

From: Matt Rainey [mailto:Mattr@intven.com]

Sent: Tuesday, September 29, 2009 5:20 PM

To: AB98 Comments

Subject: RE: Intellectual Ventures, LLC--Comments on PTO's Interim Examination Guidelines -- In Response to Request for Comments Published Sept. 17, 2009 at 74 Federal Register 47780

Attn: Caroline D. Dennison

Office of the Deputy Commissioner for Patent Examination Policy

United States Patent and Trademark Office

Dear Ms. Dennison,

Please substitute the attached Comments by Intellectual Ventures relating to the Interim Examination Guidelines in place of the copy that I emailed yesterday (which was attached to the email below).

I have corrected some typographical errors on the first page (changing "74 Fed. Reg. 179" to "74 Fed. Reg. 27740", which is the correct page reference), and correcting a date error in the first paragraph. Otherwise, the text is identical to the copy that we sent yesterday.

I note that the Patent Office has extended the comment period for the Interim Examination Instructions (as set forth at <http://www.uspto.gov/main/homepagenews/2009sep29.htm>). Accordingly, I believe that the resubmission of these comments is timely.

Thank you,

--Matt Rainey

From: Matt Rainey

Sent: Monday, September 28, 2009 3:06 PM

To: AB98.Comments@uspto.gov

Subject: Intellectual Ventures, LLC--Comments on PTO's Interim Examination Guidelines -- In Response to Request for Comments Published Sept. 17, 2009 at 74 Federal Register 179

Attn: Caroline D. Dennison

Office of the Deputy Commissioner for Patent Examination Policy

United States Patent and Trademark Office

Dear Ms. Dennison,

Attached please find comments by Intellectual Ventures, LLC on the PTO's Interim Examination Guidelines, which we are submitting in response to the Request for Comments published on September 17, 2009 at 74 Federal Register 179.

Best regards,

--Matt Rainey

Vice President/Patent Counsel

Intellectual Ventures
1756 114th Avenue SE, Suite 110
Bellevue, Washington 98004
Tel.: 425-467-2300

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re:

[Docket No.: PTO-P-2009-0037]

For: **Request for comments:
Interim Examination Instructions
for Evaluating Patent Subject
Matter Eligibility**

**74 Fed. Reg. 47780
(September 17, 2009)**

***Comments In Reply To “Request for Comments on Interim Examination
Instructions for Evaluating Patent Subject Matter Eligibility”***

Attn: Caroline D. Dennison
Office of the Deputy Commissioner
For Patent Examination Policy
United States Patent and Trademark Office

***by e-mail:
AB98.Comments@uspto.gov***

Sir:

In reply to the *Request for Comments on Interim Examination Instructions for Evaluating Patent Subject Matter Eligibility* published September 17, 2009 at 74 Fed. Reg. 47780 (referring to the interim guidelines posted at http://www.uspto.gov/web/offices/pac/dapp/opla/2009-08-25_interim_101_instructions.pdf), Intellectual Ventures, LLC submits the following comments.

Introductory Comments

Intellectual Ventures, LLC (<http://www.intven.com>), based in Bellevue Washington, is in the business of creating new ideas. We create these ideas in-house, develop them at Intellectual Ventures Laboratory (<http://intellectualventureslab.com>), and seek to protect them through the patent system. We work with internal and external inventors – some of the brightest minds of today's inventive society – to create our new ideas. In addition, Intellectual Ventures also seeks to build upon our own ideas by licensing and acquiring intellectual property from industrial, government and academic partnerships. In short, we both invent and invest in inventions, spanning a diverse range of technologies, including software, semiconductors, medical devices, biotechnology and nuclear technology.

Intellectual Ventures appreciates the opportunity to offer these comments.

Comments on the Interim Examination Instructions

The case of *Bilski v. Kappos* addresses important issues of subject matter patentability, which are open to interpretation and hence potentially to inconsistent application among Examiners.

Our primary comment is that we believe the Patent Office has done an excellent job of explaining how claims should be analyzed to determine whether they are directed to statutory subject matter. The *Interim Examination Instructions* are clearly written and easily followed, and we believe they will contribute considerably to consistent and objective examination results, removing ambiguity that Examiners might otherwise face when interpreting the *Bilski* decision by the Federal Circuit.

By submitting these comments, incidentally, we do not mean to imply that the 2008 *In re Bilski* decision by the Court of Appeals for the Federal Circuit is correct or incorrect in any respect. Our comments are confined entirely to the Patent Office's interim guidelines, given the *In re Bilski* decision as the current state of the law.

While parties may debate the holding in the *Bilski* decision and many different outcomes are possible at the Supreme Court, as an interim measure we believe the Patent Office has performed an important public service for the patent system and the protection of innovation by publishing the *Interim Examination Instructions*.

That said, there is one particular point that we would like to focus on: the Patent Office's guidance as to what may be interpreted as "insignificant extra-solution activity," addressed at pages 6 and 26-27 (including slides 15-16) of the posted (PDF) document containing the interim guidelines.

We would like to thank the Patent Office for its examples relating to what might or might not constitute "insignificant extra-solution activity." We believe that this is the first exposition that we have seen that gives any clarity on this obscure concept. The only additional thing we would ask is that the Patent Office include at least one more slide that would illustrate under what circumstances an operation such as "obtaining the search results by electronically downloading the results from a database" (which is used on slide 16 to illustrate "insignificant post solution activity") might indeed not be "insignificant post solution activity."

For example, during a recent public discussion of the proposed interim guidelines, several patent attorneys with expertise in medical devices pointed out that "obtaining ... by electronically downloading ..." might not constitute merely "insignificant" extra-solution activity if the downloading were obtaining unique data from a unique device. An example given was "obtaining ... by downloading functional magnetic resonance imaging data (fMRI data) from an fMRI machine." These attorneys were of the opinion that since fMRI data conveys significant information that informs solutions, this type of operation would *not* be "insignificant extra-solution activity."

Since the interim guidelines provide no examples of when and how "obtaining ... by electronically downloading ..." would not constitute "insignificant extra-solution

activity,” we have some concern that this might become a source of disagreement between applicants and Examiners. Thus, we ask that the Patent Office address this issue with one or more examples. If at least one example were framed in terms of medical/health-related inventions (which often involve very significant solution-specific information), that could be particularly useful.

Conclusion

In summary, we would like to express our appreciation for these clear guidelines on the issue of subject matter patentability, which we believe will go a long way to returning the Patent Office to a functionally and fiscally sound agency. We are grateful to the new leadership of the Patent Office and the drafters of these interim guidelines. While interpreting the law in this area will certainly continue to present challenges, and perhaps require modification once the Supreme Court has ruled on the *Bilski* case, in the meantime the interim guidelines should be studied and followed by patent applicants and Examiners alike.

Respectfully submitted,

Intellectual Ventures, LLC


Matthew Rainey, Esq.
Vice President/Patent Counsel
Reg. No. 32,291

Date: September 28, 2009

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Bellevue, Washington 98004