Patterson Thuente Suggestions for Group 2 Rulemakings:
Subgroup 8 – Business Method Review (BMR) Specific Rules; and
Subgroup 9 – Definition of Technological Invention Rules

The law firm of Patterson Thuente Christensen Pedersen ("Patterson Thuente") appreciates the opportunity to provide input with respect to the Request by Janet Gongola for Public Comments Urged for Group 2 Proposed Rule Makings, dated October 28, 2011 on the USPTO America Invents Act (AIA) website. The suggestions contained in this email are submitted with respect to Group 2 Rulemakings - Subgroup 8 - Business Method Review (BMR) Specific Rules, and Subgroup 9 - Definition of Technological Invention Rules.

Patterson Thuente is a firm with significant experience in the areas of ex parte reexamination, inter partes reexamination and interference practice. The firm is also nationally recognized for its expertise with respect to the AIA. Patterson Thuente represents a wide and diverse spectrum of individuals, companies, and institutions before the United States Patent and Trademark Office.

The comments submitted herewith reflect the general views of Patterson Thuente and do not necessarily reflect the view of opinions of any individual members of the firm, or any of their clients. Patterson Thuente understands that the USPTO will not directly respond to these suggestions, and Patterson Thuente reserves the right to formulate specific comments pursuant to formal rule promulgation with respect to the Group 2 Rulemakings.

With respect to Subgroup 8 - BMR Specific Rules, Patterson Thuente has the following suggestions:

8.1 Prior Art Validity Challenges in a BMR
We suggest that once the threshold for initiating a BMR has been met, the petitioner should be able to raise any validity challenged permitted under a PGR.

8.2 Interpreting Financial/Business Limit in a BMR
We suggest that the Office establish rules that in order to serve as the basis for initiating a BMR, a claim must: (a) include only a nominal recitation of a data processing system, calculating computer or other system for performing the data processing or other operations, and the machine or manufacture limitations must not be central to the claimed invention; (b) include only nominal claim recitation of any other environment; and (c) predominantly cover the practice, administration, or management of a financial product or service.

With respect to Subgroup 9 - Definition of Technological Invention Rules, Patterson Thuente has the following suggestions:

9.1 Definition of Technological Innovation
We suggest that the Office should promulgate separate rules that define the term "technological innovation" in a manner consistent with the latest Federal Circuit guidance interpreting the Supreme Court's decision in Bilski.

Brad Pedersen
Patent Practice Chair

PATTERSON THUENTE CHRISTENSEN PEDERSEN, P.A.
4800 IDS Center, 80 South 8th Street
Minneapolis, MN 55402-2100