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Subject: Comments on Alice Guideline

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Dear Sir or Madam,

Thank you for releasing the 2014 Interim Guidance on Subject Matter Eligibility. In my practice, I constantly work with early-stage companies who attempt to patent their business model embodied as a software (web app or mobile device – (I am co-founder of a well-known and popular center for inventors and entrepreneurs, <https://www.smartuplegal.com>).

Although a large part of my practice does involve the prosecution of software patent applications, my position is aligned, to an extent, with the recent Supreme Court holdings relating to the machine and transformation test, as well as keeping the door open to other tests. It is extremely hard to categorize emerging technology with ‘tests’ – as constant innovation will often exceed the applicable bounds of any such test with time. Rather, it is the thought process and logic that leads to these tests that we must adopt.

In this letter, I would like to emphasize the thought process that I believe is important for the office to adopt in setting the guidelines out for public review. I appreciate the Office’s understanding of the history of pre-internet business methods and how they came to obtain patentable status in many cases. With the advent of the internet and home computing access, many ordinary business methods began taking shape in the virtual world. Online auctions and e-commerce became popular – taking standard methods of doing business and bringing them up-to-date with technology. Many patents were being filed for business methods being performed with the use of software – and many were being approved by the USPTO. I agree with this approval as the USPTO properly characterized these applications as inventive uses of then-existing technology.

With time, however, the technology became common place. It was now becoming ‘obvious’ to use standard computing devices, software, and internet, to perform ordinary business operations that were not before possible. This began to raise questions of the patentability of such software as *subject matter 101* issues. In my opinion, this is rather a 103 obviousness issue. The technology is prior art and the business method is prior art, the issue is not one of subject matter – but the 103 combination of the two.

Thank you for your consideration.

Kindest regards,

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