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Sent: Sunday, April 23, 2006 3:54 PM
To: AB98 Comments
Subject: Comment on Inerim Guidelines

23 April 2005

To: Commissioner for Patents; AB98.Comments@uspto.gov.

Dear Sir:

This comment is submitted with respect to (c) Electro-magnetic signals of the Interim Guidelines as published in the United States Patent and Trademark Office OG Notices: 22 November 2005. These interim guidelines propose that signal claims, as described therein, are ineligible for patent protection because they do not fall within any of the four statutory classes of Sec. 101. Public comment was sought for further evaluation of this question.

The Interim Guidelines, while not having the force of law, are used by examiners at the USPTO as the basis or determination of the patentability of subject matter and claims thereto. Legally incorrect or ambiguous guidance is contrary to the public interest as it increases the delay and cost of patent examination, as such incorrect or ambiguous guidance will result in an increase in the number of appeals from the actions of patent examiners based on the associated examination errors..

The USPTO accepts that "a signal encoded with functional descriptive material is similar to a computer-readable memory encoded with functional descriptive material" which the previous section of the Interim Guidelines considers patentable subject matter. In a very narrow interpretation of electromagnetic signals as apparently being usable only with a computer, the USPTO then renders an unsupported judgment that "such signal claims are ineligible for patent protection because they do not fall within any of the four statutory classes of Sec. 101."

The respondent respectfully submits that such a conclusion is contrary to settled law, is a conclusion much broader than the arguments presented, and is not supported by any competent authority. As such, the respondent respectfully requests that the USPTO modify the Interim Patent Examination Guidelines by deleting section (c) in its entirety.

Generally, the USPTO modifies the guidelines for patent examiners, as provided in the Manual of Patent Examination Practice (MPEP), based on one of: (a) changes to 35 USC, other public law, or (b) precedential court decisions which have become settled law. To do otherwise would substitute the judgment of the USPTO for the branches of government competent to make and interpret such laws. Although there are exceptions to this practice for administrative matters which are delegated by law to the USPTO, the change in examination practice in the Interim Guidelines goes to the heart of the law.

In the change to the examination guidelines with respect to (c), Electro-magnetic signals, the USPTO does not make reference to any recent change in the law by the Congress, or to a precedential interpretation of the law by the courts. The latest Supreme Court decision relating directly or indirectly to this subject that is cited dates from 1931, and no decisions of the Court of Appeals for the Federal Circuit are cited. The Chisum treatise appears to be cited as a reference as the original source, which dates from 1890, is apparently not available. As such, it is evident that there is no current issue relating to the subject, and the change appears to be either spontaneous, or related to an unstated issue.

Electromagnetic signals, which act in accordance with Maxwell's equations, are indeed a phenomenon of nature and it has long been settled law that such phenomena, per se, are not patentable. "A principle, in the abstract, is a fundamental truth; an original cause; a motive; these cannot be patented, as no one can claim in either of them an exclusive right." *Le Roy v. Tatham*, 55 U.S. (14 How.) 156, 175 (1853); *O'Reilly v. Morse*, 56 U.S. (15 How.) 62, 116 (1853). However, in *Morse*, the Court also ruled that certain of the claims were valid; and a fair reading of the upheld claims would establish that signals modulated on electromagnetic waves (that is, the current of the Morse telegraph) are patentable subject matter. Equivalently, it is also settled law that the practical use of a natural law to achieve a practical result is patentable subject matter. *Diamond v. Chakarabarty* 447 U.S. 303 (1980), *Diamond v. Diehr* 450 U.S. 175 (1981) .

In another aspect, light is an electro-magnetic signal phenomena; a myriad of inventions use and modify light to achieve practical results. Such devices include, for example, lasers, the use of lasers to heat, or to cut, materials, or the modulation of data on a laser signal for optical fiber communications. The act of directing a laser signal onto an object, or modulating a data signal onto a laser beam is the subject of many granted patents, and none of them has been challenged in court using arguments such as the USPTO now sets forth regarding electromagnetic waves and signals modulated thereon. In an alternative to analysis of the engineering aspects of light using Maxwell's equations, light can be considered as having particulate properties (see Einstein, A., *Über einen die Erzeugung und Verwandlung des Lichtes betreffenden heuristischen Gesichtspunkt* (Ann. Phys., Lpz 17 132-148(1905)), and the quanta of light are called photons. Such photons are tangible and the interaction of the photons with matter can be described by the known laws of physics, and the practical effects of such interaction, including the modulation of signals, have long been patentable.

This submission is made by me personally and represents my own professional opinion and not that of my employer.

Respectfully submitted,

Sid Bennett, Reg. 53,981