

From: Lindberg, Van
Sent: Friday, March 8, 2019 5:31 PM
To: Eligibility2019
Subject: Comments on Director's Iancu's Section 101 Guidance

To Director Iancu and the Patent Office:

Director Iancu's push for greater predictability is laudable, particularly with regard to Section 101. Unfortunately, the proposed guidance will result in patents being issued that will have a high possibility of being held invalid if asserted. This is inefficient and contrary to the mission of the office.

I have the opportunity to participate professionally in both patent prosecution and patent litigation, primarily in the software and computer arts. A number of the patents asserted against my clients date back to the 2000-2010 timeframe under *State Street's* "machine or transformation" test or early *Bilski*. During this time, the patent bar was incentivized to get the broadest, most abstract claims allowable by an examiner. As a result, they display a lack of rigor and have almost all been invalidated.

As a patent prosecutor, I understand that many attorneys would prefer not to have to respond to *Alice*-type objections. But it is not hard to write non-abstract claims, including under the *Alice* and *Mayo* precedents. It just requires a deeper analysis of the technology and a clearer description of the specific workings that are novel.

Instead of restricting the various 101 precedents to their exact terms, I would suggest instead an renewed focus on section 112. Emphasizing functional enablement – and requiring the specific enabling elements in the claims – will automatically handle almost all the 101 issues on their own, and help patents better fulfill their function of teaching others of skill in the art.

Respectfully,

Van Lindberg



Van Lindberg
Member
[email redacted]

[redacted] Direct
210-554-5500 Main
855-256-1479 Fax
[redacted] Mobile

112 E. Pecan Street, Suite 1800
San Antonio, Texas 78205
www.dykema.com

*** Notice from Dykema Gossett PLLC: This Internet message may contain information that is privileged, confidential, and exempt from disclosure. It is intended for use only by the person to whom it is addressed. If you have received this in error, please (1) do not forward or use this information in any way; and (2) contact me immediately. Neither this information block, the typed name of the sender, nor anything else in this message is intended to constitute an electronic signature unless a specific statement to the contrary is included in this message.