

From: Adam Citrin [e-mail redacted]
Sent: Wednesday, October 28, 2015 12:38 PM
To: 2014_interim_guidance
Subject: Comments on Guidance on 35 U.S.C. § 101
Importance: High

Good afternoon,

I apologize for the brevity of my comments, but there is an important aspect of claims that I feel is not being adequately addressed by the Office when considering eligibility of claims under 35 U.S.C. § 101.

In particular, the priority date of applications can be instructive as to whether or not claims are in fact directed to “well known” and/or “conventional” activities. Also, the priority date of applications can be instructive as to whether or not *DDR Holdings* issues apply to claims as technology developed 10-11 years ago to address an issue being faced at the time may, from today’s perspective, be directed to well known, conventional, and/or routine matters; whereas 10-15 years ago these filings were directed to problems that were inherent to certain arts and had until that time not been addressed (or perhaps even known to exist).

One way to address such issues, in my opinion, is to require some level of documentary evidence that establishes that the non-computer equivalent of the claims was “well known” or conventional at the time of filing. Absent such a showing, the Office risks using improper hindsight reasoning to deem non-statutory some claims that were, at the time of filing, directed to new technologies, new problems, etc., and/or that did, at the time of filing, involve a special purpose computer; significantly more..., etc. At the very least, the filing date of applications should be considered.

As an example, I am currently working on an application that claims priority back to early 2004. A specialized server practiced the invention as embodied by the pending claims. I have received a 101 rejection on a continuation claiming that a general purpose computer could practice the invention. This is not true—the server cost a huge amount of money in 2003-2004 dollars—the inventors would have preferred to use a general purpose computer, but such a computer was not available at the time and therefore had to be constructed. Just an example that illustrates the above problem. I am happy to provide more thoughts and/or details, if that would be helpful.

Thank you,
Adam Citrin

Adam J. Citrin, Esq.
Hartman & Citrin LLC
2401 Macy Drive
Roswell, GA 30076
(678) 731-7460 (tel)
(678) 731-7462 (fax)
(770) 545-8230 (direct)
<http://www.hciplaw.com>

This communication was sent by an attorney and may contain legally privileged and confidential information intended only for the use of the recipient(s) intended by the original sender. If you are not

the intended recipient, please permanently destroy all copies of this communication and any message attachments, without reading, saving, or reproducing any portion of this communication or message attachments in any manner. Please contact me or an office representative immediately regarding the errant distribution. Any unauthorized reading, disclosing, copying, or distribution of any portion of this communication may be prohibited by state and federal law.