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To: Eligibility2019
Subject: 2019 Subject Matter Eligibility Guidelines Comments

The 2019 guidelines are established based on the current state of jurisprudence and practice. I believe that the current state is unsustainable and will eventually evolve.

Accordingly, this comment is meant to present my ideas about what should supersede the current state. Because the consumers of these comments will be stakeholders as this evolution unfolds, I thought it appropriate to present these ideas esp. that they may be contrasted and compared to the 2019 guidelines.

In the same way that "processes" stand-out from the other three statutory categories as a point of controversy, "abstract ideas" stand-out from laws of nature & natural phenomena as the point of greatest concern by stakeholders of all stripes in determining subject matter eligibility.

An abstraction or idea may only be an aspiration or observation, rather than a new, useful, and actually realized thing in the world. A constant refrain from *Alice/Mayo* critics is a demand that "abstract ideas" be defined or bounded.

I suggest that there are at least two dimensions to the "abstract ideas" inquiry; those aspects of a purported invention that are *intrinsically abstract* for patent eligibility purposes, and those aspects that relate to the location or description of patentable novelty within a patent claim.

The dictionary definition of abstract includes: existing in thought or as an idea but not having a physical or concrete existence. In the vernacular, abstract is often a synonym for intangible.

Bilski established that process patents require no physical manifestation, so mere intangibility cannot preclude eligibility.

The root of the word is the Latin 'abstrere', meaning 'to draw away from'. I suggest that an abstraction can only exist in relation to a human mind. If there is no human consciousness to host an abstraction, it cannot exist. At its most essential, an "abstract idea" must include the drawing of meaning from information; a drawing of information for further processing in the mind of an individual person.

The act of drawing information into a human mind is unequivocally an act of consumption. Consumption is the precise moment when the degree or character of an abstraction becomes 100%, regardless of the a priori degree or character of the abstraction.

I therefore suggest that when a method patent's result is construed to be an item (or items) of information consumed by human actors, that method may not be eligible subject matter.

This statement of doctrine eventually could be implemented judicially, or by statute, for example by modifying Section 100(b) to read:

The term "process" means process, art or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material. The term "process" excludes any process which results in information consumed by human beings, excepting processes that improve information processing without regard to the particular content or meaning of the processed information".

This consumption of information test would be intrinsic and simple to apply, so appropriate even for a 12(b)6 motion. It would invalidate the vast majority of "do it on a computer" claims, business method claims, and diagnostic correlation claims that are the cause of so much of the difficulty with information and computer-implemented inventions.

The test would allow for new, useful, and non-obvious information results to be consumed by non-human actors while maintaining subject matter eligibility, which would prevent a feared closing-off of the patent system to a whole range of new and potentially important robotic and machine-intelligence technologies.

In those instances, and others where the location and context of the novelty of a putative invention within claims would be disputed and require construction, the current *Alice/Mayo* test could be more formalized and carried-out just as claim construction is now conducted.

To summarize my concepts:

- 1) Process patents should, by the meaning of the word "process", have the nature of their intended result construed.
- 2) Patent case procedure should expand the Markman step to include an adversarial and thorough subject matter inquiry both to establish eligibility and bound the formation of the appropriate PHOSITA for each accused infringer.

3) The judicial exceptions should be recognized as essentially expressions of equity and precede adjudication of questions of law or facts.

4) If a process patent's result or utility is processed information consumed by human beings, the method should not be eligible for patenting.

5) If a process patent's result or utility is partially or wholly found in information consumed by non-human actors, the method may be eligible, subject to construction under *Alice/Mayo*.

I believe these elements would greatly improve the function of the US patent system in the information age, promote greater justice, avoid conflict with other Constitutional rights (such as freedom of expression) and lower the costs of litigation by narrowing the subsequent 102/103/112 inquiries for both the patentee and accused infringers.

Yours Truly,

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