

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re:  
RIN 0651-AC75

For: **Notice of Proposed Rulemaking:  
Changes to Implement Transitional  
Program for Covered Business  
Method Patents—Definition of  
Technological Invention**

**77 Fed. Reg. 7095  
(February 10, 2012)**

**Comments In Reply To the Notice of Proposed Rulemaking Entitled  
"Changes to Implement Transitional Program for Covered Business Method  
Patents—Definition of Technological Invention"**

Via Internet to: [TPCBMP\\_Definition@uspto.gov](mailto:TPCBMP_Definition@uspto.gov)

Mail Stop Patent Board  
Director of the United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

Due: April 10, 2012

Attention: Lead Judge Michael Tierney, Covered Business Method Patent Review Proposed  
Definition for Technological Invention

Dear Judge Tierney:

In reply to the Notice of Proposed Rulemaking published February 10, 2012, at 77  
Fed. Reg. 7095, we submit the following comments on proposed rule 37 C.F.R. § 42.301:

**37 C.F.R. § 42.301(b)**

Proposed rule § 42.301(b) indicates that the "[i]n determining whether a patent is for  
a technological invention...the following will be considered on a case-by-case basis:  
whether the claimed subject matter as a whole" meets certain requirements. What is unclear,  
however, is whether the determination will be made based on the patent and subject matter  
as a whole, or whether the determination will address each claim individually.

Trying to fit the majority of patents neatly into the classification analysis proposed by the PTO is expected to be difficult. Patents typically include a number of claims covering different embodiments of the same invention. Some claims may cover embodiments that are clearly "technological inventions," while other claims may cover embodiments of the invention that are likely not "technological inventions."

Taking a data processing patent as an example, assume for the purposes of argument that half of the patent's claims are of a narrow scope that would qualify as a "technological invention," while half of the patent's claims are not. How will the PTO determine grounds for standing in this scenario?

If the PTO decides whether the patent as a whole is directed to a technological invention, the result will be unfair to one of the parties. On one hand, it would be unfair to prevent a petitioner from pursuing the non-technological claims in a CBM when the patent also is directed to other, more "technological" embodiments. On the other hand, it would be unfair to a patent owner to pull claims that are clearly directed to a technological invention into a CBM proceeding, simply because another set of claims in the same patent do not meet that standard.

There are further complications when one considers that a set of claims to a technological invention could be pulled into a CBM proceeding in combination with other claims, while an identical set of claims to a technological invention could not be pulled into a CBM proceeding if separated into their own patent. These identical claims would be subject to different levels of scrutiny simply based on other claims that may appear in the same patent. Unequal, unpredictable treatment of identical claims based on their presentation cannot be the result that Congress intended.

Instead, a more equitable approach may be for the PTO to conduct its eligibility analysis on a claim-by-claim basis, and indicate in § 42.301(b) that the proposed test will be used to determine whether a claim is for a technological invention (instead of determining whether a patent is for a technological invention). With this change, claims that do not meet the technological invention exemption can be identified as such and addressed, while claims meeting the exception remain protected from an unwarranted CBM proceeding.

This would also allow the PTO to proceed with a CBM proceeding on just those claims in a patent which meet the CBM eligibility requirements, rather than putting ineligible claims into review or dropping eligible claims from review based on the patent as a whole. This claim-by-claim approach would also meet Congress's intent of providing a substantive review process for non-technological business method claims meeting all the qualifications, while providing petitioners and patent owners with some certainty as to whether their claims are susceptible to a CBM challenge.

**Conclusion**

Consideration of the above comments is respectfully requested.

Respectfully submitted,

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