

From: Jeffrey Light
Sent: Wednesday, July 12, 2006 4:40 PM
To: AB98 Comments
Cc: Robert Schmid
Subject: Comments on Proposed Interim Guidelines on Subject Matter Eligibility

Patients not Patents, Inc. is a 501(c)(3) nonprofit organization in Washington D.C. dedicated to removing intellectual property burdens to affordable healthcare through education, advocacy and litigation.

Patients not Patents submits the following comments:

1. On page 23 of the Guidelines, *Benson* is quoted for the statement, "Phenomena of nature, though just discovered, mental processes, [and] abstract intellectual concepts are not patentable, as they are the basic tools of scientific and technological work." (Note: the bracketed word "and" is mistakenly omitted in the Guidelines.) However, on pages 46-47, the Guidelines prohibit examiners from using the "mental step test." *Musgrave* is cited as precedent for the proposition that the "mental step test" is no longer a valid test for patentability. The Guidelines direct the examiner to apply the "practical application test" set forth in *State Street*. Both *Musgrave* and *State Street* are decisions of the Federal Circuit/CCPA, while *Benson* was decided by the Supreme Court. *Benson* has not been overruled and the "mental step test" is still good law. Although Justice Stevens' dissent in *Diamond v. Diehr* argues that the mental steps test has been eliminated, the majority does not address the mental steps test at all, leaving the holding of *Benson* on this issue intact.

2. On page 13, the Guidelines state, "Accordingly, a complete definition of the scope of 35 U.S.C. § 101, reflecting Congressional intent, is that any new and useful process, machine, manufacture or composition of matter under the sun that is made by man is the proper subject matter of a patent." However, the Congressional report from which the "anything under the sun" language derives does not mention either processes or compositions of matter. The report states, "A person may have 'invented' a machine or manufacture, which may include anything under the sun made by man, but it is not necessarily patentable under section 101 unless the conditions of the title are fulfilled." *S. Rep. No. 1979, reprinted in 1952 U.S. Code Cong. & Admin. News at 2399*. Additionally, the statement in the Guidelines is incorrect gramatically, as processes are not "made."

3. On pages 21-22 of the Guidelines, there is no basis for the given definition of "concrete." *In re Swartz* is relied upon for the definition of "concrete." However, *Swartz* never uses the term concrete. *Swartz* is a case about operability. While *Swartz* enunciates an important rule of operability, it has nothing to do with defining "concrete." The term "concrete" as used in the Guidelines also finds no basis in the ordinary meaning of the term, which is defined as "of or relating to an actual specific thing or instance; particular." American Heritage Dictionary, Fourth Edition. If this definition is adopted, a "concrete" result would be the opposite of a "general" result. This understanding is better supported by case law than the *Swartz* definition. In the following cases, the result of the invention was found to be tangible, concrete and useful: *State Street-the price of a share*

of stock; Arrhythmia-an arithmetic value which represents the state of a patient's heart; In Re Alappat-a machine displaying a smooth waveform; Diehr-precision molded rubber; and Chakrabarty-an oil-eating, genetically engineered bacteria. In contrast no practical application existed due to the general nature of the results of Flook-a number derived from a formula in which none of the variables are specified, and Morse-a method for writing characters at a distance using electromotive force.

Thank you for providing the public with an opportunity to comment on these Guidelines.

Sincerely,

Jeffrey Light
Executive, Director
Patients not Patents