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Subject: Comments on Bilski Guidelines

Attached are comments on the Bilski Guidelines.
These comments were inadvertently and mistakenly delayed.
I respectfully request that they be considered.

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COMMENTS ON

“Interim Guidance for Determining Subject Matter Patentability for Process Claims in View of *Bilski v. Kappos*, 75 Fed. Reg. 3922 (July 27, 2010)

The Interim Guidance published by the PTO specifically states that “[i]t is intended to be used by Office personnel as a supplement to the previously issued Interim Examination Instructions for Evaluating Subject Matter Eligibility Under 35 U.S.C. 101 dated August 24, 2009 (“Interim Instructions”) and the memorandum to the Patent Examining Corps on the Supreme Court Decision in *Bilski v. Kappos* dated June 28, 2010. [emphasis added] These comments are submitted to urge the PTO to confirm that, with regard to three specific issues, the Interim Instructions are, indeed, to be followed. Such confirmation will provide further support for the Supreme Court’s statement in *Bilski* that to “freeze process patents to old technologies, leaving no room for the revelations of the new, onrushing technology...is not our purpose”. With regard to a fourth specific issue, we urge that Section 112, rather than Section 101 is the more appropriate guiding principle.

Interim Guidance, Section IV(A)[1] and IV(A)[2]

In Section IV(A) of the Interim Guidance, there is a discussion of factors that are relevant to determine “whether a method involves or is executed by a particular machine or apparatus.” In Section 4A[1] of the Interim Guidance one of the factors that is relevant to determine whether a method involves or is executed by a “particular machine or apparatus” is identified as: “...the degree to which the machine in the claim can be specifically identified”. In Section IV(A)[2] of the Interim Guidance, another of the factors is identified as: “Whether the machine or apparatus implements the steps of the method.” The Guidance then states that “[i]ntegral use of a machine or apparatus to achieve performance of the method weighs toward eligibility, as compared to where the machine or apparatus is merely an object on which the method operates, which weighs against eligibility”. We urge that the Interim Guidance be clarified to confirm that a general purpose computer is a “particular machine or apparatus” with which a method may be involved or on which a method may be executed.

The previously issued Interim Instructions state in Section IIB. (page 6) that “[f]or computer implemented processes, the ‘machine’ is often disclosed as a general purpose computer. In these cases, the general purpose computer may be sufficiently “particular” when programmed to perform the process steps. Such programming creates a new machine because a general purpose computer, in effect, becomes a special purpose computer once it is programmed to perform particular functions pursuant to instructions from program software.”

The Interim Guidance published by the PTO specifically states that “[i]t is intended to be used by Office personnel as a supplement to the previously issued [Interim Instructions], yet even the word computer does not appear in the Interim Guidance, much less any echo of the Interim Instructions’ statement on general purpose computers. To avoid any confusion, the Interim Guidance should specifically reconfirm the cited statement of the Interim Instructions regarding general purpose computers, and should specify that a

general purpose computer is a “particular machine or apparatus” that may be used to perform a method, as opposed to being “merely an object on which the method operates” [emphasis added], thereby making it less likely that such a method is drawn to an abstract idea.

Interim Guidance, Section IV(A)[3]

In this Section, the Interim Guidance discusses another factor that is relevant to determine whether a method involves or is executed by a particular machine or apparatus. The Guidance states this factor as: “Whether [the] involvement [of the machine or apparatus] is [an] extrasolution activity or a field-of-use, i.e., the extent to which (or how) the machine or apparatus imposes meaningful limits on the execution of the claimed method steps.” The Guidance then states that “[u]se of a machine or apparatus that contributes only nominally or insignificantly to the execution of the claimed method (e.g., in a data gathering step or in a field-of-use limitation) would weigh against eligibility”.

In Section IIB., the previously issued Interim Instructions state that “the use of the particular machine or the transformation of the particular article must involve more than insignificant ‘extra-solution’ activity.” In the same Section, the Interim Instructions further state that “[i]nsignificant ‘extra-solution’ activity means activity that is not central to the purpose of the method invented by the applicant. For example, gathering data to use in the method when all applications of the method would require some form of data gathering would not impose a meaningful limit on the claim.”

The Guidance should clarify that the performance of a claimed method on a general purpose computer is not an “extrasolution activity”, thereby making it less likely that such a method is drawn to an abstract idea.

Section IV B

In this Section, the Guidance discusses “[w]hether performance of the claimed method results in or otherwise involves a transformation of a particular article”. In Section IV B[2] the Guidance states that one of the factors is: “The degree to which the recited article is particular. In Section IV B[3] the Guidance states that another factor is: “The nature of the transformation in terms of the type or extent of change in state or thing...” In Section IV B[4] the Guidance states that yet another factors is: “The nature of the article transformed, i.e., whether it is an object or substance, weighing toward eligibility, compared to a concept such as a contractual obligation or mental judgment, which would weigh against eligibility.” We urge that the Interim Guidance should clarify that methods of transforming data representative of information is “transformation of a particular article” in accordance with the Interim Guidance.

The previously issued Interim Instructions state, In Section IIB, that “[a]n article can also be electronic data that represents a physical object or substance. For the test, the data should be more than an abstract value. Data can be specifically identified by indicating what the data represents, the particular type or nature of the data, and/or how or from

where the data was obtained.” Accordingly, the Guidance should clarify that performance of a method that transforms an electrical or electromagnetic signal representative of information is a “transformation of a particular article”, making it less likely that such a method is drawn to an abstract idea.

Section IV D [2]

In this Section, the Guidance discusses “[w]hether a general concept (which could also be recognized in such terms as a principle, theory, plan or scheme) is involved in executing the steps of the method.” The Guidance states that one of the factors is: “The extent to which the claim is so abstract and sweeping as to cover both known and unknown uses of the concept, and be performed through any existing or future-devised machinery, or even without any apparatus.” *Gottschalk v. Benson*, 409 U.S. 63, 93 S.Ct. 253 (1972)

The simple test of whether a claim covers both known and unknown uses of a concept should be removed as a consideration in making it more likely that the claim is drawn to an abstract idea. It is a fundamental principle of patent law that all claims may cover unknown uses that come to light with after arising technologies. Whether a claim can properly cover such unknown uses involves enablement and written description requirements (35 USC 112), not subject matter eligibility (35 USC 101). For example, in the context of 35 USC 112, the CAFC has stated, “blocking conditions conceivably occur often where a pioneering patent claims a genus and an improvement patent later claims a species of that genus”, and “A generic claim may define the boundaries of a vast genus of chemical compounds, and yet the question may still remain whether the specification, including original claim language, demonstrates that the applicant has invented species sufficient to support a claim to a genus. *Ariad v. Eli Lilly*, 598 F.3d 1336 (Fed Cir. 2010) (en banc) Additionally, in the context of “means for” claims, the CAFC has specifically stated that such claims can cover “after-arising technologies”, albeit under the doctrine of equivalents. *Al-Site v. VSI International*, 174 F.3d 1308 (Fed. Cir. 1999) When the Supreme Court in *Benson* considered whether a claim covered both known and unknown uses, it clearly was referring to a claim that it felt covered all known and unknown uses of the claim.

In view of the fact that a claim’s coverage of unknown uses is a question of enablement under 35 USC 112, the Interim Guidance should clarify that a claim’s scope should be considered in a 35 USC 101 inquiry only if written in such abstract terms as to and thereby preempt an abstract idea or principle.

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