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Hon. Michelle K. Lee
Under Secretary of Commerce
United States Patent and Trademark Office
Arlington, Virginia
via email c/o: 2014_interim_guidance@uspto.gov

Re: **PTO Patent-Eligibility Examination Guidelines**

Dear Madam Under Secretary:

This letter is a personal request and suggestion that you intervene in Office policy-making relating to patent-eligibility to simplify matters for both your examiners and the public. A four point summary is attached, *Vision of Patent-Eligibility "Trees", not the Case Law "Forest"*. If you are able to straighten out the current patent eligibility situation, your tenure as head of the Patent Office will have been a success.

This input is *pro bono* and does not necessarily reflect the views of any other person or organization, including The Naples Roundtable™, where this issue will be considered at a conference on February 15, 2016, as part of the"Phoenix Issues", https://www.thenaplesroundtable.org/issues-and-papers/phoenix-issues-2/

Respectfully submitted,

Hal Wegner

Harold C. Wegner

VISION OF PATENT-ELIGIBILITY "TREES", NOT THE "FOREST"*

Harold C. Wegner

An Examiner should properly follow a four step process for patent-eligibility determinations in the wake of *Mayo/Alice* precedents:

(1) If the claimed subject matter is to a "new and useful process, * * * manufacture, or composition of matter" as defined in Section 101, is any *element* of the claim either a "law of nature," "natural phenomenon," or "abstract idea"? If "yes", go to step (2).

(2) *If "yes"*, is the claim to a *combination* of steps or elements so that the claimed invention is *different from* the "law of nature," "natural phenomenon," or "abstract idea"? If "yes", go to step (3). (If the answer is ambiguous (or negative) as to whether the claim includes the mere element, *alone*, then the claim should be rejected under Section 101, leaving it to the applicant to respond by amendment or by an estoppel-provoking argument that the claim *is* limited to the combination.)

(3) *If "yes"*, does the *combination* yield an "inventive step", which should be based upon a prior art search for nonobviousness under 35 USC § 103 of the *Leahy Smith America Invents Act.*

(4) *If "yes"*, the invention is both patent-eligible under Section 101 and nonobvious under Section 103. If "no" is the answer to point (3), the Examiner should now reject the claimed invention as obvious under Section 103. (It makes no sense for the Examiner to reject based upon patent-eligibility under Section 101 because the point is now moot.)

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*This paper is in part responsive to the *Examination Guidance and Training Materials*, available at http://www.uspto.gov/patent/laws-and-regulations/examination-policy/examination-guidance-and-training-materials, and more particularly to the *July 2015 Update: Subject Matter Eligibility* (July 2015). *id.* The examination proposal, here, is an outgrowth of this writer's paper, SEQUENOM PATENT ELIGIBILITY CHALLENGE, § 10[a], *A Five Step Proposal for Patent Eligibility Examination*, which is background material for "Phoenix Issue I" for The Naples Roundtable™ patent experts conference, Naples, Florida, February 15, 2016, as explained at https://www.thenaplesroundtable.org/. This paper may be cited as Wegner, Harold C., *The Sequenom Patent Eligibility Challenge*, The Naples Roundtable (Jan. 4, 2016), available at https://www.thenaplesroundtable.org/papers-2/.