From: Stuart Meyer
Sent: Friday, August 17, 2018 11:10 AM
To: Eligibility2018
Cc: Stuart Meyer
Subject: Individual Comments of Stuart Meyer on Berkheimer Issues

To Whom It May Concern:

I appreciate the PTO's efforts to take into account how the Federal Circuit's recent ruling in the *Berkheimer* case affects examination procedure, as well as the opportunity to comment. This is an area rife with uncertainty, and any efforts that the PTO might take to improve predictability of outcomes will be welcome.

I write as a patent practitioner who, along with my colleagues at Fenwick & West, has maintained an ongoing discussion of related Section 101 issues at www.bilskiblog.com. Some of those discussions relate directly to the issues on which you've requested comments.

In its April 2018 memo, the PTO acknowledged the importance of the *Berkheimer* case, noting that while the decision "does not change the basic subject matter eligibility framework as set forth in MPEP § 2106, it does provide clarification as to the inquiry into whether an additional element (or combination of additional elements) represents well-understood, routine, conventional activity."

The Federal Circuit has on numerous occasions addressed *Mayo's* "well-understood, routine, conventional" test. One would think we'd have a good understanding of it by now. But is that the case?

I'd like to suggest that much more clarity is needed. Specifically, in order to determine how the test is going to be applied, we need to know what is meant by the terms "well-understood," "routine," and "conventional."

From my reading, the Federal Circuit cases don't seem to differentiate among these terms. The cases also generally connect the three terms with "and" rather than "or," but curiously most of the cases don't seem to actually require all three to be explicitly met for a determination of ineligibility. *See, e.g., Content Extraction*, where the Federal Circuit focused on the patent owner's concession that one function was "routine."

Similarly, the MPEP has an entire section (2106(05)(d)) devoted to "well-understood, routine, conventional" without attempting to define these terms or differentiate among them.

The validity of thousands of patents could well be determined by exactly what those three terms mean, so the task should not be ignored or taken lightly. At a minimum, we need to understand the terms conventional, routine and well-understood—as well as whether they should be joined by "and" or "or."

I've included a link to an article where I have expanded on this theme: "How Well-Understood is the Meaning of 'Well-Understood'?" hosted at http://www.bilskiblog.com/blog/2018/04/how-well-understood-is-the-meaning-of-well-understood.html.

While that post focused on definitions for the terms "well-understood," "routine," and "conventional" (W-URC for short) from the subject matter eligibility test set forth in *Mayo* and further described in *Alice*, those terms relate to one part of the current test only. There is another important term in the test, one that's considered before even reaching the W-URC issue: whether the claim is "directed to" patent-ineligible subject matter, e.g., a law of nature.

Neither the U.S. Supreme Court nor the Federal Circuit have really addressed whether "directed to" should be thought of as involving multiple targets or a single target. The subtle differences in how one thinks about the phrase "directed to" can be outcome-determinative, and as with W-URC, we've not been provided with sufficient guidance as to how that phrase should be interpreted. The conclusion is the same: Such uncertainly allows result-oriented opinions that cannot readily lead to any meaningful settling of this fundamental issue.

Please find my thinking laid out in a second post, "Our Attention is Now Directed to: "Directed To" hosted at http://www.bilskiblog.com/blog/2018/04/our-attention-is-now-directed-to-directed-to.html.

We should demand clarification from either the courts or Congress, since the viability of so many patents depends on what these phrases are understood to mean. That said, the PTO too must interpret these phrases; being explicit about how it does so (even if Congress or the courts ultimately disagree) will be a big step forward in settling the law regarding patentable subject matter.

Judge Plager's dissent-in-part in *Interval Licensing* in July emphasizes the "near impossible" task of reliably predicting patent eligibility. Though the PTO is guided by Federal Circuit precedent, how it applies this "incoherent body of doctrine" (in Judge Plager's words) has lasting effects on what applications enter the pipeline and mature into patents, as well as broader issues of cost and confidence in the entire patent process. Any proactive measures the PTO can take to improve predictability of eligibility outcomes will be a great service not only to the inventors the PTO serves, but to the greater public as well.

Thank you for your consideration,

Stuart Meyer

STUART MEYER
Partner | Fenwick & West LLP | 650-335-7286 |
Admitted to practice only in California, Vermont and Washington, DC.