

From: Roberta J Morris [e-mail redacted]  
Sent: Monday, September 27, 2010 5:01 PM  
To: Bilski\_Guidance  
Subject: Second Try: Comments

My comments are attached as a Word document. If you have any questions, please do not hesitate to email.

-----

Roberta J. Morris  
AB Brown University 1971 summa cum laude  
JD Harvard Law School 1975  
PhD Columbia University 1986 (Physics)  
Room 208 Crown Quadrangle 650-723-9505  
Stanford Law School  
Lecturer, Patent Law and related subjects  
University of Michigan Law School, 1991-2005  
Stanford University Law School, 2006-Present  
Member of the Patent Bar and of the Bars of  
New York and Michigan  
<http://www.stanford.edu/~rjmorris/>

-----

Comments to the Interim Guidance for Determining  
Subject Matter Eligibility for Process Claims

In View of *Bilski v. Kappos*

75 FR 43922, July 27, 2010

by

**Roberta J. Morris, Esq., Ph.D.**

Member of the Patent Bar and of the

Bars of New York and Michigan

Lecturer, Stanford Law School

submitted by email, 9/27/2010

A. Comments on Part II. Summary, last paragraph (75 FR 43924-5).

The last paragraph of Part II, Summary, states:

"Therefore, examiners should avoid focusing on issues of patent-eligibility under § 101 to the detriment of considering an application for compliance with the requirements of §§ 102, 103, and 112, and should avoid treating an application solely on the basis of patent-eligibility under § 101 except in the most extreme cases." (emphasis mine)

1. *Word Choice*

There is neither a detriment nor its opposite, a benefit, to the statute when examiners use or do not use it. You do not mean *detriment*, you mean *exclusion*. I point out this error not only because accuracy with words is of such importance to all who deal with patents, but also because the wrong word may have been chosen from a subconscious prejudice against, and misunderstanding of, the purpose and importance of, §§ 102, 103 and 112 as gatekeepers against unpatentable subject matter.

2. *The Detriment When Examiners Consider Patent Eligibility to the Exclusion of The Other Statutory Requirements*

It is the applicant and the public who suffer a detriment when the statute is not applied intelligently. Rejecting claims on "patentable subject matter" ("PSM") grounds alone is not just ill-advised and lacking in reason, it is contrary to the statute.

Section 101 (35 USC § 101) states:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, \_subject to the conditions and requirements of this title\_."

Both Justice Kennedy, at the start of Part II.A of the majority opinion, and Justice Stevens at the start of Part III of the minority concurrence in the judgment, quote this final phrase of 101: "subject to the conditions and requirements of this title." The Supreme Court has never said that those words have no value.

Ignoring the other conditions and requirements of Title 35 wastes the time and resources of the Patent Office and the applicants alike, because the number of claims in condition for allowance after examination for validity over the prior art and for enablement, that nevertheless present a PSM problem, is smaller, far smaller, than the number of unexamined claims that appear to have such a problem.

Wasting Patent Office resources harms the public, as taxpayers, and as beneficiaries of both the teachings of patents and the impetus that patents give to innovation for both those who take licenses and continue development and those who choose to design around the patent.

### 3. *The "Most Extreme" Cases*

You do not define "most extreme" but I think you mean cases where the olfactory or intestinal response is that no patent should be issued. These are the cases where a lay person who was told about the claimed invention would say, "Surely you can't get a patent on THAT."

People with some knowledge of patent law realize, however, that those cases are exactly the ones where either **the claim is not new or the claim is not enabled**. Many lawyers, including amici in *In re Bilski* (myself among them, see 2008 WL 1842256, 2008 U.S. Fed. Cir. Briefs LEXIS 27 at \*11), and in *Bilski v. Kappos*, have pointed out that the problem with Morse's claim in **O'Reilly v. Morse**, 56 US 62 (1853), for example, would under the Patent Act of 1952 be considered non-enablement.

Many patent practitioners, looking at the Bilski claim or the Ferguson claim mentioned in the Interim Bilski Guidance (75 FR at 43924) immediately appreciate that hedging and marketing were both well known at the time of filing either of those applications: prior art exists. Thus it is wrong to instruct examiners to ignore 35 USC § 102, 103 and 112 ("102-103-112") in any examination, and especially in the "most extreme" cases.

If examiners use 102-103-112 whenever they use 101, then the applicant can either:

1. amend to overcome the prior art, and by so doing almost always solve both the enablement and any 101 patentable subject matter problems, or
2. if the specification as submitted does not support enablement or amendment, then abandon that application,
  - 2.1 completely, in cases where the loss of the parent filing date would lead to a 35 USC 102b bar, or
  - 2.2 after submitting a continuation-in-part with the needed new matter for support, and amending the claims in the new case as needed.

Applicants and the public will benefit: The applicant benefits because possibilities 1 and 2.1 provide a means to place the claims in position for allowance. The public benefits because rightly-issued patents are a societal good (or so the founders of our government believed when they included Article I, Section 8 Clause 8 in the Constitution. The public also benefits because possibility 2.2 removes the "most extreme" cases from the system and, further, because the original publication, if published, will serve as prior art available to defeat other "extreme cases."

In addition, whether possibilities 1, 2.1 or 1.2 occur, applicants, the public, the Patent Office and the courts, benefit by preventing more cases like Bilski and Ferguson from taking up the time of the Office, the Board and the Courts: cases where patent claims have not been put in position for allowance with regard to the "other requirements" that Section 101 mentions yet are attacked as being directed to improper subject matter.

#### *4. Employ Compact Prosecution Always*

Compact prosecution will permit the Office to spend more time on searching for prior art and looking out for the public interest in having patents that teach by checking for enablement, and less time on worrying over

"patentable subject matter" - a blunt, abstruse weapon divorced from the reason we have a patent system at all. That reason, if I may dare to paraphrase Article I, section 8, clause 8 of the United States Constitution, is: to confer a temporary exclusivity in exchange for being taught about something new.

The "being taught" part is enablement (35 USC 112); the "something new" is something that is novel and non-obvious (35 USC 102 and 103). Thus 102-103-112 are the right way to effect the purposes of the Constitution. PSM is not. (See also my "An Urgent Letter and a Time-Sensitive Proposal To David Kappos," sent to Mr. Kappos last October and available at <http://myunpublishedworks.blogspot.com>.)

#### B. Invitation to Submit Claims - A Half Measure

In the section entitled Request for Comments (75 FR at 43923) members of the public were invited to submit claims, and claims alone, by which the Office should consider its post-Bilski rules. This is only a half measure.

Section 101 requires the Patent Office to consider "the conditions and requirements of this title." That means enablement and validity over the prior art. For enablement, a specification is needed, not just claims. This is also true for validity: claims must be interpreted in light of the specification, and terminology in a claim, whether it may be attacked under 101 or not, is often in language that the specification defines.

In order for the Patent Office to make a meaningful analysis of 101 and how compact prosecution aids in removing from the possibility of issuance any claims that may somehow be drawn to unpatentable subject matter by whatever test might be devised, it must do so by looking at applications, not claims in a vacuum.

Neither Bilski nor Ferguson (nor, indeed the patent in **State Street v. Signature**, 149 F.3d 1368 (Fed. Cir. 1998)) were properly vetted for validity over the prior art and enablement. In none of the Supreme Court's 101 cases had a search been done. The only 101 case where the claim was subject to a prior art attack by a litigant is **AT&T v. Excel**, 172 F.3d 1352 (Fed. Cir. 1998). There the claims were subsequently invalidated under §§ 102 and 103. That case shows how well served the patent system would be by compact prosecution.

C. The *Bilski v. Kappos* Decision, the Constitution, and Keeping the Patent System Flexible.

Justice Kennedy, especially in the plurality opinion where he quoted **Benson** (part II.B.2), was particularly concerned to avoid freezing the patent law in a particular time and place. Such flexibility is in fact required by the Constitution. The patent system created by Congress, in order to fulfill the Constitutional mandate of Article I, Section 8, Clause 8, must adapt as new areas in which inventors make discoveries (to use the Constitutional nouns) emerge and evolve.

102-103-112 by their nature are flexible and adaptable. As a new field of endeavor begins, people create prior art by patent applications, articles and advertisements on the web and in print, manuals, actual goods and services offered to the public, etc.

Enablement also changes with time, as there is growth in the knowledge of "any person skilled in the art to which [the invention] pertains, or with which it is most nearly connected."

It is respectfully submitted that the public, as consumers, as inventors, as taxpayers, are best served when 102-103-112 do the work they were intended to do, and the Patent Office only engages in jousting with words like "abstract" when it confronts claims that are fully enabled and valid over the prior art.

Respectfully submitted,

Roberta J. Morris