Dear Sir or Madam:

As a preliminary matter I am a U.S. citizen, a United States registered patent attorney, and I have practiced United States patent law for over thirty years. One of my areas of expertise is patent eligible subject matter under 35 U.S.C. section 101 [hereinafter section 101], and I have published and presented to continuing legal education and university audiences on this subject for over fifteen years.

COMPUTER RELATED INVENTIONS

There are always outliers and cases on which reasonable and competent legal minds could disagree. However, a careful review of 2020-2021 Federal Circuit section 101 decisions and discussion of earlier Federal Circuit decisions therein, as well as Alice Corporation v. CLS Bank International, 575 U.S. 208 (2014) [hereinafter 'Alice'] reveals three clear and consistent trends:

1. Claims for abstract ideas implemented by generic computers are always subject matter ineligible. There is no manner in which to draft a United States utility patent application to obtain patentable subject matter eligibility.
2. Claims for computer improvements in which computer components or computer networks comprise newly designed or structurally modified features may be patent subject matter eligible if the patent is properly drafted.
3. Claims for processes in which one or more computerized step is an improvement to a previously existing industry or other technological process or method may be patent eligible if the patent is properly drafted.

I have carefully reviewed the patents or patent applications which the Federal Circuit recently held invalid under section 101. I have also observed that a significant number of these documents were submitted to the patent office approximately when the Supreme Court decided Alice. I most reluctantly conclude that many of these patents did not comply with Alice or its Federal Circuit progeny, and even though Alice was retroactive with respect to its section 101 patentable subject matter requirements.

The last step in the process i.e., a losing appeal to the Federal Circuit, has now occurred in many of these situations. The dissatisfied appellants loudly and persistently blame the law, the Federal Circuit and Alice, but these allegations have no legal, factual or policy merit, especially for poorly drafted patents.

As to financial injury to computer related industries, the dissatisfied parties should provide bona fide evidence that the financial woes are (i) directly caused by Alice and its Federal Circuit progeny and (ii) not the result of unenforceable patents and patent applications. Has any evidence yet been submitted, and if so, is this evidence sufficiently specific with a clear cause and effect relationship? In any event, abstract ideas have been held to be characterized as patent ineligible subject matter for a very long time. If the computer industry prevails in its proposal to change the law, should its alleged financial injury supersede the stifling of innovation in both business and technology when abstract ideas are monopolized by business competitors? There are also anti-trust issues to consider when an abstract idea covers all possible means of arriving at an abstract idea 'innovation.'

BIOMEDICAL SUBJECT MATTER

Without more, discoveries of naturally occurring events or natural laws (i)have never been characterized as patent eligible subject matter and (ii) comprise a long-standing judicially created exception to section 101 statutory categories for patent eligibility. In Mayo Collaborative Services v. Prometheus Laboratories, Inc., 566 U.S. 66 (2012), the Court explicitly confirmed that naturally occurring biomedical discoveries do not qualify as patent eligible subject matter. After Mayo, the Federal Circuit has consistently held that claimed diagnostic methods are not patentable subject matter. This is because the only claimed novel elements in these cases were exclusively naturally occurring phenomena which researchers discovered, but did not create or modify. The only other claimed limitations were inevitably and exclusively information gathering steps, review of the information about the natural occurring event (mental steps), or a conventional display of the information and/or results.

In contrast, claimed treatments or laboratory methods may be patent eligible if the patent is properly drafted. The reason: Because a treatment or laboratory method may comprise at least one newly conceived and created limitation of a quantitative, qualitative, time duration, etc. feature. Although a medical treatment or laboratory method is inevitably based upon an underling natural phenomenon, the properly drafted treatment or laboratory method patent does not CLAIM the natural phenomenon.

As with the computer related subject matter, has the pharmaceutical or biomedical community submitted bona fide evidence that Mayo and its Federal Circuit progeny has serious injured them in any manner? This evidence should establish that (i) there is a specific clear cause and effect relationship between the actual judicial decision(s) and a specific injury; and (ii) exactly how these industries were adversely affected financially by each specific decision. Nevertheless, even if this evidence exists, if the pharmaceutical industries' proposals for patenting naturally occurring phenomena are implemented there would be the following consequences:

1. Researchers and medical practitioners would be unable to develop treatment plans or even clinically treat patients for any malady which requires use of the patented naturally occurring phenomenon;
2. For a researcher or physician to access the patented natural phenomenon would require an extravagant fee to a business competitor as well as at the business competitor's discretion; and
3. The patenting of this natural phenomenon would raise serious anti-trust problems.