

From: Kurt Mueller [EMAIL ADDRESS REDACTED]
Sent: Thursday, July 24, 2014 9:41 PM
To: alice_2014
Subject: draft guidance - comment

To Whom it May Concern:

I am a registered patent attorney and a USPTO patent examiner, however I offer the following comments purely in my personal capacity as a member of the public, and nothing should be interpreted as necessarily reflecting the views of any other person or entity.

Though the Supreme Court in *Alice Corp. v. CLS Bank* had the opportunity to rule all computer based or business method based inventions as automatically ineligible for a patent, the Supreme Court explicitly declined to render such a categorical ruling. It is clear that many, if not most, computer based or business method based inventions remain patent eligible. The USPTO must, in order to implement the wishes of Congress as interpreted by the Supreme Court, render such guidance as will keep the widest range of inventions possible patent eligible.

Thus, I propose that the USPTO adopt a per se obviousness test. The USPTO should hold that an invention is per se obvious if 1) the claimed invention without consideration of the technology platform the invention is implemented in is otherwise anticipated or rendered obvious, then 2) the mere implementation of the otherwise anticipated or obvious invention in a new technology platform is automatically per se obvious. If the invention is found to be per se obvious, then the invention automatically lacks patentability under 35 USC 101.

For example, consider an auction system implemented in a computer. If the patent examiner concludes that the auction system described in the claims was known or obvious in the art before the computer, then the patent examiner should conclude that the mere implementation of the known or obvious auction system in a computer is per se insufficient to make the invention patent eligible. The examiner should thus write a rejection providing the appropriate 103 rejection without consideration of the technology platform, and give a parallel 101 rejection that because the invention was obvious without consideration of the technology platform, that the mere implementation of the invention in a new technology platform is per se obvious, and that the invention is therefore ineligible for a patent.

In other words, if the only "improvement" to a known or obvious invention is implementation in a new technology platform, or if the only "improvements" are those that inherently or necessarily flow from the new technology platform, then the resulting invention is per se obvious and is patent ineligible 35 USC 101. As a result, merely tacking a technology platform into the claim language cannot alone transform otherwise known or obvious art into patent eligible art under 35 USC 101.

This standard is technologically neutral. Thus, if new technological platforms come into being, all that is old and known does not suddenly become new again because the old and known inventions can now be implemented in a new platform that was previously unknown. By way of

analogy to copyright law, this standard would be similar to a standard that would hold that a particular recording that was originally contained on vinyl does not become a new recording merely by being transferred to tape, cd, mp3, or any other technology platform now known or known in the future. The platform should not change the nature of the recording in copyright law, and the platform should not change the nature of the invention in patent law.

This naturally raises the scenario where the examiner concludes that a proposed invention has elements to it that do not inherently or necessarily flow from the technology platform itself. In such circumstances, the examiner should still conclude that those elements that do flow inherently or necessarily from the technology platform itself are per se obvious, and the examiner should then with respect to any remaining elements conduct a standard obviousness analysis under *Graham v. John Deere Co* and its progeny. Because the examiner has concluded that the remaining features do not inherently flow from the technological platform, the examiner should conclude that the resulting invention satisfies the requirements under 35 USC 101 as far as Alice is concerned (though a rejection under 35 USC 103 could still be potentially proper, and a 101 rejection could still be proper if it would have been proper pre-Alice).

Such a per se obviousness rejection under 35 USC 101 satisfies several goals. It honors the clear wishes of Congress as interpreted by the US Supreme Court to keep computer based and business method based inventions as a general category patent eligible, provides clear guidance to examiners who already understand how to perform obviousness analysis, provides clear guidance to the patent bar who will understand that to make an invention patent eligible under Alice they must explicitly claim elements that do not inherently or necessarily flow from the technological platform the invention is implemented in, and the standard is technologically neutral so that the creation of a new platform does not lead to a false "gold rush" to claim all previously known inventions in the new platform.

Sincerely,

Kurt Mueller