PUBLIC SUBMISSION

As of: 7/15/15 9:44 AM
Received: January 23, 2015
Status: Posted
Posted: July 06, 2015
Tracking No. 1jz-8gsl-m9ee
Comments Due: March 16, 2015
Submission Type: API

Docket: PTO-P-2014-0058
2014 Interim Guidance on Patent Subject Matter Eligibility

Comment On: PTO-P-2014-0058-0001
2014 Interim Guidance on Patent Subject Matter Eligibility

Document: PTO-P-2014-0058-0005
Comment on FR Doc # 2014-29414

Submitter Information

Name: Canek Acosta
Address:
1345 16th Ave
Apt 6
San Francisco, CA, 94122
Email: canek43@yahoo.com
Phone: 408-718-0667

General Comment

As the representative case for Post-Alice patent eligibility in the Federal Circuit, it is my personal view, as a patent attorney working largely with software clients, that the description of the holding in DDR Holdings v. Hotels.com is inadequate guidance. While the Court did hold that the claims were more than just "using the Internet," I believe the following quote to more pertinently address what made those claims patent eligible:

"But these claims stand apart because they do not merely recite the performance of some business practice known from the pre-Internet world along with the requirement to perform it on the Internet. Instead, the claimed solution is necessarily rooted in computer technology in order to overcome a problem specifically arising in the realm of computer networks."

That is, old business practice + generic use of internet is non-eligible, while specific use of internet to overcome a particular internet problem is eligible. However, the opinion goes further:

"Unlike the claims in Ultramercial, the claims at issue here specify how interactions with the

Internet are manipulated to yield a desired resultâ€”a result that overrides the routine and conventional sequence of events ordinarily triggered by the click of a hyperlink. Instead of the computer network operating in its normal, expected manner by sending the website visitor to the third-party website that appears to be connected with the clicked advertisement, the claimed system generates and directs the visitor to the above described hybrid web page that presents product information from the third-party and visual â€œlook and feelâ€ elements from the host website. When the limitations of the â€™399 patentâ€™s asserted claims are taken together as an ordered combination, the claims recite an invention that is not merely the routine or conventional use of the Internet."

In other words, patent eligibility in the internet arena can be accomplished through non-routine and unconventional use of the Internet, albeit being "use of the Internet." The requirement for the problem solved by the invention to be internet-related is dicta unnecessary to the holding. They key to eligibility is being rooted in computer technology, rather than merely incidental use of computer technology.

As such, I propose that this language of the guidance:

The court held that, unlike in Ultramercial, the claim does not generically recite â€œuse the Internetâ€ to perform a business practice, but instead recites a specific way to automate the creation of a composite Web page by an outsource provider that incorporates elements from multiple sources in order to solve a problem faced by Web sites on the Internet. Therefore, the court held that the claim is patent eligible.

Be changed to:

The court held that, unlike in Ultramercial, the claim does not generically recite â€œuse the Internetâ€ to perform a business practice, but instead recites a specific way to automate the creation of a composite Web page by an outsource provider that incorporates elements from multiple sources, thereby amounting to more than routine or conventional use of the Internet. Therefore, the court held that the claim is patent eligible.

Attachments

13-1505.Opinion.12-3-2014.1