To: USPTO
From: Adam H. Masia (Reg. No. 35,602)
Response to July 9, 2021 Request for Information from USPTO

In response to the July 9, 2021 request for information regarding the business and economic effects of the current state of patent eligibility jurisprudence in the United States, I hereby respectfully submit the comments below. These comments are my personal opinions, and are not made on behalf of my law firm Neal, Gerber & Eisenberg LLP, or on behalf of any of my clients or the clients of Neal, Gerber & Eisenberg LLP.

I have been a registered patent attorney for about 30 years. The main focus of my practice over the last 30 years has been patent prosecution. I have represented and currently represent numerous owners of pending U.S. patent applications. My clients range from U.S. publicly traded companies to U.S. small businesses and individuals. At various points in time over the last 15 years, I have been responsible for 400 to 700 pending U.S. Patent Applications. For instance, on August 30, 2021, I had 519 U.S. Patent Applications pending on my docket.

The flawed current state of patent eligibility jurisprudence creates many problems for many companies and individuals.

Since 2014, I have had numerous U.S. Patent Applications rejected for subject matter eligibility. During this period of time, my clients have been forced to abandon numerous U.S. Patent Applications directly due solely to subject matter eligibility (i.e., applications without any novelty or obviousness rejections). The technology areas of these abandoned U.S. Patent Applications range from gaming machines to internet software based inventions.

The flawed current state of patent eligibility jurisprudence makes it difficult, if not impossible, to predict when U.S. patent protection will be available for new software related inventions. This makes it difficult for certain clients (especially smaller clients or start-ups) to invest in U.S. patent applications. This puts certain clients at a competitive disadvantage because they cannot protect their inventions.

The flawed current state of patent eligibility jurisprudence also makes it extremely expensive for certain clients to invest in filing and prosecuting U.S. patent applications. This again puts many larger and smaller clients at a competitive disadvantage, and quite frankly is a waste of money for these clients.

The flawed current state of patent eligibility jurisprudence makes it easier for competitors of certain clients to copy the clients' technology.

I provide the following brief examples.

In a first example, one client invented and commercialized an internet based physical therapy system that enabled patients to obtain physical therapy at home via a web site.

Before we filed, I explained to the client the potential for a subject matter rejection for its U.S. Patent Application. The client took the risk, and believed that the USPTO would understand that its system was a very specific new way to provide physician approved and monitored physical therapy for people. After the first or second office action, we overcame all of the section 102/103 rejections because nothing existed that was remotely close to the claimed invention. The only rejection remaining was a patent eligibility rejection based on the examiner's statements that providing physical therapy to patients is an abstract idea. The claims were way more specific than just providing physical therapy to patients. That did not matter and we received and responded to multiple section 101 rejections, each time adding one or more device or other specific elements to the claims in response. None of these additional claim elements mattered to the examiner. The client made a significant investment in the U.S. patent application and the multiple responses. After the multiple final office actions, and multiple telephone interviews with the examiner, the client could not invest any more money in its U.S. patent application, and decided to abandon its U.S. patent application.

In a second example, a diverse minority client wanted to patent their music selection software invention. The invention enabled digital music selection and purchase in a completely different way than has ever been done before. In my opinion, the invention should have been patentable, but it would be extremely expensive to try to convince the USPTO, and given the entire subjective application of *Alice*, it was impossible to know if a U.S. patent would actually be granted. The client was starting a business solely based on this software, and it was clear to me that the USPTO would certainly, at least initially, reject any U.S. Patent Application for this invention based on the state of patent eligibility jurisprudence. I explained the risks to the client, and the client could not afford to proceed and decided not to file any U.S. patent applications. The client had a significant problem trying to raise money to start their business because they could not protect against bigger players in the music business stealing their invention. The client's business never got off the ground. The uncertainty and cost due to the state of patent eligibility resulted in the loss of a new minority owned American business.

This second example is even more frustrating to me than the first example. In today's world, a disadvantaged person can start a new business simply with a computer and an idea for new software (that can do something the world has never seen before). But the flawed current state of patent eligibility jurisprudence practically prevents such an inventor from patenting their software simply because such software is done on a generic computer and does not improve the computer itself. Thus, the truth of the matter is that the flawed current state of patent eligibility jurisprudence is discriminatory in its nature against such inventors. If we want to give disadvantaged people a chance to better themselves, let's get them computers, teach them to program, encourage them to invest their time in developing great inventions (in the form of new software), and let's enable them to protect what they invent. Software enables disadvantaged people to have the opportunity to succeed, but the USPTO and the flawed current state of patent eligibility jurisprudence simply does not. It is time to change that.