

From: [e-mail redacted] On Behalf Of Roberto Bayardo
Sent: Saturday, September 25, 2010 8:19 PM
To: Bilski_Guidance
Subject: Feedback from a Google Research Scientist on Bilski v. Kappos

Dear USPTO,

I am a Principal Research Scientist at Google where I have been working for 5 years. Prior to that I was at IBM where I worked as a Research Staff Member for 8 years. I have graduate degrees from MIT and the University of Texas at Austin. I have over a dozen software patents either granted or in application. My participation in the software patent process has always been reluctant. But because of the nature of the software patent system, my employers have had to spend enormous resources patenting most any software concept, innovative or otherwise, as a "defensive" maneuver in order to protect themselves against frivolous patent litigation. While the goal of software patents should be to spur innovation, in my experienced view it has had the exact opposite effect. The resources we spend on filing patents and defending against infringement lawsuits could much better be invested into developing new software innovations. This perspective is from that of someone who has largely worked in large companies.

However, the situation is even worse for the small entrepreneur, for whom a single software patent can put up an insurmountable, and unjustifiable, legal hurdle for bringing an innovative software application to market. Never have I seen the outcome of a patent lawsuit actually protect an innovator.

The Supreme Court of the United States has never ruled in favor of the patentability of software. Their decision in *Bilski v. Kappos* further demonstrates that they expect the boundaries of patent eligibility to be drawn more narrowly than they commonly were at the case's outset.

The primary point of the decision is that the machine-or-transformation test should not be the sole test for drawing those boundaries. The USPTO can, and should, exclude software from patent eligibility on other legal grounds: because software consists

only of mathematics, which is not patentable, and the combination of such software with a general-purpose computer is obvious.

If you need any clarification on my opinion, please do not hesitate to contact me, either at this e-mail address, by regular mail, or by phone.

Sincerely,

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