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Sent: Thursday, August 05, 2010 8:17 AM
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Subject: Comments on Interim Bilski guidance

08/05/2010

To,
Commissioner for Patents
USPTO
PO Box 1450, Alexandria, Va. 22313

Ref: Request for Comments- Notice No.PTO-P-2010-0067
Interim *Bilski* Guidance

Answer to the 3-questions on which USPTO is "particularly interested" in receiving comments can be found in *Bilski* ruling-

"Congress plainly contemplated that the patent laws would be given wide scope…ingenuity should receive a liberal encouragement…The Court's precedents provide three specific exceptions to @101's broad patent-eligibility principles: laws of nature, physical phenomena, and abstract ideas… consistent with the notion that a patentable process must be new and useful…the invention be novel, nonobvious, and fully and particularly described. This Court has more than once cautioned that courts should not read into the patent laws limitations and conditions which the legislature has not expressed. Concerns about attempts to call any form of human activity a process can be met by making sure the claim meets the requirement of @101. Adopting the machine-or-transformation test as the sole test for what constitutes a process (as opposed to just an important and useful clue) violates these statutory interpretative principles. The court of Appeals incorrectly concluded that this Court has endorsed the machine-or-transformation test as the exclusive test. It is true…that a process is an act or a series of acts, performed upon the subject-matter to be transformed and reduced to a different state or thing (and it is) not intended to be an exhaustive or exclusive test (because) transformation and reduction of an article to a different state or thing is the clue to the patentability of a process claim that does not include particular machines… *Diehr* explained that while an abstract idea, law of nature, or mathematical formula could not be patented, an application of a law of nature or mathematical formula to a known structure or process may well be deserving of patent protection."

This ruling clearly prohibits USPTO to set any limitations on the scope with examples of patentability or unpatentability under @ 101, other than "**an abstract idea, law of nature, or mathematical formula could not be patented"**- but**, "an application of a law of nature or mathematical formula to a known structure or process may well be deserving of patent protection"**

Under this ruling the USPTO's *new*-rule set in the Interim Instructions of 2009 that "*Purely mental processes in which thoughts or human based actions changed are not considered an eligible transformation*" [see Sec.II(B) on p.5] is clearly a limitation on the scope of process-patentability under @ 101 and any use or misuse of that rule or policy makes compliance essentially impossible and substantively deprives rights of applicants under APA @553 (c), (d) & (e) and @706(2). Human brain is a physical object and particular thought transforms specific neurons in the brain into a different state; and the neuron is a

substance or matter. For that reason USPTO should amend or repeal that new-rule, because the Notice for comment says-

"*This additional guidance, which builds upon the 2009 Interim Instructions, is a factor-based inquiry…Examiners will recognize that the machine-or-transformation test set forth in Sec. II(B) of the 2009 Interim Instructions, although not the sole test for evaluating the subject matter eligibility of a method claim, is still pertinent in making determinations pursuant to the factors*…." (see on p.43925).

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