

**From:** Mark Webbink [e-mail address redacted]  
**Sent:** Monday, September 27, 2010 9:38 AM  
**To:** Bilski\_Guidance  
**Subject:** Comment on Docket No. PTO-P-2010-0067

Dear Madam or Sir,

Please find attached comments submitted by New York Law School's Center for Patent Innovations related to the request for comment on *Interim Guidance for Determining Subject Matter Eligibility for Process Claims in View of Bilski v. Kappos*. Should you have any questions concerning this submission, please contact me by e-mail.

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September 27, 2010

**VIA EMAIL**

Comments – Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313–1450

RE: Interim Bilski Guidance

Dear Sir/Madam:

The Interim Guidance for Determining Subject Matter Eligibility for Process Claims in view of *Bilski v. Kappos* (Interim Bilski Guidance) suggests the following factors be considered in weighing against eligibility:

- No recitation of a machine or transformation (either express or inherent).
- Insufficient recitation of a machine or transformation.
- Involvement of machine, or transformation, with the steps is merely nominally, insignificantly, or tangentially related to the performance of the steps, e.g., data gathering, or merely recites a field in which the method is intended to be applied.
- Machine is generically recited such that it covers any machine capable of performing the claimed step(s).
- Machine is merely an object on which the method operates.
- Transformation involves only a change in position or location of article.
- “Article” is merely a general concept (see notes below).

We believe this to be a relatively comprehensive list; however, we also believe the list would benefit by the addition of the following factor:

- The recitation of a machine is unnecessary to the performance of the method, i.e., the method can readily be performed within reasonable time frames without the use of a machine.

For clarification, this additional factor is intended to preclude the patentability of processes capable of performance through human endeavor without the assistance of a machine where the only role of the machine is to automate the process but not make a meaningful change in the application of the process. Thus, methods that could be or have been applied without a machine would not be patent

Comments – Patents  
September 27, 2010  
Page 2

eligible merely because they now recite the use of a machine. As with any such broad rule, there should be exceptions. In this instance the exception would be that moving the process to a machine is the only practical means of achieving the speed of calculation necessary to achieve meaningful and useful results. For example, a complex calculation that must be performed in a matter of milliseconds in order to provide meaningful and useful results, even though it could be performed by a human without machine intervention, would not be precluded from patent eligibility.

Sincerely,



Mark H. Webbink  
Visiting Professor and Executive Director