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RESPONSE TO NOTICE

Ms. Elizabeth Shaw
Office of Policy and International Affairs (OPIA)
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22314
VIA ELECTRONIC SUBMISSION (www.regulations.gov)

October 15, 2021

RE: Notice Regarding the Patent Eligibility Jurisprudence Study (July 9, 2021; Docket No. PTO-P-2021-0032)

Dear Ms. Shaw:

On behalf of my firm, Mertzlufft Law PLLC, I am pleased to have the opportunity to present a response to the U.S. Patent and Trademark Office's request for comments regarding its Patent Eligibility Jurisprudence Study, 86 Fed. Reg. 36257, dated July 9, 2021 (the "Request"), Docket No. PTO-P-2021-0032.

As Mertzlufft Law PLLC's principal attorney, I work with clients across varied subject matter, including in fields particularly relevant to the Request, *inter alia*, software, artificial intelligence, and machine learning. I work primarily with startups and small businesses, which form the backbone of cutting-edge American innovation. This and other previous experiences provide me a unique perspective regarding the effects of the current state of subject matter eligibility on American innovators.

The Request solicits comments regarding "the current state of patent eligibility jurisprudence in the United States," specifically referring to "the body of patent subject matter eligibility decisions issued by the U.S. Federal Judiciary" (hereinafter "Section 101 jurisprudence").[1] The Request aptly references the Federal Circuit's decision in *American Axle*[2] as indicative of the state of Section 101 jurisprudence in the United States patent system. There, the Federal Circuit effectively reduced a method for manufacturing a driveshaft assembly down to Hooke's law and held the patent was thus invalid for want of eligible subject matter.[3] The court's analysis turned in part on whether the claims embodied an "inventive concept."[4]

While a *mechanical* invention being held invalid is undoubtedly an extreme and unusual case, it is a symptom of an endemic Section 101 jurisprudence problem faced by applicants. American innovators in another field, information technology (*e.g.*, software, artificial intelligence, and machine

[1] 86 Fed. Reg. 36257, 36259 (July 9, 2021).
[2] *See generally Am. Axle & Mfg., Inc.* v. *Neapco Holdings LLC,* 966 F.3d 1347 (Fed. Cir. 2020).
[3] *Id.* at 9.
[4] *Id.*

learning), face even greater uncertainty in making decisions of whether to apply for patent protection for their inventions. According to Indeed.com, information technology is one of the top growing industries in the United States.[5] As a patent attorney who works regularly with innovators in this and other fields subject to the ever-growing hydra of Section 101 jurisprudence, I feel compelled to submit this response to the Request.

With the 1952 Patent Act, "Congress intended statutory subject matter to 'include anything under the sun that is made by man,'" as the Supreme Court itself recognized.[6] Under the current state of Section 101 jurisprudence, this could not be further from the truth in practice—*and it is getting further*. As one deft observer noted in 2018, "It is clear that continuing down the *Alice* [*Corp. Pty. Ltd. v. CLS Bank Int'l*] rabbit hole will not fix the problem, guidance is needed in the form of a legislative solution."[7] It's clear Section 101 jurisprudence has traveled far down the *Alice* rabbit hole into a wonderland where the law cannot be relied upon as stable *over the time between filing and examination of an application*. It is past time to restore the U.S. patent system to its rightful position as the world's foremost intellectual property system.

The current state of Section 101 jurisprudence adds a significant amount of uncertainty to my practice and that of many other practitioners. As an illustrative example, it is often necessary to explain to applicants up front the ever-evolving nature of Section 101 jurisprudence, which is difficult for patent attorneys to understand and keep up with, let alone for startup applicants seeking to obtain patent protection *and* create or grow a business. Given the length of the examination process in a typical application, this often may mean informing applicants the law may change in a way affecting their application between the time their application is filed and the time it is examined. It is widely accepted that a foundational purpose of law is to afford certainty. The most certain aspect of Section 101 jurisprudence practitioners can count on is that it will likely change, and this presents what should be unnecessary difficulties to applicants, examiners, and practitioners.

Furthermore, for some software applications, Section 101 has in practice morphed into an "obviousness-lite" inquiry. This effectively permits summary rejection of claims for want of an "inventive concept" and shifts to the applicant a burden of proving their invention exhibits an inventive concept using an unsettled standard. The "inventive concept" standard lacks the rigorous safeguards of a *prima facie* case of obviousness required under 35 U.S.C. § 103 as clarified in *Graham v. John Deere Co. of Kansas City*[8] and its progeny.

A result widely observed in practice is frequently the fate of computer-based inventions—otherwise clearing the great bars of novelty and non-obviousness—is uncertain unless the claims are sufficiently narrow to avoid being summarily declared an application of an abstract idea on a "well-

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[5] Indeed Editorial Team, 12 Fastest-Growing Industries in the U.S., INDEED.COM (February 25, 2021), https://www.indeed.com/career-advice/finding-a-job/top-growing-industries.

[6] *Diamond v. Diehr*, 450 U.S. 175, 182 (1981) (quoting S. Rep. No. 1979, 82d Cong., 2d Sess., 5 (1952); H.R. Rep. No. 1923, 82d Cong., 2d Sess., 6 (1952)).

[7] Katherine L. O'Sullivan, *Returning Patentable Subject Matter to Anything Under the Sun Made By Man*, 1 UCLA J. L. & Tech. (2018).

[8] 383 U.S. 1 (1966).

understood, routine, and conventional" computing device under the *Berkheimer* standard.[9] The rejections seen by applicants in such applications can be gratuitously difficult to overcome, and sometimes result in the need to add otherwise extraneous limitations to claims for the sole purpose of satisfying an undefined standard.

Beyond the strain the current state of Section 101 jurisprudence adds to individual cases, it places a strain on the American public by suppressing the progress of science and the useful arts, by unduly limiting and casting uncertainty on the primary means for our innovators to secure for limited times the exclusive right to their discoveries. The American public can see this strain manifested in a throttling of innovation, which may be at least in part due to uncertainty among potential patent applicants of whether they will be able to avail themselves of U.S. patent protection and thus reap the benefits of their valuable contributions to society.

Therefore, it is essential to American innovation that the USPTO and the Senators consider necessary changes to subject matter eligibility in the U.S. patent system to clarify the law and provide a measure of certainty to America's tech innovators. If an increase in software patents carving up the market is a concern, the remaining provisions of the Patent Act (*e.g.*, §§ 102, 103) still provide necessary barriers to patenting trivial variations and improvements. A clear statutory pathway for software inventions to be patent-eligible[10] would provide needed clarification and lower the barriers businesses and independent inventors face to avail themselves of patent protection and increase competition in the marketplace. The list has been the same since 1793. It's time to add "software."

Mertzlufft Law PLLC appreciates the initiative of the USPTO and the Senators in issuing the Request and encourages the USPTO and the Senators to consider necessary adjustments to current examination practice and the statutory requirements of 35 U.S.C. § 101 to revitalize our patent system as the world's patenting hub and enable twenty-first century American innovation to flourish.

Yours for fixing up the world,

Joshua D. Mertzlufft, Esq., USPTO Reg. #76,241
Principal
Mertzlufft Law PLLC

Cc: U.S. Sens. Thom Tillis, Mazie Hirono, Tom Cotton, and Christopher Coons
United States Senate Committee on the Judiciary, Subcommittee on Intellectual Property
U.S. Congressman Christopher Jacobs

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[9] *Berkheimer v. HP Inc.*, 881 F.3d 1360, 1368 (2018).

[10] For example, 35 U.S.C. § 101 could be amended to read: "Whoever invents or discovers any new and useful process, machine, software, 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."