic paths between said opposite ends of said permanent magnet, wherein
said magnetic core comprises a closed loop,
said permanent magnet extends within said closed loop, and
said opposite ends of said permanent magnet are disposed adjacent opposite sides of said closed loop and against internal surfaces of said magnetic core comprising said closed loop;
a first input coil extending around a portion of said first magnetic path,
a second input coil extending around a portion of said second magnetic path,
a first output coil extending around a portion of said first magnetic path for providing a first electrical output;
a second output coil extending around a portion of said second magnetic path for providing a second electrical output; and
a switching circuit driving electrical current alternately through said first and second input coils, wherein
said electrical current driven through said first input coil causes said first input coil to produce a magnetic field opposing a concentration of magnetic flux from said permanent magnet within said first magnetic path, and

said electrical current driven through said second input coil causes said second input coil to produce a magnetic field opposing a concentration of magnetic flux from said permanent magnet within said second magnetic path.

Comment: The claim above is claim 1 of U.S. Pat. No. 6362718. The useful result alleged (implicitly) by the '718 patent is a perpetual motion machine. Such a result is impossible to achieve and therefore the claim recites an abstract idea.

iii. Response to Question 3: Unpatentable Categories.

It is suggested that this inquiry is counter-productive. The issue that needs to be resolved is developing a legal definition of "abstract idea." Unfortunately, the Bilski decision did nothing to further this effort. As such a definition is developed, abstract ideas will be more easily identified, regardless of field of endeavor.

The Office is again thanked for the opportunity to submit these comments.

Very Truly Yours,

Ray Meiers
Meiers Law Office
7245 Sawmill Run
Holland, Ohio 43528

419.740.2566 Office
248.790.9377 Cell

www.ipatt.com