

## Cain, Brigit

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**From:** John Vandenberg <john.vandenberg@klarquist.com>  
**Sent:** Wednesday, April 04, 2012 12:29 PM  
**To:** TPCBMP\_Rules  
**Subject:** Proposed Rule for the Technological Invention Definition (77 Fed. Reg. 7095, February 10, 2012)

The proposed rule regarding “technological invention” seems likely to cause undue confusion and cost and is not consistent with the legislative history it cites as support.

It deviates both from the legislative history the Office quotes in its support (“those patents whose novelty turns on a technological innovation over the prior art”) and from the Office’s own summary of the proposed rule (“solve technical problems with technical solutions and which are patentable over the prior art based on a technological innovation.” ) Contrary to the quoted legislative history and summary, the proposed rule rejects the point of novelty approach. Right or wrong, that will just confuse the bar, likely causing many petitions to be prepared at great expense only to be rejected by the PTO.

I suggest instead the following proposed rule: “(b) Technological invention. In determining whether a patent is for a technological invention solely for purposes of the Transitional Program for Covered Business Methods (section 42.301(a)), the following will be considered: whether there is a reasonable likelihood that no challenged claim of the patent covers subject matter ineligible for patenting under 35 USC 101 as an abstract idea, law of nature, natural phenomena, mathematical formula or algorithm, or mental process.”

This standard will allow the patent bar to use the continuing development of Section 101 law in the Office and the Courts as a guide, which will lessen uncertainty. Also, the legislative history cited by the Office is consistent with the Supreme Court’s analytical approach to the exclusions to patent eligibility under Section 101. Therefore, this proposed standard is more consistent with the legislative history than is the published proposed rulemaking.

Thank you.

John D. Vandenberg  
Reg. No. 31,312  
Portland, Oregon  
503-226-7391