

January 18, 2017

The Honorable Michelle K. Lee  
Under Secretary of Commerce for Intellectual Property and  
Director of the U.S. Patent and Trademark Office

VIA ELECTRONIC MAIL TO [101Roundtable2@uspto.gov](mailto:101Roundtable2@uspto.gov)

RE: Notice of Roundtables and Request for Comments Related to Patent Subject Matter Eligibility, [Docket No.: PTO-P-2016-0041]

Dear Under Secretary Lee:

Mozilla Corporation (“Mozilla”) is most appreciative for the opportunity to provide our written comments in response to the USPTO’s October 2016 Request for Comments, and specifically on the *Topics for Public Comment and Discussion At Roundtable 2: Exploring the Legal Contours of Patent Subject Matter Eligibility*.

Mozilla is a software and technology company, dedicated to ensuring the Internet remains a global public resource available to all. As a wholly-owned subsidiary of the non-profit Mozilla Foundation, our work is guided by a set of principles that recognizes, among other things, the importance of interoperability, innovation, and decentralized participation to the Internet. We work with a worldwide community to create open source products like our web browser Firefox, used by an estimated half billion people worldwide. We also actively collaborate with other technology companies around the world to develop core technology and interoperability standards that power the Internet and the World Wide Web.

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## I. Judicial interpretation of Section 101’s impact on software, Internet, and technology

Mozilla has previously offered our views, both in comments to the USPTO and in amicus briefs before the federal courts, that the patent system poses significant challenges to the software and Internet industries.<sup>1</sup> We viewed the Supreme Court’s decision in *Alice Corp. Pty. Ltd. v. CLS Bank International* (“*Alice*”) as an important step towards improving patent quality, and curtailing the impact of the many overly broad software-related patents still in force today. Contrary to some fears, two years have passed

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<sup>1</sup> See, e.g., <https://blog.mozilla.org/netpolicy/2016/01/22/addressing-the-chilling-effect-of-patent-damages/> and <https://blog.mozilla.org/netpolicy/2015/04/15/open-source-software-and-the-patent-system/>.

since the *Alice* decision was issued and it has not negatively impacted innovation in the software industry.

Indeed, many developers of software, from Free and Open Source Software projects to startup companies, do not rely on patentability as the primary incentive to innovate.<sup>2</sup> Thus, Mozilla is unsurprised that there has been no decline in industry innovation in the wake of *Alice*.

## A. Patents and open standards

Mozilla strongly believes in the importance of open, royalty-free standards to the Internet and World Wide Web and we work with a wide variety of entities to develop software and standards that are made available to the public, royalty-free. These technologies range from Web interoperability, to security and encryption protocols, to video encoding and processing. This is a prime example of how traditional patent rights to exclude are not necessarily the primary motivation behind innovation in these fields.

In our view, *Alice* has had a positive effect on innovation by decreasing the potential chilling effect of invalid patents on standards.<sup>3</sup> Unfortunately, our experience shows that uncertainty with regard to patents and licensing continues to be one of the largest obstacles to the successful development and adoption of technology standards. Viewed in this light, *Alice* and other cases interpreting subject matter eligibility have served as an important backstop to reassure collaborators that over broad and vaguely worded patents will not unfairly threaten to derail standardization, or hold innovation hostage.

## B. Patent applications and prosecution

At the same time, Mozilla's own patents and patent applications have largely gone unimpacted by *Alice*. This is consistent with other commentators that *Alice* primarily invalidated patents that were used to "harm real innovators in the software industry who did the hard work of finding the technical solutions that are necessary to create valuable products."<sup>4</sup>

In our case, we have consistently focused on patent quality above all else, which means *Alice* has had little impact on our prosecution. Our patent program is motivated by a desire to ensure that our innovations will remain available to others through standards and open licensing. As a result, we have no incentive to seek low quality patents to increase the size of our portfolio, and patent quality is a key criteria when deciding whether to apply for a patent. We strive to ensure our patent applications are directed to specific technical solutions to specific technical problems, rather than over broad descriptions or generic recitations of steps or methods.

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<sup>2</sup> See, e.g., Seltzer, Wendy, *Software Patents and/or Software Development*, 78 Brook. L. Rev. 929 (2013), available at <https://ssrn.com/abstract=1985780>.

<sup>3</sup> For example, Mozilla submitted a joint amicus brief in *Halo Electronics v. Pulse Electronics and Stryker Corporation v. Zimmer, Inc.* at the Supreme Court explaining how the fear of over broad patents has greatly hindered industry efforts to work together on standards.

<sup>4</sup> Allen Lo, *Protecting Alice protects patent quality and technological innovation*, The Hill, Dec. 8, 2016 (<http://thehill.com/blogs/congress-blog/judicial/309416-protecting-alice-protects-patent-quality-and-technological>).



## C. Insufficiency of other patent provisions to prevent abuse

The USPTO specifically asked for comments on whether “other provisions of title 35 (enablement, written description, definiteness, novelty, non-obviousness) could be used more effectively” to prevent the issuance of overly broad software patents covering wide swaths of economic activity. We strongly believe that these provisions, without the limitations on subject matter eligibility articulated in cases such as *Alice*, are inadequate to prevent abuse.

First, determining whether those provisions might prevent the *issuance* of overly broad patents is not enough. Many harms of overly broad patents are realized when they are asserted against parties, not when they are issued. Because provisions such as enablement, written description, and indefiniteness must be evaluated in light of a claim’s construction<sup>5</sup>, the analysis must be done anew if the patentee or a court adopts a construction that differs greatly from the examiner’s at the time of issuance. This is especially problematic because courts will often not have the benefit of knowing what construction was applied by the examiner during prosecution, nor are courts bound by the examiner’s construction.<sup>6</sup>

Similarly, the ability to challenge a patent’s written description, enablement, novelty, obviousness, or definiteness during litigation may sometimes be an insufficient remedy from a procedural perspective. For example, an issued patent’s presumption of validity places the burden on each defendant to prove invalidity by clear and convincing evidence. In addition, each of these provisions require reference to the construed claim language, which may require the parties to undergo significant discovery or time before bringing such a challenge. Lastly, though these provisions are generally treated as questions of law on appeal, they each turn on a wide variety of facts which often make them impractical for early adjudication.<sup>7</sup>

Finally, it is not realistic to expect examiners at the USPTO to be fully versed in new technology well enough to reliably determine the intricacies of whether, for example, a written description is adequate or enabling in light of the state of the art. For example, an examiner may have to determine whether the application is directed to a wholly novel invention, nascent technology that may be known but still

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<sup>5</sup> See *Chiron Corp. v. Genentech, Inc.*, 363 F.3d 1247, 1254 (Fed. Cir. 2004) (“Because a patent specification must enable the full scope of a claimed invention, an enablement inquiry typically begins with a construction of the claims.”); *Sitrick v. Dreamworks, LLC*, 516 F.3d 993, 999 (Fed. Cir. 2008) (“The full scope of the claimed invention must be enabled ... A patentee who chooses broad claim language must make sure the broad claims are fully enabled.”).

<sup>6</sup> See, e.g., *Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1347 (Fed. Cir. 2001) (“Furthermore, we may presume that the examiner gave the terms in the proposed claim their ‘broadest reasonable interpretation consistent with the specification,’ since he was obliged to do so.”) (citation omitted); *SRAM Corp. v. AD-II Eng., Inc.*, 465 F.3d 1351, 1359 (Fed. Cir. 2006) (observing that the USPTO interpreted the claim too narrowly, and that “this court is not bound by the PTO’s claim interpretation because we review claim construction de novo”) (citation omitted).

<sup>7</sup> As an example, claim construction, written description, enablement, and obviousness will all turn on factual determinations of what knowledge a person of ordinary skill in the art would have, and what such a person would have understood or known from the patent. See *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17 (1966); *Vulcan Engineering Co., Inc. v. Fata Aluminum, Inc.*, 278 F.3d 1366, 1372 (Fed. Cir. 2002) (“Invalidity on the ground of obviousness is a question of law based on underlying factual findings. The district court’s findings of fact are reviewed for clear error, and its statements of law and application of the law to the found facts are reviewed for correctness.”)



require full enablement, or a far more straightforward improvement on existing technology.<sup>8</sup> It would also require an examiner to understand when the expansion of a claim in a natural way renders the disclosure non-enabling because the expansion is not sufficiently analogous to the disclosure.<sup>9</sup> This is especially true in light of the fact that prosecution is generally *ex parte*, and examiners do not have access to experts or other evidence that would bear on questions such as enablement.

Therefore, it is important to ensure that subject matter eligibility remains available as a way to prevent the issuance and enforcement of unfair patents, in addition to these other patent provisions.

## II. Legislative amendment to the Patent Act on subject matter eligibility is not necessary

The USPTO has also requested comment on whether or not legislative amendment to the Patent Act regarding subject matter eligibility is necessary or recommended. Mozilla believes that legislative action in this area is neither warranted nor wise at this time.

As already mentioned, the *Alice* decision is only two years old, and case law applying its teachings to patents is still developing. Likewise, the USPTO has taken tremendous and commendable efforts to understand and integrate *Alice* into its prosecution procedures and standards. Accordingly, Mozilla believes that Congressional action would be disruptive, and instead that the common law and administrative processes ought to be allowed to play out. The overall effect of *Alice* has been positive to the software industry, and premature legislative action would risk resetting the hard work and progress by practitioners, courts, and USPTO staff.

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Once again, we would like to thank the USPTO for its continuing efforts to address the important issues of patent quality and subject matter eligibility, and providing the public an opportunity to provide written comment and feedback. We are confident that the continued efforts of all stakeholders will help further clarify the dividing line between eligible and ineligible subject matter. Please do not hesitate to contact us with questions or for additional input.

Respectfully Submitted,

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<sup>8</sup> See *Chiron Corp.*, 363 F.3d at 1254 (technology that is known but nascent must still be fully enabled by the disclosure, “because a person of ordinary skill in the art has little or no knowledge independent from the patentee’s instruction”).

<sup>9</sup> As an example, in *Sitrick v. Dreamworks, LLC*, 516 F.3d 993 (Fed. Cir. 2008), the invention and claims related to the manipulation of predefined “video and audiovisual presentations such as movies and video games.” *Id.* at 996. On appeal, the court upheld summary judgment that the claim was enabled only as to video games, and not movies, due to the technological differences between the two visual media. *Id.* at 1000-01.

