

From: Tom Brody [e-mail address redacted]
Sent: Wednesday, January 21, 2015 8:55 PM
To: 2014_interim_guidance
Subject: Comment from Tom Brody, Ph.D., Reg. No. 46,433, on subject matter eligibility

Honorable Commissioner,

This is to submit a comment regarding subject matter eligibility.

Obviousness has its own specialized case law, e.g., that relating to motivation to combine (see, (2010) *Obviousness in patents following the U.S. Supreme Court's decision of KSR International Co. v. Teleflex, Inc.* JPTOS. 92:26-70), and that relating to impermissible hindsight (see, (2014) *Rebutting obviousness rejections based on impermissible hindsight.* JPTOS. 96:427-485).

That said, please note that at various points in *Mayo v. Prometheus* (2012), where the narrative concerns subject matter eligibility, the opinion invokes the obviousness inquiry by writing, "purely conventional or obvious pre-solution activity," and by writing, "obvious, already in use, or purely conventional."

Thus, the opinion seems to suggest that the 101 inquiry may involve the obviousness regime, and by extension, that it is appropriate to cite case law on motivation to combine, and on impermissible hindsight, when rebutting 101-rejections.

USPTO should consider commenting on whether subject matter eligibility analysis can involve the case law that is dedicated to obviousness. I suggest that the term "obvious" only be used in opinions where the writer intends to invoke the case law relating to 103. I suggest that if the writer does not intend to invoke 103, and does not intend to invoke the case law of obviousness, then the writer should refrain from using the word, "obvious."

According to the *Prometheus* opinion, the U.S. Supreme Court indicates that it is acceptable to allow the case law on obviousness to creep into subject matter eligibility analysis. My own opinion, is that U.S. Supreme Court made a careless error by using the term "obvious" as part of its comments on subject matter eligibility.

Best regards, *Tom Brody*

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P.S. To date, I have published eleven 60-page articles on patent law, several of these appearing in JPTOS.