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Posted by the **Patent and Trademark Office** on Sep 7, 2021

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Comment for Patent Eligibility Jurisprudence Study

I own an intellectual property law firm, and have been practicing patent law, primarily patent litigation, for over 30 years.

Here, I contend that 35 USC §101 has been misinterpreted by the courts, and that §103 should often be used instead of §101 to analyze patentability.

35 USC §101 sets out initial criteria for patentability ("Whoever invents or discovers any new and useful process, machine… may obtain a patent….") Think of §101 as a filter with relatively large holes. If the invention or discovery falls within the scope of the criteria set forth in §101, then it is patentable "subject to the conditions and requirements of this title."

35 USC §103 can be thought of as a filter with smaller holes. If a potential invention or discovery clears the §101 hurdle, then it must still clear the §103 hurdle before it can be found patentable.

As an example, under §101, a law of nature is not patentable because, while it may be useful, it is not "new." §101 is a filter with large holes, letting many things pass through because, once a putative invention is determined to be "new and useful," it will certainly pass the remaining §101 criteria. Can you name an invention or discovery that is not either a "process" or a "composition of matter"? I can't. More the point, §101 DOES NOT say that an algorithm is not patentable. That is judge-made law. And I believe it is inconsistent with the statutory framework, and has led to the morass of problems we now face.

An "algorithm" (Webster's defines it as a "procedure for solving a mathematical problem….") is not patentable because it fails under 35 USC §103, as being "obvious" to a person of ordinary skill in the art. An "algorithm" may also not be "new" if it is in the nature of a mathematical theorem, for example.

The court system, by saying that an "algorithm" is not patentable under §101, has forced courts to try to make artificial, and often semantic, determinations as to whether a particular business method, computer program or other discovery is an "algorithm" or has sufficient "algorithmic" characteristics such that it should be treated as one. These can be nearly impossible questions to answer, and have led to inconsistent and sometimes downright weird §101 results in the courts. But all of this evades the statutory framework. If the

invention is “new and useful,” and therefore meets the §101 criteria, then the patentability question should be taken up under §103, and the “obvious” question can then be directly confronted, with its rich history of jurisprudence.

Business methods, computer programs and “algorithms” often build iteratively on what has come before, and will often be found “obvious” as not sufficiently different and inventive from prior technology. But currently, in my opinion, courts are using the wrong tool (§101) to analyze the patentability criteria when the §101 hurdle has already been cleared.

As a result of the current situation, many of my clients are in limbo. They don't know whether it makes sense to try to obtain a patent, if there is any question an "algorithm" or a "business method" may be involved, for example. Nor am I sure how to counsel them at this point.

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Comment ID

PTO-P-2021-0032-0005

Tracking Number

kqw-csqz-5j8y

Comment Details | **Submitter Info**

Document Subtype

Public Comment

Received Date

Jul 8, 2021

Page Count

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